

World Trademark Review Daily

Proposed amendments could make it easier to obtain 3D protection
Thailand - Tilleke & Gibbins International Ltd

National procedures

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The Council of State of the Thai Government is currently reviewing draft amendments to the [Trademark Act](#). There are several proposals on the table, including:

- the allowance of multiple class applications;
- the abolition of the 'association' requirement for identical/similar marks owned by the same company;
- the inclusion of "smell and sound" in the definition of a 'trademark'; and
- the introduction of a grace period for renewal applications.

However, perhaps of most note is the amendment of 'distinctiveness' under Section 7(2) of the act to include three-dimensional (3D) objects which are not the natural shapes of the goods applied for, are not functionally necessary and whose shape does not add value to the goods.

Historically, it has been difficult to obtain 3D protection because a 3D shape is seen as descriptive of the goods applied for (eg, a perfume bottle shape is not distinctive if it is too closely related to the goods). In 2009 the Supreme Court decided to allow only two-dimensional protection to the Coca-Cola bottle for similar reasons. The question is now whether the proposed amendment, if approved by the Council of State, will make any difference to the Trademark Office's approach to 3D registrability.

What we can expect is an initially cautious approach, certainly until the Intellectual Property and International Trade Court or the Supreme Court has given a ruling that the Trademark Office can follow. The Trademark Office will need guidelines as to what the courts consider to be "not the natural shapes of the goods", "not functionally necessary" and "adding value to the goods".

"Natural shape" would appear to cover situations where the shape merely represents a generic shape for the goods themselves, such as naturally occurring things (eg, fruit and vegetables) and well-established shapes (eg, a bar of chocolate or even a mobile phone). The phrase "functionally necessary" would rule out 3D features that add nothing more than a mere practical purpose. In this instance, the law is getting close to design or copyright law (which may still be viable alternative areas of protection).

It is difficult to predict how the Trademark Office will assess the phrase "adding value to the goods". Value is an essentially quantitative measurement. However, in this instance, it may be construed as allowing for distinctiveness acquired through use by increasing the goodwill associated with those goods. The link between use and increase in value must surely be presumed, unless glaringly to the contrary. It also remains to be seen whether this third facet could trump the first two, so that functionally necessary 3D shapes could acquire distinctiveness. If it definitely does not, then the new amendments would make it only marginally easier to obtain 3D protection, and it would remain questionable whether bottle shapes would be able to obtain 3D protection.

The Council of State is expected to give its decision this year or early next year. If the Thai government approves the proposed amendments, companies which have successfully registered 3D marks in other jurisdictions, particularly where they have strong evidence of acquired distinctiveness, should be encouraged to apply for 3D marks in the future.

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