

REGISTRATION AND PROTECTION OF WORD MARKS IN THAILAND

Companies place a great deal of focus on creating and developing their brands. As part of the process, however, companies must not lose sight of the importance of ensuring that a newly created trademark will be registrable with the government. The rejection of a trademark means not only wasting the money that has already been invested in building the brand but also losing business opportunity and competitive advantage.

In Thailand, the registration of a brand falls under the authority of the Department of Intellectual Property, a Commerce Ministry agency. Section 7 of the Trademark Act stipulates a fundamental condition for trademark registration. It holds that a distinctive trademark must allow the public or consumers to understand that the goods bearing the mark are different from the goods of other parties (known as "inherent distinctiveness"). The second paragraph of this provision lists a number of essential elements that constitute distinctiveness. For word marks, the trademark must not directly refer to the character or quality of the goods.

Unfortunately, this regulation often



comes into conflict with a company's desire to create a trademark that can be easily associated with its products. Examples might include the trademark Best Foods with food and beverages, Craftwood with construction instruments, or WrestleMania with wrestling broadcasting services.

There is a risk that these trademark applications will be rejected by the Registrar and the Board of Trademarks on the basis that they directly refer to the character or quality of the goods. Regardless of whether they agree with the rejection, many applicants simply decide to abandon their applications and invent new trademarks that are more likely to be registered. This is often a practical decision in order to avoid the difficulties and investment necessary in seeking judicial review by filing a civil

suit with the court.

Abandoning the mark, however, may not be a viable option for companies that have already invested significant resources in marketing their brand and developing recognition among consumers. The third paragraph of Section 7 provides a resolution in this circumstance. Under this paragraph, a mark that would normally be viewed as non-distinctive (and thus unregistrable) can nevertheless be deemed distinctive if it has been widely distributed or extensively used in Thailand. Through this wide distribution and use, the mark develops a secondary meaning; that is, consumers are able to recognise it as a trademark even though it is not inherently distinctive.

According to a 2003 Commerce Ministry notification, the following evidence can be presented to the authorities: receipts for goods or services, receipts for advertising fees, delivery notes, purchase orders, licence to set up a factory, advertisements published in various media, samples of goods, or other evidence or witness statements.

There is no limitation in presenting the documents to the Court as long as

the documents can prove that the trademark has been widely distributed or extensively used. Also, there is no set period of time that will prove that the mark has acquired secondary meaning. Instead, it depends more on the company's strategies to advertise or promote the trademark with products in the Thai market until brand awareness or consumer recognition is created among the public.

In Supreme Court Case No. 3685/2551 (Hewlett-Packard Company vs The Department of Intellectual Property), the plaintiff submitted several reference books, including dictionaries that recognised and provided the definition of the trademark in dispute. The dictionaries defined that such mark was a trademark used by the plaintiff with the products covered by the application. In IP&IT Court Case No. Red IP 46/2548 (World Wrestling Entertainment Inc vs The Department of Intellectual Property), the plaintiff submitted several advertising materials, news articles, websites, online forums, and magazines providing information on its products and services bearing the disputed trademark. Although most of the evidence was

initiated by members of the plaintiff's fan club, the court accepted its validity and ruled that the plaintiff's trademark had achieved secondary meaning through wide use. The mark was therefore registrable in accordance with Section 7, paragraph 3.

What can be done if there is little or no use of a word mark in Thailand? When a little-used mark is rejected due to lack of distinctiveness, it is unlikely to achieve registration based on the above provision. The alternative option is that the company should use the mark with the specific goods in Thailand for an extended period of time until it becomes well-recognised by the Thai public. An application can then be filed to register the word mark alongside the essential set of evidence of use demonstrating that the mark has become distinctive through long use and valued reputation, thus acquiring secondary meaning and allowing it to function as a trademark.

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