บทคัดย่อ

ปัญหาเรื่องการนำเข้าซื้อ (Parallel Importation) เป็นปัญหาที่พบบ่อยในความสามารถในการขนส่งระหว่างประเทศที่มีภักดีการค้ามากขึ้น ประกอบกับนโยบายการค้าเสรีที่แต่ละกลุ่มประเทศต่างๆ ได้นำมาปฏิบัติ อย่างไรก็ตามปัญหาเรื่องการนำเข้าซื้อในปัจจุบันต่างๆ ที่ยังไม่เป็นที่รู้ว่ากรณีใดบ้างหรือต้องเข้าชายฝั่งของที่มีการนำเข้าซื้อไม่ได้ กำหนดสำหรับผู้ซื้อที่นำมานั้นได้แก่ผู้บริโภคได้รับผลผลกระทบในทางที่อาจสับสนหลังผิดหรือถูกหลอกลวง (deceived) จากสินค้านั้นๆ หรือไม่ทั้งนี้เป็นข้อที่น่าพิจารณาประกอบกับเรื่องทางกฎหมายการค้าของสินค้าที่มีการขายในประเทศและสินค้าที่มีการนำเข้าซื้อในประเทศนั้นเป็นบุคคลคนเดียว หรือมีความสมัครใจต้องไม่ว่าจะเป็นในแถวของสัญญาหรือสถานการณ์ระหว่างกัน ขององค์กรประกอบการ เป็นเรื่องที่สามารถนำขึ้นได้ว่าการนำเข้าซื้อในต่างทุ่น หรือไม่ สำหรับกฎหมายที่เกี่ยวข้องกับสินค้าในการนำเข้าซื้อในสินค้าที่มีเครื่องหมายการค้าที่เดียวกันนั้น ก็มีกฎหมายเครื่องหมายการค้าซึ่งแต่ละประเทศมีกฎหมายที่ต่างกันได้ ที่อาจแตกต่างกัน โดยเฉพาะกฎหมายของประเทศใหญ่ไร่จะมีกฎหมายที่ซับซ้อน เมื่อมีการประคุกคลทุฏฏิภูมิเกี่ยวกับหลักการเขต (territoriality) และการรับรู้สิทธิไปของสิทธิ (exhaustion of rights) มาใช้ สำหรับการนำเข้าซื้อทางอื่นๆ การนำเข้าซื้อที่เกี่ยวข้องกับสินค้านั้น บทความนิเวศวิเคราะห์แนวโน้มของการนำเข้าซื้อที่มีต่ออันตรายทางการค้าและสุสานสิ่งที่นำเข้าซื้อว่าต่อสุขนิสัยและมีความรับผิดชอบต่ออันตรายไร้ด้วย

* จากบทความเรื่อง "Parallel Importing of Trade" โดย Mark Davison
Parallel Importing of Trade Marked Products

Mark Davison

This area is complex and there is no clear cut answer to the question whether parallel importing of trade marked goods is legal. It depends on the particular circumstances. In the discussion below, I will refer to “the parallel import” and “the domestic goods”. The domestic goods may, of course, also be imported.

Policy Considerations

Let us look first at the policy arguments for and against parallel importing. If the parallel import and domestic goods are significantly different in some way, consumers will be deceived if they purchase the parallel imports believing them to be the same as the domestic goods. For example, in Australia, one case involved electronic goods. The parallel import was not manufactured to be compatible with the Australian electrical system, unlike the domestic goods. Selling the parallel import deceived consumers, which was clearly inappropriate from a policy perspective. In such cases, the matter could be dealt with as a case of passing off or misleading conduct and it was dealt with on the basis in that case.

If the goods as the same, the considerations are different, as a consumers are not deceived. The company objecting to parallel importing (the domestic company) wishes to protect its investment in marketing the goods in Thailand. It has spent time and money advertising the domestic goods or otherwise developing goodwill for the domestic goods. If the parallel importing is permitted, the importer may obtain the benefit of the efforts of the domestic company. The importer will not have to advertise the goods as much because the domestic company has already done so. The long-term effect may be that domestic companies will invest less money in advertising, providing information about products to consumer and so on.

The argument in favour of parallel importing is this. The domestic company is attempting to avoid competition. The price of the domestic goods is too high because consumers can only buy the trade mark goods from the domestic company. For

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2 Star Micronics Pty Ltd v Five Star Computers Pty Ltd (1990) AIPC 90–717
example, "Johnnie Walker Scotch" will only be available from one source – the
domestic company – that can raise the price too high.

The Legal Situation

What is the legal situation? Section 44 of the Thai Act says that the owner of
the trade mark shall have the exclusive right to use it. So, is the parallel importer using
the trade mark? The question was the same in Australia under the old legislation of
1955 but under the new legislation of 1955 the question is whether the domestic
trade mark owner has either applied the trade mark to the parallel imports or consented
to the application of the trade mark. However, there does not appear to be any
difference in the result of the cases, regardless of which legislation is referred to.

If the foreign owner of the trade mark in the country from which the parallel
import comes is the same as the domestic owner of the trade mark; the parallel
importer is not infringing the trade mark. In such cases, it (the domestic trade mark
owner) has used the trade mark but the parallel importer is not using the trade mark as
a trade mark and is not --infringing the trade mark. Alternatively, the domestic trade
mark owner has either applied the trade mark to those goods itself or consented to
them being applied. From a policy point of view, this may be fair as the same
company has sold the product originally and they received a return for doing so in the
foreign country. This situation does not change if the domestic trade mark owner has a
domestic licensee. The domestic trade mark owner still applies the trade mark to the
goods originally and it, not the parallel importer, is using the trade mark.

\[\text{footnotes:}
3\text{ Trademarks Act 1955 (Cth), S 62(1)}
4\text{ Trademarks Act 1955 (Cth), S 123(1)}
5\text{ Bailey v Boccacio (1986) 6 IPR 279, Atarai Inc and Futuretronics Australia Pty Ltd v Fairstar Electronics Pty Ltd (1983) 50 ALR 274, Delphic Wholesalers Pty Ltd v Elco Food Co Pty Ltd (1987) 8 IPR 545. But see Atari v Dick Smith (1980) 33 ALR 20 (interlocutory decision only). See also the English Court of Appeal decision of Colgate Palmolive Ltd v Markwell Finance Ltd (1989) RPC 497 which was criticised in the Australian decision of Transport Tyre Sales Pty Ltd v Montana Tyres, Rims & Tubes Ltd (1999) AIPC 91-467 (Full Court of the Federal Court of Australia)}
6\text{ Australian decision of Transport Tyre Sales Pty Ltd v Montana Tyres, Rims & Tubes Ltd (1999) AIPC 91-467 (Full Court of the Federal Court of Australia)}
7\text{ Delphic Wholesalers Pty Ltd v Elco Food Co Pty Ltd (1987) 8 IPR 545.}\]
In order to avoid this difficulty, some trade mark owners assign their trade mark to a separate domestic company which distributes the goods. But the assignment is conditional upon the distributorship agreement continuing. Once it comes to an end, the original domestic trade mark owner can insist that it be re-assigned to it. One Australian case has decided that this is permissible and the distributor can prevent parallel importing in such situations. In my view, this decision was wrong, as the distributor was, in effect, a licensee who was really controlled by the original owner of the trade mark. It knows that the original owner will continue to use the trade marks overseas and is, therefore, consenting to that owners continuing to apply the trade mark to goods. Some of these goods are intended to be forwarded to the domestic owner while others are intended for other markets. Nevertheless, all of them have had the trade mark applied to them with the consent of the domestic trade mark owner.

What if the foreign trade mark owner and the domestic trade mark owner are not the same? They may be related companies, perhaps part of a global group of companies. Quite possibly, each has consented to the other applying the trade mark to the goods jointly sold and marketed by the group.

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8Fender Australia Pty Ltd v Bevk (1989) 89 ALR 89. The Judgment in Transport Tyre Sales Pty Ltd v Montana Tyres, Rims & Tubes Ltd (1999) AIPC 91-467 does not directly address the issue as the facts pleaded did not raise the issue. However, the judgment suggests that infringement might take place in such circumstances. The case dealt with importation at a time when the domestic owner and the foreign owner were the same and did not directly address the question of importation after the foreign owner had conditionally assigned the trademark to an Australian distributor. However, if required to address the issue, the court may adopt the argument made by me above that the distributor is, in effect, a licensee who is really controlled by the original owner of the trademark. It knows that the original owner will continue to use the trade mark overseas and is, therefore, consenting to the owner continuing to apply the trademark to goods. Some of these goods are intended to be forwarded to the domestic owner while others are intended for other markets. Nevertheless, all of them have had the trademark applied to them with the consent of the domestic trademark owner.

9Revlon Inc & Ors v Cripps & Lee and Others (1980) FSR 85. However, in that case two of the three judges reached their decision on the basis that the product in question had been marketed on a global basis as the product of the Revlon corporate group. One of the judges, Templeman LJ found that it was sufficient that the domestic owner was a subsidiary of the overseas owner.
If the companies are completely unrelated, then parallel importing will be an infringing use of the domestic trade mark owner’s trade mark. However, the circumstances in which this will arise are relatively rare. Usually there will be some corporate or contractual relationship between the two trade mark owners concerning distribution or, at least, controls on production and marketing for the purposes of ensuring the on-going integrity of the trade mark. If there is not such an ongoing relationship, then there is a strong likelihood that at some stage the two products in question will differ significantly. At that point, the issue of parallel importation can be resolved by reference to passing off considerations.

The doctrines of Territoriality and Exhaustion

Many of the decided cases on this topic refer to the issue of whether a trade mark is territorial in the sense that the trade mark owner’s rights in one country exist completely independently of those rights in another country. An opposing theory is the exhaustion of rights theory which provides that once the trade mark proprietor places the trade mark on the goods or consents to that happening and disposes of those goods, its rights to control the subsequent distribution of those goods are exhausted. On the whole, most cases have adopted the exhaustion of rights theory.\(^9\)

However, while references to these competing theories of trade mark law are useful, they do not completely answer the question of whether any particular act of parallel importing is illegal. This is partly because the identity of the relevant trade mark owner whose rights are said to be exhausted is critical. If the trade mark owner has not applied the trade mark or consented to the application of the trade mark on the goods in question, it has not exercised its rights in relation to those goods and, hence, it is difficult to see how those rights have been exhausted. On the other hand, any consent to the application of the trade mark to the goods can be considered to be sufficient to exhaust the trade mark owner’s rights. The scenarios above relate to the question of whether the trade mark owner has consented to the application of the trade mark and, thereby, has exhausted its rights.

It should also be noted that the situation in the United Kingdom and other members of the European Community is complicated by the various agreements between the members of the Community concerning trade matters. The effect of these agreements is that parallel importing within the European Community is permitted but parallel imports imported from outside the European Community will not be

permitted.\textsuperscript{10} Therefore, any recent decisions from these countries are unlikely to be helpful for the purposes of Thai law.

**Breach of Contract and Inducing Breach of Contract**

A related but separate issue is whether there can be any action for breach of contract by the domestic owner or licensee against the foreign owner or any related action for inducing breach of contract against the parallel importer. This scenario may arise when the foreign owner promises to exclusively supply goods for the purposes of export to the domestic owner or the domestic licensee. If the foreign owner then proceeds to sell the goods knowing that will be exported to the country of the domestic owner or licensee, it will have breached its contract with the domestic owner or licensee. In addition, under Australian law, the domestic owner or licensee could sue the parallel importer for deliberately inducing the breach of the contract if the parallel importer knew about the exclusive supply arrangement between the domestic owner or licensee and the foreign owner.\textsuperscript{11} Under Thai law, there may be provisions in the Civil Code concerning conduct in bad faith that would relate to this situation.

**Relationship to Policy**

How do these results relate to the policy considerations discussed above? If the domestic owner and the foreign owner are the same, it has received some compensation from the overseas sale of the goods although perhaps not enough to compensate it for its domestic investment. However, at least it receives some compensation.

If the domestic owner has a licensee, the situation is the same. The licensee must be aware that it does not have exclusive rights to sell the trade marked products and the licence fee should reflect this fact. If the assignment is conditional and is really a licence, the situation is, in effect, the same.

If the two companies are related in the sense that one controls the other, they can agree on re-distributing profits of the original, overseas sale of the trade marked goods.

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\textsuperscript{11} Delphic Wholesalers Pty Ltd v Elco Food Co Pty Ltd (1987) 8 IPR 545.
If the foreign and domestic owners are completely unrelated, the domestic owner gets no return from its domestic investment as a consequence of the overseas sale of the imported goods and the importing should be prohibited.

Of course, it is difficult to identify the exact position in any case. However, the situation should become clear during pre-trial procedures such as pleading and discovery. The parallel importer must know from whom it obtained the goods in question and be able to prove that the trade mark was legitimately applied. In addition, the domestic trade mark owner must know about the relationship between itself and the person who did in fact apply the trade mark to the parallel imported goods.

While none of the above solutions is perfect, they do reflect to some extent, the policy issues involved in this area. In any event, the most important matter is that there is certainty so that importers, trade mark owners and licensees can arrange their affairs accordingly.