

THAILAND

Criteria in Determining Well-Known Trademarks in Thailand

Thailand is one of the few countries where registration (or recordation, to be precise) of a well-known trademark is available at the Department of Intellectual Property (DIP) under its Regulation Regarding Well-Known Marks B.E. 2548 (2005). In most countries, a trademark owner needs to prove the well-known status of its trademark through adversarial proceedings, such as opposition or litigation in court, which often involve great effort and expense and uncertain results that are dependent on the discretion of the examining authority.

Amassing the requisite evidence is an important first step in preparing an application for a well-known mark.

The introduction of well-known mark recordation in Thailand by the DIP should theoretically lessen this difficulty by having a unified well-known mark certification, which can be cited at all levels of legal proceedings. This will also avoid the possibility of repetitious burden of proof and inconsistent decisions as to the well-known status between various judicial bodies.

Applications for well-known marks will be thoroughly examined by the Board of Well-Known Marks, chaired by the Director of the Trademark Office and composed of Thai Trademark Registrars from all classes of goods and services. When assessing well-known mark applications, the Board of Well-Known Marks requires that marks comply with certain criteria. In particular, evidence addressing the following aspects will carry the most weight in convincing the Board to accept the recordation:

- **Level of Awareness and Acceptance of the General Consumer and Relevant Trade:** On this basis, the Board will consider evidence such as sales volume, extensiveness of goods and services, rankings by prestigious institutions, etc.

- **Level of Inherent Distinctiveness and Distinctiveness Through Use:** The Board is likely to examine the nature of the applied mark, assessing whether it is an invented word or

a generic term as well as examining evidence of the extensiveness of use, focusing mainly on Thailand.

- **Longevity, Extensiveness, and Area of Trademark Registrations:** On this basis, the more registrations on a worldwide basis and the longer the period of registration, the better the chance that the applied mark will be successfully recorded as well known.

In addition to this key evidence, the Board will also consider relevant supplementary evidence as set out below:

- **Longevity, Extensiveness, and Area of Advertising and Public Relations:** The applicant should submit as much publication and advertising material as possible both domestically and globally. The most advisable form of this material would be news clippings, including material printed from the internet.

- **Longevity, Extensiveness, and Area of Marketing:** The Board will consider evidence like declarations of expenses for marketing, television and radio ads, or public surveys.

- **Longevity, Extensiveness, and Area of Other Types of Use of the Mark:** Other evidence that is not included in the above criteria will be considered on this basis, which may include proof such as a distributor's affidavit and annual reports.

- **Other Evidence:** Other admissible evidence may include (1) successful history in enforcing the rights to the trademark, especially proof that the mark has previously been accepted as a well-known mark by other authorities or organizations; (2) value of the mark; (3) measures in preserving the well-known status of the mark; and (4) survey by a reputable organization of the trademark's goodwill among consumers.

To fulfil the "Other Evidence" criterion, the applicant may submit evidence related to oppositions, cancellations against a third party's confusingly similar trademarks, copies of licensing agreements to prove the value of the mark, or goodwill surveys.

If a majority of Board members concur that the applied mark substantially meets the above criteria, then a Certificate of Recordation of Well-Known Mark will be issued.

Clearly, amassing the requisite evidence is an important first step in preparing an application for a well-known mark. Applicants would therefore be



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well advised to avoid rushing to apply for well-known mark recordation. Instead, they should take time to methodically gather all of the relevant evidence to prove the well-known status as described above.

Once this evidence has been collected, applicants often find success with presenting the evidence in the form of an affidavit detailing the highlighted facts. This approach is useful both to ease the burden of preparing the evidence and to best facilitate the examination.

By following this roadmap, applicants for potential well-known marks will be in a position to fulfil the examination criteria and successfully record their well-known marks in Thailand, which is a significant tool to broaden and enhance trademark protection.

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