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## *Trademarks/Enforcement*

# Replacing Thailand's System to Record Well-Known Marks



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Changes to how Thailand handles well-known marks mean that rights holders will have to change their strategies and best practices to protect their marks.

In Thailand, protection over a trademark is usually granted once a trademark is registered. A registrar will

not grant the registration of a mark that is identical or similar to a prior-registered trademark, as it may lead to confusion among the public as to the owner or origin of the goods.

Thailand protects well-known marks under Section 8(10) of the Trademark Act, consistent with the Paris Convention and the TRIPS Agreement. Section 8(10) states that “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.”

Cross-class protection is available for well-known marks— they are protected even if the trademark has not been registered in the same class or a relevant class as the offending application.

Well-known status can be especially important for foreign brand owners in Thailand, because it is not uncommon for third parties to try to register these well-

known marks in unrelated classes, in an attempt to take advantage of the brand's considerable goodwill.

## The Recordation System.

Thailand previously had a recordation system for well-known marks which was set up by the country's Department of Intellectual Property (DIP). A trademark owner could submit documents to the DIP to prove the well-known status and obtain official recognition of a mark.

However, on September 9, 2015, the DIP announced that it would abolish the recordation system. Subsequently, trademark owners who had filed or were going to file an application to record a well-known mark were stopped in their tracks. Now, these trademark owners are waiting for the DIP to clarify how their well-known marks will be protected in Thailand.

## Why Was the Well-Known Marks Recordation System Abolished?

Thailand's recordation system for well-known marks was established by a set of rules issued under the National Government Organization Act. Thailand's Trademark Act, however, does not provide for a well-known marks recordation system. The rules also do not identify which authority must comply or acknowledge the recordation system.

In addition, trademark registrars, the Board of Trademarks, the Intellectual Property and International Trade Court (IP&IT Court), and the Supreme Court have the authority to subjectively determine whether or not a mark is well known under Thai law.

Ideally, all of these authorities should arrive at the same decision. In practice, however, this often does not happen due to the varying perspectives of each authority. Therefore, it is possible for a trademark registrar to deem that a mark is well known, yet the Board of Trademarks may determine that the same mark is not well known.

When the recordation system for well-known marks still existed, there was also a unique committee named the Board of Well-Known Marks, comprised mainly of trademark registrars who determined whether or not a mark was well known. Last year, the DIP issued a notification abolishing its recordation system for well-known trademarks to avoid potentially conflicting decisions.

## Are Well-Known Marks Still Protected in Thailand?

As Thailand is a member of the Paris Convention and the TRIPS Agreement, protection for well-known marks still exists despite the recordation system being abolished. Under Section 8(10) of the Trademark Act, a mark that 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—cannot be accepted for registration.

This provision is applicable to all government organizations, from the DIP to the Supreme Court. It sets out cri-

teria to determine whether or not a mark is well known, broadly prescribing that a well-known mark should:

- Have 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;
- Have 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; and
- Have been used to the extent that its reputation for quality is generally accepted among consumers.

In addition, the use of the mark as described above must be done by the applicant or the applicant's authorized representative or licensee, either locally or abroad.

## Does the DIP Plan to Replace the Recordation System?

In moving forward and evaluating the drawbacks under the former system to record well-known marks, the DIP is planning to develop a system that harmonizes the decisions surrounding whether a mark is well known. This would provide an important economic benefit to trademark owners, as they currently have to submit an enormous amount of evidence to prove that their marks are well known every time they apply for a new trademark.

A new system does not mean that the DIP will re-establish the recordation system or a new committee that is authorized to make a binding decision on whether a mark is well known. Instead of a centralized authority, the DIP is planning to establish an internal system to collect all decisions from the Board of Trademarks, the IP&IT Court, and the Supreme Court on whether a mark is well known.

This will help trademark registrars check whether any decision from the Board of Trademarks, the IP&IT Court, or the Supreme Court has been made regarding the well-known status of a mark. If a precedential decision has been made determining that a mark is well known, the trademark registrars will follow this decision for the sake of harmonization.

In addition, the DIP is planning to issue a new Ministerial Notification to empower trademark registrars to make a decision by taking precedent decisions of the Board of Trademarks, the IP&IT Court, and the Supreme Court into account. This would not only facilitate determining whether or not a mark is well known, but it would also help trademark owners as they would not need to repeatedly prove the well-known status of their marks.

## When Will This New System Come Into Effect?

At present, this internal system is only a plan, and it needs to be further discussed to refine the procedures. One potential drawback of this system is that precedential decisions may become outdated. These decisions should only serve as guidance of what trademark owners

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have proved in the past, and ideally, the Ministerial Notification should specify how far back trademark registrars should take precedential decisions into consideration.

### **What Actions Should Trademark Owners Take?**

While waiting for the new system to be introduced, there are still actions that trademark owners can take to en-

sure that their rights are fully protected. The key action is for trademark owners to collect evidence in support of the well-known status of their marks. This evidence can be used to obtain favorable decisions from the Board of Trademarks, the IP&IT Court, or the Supreme Court regarding the well-known status of their marks. These decisions will be beneficial now and in the future when the new recordation system is established.