

**THAILAND**  
**Manual of examination and opposition of Trademarks**  
B.E.2554 (2011)

Table of Contents

Preface

Chapter 1 Definition of Trademark

Chapter 2 Registrable trademarks

Part 1 Distinctive trademark

The mark itself be distinctive

Distinctive marks thru use

Part 2 Prohibited trademark for registration

Part 3 The consideration on identical or similarity of trademark

Part 4 The registration of identical or similar trademarks

Chapter 3 Opposition of trademark registration

Grounds for an opposition

The filing of opposition

The filing of counter statement

Extension of submitting supporting evidences

The consideration and determination of the opposition

Annex

## **Preface**

Trademark is an intellectual property which classify as one type of industrial property. It is an intellectual property which is essential to economic system and a trade of country. The Trademark Law protects the trademark's owner to have an exclusive right to use a trademark on registered goods while the law also protect the consumer from deceiving or confusion as to the origin of the goods which has an identical or similar to each other. It facilitates the consumer to purchase the goods as to the quality they need.

At present, there is an increasing of a number of trademark application. It caused from the people's awareness on the importance of trademark. In addition, the business sector has been increasingly expanded domestically and internationally. The Department of Intellectual Property as a responsible sector on a trademark registration with the Trademark Registrar, appointed by the Commerce Minister, as an examiner and determination. Since there are many Registrars divided by group of goods, therefore, the Manual of examination and opposition of Trademarks is made for the Registrars in order to be a guideline in making a consideration of a trademark application to be accurate and fair in the same way. It facilitates the operation on examination and determination to be more effective. Besides, the Manual is useful for the profession on trademark registration, people and interested person for further research.

The Department of Intellectual Property truly wishes this Manual is helpful to all related person.

Department of Intellectual Property

## Chapter 1 Definition of Trademark

The Trademark Act B.E. 2534 (1991) as amended by the Trademark Act (No.2) B.E. 2543 (2000) specified the definition of "Mark", "Trademark", "Service mark", "Certification mark", "Collective mark" in Section 4 as follows: "Mark" means a photograph, drawing, device, brand, name, word, text, letter, numeral, signature, combinations of colors, shape or configuration of an object or any one or 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. One or combinations of the mark in item Nos.1-12.

"Trademark" means a mark used or proposed to be used on or in connection with goods to distinguish the goods with which the trademark of the owner of such trademark is used from goods under another person's trademark.

### Examples



"Service mark" means a mark used or proposed to be used on or in connection with services to distinguish the services using the service mark of the owner of such service mark from services under another person's service mark.

#### Examples



"Certification mark" means a mark used or proposed to be used by the owner thereof on or in connection with goods or services of another person 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



"Collective mark" means a trademark or service mark used or proposed to be used by companies or enterprises of the same group or by members of an association, cooperative, union, confederation, group of persons or any other state or private organization.

#### Examples



(Siam Cement Group)



(Sahaviriya group)



(Robinson 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 one 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

List of goods: Airbag used with vehicle

รสชาติเต็มร้อย น้ำตาล 0 %

List of goods: Soft drinks

NATURAL DEFENSE  
2-WAY POWDER FOUNDATION

List of goods: Cosmetics

TREAT THE CONDITION. TRANSFORM THE LIFE |

List of goods: Pharmaceutical services

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

Example

**International  
NSERIES  
CLUB 2000**

**GUARANTY  
NINEMILLION  
59FIFTY**

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

Examples

- Pictures of lady or flowers are things that common to trade for some goods or some classes.
- Pictures of fish is thing that common to trade for fish sauce product.

(according to Trademark Registrar's Notification on the determination of things which are common to trade)

#### **Section 7 paragraph 2**

A trademark having or consisting of any one of the following essential characteristics shall be deemed distinctive:

(1) a personal name, a surname not being such according to its ordinary signification, a name of juristic person or trade name represented in a special manner

1. Registrable personal name must be considered as follows:

1.1 Personal name which has a title but no surname is registrable without representing distinctive characteristics (because people do not know whose name is but it needs to disclaim exclusive right to use the title)

Examples

Mr.Amnuay, Dr.Montree, Miss Somsri

1.2 Personal name which has no title and surname is registrable without representing distinctive characteristics

Examples

Amnuay, Montree, Somsri

2. Registrable surname must be considered as follows:

- 2.1 Must be represented in a special manner
- 2.2 Must acquire a permission from that person or parent, heirs or spouse (if any) in case that person is dead.
- 2.3 Must not be a well known surname (if it is, it is unregistrable though it represented in a special manner)

#### Examples

Well known surname is unregistrable.



**NobelGuide**

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*

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

- 4.1 Must be a full name of a juristic person which specified a juristic position
- 4.2 Must be represented in a special manner

#### Example



5. Registrable trade name must 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.

(2) a word or words having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the Minister in the Ministerial Notifications

"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 KOOL

Goods: Light filter films

AROY-D

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.



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 Though a word or words is stylized, it is unregistrable.

Examples



Service: Food and drinks



Service: Food and drinks

2. A word or words mentioned above must not be a Geographical name  
Geographical name means the name of the places in geographical whether it is Thai or foreign geographical areas such as name of country, name of continent, name of capital city, name of seaport, name of province, name of island, etc.

Geographical names considered from the characteristics as follows:

2.1 The Notification of Ministry of Commerce on the determination of geographical names (Annex)

2.2 The geographical names though it is stylized, it is unregistrable.

Examples



2.3 Words written as of the pronunciation of geographical name m

other languages (Transliterated word) shall be deemed as geographical names

Examples

**KunLun**

This word was written as pronunciation in Chinese language as "Kunlun" which is the name of mountain in Xinjiang precinct, People's Republic of China

(3) a combination of colors represented in a special manner, stylized letters, numerals or invented word

1. Combination of colors means the combination of colors starting from 2 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 Normal color code

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



2. Stylized letters means the letters in any languages which can be considered from characteristics as follows:

2.1 The letters which are cling to each other

2.2 The letters which is bold or depth

2.3 The letters which draw as pattern

2.4 The letters which is overlapped as shadow

### Examples Invented letters



3. Invented numerals mean numerals in any languages which can be considered from characteristics as follows:

3.1 The numerals which are cling to each other

3.2 The numerals which is bold or depth

3.3 The numerals which draw as pattern

3.4 The numerals which is overlapped as shadow

### Examples

#### Invented numerals



4. Invented word means the created words which has no meaning or translation.

### Examples

#### Invented words



The following words are not an invented word

4.1 The word that is made intentionally to be grammatically wrong spelling. If it is considered from the pronunciation, it is understood that it has meaning and those meaning directly refer to the characteristics or qualifications of the goods, it shall not be deemed invented word.

### Example

#### Uninvented words

**Super  
Klean**

List of goods: Cleaning cream

It is combined to mean as "Special clean".

**Kool**  
*Design*

List of goods: Freezer

It is combined to mean as "Design".

**Nature Kare**

List of goods: Cosmetics for face

It is combined to mean as "naturally nourishing".



List of goods: Rice

It is combined to mean as "save".

4.2 The word that written begins from 2 words combining in any forms and the meaning of those words having direct reference to characteristic or qualification of goods, it should not be deemed as an invented word.

Examples

Uninvented words

**POPSCENT**

List of goods: Perfume

It is combined to mean as "Popular fragrance scent".

Play**Online**

List of goods: Computer game service

It is combined to mean as "play with computer".


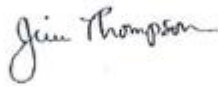
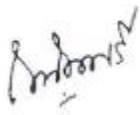
(4) The signature of the applicant for registration or some predecessor in his business or the signature of another person with his or her permission

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



(5) A representation of the applicant or of another person with his or her permission or of a dead 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. There must be a written document indicating the intention to use his representation as a trademark in case it is the applicant's representation.

2. There must be a written permission from the owner of representation to use it as a trademark in case it is a representation of others.

3. There must be a written permission from the parent, heir or spouse (if any)

allowing to use the representation as a trademark in case it is a representation of a dead person.

## Examples

### Representation of applicants

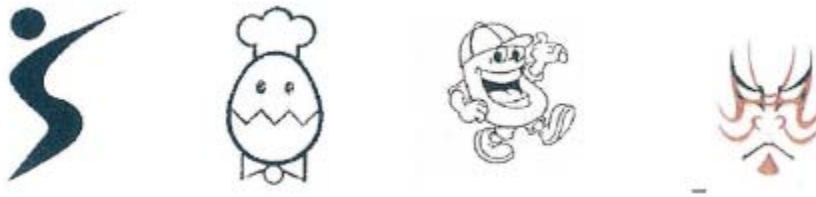


### (6) An invented device

The invented device means the device which is made, decorated, created, imagined or adapted and it must not be a picture of goods or services or things that is related to goods and services. Also, it must not be a picture representing the characteristics or qualification of goods or services.

## Examples

### Invented devices

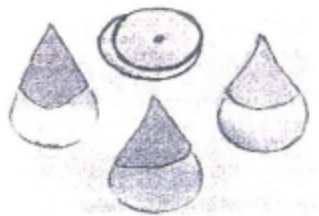


The mark which is a figure or shape of an object means the mark which has characteristic of figure or shape indicating width, length or depth and has a characteristic as follows:

1. A figure or shape which is not a natural design of the goods such as a round shape use with football.
2. It is not a figure or shape which is necessary for the technical operation of the goods such as siphon flash trap way shape use with sanitary ware.
3. it is not a figure or shape which add more value to the goods such as taking a gold or diamond to decorate on a normal container.

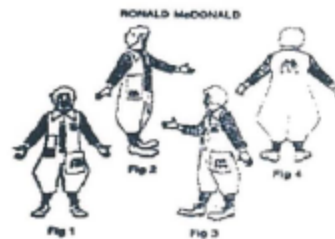
#### Examples

The distinctive figure or shape mark



List of goods: Perfume

Reason: The bottle's shape is similar to oval shape. The cover is acuminate which is similar to drop more than a bottle shape therefore it is distinctive.

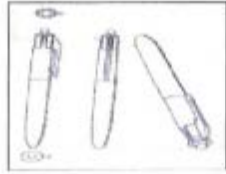


List of services: Providing restaurant services and facilitating business or places

Reason: The figure or shape has no characteristics related to the goods. Thus, it is distinctive.

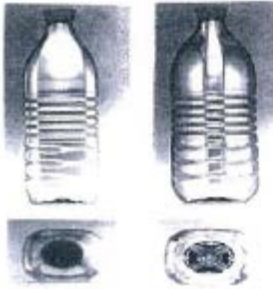
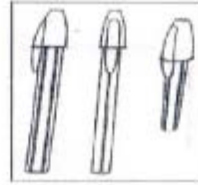
#### Examples

A figure or shape mark which has no distinctiveness



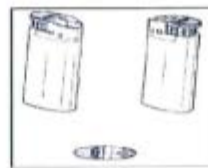
List of goods: Pen

Reason: it has normal shape and usability.



List of goods: Drinking water, Mineral water

Reason: It is a normal shape of drinking water container.



List of goods: Smoking lighter

Reason: it is a normal shape.



## Distinctive marks thru use

### Section 7 paragraph 3

There are sale, publicize or advertising trademarks until it becomes well known as the rules of the Minister has announced and it is able to 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. Evidences 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 evidences 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. The mark to be proved for distinctiveness must be the same mark as the filed. It can be said that the mark which is filed must be in the same mark appeared in evidences. It may be a little differences but not on the main part of the mark.

The examples of the evidences 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. Evidences on media advertisements
6. Sample of goods
7. Other evidences, 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:

(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.



(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.



*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*

(3) Royal names, royal monograms, abbreviations of royal names or royal monograms.



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

(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.

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



United Nations



World Intellectual Property Organization



Olympics



World Trade Organization

(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.)

(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.

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  
Nongsrichan 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

(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 consideration shall be considered from the current Notification of Ministry of Commerce on Rules on consideration of well-known mark (Annex)

### Examples

#### Well-known marks



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



(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

(13) Other trademarks prescribed by the Ministerial Notifications  
The consideration shall be considered from the Notification of Ministry of Commerce on prohibited marks (Annex).

#### Examples

National symbols which are prohibited to register (Annex)



## **Part 3 The consideration on identical or similarity of trademark**

### **Section 13**

Subject to Section 27, where the Registrar finds that the trademark for which an application for registration is filed:

- (1) is identical with a trademark already registered by another person; or
- (2) is so similar to a registered trademark of another person that the public might be confused or misled as to the owner or origin of the goods, and such application is for goods of the same class or for goods of a different class found by the Registrar to be of the same character, he shall not register such trademark.

If there are applications on the same class or different class of goods and the Registrar considers that they have the same character, he shall not register such trademark.

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

The word "similar" means the marks seem almost identical that the public might be confused or misled as to the owner or origin of the goods

The trademark search has 2 types as follows:

- 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-last sound as -ine (for medicines)
  - 2.4 Synonyms sound of each syllable

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



1.2 Word mark shall be considered on the letters or alphabets combining as words.

## Examples

**ARRIVAL** similar to **ARLIVAL**

**CALPICO** similar to **CAPLICO**

**SPARK** similar to **SPARC**

**NGK** similar to **NGK**

1.3 Device mark, word, label compose of many parts cooperate, it can be considered as follows:

1. Essential part of the marks is identical or similar though other parts of the mark are different, it shall be deemed similar.
2. Arrangement of figure or artificial picture of the marks are identical or similar though the essential part are different, it shall be deemed similar.

Example



Example



Example



## 2. The pronunciation

2.1 Device mark shall be considered and compared on the pronunciation of the picture whether it can be pronounced the same or similar to device or word marks of others.

Example



Example



Example



similar to



pronounces as tra-kra-tai-ruang-kow

2.2 Word mark shall be considered on the pronunciation of word in the same or different languages which has identical or similar pronunciations without concerning on the meaning or translation of such word. For example, the Thai letters "CHANG" is neither similar to the Roman letters "ELEPHANT" nor the Chinese letters pronounces as "CHIA" or "SIENG".

Examples

กะรัต

similar to

KARAT

Exteel

similar to

Xsteel™

BOS

similar to

บ๊อบ

GENIUS

จีเนียส

similar to

จีเนียส

ZANOCIN

similar to

SANOXIN

GOLD ROAST

similar to

GOLDROAST

3. The usage of trademark with the goods

3.1 It shall be considered from the mark appearing on goods which may cause confusion or misled the public such as the usage of the words "SOLD" and "SOLO" affixed on master key. It is possible that the letters "O" and "D" look similar.

3.2 It can be considered from type, quality, price or the reputation of the goods using that trademark such as the Roman letters "H HUNDAI" and "H HONDA".

Since it is an expensive goods therefore the consumer must make a decision before purchasing.

However, it must be considered strictly for the medicines and pharmaceuticals products.

4. An intention of the applicant shall be considered from the appearance of the applied mark for registration that the applicant has a dishonest intention to imitate or using reputation of other people's trademark. In this regard, it should be considered on case by case basis.

The Rule for consideration from Nos.1-4 as mentioned above shall use with the goods in the same class or different class which the Registrar considers they have the same character. As such, the Manual of examination and opposition of Trademarks B.E.2554 (2011) will be used as a guideline for operation.

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

E.g. 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

E.g. 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

E.g. 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

E.g. 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.

#### **Part 4 The registration of identical or similar trademarks**

##### **Section 27**

If the Registrar is of the opinion that there has been honest concurrent users or special circumstances which make it proper to do so, the Registrar may allow the registration by more than one owner of a trademark which is identical with or similar to a registered trademark under Section 13 or to trademarks applied for under pending applications under Section 20 in respect' of goods of the same class or goods of a different class but found by the Registrar to be of the same character subject to such conditions and limitations as to the mode or place of user or such other conditions and limitations as the Registrar may think fit to impose. The Registrar shall without delay notify the applicants and registered trademark owner in writing giving the grounds thereof.

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.

In Section 27, it is the case that there is a concurrent that applicants has filed the trademark application which is identical with or similar to other registered trademarks or identical with or similar to other pending trademark applications, however, the Registrar has considered that:

(1) There has been honest concurrent users which can be considered as follows:

1. Each person has used the mark with his goods or
2. They has no intention to imitate the marks of others
3. They do not know that others have used the identical or similar mark of his mark.

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

1. The mark was registered but failure to renew, however, it has been used or
2. The mark has been distributed or advertised until it is well known in Thailand.
3. There is an amendment of classification.

The Registrar may allow the trademark registration subject to conditions and limitations regarding usage or scope of use of the mark. In this regard, the Registrar shall consider the facts and circumstances that the applicants refer to including documents and evidences on case-by-case basis. (in compliance with the consideration of trademarks which acquire distinctiveness thru use according to Section 7 paragraph 3).



## **Chapter 3 Opposition of trademark registration**

### **Section 35**

After the publication of a trademark application under Section 29, any person who thinks that he has better right in the trademark than the applicant or that the trademark is not registrable under Section 6 or that the applicant is not in conformity with the provisions of this Act may, within 90 days from the date of publication under Section 29, file a notice of opposition with the Registrar stating the grounds of the opposition.

Oppositions under the first paragraph shall comply with the rules and procedures prescribed in the Ministerial Regulations.

### **Grounds for an opposition**

After the publication of a trademark application, any person is entitled to file an opposition with grounds of the opposition to the Registrar within 90 days from the date of publication if the person views that:

1. He has better right in the trademark than the applicant

In case the opposer claims that he has better right than the applicant, there might be happen as follows:

1.1 The opposer has filed the trademark application which is identical with or similar to the trademark of the applicant which is in publication period. The opposer is able to file an opposition to the Registrar.

1.2 The opposer has filed the trademark application which is identical with or similar to the a prior trademark application of the applicant. Therefore, the opposer is able to file an opposition to the Registrar when the Registrar publishes the trademark application of the applicant.

1.3 The opposer which is the real owner of trademark finds that other person has taken his trademark or similar mark to register without permission. Therefore, the opposer is able to file an opposition to the Registrar when the Registrar publishes the trademark application of the applicant.

2. The trademark application is not registrable under Section 6 as follows:

2.1 Lack of distinctiveness according to Section 7

2.2 Prohibited for registration under Section 8

2.3 Identical with or similar to other registered trademarks

according to under Section 13.

3. Trademark of the applicant which is wrongful registered according to this Act, it is broad specified grounds of opposition in order to cover other cases apart from Nos. 1 and 2.

For example, the Registrar orders for publication but the applicant has not complied with the Registrar's order correctly or the applicant has not fully paid for the fee.

### **The filing of opposition**

The opposition of trademark registration according to Section 35 paragraph 1 shall be in compliance with regulations and procedures as specified in the Ministerial Regulation(B.E.2535) (1992) in Chapter 2, part 4.

For the opposition of trademark application, the opposer can file the opposition with the documents as follows:

- (1) One copy of the notice of opposition
- (2) Identification card
- (3) Documents supported the opposition

In practice, the announcement of Department of Intellectual Property on title of the specification of form has specified to use Form Kor. 02 and the Ministerial Regulation B.E.2535 (1992) has specified the opposer to file a notice of opposition with a copy of it. The required documents attached with the opposition are as follows:

1) A copy of opposer's identification card (if the opposer is a natural person), a copy of passport (if the opposer is a foreigner) or an original copy of a company certificate, certified by the Registrar, and issue not later than 6 months (if the opposer is a juristic person) or the Power of Attorney which is made and notarized in abroad by having a certified statement the status of foreign juristic person with translation (if the opposer is a foreign juristic person).

2) A copy of Power of Attorney in case the opposer authorised other person to proceed it or a copy of notarized Power of Attorney with translation in case the opposer has no Thai nationality and the authorization is made in abroad.

3) A copy identification card of grantee.

In addition, the opposition fee is at 1,000THB per application according to the Ministerial Regulation (No.3) B.E.2540 (1997).

## **The filing of counter statement**

### **Section 36**

If an opposition is filed under Section 35, the Registrar shall send a copy thereof to the applicant without delay.

The applicant shall, within 90 days from the date of receipt of the copy of the opposition, file a counterstatement, in the form prescribed by the Director-General, stating the grounds on which he relies in support of his application. The Registrar shall send a copy of the counterstatement to the opposer without delay.

If the applicant fails to comply with the requirement under paragraph 2, he shall be deemed to have abandoned his application. In considering and determining the opposition, the Registrar may order the opposer and applicant to give additional statements, written explanations or evidence.

If the applicant or opposer fails to comply with the order of the registrar within 90 days from the date of receipt of the order, the Registrar shall proceed to consider and decide on the opposition on the basis of the existing evidence.

According to Section 36, if a notice of opposition is filed, the Registrar shall send a copy of the opposition to the applicant and the applicant has to file a counterstatement within 90 days from the date of receipt the copy of opposition. When the Registrar receives a counterstatement, the Registrar will send a copy of the counterstatement to the opposer.

If the applicant fails to submit the counterstatement to the Registrar within 90 days from the date of receipt, it shall be deemed that the applicant has abandoned his application.

Thus, the Registrar will dispose the application.

The applicant shall submit the counterstatement with the evidences as follows:

- (1) Copies of counterstatement as to a number of opposer
- (2) Supporting evidences of the counterstatement

### **Extension of submitting supporting evidences**

The supporting evidences shall be submitted together with a notice of opposition or counterstatement. The opposer or the applicant shall submit extension request for submitting the supporting evidences together with a notice of opposition or counterstatement. In this regard, the Registrar has the right to allow for an

extension for 2 periods. Each period shall not more than 30 days from the date of submitting the extension request in each time. In case the opposer or applicant fails to submit the supporting evidences within the time specified above, the Registrar shall proceed to consider the trademark application without holding for those evidences.

### **The consideration and determination of the opposition**

When the officer has already examination the opposition and counterstatement, which are filed to the Registrar, are legally in compliance with the law. The officer shall proceed the opposed trademark application for preparing the decision.

#### **1. Preparing the decision**

Before the officer will proceed with drafting the decision, the officer will prepare a conclusion of fact and analyze the points in the opposition and counterstatement together with consideration on submitted supporting evidences of the opposer and applicant in order to present to the Registrar whether or not to dismiss the opposition or restrain the trademark registration of the applicant. When the meeting, which comprised of Director of the Trademark office in act of the Registrar of opposition group, head of opposition group and the officers, issued a decision, there will be a procedure of the draft of decision presenting to the Registrar for the signature.

#### **2. The consideration and determination of a notice of opposition**

When there is a resolution of the meeting, the officer will proceed with drafting a decision with the reasons mentioned as of the grounds from the opposition as follows:

2.1 Whether or not the issues in the opposition of trademark registration are legal. This is the case that the applicant claims in the counterstatement that the opposer has no right to oppose trademark registration of the applicant since the opposer is neither the owner of the trademark which he has claimed nor an interested person in the trademark.

The consideration and determination shall be considered on the right to submitting an opposition in Section 35 of the Trademark Act B.E.2534 (1991) amended by Trademark Act (No.2) B.E.2543 (2000) provided that "Any person who thinks that.....that person may file a notice of opposition with the Registrar..... ". Any person in Section 35 is not specific to only the owner of trademark or an

interested person in trademark but it covers to any person who has a legal status also.

## 2.2 The issue of trademark's ownership

2.2.1 In case many persons claim for the ownership of the same or similar trademark applied for the same goods and request for the trademark registration of those marks, the principle in consideration is on first- to-file system. It means any person who submit the trademark application first shall be deemed the person who has a right to register prior to others with the exception that the opposer is able to prove to the Registrar that he is the real owner and has better right than the applicant.

2.2.2 In case other persons brought the trademark of the real owner to register without permission or imitate the trademark of the real owner.

In case owner of the trademark which is registered with a goods or many goods but claims for the ownership for the goods that he does not registered with, the principle in consideration is that any person who registered trademark with their goods shall be the owner and have an exclusive right to use trademark with those goods registered. Thus, that person cannot claim for the ownership of trademark for the goods which have not registered on the exception that the opposer is able to prove to the Registrar that the opposer is the real owner of the trademark and has better right than the applicant.

2.2.3 In case the trademark is registered in abroad but has not yet filed in Thailand and claim for the ownership of such trademark in Thailand, the principle in consideration is that the registered in abroad, has no legal binding in Thailand. However, it can be a fact to consider for the ownership and usage of the mark. The trademark, which is filed in Thailand, must be identical or so similar that the public might be confused or misled as to the owner or origin of the goods.

2.3 The issue of unregistrable trademark according to Section 6 uses the same principle as in consideration on examination and registering trademark.

## 3. The inform of a decision

### **Section 37**

The Registrar shall in writing notify the applicant and opposer of his decision with the grounds thereof without delay.

The applicant or opposer may appeal the decision of the Registrar to

the Board within ninety days from the date of receipt of the notification. The Board shall decide the appeal without delay.

When the Registrar has given decision, he shall notify the applicant and opposer of his decision without delay. If the applicant or opposer does not agree with the decision of the Registrar, the applicant or opposer is entitle to the Trademark Board within 90 days from the date of receipt of the notification.

## **Annex**

### **Trademark Registrar's Notification at 1/2546**

The determination of things which are common to the trade By virtue of provisions of Section 17 of the Trademark Act B.E. 2534 (1991) amended by the Trademark Act B.E.2543 (2000), the Trademark Registrar therefore issue the announcement as follows:

1. To revoke the announcement of Trademark Registrar at 1/2535 on The determination of things which are common to the trade dated March 6, 1992.

2. To use the announcement on determination of things which are common to the trade as attached to this announcement.

Announced on July 1, 2003

Signed by Mrs. Patchima Tanasanti

(Mrs. Patchima Tanasanti)

Trademark Registrar

**Things which are common to the trade**

As implied from Section 17 paragraph 2 of the Trademark Act B.E.2534 (1991)

Amended by the Trademark Act (No.2) B.E.2543 (2000)

Class	list of goods	Things which are common to the trade
3	Soaps, Fragrances, Essential oils, Cosmetics, Hair oils, Toothpaste, Fragrance powder	Ladies, Flowers, Flower's names, Stars, Crowns  Children
5	Human medicine	Snakes, King of Nagas, Hanuman, Hermits, Children, Nurses, Globe and the design of letters or numbers or intersect as a cross
7	Machines, Mechanical tools	Gears
24	Textiles Cotton, Silk fabric, Artificial fabric	Ladies, Elephants, Watches, Automobiles and Non-mechanic dragging machines, Old men, Tigers, Lions, Dogs The word "PRINT" is deemed as flower printed fabric.
29	Milk and powdered milk	Cows, Children and Nurses
30	Fish sauce and Shrimp paste Fish sauce	Shrimps  Fishes
33	Alcohols	Langur
34	Tobacco	Chickens, Pair of animals with shield Pair of animals with globe
1-45	Every goods in each classification	Pictures of goods or services or use related with goods or services and pictures that represent the meaning of character or quality of goods or services.



## **Notification of Ministry of Commerce**

### **Re: Determination of the Geographical Names**

By virtue of provisions of Section 5 and 7(2) of the Trademark Act B.E. 2534 (1991) amended by the Trademark Act B.E.2543 (2000), the Commerce Minister issued the Notification as follows:

1. To revoke the Notification of Ministry of Commerce No.5 B.E. 2535 (1992) on the determination of Geographical names as in Section 7(2) of the Trademark Act B.E.2534(1991) dated January 22, 1992.

2. The following Geographical names shall be deemed as Geographical names according to Section 7(2) of the Trademark Act B.E.2534 (1991) amended by the Trademark

Act (No.2) B.E.2543 (2000):

(1) Names of countries, Group of countries, Regions or Autonomous Regions which is the same as countries.

(2) Names of Region, State or Precinct

(3) Names of Capital city, Seaport, Province or Special Local Administrative District

(4) Names of Continent

(5) Names of Ocean, Sea, Gulf, Peninsula, Cape, Island, Archipelago or Lake

(6) Other Geographical names which are well known to the public such as Mountain, River, District, Sub-district, Village, Road etc.

The above Geographical names shall covered to the abbreviations, old names or generally referred to but not limited to official names.

To be effective from now on,

Announced on September 20, 2004

Signed by Mr. Wattana Muengsuk

(Mr. Wattana Muengsuk)

Commerce Minister

**Notification of Ministry of Commerce**

**Re: Rules for proving of distinctiveness in Section 7 paragraph 3 of the Trademark Act B.E.2534 (1991)**

**amended by the Trademark Act B.E.2543 (2000)**

By virtue of provisions of Sections 5 and 7 paragraph 3 of the Trademark Act B.E.2534 (1991) amended by the Trademark Act (No.2) B.E.2543 (2000), the Commerce Minister determined the distinctiveness as follows:

1. To revoke the Notification of Ministry of Commerce on Rules for determination of distinctiveness in Section 7 paragraph 3 of the Trademark Act B.E.2534 (1991) dated March 12, 2003.

2. The proving of distinctiveness by sale, publicity or advertisement of goods or services with the trademark, service mark, certification mark or collective mark until it is widely known to the public according to Section 7 paragraph 3 of the Trademark Act B.E. 2534 (1991) as amended by the Trademark Act (No.2) B.E.2543 (2000) must consist of the rules as follows:

(1) The good or services must be continuously sold, publicized or advertised for a period of time until general public or the public in the related field recognize and understand that those goods or services different from others.

(2) The sale, publicity or advertisement of goods or services until the mark is widely known in Thailand shall be deemed that the mark has a distinctiveness only on the goods or services that the mark is applied with.

(3) The mark that will be proved on distinctiveness according to this Notification must be the same mark with the applied mark for registration.

3. For proving the distinctiveness as specified in Article 2, the applicant shall submit evidences relating the sale, publicity or advertisement for the goods or services that used the mark which intend to register. Those evidences are such as copies of receipt for purchasing of goods or services, copies of receipt on advertisement expenses of goods or services, copies of invoices, copies of purchase orders of goods or services, copy of factory license, copies of evidences on advertisement in medias, Sample of goods or other evidences including witness (if any), etc.

4. For the evidence submission on Article 3, the applicant shall

submit evidences with the trademark application otherwise the applicant shall submit the extension request attached with the trademark application within 60 days from the date of submitting extension request.

In case the applicant fails to submit the evidences as specified above or having the letter informing not to submit the said evidence, the Registrar can proceed the trademark application with the existing of evidences as the applicant has filed (if any).

5. The proving of fact in Article 2 and the submission of evidences in Article 3 for the trademark, service mark, certification mark or collective mark applications which have been filed prior to this Notification is enforced, those applications shall fall into the Notification of Ministry of Commerce on Rules for determination of distinctiveness in Section 7 paragraph 3 of the Trademark Act B.E.2534 (1991) dated March 12, 2003 until the application is being registered or not being registered or the applicant abandons the application.

Announced on October 11, 2012

-Signature-

(Mr. Boonsong Teriyapirom)

Commerce Minister

## **Notification of Ministry of Commerce**

### **Re: Rules on the consideration of Well-known mark**

By virtue of provisions of Sections 4 and 8(1 0) of the Trademark Act B. E. 2534(1991) as amended by the Trademark Act (No. 2)

B.E.2543 (2000), the Commerce Minister determined the Rules on consideration of well-known mark as follows:

1. To revoke the Notification of Ministry of Commerce on Rules on the consideration of well-known mark dated July 4, 2000.
2. The consideration on well-known mark must consists of 2 components as follow:
  - (1) Goods or services which used with the mark must be widely sold or used or advertised or used by any methods such as use as mark of football team, etc. in good faith, no matter by the owner, a representative or a licensee whether or not in domestic or abroad until the general public or the public in related field in Thailand know it well.
  - (2) The mark must be famous and the consumers accept it.

To be effective from now on,

Announced on September 21, 2004

Wattana Muengsuk

(Mr. Wattana Muengsuk)

Commerce Minister

**Notification of Ministry of Commerce No.5 B.E.2543 (2000)**

**Re: Prohibited mark**

By virtue of provisions of Sections 5 and 8(13) of the Trademark Act B.E. 2534(1991) as amended by the Trademark Act (No. 2) B.E.2543 (2000) which is the Act, containing some provisions related on limitation of right and liberty of person, which Section 29 together with Sections 31 , 35, 48 and 50 of the Constitution of the Kingdom of Thailand enact to do so by the virtue of law, therefore, the Commerce Minister issued the Notification as follows:

1. To revoke the notification of Ministry of Commerce No.11 B.E.2540 (1997) Re: Prohibited Trademark dated May 13, 1997.

2. The following characteristics of trademark, service mark, certification mark and collective mark are prohibited for registration:

(1) The mark which identical with or similar to the international pharmaceutical names which the World Health Organization has been registered to reserve the possession right.

(2) The mark and descriptive words which the public might be confused or misled as to the kind of goods or services or the origin or ownership of the goods or services

To be effective from now on,

Announced on October 25, 2000

Suppachai Panichapak

Commerce Minister

**Notification of Ministry of Commerce No.2 B.E.2548 (2005)**

**Re: Prohibited marks**

By resolution of the Cabinet dated October 2, 2001, it is agreed to determine the Thai national symbols as National animal (Chang Thai or *Elephas maximus*), National flower (Ratchapruk or *Cassia fistula* Linn.) and National architecture (Sala Thai or Pavilion) and the Cabinet has acknowledged those 3 Thai national symbols as the Board of National characteristics proposed on February 1, 2005.

By virtue of provisions of Sections 5 and 8(13) of the Trademark Act B.E. 2534 (1991) amended by the Trademark Act (No.2) B.E.2543 (2000) which is the Act, containing some provisions related on limitation of right and liberty of person, which Section 29 together with Sections 31, 35, 48 and 50 of the Constitution of the Kingdom of Thailand enact to do so by the virtue of law, therefore, the Commerce Minister issued the Notification as follows:

1. Trademarks, Service marks, Certification marks and Collective marks, which contain Thai national symbols as pictures of Chang Thai, Ratchapruk, Sala Thai as attached to this Notification are prohibited for registration.

2. The Mark which contained or comprised of one or similar to characteristics of Thai national symbols according to Article 1 are prohibited for registration.

To be effective from now on,

Announced on March 30, 2005

Tanong Pittaya

Commerce Minister

## Pictures of Thai national symbol



ช้างไทย Chang Thai (Elephant ช้าง *Elephas maximus*)



ดอกราชพฤกษ์ Ratchaphruek (*Cassia fistula* Linn.)



ศาลาไทย Sala Thai (Pavilion)