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## Updates on Thailand's Trademark Registration Practices

The current version of Thailand's Trademark Act came into force on July 28, 2016. The most recent amendments to the trademark laws introduced multiple-class filings, registration of international trademarks, new methods to calculate official fees, and the acceptance of sound marks. What did not change were the formality requirements and the general examination practices of the Thai Trademark Office. Nevertheless, we have recently come across certain issues that require increased scrutiny from trademark owners.

### Priority Claiming

As Thailand is a party to the Paris Convention, a trademark owner's right to claim the priority date of a trademark application in a foreign country and then file an application for the same trademark in Thailand within six months of that date has remained unchanged. However, we recently learned that a number of priority claim requests have been rejected by the Trademark Office, which was not an issue we had encountered in the past.

It would be no surprise if the rejection of the priority claim was the result of a failure to submit the required documents, or if it was due to the material differences in the applied marks in the priority applications. This issue caught our attention because the rejections seemed to target word marks filed in plain block letters. It appears that the Trademark Office has been rejecting priority claim requests for all word marks that were filed using even slightly different fonts from those used by the trademarks appearing in the priority applications.

Examples of such marks that would be rejected in a priority claim might be as follows.

Trademark applied in Thailand	Trademark applied in the priority application
ABC	ABC
ABC	ABC
ABC	ABC

*Note: The font used in the left column is Times New Roman, while the fonts used in the right column are Calibri, Arial Narrow, and BrowalliaUPC, respectively.*

We disagree with this type of rejection and approached the Trademark Office to explain that the marks, as claimed, consist of standard characters, without claiming any particular font style, size, or color. Thus, minor differences between font styles should not be cited as the main reason for rejecting priority claim requests.

However, we later found that the cause of rejection stems from the Trademark Office's Internal Guidelines dated 2016, which require that the marks, as claimed, must be identical to the marks in the Thai applications. In particular, for word marks the fonts must be identical. The Internal Guidelines state the criteria for claiming a priority date from a foreign application as follows:

- ▶ Priority application must be stated in the Kor 10 form.

- ▶ The trademark must be the same as set out in the foreign priority application. In this respect, the Registrars are required to examine the primary visual similarities of the marks; e.g., word marks must be in identical fonts.
- ▶ In cases where the trademarks in the foreign applications are in color and the Thai applications contain different colors, the marks are deemed to be the same, except in case of a "group of colors" type of mark.
- ▶ If trademarks applied in foreign applications are Series Marks, and one of the marks in the Series is identical to the trademark applied in Thailand, the two marks are deemed to be the same.
- ▶ The descriptions of goods or services in foreign applications must cover the goods or services listed in the Thai applications.
- ▶ A copy of the priority application must be submitted.
- ▶ Statements certifying that the priority application has never been rejected, withdrawn, or abandoned must be submitted. Such statements must be certified by the trademark owners or their authorized representatives, either within or outside of Thailand.

The Trademark Office's Internal Guidelines have not been publicly announced, but these Internal Guidelines seem to be used as the basis for rejection of priority claim requests in many cases. Therefore, trademark owners are urged to be aware of this issue and to ensure that when a priority claim is requested, the applicant must strictly comply with these Internal Guidelines.

### Multiple-Class Filings

Since the enactment of the new Trademark Act in 2016, we have always advised our clients who prefer to file multiple-class trademark applications that a problem in one class would delay the whole application, as divisional applications are not allowed in Thailand. This advice remains valid, and we would now like to emphasize that not only will a problem in one class delay the whole application, but it could also result in the rejection of the whole application.

When a multiple-class trademark application is rejected, the application is rejected in its entirety. The applicant has to appeal with respect to the whole application, even though arguments for some classes may be stronger than other classes, and the Board of Trademarks will issue its decision with respect to the whole application rather than rejecting certain classes and allowing other classes to remain.

In other words, even if a trademark is descriptive only of certain classes of goods or services, when the Registrar rejects the mark, they usually reject the whole application. Additionally, when the Board of Trademarks issues its decision in an appeal, such decision will target the whole application. We have not yet received a decision by the Board whereby the Board allows only some of the non-affected classes in a multiple-class application to proceed to registration. The Board tends to either accept or reject the application in its entirety, despite there being no official objections targeting some of the classes.

With this trend of rejecting whole multiple-class applications without allowing divisional applications, trademark owners should consider their risks and may opt to file single-class trademark applications if they anticipate that there might be problem in some but not all classes. On the other hand, if trademark owners anticipate rejection in all classes, filing multiple-class applications would save costs since the appeal for all classes could be filed at the same time.

We will be closely monitoring these slight and sometimes undisclosed changes in the Trademark Office's practices, which can have substantial effects on applicants, and will continue to provide timely updates on the trademark registration process in Thailand. 🏠