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Registration of Three-Letter Trademarks in Thailand

The distinctiveness of trademarks can be hotly debated, with the trademark authorities in different countries adopting a wide range of approaches to determine what types of marks can be registrable. The Trademark Office in Thailand has a reputation, among some international practitioners, as being relatively conservative, often challenging marks on various grounds relating to distinctiveness. The Thai Trademark Act has a clear requirement for marks to be distinctive in order to be registrable, but the Trademark Office is left to determine, on a subjective basis, whether or not any given trademark is distinctive.

One instance where the question of distinctiveness is often raised is the registrability of trademarks consisting of three non-stylized letters. Brand owners frequently like to use simple marks consisting of only three letters, as they are easy to remember and can be effective in building market awareness. But it can be difficult to successfully register these types of marks in Thailand. Many trademarks consisting of three non-stylized letters have been filed with the Trademark Office. Yet few of these applications have been accepted, with most being rejected because they are insufficiently distinctive.

In one notable case, a brand owner sought registration of a mark consisting of three non-stylized letters (**TCL**) in International Classes 7, 9, and 11. Under the authority of the Trademark Office, both the Registrar (at the initial stage) and the Board of Trademarks (on appeal) rejected the application for the TCL mark on the grounds it was not distinctive. Although the trademark owner had submitted evidence of use to support the application, the officials stated that this evidence was insufficient to prove the mark's distinctiveness.

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Dissatisfied with this decision, the brand owner appealed the Board’s decision, first to the Intellectual Property and International Trade Court (IP&IT Court), and then to the Supreme Court. Ultimately, in Red Court Case 94/2551, the Supreme Court ruled in favor of the brand owner, judging that the TCL mark was inherently distinctive and registrable because the mark was a combination of

letters which were represented in a special manner and the mark did not have any meaning in any dictionary.

Although this represented a victory for the brand owner in regard to the initial TCL trademark for goods in International Classes 7, 9, and 11, unfortunately the brand owner has continued to struggle with subsequent conservative decisions of the Trademark Office. When considering the brand owner’s later applications for the same TCL mark (**TCL**) in International Classes 4 and 37, the mark was again rejected.

This decision was made even after the Supreme Court had ruled the mark to be registrable. In issuing its rejection of the mark, the Board of Trademarks reasoned that the previous Supreme Court case involved a different set of facts, and the applicant provided insufficient grounds and evidence to support the registration in Classes 4 and 37.

While this was a frustrating situation for the brand owner, it is important to understand that the Trademark Office’s practice is to examine each trademark application on a case-by-case basis. A decision involving a prior application cannot always be applied to later-filed applications for the same trademark. Instead, the decision will be considered along with all other supporting evidence, and the Board can exercise subjective discretion with respect to accepting new applications. As a result, trademark owners should be aware that even if their trademark has been registered and they file a new application for the same mark in a different class, the mark may not be accepted for registration.

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It is also important to understand that Thailand is a civil law country, and so Supreme Court decisions do not necessarily have a binding effect on the outcomes of later cases. They do, however, hold strong influence over the decisions of lower courts. In the case described above, the Trademark Office seems not to have been influenced by the distinctiveness ruling of the Supreme Court. But if the brand owner chose to once again appeal that decision to the IP&IT Court and the Supreme Court, this decision might be overturned. The challenge, of course, is that these types of civil suits to obtain registration are costly and time consuming, and some brand owners may simply decide that the effort is not worthwhile.

Fundamentally, this case demonstrates the need for cooperation and understanding between Thailand’s authorities, such as the Board of Trademarks and the Supreme Court, to determine how to define trademark distinctiveness, particularly for marks consisting of a combination of letters. Until we see more consistency among the various levels of authorities in the process, brand owners may continue to face frustrations in protecting their intellectual property when distinctiveness is called into question. ⚖️