



# Thailand: *IP Developments*

## RECORDATION OF WELL-KNOWN MARKS IN THAILAND

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The following are examples of well-known marks, both Thai and foreign, that have been successfully recorded with the Department of Intellectual Property (DIP).



The current Thai Trademark Act 2000 provides protection of well-known marks under Section 8 (10). This section prescribes the registration of a mark that is confusingly similar to a well-known mark, regardless of whether or not that well-known mark has been registered in Thailand. The application of this section, however, is limited to the registration process. When a similar mark has already been registered, the owner of a well-known mark must rely on Section 61 of the Act, which allows a petition to be filed with the Board of Trademarks to cancel the registration of a similar mark.

Based on precedent cases, if the owner of a well-known mark does not record the mark's well-known status in Thailand, it is quite difficult to cancel a registered mark which is similar to such well-known mark. This is because the owner of the (unregistered) well-known mark is required to submit substantial evidence of use to prove to the Board that

its mark is well known. If the owner of the well-known mark fails to prove the well-known status of the mark to the Board, or if the Board considers that the evidence submitted to prove the well-known status of the mark is not sufficient, the Board will not cancel the registered mark.

### Recordation of Well-Known Marks

On July 19, 2005, the Department of Intellectual Property (DIP) issued a regulation governing recordation of well-known marks, and from August 1, 2005 it started accepting applications for recordation of well-known marks.

Eligibility for recordation as a well-known mark is extended to trademarks, service marks, certification marks, and collective marks, regardless of whether or not registration for the mark has already been obtained in Thailand. The mark must have been used, distributed, and advertised for a long continuous period of time up to the date the application is filed, to the extent that it has become highly

accepted among customers in Thailand. Use of the mark either by the owner of the mark or by its or authorized representatives or licensees, either in Thailand or abroad, is accepted.

As of April 2008, more than 180 applications have been filed for well-known mark recordation. Among these, 52% of the applications were for Thai marks and 48% were for foreign marks. The success rate of these applications is approximately 35%, which emphasizes the strict criteria used in evaluating the well-known status of a mark.

### Affidavit

In response to these rather stringent requirements for recordation, Tilleke & Gibbins has prepared a form of affidavit to facilitate the owner of the well-known mark to formulate the information and evidence required by the DIP.

The affidavit will cover the following:

- History, background, and popularity of the owner of the mark.
- History and background of the mark.
- Worldwide distribution of products bearing the mark.
- Distribution of products bearing the mark in Thailand.
- Worldwide advertisement and promotion of products bearing the mark.
- Advertisement and promotion of products bearing the mark in Thailand.
- Consumer recognition of the mark.
- Value of the mark.
- Maintenance of quality of the goods bearing the mark.
- Achievement in right protection or enforcement of the mark and actions against infringement of the mark.

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Clearly, a great deal of information and documents are required for submission along with the application for well-known mark. This is a time-consuming process. It is important that the trademark owner prepare the affidavit and supporting documents before filing the application. Otherwise, it may not be possible to collect sufficient supporting evidence by the required deadline for submission, which is 60 days from the filing date. This might result in dismissal of the application because of insufficient supporting evidence.

### **Recordation Process**

The Board of Well-Known Marks is the responsible body for the recordation of well-known marks. This Board consists of ten Trademark Registrars, and the Director of the Trademark Office acts as its Chairman.

In considering the possibility of recordation, the Board will examine the application and supporting evidence. If the Board considers that the supporting evidence is insufficient to prove that the applied mark is well known, as required by the regulation, the Board will reject the application. The applicant will then be entitled to file an appeal petition to the Director General of the DIP within 60 days. If an unfavorable decision is

rendered by the Director General, the application will be deemed abandoned.

If, on the other hand, the Board considers that the applied mark has successfully been proven to be well known among Thai consumers, the applied mark will be recorded as a well-known mark.

There is no government fee for filing the application. It will take about 6 months to complete the recordation of the well-known mark.

### **Benefits of Recordation**

There are two primary benefits resulting from the recordation of well-known marks. First, the Registrar will rely upon the Register of Well-Known Marks when considering new trademark applications. This should ensure that the Registrar will not allow the publication of marks that are confusingly similar to a well-known mark in any class. Second, the owner of a recorded well-known mark does not need to prove that the mark is a well-known mark when the mark is:

- Used as the basis of a cancellation action according to Section 61 of the Trademark Act 2000;
- Used as a reference in an opposition filed against a third party's mark;
- Used as a reference to support an appeal petition to the Board of Trademarks against the Registrar's refusal decision in relation to (a) non-distinctiveness of similar

marks owned by the same owner or (b) similarity to another owner's registered mark.

In other words, well-known trademark recordation provides irrefutable evidence of the fame of the mark, which can provide an extremely valuable basis for a large number of actions that prevent the dilution of a mark.

In sum, the recordation system that was created in 2005 has led to a significantly improved process for establishing the well-known status of a mark. This presents numerous benefits for the owner of a well-known mark, as the recordation with the Board of Well-Known Marks can be relied upon in defending and expanding a famous brand. The key to successfully pursuing this type of recordation is the trademark owner's ability to present significant evidence demonstrating the fame of the mark. To this end, Tilleke & Gibbins has carefully crafted a specific affidavit that is tailored to the requirements and expectations of the Board of Well-Known Marks. This affidavit, accompanied by the requisite supporting evidence, has proven to be very successful in ensuring a smooth recordation process. Clients who wish to obtain the suggested form of the affidavit may contact Darani Vachanavuttivong at [darani.v@tillekeandgibbins.com](mailto:darani.v@tillekeandgibbins.com). ♦