

THAILAND

Recognition of well-known marksTilleke & Gibbins
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After Thailand's Department of Intellectual Property (DIP) recently announced that it would abolish the recordation system for well-known trade marks, many questions about the status of well-known marks remained unanswered. This article will discuss whether well-known marks are still protected in Thailand, who has authority to determine whether a mark is well known, and whether a similar recordation system will be reestablished in the future.

Abolition of well-known marks recordation system

The Notification of Cancellation of Rules of the Department of Intellectual Property Regarding Recordation of Well-Known Marks BE 2548 (2005), issued on September 9 2015, stated that the DIP's recordation system for well-known trade marks was abolished because the Board of Trade Marks already has criteria to determine whether a mark is well known. For the sake of harmonisation, the DIP cancelled its recordation system.

Protection of well-known marks

As Thailand is a member of the Paris Convention and the TRIPs Agreement, protection of well-known marks still exists in Thailand despite the recordation system being abolished. Under Section 8(10) of the Trade Mark Act, a mark which is identical or very similar to a well-known mark to the extent that it may cause confusion among the public as to the owner or origin of the goods is not registrable.

According to the Ministerial Notification regarding Rules on Determination of Well-Known Marks, dated September 21

2004 — which applies to all government organisations, from the DIP to the Supreme Court — the following criteria should be used to determine whether a mark is well known:

- the mark has been used on goods or services by way of distribution, or has been used, advertised, or used by other means in the usual manner and in good faith;
- the mark has been widely used, whether in Thailand or abroad, in the usual manner and in good faith to the extent that it is well known among the general public or those in the relevant industry in Thailand;
- the mark has been used to the extent that its reputation for quality is generally accepted among consumers; and
- such use is done whether by the applicant or the applicant's authorised representative or licensee, whether locally or abroad.

Current system

In the absence of the previously existing recordation system, the following authorities can now determine whether a mark is well known:

Trade mark registrars: At the examination stage, trade mark registrars have a duty to reject the registration of a mark which is identical or similar to a well-known mark and may cause confusion among the general public as to the owner or origin of the goods.

Board of Trade Marks: The Board of Trade Marks, which acts as an appeal authority for decisions of the registrars, still has the authority to decide whether a mark is well known. If a case is appealed to the Board of Trade Marks, the applicant or opposer may argue that its mark is well known. The Board of Trade Marks will then make a decision on the well-known status of the mark in accordance with the Ministerial Notification, taking into account factors such as acknowledgement of the public in Thailand; the amount of sales or revenue generated by the mark; the market share of the applicant's business; and so on.

The applicant or opposer should submit evidence in support of these factors, such as magazines, product

samples, invoices, bills of lading, advertisements, trade mark registration certificates, awards and judgments with favourable decisions. In Thailand's civil law system, however, court judgments are merely persuasive and do not hold binding precedence.

Courts: The Intellectual Property and International Trade Court (IP&IT Court) and the Supreme Court can also make decisions on the well-known status of marks based on the Ministerial Notification. According to Supreme Court Decision No 6113/2555, recordation is not mandatory. The fact that the opposer did not file a recordation was not a significant reason to decide that the mark was not well-known. It was determined that all facts must be considered in accordance with the Ministerial Notification, such as evidence proving the well-known status of the mark.

There is no indication that a recordation system for well-known marks will be reestablished in the future. A single committee which is authorised to make a binding decision on whether a mark is well known would be welcomed, because multiple authorities issuing non-binding decisions can be burdensome to trade mark owners, who need to prove their mark's well-known status at every different stage and in every similar case. In the future, if a system to record well-known marks is established which binds all relevant government authorities, owners of well-known trade marks will benefit tremendously because it will reduce costs and time to prove that a mark is well known.

