



Sukontip Jitmongkolthong
Partner
sukontip.j@tilleke.com

Update: Recordation of Well-Known Trademarks in Thailand

Thailand began accepting applications for recordation of well-known trademarks in 2005, but to date, only 75 trademarks have been recorded as well-known marks—a relatively small number compared to the volume of applications filed. In the May 2014 edition of *Informed Counsel*, we updated readers that, although it was still accepting applications, Thailand's Department of Intellectual Property (DIP) had, in practice, [suspended the process for recording well-known trademarks](#).

In a new development, on September 9, 2015, the DIP confirmed that it is abolishing the recordation system for well-known trademarks altogether. Under the Notification of Cancellation of Rules of the Department of Intellectual Property Regarding Recordation of Well-Known Marks B.E. 2548, trademark registrars will return all pending applications for recordation, including those that have not yet been examined, those that have been rejected, and

those that are under appeal after rejection. If an applicant wants to retrieve any evidence that was filed to support an application to record a well-known mark, the applicant must contact the DIP.

If a trademark was recorded as a well-known mark under the previous regulation—the Rules of the Department of Intellectual Property Regarding Recordation of Well-Known Marks B.E. 2548—a trademark registrar can still consider this recordation in examining new trademark applications.

In addition, when examining a mark or reviewing an appeal, trademark registrars may still determine that a mark is well known by following the criteria listed in the current Ministerial Regulations. The applicant must be able to demonstrate that:

- ▶ the trademark has been used by the applicant, or by the applicant's authorized representative or licensee, either locally or abroad, on goods or services by way of distribution; or
- ▶ the trademark has been used, advertised, or used by other means in the usual manner and used in good faith continuously to the present to the extent that it is well known among the general public or those in the relevant industry in Thailand, and its reputation for quality is generally known among consumers.

It is unclear whether a new recordation system for well-known trademarks will be established in the future. We will keep readers updated on any developments in future issues of *Informed Counsel*. 