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Trademark opposition proceedings: Comparing Thailand and the US

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A trademark opposition proceeding is a specialised legal process in which one party challenges another party's pending trademark application. Such proceedings can be useful tools for third parties to protect their trademark rights and are often undertaken when a third party believes that a trademark filed by another party is confusingly similar to its own and will cause confusion to consumers. This article examines the differing approaches to trademark opposition proceedings in Thailand and the United States, and the benefits and drawbacks of each.

Thailand: In Thailand, after a trademark application is filed with the Department of Intellectual Property, it is reviewed by a Trademark Registrar. If the registrar approves the trademark for registration, the application is published in the Trademark Gazette. Third parties have 60 days after the publication date to oppose the trademark if they wish.

Opposition proceedings in Thailand are initiated with the Trademark Registrar. The opposing party files a petition setting out the reasons why the trademark should not be registered, and the owner of the trademark may submit a counterstatement in response within 60 days of receiving the petition. The registrar assigned to the case will consider the parties' submissions and will make a decision within 12 to 18 months.

The United States: Similar to Thailand, a trademark application in the United States is filed with the US Patent and Trademark Office (USPTO) and is reviewed by an examining attorney. If the application is approved for registration and all other requirements are met, the application is published in the Official Gazette. A third party wishing to oppose a trademark application files a notice of opposition with the administrative tribunal of the USPTO, known as the Trademark Trial and Appeal Board.

Once a notice of opposition is filed, the board issues an order with a schedule of proceedings. The owner of the trademark must then submit an answer to the notice of opposition. Subsequently, the parties engage in a process called "discovery", in which they request information and documents from each other to support their claims and defences. The discovery process can include taking depositions of witnesses.

By the time it is ready to make a decision, the board will often have an extensive legal record to consider, including the notice of opposition, the answer filed by the trademark owner, and all the documents, information and testimony submitted by the parties to support their cases. An oral hearing before the board is also available upon request.

A decision regarding a trademark opposition in the United States is required to be rendered within 10 to 20 weeks from the date that the case is ready for decision. Once the board makes a decision, a party may file a request for rehearing, reconsideration or modification of a decision.

Comparison: Opposition proceedings in Thailand are straightforward, and the process of filing and responding to an opposition petition is clear. The limit on the submissions that the parties can make helps keep costs relatively low. On the other hand, the proceedings do not provide opportunities for the parties to try to negotiate a settlement.

By comparison, the proceedings in the United States are complex and involved. The parties must exchange information and documents, so that each has an opportunity to gather evidence to support its claims and defences. The result is often a robust legal record on which the board can rely when making its decision. However, the process can also lead to high costs.

One of the key differences between US and Thai proceedings is the ability to suspend the proceedings or extend deadlines in certain circumstances in the United States -- an option that is not available in Thailand.

For example, in the United States, in the period after publication but before the opposition is filed, the potential opposer may request an extension of the deadline to file the opposition. The extension is often requested by the potential opposer to provide time to contact the trademark owner and try to resolve the dispute without the need to enter into opposition proceedings. It is also often possible to suspend ongoing proceedings if the parties are actively engaged in settlement discussions.

While opposition proceedings in Thailand could be improved by allowing for more opportunities for parties to gather information from each other and by allowing for extensions of deadlines and suspensions of the proceedings, US opposition proceedings could be enhanced through simplifying and streamlining the process.

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