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## Developments in Life Sciences Trademark and Regulatory Restrictions in Thailand

Regulatory issues related to the commercialization of life sciences products cannot be overlooked or brushed aside. As a first step, an intellectual property (IP) owner needs to obtain a marketing authorization license from the relevant regulatory authorities, while exercising their best efforts to protect their IP rights.

When considering consumer protection, trademark laws and life sciences product regulation laws have similar objectives—to protect consumers from misrepresentation. Misrepresentation in the trademark sense involves misrepresenting the origin of goods, while misrepresentation in the product regulation sense involves overclaims made about a product's properties or characteristics.

A tension exists between these two areas of the law, which is to the disadvantage of consumers and business operators alike. This article examines developments in life sciences trademark and regulatory restrictions in Thailand, where trademark and regulatory authorities do not always see eye to eye.

### Trademarks

Among the various categories of trademark, suggestive word marks are the most frequent subject of regulatory objections in Thailand. Section 7, paragraphs 2 and 9 of the Trademark Act B.E. 2534 (1991), as amended, confirms the eligibility of a word or figurative mark that is “not *directly* descriptive of characteristics or property of the goods...” (emphasis added). The distinction between direct descriptiveness and suggestiveness has been consistently affirmed by Thai Supreme Court decisions.

Section 44 of the Trademark Act asserts the right of trademark stating that “the registered proprietor of the trademark shall be entitled to the exclusive right to use that trademark in respect of the goods for which it has been registered.” This is clearly a positive right to use, as opposed to the negative right to prevent others from use, as found in some other jurisdictions. The same provision provides exceptions to this right only in cases of: (1) concurrent and independent uses in good faith, or (2) trademark licensing.

### Product Regulations

Laws and subsequent regulations for highly regulated life sciences products—drugs, medical devices, cosmetics, or food—usually prohibit the use of a product name that is exaggerating or misleading when considering the nature of the represented product. Misleading product names are generally understood to be those suggesting that the product belongs to another category (e.g., a food name that alludes to a type of medical therapy), or contains an ingredient that it in fact does not have. Exaggeration refers to

names that convey absoluteness (e.g., “free,” “zero,” “instant cold remedy”) or unsubstantiated product claims.

It is not a mandatory requirement for a product's trademark to be registered before that product is registered in Thailand. Thus, in most cases, the Thai Food and Drug Administration (FDA) will not require proof of trademark registration. Recently, the FDA has objected to the use of certain product names with the wording “extra white” or “slim.” In addition, a brand or trademark with the terms “doctor” or “Dr.” will not be allowed, unless the applicant can prove that the product is owned or has been designed by a named doctor, including submitting proof of qualifications. In such cases, obtaining trademark registration alone is not sufficient to convince the FDA to grant marketing authorization.

Problems can also arise when a proposed word mark contains a word element that is suggestive of a positive attribute (e.g. “max,” “super,” “life,” “vita,” and “health”). Promulgated regulations and notifications grant regulators broad discretionary powers to object to the use of a product name if they determine that it could be misleading or exaggerating. Such regulatory decisions are occasionally influenced by public sentiments, and sometimes yield unpredictable or inconsistent results, especially across the different regulatory offices involved with different product categories.

It is therefore possible to surmise that the criteria for regulatory approval are stricter and less clear than the requirements for trademark registration. In fact, a number of registered Thai trademarks have been rejected during the application process for marketing authorization, effectively restricting or delaying the right to use a successfully registered trademark.

### Business Implications

Business concerns are rightfully based on Thailand's constitutional right to trade and the state's constitutional duty to ensure that any regulatory mechanisms do not create unnecessary obstacles to a Thai citizen's trading capabilities.

However, a marketing authorization dispute usually takes months, or even years, to resolve. The damage suffered from business interruption is magnified when the subject of the pending application is part of a regional or global marketing plan, which involves setting up manufacturing sites and arranging for logistics in several locations. Collectively, this practice projects an IP-hostile climate, affecting Thailand's competitiveness.

While recognizing regulators' duties to safeguard consumers against commercial misrepresentation, the regulatory framework should also account for private entities' rights to conduct business. To this end, the existing framework should be improved so that (1) IP implications and trading concerns are taken into account; (2) clear and predictable guidelines are provided; and (3) examination practices across various regulatory offices are consistently applied and based on understandable rationales.

Business operators, especially those in the life sciences sector, should be aware of the complex interactions between IP and product regulations to avoid major business impacts. Before pursuing registration, it is essential to conduct a thorough assessment from both an IP and a regulatory perspective, taking into account the feasibility of a product name, relevance of trademark registration, steps to registration and marketing approval, and suitable and effective responses to potential office actions. 🏠