

# World Trademark Review Daily

Board of Trademarks decisions highlight difficulty of cancelling mark for non-use

Cancellation  
National procedures

Thailand - Tilleke & Gibbins

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The [Thai Trademark Act](#) allows any interested party or the registrar to file a petition with the Board of Trademarks to cancel a trademark registration on the basis of non-use. In order for a mark to be cancelled, it is necessary to prove the following:

- At the time of seeking such registration, the proprietor had no good-faith intent to use the trademark for any of the goods or services covered by the application and, in reality, the trademark has never been used for such goods or services in a good-faith manner; or
- During the three years prior to the petition for cancellation, there was no good-faith use of the trademark for the registered goods/services.

Section 63 of the Thai Trademark Act clearly places the burden on the petitioner to prove that the proprietor had no good-faith intent to use the mark and that, in reality, the trademark has never been used. As a consequence, in cancellation proceedings, it is problematic to assess whether there is determinative evidence regarding the intent to use or actual use of the mark.

Trademark law in some countries shifts the burden to prove actual use or intent to use to the owner of the mark. For example, Section 100 of the [UK Trademark Act 1994](#) requires the proprietor to show that use has, in fact, occurred. The [US Lanham Act](#) requires the owner of a mark to show intent to resume commercial use. The Thai Trademark Act, however, does not have such provisions. This makes it difficult to cancel a trademark on the ground of non-use. The following decisions of the Board of Trademarks reflect such difficulty.

In Decision No 44/2556 (September 5 2013), the petitioner filed a petition for cancellation based on non-use against a trademark registration for goods in Class 6 and submitted a report conducted by an independent investigation firm. The report demonstrated that no actual use of the mark had been found. The Board of Trademarks, however, concluded that such evidence was insufficient to prove non-use, even though the proprietor of the mark had not submitted any reply or evidence of use in response to the non-use allegation.

Decision No 13/2555 (December 22 2012) involved a registered service mark in Class 44. As above, the owner of the registered mark did not submit a response to the cancellation action and the board considered the cancellation *ex parte*. The petitioner claimed that the registered service mark had never been used, because the owner of the mark had never obtained any licence or standard certificate from the relevant authority. Together with this argument, the petitioner submitted documents printed from the relevant authority's website showing that no licence to conduct the registered service had been given to the proprietor. In addition, the petitioner submitted information taken from the proprietor's website showing that the proprietor merely operated the business in countries other than Thailand.

However, the Board of Trademarks found that such evidence was insufficient to prove the absence of use and an intent not to use. The reasons were that the document submitted by the petitioner was printed from a website and was not a confirmation letter from the Office of Health Business Promotion, and that the petitioner had not presented the relevant law indicating that it is mandatory to obtain a licence to operate a health business.

Based on these decisions, it can be concluded that, even if the owner of a registered mark is in default of appearance, the board can still proceed with its consideration and make a decision on the case *ex parte*, and the petitioner must sufficiently prove that the registered mark is not actually being used. Moreover, investigation reports or documents taken from the Internet seem to be insufficient to prove non-use or an intent not to use.

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