

## NOVEMBER 2009 Thailand: Court rules on rejected trade marks

01 Nov 2009

---

Under Section 18 of the Thai Trade Mark Act, applicants are entitled to appeal to the Board of Trade Marks when the Trade Mark Registrar initially finds their mark unregistrable, and the decision of the Board shall be deemed final. However, many trade mark owners file a complaint appealing the Board's decision with the Central Intellectual Property and International Trade Court (IP&IT Court), and later file an appeal with the Supreme Court if the IP&IT Court rules against them.

Several Supreme Court judgments have confirmed that the Board's decision to uphold the Registrar's rejection is final only if the decision is correct and lawful. Therefore, a trade mark owner who believes that the Board of Trade Marks' decision does not meet the above criteria has the right to litigate. The Supreme Court has further confirmed that there is no specific deadline for bringing the case to court.

However, when the Board of Trade Marks renders its decision to affirm the Registrar's rejection, the practice of the Department of Intellectual Property (DIP) is to dismiss the rejected application from its records, even if the trade mark owner has duly informed the DIP that it is pursuing litigation. But if the Supreme Court reverses the Board's decision, the application will proceed to registration. This raises important questions: What if a trade mark application is filed by a third party for the same or similar marks during the litigation process? Should such an application be rejected due to a conflict with the mark which has been dismissed by the DIP, but which remains pending in the court procedure?

The IP&IT Court Case no 47/2552, announced in mid-2009, illustrates this predicament. In this case, the Board originally asserted that a rejected mark does not exist in a manner that bars later applications for the same or similar marks. In reversing this decision, the IP&IT Court held that if a mark has been rejected by the Registrar and the Board of Trade Marks but a complaint against the Board's decision has been filed, the application still exists and may be an obstacle for subsequent trade mark applications for similar or identical marks. Therefore, a confusingly similar mark filed while the court action is ongoing cannot be automatically registered as if such application never existed. If the Supreme Court upholds this IP&IT Court decision, this may bring to an end the DIP's practice of using Section 18 to deprive marks of their existence during ongoing legal action.



*Parichart Monaiyakul and  
Nuttaphol Arammuang*

### **Tilleke & Gibbins International Ltd**

Supalai Grand Tower, 26th Floor  
1011 Rama 3 Road, Chongnonsi, Yannawa  
Bangkok 10120  
Thailand  
Tel: +66 2653 5555  
Fax: +66 2653 5678  
[bangkok@tillekeandgibbins.com](mailto:bangkok@tillekeandgibbins.com)  
[www.tillekeandgibbins.com](http://www.tillekeandgibbins.com)