

## THAILAND

**Considerations for Proving Secondary Meaning of a Nondistinctive Mark**

Among the criteria for trademark registration in Thailand, the issue of “distinctiveness” can often present a hurdle for applicants. If the Registrar finds that an applied-for mark lacks distinctiveness on absolute grounds, the applicant will be asked to submit evidence of use of the mark to prove that it has acquired distinctiveness through use. If the evidence fails to convince the Registrar that it has acquired distinctiveness, the application will be rejected and the applicant may then file an appeal with the Board of Trademarks and at the Courts, respectively. The appeal can be based on the inherent distinctiveness of the mark and/or on the acquired distinctiveness issue. Two recent Supreme Court decisions, as explored below, offer guidance in how the Thai authorities perceive distinctiveness on an inherent and acquired basis.

**JobsDB Case**

Supreme Court Decision 5403/2551 considered the denial of registration of the trademark JobsDB under International Class 35 (for consultation services relating to business management, recruitment, and the like). This mark was initially rejected because the term “Jobs” was found descriptive of the applied services in Class 35, whereas “DB” was insufficiently stylized. While this particular decision saw the Registrars, the Board of Trademarks, and the Courts interpreting the concept of “distinctiveness” in the same way, there have been several cases in which the Courts have overturned the rejection of the Board of Trademarks.

In order to overcome the rejection, the applicant argued for inherent distinctiveness in that JobsDB was a coined word. The term “Jobs” and the letters “DB” were arbitrarily put together without meaning, and the term was grammatically incorrect. However, the Court stated that even though the term “Jobs” and “DB” had been put next to one another, the mark would still be pronounced as “Jobs-DB”, which is not sufficiently inventive for the applicant to be given exclusive rights to the term.

Together with the arguments, the applicant submitted evidence of use of the mark JobsDB to prove that the

mark was not only distinctive on absolute grounds, but also had acquired distinctiveness through extensive use in Thailand. However, the Court viewed that the evidence submitted was insufficient to prove distinctiveness through use as it focused mainly on advertisements and publications of the mark in the years 1999 and 2000. Although the evidence did show that the mark had been used for more than two years (the minimum length of use to be considered widespread according to the Registrars), the evidence submitted did not show that the advertisements and publications were made continuously during that two-year period nor afterwards. Therefore, it was concluded that the mark JobsDB lacked distinctiveness and was unregistrable.

As this decision shows, to prove acquired distinctiveness, the applicant must submit evidence of use of the mark to show that the mark has been used in Thailand for a long time, and such evidence must comprise advertisements and publications in different media published on several occasions. Most importantly, the advertisements and publications must be made consistently throughout the long period of use. The Courts mentioned that the minimum period of use should be two years. However, applicants should always submit evidence showing the use of their marks for a period of five years or more in order to increase the chances of success in proving distinctiveness.

**MAGGI Case**

In a related case, Supreme Court Decision 2044/2552, the applicant tried to register the device mark as shown below in Classes 29 and 30.

While the Registrar and the Board of Trademarks held that this mark was a nondistinctive geometric symbol, the Supreme Court decided it is not a geometric symbol per se, but is an oval shape lacking a marked difference from general geometric symbols. Hence, the mark is not distinctive on absolute grounds.



Unlike the JobsDB case, the applicant in this case had submitted sub-



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stantive evidence to prove that the mark had been consistently used and advertised for more than 50 years on a global basis. However, the evidence showed that the device had normally been used with the term MAGGI in the center, and thus the device itself was not distinctive through use on its own. The lesson learned from the case is that evidence submitted must show the mark used in the exact same manner that has been applied for registration; otherwise, the Courts may be reluctant to grant monopoly rights to the mark even if the evidence submitted makes it obvious that a variation of the mark has been used for a very long time.

As distinctiveness is essential for any trademark to be accepted for registration, applicants should refer to the above Court decisions and try to submit a large volume of evidence showing long-term, consistent use of the mark. When making the submission, applicants must ensure that, in supporting the argument that a mark has acquired distinctiveness through use, their evidence shows use of the mark in the exact same style as applied for registration. Failure to comply with these criteria may result in rejection of the trademark application in Thailand.

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