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3D PROTECTION IN THAILAND

Three-dimensional objects can be protected under Thailand's Trademark Act, but to date, few applications have been successful.

Three-dimensional objects are included in the definition of marks in Section 4 of the Trademark Act (1991), as amended by the Trademark Act (2000), which came into force on June 30, 2000. Since then, many applications for registration of three-dimensional objects have been filed with the Department of Intellectual Property (DIP). However, very few of these applications have actually been accepted for registration.

Three-dimensional trademarks

DIP's examination guidelines

The DIP adopted its examination guidelines for the registration of three-dimensional (3D) trademarks on May 13, 2002. According to the guidelines, a registrable 3D mark will be the shape or figure of a 'registrable mark' as specified in Section 7 of the Trademark Act—for example, a name or surname of an individual whose meaning is not ordinarily understood and that has no direct reference to the character and quality of the goods; words or clauses that have no direct reference to the character or quality of the goods and are not a geographical name; and groups of colours, signatures, photographs or invented pictures.

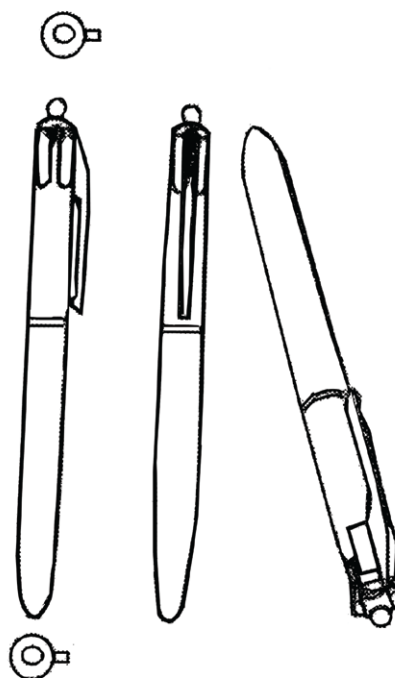
According to the regulation, the following are not acceptable for registration:

- 3D marks that are shapes or figures of the goods or services being sought for registration or that are related to the goods or services covered by the application
- 3D marks that are not the shape or figure of goods, even though such marks have been designed or decorated, if the goods or services applied for registration are still visible or if the shape may be perceived as related to the goods or services.

A key concern regarding the registration of 3D marks is that applicants would seek to protect the shapes, objects or containers of the goods or services for which protection is being sought. The DIP's current guidelines have been drafted so that such 3D marks are unlikely to be registrable in Thailand.

Below are examples of three-dimensional marks for which applications have been filed in Thailand.

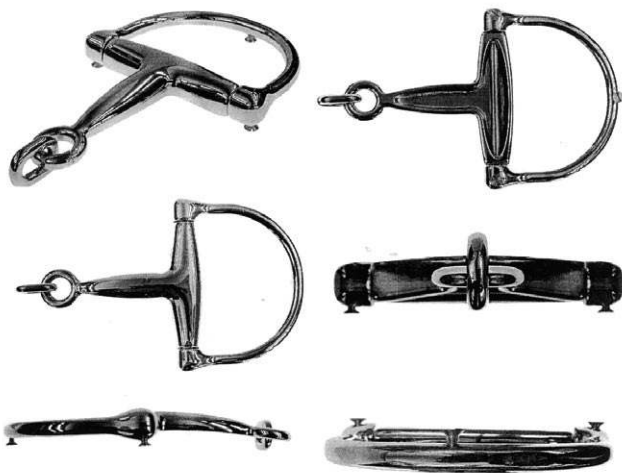
3D mark rejected for registration:





THAILAND

3D mark accepted for registration:



Supreme Court judgment

The Supreme Court allowed the marks 'Coca-Cola Bottle' and 'Green Dimple Bottle' to be registered as two-dimensional marks as they appear in the application form, rather than as three-dimensional marks. The Supreme Court considered the invented pictures comprising the two marks to be distinctive enough for registration as trademarks. The court also supported the distinctiveness of the bottle devices through its reasoning that the bottles were uniquely designed. It found that there were convex and concave parts, and concave spots around the bottles that made them distinguishable from other bottles. In addition, the applicant sells the drinks contained in the bottles but does not sell the bottle separately as a container. The bottles have therefore functioned as a trademark to distinguish the applicant's product from other persons' products.

This judgment raised an important question: if the applicant sought to register the Coca-Cola Bottle and Green Dimple Bottle in the form of three-dimensional pictures, would the three-dimensional objects be allowed to be registered? The answer to this question is uncertain because the three-dimensional objects are the shape or three-dimensional object of the invented picture as described in the DIP's guideline.

Other alternatives

Design patent

A design patent is another form of protection for a shape or three-dimensional object in Thailand. Design patents are protected under the Thai

Patent Act (1979), Thai Patent Act No. 2 (1992) and Thai Patent Act No. 3 (1999), which cover both inventions and product designs. A shape or three-dimensional object may be granted under this act if the designs are new and have not been disclosed anywhere prior to the date of filing.

Below are three-dimensional objects that are registered as design patents:



Copyright

Copyrights are protected and governed by the Copyright Act (1994), Ministerial Regulations (1997), the Convention Governing Protection of Copyrights and the Convention Governing Protection of Performers' Rights.

Protection under the Copyright Act lasts longer than protection under the Patent Act. In general, a copyright exists for the life of the author plus an additional period of 50 years after their death. If the author is a juristic person, the copyright exists for a period of 50 years after the work is first published or, if unpublished, after its creation.

There is no requirement for copyright to be registered with any authority. However, one can file an application with the Department of Intellectual Property for copyright recordation. A current, notarised power of attorney and one original or copy of the copyrighted work must accompany the application form, which must be completed in the Thai language.

A record of copyright does not conclusively prove ownership or priority, but it may be used as one piece of evidence in court among other evidence (e.g. affidavit stating history of creation, registration [if any], transfer or assignment of right, etc.). It is important to note that a copyright notice should also be shown or attached to the copyrighted work.

Three-dimensional objects might be deemed 'works of applied art', which are defined in Section 4 of the Copyright Act as "compositions of any one or more of the works under (1) to (6) used for other purposes apart from



THAILAND

“ONCE THE UNIQUE DESIGN OF THE SHAPE OF A PRODUCT HAS BEEN CREATED, THE DESIGN SHOULD IMMEDIATELY BE PROTECTED”

the appreciation of the inherent value thereof, such as that used for utility, decorating material or equipment, or for commercial purposes”.

The works under subsections (1) to (6) of Section 4 are: “(1) Works of painting and drawing, (2) Sculptural works, (3) Lithographic works, (4) Architectural works, (5) Photographic works, and (6) Illustrations, maps, structures, sketches... relating to geography, topography, or science.”

Supreme Court judgment

The Supreme Court has supported the protection of three-dimensional objects as ‘works of applied art’ under the Copyright Act. In a 1994 decision, the court considered that the design of a pen was a creative work that was created by building a mould of the shape of the pen drawn by lines. This was protected as a sculptural work under applied art, being an example of “solid representations of tangible objects”.

However, the Central Intellectual Property and International Trade Court (IP&IT Court) rendered the opposite opinion in 2007 regarding the shape of a pen, finding that the shape of a Reynolds pen cannot be protected as a work of applied art even though the process of designing the product might be covered as a sculptural work under applied art. However, the shape of the Reynolds pen was protected as a design patent. The court felt it prudent to comply with the legal notion that the laws providing protection should not overlap.

In a 2009 Supreme Court decision involving similar issues, the court did not allow protection of the shape of the Maggie sauce bottle because its owner

could not prove that the 3D Maggie bottle had been used as a trademark. In addition, the brand owner did not take legal action against other sauces that used the same bottle design, and the Maggie bottle design had lost its distinctiveness and become generic.

Recommendation

It is recommended that once the unique design of the shape of a product has been created, the design should immediately be protected as a patent design. The patent design has a protection term of 10 years. Before the end of the 10-year protection, the owner of the design should seek protection as a 3D mark. The owner of the design should strictly enforce its right under the Patent Act to prevent the design from becoming generic.

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