

# Thailand

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## 1. Legal framework

### National

Trademark registration in Thailand is governed by the Trademark Act BE 2534 (1991) and subsequent amendments, which came into force on June 30 2000. The act provides the owner of a registered trademark with the exclusive right to use the mark in the course of trade. In addition to these specific laws, the Penal Code, the Civil and Commercial Code, the Consumer Protection Act and various ministerial regulations are also essential in enforcing trademark rights. These statutes allow the owner of a registered trademark to take legal action against infringements and/or claim redress damages.

### International

Thailand is a member of the World Intellectual Property Organisation and the World Trade Organisation, and a signatory to the Agreement on Trade-Related Aspects of Intellectual Property Rights. In line with these international treaties, the trademark legislation has been amended and the Central Intellectual Property and International Trade Court has been established in order to deal solely with IP disputes.

On May 2 2008 Thailand acceded to the Paris Convention for the Protection of Industrial Property; it became bound by the convention on August 2 2008. Thailand is not yet a member of the Madrid Protocol, but preparations to harmonise domestic laws with the protocol regulations are underway.

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## 2. Unregistered marks

### Protection

Protection for unregistered marks can be sought through both civil and criminal actions. The owner of an unregistered trademark may initiate legal proceedings in order to seek an injunction or to obtain monetary compensation for an act of passing off pursuant to Section 46 of the Trademark Act and/or Section 420 of the Civil and Commercial Code. In addition, the owner of an unregistered trademark may seek criminal enforcement under Section 272 of the Penal

Code. In such cases both actual infringement and bad faith must be clearly demonstrated.

### Well-known marks

In Thailand, a well-known mark is legally protected under Section 8(10) of the Trademark Act, even if it is unregistered. A well-known mark can be recorded with the Department of Intellectual Property (DIP) if it fulfils the recordal criteria set out in the relevant regulation. For the mark to be recordable, the applicant must prove that:

- the mark has been widely and continuously used and advertised in good faith in either Thailand or a foreign country; and
- the mark is well known among the general public or relevant sector of the public.

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## 3. Registered marks

### Ownership

Any natural or legal person is eligible to file a trademark application in Thailand. However, if the applicant does not reside or have a permanent business establishment in Thailand, a representative or an agent must be appointed to file the application.

### Scope of protection

In addition to traditional trademarks, protection is afforded to combinations of colours, three-dimensional marks and geographical indications. Other types of non-traditional trademark such as smells, sounds and tastes are not yet recognised for registration in Thailand. To be registrable, a trademark must be capable of distinguishing the trademark goods or services from those of others and must:

- be distinctive;
- not be forbidden by the Trademark Act; and
- not be identical or confusingly similar to any other prior registered trademark.

A mark that includes characteristics of national flags, official symbols or emblems, royal names or pictures or any immoral elements, or that is identical or similar to a well-known mark, cannot be registered.

## 4. Procedures

### Application

A trademark application can be filed through various channels:

- at the DIP;
- by registered mail with payment of the fee by money order to the DIP; or
- online at [www.ipthailand.org](http://www.ipthailand.org) (a hard copy of the application form must be submitted to the DIP within 15 days of the online filing).

Actual use is not a requirement of registration. Thus, evidence of use is not required at the time of filing. However, it can be submitted together with the application or within 30 days of the date of filing in order to establish the distinctiveness of the mark under a secondary meaning.

Multiclass applications are not available; thus a separate application is required for each class. The specification of goods or services must be itemised in the application. If the goods or services are too broadly specified, the registrar may request further details and amendments.

Claiming a priority date is also possible. If an applicant wishes to claim the date of first filing in a foreign country as the filing date in Thailand, it must file the application in Thailand within six months of the first filing in the foreign country.

Three-dimensional marks may be registered. However, representations of the marks in all dimensions must be submitted to the DIP in accordance with the relevant regulation. Geographical indications are also eligible for protection. In order to register a geographical indication, names must be used and well known among the general public. An application must be submitted to the DIP together with other evidence certifying the reputation, quality or any other characteristics of the goods, and the relationship between the geographical origin and the goods in relation to which the geographical indication is used.

### Examination

Once a trademark application has been filed, the registrar will examine the application to determine whether it complies with the required formalities and whether it is identical

or confusingly similar to any prior registered trademark. If the mark fulfils the registrability requirement, the application will proceed to publication. The examination process takes approximately six to eight months from the filing date.

### Opposition

Once the mark is approved by the registrar, it will be published in the *Thai Trademark Gazette* for a period of 90 days. During such period, an opposition can be lodged with the registrar if any interested person believes that the published mark is identical or confusingly similar to its marks or does not fulfil the registrability requirements.

Any party to opposition proceedings that disagrees with the registrar's decision may file an appeal with the Trademark Committee within 90 days of receipt of the decision. If any party is not satisfied with the decision of the Trademark Committee, an appeal can be filed with the Central Intellectual Property and International Trade Court within 90 days of receipt of the decision.

In the absence of an opposition from an interested party, the registrar will request payment of the registration fees. Upon payment, a certificate of registration will be issued within three months.

### Registration

The trademark registration process can be completed within 10 to 12 months if there is no objection from the registrar and no opposition from an interested party. Once the trademark is registered, the rights holder has the exclusive right to use the mark for the registered goods or services.

The period of trademark protection is 10 years from the date of filing and can be renewed indefinitely for further 10-year periods. A renewal request must be lodged in the 90 days preceding the expiration of the registration term. If the owner of the trademark fails to renew the registration, the trademark right will lapse.

### Removal from register

A registered trademark may be removed from the register by either the Trademark Committee or the Central Intellectual Property

and International Trade Court. At Trademark Committee level, a registered trademark can be removed from the register upon a request by either an interested person or the registrar on the grounds that the mark:

- is not distinctive;
- is prohibited;
- is identical to an existing registered marks for related goods or services;
- is confusingly similar to an existing registered marks for related goods or services;
- has never been used or has not been used in good faith for a period of three years prior to the date of the petition for cancellation; or
- is contrary to public order, public morals or government policy.

Any unsatisfied party can file an appeal with the Central Intellectual Property and International Trade Court within 90 days of receipt of the committee's decision. If there is no appeal, the court's decision shall be deemed final.

At the court level, a registered trademark is subject to cancellation if any interested party believes that it has a superior right to the registered trademark. It is entitled to petition the Central Intellectual Property and International Trade Court for such cancellation within five years of the date of registration.

### Searches

In order to avoid potential conflicts with former registered trademarks, a trademark applicant is encouraged to perform a search prior to filing a trademark application. Even though official DIP searches are not available, the applicant can conduct a search for pending or registered trademarks that are identical or similar to its mark in all classes at the DIP or via its online service. The DIP database is searchable for both word and graphic marks. If a trade name search is required, the search must be performed at the Ministry of Commerce or via its website at [www.dbd.go.th](http://www.dbd.go.th).

## 5. Enforcement

### Complexity

IP rights infringement has been a persistent issue in Thailand. To address this issue, the Thai government, along with the DIP and other bodies, including the Intellectual Property Association of Thailand and the Intellectual Property Promotion Association of Thailand, has devoted considerable efforts to providing knowledge and raising awareness of the importance of IP rights. The police also play an increasingly important role in enforcement.

The Trademark Act allows victims of trademark infringement to seek both civil redress and criminal punishment against trademark infringers. However, in practice, trademark enforcement can be carried out in conjunction with other administrative measures – that is, by either filing an opposition to the registration of a similar mark or pursuing a cancellation action against a mark registered in bad faith.

### Civil enforcement

The Trademark Act recognises the need for prompt measures to minimise the damage suffered by trademark owners. Thus, it allows an injured party to obtain, prior to filing a complaint, a preliminary injunction against the alleged infringer by demonstrating that:

- there is clear and convincing evidence that the party against which injunctive relief is sought is engaging in the infringing activities; and
- there would be irreparable harm if the relief were not granted promptly.

Although injunctive relief is useful, the standard of proof required to provide such relief may be difficult to meet, compared to the enforcement mechanisms under criminal law that empower the police to confiscate infringing goods following a raid.

Rights holders are entitled to monetary damages, as well as permanent injunctions against future infringement. Furthermore, if the infringing party has registered the mark with the DIP, the rights holder can request the mark to be removed from the Trademark Register without having to file a separate

cancellation action. However, there is no provision allowing plaintiffs to seek damages beyond what they can prove, even in the case of bad faith or wilful infringement.

Typically, proceedings before the Central Intellectual Property and International Trade Court take one to two years.

### **Criminal prosecution**

Trademark infringement is recognised as a criminal offence under both the Penal Code and the Trademark Act. The Trademark Act prohibits the forgery and imitation of registered trademarks, as well as the import and offering for sale of counterfeit products. However, while the Trademark Act concerns only trademarks registered in Thailand, the Penal Code also covers the protection of the marks that are registered overseas.

Both the Penal Code and the Trademark Act regard trademark infringement as a crime against commercial property, which is a compoundable offence. The victim of a trademark rights violation must either lodge a complaint with the police or file a complaint with the court within three months of becoming aware of such infringement.

Most victims of trademark infringement prefer to enforce their rights under criminal law, which offers the following advantages – especially for foreign mark owners – over civil actions:

- An act of trademark infringement is punishable even when the trademark at issue has not been registered in Thailand. In fact, it is not even mandatory that the trademark be used in Thailand.
- The punishments stipulated by the Trademark Act are severe, involving heavy fines and lengthy jail terms, which serve to deter repeat infringers.
- There is no need to demonstrate public confusion or economic loss in order to secure a conviction – proof that the plaintiff's trademark has been intentionally forged or imitated by the accused party is sufficient.
- The Penal Code provides a course of action for illegal conduct that falls outside the scope of the Trademark Act (ie, false advertising or endorsement, commercial

disparagement and misappropriation of non-trademark designations or symbols).

Although a rights holder may instigate a criminal complaint directly with the court, it should first seek cooperation from the competent authorities (ie, the police, the Economic and Cybercrime Division and the Department of Special Investigation) in order to obtain the necessary evidence.

### **Enforcement through Customs**

To assist with anti-infringement efforts Customs can record trade labels – a combination of applied art and trademarks – for the purpose of monitoring infringing goods at the borders. In order to proceed with the recordal, a rights holder must declare its ownership of the registered trademark or label to Customs and appoint an agent to cooperate with Customs to identify counterfeit products. The DIP also cooperates closely with Customs and can assist Customs in identifying counterfeit goods. If customs officers detect infringing products, the agent appointed by the rights holder will be informed.

A rights holder can also initiate an inventory inspection of a shipment by submitting a request for inspection, together with evidence showing that there is reasonable cause to believe that counterfeit goods will pass through a specific customs office.

## **6. Ownership changes and rights transfers**

### **Assignment**

A trademark can be transferred to or inherited by other persons regardless of whether it is a pending or registered trademark. According to the Trademark Act, an assignment must be in writing and recorded with the registrar. A deed of assignments signed by both the assignor and assignee and a notarised power of attorney of the assignee are required for recordal of an assignment.

### **Licensing**

A registered trademark can be licensed to other persons. The licensing agreement must be in writing and recorded with the registrar. Moreover, the notarised power of attorney and

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the original certificate of registration are required as evidence of the existence of the trademark.

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## 7. Related rights

The sphere of protection established by trademark legislation overlaps to some degree with other IP rights. In principle, a product design that has been applied for as a design patent can also be protected as a three-dimensional mark or trade dress. Similarly, a pictorial, graphic or sculptural work that passes the bar of originality and creativity under copyright law would usually be deemed to be distinctive enough to earn trademark protection. In this regard, owners of unregistered trademarks may resort to copyright lawsuits as an available course of action.

However, due to the overlapping protection between design patents and trademarks, the DIP tends to be reluctant to regard any three-dimensional object as sufficiently distinctive to be eligible for trademark protection. Under existing ministerial guidelines a three-dimensional object may be protected as trade dress only when it is truly capable of functioning as a designation of origin and does not suggest its utility function. For example, a bottle-shaped article, although distinctively contoured, is unlikely to be accepted for registration as a three-dimensional mark because, by having the shape of a container, it inherently suggests its function as a container.

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## 8. Online issues

In 2007 Thailand passed the Computer Crime Act, which addresses most online issues. The act provides extensive protection for online users from various types of computer crime, including phishing, spam mail, malware and even the input of incorrect or false information. The crimes set out by the act can be subject to both criminal and civil action. Issues relating to electronic commerce are governed by the Electronic Transactions Act, which specifically deals with electronic commerce and online transactions.

However, no legislation specifically regulates online trademark infringement. If a company uses its corporate name as a trademark, it has an available course of action under the doctrine of wrongful appropriation of a person's name pursuant to Section 18 of the Civil and Commercial Code. This provision states that a person whose rights to use a name are contested by another party or whose interest is injured by such unauthorised use may demand that the unauthorised user cease such use and compensate the rights holder for damages incurred.

### Administration of domain names

The Thailand Network Information Centre (THNIC) oversees all '.th' domain name registrations in Thailand. Under the THNIC's requirements, an overseas business entity which wishes to register its corporate name as a domain name must appoint a representative in Thailand; where the company's trademark is to be used as a domain name, it must have a valid trademark registration in Thailand.

Although the THNIC administers the registration of domain names on a first to register basis, it reserves the right to take down or cancel domain names that have been registered on the basis of false information or that have been used for illegal purposes. However, the THNIC does not provide any dispute settlement mechanism for conflicts over ownership of domain names and the party with the stronger right to a domain name must secure a court order to compel the THNIC to act in its favour.

**DEJ-UDOM & ASSOCIATES**  
**ATTORNEYS-AT-LAW**  
**&**  
**IP-AT-LAW**

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|---------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Unregistered rights</b><br>Protection for unregistered rights?                                                   |                                                                                           |
| Specific/increased protection for well-known marks?                                                                 | But well-known marks should be recorded at the Department of Intellectual Property                                                                                           |
| <b>Examination/registration</b><br>Representative requires a power of attorney when filing?<br>Legalised/notarised? | But power of attorney can be submitted after filing (notarisation)                                                                                                           |
| Examination for relative grounds for refusal based on earlier rights?                                               |                                                                                           |
| Registrable unconventional marks                                                                                    | 3-D, colours, shapes, slogans                                                                                                                                                |
| <b>Opposition</b><br>Opposition procedure available? Term from publication?                                         | 90 days                                                                                                                                                                      |
| <b>Removal from register</b><br>Can a registration be removed for non-use?<br>Term and start date?                  | 3 years' non-use prior to date of petition for cancellation                                                                                                                  |
| Are proceedings available to remove a mark that has become generic?                                                 |                                                                                          |
| Are proceedings available to remove a mark that was incorrectly registered?                                         |                                                                                         |
| <b>Enforcement</b><br>Specialist IP/trademark court?                                                                | Central Intellectual Property and International Trade Court                                                                                                                  |
| Punitive damages available?                                                                                         | Under product safety and consumer protection laws                                                                                                                            |
| Interim injunctions available? Time limit?                                                                          |                                                                                         |
| <b>Ownership changes</b><br>Is registration mandatory for assignment/licensing documents?                           |  /  |
| <b>Online issues</b><br>National anti-cybersquatting provisions?                                                    |                                                                                         |
| National alternative dispute resolution policy for local ccTLD available?                                           | ADR available at discretion of parties.                                                                                                                                      |