

# Informed Counsel

Analysis of Recent Legal Developments in Southeast Asia



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## Trademark Act Amendments Usher in Thailand's Accession to the Madrid Protocol

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Amendments to Thailand's Trademark Act were published in the *Royal Gazette* on April 29, 2016. The amendments will become effective on July 28, 90 days after the publication date. Among the amendments is a new chapter on trademark registration which introduces a number of changes that set the stage for Thailand to accede to the Madrid Protocol in 2016.

The Department of Intellectual Property is currently preparing a draft Ministerial Regulation that will allow Thailand to become a member of the Madrid Protocol, and it is preparing a new team of Trademark Registrars with responsibilities to: (1) take charge of filing International Applications at WIPO; and (2) accept and handle examinations of international registrations designating Thailand from WIPO.

The significant amendments to Thailand's Trademark Act are discussed below.

**Sound marks.** The definition of "mark" under Section 4 will include "sounds." Sound marks will be registrable. (The protection of smell marks was considered in the proposed amendments but was not included due to conflicting opinions over their inclusion.)

**Distinctive marks.** The criteria that constitute distinctiveness for different types of marks are clearly stated in Section 7(2), which includes shapes or three-dimensional objects that are not the natural shapes of the applied goods, are not functionally necessary, and do not add value to the goods. In addition, sound marks must not be descriptive of the applied goods.

Marks that are considered as not sufficiently distinctive may be registrable if they are proved to be substantially sold, distributed, or advertised in Thailand.

**Multiple-class applications.** Multiple-class applications will be allowed.

**Oppositions and responses to official actions.** The allowed period for responses to official actions and appeal petitions against orders from Registrars, the publication period for oppositions, and the period to file counterstatements to oppositions will be reduced from 90 days to 60 days.

The allowed period for registration fee payment, however, will increase from 30 days to 60 days. Responses to official actions regarding the assignment of marks must be completed within 60 days—otherwise, the application for assignment will be deemed abandoned.

**Partial assignment.** Partial assignment for some or all registered goods or services will be allowed.

**Abolishment of requirement to register associated marks.** The requirement to register associated marks will be abolished. All registrations of associated marks under the previous Trademark Act will be cancelled as if they were not registered as associated marks.

**License agreements.** A license agreement will not be terminated as a result of the transfer or inheritance of the right of the mark for which the license agreement is made unless there is a provision in the agreement to the contrary.

**Expiry grace period.** After the expiry date, there is a grace period of six months to renew the registration of a mark. A surcharge of 20 percent of the government renewal fee must be paid by the end of the grace period.

**Government fees.** The government fees for certain transactions have been revised. Government fees will not be calculated for every item of goods in filing a new application.

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## Trademark Act Amendments (from page 1)

The new government fees for filing a new application, registration, and renewal are as follows:

<b>New application:</b>	For goods/services of up to five items	THB 1,000
	For more than five items of goods/services	THB 9,000
<b>Registration:</b>	For goods/services of up to five items	THB 600
	For more than five items of goods/services	THB 5,400
<b>Renewal:</b>	For goods/services of up to five items	THB 2,000
	For more than five items of goods/services	THB 18,000

**Refilling.** The offense of refilling has been added to Section 109/1 of the amended Trademark Act. It stipulates that a person who reuses or refills packaging or containers bearing another's registered trademarks to mislead the public into believing that the goods are of the trademark owner will be liable for imprisonment of up to four years and/or a fine of up to THB 400,000.

The amended Trademark Act introduces a new trademark filing system to prepare Thailand for its accession to the Madrid Protocol. The system allows trademark owners to file and protect their marks in multiple countries that belong to the Madrid Protocol by filing a single application. Not only does this save applicants time and costs, but it also harmonizes Thailand's trademark protection procedures and system with international practices. ⚖️