

Making proper use of marks

Many clients have inquired whether the markings or ® or ™ should be included on the labels or packaging of goods. Is there any merit to adding those markings? What do they stand for? Are they recognised around the globe? Can they be included on all of the packages regardless of the destination? And what are the legal implications?

These kinds of questions are raised in many businesses, which can cause confusion about the proper use of trademarks after significant efforts have been expended over many years to register the marks.

It should first be noted that the ® is a symbol representing Registered status of the mark, whereas the ™ sign is an abbreviated form of Trademark. From a legal point of view, the practices of using these legends vary depending on each jurisdiction due to the differences in domestic trademark law. In some countries, the trademarks are protected at common law without the use of these markings, but in countries such as the United States, if a trademark owner fails to use the proper markings for their trademarks, their ability to obtain damages can be adversely affected.

It is also notable that the ® or ™ signs might have local variations depending on the countries in which a business operates. For example, in Mexico, the wording *Marca Registrada* or *M.R.* should be used with all the packaging and labels to indicate that the mark is registered and also to avoid hindrance in taking legal action against infringers. Thus, it is helpful to include the marking since it will clearly stake a strong claim to the trademark rights.

In Thai trademark law, unlike patent law, there is no definite provision stipulating the proper use of the markings. The most relevant provision on this matter lies in Section 111 of Thai Trademark Act, which reads as follows: "Whoever:

1. represents as registered in the Kingdom a trademark, service mark, certification mark or collective mark that is not registered,
 2. knowingly sells or possesses for sale products bearing such a false representation of a trademark, certification mark or collective mark as stated in (1), or
 3. knowingly provides services or offers to provide the same by such a false representation of a service mark, certification mark or collective mark as stated in (1),
- shall be punishable by imprisonment

not exceeding one year or a fine not exceeding 20,000 baht, or both."

Based on this provision, anybody who misrepresents the status of their trademark as a registered trademark, when in fact it is not, or sells and provides goods or services bearing such misrepresentation, will be subject to imprisonment or fine or both. In practice, the way one can misrepresent the status of their marks is mostly through the use of the marking. As such, the most important general precaution is not to use the ® sign on a product when its trademark has not yet been registered with the competent authority, i.e. the Department of Intellectual Property.

Instead, the ™ symbol should be used with unregistered marks. This symbol is normally placed on the upper right-hand corner of the trademark to indicate that this particular wording or logo is actually a trademark, and not just a generic term, for instance, *Toyota™*. When the marking is to be used with services, the proper marking to use is SM which is short for Service Mark.

Using ™ or ® will also protect a trademark from becoming a generic term, which would dilute the function and value of the trademark, and in the worst case, the registered mark might even be withdrawn from the Registry for being diluted.

These markings not only provide benefits in terms of legal effects, but also serve as a warning to the potential infringers of a trademark to think twice before illegally violating legitimate trademark rights.

To ensure these benefits, it is important to update these trademark legends as soon as the status of a trademark changes in each country. Although this will incur certain short-term additional costs to customise packaging to each market's trademark status, the return will be high, as it will serve to protect against the possible loss from infringement and avoid incurring undue damages.

To sum up, the markings ® or ™ are useful tools that can be employed to protect and strengthen trademark rights, but their usage must be tailored to the requirements of individual jurisdictions. As with most business decisions, the bottom line is to use these markings in the right way and when the time is right.

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