

**TWO-MONTH STUDY-CUM-RESEARCH
FELLOWSHIP PROGRAM (FY 2019)**

October – December 2019

Research Theme

**Enhance the Trademark Examination Procedure
and Evaluating the Possibility Similar Group Code
in Thailand**

By

Miss Chayaknit Kanchanakaroon
Department of Intellectual Property (DIP), Thailand

Supervised by

Dr. Yorimasa Suwa
Asia-Pacific Industrial Property Center (APIC)
Japan Institute for Promoting Invention and Innovation (JIPII)

Advised by

Miss Hiroko Hirayama
Asamura Patent Office

The views and findings in this report are those of the author and do not necessarily reflect the views and policy of the organization or sponsor of this study.

Abstract

Trademark is the symbol that producer of goods and services would like to present to their customers. Trademark will have the distinctive characteristics that customer can distinguish the goods and services from the others. According to trademark application, not only consist of the trademark symbol, but also list of goods and services. In case of list of good and services, some of the list do not indicate clearly in the application. Some of the designated goods and services list indicated clearly but their characteristics or purposes related or very similar to the prior trademark application in different classes which it causes to difficulty for searching similarity on designated goods or services.

According to Similar Group Code, it is the group of numbers and alphabets for Japan Patent Office trademark examiner to indicate the goods, services or goods and services which considering that they will similar to each other or not. Regarding to the concept, it will be the criteria that can adapted and use in Thailand. In addition, it will assist Thailand trademark examiner for searching correct and accurate goods and services.

In this research, the researcher would like to make some example or criteria related to Similar Group Code. Therefore, we use qualitative research method that consist of interview and content analysis. In case of interview method, we interview the stakeholder that related to trademark registration process from applicant and representative side. In addition, we use content analysis method to review and analyze Similar Group Code from “Examination Guidelines for Similar Goods and Services (corresponding to the Nice Classification, 11th Edition, Version 2019)” book and Japan Platform for Patent Information website (J-PlatPat).

As a result of this research, we found that Similar Group Code that use in Japan Patent Office can adapted and use in Thailand. In addition, we would like to have the committee to decide and create Similar Group Code that proper to Thailand trademark registration system and operate them in the future.

Tables of contents

Abstract	i
List of figures	iv
List of tables	iv
 Chapter 1: Introduction	
1.1 Problem consciousness	1
1.2 Current understanding	2
1.3 Study design	2
1.4 Expected findings	3
1.5 Expected contribution	3
 Chapter 2: Basic information and previous study	
2.1 Overview of Thailand's trademark registration process	
2.1.1 Functions and activities in Trademark Office	4
2.1.2 Current practice for trademark examination in Thailand	7
2.2 Overview of Japan's trademark registration process	8
 Chapter 3: Methodology of the study	11
 Chapter 4: Result and analysis	
4.1 Result	
4.1.1 List of the questions and response from members of JIPA and JPAA	13
4.1.2 JPO Similar Group Code review	14
4.2 Analysis	
4.2.1 Thailand trademark examination	16
4.2.2 JPO Similar Group Code	17

Chapter 5: Implications and the recommendations to IP office or IP stakeholders in your country

5.1 Example of Similar Group Code that will be adapted in Thailand	21
5.1.1 Example of Similar Group Code for Class 16	22
5.1.2 Example of Similar Group Code for Class 23	24
5.2 Implication in Thailand Trademark office	25
Acknowledgement	27
References	28
Appendix I Minute of the interview: Member Companies of Trademark Committee in Japan Intellectual Property Association (JIPA)	I
Appendix II Minute of the interview: Member of Japan Patent Attorneys Association (JPAA)	V
Appendix III Research feedback from DIP colleagues	IX

List of Figures

Figure 2.1	Function of Trademark Office	8
------------	------------------------------	---

List of tables

Table 2.1	Thailand's trademark examiner and trademark registrar responsibilities	7
Table 2.2	Example for list of goods and services with Similar Group Code	11
Table 3.1	List of the Questions for the interview	13
Table 4.1	Similar group code review for goods in class 16	16
Table 4.2	Similar group code review for goods in class 23	18
Table 5.1	Example of Similar Group Code for class 16	24
Table 5.2	Example of Similar Group Code for class 16 when related to other classes	25
Table 5.3	Example of Similar Group Code for class 16 when related to other classes and class 35	25
Table 5.4	Example of Similar Group Code for class 23	26
Table 5.5	Example of Similar Group Code for class 23 when related to class 35	27

Chapter 1

Introduction

1.1 Problem consciousness

Trademark is the symbol that producer of goods or services would like to present to all of their customer which will be consist of word, design, number, color, shape or packaging of goods, sound or mixing these components in one trademark. The trademark that the applicant would like to be filing, it will have the distinctive characteristics that customer can distinguish the goods or services from the others. According to trademark application, not only consist of the trademark symbol, but also list of goods and services that based on Thailand's list of goods and services or reference to international classification of goods and services (Nice Classification). In case of list of good or services, some of the list do not indicate clearly in the application. Some of the designated goods or services list indicated clearly but their characteristics or purposes related or very similar to the prior trademark application in different classes that causes to difficulty for searching on designated trademarks and goods or services of trademark examiner and trademark registration requirement, which related to trademark registrar decision.

According to trademark examiner process for searching designated trademarks that consist of list of goods or services, nowadays, we search the trademark in their own class and related classes. For example, if the applicant filing "essential oils" in class 3 as one of the lists of goods in trademark application, trademark examiner will search the trademark in class 3, 35 and 44. Because class 3 is the class of itself, class 35 related to conveniently view for customer to purchase the goods (WIPO IP PORTAL, n.d.-a) such as wholesale or retail store and class 44 which "essential oils" is the one of spa or beauty services accessories. Regarding to trademark examiner responsibilities are translate, examine distinctiveness and likelihood of trademark confusion and send to trademark registrar. Each examiner has knowledge about related classification for trademark searching that reference from trademark examiner guideline. But this knowledge and some related classes do not compile in the same place. In order to the same direction of trademark examination, work efficiency for all of their colleagues and maybe reduce the examination period of trademark registrar to consider the trademark that will be registered or not, especially for the list of goods and/or services, it will be making some example or criteria which included in trademark examination guideline for trademark examiner with correct and accurate goods or services classification which can adapted and use in Thailand in the future.

According to Similar Group Code concept on Japan Patent Office website (Japan Patent Office, Trademark Division, 2019), initially, it is the assistant for Japan Patent Office trademark examiner to search trademark that the goods and/or services characteristics or purpose are very similar to the prior trademark application even though they come from different goods or services classes. If the Similar Group Code of goods and/or services are the same, they will be assumed that they are related. In addition, this concept will arrange the same characteristics or purpose of goods and/or

services in one group which help Japan Patent Office trademark examiners to narrow down the list of goods and/or services which they will consider that the trademark will register or not.

According to the concept of examination guideline for trademark examiner related to goods or services classification and Similar Group Code, if it is possible to combine this concept together, adapt and use in Thailand, it will advantage to trademark examiner and registrar performance and trademark examination procedure period will be faster and more efficiency.

1.2 Current understanding

According to my understanding, Thailand's trademark examiner process for searching designated trademarks that consist of list of goods or services, nowadays, they search the trademark in their own class and related classes. Each examiner has knowledge about related classification for trademark searching that reference from trademark examiner guideline. But this knowledge and some related classes do not compile in the same place. In order to the same direction of trademark examination, work efficiency and will reduce the examination period of trademark registrar to consider of trademark that will be registered or not, especially for the list of goods and/or services, it will be making some example or criteria which included in trademark examination guideline for trademark examiner with correct and accurate goods or services classification.

In addition, in Thailand do not have the system to narrow down the list of goods and/or service for trademark registrar consideration. If the Similar Group Code can adapt and use for trademark examination in Thailand, it will help trademark registrar to work faster and more efficiency.

1.3 Study design

The prospect methodologies are data collection and interview with the person that relating to trademark examination procedure such as trademark examiner and registrar in Thailand and the person that knowledgeable in trademark examiner guideline and Similar Group Code system in Japan.

However, the definition of authorize person in Thailand that related to trademark examination procedure will be described below:

- **Trademark examiner** is the person who translate meaning of the words in trademark, examine distinctiveness and likelihood of trademark confusion for domestic and international trademark application under Madrid Protocol and send trademark examination report to trademark registrar

- **Trademark registrar** is the person who can double-check related to translate meaning of the words in trademark, trademark distinctiveness, likelihood of trademark confusion, check for all of document which filing before trademark will be register, such as, power of attorney, juristic person document, applicant identity card. Then, considering of related law and regulation. If the application meets all of conditions, trademark registrar will send the application to Gazette and Certificate group to announce in the gazette. If the application does not meet some of the conditions, trademark registrar will issue trademarks notification or letter to the applicant. Then, send to Monitor Section to issue notification of refusal and send to applicant or representative which filing the application in Thailand. In case of international trademark application which indicate Thailand as designated country under Madrid Protocol, trademark registrar will send trademarks notification or letter in English to International Bureau or World Intellectual Property Organization (hereinafter “WIPO”) directly by computer system.

In addition, when it has some content that reference to trademark examiner in Japan Patent office (hereinafter “JPO”), it will use “JPO trademark examiner” in this report.

1.4 Expected findings

The finding will give useful information to making some example or criteria which included in trademark examination guideline for trademark examiner with correct and accurate goods and/or services classification and example of Similar Group Code model for trademark examination procedure, which can adapt and use in Thailand in the future.

1.5 Expected contribution

- 1) The example or criteria which included in trademark examination guideline for trademark examiner with correct and accurate goods and/or services classification, which can adapt and use in Thailand in the future.
- 2) The example of Similar Group Code model for trademark examination procedure, which can adapt and use in Thailand in the future.

Chapter 2

Basic information and previous study

2.1 Overview of Thailand's trademark registration process

2.1.1 Functions and activities in Trademark Office

In Thailand, trademark registration process will start from the applicant filing trademark application to Department of Intellectual Property (DIP). Then, it will be sent to Trademark Office sections to proceed the registration process. In Trademark Office, we have 15 groups that will be described below:

- 1) **Receiving Application and Related Services Group** has authorities to receive trademark application from the applicant, give some advices and primary trademark search services before filing application and issue the document related to trademark registration certificate.
- 2) **Transliteration and Monitor Group** that can divide into 2 sections:
 - 2.1) **Transliteration Section** will receive trademark application from Receiving Application and Related Services Group and Examination 7 Group (Madrid Protocol). Then, they will transliteration for pronunciations of the mark, define and recording figurative element that reference from Vienna Classification Code and send to trademark examiner.
 - 2.2) **Monitor Section** will issue notification of refusal and send to applicant or representative which filing the application in Thailand. In addition, monitor trademark registration period and dispose of trademark application when the applicant did not file the application related to notification of refusal.
- 3) **Examination Group** which have 7 groups and can divide into 2 sections:
 - 3.1) **Examination 1-6 Group**, in each group consist of 2 types of staffs.
 - **Trademark examiner** is the person who translate meaning of the words in trademark, examine distinctiveness and likelihood of trademark confusion for domestic and international trademark application from Madrid Protocol (hereinafter “international trademark application”). Then, trademark examiner will send trademark examination report to trademark registrar.
 - **Trademark registrar** is the person who can double-check related to translate meaning of the words in trademark, trademark distinctiveness, likelihood of trademark confusion, checking related document that filing before trademark will be registered, such as, power of attorney, juristic person document, applicant identity card. Then, considering of related law and regulation. If the application meets all of conditions, trademark registrar will send the application to Gazette and Certificate Group to

announce in the gazette and counting for opposition period. If the filing trademark did not have any opposition, the application will be registered. If the application does not meet some of the conditions, such as, filing trademark and prior trademark appearance and class of lists of goods and/or services are identical or similar and/or lists of goods and services are too broad, trademark registrar will issue trademarks notification or letter to the applicant. Then, send to Monitor Section in Transliteration and Monitor Group to issue notification of refusal and send to applicant or representative which filing the application in Thailand.

3.2) **Examination 7 Group (Madrid Protocol)** have responsibility for the trademark application that related to Madrid Protocol. In this research, we focus on inbound application that indicate Thailand as designated countries, this group consist of 2 types of staffs.

- **Supporting staff** is the person who translate list of goods and services and related information to Thai language, generate trademark domestic application number and send to Transliteration Section in Transliteration and Monitor group.
- **Trademark registrar** is the person who can double-check related to translate meaning of the words in trademark, trademark distinctiveness, likelihood of trademark confusion, checking related document that filing before trademark will be registered from WIPO, such as, limitation for list of goods and services, transfer document and change in name and/or address of applicant. Then, considering of related law and regulation. If the application meets all of conditions, trademark registrar will send the application to Gazette and Certificate Group to announce in the gazette. Then, the computer system will create the form to inform date of opposition period in English. After that, trademark registrar will send this document to WIPO. If the filing trademark did not have any opposition, the application will be registered. If the application does not meet some of the conditions, such as, filing trademark and prior trademark appearance, class of lists of goods and/or services are identical or similar and/or lists of goods and services are too broad, trademark registrar will issue trademarks notification in English and send to WIPO.

4) **Gazette and Certificate Group** has authorities to review all of application information before announce in the gazette, announce application information in the gazette and issue trademark registration certificate and send to applicant or representative in Thailand by mail.

Table 2.1 Thailand's trademark examiner and trademark registrar responsibilities

No.	Responsibilities	Types of trademark office staff that related to trademark examination	
		Trademark examiner	Trademark registrar
1.	Translate meaning of the words in trademark	✓	They can double-check when receive trademark examination report
2.	Examine distinctiveness of trademark	✓	
3.	Examine likelihood of trademark confusion	✓	
4.	Send trademark examination report to trademark registrar	✓	
5.	Check all of document that filing before trademark application will be registered		✓
6.	Considering of related law and regulation		✓
7.	Send the application to Gazette and Certificate Group to announce in the gazette		✓
8.	Issue trademarks notification or letter to the applicant in case of the application does not meet some of the conditions, such as, filing trademark and prior trademark appearance, lists of goods and/or services are identical or similar and/or lists of goods and services are too broad		✓

- 5) **Opposition Group** has authority to receive the document from opponent and the applicant during opposition period. Then, the staff of this group will consider related document and send the decision to both parties.
- 6) **Alteration Group** has authority to change registered trademark information by applicant request such as transfers, change in name and/or address of applicant or name and/or address of representative.
- 7) **Renewal Group** has authority to examine the document that related to registered trademark renewal, issue trademark registration certificate and send to applicant or representative.
- 8) **Administration Group** has authorities to receive and sending letter that related to the office and coordinate with staff and others office in the department.

- 9) **Geographical Indication Group** has authorities to advise and disseminate the knowledge related to Geographical Indication and examine the document that related to Geographical Indication goods

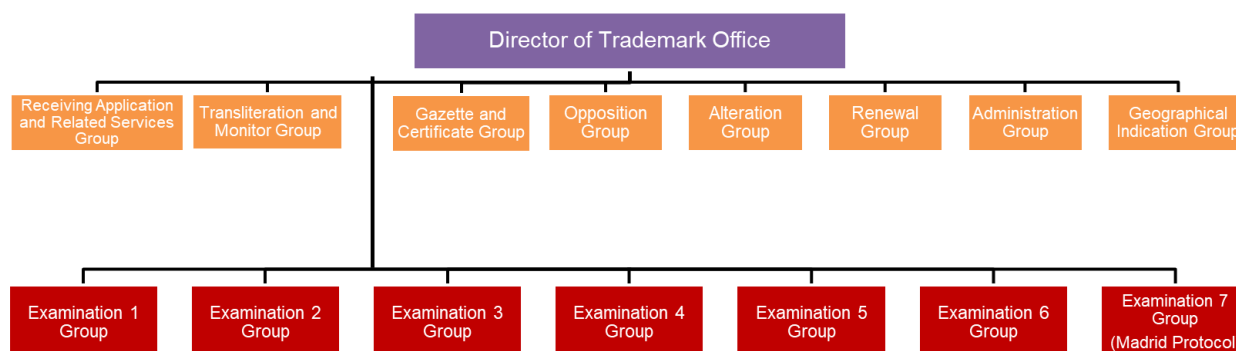


Figure 2.1 Function of Trademark Office

2.1.2 Current practice for trademark examination in Thailand

According to functions and activities in Trademark Office, we can consider that trademark examiners are the important person in trademark examination process because they have responsibilities to examine distinctiveness and likelihood of trademark confusion for domestic and international trademark application. They will examine and compare lots of goods and services in the application. In case of domestic application, some applicant did not indicate list of goods and services clearly, such as, “computer peripherals” that can be Computer keyboards, Computer mouse, Computer printer and so on. In addition, international trademark application, some of applicant will merge list of goods and service together instead of separate to each of goods and/or services. For example, “Assistance for industrial or commercial enterprises, assistance to individuals in business activities” which can separate into 3 lists of services, namely, Business management assistance for industrial enterprises, Business management assistance for commercial enterprises, Business management assistance for individuals.

Nowadays, trademark examiner will examine filing trademark by Cross Search method. This method will start from trademark examiners receive the trademark application and look at list of goods and services. When they find some classes that will be similar to the application that reference from trademark examiner guideline, they will put the related class to examine. For example, if the applicant filing “essential oils” in class 3 as one of the lists of goods in trademark application, trademark examiner will search the trademark in class 3, 35 and 44. Because class 3 is the class of itself, class 35 related to conveniently view for customer to purchase the goods (WIPO IP PORTAL, n.d.-a) such as wholesale or retail store and class 44 that “essential oils” is the one of spa or beauty services accessories. In case of, Cross Search method in Thailand, trademark examiners will examine distinctiveness and likelihood of trademark confusion for domestic and

international trademark application and consider the related list of goods and services by their judgement, such as, purposes of lists of goods and services, the place that provided goods and services or materials. And then, they will send trademark examination report to trademark registrar.

When trademark registrars receive the report, they can double-check distinctiveness and likelihood of trademark confusion again, if they need. Then, considering to related law and regulation that meet all of conditions or not. If the application meets all of conditions, trademark registrar will send the application to Gazette and Certificate Group to announce in the gazette. If not, for domestic application, trademark registrar will issue trademarks notification or letter to the applicant. Then, send to Monitor Section to issue notification of refusal and send to applicant or representative. In case of international trademark application, trademark registrar will issue trademarks notification in English and send to WIPO.

2.2 Overview of Japan's trademark registration process

According to Japan Patent Organization Chart (Japan Patent Office, 2015), this organization has many divisions that related to intellectual property registration procedures. In case of trademark registration, Trademark and Customer Relations Department will in charge of it. For example, receive trademark application from applicant, check and examine applicant necessary document (Japan Patent Office, n.d.-c), assigning Similar Group Code for list of goods and services, substantive examination by JPO trademark examiners with Cross Search method (International Trademark Classification Office, Trademark Division, Japan Patent Office, 2019). Then, JPO trademark examiners will examine distinctiveness of filing trademark by compare with prior trademark that related to list of goods and services, words, figure and appearance of trademark and consider that both of them are similar or not. Then, JPO trademark examiner will considering to related law and regulation. If the filing trademark did not have reason to refusal, it will be registered. In contrast, if the filing trademark have reason for refusal, applicant will be amendment (Trademark Examination Standards Office, Trademark Division Japan Patent office, 2019).

Similar Group Code is the group of numbers and alphabets that can indicate the goods, services or goods and services which consider that they will similar or related to each other. Not only in the same class, but also in different classes (Japan Patent Office Trademark Division, 2019). In addition, Similar Group Code will separate list of goods and services which did not related. It has criteria to create Similar Group Code which call "Tanzaku" system. Tanzaku consist of 3 sets of alphabet and numbers. First set of Tanzaku is "Class" of goods and/or services that indicate by 2 digit numbers. For examples, "05" for goods in class 5 and "35" for services in class 35. Second, "Main class" in each class of goods or services that instead with English capital alphabet. For examples, "05A" for fuel which is the goods in class 5. The last set of criteria is "Intermediate class" in each class of goods or services that indicate by 2 digit numbers. For example, "05A01",

“05” for class 5, “A” is main class in class 5 that means Fuel and “01” stand for solid which is the type of fuel.

According to similarity of goods, services or goods and services that will make confusion to consider that the goods and/or services are similar or not, JPO has the criteria to categorize below (Japan Patent Office. (n.d.-a):

1) Similarity of goods

- (1) Whether they correspond in production stage.
- (2) Whether they correspond in stage of sales.
- (3) Whether they correspond in materials and quality.
- (4) Whether they correspond in intended purpose.
- (5) Whether they correspond in a range of consumers they are targeted at.
- (6) Whether they are in a finished-product-and-parts relationship.

2) Similarity of services

- (1) Whether they correspond in the manner, purpose and place of their provision.
- (2) Whether they correspond in articles connected with their provision.
- (3) Whether they correspond in the range of consumers and customers they are targeted at.
- (iv) Whether they correspond in the category of their business.
- (v) Whether they correspond in laws regulating business relating to the services concerned and their business operators.
- (vi) Whether they are provided by business operators in the same category of business.

3) The similarity of goods and services

- (1) Whether it is common for the same business operator to engage in the production and sales of goods and in the provision of services.
- (2) Whether the goods and services correspond in intended purpose
- (3) Whether the goods and services correspond in the points of sales of the goods and provision of the services.
- (4) Whether the goods and services correspond in a range of consumers and customers they are targeted at.

According to the criteria, please see the examples in table 2.2 (Japan Patent Office, n.d.-b)

Table 2.2 Example for list of goods and services with Similar Group Code

No.	List of goods and services with Similar Group Code	Note
-----	--	------

	Class	Goods/ Services	Similar Group Code	Class	Goods/ Services	Similar Group Code	
1	12	Aircraft	12A02	12	Automobiles	12A05	Initially, these goods are separate by vehicle categories or finished-product-and-parts relationship
2	43	Providing alcoholic beverages	42B01	43	Providing Japanese cuisine	42B01	Initially, these services are correspond in the category of their business.
3	25	Clothing	<u>17A01 17A02</u> <u>17A03 17A04</u> <u>17A07</u>	35	Retail services for clothing	<u>17A01 17A02</u> <u>17A03 17A04</u> <u>17A07 35K02</u>	Initially, they are the goods and services correspond in the points of sales of the goods, provision of the services and same customers they are targeted at.

Relating to input of Similar Group Code for goods and services, they can separate into 2 directions. The first one is national application. Similar Group Code will assign automatically before substantive examination by “Check Table” which is the database of goods and services. If list of goods and/or services cannot assign by the system cause of indication do not match with the database, International Trademark Classification Office will assign Similar Group Code by referring the codes that adopted in the past. Another path is international trademark application. In this case, JPO has Japan Patent Information Organization (hereinafter “JAPIO”), JPO’s outsource organization, to arrange and translating important data such as translating designated goods and services, description of the marks in English to Japanese and assign Similar Group Code to the application with specific database before sending to JPO. Then, JPO trademark examiner will conduct the trademark examination and considering trademark’s law and regulation later.

According to the trademark examination procedure in Japan, we can imply that Similar Group Code is the important tool for trademark examination because it will be assign for list of goods and services that will effect to JPO trademark examiner decision to issue notification of refusal or allow the application to be registered.

Chapter 3

Methodology of the study

According to this research related to enhancing the trademark examination procedure and evaluating the possibility of Similar Group Code in Thailand, we will use qualitative research method.

In this research, we would like to make some example or criteria which included in trademark examination guideline for trademark examiner with correct and accurate goods or services classification to enhancing trademark examination. Therefore, we will use interview method to interview stakeholder that related to trademark registration process. They are 2 groups of interviewees which are the user of trademark registration. First, 7 member companies from Trademark Committee in Japan Intellectual Property Association (hereinafter “JIPA”) which is the applicant side. Second, 2 members of Japan Patent Attorney Association (hereinafter “JPAA”) which is the representative side. These 2 interviewee groups, they will be asked to the same questions that will be described below.

Table 3.1: List of the Questions for the interview

No.	List of the Questions
1.	How is the satisfaction of the JPO's Trademark examination? 1.1 Indicate designated goods and/or services and Similar Group Code 1.2 Quality management 1.3 Others (please specify)
2.	According to JPO's trademark examination, are there any problem or issue that should be resolved? If yes, please specify. 2.1 Indicate designated goods and/or services and Similar Group Code 2.2 Quality management 2.3 Others (please specify)
3.	The IT tools, and information relate to Trademark Examination, that provide through JPO's website, how is the satisfaction of them?
4.	Have you ever filed the trademark applications in Thailand? (Filing application by representative in Thailand, Madrid Protocol or both) If yes, what is your opinion on Thailand's trademark examination?
5.	Do you have any suggestion about Thailand's trademark examination? If yes, please specify.

According to Table 3.1, the answer of these questions will be included the experience of the interviewee from trademark registration in their country and Thailand. Because we would like to receive all of opinion. Not only advantage, but also disadvantage from the stakeholders to compare, analyze and develop some criteria that can efficiency to the users and trademark registration procedure in the future. Regarding to the questions, it has many topics in the same list such as quality management, IT tools,

designated goods and/or services and trademark examination in Thailand. But in case of this research, we will focus on designated goods and/or services and trademark examination procedure especially in Thailand.

In addition, we use content analysis method in this research to review and analyze Similar Group Code in class 16 and 23. Because Similar Group Code in these classes have relationship in their own class and other classes which imply that the goods and services will be similar. In case of information, we reference from “Examination Guidelines for Similar Goods and Services (corresponding to the Nice Classification, 11th Edition, Version 2019)” book (hereinafter “JPO Examination Guidelines current version”) and “Goods/Service Name Search” with International Classification 11-2019 Edition (Applicable to applications beginning on January 1 2019) on Japan Platform for Patent Information website (herein after “J-PlatPat current version”).

Chapter 4

Result and analysis

According to stakeholder interview that related to trademark registration process. They are 2 groups of interviewees which are the user of trademark registration. They are 7 member companies of JIPA trademark committee which is the applicant side and 2 members of JPAA which is the representative side. We received the experience from the user related to Japan and Thailand trademark examination. In addition, we reviewed Similar Group Code and find out the relationship of Similar Group Code in their own class and other classes which imply that the goods and services will be similar and/or related from JPO Examination Guidelines and J-PlatPat current version. These 2 methods in this research will be explain as the result and analysis to make some example or criteria that will adapted in Thailand.

4.1 Result

4.1.1 List of the questions and responses from members of JIPA and JPAA

(1) How is the satisfaction of the JPO's Trademark examination?

According to indicate designated goods and/or services and Similar Group Code, both of the user groups had experiences related to JPO designated goods and services and Similar Group Code system. It is very easy to understand.

In addition, JPAA said that sometimes, in case of the new goods and services come up, the Similar Group Code that the JPO assigned is inappropriate. Moreover, in the case of Nice Union committee's discussion on the new goods and services that should be in which class and how-to indication it. After JPO got the result of that meeting, they need to decide that which Japanese translation should be used for that term and what the Similar Group Code should be assigned. Normally, the JPO also consult with JPAA and ask for the JPAA's view. Then, if there have something which is inappropriate whether the Japanese translation or the Similar Group Code, JPAA will point out to JPO.

(2) According to JPO's trademark examination, are there any problem or issue that should be resolved? If yes, please specify.

According to indicate designated goods and/or services and Similar Group Code, the interviewees said that when someone would like to conduct the search, they will observe that goods and services are in the correct year, edition and version.

Moreover, one of JIPA member said that Similar Group Code is reviewed and amended very frequently. Sometime, lists of goods and services do not put together or put together. Maybe it difficult to grouping. Therefore, when you conduct the search some Similar Group Code you need to pay attention, what exactly year we

talking about, what specific year that trademarks were registered and you have to see what version of Similar Group Codes was use at the time of registration, in case of the prior registered trademark.

- (3) Have you ever filed the trademark applications in Thailand? (Filing application by representative in Thailand, Madrid Protocol or both) If yes, what is your opinion on Thailand's trademark examination?

According to the question, member of JIPA and JPAA had ever filed Thailand trademark application and had experiences about designated goods and services.

Regarding to one of JIPA member, he said that in case of JPO, they have Similar Group Code system. It is very easy to understand. But if we compare to Thai system, and the point of view of the user, they are not clear between goods and services. We always have considered these points, in Japan, we have Similar Group Code. If the codes are similar to others, we have to avoid to registered. It is easy how we proceed. In addition, one of JPAA said that the decision on the indication of the designated goods and services in Thailand is too strict. For example, in Thailand, they did not allow to designate “toys”, we have to designated “metal toys, plastic toys, wooden toys, electric toys...”. But the goods had sold in the market, they sold in the toy store.

- (4) Do you have any suggestion about Thailand's trademark examination? If yes, please specify.

According to the question, JPAA had collected opinion from members of the association and one of them recommend that the decision of indication of goods and services in Thailand would be less strict, clearly and easy understand. Moreover, Thai office should make sure that the decision that make by different registrars will become uniform and the criteria for that decision should be clearly and easy for everyone to understand.

4.1.2 JPO Similar Group Code review

According to Methodology of the study in Chapter 3, we focus on goods in class 16 and 23. They will be explained and separate goods by Similar Group Code in the table below.

Table 4.1 Similar group code review for goods in class 16

No.	List of goods in Class 16	Similar Group Code	Description
1.	Pastes and other adhesives for stationery or household purposes	01A02	Paste, glue or adhesive for stationery or household purposes
2.	Sealing wax	05D01	Initially, sealing wax in this class did not use for industrial purpose
3.	<ul style="list-style-type: none"> • Printers' reglets [interline leads] • Printing type 	09A11	Initially, goods in this category is apparatus related to printing
4.	<ul style="list-style-type: none"> • Addressing machines • Ink ribbons • Automatic stamp affixing machines • Electric staplers for offices • Envelope sealing machines for offices • Stamp obliterating machines • Drawing instruments • Typewriters • Checkwriters • Mimeographs • Relief duplicators • Paper shredders for office use • Franking machines • Rotary duplicators 	09D01	Machine or apparatus related to office requisite
5.	Marking templates	09G56	-
6.	Decorators' paintbrushes	13B04	-
7.	Containers of paper, for packaging	18C04	-
8.	Bags [pouches] of plastics, for packaging	18C09	-
9.	Food wrapping plastic film for household purposes	19A05	-
10.	<ul style="list-style-type: none"> • Garbage bags of paper for household purposes • Garbage bags of plastics for household purposes 	19A06	-
11.	<ul style="list-style-type: none"> • Paper patterns • Tailors' chalk 	19B03	-
12.	<ul style="list-style-type: none"> • Banners of paper • Flags of paper 	19B22	-
13.	• Hygienic hand towels of paper	19B38	-

No.	List of goods in Class 16	Similar Group Code	Description
	<ul style="list-style-type: none"> • Towels of paper • Table napkins of paper • Hand towels of paper • Handkerchiefs of paper 		
14.	Shipping tags	19B46	-
15.	Printed paper for lot, other than toy	19B47	-
16.	Paper and cardboard	25A01	Goods appearance in the form of paper or cardboard
17.	Stationery	25B01	Stationery that can separate to 4 groups: paper stationery, writing instrument [writing instruments], painters' articles and the group which did not have the name.
18.	Printed matter	26A01	Publications in the form of hard copy
19.	Paintings and calligraphic works	26B01	-
20.	<ul style="list-style-type: none"> • Photographs [printed] • Photograph stands 	26D01	-

Table 4.2 Similar group code review for goods in class 23

No.	List of goods in Class 23	Similar Group Code	Characteristics
1.	Threads and yarns, other than degreased waste threads and yarns	15A01	Made from natural and/or synthetic material such as cotton, hemp, rubber
2.	Degreased waste threads and yarns	15A03	-

4.2 Analysis

4.2.1 Thailand trademark examination

According to chapter 2, Thailand trademark examination process had explained. This process related to trademark examiner who examine distinctiveness and likelihood of trademark confusion for domestic and international trademark application and consider the related list of goods and services by Cross Search method. This method, trademark examiner will find some related classes that will be similar to the filing application that reference from trademark examiner guideline, examine and consider the related list of goods and services by their judgement. Then, they will send trademark

examination report to trademark registrar to consider related to trademark law and regulation.

Regarding to interview from JIPA and JPAA member related to indicate designated goods and/or services, when comparing list of goods and services between JPO and Thailand, JPO indication is very easy to understand. In addition, one of JPAA said that, in Thailand, the office should make sure that the decision of different registrar will become uniform and the criteria for that decision should be clearly and easy for everyone to understand.

According to basic information in chapter 2 and interview of the user. We can imply that we will create some criteria that make accuracy result for examine the list of goods and services. These criteria will be clarified and easy understanding for related staff and user. In addition, it will advantage to trademark examiner, trademark registrar performance and trademark examination procedure period will be faster and more efficiency.

Initially, as a trademark registrar opinion, most of trademark application have probability to notify for editing some list of goods and services because list of goods and services are too broad, and they can indicate to many goods in that class. This case will appear to domestic application especially trademark applicant is the foreigner and international trademark application under Madrid Protocol that send from the foreigner. Moreover, according to trademark examiner judgement for list of goods and services, sometime list of goods and services from prior trademark did not related or similar to the filing application. In addition, this topic will lead to make some example or criteria to narrow down the lists of goods and services that included in trademark examiner guideline.

4.2.2 JPO Similar Group Code

According to Similar Group Code for goods and services, especially for goods, we find that they categorized by Tanzaku system. This system separates the code into 3 sets with alphabet and numbers that will explain class of goods and services, main class and intermediate class. In addition, goods will categorize into the system by considering these 6 conditions together: production stage, stage of sales, materials and quality, intended purpose, target consumer and finished-product-and-parts relationship.

Regarding to Similar Group Code, at the first sight, we so confused that the class of goods, which are not relevant to current classification. Then, we received the data related to history of goods and services classification in Japan and lecturer from JPO International Trademark Classification Office, we just know that all of Similar Group Code of goods and services did not create in the same year and had several versions before created new Similar Group Codes for goods in 1959. Meanwhile, in 1990, Japan had accessed the Nice

Agreement. According to this criteria, JPO have their own Similar Group Code for goods around 40 years before participating in Nice Agreement, it maybe effect that Similar Group Code especially for goods do not match with current classification. For example, The Similar Group Code of “Liquid fuels” in class 4 is 05A02 (Japan Patent Office Trademark Division,2019).

According to Similar Group Code in Class 16, we found several relationships in their own class, related classes, some goods did not match with Similar Group Code and categorize in the class and some Similar Group Code maybe added some new code to assist JPO trademark examiner substantive examination.

First, the example for relationship in their own class, we found that “Containers of paper, for packaging (18C04)” is related to “Bags [pouches] of plastics, for packaging (18C09)”. According to their Similar Group Code and Tanzaku system, we can imply that, in the past, these goods were in class 18, have the same purpose as a container or carry something for packaging that will categorized in main class “C”. In contrast, they are separated for intermediate class with material condition, “04” stand for “made from paper” and “09” stand for “made from plastic”.

Second, the example for related classes relationship, we found that “pastes and other adhesives for stationery or household purposes (01A02)” maybe related some goods that have another purpose in other classes. Then, we search “01A02” in J-PlatPat current version, we found that most of the goods in the same code appear in class 1 and related to “adhesives for industrial use (01A02)”. Therefore, we can imply that the goods that very similar in the appearance, even though they are different in purpose. Then, these goods use the same code and use the code of the prior class to imply that the goods will be similar. In contrast, in JPO Examination Guidelines current version, “electronic publications (26A01 26D01)” in class 9, it is implied that it will be similar to “printed matter (26A01)” and “photographs [printed] (26D01)” in class 16. In my opinion, “publication” means “a publish work that disseminate some information, report or knowledge such as books and newspaper”. In addition, if considering of intended purpose and target consumer, electronics publications in Class 9 would have only one code, there is “26A01”, for substantive examination.

Third, some goods did not match with Similar Group Codes and their categorize in the class. In my opinion, there are 3 examples. First, “packaging material made of starch” is categorized in “container of paper, for packaging (18C04)”. Initially, in J-PlatPat current version show that it did not include in Examination Guidelines for Similar Goods and Services, but it included in the guideline by International Classification Table of Goods and Services (Nice Classification). In addition, when we search this goods in Madrid Goods & Services Manager, we found that as the Designated Contracting Party (DCP) of Madrid Protocol, Japan accepted. (WIPO IP PORTAL, n.d.-b). In my opinion, its appearance maybe looks like container of paper but for its material, it may be received new similar group code for clearly understanding and maybe accelerate JPO trademark examiner substantive examination. Second, “toilet paper” is categorized in “paper and cardboard (25A01)”. Initially, toilet paper made from paper, but if we consider to target consumer

and the purpose, it would be categorized in “Hygienic hand towels of paper, towels of paper, table napkins of paper, hand towels of paper, handkerchiefs of paper (19B38)”. And the last one, “Food wrapping plastic film for household purpose(19A05)”. Initially, when we search “19A05” in J-PlatPat current version, most of the goods in this code are related to kitchen utensils in class 8, 16 and 21. In my opinion, when considering the category name in class 16, it does not match with the goods, such as, coasters of paper, paper coffee filters. Therefore, it would be changing the name, such as “kitchen utensils for household purpose”.

According to some Similar Group Code maybe added some new code in Class 16. In my opinion, “Stationery (25B01)” consist of several type of goods that would be separate and added new Similar Group Code in each group. Regarding to JPO Examination Guidelines current version, we can imply that “Stationery (25B01)” had 4 categories in itself. There are “paper stationery”, “writing implements [writing instrument]”, “painter articles” and the last group which did not have the name. When we considering of goods in “25B01” code, we have some recommendation to assist JPO trademark examiner substantive examination. First, it maybe set the new group for “paper stationery” by change the name to “stationery in the form of pad or books” and added the new Similar Group Code. Because the goods in this category consist of “goods in the form of pad or books” such as account books and writing pads. In addition, when we go to the stationery shop, they did not place together with “writing implements [writing instrument]” and “painter articles”. Second, maybe create some new Similar Group Code for “writing implements [writing instrument]” and “painter articles”, the reasons are as same as setting the new group of “paper stationery”. Third, it maybe set the new group “others stationery” for the last category which did not have the name that consist of many goods and may not group in earlier categories, such as, inkwells, clips, thumbtacks and blackboard. In addition, JPO maybe added some new codes for “stationery” that included 4 categories similar group code like “clothing (17A01 17A02 17A03 17A04 17A07)” in class 25 that consist of all categories of clothing, namely, “non-Japanese style other clothing, coats (17A01)”, “nightwear, underwear, swimwear, swimming caps (17A02)”, “Japanese traditional clothing (17A03)”, “Sleep mask, aprons [clothing], collar protectors for wear, ... , ear muffs [clothing] (17A04)” and “nightcaps, headgear for wear (17A07)”

Regarding to the reasons that mention above, initially, if we adapted for using the Similar Group Code in Thailand, “Stationery” would be separate in 4 groups: paper stationery, writing implements [writing instrument], painter articles and others stationery.

According to another Similar Group Code that we consider, there are in Class 23. This class has only 2 Similar Group Code. Initially, they are clarified by its code. There are “threads and yarns, other than degreased waste threads and yarns (15A01)” and “degreased waste threads and yarns (15A03)”. First, “threads and yarns, other than degreased waste threads and yarns”, when we consider to the goods in this code, we can imply that the goods made from natural and/or synthetic material such as cotton, hemp and rubber. In addition, when we search “15A01” in J-PlatPat current version, most of

goods are in class 17, 21 and 23. For threads and yarn in class 17 and 21, most of them have “not for textile use” phrase that describe for each list of goods. Therefore, we can imply that, goods in class 23 have intended purpose for textile use in this class.

For another code in this class, “degreased waste threads and yarns (15A03)”. The goods included in JPO Examination Guidelines current version. In addition, J-PlatPat current version show that it included in WIPO Madrid Goods and Services Manager. Initially, from searching information on the internet, we did not find the meaning or picture of this goods. We just know that, some process of making yarns, it had some oil or lubricant to make yarn strength when it will be used in sewing procedures (Textilchemie Dr. Petry GmbH., n.d.). Basically, we can imply that it will be made from waste. In addition, this goods, maybe included in “15A01” as same as waste cotton yarns, if we consider to material of the goods.

In case of degreased waste threads and yarns (15A03), in my opinion, if these goods will be filing in Thailand, trademark examiner will search that it will be similar to thread and yarn. In addition, as a trademark registrar, we will request the applicant to sending some documents that can explain goods purpose, target customer and appearance for trademark registration consideration.

Chapter 5

Implications and the recommendations to IP office or IP stakeholders in your country

According to basic information, previous studies, result and analysis, we will conclude that Thailand trademark registration will have some criteria or condition for trademark examination especially list of goods and services. Therefore, we make some example of Similar Group Code that will be included in trademark examination guideline. In addition, it will be affected to accurate trademark examination, decrease misunderstanding for lists of goods and services and accelerate trademark examination period.

5.1 Example of Similar Group Code that will be adapted in Thailand

The structure of Similar Group Code, we will use 3 sets of number and have 2 digits in each set. The first set of code is “Class” that based on current list of goods and services in Thailand. Second, it is “Goods category in the class” that will explain which type of designated goods. The last one is “Characteristics of the goods” that will consider from 2 sets of condition. First, we consider to purpose, the place that provided goods and appearance altogether at the same time. Second, if the first condition for comparing the goods are very similar, we will consider to material of that goods.

In case of, the number that consist with 2 digits in each set of “Goods category in the class” and “Characteristics of the goods”, just in case for the future. Maybe it will have several types of goods and may be extend to 99 categories and/or characteristics in that class. In addition, in each class, it will have summarize description to explain that which kind of goods will contain in that class with Similar Group Code table.

For all of information related to these examples, we reference from “Examination Guidelines for Similar Goods and Services (corresponding to the Nice Classification, 11th Edition, Version 2019)” book and “Goods/Service Name Search” with International Classification 11-2019 Edition (Applicable to applications beginning on January 1, 2019) on Japan Platform for Patent Information (J-PlatPat) website.

5.1.1 Example of Similar Group Code for Class 16

Class 16

There are the goods that related to stationery, office requisites, goods made from paper which included packaging materials, hardcopy publications and painter articles. In contrast, this class do not include to “electronics publications” (class 9) and “adhesive for industrial purposes” (class 1).

Table 5.1: Example of Similar Group Code for class 16

Class	Goods category in the class		Characteristics of the goods		Examples	
	Description	Code	Description	Code	Goods	Code
16	Containers	01	For Packaging and made from paper or plastic	01	Paperboard boxes for packaging	160101
					Paper boxes for packaging	
					Plastic bag for packaging	
	Stationary	02	Stationery in the form of pad or books	01	Scrapbook	160201
					Notebooks	
					Writing pads	
		02	Writing instrument and parts other than painter article	02	Pen	160202
					pencil	
					Pencil point protectors	
		03	Painter articles	03	Canvas for painting	160203
					Palettes for painting	
					Clips	160204
	Paper and cardboard	03	Paper or cardboard goods that appearance in the form of itself.	01	Thumbtacks	
					Blackboard	
					Printing paper	160301
					Paper for writing	
					Color board (colored paper board)	
	Photographs	04	Photographs [printed]	01	Luminous paper	160401
					Photographs [printed]	
			Photograph stands	02	Photograph stands	160402

According to structure of Similar Group Code that mention earlier, in class 16, we start with summarize of goods in class 16. Then, we added Similar Group Code table with class numbers, description and code that stand for in each categories and examples.

In case of “Stationery” that discussed in chapter 4, initially, we would be separate in 4 groups: paper stationery, writing implements [writing instrument], painter articles and others stationery. Because when we go to the stationery shop, these goods did not place or sell together. For examples: Scrapbook did not place together with “writing implements [writing instrument]” and “painter articles”.

Table 5.2: Example of Similar Group Code for class 16 when related to other classes

Class	Goods category in the class		Characteristics of the goods		Examples	
	Description	Code	Description	Code	Goods	Code
01	Adhesive, paste, glue	01	For industrial purpose	01	Glue for industrial purposes	010101
16		05	For stationery or household purposes	01	Glue for household purposes	
09	Publication	01	Publications in electronics form	01	Downloadable electronic books	090101
16		06	Publications in the form of hardcopy	01	Books	

In case of the goods, that have similar in appearance, even though they are different in purpose. We will use the code of the earlier class to imply that the goods will be similar. For example: “Glue for household purposes” in class 16 will use the code as same as “Glue for industrial purposes” in class 1.

In contrast, some goods have the same purpose but in different form. We will use the code of the earlier class to imply that the goods will be similar too. For example: “Books” in class 16 will use the code as same as “Downloadable electronic books” in class 9.

Table 5.3: Example of Similar Group Code for class 16 when related to other classes and class 35

Class	Goods category in the class		Characteristics of the goods		Examples	
	Description	Code	Description	Code	Goods	Code
35	Retail or wholesale services	01	Retail or wholesale services	01	Retail services related to printing paper	350101, 160301
					Wholesale services related to glue for household purposes	350101, 010101

Due to services related to goods, such as “retail or wholesale services”, we will put the code of services and goods together when we conduct the search. For example, “Retail services related to printing paper”, we will put “350101” that stand for “Retail or wholesale services” in class 35 and “160301” stand for “printing paper” which is the goods that will sell in this designated service. Another example, “wholesale services related to glue for household purposes”, we will put “350101” that stand for “Retail or wholesale services” in class 35 and “010101” stand for “glue for household purposes”. In addition, retail and wholesale services can be categorize in the same code. Even though, these services are different in quantity of selling goods, the purpose and place that provided services can operation in the same owner, same place and same target customer.

5.1.2 Example of Similar Group Code for Class 23

Class 23

There are the goods that related to natural and/or synthetic threads and yarns. In contrast, this class do not include to “rubber thread, not for textile use” (class 17).

Table 5.4: Example of Similar Group Code for class 23

Class	Goods category in the class		Characteristics of the goods		Examples	
	Description	Code	Description	Code	Goods	Code
23	Threads and yarns	01	Made from natural and/or synthetic material such as cotton, hemp, rubber	01	Cotton threads	230101
					Rubber thread for textile use	
					Waste cotton yarns	
					Degreased waste threads and yarns	

According to structure of Similar Group Code that mention earlier, in class 23, we start with summarize of goods. Then, we added Similar Group Code table with code numbers, description in each categories and examples.

For “degreased waste threads and yarns”, as discuss in chapter 4, we did not find the meaning or picture of this goods even though it appears in WIPO Madrid Goods and Services Manager. Basically, we can imply that it will be made from waste. In addition, the goods maybe as same as waste cotton yarns, if we consider to material of the goods. Initially, we will put it in the same code as “waste cotton yarns” by assuming that goods make from threads or yarns waste.

Table 5.5 Example of Similar Group Code for class 23 when related to class 35

Class	Goods category in the class		Characteristics of the goods		Examples	
	Description	Code	Description	Code	Goods	Code
35	Retail or wholesale services	01	Retail or wholesale services	01	Retail services related to rubber thread for textile use	350101, 230101

According to the example of “retail or wholesale services” that mention earlier, in this case, we will put the code of services and goods together when we conduct the search. For example, “Retail services related to rubber thread for textile use”, we will put “350101” which stand for “Retail or wholesale services” in class 35 and “230101” stand for “rubber thread for textile use” which is the goods that will sell in this designated service.

5.2 Implication in Thailand Trademark office

According to example of Similar Group Code that will be adapted and use in Thailand, initially, most of list of goods and services are similar to Thailand, such as, paper boxes for packaging, canvas for painting and paper for writing. In addition, we would like to have the committee to decide and create Similar Group Code that proper to Thailand trademark registration system. The committee will be consisting of 3 groups of these persons.

First, trademark registrars which expert in goods and services in Thailand. Some of them will be the trademark registrar that knowledgeable in trademark examination current practice, trademark registrar that had ever examine trademark examination with prior goods and services classification or trademark registrar that expert in the special field, for example, food, clothing or providing services industry. In addition, this group

will be included trademark registrar that acquaintance with international trademark application list of goods and services or application that related to Madrid Protocol.

Second, trademark registrars which interested in innovation or new goods and services that will provided in Thailand and overseas. Because we will have to updated new products and services that will be presented in the world anytime. In addition, it will affect to the trademark registration when the applicant would like to be registered and protect their goods and/or services under their filing trademark.

Third, trademark registrars that acquaintance or had ever training with JPO related to Similar Group Code. Because they will know the concept and/or how to use in JPO. In addition, they will estimate what is the proper way to adapted and use in Thailand.

Regarding to the committee, initially, they will have authorities to discuss and decided how to group or separated list of goods and services. Nowadays, list of goods and services in Thailand, they base on the purposes or objective of goods and/or services. When we will adapt and use Similar Group Code for Thailand's trademark system, the committee will start with revision the current list of goods and services that they are in the correct classes and set up more criteria to scope the similarity and create Similar Group Code. From earlier example, they maybe use 2 set of conditions. First, consider to purpose, the place that provided goods and appearance altogether at the same time. Second, if the first condition for comparing the goods are very similar, we will consider to material of that goods. If these conditions did not decide the similarity, the committee will discuss with other trademark registrars and/or find more evidences from the credibility sources such as the manufacturer that produce the goods and/or services in foreign countries on the internet. According to this phrase of operation, we will plan that the committee will have around 10 persons. Each time for the meeting, the committee will receive the same list of goods and/or services to review and consider before the next meeting for discussion. Initially, the meeting will be held every 3 weeks to balance trademark registrar authorities between the Similar Group Code committee and substantive examination. In addition, this operation will be finished all of 45 classes of goods and services, around 1 year. Furthermore, if Similar Group Code will be launched and used in Thailand, the committee that created the code will have the meeting every 3 weeks. The meeting will be held, just in case it has some list of goods and services updated. Regarding to the updated, we will publish new list of goods and services once a year by coordinated with technical staff to update data on our organization website.

Acknowledgement

This research is completed with assistance and support from many parties.

First of all, I would like to thank you my organization, Department of Intellectual Property (DIP) that give me an opportunity to participate this program which related to my current authorities. In addition, a lot of knowledge that I receive here will be enhance my work performance and the organization in the future.

Second, I would like to express my gratitude to Mr. Akira Matsunaga, Japan Patent Office Commissioner for giving an opportunity of being here in the two-month study-cum-research program. In addition, Japan Patent Office staff especially “JPO Lectures of the Trademark System” lecturer’s team that support me for the knowledge and material related to my research, answer many questions that I still confused and great friendship. I’m very appreciated.

Third, I would like to express my special gratitude to my advisor, Ms. Hiroko Hirayama, who give me a lot of information, experience and recommendations related to my research.

Fourth, I would like to thank you the interviewees from member companies from Trademark Committee, Japan Intellectual Property Association (JIPA) and members of Japan Patent Attorney Association (JPAA) that give a lot of information and suggestion that useful for this research. In addition, Japan Patent Information Organization (JPIO) to give some information relating to international trademark application data input process.

Fifth, I would like to thank you two interpreters, Ms. Reiko Madren to support me related to the communication during my training course and research interview. Ms. Yoko Okazaki who support me relevant to communication on my final report presentation and evaluation meeting. In addition, thank you to both of you for your kindness and friendship that give to me during this program.

Finally, I would also thank you Mr. Takao Ogiya for your warm welcome and kindness. And all of Asia-Pacific Industrial Property Center (APIC) staff especially, Dr. Yorimasa Suwa, Mr. Takayuki Shibata and Ms. Tomoko Uno for your coordination relating to my research, useful information, your kindness, give me a chance to meet new experience and great friendship during staying here in Japan. I’m very appreciated.

References

- Japan Patent Office. (2015, December 3). *“Organization”*. <https://www.jpo.go.jp/e/introduction/soshiki/sosikizu.html>
- Japan Patent Office. (n.d.-a). *“Examination Guidelines for Similar Goods and Services (corresponding to the Nice Classification, 11th Edition, Version 2019)”*. <https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/all.pdf>
- Japan Patent Office. (n.d.-b). *“J-PlatPat Japan Platform for Patent Information”*. <https://www.j-platpat.inpit.go.jp/t1201>
- Japan Patent Office. (n.d.-c). *“Procedures for Obtaining a Trademark Right”*. <https://www.jpo.go.jp/e/system/trademark/gaiyo/trademark.html>
- Japan Patent Office Trademark Division. (2019, June 10). *“Similar Group Code” Used at the Japan Patent Office*. https://www.jpo.go.jp/e/system/trademark/gaiyo/bunrui/kokusai/ruijigun_cord_reidai.html
- International Trademark Classification Office, Trademark Division, Japan Patent Office. (2019, February 4). *“Examination Guidelines for Similar Goods and Services (corresponding to the Nice Classification, 11th Edition, Version 2019)”*. https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/ruiji-kijun/ruiji_kijun11-2019.html
- Textilchemie Dr. Petry GmbH. (n.d.). *“Yarn Lubricants”*. <https://drpetry.de/en/products/yarn-lubricants.html>
- Trademark Examination Standards Office, Trademark Division Japan Patent office. (2019, March 6). *“Flow-Chart Concerning Trademarks-Related Procedures”*. https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/tt1303-061_1.pdf
- WIPO IP PORTAL. (n.d.-a). *“List of Classes with Explanatory Notes”*. https://www.wipo.int/classifications/nice/nclpub/en/fr/?explanatory_notes=show&lang=en&menulanguage=en¬ion=class_headings&version=20190101
- WIPO IP PORTAL. (n.d.-b). *“Madrid Goods & Services Manager”*. <https://webaccess.wipo.int/mgs/>

Appendix I

Minute of the interviews: Member Companies of Trademark Committee in Japan Intellectual Property Association (JIPA)

Interviewee name, title, organization:

- | | |
|--------------------|---|
| 1. Shinya Fuji | Manager of intellectual property team, legal & IP department, |
| | BANDAI CO.,LTD. |
| 2. Shin Hinohara | Intellectual property section, intellectual property and legal Department, KADOKAWA CORPORATION |
| 3. Megumi Oumi | Patent attorney manager, licensing group, NIPPON TELEGRAPH |
| | AND TELEPHONE CORPORATION |
| 4. Toru Sugisaki | Manager, trademark, TAKEDA PHARMACEUTICAL COMPANY |
| | LIMITED |
| 5. Mitsuru Saito | Intellectual property department, SUBARU CORPORATION |
| 6. Takuya Tokuwaka | Assistant manager, intellectual property, patent attorney, YONEX CO.,LTD |
| 7. Takashi Tsurumi | Patent attorney, assistant manager, processed foods division, |
| | NISSHIN FOODS INC. |

All of interviewees are member companies of Trademark Committee in Japan Intellectual Property Association (JIPA)

Interview date, time and place:

November 7, 2019 at 10.00-11.15 am, Japan Intellectual Property Association.

Question and responses:

1. How is the satisfaction of the JPO's Trademark examination?

1.1 Indicate designated goods and/or services and Similar Group Code

Summary of answers: Regarding to JPO designated goods and services. In case of JPO, they have Similar Group Code system. It is very easy to understanding.

1.2 Quality management

Summary of answers: In term of distinctiveness, Japanese trademark examiner, sometime office action, the trademark indicate quality itself. And some

issuing some office action, in terms of reference document, sometimes they cited academic paper but sometime they also use Wikipedia or the kind of stuff that anybody can added to the writing.

According to Takashi Tsurumi from NISSHIN FOODS INC, he said that his company is a food company, not only Wikipedia, sometime JPO examiner office action based on the ground something that written in restaurants menu or tweeting by the shop owner or the internet which examiner think that it widely uses and lack of distinctiveness. Not only in term of JPO examination, but court also focus on the tweets.

1.3 Others (please specify)

Summary of answers: We have some issues that very unique to Japan, there are three different types character in Japanese. In addition, we have own Japanese phonetic letters call Katakana and Hiragana. One of the issue we concern that the trademark consisted of two lines, one line is English letter and in another line we have Katakana or Hiragana Japanese phonetic letters. About the issue concerning pronunciation and sound that the trademark should be read or pronounce. It's very complicated and unique to Japan. And the current of Japan trademark system, applicant is not really required to explain how to pronounce the specific words. Sometime it very difficult to determine what are they similar to something else or not. And the biggest issue from the user side, in term of similarity decision, it do not have very high predictability for the application will register or not. Because we really need to know that it can register or not in advance. However, if we find some similar looking prior registered trademark, it very difficult for us to see some that are similar or dissimilar. Therefore, all we can do, just go ahead and file some trademark application. And we have to wait at the time that examiner give decision.

2. According to JPO's trademark examination, are there any problem or issue that should be resolved? If yes, please specify.

2.1 Indicate designated goods and/or services and Similar Group Code

Summary of answers: The Japanese Similar Group Code are review and amended very frequently. Sometime designated goods, you need to be careful. Sometime, lists of goods and services they do not put together or put together. Maybe it difficult to grouping especially in the field of food and beverages, sometime they put together or separate it. Therefore, when you conduct the search some Similar Group Code you need to pay attention, exactly what year we talking about, what specific year that trademarks were registered and you have to see what version of Similar Group Codes was use at the time of registration in case of the prior registered trademark.

2.2 Quality management

Summary of answers: Some examiners use a kind of documentation that very weak as ground of office action. That makes somewhat perplex that how should we respond to the office action. Therefore, we request to the JPO that have more clear guideline what kind of document that they use.

2.3 Others (please specify)

Summary of answers: The interviewees did not discuss in this topic.

3. The IT tools, and information relate to Trademark Examination, that provide through JPO's website, how is the satisfaction of them?

Summary of answers: Japanese system has been changed to now. It is very handy. And part of the practice, we have used it as a search tools. The function is quite easy for us to find out the Similar Group Code specific goods and services. However, in term of the filing of JPO, the interviewee wouldn't say it is easy to use. It is a question for how to use the e-filing system.

For BANDAI CO., LTD., in term of databases, quality, it is okay. But compare with other foreign countries, as Shinya Fuji's personal impression, in term of quality information, his impression is USPTO (United States Patent and Trademark Office) is the best.

4. Have you ever filed the trademark applications in Thailand? (Filing application by representative in Thailand, Madrid Protocol or both) If yes, what is your opinion on Thailand's trademark examination?

Summary of answers: Regarding to JPO designated goods and services. In case of JPO, they have Similar Group Code system. It is very easy to understanding. But if we compare to Thai system, and the point of view of the user, they are not clear between goods and services. In Thailand, they did not allow to designated "toys". We have designated "metal toys, plastic toys, wooden toys, electric toys...". But the goods had sold in the market, they sold in toy store. Another example is "electronics toys" is similar to the product in class 9. We always have considered these points. In Japan, have Similar Group Code. If the codes are similar to others, we have to avoid to registered. It is easy how we proceed. And the second point of view, in regards to trademark examination itself, as compare with Japan and Thailand system, the term of determination of distinctiveness is huge different between two offices.

5. Do you have any suggestion about Thailand's trademark examination? If yes, please specify.

Summary of answers: Toru Sugisaki from TAKEDA PHARMACEUTICAL COMPANY LIMITED, he said, in Thailand, have some database that conduct search. Therefore, please accept my apologies, maybe it is my misunderstanding. It is almost in Thai language. The issue in the top is English, but when I click, then the things will display is all in Thai language. That is my experience. Please modify, it might be grateful.

Moreover, Shinya Fuji form BANDAI CO.,LTD. , he use the Global Brand Database provided by WIPO (World Intellectual Property Organization). When database come to be some graphical data, it also indicated in Thai language. Therefore, he still need to use Google translation function to have the Thai language translated.

Note: If interviewee talking about Trademark Examiner or Examiner in Thailand, we will use the word “registrar” or “Trademark registrar” in content of the report.

Appendix II

Minute of the interview: Member of Japan Patent Attorneys Association (JPAA)

Interviewee name, title, organization:

1. Tomohiko YAMADA Chairperson of the Trademark Committee, NISHIURA & ASSOCIATES
2. Emi AOSHIMA Vice Chairperson of the Trademark Committee, YUASA AND HARA

All of interviewees are member of Japan Patent Attorneys Association (JPAA).

Interview date, time and place:

November 18, 2019 at 14.00-16.00 pm, JPAA's meeting room in Tokyo Club Building.

Question and responses:

1. How is the satisfaction of the JPO's Trademark examination?

1.1 Goods and/or services indication and Similar Group Code

Summary of answers: In term of indication goods and services, The examiners' ground for refusal based on Article 6 and mainly involved with unclear indication issues whether or not the classes are correct or not.

For the similar-group code, the practice of the JPO is very clear and easy understand. We are often asked by the clients to conduct the trademark search, and then with the similar-group code, we are able to conduct the search easily and accurately predict the result of the examinations. Moreover, the similar-group code will not be effected by the results of Nice Union for the changing of classes. Because the similar-group code is still remain even the classes changed.

Sometimes in case of the new good and service come up, the similar-group code, that the JPO assigned, is inappropriate. Moreover, in the case of Nice Union committee's discussion on the new goods and services that should be in which class and how to indication it. After JPO got the result of that meeting, they need to decide that which Japanese translation should be used for that term and what the similar-group code should be assigned. Normally the JPO also consult with JPAA and ask for the JPAA's view then if there is somethings that is inappropriate

whether the Japanese translation or the similar-group code, The JPAA will point that out to JPO.

1.2 Quality management

Summary of answers: For nowadays, the JPO's examiners suggest and give directions for amendment regardless direct applications or Madrid applications. By the suggestions or directions, these are very helpful for the attorneys in drafting the amendment to response the JPO.

In addition, if the attorneys do not completely agree with the suggestions or directions based on the view of the examiners, the JPO allows the attorneys directly consult or discuss with the examiner to exchange the facts then the examiner will come up with the indication of goods and services that should be submitted.

The JPO conduct about the questionnaire and survey among the users to give the feedback to the examiner who handle the case. The JPAA quite satisfy for the way that JPO conduct the quality management.

1.3 Others (please specify)

Summary of answers: The interviewees did not discuss in this topic.

2. According to JPO's trademark examination, are there any problem or issue that should be resolved? If yes, please specify.

2.1 Indicate designated goods and/or services and Similar Group Code

Summary of answers: The negative aspects of similar-group code, in case of determination similarity designated goods and services sometimes these are not flexible. Because the JPO has the examination guidelines and they said they determine the similarity of goods and services based on this guidelines but in the reality there are some cases that determine the similarity of goods and services based on the jurisprudence under the decision of the supreme court in the past whether the same similar-group codes are assigned or not. Then sometimes the decision of similarity of designated goods and services may not be made on the actual situation of goods and services actual transaction.

Other JPO practice, sometime if they assigned the similar-group code in the past to the very similar goods and services, so they will refuse to change their minds. In addition, sometimes they issue an office action based on Article 6 for unclear indication but the indication is very clear and the problem is the examiner cannot find out what suitable similar-group code that should be assigned.

2.2 Quality management

Summary of answers: Sometimes the Examiners' decision may be different from the guidelines, then if the attorney receives the office action like that the attorney will point that out to the JPO. Normally after the attorney point that out to JPO, the office action can be overruled.

Normally if the substantive examiners eventually have to make decision to grant or refuse at the final stage this decision need to be approved by senior examiners. So if the attorney point out to The JPO that the office action is different from the examination guidelines, the senior examiners who approve this decision will tell the younger examiner to change and try match the decision closer to the examination guidelines. And the case like this sometimes issue by the inexperienced younger examiners

2.3 Others (please specify)

Summary of answers: The interviewees did not discuss in this topic.

3. The IT tools, and information relate to Trademark Examination, that provide through JPO's website, how is the satisfaction of them?

Summary of answers: The JPAA quite satisfy with the information that provide by the JPO, which are the examination guidelines, the indication of goods and service also include the similar-group code, and also provide some the information detail about the changes of the rules, guidelines and regulations . On the other hand, the JPO also give the opportunity to the users for the public comments and always make sure that they have listened to the view of the users.

By the follow the situation that JPO announce through the website that make the users catch up the latest situation and also there is no confusion.

4. Have you ever filed the trademark applications in Thailand? (Filing application by representative in Thailand, Madrid Protocol or both) If yes, what is your opinion on Thailand's trademark examination?

Summary of answers: Many members of the trademark committee handle with the Thai office. Some of members mention that, in case of distinctiveness and the decision on acquired distinctiveness, the examiner's decision is very strict when compare to the JPO practice. Moreover, the criteria or standard is not quite clear enough then it will be difficult to overcome the office action.

Other issue is the decision on the indication of the designated goods and services is too strict.

5. Do you have any suggestion about Thailand's trademark examination? If yes, please specify.

Summary of answers: The member of JPAA tell that if it is possible to make the decision on the distinctiveness, acquired distinctiveness and the indication of goods and services less strict, clearly and easy understand. In addition, Thai office should make sure the decision that make by different examiners, become uniform and the criteria for that decision should be clearly and easy for everyone to understand

Note: If interviewee talking about Trademark Examiner or Examiner in Thailand, we will use the word "registrar" or "Trademark registrar" in content of the report.

Appendix III

Research feedback from DIP colleagues

According to the research and outcome related to implications and recommendations to IP office or IP stakeholders in Thailand, we introduce the result to some of our colleagues in DIP Trademark Office to ask about their feedback. Please see the summary of feedback and opinion below.

1. Example of Similar Group Code that will be adapted in Thailand

According to Similar Group Code that categorize goods and services by purpose or material which appear in chapter 5, it is appropriated. Because it is easy to understand, indicated goods or characteristics up to 99 categories and convenience to categorize goods and services. Not only for their details, but also covering all of specific goods in Thailand, for examples, Thai desserts and Thai foods.

In addition, if we have Similar Group Code criteria and use it in Thailand, we should design and update our trademark systems to support Similar Group Code for trademark examination procedures especially goods and services in the same class or different classes which they have the same characteristics. Furthermore, Similar Group Code will be useful for trademark examination stakeholders such as Trademark Examiner, Trademark Registrar and the applicants.

2. Implication in Thailand Trademark office

According to Similar Group Code committee, it will consist of Trademark Registrar that knowledgeable and expert in goods and services. However, we should revise and update all the goods and services of Thailand before creating Similar Group Code criteria. In addition, we may have the cooperation with JPO staff to give some recommendation, guideline or training to DIP staff before creating Similar Group Code that will be adapted and use in Thailand. If we have the cooperation with JPO, Similar Group Code will be completed rapidly and should be finished within 1 year. In addition, if some of goods and services are newly or have some innovation, the characteristics will make some confusion to put in the correct class or can place in many classes, it will be discussed with trademark registrar that expert in the special field or discuss with Similar Group Code committee.

Regarding to goods and services categorize, it will be corresponding with the Nice Classification. Therefore, we should establish a committee to update and revise goods and services classification that will be amended for Thailand's Similar Group Code every year.