

## THAILAND

## Grounds to initiate a trade mark cancellation action

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Brand owners often wish to seek cancellation of another party's registered trade mark for a range of legitimate reasons, such as unauthorised registration of the mark by a dealer or registration of a copycat mark by a third party. These issues can cause impediments to business and should be addressed without delay.

In Thailand, a party who wishes to initiate trade mark cancellation proceedings must generally do so with the Board of Trademarks. The Board of Trademarks' decision can be appealed to the Intellectual Property and International Trade Court (IP&IT Court), and ultimately, to the Supreme Court. A petitioner can seek trade mark cancellation on the following grounds:

### 1) Non-distinctiveness

A generic or descriptive meaning may not be obvious at the time of examination; therefore, it may be inadvertently granted registration, and later marks comprised of the same term could be rejected by the registrar on the basis of non-distinctiveness.

### 2) Prohibited marks

In Thailand, certain elements in marks are prohibited, including Thailand's national flag, other countries' national flags and national emblems, official emblems, and emblems of the Red Cross. A mark that consists of prohibited elements is unregistrable.

In practice, registrars request trademark applicants to remove prohibited elements from their marks prior to granting registration. It is rare to find registered marks comprised of prohibited elements

in the Trademark Office's records; therefore, this ground is rarely used.

### 3) Identical or confusing similarity to a prior registered mark

Under the Thai Trademark Act, later-filed confusingly similar marks in the same or related classes of goods and/or services are rejected. This ground is popular and often used.

The examiner's determination as to similarity is subjective, particularly for identical or confusingly similar marks in other classes where the goods and/or services are related. This can either be advantageous or disadvantageous, depending on the examiner.

### 4) Contrary to public order, morality or public policy

In Thailand, cancellation actions can be filed on multiple bases, and in practice, they are often supplemented with the ground that a mark is contrary to public order, morality or public policy. To use this ground, it is necessary to prove that the mark subject to cancellation was registered in bad faith. This ground is also often used when it is difficult to base a cancellation action on other grounds.

### 5) Non-use

Brand owners often wish to seek cancellation of an existing mark on the grounds of non-use, but this approach carries strict evidentiary hurdles. The burden of proof to demonstrate non-use is on the petitioner, and the owner of the trade mark cited for cancellation is not required to file a response – there is no default judgment. In the absence of the trade mark owner's response, the Board of Trademarks will consider the petitioner's proof of non-use, which must demonstrate absolute non-use for three years.

The Board of Trademarks rarely approves a cancellation based solely on a non-use investigation result. Other factors need to be proven, such as closure of the owner's company, lack of registration of the goods or services with the relevant

authority (where applicable), and so forth.

In addition, the owner of the mark subject to cancellation is entitled to mount a defence by proving that non-use of the mark on goods was due to exceptional circumstances in trade and not due to any intention to not use or to abandon the mark in respect of the goods, as allowed by the law.

In light of these factors, a cancellation action based on non-use is not a dependable option to remove a mark in Thailand.

### 6) Loss of distinctive character

A cancellation action based on loss of distinctive character must be filed at the IP&IT Court. An interested person or a registrar can use this ground if a registered mark has become a term that is common to trade for some goods or some classes of goods and is no longer capable of functioning as a trade mark.

Cancellations on this ground are rare, and using the symbols "®" or "™" affixed to the trade mark, can prevent a cancellation based on loss of distinctive character.

### 7) Better right

If a trade mark has been registered for less than five years, counted from the registrar's ordered date of registration, a better-right cancellation action can be requested from the IP&IT Court directly, saving time and costs. Proving prior registration, prior use or a trade relationship with the owner of the mark subject to cancellation can support this action.

While this article presents general guidelines for the available grounds in Thailand, petitioners should understand that trade mark cancellation actions are often a last resort, due to the time and costs involved. Brand owners should assess their real commercial needs and evaluate whether a cancellation action will help them achieve their specific business objectives.