

# Corporate Counsellor

TILLEKE & GIBBINS

## Listing trademarks

*Things to consider before registering*

**T**rademarks play a critical role in the marketplace. They permit consumers to identify the source or origin of goods or services. Consumers will generally assume that products or services from the same source will be consistent in terms of quality. In that sense, trademarks allow consumers to rely on past experience to make meaningful choices among competing products or services. In other words, consumers will tend to want to repeat satisfactory purchases and avoid unsatisfactory experiences.

The purpose of trademark laws is to assure that consumers can rely on trademarks to make choices by prohibiting competitors from using marks in a way that confuses consumers about the source or origin of the products in the marketplace.

Consumers benefit from trademarks because they are able to easily identify and obtain the goods and services they want. Businesses benefit because trademarks help them create and protect business goodwill. Goodwill represents the image or reputation of a business, which, while intangible, can be extremely valuable.

The legal framework for the protection of marks in Thailand is set out in the Trademark Act 1991, as amended by the Trademark Act (No. 2) 2000. Enforcement of trademark rights is governed by the Trademark Act, the Penal Code and the Civil and Commercial Code (CCC). Under this framework, there are several essential elements trademark owners should be aware of when considering protection of a trademark.

### REGISTRATION CONSIDERATIONS

To be recognised and protected as a mark, a word, name, symbol or device must be distinctive. If a mark is descriptive, on the other hand, ("crunchy" as a proposed mark for a cookie), generally speaking that mark may not be registered.

First, the criteria for what may qualify as a trademark are set forth in Section 4 of the Act. In addition to the usual text,

photographs, names, etc. that are usually protected in most jurisdictions, the Thai Trademark Act also provides protection for shapes and three-dimensional objects, groups of colours, and combinations of these concepts. Trademarks are intimately related to branding. One should think of registering any distinctive design, word, device, or combination of these concepts if there is any connection between the trademark to be registered and the desired or actual brand identity of the trademark owner.

Second, company names generally need not be presented in stylised form to qualify as a distinctive trademark so long as the name makes no attempt to establish a juristic status (e.g., "Co Ltd, Inc, or Limited").

Third, for purposes of registrability analysis, Thailand recognises the concept of "well-known mark" although the registrar's subjective opinion on what exactly constitutes a "well-known mark" controls the analysis. There is no objective list of well-known marks. Common examples are Coca Cola, Marlboro, McDonald's, Singha, etc.

Sometimes, a mark that is not distinctive by its very own nature can acquire distinctiveness through use. This concept is known as "secondary meaning." Secondary meaning arises when the relevant consuming public has been exposed to use of the mark enough to recognise the mark as an indication of the source of the product or service.

Fourth, Thailand is not yet a member of any international trademark treaties, such as the Madrid Protocol or even the Paris Convention. Some treaties such as this will generally streamline the procedures necessary for filing applications for trademarks in many different countries at the same time.

Lastly, trademark protection may be potentially valid forever, as one may renew a trademark any number of times.

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