

DEJ-UDOM & ASSOCIATES

ATTORNEYS AT LAW & IPs-AT-LAW

Dej-Udom & Associates was founded in 1986 by Atty. Dej-Udom Krairit who was President of the Intellectual Property Association of Thailand in 1980 – 1986, Vice President of the Asian Patent Attorney Association in 1985-1986, President of the Inter-Pacific Bar Association in 1999-2000, and President of the Lawyer Council of Thailand in 2004-2010. Our Intellectual Property Department is committed to providing quality legal services for foreign and local multinational companies and individuals. Our practices cover every aspect of all IP matters including, but not limited to, filing, prosecution, licensing, renewal, enforcement, due diligence services, search and investigation of infringement, and litigation.

Our experienced IP lawyers, counselors, litigators and engineers who are members of various IP related organizations including International Trademark Association (INTA), Asian Patent Attorney Association (APAA), International Association for The Protection of Intellectual Property (AIPPI), and Asean Intellectual Property Association, are readily available to render all IP services at your disposal.



Our services include

- Intellectual Property
- Business Start-ups
- Immigration and Employment
- Corporate & Taxation
- Labor and Dispute Resolution
- Litigation & Arbitration
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Contact us

Address: 942/142-3 Charn Issara Tower I, 9th Fl.
Rama IV Road, Bangrak, Bangkok
Thailand 10500

Tel: (662) 233-0055

Fax: (662) 236-6681, (662) 233-0227, (662) 233-0097

Website: [http:// www.dejudomlaw.com](http://www.dejudomlaw.com)



Thailand

Contributing firm
Dej-Udom & Associates

Authors
Dej-Udom Krairit
Founder and managing director

Pondej Krairit
IP department director



1. Legal framework

National

Trademark registration in Thailand is governed by the Trademark Act BE 2534 (1991) and its subsequent amendment, 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 the specific laws, the Penal Code, the Civil and Commercial Code, the Consumer Protection Act and other ministerial regulations are also essential in enforcing trademark rights. These statutes allow the owner of a registered trademark to take legal action in order to stop the infringement and/or claim redress damages.

International

Thailand is a member of the World Intellectual Property Organization and the World Trade Organization, and a signatory to the Agreement on Trade-Related Aspects of Intellectual Property Right (TRIPs). In line with these international treaties, the trademark legislation has been amended and the Central IP 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, and it became bound by the convention on August 2 2008. Thailand is not yet a member of the Madrid Protocol but preparations to harmonize domestic laws with the protocol regulations are underway.

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, even though unregistered, is legally protected under Section 8(10) of the Trademark Act. 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 sold, 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.

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, the scope of protection extends to combinations of colours, three-dimensional marks and geographical indications. Other types of non-traditional trademark such as olfactory, sounds and tastes are not yet recognized 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 other prior registered trademarks.

A mark which includes and characteristics of national flags, official symbols or emblems, royal names or pictures or any immoral elements, or which 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. (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.

A multi-class application is not available and a separate application is required to be filed for each class and the Madrid Protocol – one application cannot be filed for multiple classes. The specification of goods or services must be specifically itemized in the application. If the goods or services are too broadly specified, the registrar may request further details and amendment.

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

A three-dimensional mark is also available for registration. However, representations of the mark in all dimensions are required to 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 a 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 which use it.

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 persons believe that the published mark is identical or confusingly similar to their marks or does not fulfill the registrability requirements.

If they are unhappy with the registrar's decision on the opposition, the applicant or the opposing party is entitled to 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, it can file an appeal with the Central IP and International Trade Court within 90 days of receipt the decision.

If there is no opposition from any interested party, the registrar will request payment of 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 any interested party. Once the trademark is registered, the trademark owner 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-years periods. A renewal request must be lodged in the 90 days before the expiration of the registration term. If the owner of the trademark fails to renew, the mark shall be removed from registration.

Removal from register

A registered trademark may be removed from the register by either the Trademark Committee or the court. At Trademark Committee level, a registered trademark can be cancelled from the register upon a request of any interested person or the registrar on the grounds that the mark;

- is non-distinctive;
- is a prohibited mark;
- is identical to an existing registered marks for related goods or services;
- is confusingly similar to an existing registered marks for the 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.

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 IP and International Trade Court for such cancellation within five years from the date of registration. Another ground for cancellation is that the registered mark has become common to the trade. In such cases any interested person or the registrar can petition the Trademark Committee at any time.

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. The applicant can conduct a search for pending or registered trademarks which are identical or similar to its mark in all classes at the DIP or via online service. The DIP database is searchable for either word marks or 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.

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 associations including the Intellectual Property Association of Thailand and the Intellectual Property Promotion Association of Thailand, has devoted considerable efforts towards providing knowledge and raising awareness of the importance of IP right. 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 filling an opposition to the registration of a similar mark under a pending application or by pursuing a cancellation action against a mark registered in bad faith.

Civil enforcement

The Trademark Act recognizes the need for prompt measures to minimize the damage suffered by trademark owners and thus allows an injured party to obtain, prior to the 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 useful, the standard of proof required to provide this injunctive relief may be difficult to achieve, compared to the enforcement mechanisms under criminal law which empower the police to confiscate infringing goods following a raid.

Trademark owners are entitled to monetary damages as well as permanent injunctions against future infringement.

Furthermore, if the infringing party has registered the mark with the Trademark Office, the trademark owner 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 willful infringement.

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

Criminal prosecution

Trademark infringement is recognized 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 importation and offering for sale of counterfeit products. However, while the Trademark Act concerns only trademarks registered in Thailand, the Penal Code protects 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 since it offers certain advantages over civil action, especially for foreign trademark holders, as follows:

- 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 is 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 which 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 trademark owner 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 anti-infringement efforts Customs can record trade labels – a combination of applied art and trademarks – for the purpose of monitoring infringing goods at the border. In order to proceed with the recordal, an owner 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 counterfeiting goods. If customs officers detect infringing products, the agent of the mark owner will be informed.

A trademark owner 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 registered with the registrar. A deed of assignments signed by both the assignor and assignee and a notarized 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 registered with the registrar. Moreover, the notarized power of attorney and the original certificate of registration are required as an evidence of existence of the trademark.

7. Related rights

The sphere of protection of the trademark legislation overlaps to some degree with other IP rights and copyright. In principle, a product design which 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 which 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 cause of action.

However, due to the overlapping protection between design patents and trademarks, the Trademark Office tends to be reluctant to regard any three-dimensional object as sufficiently distinctive as 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:

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 cause of action under the doctrine of wrongful appropriation of a person's name pursuant to Section 18 of the Civil and Commercial Code, which provides that a person whose rights to use a name are contested by another party or whose interest is injured by such unauthorized use may demand that the unauthorized 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 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 THNIC administers the registration of domain names on 'first to register' basis, it reserves the right to take down or cancel domain names which have been registered on the basis of false information or which have been used for illegal purposes. However, 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 THNIC to act in its favour.

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Unregistered rights Protection for unregistered rights?	
Specific/increased protection for well-known marks?	
Examination/registration Representative requires a power of attorney when filing? Legalized/notarized?	/
Examination for relative grounds for refusal based on earlier rights?	
Registrable unconventional marks	3-D, colours, shape
Opposition Opposition procedure available? Term from publication?	3 months
Removal from register Can a registration be removed for non-use? Term and start date?	3 years' non-use prior to cancellation
Are proceedings available to remove a mark that has become generic?	
Are proceedings available to remove a mark that was incorrectly registered?	
Enforcement Specialist IP/trademark court?	
Punitive damages available?	
Interim injunctions available? Time limit?	
Ownership changes Is registration mandatory for assignment/licensing documents?	/
Online issues National anti-cybersquatting provisions?	actions may be available
National alternative dispute resolution policy (DRP) for local ccTLD available?	