

TRADEMARKGuide

A GUIDE TO TRADEMARK REGISTRATION
& PROTECTION IN THAILAND



ananda

INTELLECTUAL PROPERTY

INTRODUCTION

This publication is meant as a guide to the registration and protection of trademarks in Thailand. It is designed to help applicants obtain trademark protection in Thailand.

DISCLAIMER

This guide does not cover every issue and you should not regard this guide as an authoritative statement on the relevant procedure and trademark law. Requirements may also change from time to time and while we make every effort to ensure the information presented is accurate, you should check with us or with a legal practitioner experienced in Thai trademark law before relying on the information.

We assume no obligation or liability for damage arising out of the use, or inability to use, the information provided. Every effort is made to keep this information up to date. However, errors and omissions may occur.

ABOUT THE AUTHOR

Franck Fougere is Managing Partner of Ananda Intellectual Property and has been practicing in Thailand since 2003. His practice area includes patent prosecution, anti-counterfeiting and litigation. He graduated from Institut d'Etudes Politiques (Strasbourg) in France and College of Europe (Bruges) in Belgium and trained with a major international law firm before moving to Thailand.

In addition to servicing several high profile multinational corporations in Europe, China, and Southeast Asia, Franck is a frequent speaker of cutting-edge IP issues at professional symposiums and conferences. A recognized expert, Franck is a regular lecturer in patent law for the World Intellectual Property Organization (WIPO) and an advisor to the European Union (ECAP) and to the French Government on IP issues. He has authored numerous expert studies and articles. Franck Fougere is also the current President of the Franco Thai Chamber of Commerce (FTCC) and Vice-Chairman of Europe-ASEAN Business Center (EABC) working group on IPR. He is a leading individual for IP practice in Thailand since 2004 (Asia Law) and 2011 (Legal 500).

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1) WHAT TYPES OF MARKS CAN BE PROTECTED?

Trademarks, Service Marks, Certification Marks, and Collective Marks can be protected in Thailand under Trademark Act B.E.2543 (1991) as amended by the Trademark Act B.E.2543 (2000).

2) WHAT ARE THE REQUIREMENTS FOR A MARK TO BE ACCEPTED FOR REGISTRATION?

There are three requirements for a mark to be accepted for registration in Thailand. The mark must be distinctive, not prohibited by law, and be available (ie, not similar or identical to an already registered mark).*

DISTINCTIVE CHARACTER

A mark possessing one or more of the following characteristics is deemed distinctive in Thailand:

- a combination of colors represented in a special manner, stylized letters, stylized numerals or invented word (s)



7-Eleven (stylized numeral)

Kodak

Kodak (invented word)

- a personal name, a surname, a name of juristic person or trade name represented in a special manner

GIORGIO ARMANI

- a word or words having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the law



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- the signature of the applicant for registration or some predecessor in his business or the signature of another person with his or her permission



- a representation of the applicant or of another person with his or her permission or of a dead person with the permission of his or her ascendants, descendants and spouse, if any



- an invented device.



Giorgio Armani



Louis Vuitton

NOTE 1: A mark that has been extensively used in Thailand for a long period of time may be deemed distinctive even if it does not comply with the above requirements. For a trademark to be recognized as distinctive by virtue of usage, the applicant must provide evidence of use of the trademark, such as copies of advertisements, invoices, catalogues etc.

NOTE 2: Disclaimers can be filed in case the mark contains non-distinctive parts. For example, a trademark containing the words "company" or a geographical name "Paris".

LANVIN
PARIS

Disclaimer on "Paris"

Ananda Intellectual Property offers pre-registration advice on registrability of marks that are likely to be rejected due to lack of distinctive character.

NOT PROHIBITED BY LAW

Some marks are explicitly prohibited by law under the Trademark Act and Ministerial Regulations, including:

- any mark which is contrary to public order, morality or public policy
- marks registered or not, which are identical with well-known marks as prescribed by the Ministerial Notifications, or so similar thereto that the public might be confused as to the owner or origin of the goods
- geographical indications protected under the law on geographical indications
- state arms or crests, royal seals, official seals, Chakri emblems, emblems and insignia of the royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces
- national flags of Thailand, royal standard flags or official flags, national emblems and flags of foreign states or international organizations
- royal names, royal monograms, abbreviations of royal names or royal monograms, representations of the King, Queen or Heir to the Throne, names, words, terms or emblems signifying the King, Queen or Heir to the Throne or members of the royal family
- marks identical with or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Thai government or a Thai government agency for public enterprise or any other government organ of Thailand, a foreign government or international organization unless such medal, diploma, certificate or mark has been actually awarded to the applicant for goods and is used in combination with the trademark
- other trademarks prescribed by the Ministerial Notifications.

Ananda Intellectual Property offers pre-registration advice on registrability of marks that may be prohibited by law.

NOT IDENTICAL OR SIMILAR TO A REGISTERED TRADEMARK

We highly recommend checking the availability of a mark prior to filing a trademark application.

Identical searches, similar searches (including phonetic transcription of mark in the Thai language) or device (logo) searches can be performed prior to filing a trademark application.

In determining the availability of a trademark in Thailand it is important to check classes of products/services that are associated with the classes of products/services for which protection is sought. For example, a trademark for food and beverages products shall not be similar or identical to a service mark for catering services.

We also recommend checking translations and transliterations of a mark to avoid risk of confusion or similarity.

3) WHAT ARE THE REQUIREMENTS FOR FILING AN APPLICATION?

Requirements for filing a trademark application in Thailand are similar to filing requirements in other countries. There are, however, some specific conditions regarding products and services classification, and the calculation of official fees payable to the Department of Intellectual Property.

REQUIRED DOCUMENTS

Documents and information required for filing a trademark application in Thailand are as follows:

- Full name, address, country and activity/occupation of the applicant
- Electronic sample of the mark (5x5 cm recommended size)
- List of goods and services to be protected
- Notarized Power of Attorney (for foreign applicants)
- Thai Power of Attorney and copy of Thai corporate certificate or ID card (for Thai applicants only)
- Translation of priority documents (if priority is claimed)

In most cases, Ananda Intellectual Property can prepare all required documents and file the trademark application within 48 hours. If some required documents are not available at time of filing, we can help request an authorization for a later filing of missing documents.

CLASSIFICATION OF PRODUCTS AND SERVICES

Thailand follows the general framework of the International Trademark Classification (Nice Classification) regarding the list of goods and services. However, there are some important specific conditions in Thailand.

- Broad products or services descriptions are not allowed in Thailand. For example “clothing” or “cosmetics” are not accepted descriptions and shall be detailed such as “trousers”, “shirts”, “t-shirts” as per the Thai Classification of Products and Services. Objections from the Registrar regarding product and service descriptions are common in Thailand. It is best to avoid such objections by examining and addressing possible bases of objections prior to filing. Objections may complicate the prosecution of a trademark application.
- Specific local products (such as exotic food products) have been added to the Thai classification

Ananda Intellectual Property systematically reviews, and provides recommendations for product and service descriptions prior to filing a trademark application.

OFFICIAL FEES

The list of products or services for which protection is sought determines the number of applications to be filed and the amount of official fees to be paid. Thailand does not allow multiple-class filing in one single application. Therefore, separate but related applications for the same mark or may be necessary. An application form must be completed for each class of products and service for which protection is sought.

Official fees (government fees) are to be paid to the Department of Intellectual Property for each product and each service designated in the application. Costs for trademark filing and registration in Thailand are, therefore, proportional to the amount of product and service items for which protection is sought.

TRADEMARK SEARCH

It is highly recommended that trademark availability searches are undertaken prior to submission of a trademark application in Thailand. Because examination of a trademark application frequently takes up to nine months, knowledge of trademark availability (by conducting trademark searches) may allow a trademark applicant to assess the registrability of its trademark application before filing.

Identical searches, similar searches (including phonetic transcription of mark in Thai language) or device (logo) searches can be performed prior to filing a trademark application. It is recommended that translations and transliterations of a mark be checked to avoid risk of confusion or similarity.

Our firm can carry out trademark searches within a timeframe of 24 hours.

PRIORITY CLAIM

Thailand is a member of World Trade Organization and signatory to the Paris Convention. It is therefore possible to claim trademark priority (of up to six months) based on a trademark application filed in another WTO or Paris Convention signatory country.

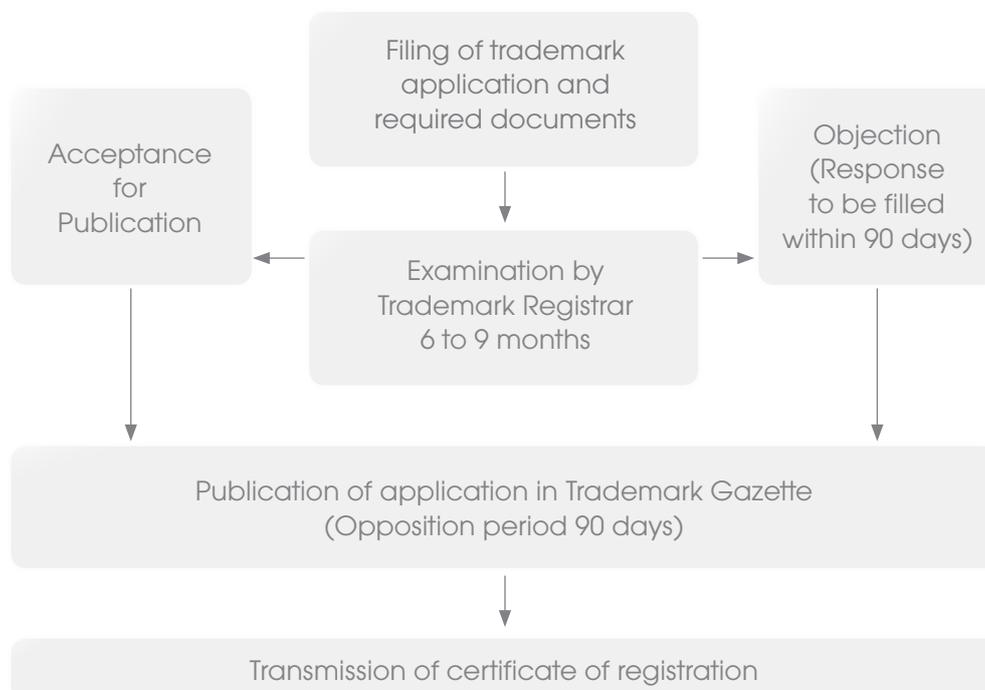
APPOINTMENT OF TRADEMARK AGENT

The trademark applicant or agent must have a residence or office in Thailand. If the applicant resides outside Thailand, the applicant must appoint a local agent and provide a notarized Power of Attorney.

4) WHAT IS THE REGISTRATION PROCEDURE?

Thailand is not a signatory to the Madrid Agreement or to the Madrid Protocol. Therefore Thailand cannot be designated under the international trademark system (Madrid System). The filing of a Thai trademark application must be made by or through a local resident (eg, an appointed local agent).

The average time frame for completing the registration process of a Thai trademark application is nine months. There are four main procedural stages for registration of a trademark application in Thailand: filing, examination, publication and registration.



REGISTRATION PROCEDURE AND TIMELINE FOR TRADEMARK APPLICATIONS**1 - FILING**

To ensure mark protection, it is recommended that an application be filed with the Department of Intellectual Property (DIP). Once the application form has been submitted to the DIP with all required documents, the trademark application will be given an application number and will be examined by the Registrar.

If a required document (such as Power of Attorney or company certificate) or information is missing, it may be possible request a later filing of the missing documents. However, an application cannot be filed without a sample mark or specification of the product/service category (ies) for which protection is sought.

2 - EXAMINATION

After a complete application (with all required documents and fees) is submitted, the trademark Registrar will carry out an examination to verify that the application complies with the requirements of the Trademark Act (distinctiveness, availability, not prohibited by law). The examination process is usually completed within nine months from date of filing.

If the Registrar does not make objections or request amendments, the application proceeds to publication phase.

3 - PUBLICATION

Publication of a trademark application in the Trademark Gazette starts the clock of a 90 period during which third parties may oppose the trademark registration application by filing necessary documents with the Registrar.

If no opposition to the application is filed within the 90 day period, the Registrar proceeds with registration of the trademark.

If an opposition is filed, the trademark applicant must file a counterstatement, within 90 days of receipt of a copy of the opposition, with the Registrar to avoid cancellation of the trademark application.

After a counterstatement is filed, the Registrar will make a decision on whether the opposition is receivable and will inform the parties accordingly. Either party may appeal the Registrar's decision to the Trademark Board and, subsequently, the Intellectual Property Court.

4 - REGISTRATION

After the 90-day publication period has lapsed, or the applicant has overcome an opposition, a request to pay official fees for registration is issued by the Registrar. The applicant must settle official fees for registration within 30 days. A registered mark is protected in Thailand for ten years from date of filing (or date of filing of priority application) and may be renewed for successive periods of ten years.

5 - RENEWALS

A registered trademark must be renewed within ninety days before the expiration of the ten year period. Failure to renew the registration will cause the trademark to lapse. Substantial official fees for each product/service apply and must be settled when submitting the renewal application.

5) HOW CAN MY TRADEMARK APPLICATION BE CHALLENGED?

Trademark registration applications may be objected to by the Registrar, opposed by third parties or cancelled under specific conditions as detailed below.

OFFICE ACTIONS

The Registrar may issue one or several office actions. The Registrar may refuse the application for grounds of non-distinctiveness, identical/similar character to a well-known and/or registered mark, public morality or any other violation of the law. In such case the applicant may file an appeal before the Trademark Board to contest the decision of the Registrar. The applicant is further entitled to appeal the decision of the Trademark Board before the Intellectual Property Court.

The Registrar may also request that amendments be made to the trademark registration application. Such amendment requests may include specification of products/services, disclaimers, association of marks, definition of the mark, or additional evidence of use or well-known character. When possible, it is recommended that applicants comply with such amendments requests. However it is also possible to contest Registrar's amendment request, either directly or in front of the Trademark Board, depending on the situation.

The Registrar reviews amendments after they are filed, and if there are no other objections, will proceed with the publication of the trademark registration application.

OPPOSITION

The opposition procedure is available against pending trademark applications (i.e. trademark applications which have been published but not yet registered).

After the publication of a trademark application in the Trademark Gazette, objection to the application may be filed by a party claiming a better right to the trademark or by a party finding that the trademark is not in conformity with the Trademark Act provisions. Such objections must be filed with the Registrar within 90 days from the date of publication of the trademark application in the Trademark Gazette and must state the grounds of the opposition. If an opposition is filed, the Registrar must inform the applicant immediately. The applicant must file a counterstatement to the objection within ninety days of the date of receipt of a copy of the opposition.

The Registrar shall send a copy of the counterstatement to the opposing party immediately. The Registrar may order the opposing party or the applicant to give additional statements, written explanations or evidence.

The Registrar then gives written notification of his decision to the applicant and opposing party. The applicant or opposing party may appeal the decision of the Registrar to the Trademark Board within ninety days from the date of receipt of the notification. An appeal of the Trademark Board's decision may be filed with the Intellectual Property Court within ninety days of the Trademark Board's decision.

CANCELLATION

The Trademark Act provides for two distinct cancellation procedures after a trademark application has been accepted for registration: a cancellation action before the Trademark Board (in cases where requirements for registration were not met at time of filing or if a registered trademark has not been used) and a cancellation action before the Intellectual Property Court.

To commence a cancellation action before the Trademark Board, any interested person or the Registrar may petition the Trademark Board to order the cancellation of any trademark if it appears that at the time of registration the trademark:

- was not distinctive, or
- contained or consisted of a prohibitory characteristics, or
- was identical with a trademark registered by another person for goods of the same class or of different class with the same character, or
- was so similar to a trademark registered by another person that the public might be confused or misled as to the owner or origin of the goods in the same class, or goods of different class with the same character in its trademark, or
- the trademark was not used (see below).

In addition, any person who is of the opinion that any trademark is contrary to public order, good morality or to public policy may petition the Trademark Board to cancel the trademark registration.

The petitioner may appeal the decision of the Trademark Board to the Intellectual Property Court within ninety days of the Trademark Board's decision.

To commence a cancellation action before the Court, any interested person or the Registrar may petition the Court to cancel a registered trademark:

- within five years from the date of the Registrar's order to register a trademark by showing that the interested person has better rights to the trademark than the person registered as its owner, or
- by showing that, at the time of the cancellation petition, the trademark had become common to the trade for certain kinds or classes of goods, to the extent that to the trade or in the public eye the trademark had lost its meaning as a trademark.

6) DO I NEED TO USE MY MARK?

Thailand does not require evidence of trademark usage.

However, it is important to note that a trademark application becomes susceptible to cancellation for non-use if:

- it is proved that at the time of registration the owner of the trademark had no bona fide intention to use the trademark with the goods for which it was registered, or
- there was no bona fide use whatsoever of the trademark for such goods after the trademark was registered, or
- that during the three years prior to the petition for cancellation there was no bona fide use of the trademark for the goods for which it was registered

Cancellation of trademarks for non-use is extremely rare. Such cancellation petitions are usually dismissed if the trademark applicant can prove that such non-use was due to special circumstances in the trade and not to an intention not to use or to abandon the trademark for the goods for which it was registered.

In practice, it is also difficult to cancel a registered trademark based on non-use. The cancellation petitioner must prove that the trademark has not been used.

7) HOW DO I ENFORCE MY TRADEMARK RIGHTS?

Trademark infringement continues to grow in Thailand. The Kingdom has been on the United States Special 301 Watch List since 1994 and on the Priority Watch List since 2007.

In 1997, the Central Intellectual Property and International Trade Court (IPIT Court), a specialized court, was established to assist trademark owners who are victim of infringement. Today, the Court handles over 3,000 cases of trademark infringement per year.

Both unregistered trademarks and registered trademarks can be enforced in Thailand. However, registration accelerates the enforcement process and significantly reduces the costs for enforcement. Registration also improves the possibility of stopping infringement action.

UNREGISTERED MARK

The owner of an unregistered trademark can initiate both civil and criminal actions.

Civil actions are available pursuant to the Trademark Act and to the Civil and Commercial Code. The plaintiff can seek an injunction or try to recover damages against any person for passing off products as originating from the owner of the unregistered trademark.

Criminal enforcement is also available under the Penal Code. However, small fines for passing off products have little deterrent effect unless actual infringement and bad faith are clearly demonstrated.

REGISTERED MARK

The owner of a registered mark can initiate both administrative and judicial actions.

Administrative actions include opposition, cancellation, and alternative dispute resolution procedures through the Department of Intellectual Property.

The alternative dispute resolution procedure can be requested by either parties and consists of mediation between the infringer and the plaintiff. Although alternative dispute resolution is a cost-effective procedure, it is rarely used as plaintiffs usually prefer criminal enforcement.

Judicial actions include criminal and civil actions.

Criminal prosecution represents the majority of trademark infringement enforcement efforts in Thailand. It is a cost-effective, quick and efficient remedy.

Criminal actions are initiated with the filing of a criminal complaint with the police. The police can then petition the court for a search warrant. If a warrant is issued, a police raid is then carried out in order to collect evidence of the infringement and arrest the infringer(s).

There are several enforcement bodies in Thailand:

- the Department of Special Investigation, which was established in October 2002
- the Economic Crime Investigation Division, a specialized police unit widely used by trademark owners
- the Metropolitan Police Bureau
- the Provincial Police Bureau
- the Food and Drug Administration

Following the raid, the case is sent to the Public Prosecutor at the IPIT Court, which usually renders criminal case decisions within one year of the introduction of the case before the Court by the Public Prosecutor. IPIT Court decisions can be appealed to the Supreme Court.

The Trademark Act sets out maximum penalties for trademark infringement (up to four years' imprisonment and/or a fine not exceeding 400,000 THB). Maximum penalties for imitation of a trademark are up to two years' imprisonment and/or a fine of up to 200,000 THB.

Registered trademark owners may also commence a civil suit based on the provisions of the Civil and Commercial Code. However, civil actions for trademark infringement are rare in Thailand. It is extremely difficult, in most cases, to bring evidence of damages. Strategically, a civil action can be helpful for preliminary measures. For example, the registered trademark owner can petition the Court for an order to preserve relevant evidence in relation to the alleged infringement (Anton Pillar order) or for an injunction order.

BORDER MEASURES

Border measures may only be utilized against counterfeited trademark and pirated copyright products. It remains unclear whether the Customs Act provides protection for patent-infringing products. Trademark owners or their representative in Thailand can file a trademark notice with Customs to request that officers seize and prosecute infringers. They can also file a request to detain a suspected shipment. In cases of seizure, the trademark owner must confirm within 24 hours whether or not seized products are counterfeit.

Customs officers also perform ex officio customs actions regularly. Because there is no Customs trademark registry, it is important that trademark owners provide to the Customs with updated contact details of its representative in Thailand. Doing so aids in timely inspection the suspected counterfeit products.

Thai Customs will usually issue fines based on the market value of the infringing/trademarked goods.

Our attorneys can assist brand owners in establishing contact with and training Thai customs officers to help them recognizing counterfeit items.

Ananda Intellectual Property's personnel have solid experience in dealing with enforcement matters. Recent examples of enforcement actions can be found on our website www.ananda-ip.com.

8) HOW DO I AMEND MY APPLICATION?

In Thailand trademark applications are usually amended at the request of the Registrar, Trademark Board or following a court decision. In some circumstances the applicant may voluntarily make amendments to a trademark application.

For example, an applicant may decide to remove products or services from a trademark application, update contact details, change the trademark agent of record, add a meaning (translation) of its trademark, file associated trademark status with similar or identical marks in other classes or products and services.

An applicant may also assign or license its trademark application as described below.

9) HOW CAN I TRANSFER MY TRADEMARK RIGHTS?

ASSIGNMENT

A trademark application can be transferred to or inherited by other persons whether it is a registered or a pending application. The Trademark Act specifically requests assignments to be in writing and recorded with the Registrar. A deed of assignment specifically indicating which trademark applications shall be assigned, must be signed by the assignee and the assignor.

LICENSING

Registered trademarks can be licensed by means of a license agreement in writing and duly recorded with the Registrar.

It should be noted that rules governing trademark licensing are quite strict in Thailand. For example, licensing agreements must contain specific provisions such as quality control of products or services of the licensee by the licensor. In addition, a notarized power of attorney and the original of certificate of registration are required to prove the existence of the trademark application.

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ANANDA INTELLECTUAL PROPERTY LIMITED

153/3, 4th Floor, A-4 | Goldenland Building | Soi Mahardlekluang 1 | Rajdamri Road, Lumpini, Phatumwan
Bangkok 10330, Thailand | T: +66(0)2684 1145 | F: +66(0)2 684 5990 | E: aip@ananda-ip.com

www.ananda-ip.com