



The Trademark Prosecution Review

2024

**Thailand: Examiners' Unique
Approach to Distinctiveness
Underscores Complex Registration
Process**

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The first edition of the WTR Trademark Prosecution Review takes a wide-ranging view of best strategies for securing trademarks in the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa. The review combines on-the-ground knowledge and analytic insight to offer an unparalleled deep dive into the prosecution landscape in specific key markets.

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Thailand: Examiners' Unique Approach to Distinctiveness Underscores Complex Registration Process

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IN SUMMARY

The trademark registration process in Thailand is a complex and time-consuming process. The examiner in Thailand has a unique approach to considering whether a trademark is distinctive. More interesting is what the examiner considers to be acceptable goods and services under the item-by-item meaning of the goods and services.

DISCUSSION POINTS

- What can I register and what can I not register?
 - How are unregistered rights protected, and how is trade dress protected?
 - How are non-traditional marks prosecuted?
 - How are oppositions and cancellations handled?
 - What are the pendency levels for the past 12 months?
 - How to transfer ownership of trademark registrations, and licensing best practices
 - What are the five key 'need-to-knows' for Thailand
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REFERENCED IN THIS ARTICLE

- Thai Trademark Act BE 2534 (1991)
- Examiner Registration Manual BE 2565 (2022)
- Penal Code
- Ministerial Regulation No. 5 BE 2560 (2017)
- Civil and Commercial Code
- Unfair Contract Terms Act BE 2540 (1997)

WHAT CAN I REGISTER?

In Thailand, you can register the following types of trademarks and service marks, including word marks and device marks:

- word marks: these are trademarks consisting of words or letters;
- device marks: these are trademarks consisting of images or, logos, or a combination of both;
- service marks: these are trademarks used to distinguish services from physical products;
- three-dimensional marks: these are trademarks comprising the shape or packaging of a product;
- sound marks: these are trademarks comprising a distinctive sound;
- collective marks: these are trademarks used by members of an association or group to identify themselves with a particular trade, service or geographical origin; and
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certification marks: these are trademarks used to indicate that a product or service meets a certain standard or certification.

The proposed trademark must be distinctive, not prohibited under applicable laws and not similar or identical to pending or registered trademarks of other persons.

One problematic aspect of trademark registration in Thailand is how a distinctive trademark is considered. The examiner in Thailand has a unique approach to considering whether the proposed trademark is distinctive.

A distinctive trademark is a mark that is capable of distinguishing the goods or services of one trader from those of another. According to the Thai Trademark Act BE 2534 (1991) and its amendments,^[1] a trademark is considered distinctive if it:

- does not describe the nature, quality or characteristics of the goods or services;
- is not a commonly used or recognised term in the relevant trade or industry;
- does not indicate the geographical origin of the goods or services; and
- is not deceptive or misleading.

There was a case where a bank brought a case against the Department of Intellectual Property (DIP), which oversees the Trademark Office, under which the examiner determined that the trademark below was unregistrable due to the non-distinctive nature of the proposed mark.



Make THE Difference

In most cases, the examiner tends to consider any abbreviated mark to be non-distinctive. The same goes for captions or descriptions of goods or services. The examiner tends to ignore whether the proposed mark directly references the goods or services. On the other hand, the Trademark Act clearly requires direct reference as the primary test. In this particular case, the bank did not agree with the examiner's decision. The case was brought to the Supreme Court's consideration and the Supreme Court decided in the ruling No. 2587/2559^[2] that:

If the words or statement that the Plaintiff applied for a service mark registration did not have direct characteristics or natures of commercial bank services as applied, the said words or statement could be deemed as having distinctiveness in itself as prescribed in Section 80 in conjunction with Section 7 paragraph two (2) of the Trademark Act B.E. 2534 (1991). In applying for registration of the service mark "TMB Make THE Difference", as the service mark which would be used for Class 36 commercial bank services, they had a nature of generic description not directly related to the commercial bank services which was the service item the Plaintiff applied for registration in any way. The said statement had a nature of suggestive word only not a descriptive word that enabled the public or the service users to immediately know or understand the nature or characteristic in relation to commercial bank activities specifically but the service users had to use their imagination or find additional information to know that the Plaintiff's commercial bank services were different from others. Moreover, the statement "Make THE Difference" was not commonly used in commercial bank services in any way. Therefore, the statement "Make THE Difference" did not convey the characteristic or nature of commercial bank directly and was not commonly used in commercial bank services that Plaintiff applied for registration. As a result, Plaintiff's service mark "TMB" with the statement "Make THE Difference" which are component parts of the image of the service mark have inherent distinctiveness and are registrable and the Plaintiff does not have to disclaim exclusive right in using the statement in Roman letters "Make THE Difference".

WHAT CAN I NOT REGISTER?

A trademark that does not have a specific character within the meaning of the first paragraph of Section 7 of the Trademark Act BE 2534 (1991) has characteristics that can be used by the public in all industries, all businesses and groups of individuals. Therefore, it lacks the feature that makes the public or the user of the product aware of and understand that the product using the trademark is different from other products.

The most common aspects of a product that parties attempt to register relate to the general meaning used by the public in industries and businesses. All groups of persons may use and should not grant any person the exclusive right to use marks related to general meaning of a product, including generic terms and product names. Examples – see the Examiner Registration Manual BE 2565 (2022)^[3] – and commonly used symbols are as follows:

- international expressions, such as 'international' and 'global';
- 'guaranty', 'warranty', etc;
- model or product numbers (eg, series numbers, classes and generation types);
- colour names and their classes, such as green, green, dark silver and dark grey;
- readings of numbers, letters and counts (eg, AB, One, First, Twin, Double and XLVI (Roman numerals));
- names of diseases, such as covid-19, HIV, Ebola and H1N1;
- country-related language, such as 'American', meaning about the country;

- currency symbols, such as baht and dollar;
- mathematical symbols, such as +, -, %, Alpha, Beta, Σ and β ;
- commonly used pictograms, such as those related to disability and gender symbol; and
- others, such as Eco3D, 4D, tec, technology, original, organic and classic.

Any words or statements directly referring to the characteristics or services of the product or services that are non-distinctive must be clear to consumers immediately or must only require a little judgment to understand. For example, 'STEELSCREWS' means screws made of steel. When applied to a product, threaded nails made of metal, it may cause consumers to immediately understand that it is a product of threaded nails made of steel. Thus, 'STEELSCREWS' is non-distinctive.

Translation of a non-distinctive trademark is considered non-distinctive even if there are several meanings and one of these meanings directly addresses the characteristics of the product. This consideration includes an abbreviation of that word. For example, the word 'cool' has many meanings, including excellent, modern or cold. When used with goods in Class 17 (window film) it is understood as a window film product that cools the temperature, so it is a term that directly refers to the properties of the product. If used with 'shirt' in Class 25, it is understood as a beautiful and modern product, so it is a word that directly refers to the properties of the product. Another example is the word 'max' – it is an abbreviation for 'maximum', and this can be considered non-distinctive.

Words or text intentionally misspelled can be non-distinctive if, considering a colloquial accent, they can be understood as words or text that have a meaning and that meaning directly describes the characteristics or properties of the product.

Words or text that are written by combining two or more words with two or more meanings, and the meanings of these words may be easily interpreted as a direct description of the appearance or properties of the product, are non-distinctive. For example, 'Clearview', which combined the two words 'clear' and 'view', translates to a clear vision. When used for contact lens products, it can be understood as a contact lens product that makes things clearly visible; it directly describes the features of the product.

Words or statements that directly refer to the characteristics or properties of goods, even if invented to have special characteristics, are considered to be non-distinctive.

Comparative consideration of whether a trademark is identical or similar is another issue. The word 'identical' means that the mark is the same and the word 'similar' means that the mark is so similar that it may confuse or mislead the public as to the ownership or origin of the goods. Consider whether a trademark is identical or similar not only comparing images, words and text that appear but also all elements of the trademark. All pronunciations, colloquial accents and items that are sought to be registered for use with trademarks should be considered. The same goes for whether the members of the public that use the goods under the trademarks are part of the same groups and have sufficient knowledge to distinguish between the goods under the two trademarks (Supreme Court Decisions No. 3271/2560 and No. 8156/2560).^[4]

HOW ARE UNREGISTERED RIGHTS PROTECTED?

In Thailand, unregistered trademarks can still receive protection under the old, but still in effect, Penal Code. Penalties under the Penal Code^[5] are very low, and it is more difficult to prove ownership and enforce the rights of an unregistered trademark owner compared to a registered trademark owner.

To protect an unregistered trademark in Thailand, the owner can take the following steps.

- Monitoring: it is important to monitor and watch out for any instances of infringement or unauthorised use of the unregistered trademark.
- Taking legal action: if an infringement occurs, the owner of the unregistered trademark can take legal action against the infringing party. This can involve filing a complaint with the police and filing a lawsuit and providing evidence of ownership, the use of the mark and the infringement.

HOW ARE NON-TRADITIONAL MARKS PROSECUTED?

In Thailand, non-traditional marks can be prosecuted under the same legal framework as traditional marks. This includes marks with a combination of colours, figurative elements or sounds, or a combination thereof. Notably, scent marks are not recognised under the Trademark Act BE 2534 (1991). To obtain protection for non-traditional marks, the owner must apply for registration with the DIP under the Trademark Act. The application must include a clear representation of the mark. For sound marks, under Ministerial Regulation No. 5 BE 2560 (2017), it is necessary to describe the sound in detail and sound files need to be submitted. While the Ministerial Regulation does not specify any format of sound files, MP3 is the most commonly recognised. Sound notes, graphs and others that represent the characters of sounds can be also submitted.

The DIP will examine the application and determine whether the mark is distinctive and not confusingly similar to existing registered marks. If the mark meets these requirements, it will be published for opposition, allowing third parties to challenge the registration. If no opposition is filed within the specified period, the mark will be registered.

Once registered, the owner of the non-traditional mark can take legal action against infringers, similar to traditional marks. Infringement of non-traditional marks can occur through acts such as unauthorised use, reproduction or imitation of the mark.

HOW IS TRADE DRESS PROTECTED?

Trade dress often refers to the visual appearance of a product or its packaging that identifies and distinguishes it from other products in the market. Unfortunately, the Trademark Act BE 2534 (1991) does not explicitly protect the trade dress of a product.

Thairath, a local newspaper, reported that a Thai restaurant copied recipes, table designs, ordering forms and the ordering system from a Japanese restaurant. At the same time, the newspaper also cited the DIP's responses that while the Japanese restaurant had a patent registration over a specific system, it had nothing to do with the overall appearance of the restaurant.^[6]

Later, in 2019, a local tea chain store brought a case against another local tea chain store claiming that the defendant used a trade name and trademark together with an animal logo, all of which were similar to those of the plaintiff. In 2021, the Central Intellectual Property and International Court (CIPITC), which is the lower court, ruled in favour of the plaintiff. The

Court reasoned that the defendant used a similar word and the animal's name in its store name and product names, including cups bearing an animal's head in the same position as that of the plaintiff. Also, the defendant was in the same business as the plaintiff. All of these could deceive the public into believing that the defendant's business is associated with that of the plaintiff. It constituted a passing off under the Trademark Act BE 2534 (1991).

To enforce trade dress rights, the owner must bring a civil action in court. In cases of infringement, the owner is entitled to request for injunctive relief, damages and other remedies.

HOW ARE OPPOSITIONS HANDLED?

In Thailand, trademark oppositions are handled by the DIP, which is responsible for the registration of intellectual property rights in the country. If the DIP decides to allow the trademark to be registered, the mark will be published in the Trademark Gazette. At this point, any interested party may file an opposition to the registration of the mark within 60 days of the publication date. The opposition must be filed in writing and must specify the grounds for opposition.

After an opposition is filed, the DIP will review the opposition and any response filed by the trademark applicant. Based on the evidence and arguments presented, the DIP will decide whether the trademark should be registered. Currently, the DIP takes around two years to render a decision.

If the DIP decides to reject the opposition and allow the trademark to be registered, the mark will be registered and published in the Trademark Gazette. If the DIP decides to uphold the opposition, the trademark application will be refused, and the applicant will have the right to appeal the decision to the CIPITC.

HOW ARE CANCELLATIONS HANDLED?

Trademark registration may be cancelled on certain grounds, including non-use, invalidity or cancellation for the public interest.

Non-use Cancellation

If a trademark has not been used in Thailand for a continuous period of three years or more, any interested person may file a request for cancellation of the trademark registration on the grounds of non-use. The request must be filed in writing and must provide evidence of the trademark's non-use. Section 63 of the Trademark Act stipulates that "if it is proved that...with the goods which it was registered". The burden of proof rests with the plaintiff to prove the non-use of all items registered. In other words, it is necessary to prove the non-existence of items registered, which is extremely difficult.

The consideration of the Board of Trademarks in Thailand has been in accordance with the Supreme Court's judgments, based on the concept of the burden of proof in the accusatorial system that "the person who asserts the matter must prove it", where the precedent is held by the Supreme Court (see Supreme Court Decision No. 7774/2540).^[7] If the plaintiff is lucky enough to be able to prove the non-use of one item out of many goods registered, the Board of Trademarks or the CIPITC, as the case may be, will cancel the trademark in question. In addition, a token of use is considered use. Supreme Court Decision No. 4006/2533^[8] ruled that "use of the mark even for a short period of time and in relation to a small number of products still constitutes use."

Invalidity Cancellation

A trademark registration may be cancelled if it is found to be invalid. Invalidity may arise if the trademark was registered in violation of the law or if it is identical or confusingly similar to a prior registered trademark. Any interested person may file a request for cancellation of a trademark registration on the grounds of invalidity.

Cancellation For Public Interest

A trademark registration may also be cancelled for public interest. This may occur if the trademark registration conflicts with public policy or if the trademark is used in a manner that is likely to mislead the public. The DIP may initiate a cancellation action on its own initiative or upon the request of any interested party.

In each case, the cancellation request must be filed in writing with the DIP. The DIP will review the request and any evidence provided and will notify the trademark owner of the request. The trademark owner will be allowed to respond to the request, and the DIP may, in theory, conduct a hearing to allow both parties to present evidence and arguments.

Based on the evidence and arguments presented, the DIP will decide whether the trademark should be cancelled. If the trademark is cancelled, the cancellation will be published in the Trademark Gazette. Currently, the DIP will take no less than two years to decide. The trademark owner will have the right to appeal the decision with the CIPITC.

WHAT ARE THE PENDENCY LEVELS FOR THE LAST 12 MONTHS?

Trademark pendency can vary depending on various factors, such as the complexity of the application, the workload of the DIP and the number of applications filed. The working environment was interrupted by the covid-19 pandemic, and applications accumulated owing to the number of applications that were filed before and during the pandemic.^[9]

The DIP has been taking steps to streamline and expedite the trademark registration process in recent years. For example, the DIP has implemented an online filing system for trademark applications, which can help to speed up the processing time. Additionally, the DIP has increased the number of examiners handling trademark applications to reduce the backlog of pending applications. However, it could take as long as two years for a straightforward application to maturely register.

Earlier in 2023, the DIP implemented a fast-track trademark registration, meaning that an application may take four months to get examined if the list of goods or services the mark relates to is not more than 10 items, and six months if the list of goods or services is not more than 50 items, provided that the application meets the following requirements:

- the application and supporting evidence as listed below is filed simultaneously online;
- the trademark or service mark – not including a combination of colour, three-dimensional or sound marks – is a letter, word or device, or combination thereof;
- the application covers only one class and not more than 10 or 50 items of goods or services;
- the applicant submits proof of the necessity for urgent use of the mark (eg, a marketing plan and a plan for using the mark); and
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the applicant submits a search result conducted from certain databases (eg, the Thai Trademark Office's online database, TMview, and the WIPO Global Brand Database).-

[10] [11]

HOW TO TRANSFER OWNERSHIP OF TRADEMARK REGISTRATIONS

The transfer of ownership of a trademark registration can be accomplished by filing a request with the DIP. The process involves the following steps.

- Draft a deed of assignment: the current owner and the new owner of the trademark registration execute a deed of assignment, which is a legal document that transfers ownership of the trademark from the current owner to the new owner. The deed of assignment must specify the details of the trademark, including the trademark registration number, the goods or services for which the trademark is registered and the date of registration.
- Submit the deed of assignment to the DIP: the new owner of the trademark registration should submit the deed of assignment to the DIP, along with a request to transfer ownership of the trademark registration. The request should include details of both the current owner and the new owner, as well as the trademark registration number.

LICENSING BEST PRACTICE

A trademark licence agreement is a legal contract between the trademark owner (licensor) and the licensee, which permits the licensee to use the trademark. Consideration is not a prerequisite.

While Thailand is based on freedom of contract, for a trademark licence agreement, under the Trademark Act BE 2534 (1991) and its related subordinate rule, the trademark licence agreement should clearly specify the scope of the licence, including the specific goods or services for which the trademark can be used, the geographic area where the trademark can be used and the duration of the licence. The agreement should also include provisions on the quality control of the goods or services to ensure that they meet the standards of the trademark owner.

In addition, under the Civil and Commercial Code, an agreement made in advance exonerating a debtor from their own fraud or gross negligence is void. Also, under the Unfair Contract Terms Act BE 2540 (1997), the following terms may cause legal issues:

- exempt or restricted liability arising from breach of contract;
- allowing contract termination without reasonable grounds or without any material breach by the other party;
- allowing one party to delay or not comply with its contractual obligations without reasonable grounds; and
- allowing one party to enforce further obligations on the other party on top of those agreed to on the date of contract execution, etc.

As required by the Trademark Act BE 2534 (1991), the trademark licence agreement must be in writing and signed by both parties. The agreement must be registered and recorded with the DIP. Failure to register and record the agreement will result in the agreement being void.

WHAT ARE THE FIVE KEYS 'NEED-TO-KNOWS' FOR THAILAND

The following are the five key need-to-knows for trademark registration in Thailand.

- **First-to-file system:** Thailand operates a first-to-file system, meaning that the first person or entity to file a trademark application for a particular mark will generally have priority over subsequent applicants. Therefore, it is important to file your trademark application as soon as possible to secure protection for your mark in Thailand.
- **Use of trademark:** unlike some other countries, Thailand does not require the use of a trademark to register it. However, if a trademark has not been used in Thailand for three consecutive years after registration, it may be subject to cancellation.
- **Trademark classes:** trademarks are categorised into 45 classes based on the goods or services for which they are used. It is important to select each very specific item for your trademark application. The item "pharmaceutical preparations" in Class 5, which may be allowed elsewhere, will not be accepted in Thailand as it is considered too broad. An acceptable description of goods in this regard would be 'pharmaceutical preparations for pain-killing'.
- **Examination process:** after filing a trademark application, the DIP will examine to determine whether the trademark is eligible for registration. The examination process can take an extremely long time, and the DIP may issue an office action requesting additional information or clarification. It is important to respond to the office action within the specified period to avoid abandonment of the application.
- **Renewal:** trademark registrations in Thailand are valid for 10 years from the date of registration and can be renewed for successive 10-year periods. It is important to renew your trademark registration in a timely manner to ensure that your mark remains protected in Thailand.

Endnotes

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