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New Protections for Sound Marks in Thailand: Music to IP Owners' Ears

The scope of Thailand's intellectual property protections was recently widened, with the new definition of marks going beyond the visual elements of a mark to include those possessing auditory characteristics. This brings Thailand in line with scores of other jurisdictions that already allow trademark registration for sound marks.

The amended Trademark Act B.E. 2534 (1991) was implemented on July 28, 2016, and now includes "sound" as a category of mark. Section 4, paragraph 1 of the Act now states that:

"mark" means a photograph, drawing, device, brand, name, word, text, letter, numeral, signature, combination of colors, figure or shape of an object, **sound**, or any combination thereof ..."

Following passage of the Act last year, Ministerial Regulation No. 5 B.E. 2560 (2017) was issued to enable the implementation of the Act, under which the Thai Department of Intellectual Property started accepting sound trademark registration applications on September 1, 2017.

Formality Requirements

Much of the information and documentation required when applying for sound mark registration is essentially the same as the requirements for filing visual trademarks, such as providing the applicant's name and address, submitting a power of attorney (if the mark's owner appoints a representative), and specifying the goods and/or services for which registration is sought.

The information required to identify sound marks is set out in clause 11 of the Ministerial Regulation as:

1. a detailed written description of the sound, specifying whether the sound is categorized as a human sound, an animal sound, a piece of music/melody, or another type of sound; and
2. an audio recording of the mark in a digital file format, such as MP3, saved on a storage device, such as a USB flash drive.

Applicants may choose to submit musical notations or

a recording of their sound mark as part of their application. The Ministerial Regulation does not address the length of the recording, but it is recommended that it not be inordinately long. A reasonable guideline, based on the laws governing sound marks in other jurisdictions, is that it should be no longer than 30 seconds.

Substantive Examination

Section 7, paragraph 2 (11) of the Trademark Act provides the essential qualifications for a distinctive sound trademark. Under this section, for a sound mark to be sufficiently distinct:

- ▶ it must not be directly descriptive of the nature or characteristics of the designated goods or services;
- ▶ it must not be an inherent sound associated with the goods or services; and
- ▶ it must not have been created by the usage or operation of the goods or services.

For instance, the sound of a working engine cannot be protected for automobiles or automobile parts; a human sound made to express that something tastes good (e.g., the sound "yummy") cannot be protected for food or restaurants; and the sound of cutting something with a metal tool cannot be protected for knives or other cutting or shearing equipment.

Under section 7, paragraph 3, a sound mark applicant can prove distinctiveness through use by submitting documentary or audio materials demonstrating that the mark applied for has been widely sold, distributed, or advertised, according to the rules prescribed by the minister in related notifications.

In addition to possessing inherent distinctiveness, a sound mark must not be identical to another person's registered trademark, whether it is filed for goods in the same class or in a different class (but where the goods are of the same nature), according to section 13 of the Act.

The Need to Protect Sound Marks

As consumers often recognize brands from what they see *and* hear, the protection of specialty sound trademarks is expected to become very popular. Securing sound marks associated with a brand, along with visual marks, increases the distinctiveness of that brand and assists consumers in easily distinguishing products from others on the market.

As of October 25, 2017, 13 sound mark applications have already been lodged with the Department of Intellectual Property—eight human sound marks and five melodies—since applications first started to be accepted on September 1. Eight of the applications were filed by foreign applicants and five were filed by Thai nationals. As more entrepreneurs and business owners become aware that they can protect the sounds associated with their businesses, this figure is expected to increase substantially.

The new regime means that sound mark holders are able to benefit from full protection under trademark law when taking legal action against third parties, provided that their sound mark is registered. The owners of such marks would be well advised to register their marks quickly to ensure that they avail themselves of this protection. 🎵