

## Trademark distinctiveness can be established through use

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To be eligible for registration, a trademark must possess distinctive characteristics that cause the public and its consumers to understand that the goods bearing that trademark are different from goods originating from other sources.

Such distinctiveness can manifest itself in the form of invented words or pictures, but it will not be achieved if generic or vague descriptive terms are used to describe the trademark in the application for its registration. This form of distinctiveness is known as "inherent distinctiveness".

This raises the question of whether a trademark that is not inherently distinctive can still be registered? The answer is yes, but only if it is proved that the trademark has been used for a long enough time that it is known to the public and they are able to distinguish goods bearing the mark from the goods of other sources. This is referred to as "factual distinctiveness".

If a trademark is void of inherent distinctiveness when the registration application is filed, evidence of prior use can be submitted to a trademark registrar within 30 days of the date of filing. But applicants seldom submit evidence of use to demonstrate factual distinctiveness at this early stage — even then, the registrar is likely to consider the trademark as one that lacks inherent distinctiveness.

If a mark is rejected due to lack of inherent distinctiveness, an applicant may appeal the trademark registrar's order to the Board of Trademarks. In the appeal, the applicant needs to prove, by presenting evidence, that its trademark has been used with goods that are widely distributed or extensively advertised in Thailand, and thus demonstrate that the trademark has gained distinctiveness through use. This evidence may include:

copies of invoices and sales figures, broken down by year, from many countries where the product is distributed;

samples of advertising or promotional materials, brochures, leaflets, catalogues, and expenses related thereto, broken down by year, from many countries, especially in Thailand, where the product is distributed; and

samples of the product and labels/packaging from as many countries as possible.

The Board of Trademarks usually takes a fairly strict approach to reviewing such evidence and often finds that the evidence is inadequate to prove that a mark has been continually sold, distributed or advertised for long enough time to allow the general public or relevant sectors in Thailand to understand that the mark's goods differ from others.

Applicants therefore need to understand that the decision of the Board of Trademarks is not final. An appeal can be made to the Intellectual Property and International Trade (IP&IT) Court. In fact, we recommend that applicants file a civil case with the IP&IT Court against the registrar's order and the Board of Trademarks' decision if the applicant has evidence of use of the trademark.

An appeal to the IP&IT Court is not restricted by a prescription period or deadline. Nonetheless, trademark owners should file a suit as soon as possible to ensure protection for their trademarks. In the IP&IT Court, trademark owners can submit evidence of use, even if they have never previously submitted evidence of use to the registrar or Board of Trademarks. However, it is important to note that the evidence must be submitted within 60 days after filing the appeal.

Evidence of use is highly important to a trademark owner if his or her trademark is not inherently distinctive. Trademark owners should collect evidence that shows, prima facie, acquired distinctiveness based on at least five years of use up to the date the claim is made. However, the number of required years varies on a case-by-case basis. In some cases, evidence of use dates back to less than five years after a mark's filing, but the evidence may nevertheless be able to demonstrate sufficient distribution or advertising for the mark to become distinctive through use.

Filing an appeal to the IP&IT Court in a civil action is not as time-consuming or costly as might be thought. An intellectual property case only has to go through the IP&IT Court and the Supreme Court, as there is no intermediary appeal court, and the expenses of proceeding with the case are relatively low.

If an applicant is confident that he or she has evidence to prove that a trademark is widely used, distributed or advertised to the extent that it has acquired distinctiveness through use, we advise such applicants to proceed through the courts to obtain trademark protection.