

THAILAND

Guidance on Considering action by Registrar of Trademark Office

B.E.2559 (2016)

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Chapter 1 Definition of Trademark

Meanings of a mark, trademark, service mark, certification mark, and collective mark defined in the Section 4 of Trademark Act B.E. 2534 amended by Trademark Act (No.2) B.E. 2543 and Trademark Act (No.3) B.E. 2559 are as follows:

Mark means a photograph, drawing, device, brand, name, word, text, letter, numeral, signature, combination of colors, figure or shape of an object, sound, or a combination thereof.

1. Photograph means photo occur from photographic process of occurring matters.
2. Drawing means picture occur from painting process of occurring matters or imagination or computer graphic or other tools.
3. Device means picture that is created to be different from natural or general existing matters.
4. Brand means the mark that contain pattern and create in many forms.
5. Name means word which use to pronounce a natural person, a juristic person or any organizations.
6. Word means alphabets and vowels combining together and can be read whether or not it has a meaning.
7. Text means a short content.
8. Letters means any letters in any languages.
9. Numeral means any numerals in any language.
10. Signature means lined figure represented name of a natural person.
11. Combination of colors means group of colors starting from 2 colors whether it is light or darkened colors.
12. Figure or shape of an object means the mark which has figure or shape of an object indicated width, length and depth.
13. Sound means a human voice, animal sound, music, or other sound.
14. One of the marks mentioned in 1-13, or a combination of several types of marks.

Trademark means a mark used in connection with goods to distinguish the goods with a trademark owned by a certain entity from those with trademarks of the other entities.

Examples:



Service mark means a mark used in connection with services to distinguish the services with a service mark owned by a certain entity from those with service marks of the other entities.

Examples:



(Service mark of aviation business)

(Service mark of search engine business)

(Service mark of food and beverage business)

Certification mark means a mark owned by a certain entity and used in connection with or on goods or services of other entities to certify the origin, composition, method of production, quality or other characteristics of such goods or to certify as to the nature, quality, type or other characteristics of such services.

Examples:



(certify jasmine rice)



(certify safety agricultural production process)



(certify Islamic food)

Collective mark means a trademark or service mark used by companies or enterprises of the same group or by members of an association, cooperative, union, confederation, group, or any other state or

private organization.

Examples:



(Siam Cement Group)



(MiTR PHOL Group)



(SANTIBURI Group)

Chapter 2 Registrable trademarks

Section 6

To be registrable, a trademark must:

- (1) be distinctive;
- (2) not be prohibited under this Act;
- (3) not be the same as or similar to a trademark registered by another person.

Part 1 Distinctive trademark

The mark itself be distinctive

Section 7 paragraph 1

A distinctive trademark is a trademark which enables the public or users to distinguish the goods with which the trademark is used from other goods.

Trademarks which has no distinctiveness according to Section 7 paragraph 1 are such as

1. General descriptive messages

Example:

เทคโนโลยีเพื่อชีวิต	NATURAL DEFENSE
รสชาติเต็มร้อย น้ำตาล 0 %	2-WAY POWDER FOUNDATION
	TREAT THE CONDITION. TRANSFORM THE LIFE

2. Generic words such as the words have meanings as international, warranty or the word indicating models of goods etc.

Example:

International	GUARANTY
NSERIES	NINEMILLION
NANO	ECO
สีเขียว	GREEN

3. Things that common to trade as the Registrar has announced in the Notification (Annex)

Section 7 paragraph 2

A trademark having or comprising any of the following essential

characteristics shall be deemed distinctive.

Section 7 (1)

a personal name, a surname of a natural person not being such by its ordinary signification, a full name of a juristic person in accordance with the law on such matter or a tradename represented in a special manner

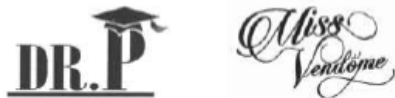
1. Registrable personal name must be considered as follows:

1.1 Personal name which is presented with a name title but without surname can be registered if it is represented in a special manner (without disclaimer of title).

Name title is a word put in front of a person's name to indicate the person's status, academic title, rank, honorable title, or rank of nobility, such as Mr., Mrs., Ms., Dr., Prof., Asst. Prof., Lt.Gen., Gen., Lt., Chao Phraya, Phra, Luang, Khun, Muen, M.C., M.R., M.L., etc. The name title written in foreign languages are also included.

Examples (Non-registrable personal name): Mr. Amnuay, Dr. Montri, Ms. Somsri

Examples (Registrable personal name):



1.2 Personal name without name title or surname can be registered without being represented in a special manner.

Examples: Amnuay, Montri, Somsri

However, all names mention above must not have a direct reference to the characteristics or quality of goods.

2. Registrable surname must be considered as follows:

2.1 Must be represented in a special manner

2.2 Must not be commonly known surname (The commonly known surname cannot be registered, even though it is represented in a special manner.)

Examples: Non-registrable commonly known surname

ดิณสุลานนท์ ศิลปอาชา **NOBEL**

However, all names mention above must not have a direct reference to the characteristics or quality of goods.

3. Registrable name and surname of a person must be considered as follows:

3.1 Must be represented in a special manner

3.2 Must acquire a permission from that person or parent, heirs or spouse (if any) in case that person is dead.

Examples (Registrable name and surname of a person):

Jack Johnson *Lolla Michael*

However, all names mention above must not have a direct reference to the characteristics or quality of goods.

4. Registrable full name of a juristic person must be considered as follows:

4.1 Full name of juristic person means a name of the juristic person with juristic status identification. However, if the juristic person is registered under the foreign law, its name can be considered as a name of juristic person, even if the juristic status is not presented. The consideration may be done according to ownership specified in the Letter of Power of Attorney.

4.2 Name of the juristic person shall be represented in a special manner.

Example:



However, all names mention above must not have a direct reference to the characteristics or quality of goods.

5. Registrable trade name must be represented in a special manner

Trade name is a name used by a certain business which is clearly specified with business identification, such as a shop, store, commercial business, mechanical business, etc.

Example:



However, all names mention above must not have a direct reference to the characteristics or quality of goods.

Section 7 (2)

a word or phrase having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the Minister;

"Direct reference to the characteristics of goods" means when user has seen the mark, he can perceive or understand instantly how the goods, that using the mark, has appearance, shape or size is.

"Direct reference to the quality of goods" means when user has seen the mark, he can perceive or understand instantly how the goods, that using the mark, has qualification, utility or special character is.

As such, in the consideration on a direct reference to characteristics or qualifications of goods, the examiner should not use exaggerated imagination or attempt in collecting information or using hypothesis in making a conclusion the meaning of the mark.

1. A word or words which has a direct reference to the characteristic or qualification of the goods are as follows:

1.1 A word or words or messages which has meanings or translations including words which written from foreign pronunciations (Transliterated word) which has meanings or translations.

Examples

KEEP COOL

Goods: Light filter Films

AROY-SURE

Goods: Seasonings

1.2 Written word or words with intention to use wrong grammatically spelling.

If it considers from the pronunciation, it is understood that a word or words have meaning and it directly refers to the appearance or qualification of goods.

Examples:



Goods: Constructing materials

ABSORBAG

Goods: Power dry

1.3 A word or words written by combining 2 words and the meanings directly describes the appearance or qualification of goods

Examples:

Clearview

Goods: Contact lens

MAXCLEAN

Goods: Washing detergents

1.4 A word or words having no direct reference to the character or quality of the goods. Even if it is represented in a special manner, such a word or words cannot be registered.

Examples:



Service: Food and drinks



Service: Food and drinks

2. A word or words shall not be a geographical name.

Geographical name is a name named after a geographical location, both in Thailand and abroad as prescribed by the Notification of Ministry of Commerce on Registration of Geographical Name (Annex).

Geographical names considered from the characteristics as follows:

2.1 Geographical name is non-registrable, even if it is represented in a special manner.

2.2 A word transliterated from the name of a geographical location which is derived from the pronunciation in other language shall be considered as a geographical name.

Examples:

KunLun

KRUNGTHEP

Transliterated from a Chinese word "Kunlun", which is the name of a mountain range in Xinjiang, China, Krungthep, or Bangkok, is the name of Thailand's capital city.



Samui is the name of an island in Surat Thani.

Fuji is the name of a volcano in Japan.

Section 7 (3)

an invented word

Invented word means a word newly created without definition or meaning; a combination of meaningful and meaningless words is also included.

Examples: Invented words

Canon

REVLON

คอนเน

3. Words with the following characteristics are not considered as an invented word.

3.1 A word intentionally misspelled or grammatically incorrect, the pronunciation of which can be understood as a meaningful word, and the meaning of which has no direct reference to the character or quality of the goods, shall not be considered as an invented word.

Examples: Words intentionally misspelled or grammatically incorrect

Zuper Klean



Goods: Cleansing cream
Meaning of the name: "very clean"

Goods: Refrigerator
Meaning of the name: "cooling design"

Nature Kare



Goods: Skin care
Meaning of the name: "take care of skin naturally"

Goods: Rice
Meaning of the name: "Inexpensive"

3.2 A word written by combining two or more meaningful words in any form, the meaning of which has no direct reference to the character or quality of the goods, shall not be considered as an invented word.

Examples: Words intentionally misspelled or grammatically incorrect

POPSCENT



Goods: Fragrance
Meaning of the name: "popular scent"

Goods: Computer game
Meaning of the name: "online game"

3.3 A word indicating characteristics or qualities of the goods or a geographical name which is represented in a special manner or beautiful design cannot be registered.

Section 7 (4)

Invented letter or numeral

4.1 Invented letter means a letter in any languages or its pronunciation. Invented letter can be considered with the following

characteristics:

- 4.1.1 The letters which are cling to each other
- 4.1.2 The letters which are thick or deep in dimension
- 4.1.3 The letters which draw as pattern
- 4.1.4 The letters which is overlapped as shadow

Examples: Invented letters



4.2 **Invented numeral** means a numeral in any languages or its pronunciation. Invented numeral can be considered with the following characteristics:

- 4.2.1 The numerals which are cling to each other
- 4.2.2 The numerals which are thick or deep in dimension
- 4.2.3 The numerals which draw as pattern
- 4.2.4 The numerals which is overlapped as shadow

Examples: Invented numerals



Section 7 (5)

a combination of colors represented in a special manner;

1. Combination of colors means the combination of two or more colors and represented in a special manner whether in light or darkened colors which has no characteristics as follows:

- 1.1 Natural color of the goods such as beige color of the woods used with furniture
- 1.2 Color from the operation or usage of the goods such as the combination of lights in front of salon.
- 1.3 Arranged color swatch such as various colored stripes, groping style, national flag.

Combination of colors represented in a special manner means combination of colors which is placed in a special character

differently from normal line or strip in vertical or horizontal rows.

Examples: Distinctive combination of colors



Section 7 (6)

the signature of the applicant or the predecessor in his or her business or the signature of another person with his or her permission;

It can be considered as follows:

1. It must be a signature of the applicant or the previous owner of the applicant's business
2. In case it is a signature of others, there must be a written consent attached with the applicant.

Examples: Signatures



Section 7 (7)

the representation of the applicant or of another person with his or her permission or of a deceased person with the permission of his or her ascendants, descendants and spouse, if any;.

The representation of the applicant can be considered as follows:

1. Representation of the applicant shall be submitted with a confirmation letter confirming that it is a portrait of the applicant.
2. Representation of a person shall be submitted with his or her permission allowing usage of the representation as trademark.
3. Representation of a dead person shall be submitted with his or her ascendants, descendants, or spouse, if any, allowing usage of the representation as trademark.

Examples: Portrait



Section 7 (8)

An invented device

Invented device means a picture which is designed, drawn, modified, created, or imagined.

Examples: Invented devices



Section 7 (9)

A picture having no direct reference to the character or quality of the goods and not being a picture of a map or a geographical site prescribed by the Minister;

Examples:



(Fertilizer)

(Feed)

(Clothes)



(Pork)

(Drinking Yogurt)

(Pork Floss and Chinese Pork Jerky)

Section 7 (10)

A shape which is not the natural form of the goods or a shape which is not necessary to obtain a technical result of the goods or a shape which does not give value to the goods;

Trademark which is similar to a figure or shape of an object shall be a trademark whose figure or shape displays dimensions, such as width, length, and depth, and have the following characteristics:

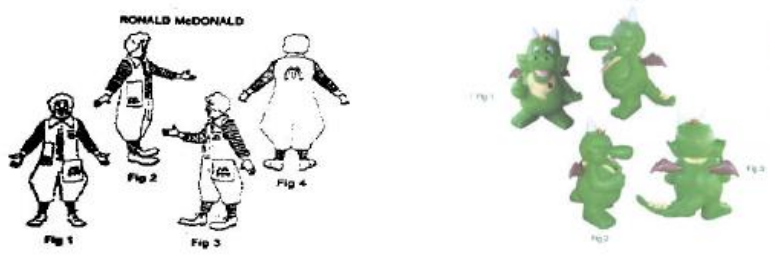
1. A figure or shape which is not a natural form of the goods, such as the round shape of football product
2. A figure or shape which is not necessary to obtain technical result of the goods, such as toilet bowl of toilet product
3. A figure or shape which does not add value to such goods, such as decoration of gold bar or diamond on normal plate shape

Examples: Trademark which is similar to a distinctive figure or shape of the goods



Goods: Wine, brandy, and whiskey

Reason: A shape of the bottle is a half-circle shape, curving inward



in the middle, allowing other side of the bottle to be seen, which makes it different from other bottle shapes.

Service: Restaurant

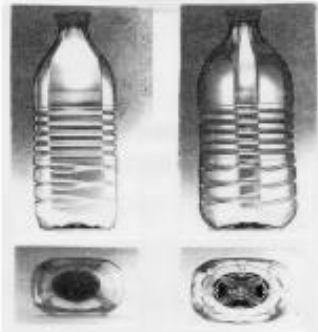
Reason: A figure or shape is not related to the goods or services applied for registration, hence it is distinctive.

Examples: A figure or shape mark which has no distinctiveness



List of good: Pen

Reason: it has normal shape and usability.



List of good: Drinking water,
Mineral water
Reason: it has normal shape of
drinking water container.



List of good: Smoking lighter
Reason: it has normal shape.

Section 7 (11)

A sound having no direct reference to the character or quality of the goods or a sound which is not the natural sound of the goods or a sound which does not result from the functioning of the goods.

Sound mark can be human voice, animal sound, music, or other sound, such as electronic sound. The registrable sound mark shall not be what is common to trade as prescribed by the Registrar Notification on Common Elements in the Trade.

1. A sound having direct reference to the character or quality of the goods means a sound describing about the goods or its characteristics, such as a sound of cows for milk products, a fish frying sound for restaurant service, etc.
2. A sound which is the natural sound of the goods, such as a sound of ducks for duckling products.
3. A sound which results from the functioning of the goods, such as an engine sound for car or motorbike products, a flushing sound for toilet products, etc.

4. A sound which is common in the trade, such as a sound of pellet drums for cloth dying service, a wood knocking sound for egg noodles and wontons, a siren sound for ambulances, etc.

Trademarks that are distinctive by using Section 7 paragraph 3

Trade marks that do not have specific characteristics according to items (1) to (11), if it has been sold, publicize or advertising trademarks until it becomes well known as the rules of the Minister has announced and it is able to be proved that there is a compliance with the rules, it shall be deemed distinctive.

The consideration on evidence on usage of mark as mentioned above considers from the current Notification of Ministry of Commerce on Rule for proving of distinctiveness according to Section 7 paragraph 3 (Annex).

From the said Notification of the Ministry of Commerce, it can be concluded to prove the distinctiveness as follows:

1. Evidence on sale, publicize, or advertising goods or services with the mark must be able to prove that there are continuously sale, publicize, or advertising for a period of time.

Some kind of goods in specific field such as mechanical tools, medical tools, the Notification of the Ministry of Commerce determined that the public in related fields in Thailand has known it is sufficiently enough.

Besides, the Notification determined that the mark must be well known to public in Thailand. Therefore, if the mark is registered in foreign country and become well known in foreign country not in Thailand, it shall not be deemed distinctive according to Section 7 paragraph 3.

2. There must be well known particularly on goods or services which acquire a trademark only. It can be said that the evidence to prove the well known mark which use with any goods or services shall be well known specifically on such goods or services only, not including other goods or services which apply with the mark but has no evidence to prove as well known mark.

3. Trademark being proved for a distinctive character shall be the same as the trademark applied for registration. To be more specific, the trademark displayed on the evidence shall be the same or almost the same as the trademark applied for registration.

The examples of the evidence to prove on the usage of trademark such as:

1. Copies of receipt of sale of goods
2. Copies of receipt of advertisement fee
3. Copies of invoice or purchase order
4. Copies of factory license
5. Evidence on media advertisements
6. Sample of goods
7. Other evidence, etc.

Example of the nondistinctive mark but the applicants have proved the sale, publicize or advertising on those marks until it becomes well known. Thus, it has been registered because it has distinctiveness thru use according to Section 7 paragraph 3.

Letters



Words or messages



Combination of colors



Part 2 Prohibited trademark for registration

Section 8 Trademarks having or consisting of any of the following characteristics shall not be registrable:

- (1) State arms or crests, royal seals, official seals, Chakkri emblems, emblems and insignia of the royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces;
- (2) National flags of Thailand, royal standard flags or official flags;
- (3) Royal names, royal monograms, abbreviations of royal names or royal monograms, or
- (4) Representations of the King, Queen or Heir to the Throne;
- (5) Names, words, terms or emblems signifying the King, Queen or Heir to the Throne or members of the royal family;
- (6) National emblems and flags of foreign states, emblems and flags of international organizations, emblems of head of foreign states, official emblems and quality control and certification of foreign states or international organizations, names and monograms of foreign states or international organizations, unless permission is given by the competent officer of the foreign state or international organization;
- (7) Official emblems and emblems of the Red Cross or appellations "Red Cross" or "Geneva Cross";
- (8) A mark identical with or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Thai government or a Thai government agency for public enterprise or any other government organ of Thailand, a foreign government or international organization unless such medal, diploma, certificate or mark has been actually awarded to the applicant for goods and is used in combination with the trademark;
- (9) Any mark which is contrary to public order, morality or public policy;
- (10) A mark registered or not, which is identical with a well-known mark as prescribed by the Ministerial Notifications, or so similar thereto that the public might be confused as to the owner or origin of the goods;
- (11) Trademarks similar to those under (1), (2), (3), (5), (6) or (7);
- (12) Geographical indications protected under the law on geographical indications;

(13) Other trademarks prescribed by the Ministerial Notifications.

The trademark shall not be registrable according to Section 8 can be considered as follows:

Section 8 (1)

State arms or crests, royal seals, official seals, Chakkri emblems, emblems and insignia of the royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces.

State arms or crests means National seal.



Royal seals means Seals of the King to be stamped with his signature and stamped with official important documents which issued in the King's signature.



Royal seals in King Rama IX

Chakkri emblems means seal of Chakkri dynasty.



Emblems and insignia of the royal orders and decorations.



Section 8 (2)

National flags of Thailand, royal standard flags or official flags. National flags of Thailand means National flags of Thailand in each period.



Royal standard flags means King's flag, Queen's flag, Crown prince's flag, Regent's flag.

Thai royal flag, B.E.2440-2453



King's flag

Queen's flag

Crown prince's flag

Regent's flag

Official flags means flag used in government services such as Boy scout's flag, Flags of government bureau, Flags of province, Flag of army.



Boy scout's flag



Flag of army

Section 8 (3)

Royal names, royal monograms, abbreviations of royal names or royal monograms.



Section 8 (4)

Representations of the King, Queen or Heir to the Throne mean photograph or drawing of the King, Queen or Heir.

Section 8 (5)

Names, words, terms or emblems signifying the King, Queen or Heir to the Throne or members of the royal family.
The consideration shall be strictly done in accordance with the context of the royal family of Thailand.

Examples King, Monarch, His Majesty, Rama I, Rama IX

Section 8 (6)

National emblems and flags of foreign states, emblems and flags of international organizations, emblems of head of foreign states, official emblems and quality control and certification of foreign states or international organizations, names and monograms of foreign states or international organizations, unless permission is given by the competent officer of the foreign state or international organization.

In terms of names or abbreviations of foreign states, if such names or abbreviations do not describe an essential part of the mark, the Registrar shall order the applicant to disclaim right to such a part or parts of the trademark, such as Made in Japan.

1. Flags of foreign states mean flags of other countries.



Flag of the USA



Flag of China



Flag of Canada

2. National emblems of foreign states means national emblems or signs of other countries.



USA's emblem



China's emblem



Canada's emblem

3. Emblems and flags of international organizations mean emblems or flags of the commonly known international organizations, such as the Olympic emblem, the emblem of the World Trade Organization, etc.



United Nations



World Intellectual Property Organization



Olympics



World Trade Organization

Section 8 (7)

Official emblems and emblems of the Red Cross or appellations "Red Cross" or "Geneva Cross"

1. Official emblems mean emblems which use in government affairs announced in the Gazette to be official emblems such as Emblems of the Ministries, Bureau, Department or emblem of province.



Seal of Ministry of Commerce

Seal of Ministry of Public Health

Seal of Bangkok Metropolitan

2. Emblems of the Red Cross mean the mark representing the medical and public health services of the Red Cross or international Red Cross.



(It includes pictures of cross in red, green color on white background or white, blue color on red background or other colors similar to those colors.)

The consideration whether the trademark is an emblem or name of the Red Cross shall be done by considering whether the trademark has a character of an emblem or name of the Red Cross which can cause any misunderstanding or not. If not, the consideration shall not be too strict.

Regarding trademark which contains black and white cross as a part of the trademark, if other parts of the trademark are registrable, the cross color can be considered to be limited and registered.

Section 8 (8)

A mark identical with or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Thai government or a Thai government agency for public enterprise or any other government organ of Thailand, a foreign government or international organization unless such medal, diploma, certificate or mark has been actually awarded to the applicant for

goods and is used in combination with the trademark.

Section 8 (9)

Any mark which is contrary to public order, morality or public policy.

1. Mark which is contrary to public order or morality



2. Mark which is contrary to public policy

2.1 Mark which is similar to official ranks

Example:



2.2 Taking trademarks of others to register in different class

Example:



Registered mark of the
Cooperative League of
Thailand



Applied mark for registration of
Nongrichan Rubber Fund Cooperative
Ltd.

2.3 Dishonestly taking registered trademarks of others in abroad to register in Thailand

2.4 Other marks which are contrary to public policy

Section 8 (10)

A mark registered or not, which is identical with a well-known mark

as prescribed by the Ministerial Notifications, or so similar thereto that the public might be confused as to the owner or origin of the goods

The aforementioned criteria shall be considered in accordance with the current Notification of Ministry of Commerce on Commonly Known Trademark Consideration Criteria. The Registrar can use registered trademarks as a commonly known trademark as prescribed by the Regulation of the Department of Intellectual Property on Commonly Known Trademark Informing B.E. 2548 (Annex) as a reference for trademark registration consideration, unless such a trademark is cancelled according to the resolution of the Trademark Committee or by the court.

Examples: Well-known marks



Section 8 (11) Trademarks similar to those under (1), (2), (3), (5), (6) or (7)

Section 8 (12) Geographical indications protected under the law on geographical indications

"Geographical indication" means a name, symbol or any other thing used for calling or representing a geographical origin and capable of identifying that the goods originating in that geographical origin are the goods having particular quality, reputation or characteristic of such geographical origin. If those geographical origins are registered under the law, it is unregistrable as trademarks (Annex).

Examples: Chaiya: salted eggs, Petchaboon: sweet tamarind, Surin: jasmine rice, Doi chang: coffee

Section 8 (13) Other trademarks prescribed by the Ministerial Notifications

The consideration shall be considered from the Notification of Ministry of Commerce on prohibited marks.

Prohibited marks are as follows:

1. Notification of Ministry of Commerce No. 5 (B.E. 2543) on Marks Prohibited from Registration (Annex)

1.1 Trademarks which are the same as or similar to international nonproprietary names (INN) for pharmaceutical substances of WHO.

1.2 Trademarks and their description which might cause the public to misunderstand or to be misled about the category, origin, or ownership of the goods or services.

2. Notification of Ministry of Commerce on Marks Prohibited from Registration (No.2) B.E. 2548 (Annex)

2.1 Trademarks which are Thai national symbols, a picture of Thai elephants, a picture of Ratchphruek, and a picture of Sala Thai (Pavilion).

Examples: National symbols which are prohibited to register (Annex)



๙๙๙๙๙๙๙ The Elephant (Elephant)



๙๙๙๙๙๙๙ Ratchphruek (Ratchphruek)



๙๙๙๙๙๙๙ Sala Thai (Pavilion)

2.2 Trademarks which are a combination of characteristics of or similar to the national symbols mentioned in 2.1.

Part 3 The consideration on identical or similarity of trademark

Section 13

Subject to Section 27, the Registrar shall not grant registration to a trademark applied for if he finds that:

(1) it is identical with a trademark registered by another person for use with goods in the same class or in different classes found to be of the same character; or

(2) it is so similar to a trademark registered by another person that the public might be confused or misled as to the ownership or origin of the goods for use with goods in the same class or in different classes found to be of the same character.

The word "identical" means the marks have the same character or appearance.

The word "identical" means the marks have similar character or appearance that the public might be confused or misled as to the ownership or origin of the goods.

The trademark search

1. Device mark shall be searched on descriptive code (Vienna Classification)

2. Word mark shall be searched for 4 methods as follows:

- 2.1 First letter-last sound
- 2.2 Identical/similar words
- 2.3 First letter- sound (for products)
- 2.4 Synonyms sound of each syllable

3. Sound mark shall be search for 2 methods as follows:

3.1 Search from directory of each sound category including human voice, animal sound, music, and other sound, such as electronic sound, natural sound, etc.

However, a sound mark can be a combination of sounds from more than one category.

3.2 The word pronunciation sound shall be checked with the directory of such word. For example, the sound "Rak Khun Tao Faa" shall be check with the directory of "Rak Khun Tao Faa".

The consideration on identical or similarity of trademarks shall consider as follows:

1. The appearance of the mark

1.1 Device mark can be considered on picture of the mark as follows:

Examples:



Similar to



Similar to



Similar to



Similar to



Similar to



Similar to



1.2 Word mark can be considered on letters or characters combined into the mark and the pronunciation of such words:



Similar to



Similar to



Similar to



Similar to



Similar to



Similar to



Similar to



Similar to



1.3 Letter or numeral can be considered on the appearance of its design. If the design is distinctive, the trademark shall be

considered as a distinctive trademark.

Examples:



(Honda)



(Hyundai)

1.4 Trademark presented in a label form can be considered as follows:

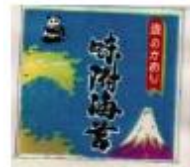
1. If composition of invented devices on the trademarks has the same meaning or is similar to each other, although essential parts of the trademark are different, they shall be considered as identical trademarks.

2. If the essential parts of trademarks are identical or similar, although other elements are different, they shall be considered as identical trademarks.

Examples:



Similar to



Similar to



Similar to



After considering identicalness or similarity of appearance of the trademarks as mentioned above, characteristics of the goods or services of such trademarks shall be also considered whether they are identical or not.

The consideration on class and list of goods shall be mainly considered from the character of goods, no matter those goods are in the same class or not. It can be considered as follows:

1. Same class and characteristic list of goods

Example : Paregoric (class 5) and Decongestants (class 5)
Air conditioner (class 11) and Electric fan (class 11)
T -shirt (class 25) and Underwear (class 25)
Banking services (class 36) and Insurance services (class 36)

2. Same class but the different characteristic list of goods

Example : Manure (class 1) and Glue used in industry (class 1)
Lipstick (class 3) and Detergent (class 3)
Pencil (class 16) and Tissue paper (class 16)
Restaurant services (class 43) and Temporary accommodation (class 43)

3. Different classes but same characteristic list of goods

Example : Liquid used in brake system (brake fluid) (class 1) and Lubricant (class 4)
Beer (class 32) and Alcohols (class 33)
Computer software (class 9) and Computer software design service (class 42)
TV Broadcasting service (class 38) and TV pro gram production service (class 41)

4. Different class and characteristic list of goods

Example : Painting (class 2) and Floor tiles (class 19)
Metal ladder (class 6) and Elevator (class 7)
Sausage (class 29) and Bread (class 30)
Aircraft repairing service (class 37) and Air travel service (class 39)

The specification of goods shall be itemized according to List of goods and services (Nice Classification) by using only necessary words

or texts which are clearly and sufficiently for understanding the function or the usage of the goods.

The registration of identical or similar trademarks

Section 27

Where there are applications under Section 13 or Section 20 paragraph 1, as the case may be, if the Registrar finds there have been honest concurrent trademark users or special circumstances making it proper to do so, he or she may grant registration of such identical or similar trademarks of several owners subject to such conditions and limitations as to the mode or place of use or such other conditions and limitations as he or she may think fit to impose. The Registrar shall, without delay, notify the applicant and the registered owner of the order in writing with reasons.

The applicant or registered trademark owner may appeal an order of the Registrar under the first paragraph to the Board within ninety days from the date of receipt thereof.

Decisions of the Board under paragraph two shall be final.

According to the registration granting prescribed by Section 27, the Registrar shall perform such action by considering as mentioned below:

(1) To consider whether the trademark has been honestly, concurrently used by several users or not shall be done with the following criteria:

1. Each user has concurrently used the trademark with their product or has used the trademark before the other user is registered.

2. The users have no intention to copy other trademark.

This criterion can be considered by examining appearance of the trademark, such as invented word, invented device, and letter font, whether they are identical or similar or not.

3. The users do not know that there is another user owning an identical or similar trademark with them.

(2) There are special circumstances which are considered as follows:

1. A trademark which is not renewed but has been continuously used;

2. The goods has been traded, released, or advertised until it is commonly known in Thailand and the other trademark user does not settle the dispute over trademark usage rights;

3. There is a change of goods category due to the issuance of Notification of Ministry of Commerce, which will consequently find that the goods of such trademark users may have the same character;
or

4. There is the submission of registration allowance letter issued by

the assignor, the assignee, or all the inheritors prescribed in Section 51/1 paragraph 2. Granting of such registration, the Registrar may determine conditions and limitations as to the mode or place of use. However, the Registrar shall consider facts and cause of such circumstances mentioned by the applicant, as well as documents and evidence, on case by case basis.

Considering Orders in Accordance with Section 17

Considering orders in accordance with Section 17 can be divided into two cases:

1. If the trademark applied for registration contains one or more parts which are not distinctive and such parts are not essential for the trademark, the Registrar shall order the applicant to disclaim exclusive right to such a part or parts of the trademark in the following cases:

1.1 If the trademark contains a word or words directly referring to characteristic or quality of the goods, the Registrar shall order the applicant to disclaim exclusive right to such a word or words. For example, the word "NIVEA Soft", the Registrar shall grant the registration of the trademark but deny granting the registration of the word "Soft".

1.2 If the trademark contains geographical name as prescribed by Section 7 paragraph 2, the Registrar shall order the applicant to disclaim exclusive right to such geographical name. For example, the word "Snow Bangkok", the Registrar shall grant the registration of the trademark but deny granting the registration of the word "Bangkok".

1.3 If the trademark contains common modifiers or commonly used words, the Registrar shall not order the applicant to disclaim exclusive right to such a part or parts of the trademark. For example, the word "BLUE MOUNTAIN", the Registrar shall grant the registration of the trademark without denying granting the registration of the word "BLUE". For the word "TWIN RABBIT", the Registrar shall grant the registration of the trademark without denying granting the registration of the word "TWIN".

1.4 If the trademark contains unmodified, common letters and the words combined into one word, the Registration shall grant the registration of the trademark without ordering the applicant to disclaim exclusive right to such letters, even if they are not modified into a special manner. For example, the word "BBIRD", the Registrar shall grant the registration without ordering the applicant to disclaim exclusive right to the letter "B". For the word "K-KINE", the Registrar shall grant the registration without ordering the applicant to disclaim exclusive right to the letter "K".

1.5 If the trademark contains the words indicating the goods' origin, such as from China and made in Japan, the Registrar shall grant the registration and order the applicant to disclaim exclusive right to such words which is not a prohibited mark as prescribed by Section 8(6). The consideration of trademark as prohibited mark as prescribed

by Section 8(6) shall be done by checking nationality of the applicant. For example, the trademark contains the words "made in USA" but the applicant is Thai not American (nationality does not comply with the goods' origin), the trademark shall be considered as prohibited mark as prescribed by the Section 8(13) (causing the public to be confused as to the origin of the goods). However, if the applicant submits evidence of the goods' origin appearing on trademark or the applicant's nationality is the same as origin of the goods, the Registrar shall grant the registration and order the applicant to disclaim exclusive right to such words.

1.6 If the trademark contains words which are commonly used or known by public that those words are not registered for protection, such as brand terms, brand names, TM (an acronym, or different words with the same meaning), the Registrar shall grant the registration without ordering the applicant to disclaim exclusive right to such words.

1.7 If the trademark contains an article, such as a, an, the, and la, the Registration shall not order the applicant to disclaim exclusive right to such articles.

Note:

1. In the cases mentioned in 1.3, 1.4, 1.6, and 1.7, even if the Registrar does not order the applicant to disclaim exclusive right to such words, the applicant cannot claim for exclusive right to such words. Other users may combine such words with other words in their trademark as long as such combination is not identical or similar to other trademarks, and will not cause public to be confused or misled as to the ownership or origin of the goods (Supreme Court Judgement No. 14583/2557).

2. The trademark contains a part or parts which are common in the trade of some goods or categories of goods.

This case shall be considered in accordance with the Notification of Registrar on Common Elements in the Trade (Annex).

Consideration of allowance for claiming the first foreign application filing date as the filing date in Thailand according to the Section 28.

Considering orders prescribed by Section 28 shall be done with the following criteria:

1. The trademark shall be specified in the retroactive rights registration (Kor. 10) by the applicant.

2. The trademark shall be the same trademark registered for retroactive rights in foreign country. The consideration shall be focused on the trademark's appearance. For example, the trademark shall be presented in the same font.

If the trademark registered in foreign country is colored picture and the trademark applied for registration in Thailand has different tones of colors, they shall be considered as the same trademark, unless the trademark is a combination of colors.

3. If the trademark registered in foreign country is one of a series of trademarks and one or more marks in the series are identical to a trademark applied for registration in Thailand, they shall be considered as the same trademark.

4. The list of goods registered in foreign country shall cover all the goods applied for registration in Thailand.

5. The copy of foreign registration application shall be submitted.

6. There shall be a certification letter confirming that the foreign registration application has never been denied, revoked, or repealed. The certification letter may be signed off by either the owner or representative of the attorney in Thailand or foreign country.