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Cancellation of a registered trade mark by a registrar

In Thailand, registrars seeking to solve the problem of a mistakenly registered trade mark may call upon the solution in section 61 of the Thai Trade Mark Act, which permits the Board of Trade Marks to re-examine such marks. Based on this section, the Board conducts re-examinations on distinctiveness, dissimilarity, and morality grounds only when an authorised person, limited to either an interested person or a registrar, files a cancellation petition to the Board citing section 61. In the view of many registrars, section 61 provides a means of effectively revisiting decisions; nevertheless, the registrars, having already given their approval, rarely seek to use this solution. Recently, however, the Board rendered a decision in favour of the registrar's use of section 61 by withdrawing a registered trade mark which had been registered for more than five years.

In 2008, a registrar filed a cancellation petition with the Board to withdraw the registration of the trade mark Sencan App/Reg number 524647/TM200267 (the junior trade mark) because this trade mark was similar to the prior registered trade mark Sencan and device App/Reg number 505820/TM191211 (the senior trade mark). The registrant of the junior trade mark, Yongkang Xinyuan Electric Tools Manufacture Co, Ltd, then filed an explanatory letter with the Board in reply to the cancellation petition.

In its decision, the Board ruled that during the examination period, the senior trade mark had not been cited. The fact of similarity between the junior trade mark and the senior trade mark became known only after the junior trade mark was registered. Once this fact was known, the registrar was then entitled by section 61 (4) of the Thai Trade Mark Act to file a petition to cancel the junior trade mark, despite its registration. Apart from above issue, the Board also stated that the junior trade mark was similar to the senior trade mark in appearance, pronunciation and the list of covered goods. Consequently, the Board rendered the decision in favour of the registrar by ordering the registrar to withdraw the registration of the junior trademark.

According to the solution in section 61 of the Thai Trade Mark Act as exemplified by this decision, one may conclude that the registrars themselves do not have the authority to withdraw a registered trade mark, but are limited to filing cancellation petitions to the Board. This process gives registrants the opportunity to defend against the cancellation in an explanatory letter.



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