

## THAILAND

**Disclaimed Elements: Questions Regarding the Essence of a Trademark in Thailand**

A mark that is sufficiently distinctive to be registered as a trademark may consist of plain letters, numerals, descriptive words, and/or devices. According to the Thai Trademark Act 1991, as amended by the Trademark Act 2000, a disclaimer will be required for such non-stylized letters, numerals, and/or descriptive parts. Based on the current practice, it seems that the Registrar and

**Trademark applicants must be aware of whether their mark consists of non-stylized letters, numerals, or descriptive parts, as it is possible that the Registrar may require a disclaimer of such parts and cite the mark to be in conflict with a prior mark, even if the overall appearance and pronunciation of the two trademarks is different.**

the Board of Trademarks always raise such disclaimers as reasons in accepting or rejecting the registration of marks cited to be in conflict with a prior mark. A key feature of the Board's decisions is its consideration of whether such disclaimed part is or is not the essence of the mark.

According to Section 17 of the Trademark Act, if, in the opinion of the Registrar, a trademark as a whole is registrable but contains a part or parts common to trade in respect of certain kinds or classes of goods, the ownership of which the applicant is not solely entitled to, or is not distinctive, the Registrar shall proceed with either: (1) instructing the applicant to disclaim the right to exclusive use of such part of the trademark within 90 days after receiving the instructions; or (2) instructing the applicant to make such other disclaimers as the Registrar may consider necessary for determining the right of the trademark proprietor within 90 days after receiving the instructions. Although the purpose of this section is to limit the exclusive right of the applicant from using a disclaimed part that is common to trade, or is not distinctive,

the Registrar and the Board always use the disclaimer in determining the issue of citation.

**Ginzadiana v. Diana Jewel**

Many applications have been rejected on the basis that the disclaimed part is not the essence of the mark. For example, the trademark GINZADIANA, Appl. No. 619790, was cited to be in conflict with the trademark DIANA JEWEL & Device, Reg. No. 195108, and the Board affirmed the Registrar's citation by stating that the words "GINZA" and "JEWEL" were not the essence of each mark because they were disclaimed.

Therefore, the essences of the two marks were the same word, "DIANA," which may cause confusion among the public as to the proprietor or the origin of the goods. This decision is very peculiar because the overall appearance and pronunciation of the two trademarks is absolutely different, and it is impossible that the public will recognize the two trademarks as both being "DIANA" even if the words "GINZA" and "JEWEL" were disclaimed.

**Para-G v. Para 555 and Para Plus**

Contrary to the above case, the trademark PARA-G, Appl. No. 577150, was accepted for registration after the Registrar initially cited it to be in conflict with the prior marks PARA 555 (in English & Thai), Reg. No. TM51343, and PARA PLUS, Reg. No. 121400. Although the numerals "555" and "PLUS" of the mark PARA 555 (in English & Thai) and PARA PLUS were disclaimed, the Board considered that the disclaimed elements were the essence of these marks. Eventually, the Board overturned the Registrar's citation by reasoning that the overall appearance and pronunciation of the mark PARA-G was different from the prior marks PARA 555 (in English & Thai) and PARA PLUS and would not cause confusion among the public as to the proprietor or the origin of the goods.

**Advice for Applicants**

Based on the inconsistent practice detailed above, it seems that the disclaimed element may or may not be deemed the essence of the mark. In this instance, trademark applicants must be aware of whether their mark



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consists of non-stylized letters, numerals, or descriptive parts, as it is possible that the Registrar may require a disclaimer of such parts and cite the mark to be in conflict with a prior mark, even if the overall appearance and pronunciation of the two trademarks is different. Moreover, the Board may have the same view about the disclaimer as the Registrar and affirm the Registrar's citation.

To avoid the possibility of citation based on the grounds that the disclaimed element is not the essence of the mark, the applicant should: (1) use distinctive words or devices in the main part of the mark; (2) present numerals or letters in the mark in stylized form in order to avoid the possibility of a disclaimer requirement from the Registrar; and (3) conduct a trademark search to determine whether any identical or confusingly marks have been registered. Alternatively, the applicant may file an application for the mark as usual. If the Registrar cites the applicant's mark to be in conflict with a prior mark based on the ground that the disclaimed element is not the essence of the mark and the Board affirms the citation, the applicant may then appeal to the IP&IT Court. The chances of successfully appealing with the Court are generally better than with the Board, as the Court has a broader view when considering distinctiveness or similarity of a mark.

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