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## Letter Marks in Thailand: Supreme Court Provides Guidance on Distinctiveness

Many business owners wish to protect trademarks or service marks in Thailand in the form of abbreviations, acronyms, initialisms, or letters that are not generally used words or that cannot be pronounced. Thai Trademark Registrars and the Board of Trademarks take a conservative view of the distinctiveness of such marks, which is not always echoed by the courts. Brand owners therefore need to strategically consider how such marks are treated to determine whether their letter marks are sufficiently distinctive to be registrable.

According to section 4 of the current Thai Trademark Act, a mark can be 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.”

Section 7 of the Trademark Act then sets out the criteria for trademark distinctiveness, stating that “a distinctive trademark is a trademark that enables the public or users of the goods under said trademark to know and understand that such goods are different from other goods. A trademark containing or consisting of one or more of the following as an essential element shall be deemed distinctive: ... (4) An invented letter or numeral.”

According to the Department of Intellectual Property’s *Guidelines on the Examination of Trademarks*, an invented letter means any letter of any language that is represented in any of the following manners: (1) interconnected letters; (2) a letter (or letters) with depth; (3) a letter (or letters) with an inside pattern; and (4) a letter (or letters) with shadowing/shading. In interpreting these guidelines, the Registrar and the Board of Trademarks usually reject marks of three or four letters that do not form words or that cannot be pronounced, if they are not presented in stylized form. This leaves brand owners to question what threshold of stylization is sufficient in order to achieve distinctiveness.

A lot of letter mark applications are rejected by the Trademark Registrar and the Board of Trademarks on the grounds of lack of distinctiveness, most of which are then abandoned by the applicants. However, some applicants choose to pursue the registration of their marks after rejection, with some examples shown inset.

After being rejected for lack of distinctiveness, the applicants for the referenced marks brought their cases before the Intellectual Property and International Trade Court (IP&IT Court), and then ultimately to the Supreme Court. The Supreme Court issued similar opinions in all three contested cases, finding that the unusual combination of three letters in each of the marks, even if not presented in a stylized

manner, rendered each of the marks sufficiently distinctive and registrable.

Despite the Supreme Court’s positive reasoning in these cases, the Trademark Registrar maintains a strict interpretation regarding the distinctiveness of non-stylized letter marks. In 2013, the Trademark Registrar denied the registration of the trademark . The owner of this mark

chose to challenge this rejection in the IP&IT Court and the Supreme Court, as Supreme Court Case No. 862/2561.

The Supreme Court decided again to confirm the registrability of the unusual combination of letters. Its decision, handed down in May 2018, affirmed the decision of the IP&IT Court to reverse the decisions of the Registrar and the Board of Trademarks, which had previously rejected an application to register the mark in International Classes 7 and 9.

The Registrar, with whom the Board of Trademarks agreed, found that the mark was nondistinctive because the letters “B,” “F,” and “t” were letters of normal appearance that were not presented in a stylized manner.

Striking down that decision, the Supreme Court considered the mark to be comprised of three letters, “B,” “F,” and “t,” which do not form a specific word with any particular meaning, appearing on a red background, which helps to make these Roman letters more distinguishable and outstanding from normal non-stylized Roman letters. The court reasoned that this makes it easier for consumers to recognize and distinguish this applicant’s mark from other marks, and therefore deemed the mark sufficiently distinctive to be registrable under the Trademark Act.

### Examples of Marks Accepted by Supreme Court

**BDF●●●●** Trademark Application No. 464976

**TCL** Trademark Application No. 574880

**htc** Trademark Application No. 685442

We can infer from this that Roman letters that are not assembled as words, cannot be pronounced, and are not presented in sufficiently stylized forms, are still not acceptable to the Trademark Registrar and the Board of Trademarks in Thailand. A business that wishes to apply for an initialism or a three-letter (or more) trademark of its company name, using only letters, might have to plan strategically, well in advance, to successfully apply for this type of trademark. If a brand owner wishes to avoid rejection based on nondistinctiveness during the examination stage, it should design a mark that is sufficiently stylized. This appears to be the best option for brand owners seeking a better-than-average chance of registering their letter marks without having to appeal to the courts. However, if an owner wishes to register this type of mark in a non-stylized form, the courts are more open-minded, and the well-informed owner can prepare to appeal any refusals before they occur. 🏠