Trademark Registration in Thailand

Introduction

The Thailand Trademark Act B.E. 2534(1991) provides protection for trademarks, service marks, collective marks and certificate marks. According to Section 6, there are three requirements for registering a trademark in Thailand

A trademark must
(1) be distinctive,
(2) not be prohibited under this Act.

Trademarks having or consisting of any of the following characters shall not be registrable:

2.1 state arms or crests, royal flag, official seals, royal decoration
2.2 national flags of Thailand, royal standards or official flags
2.3 royal names or name of royal families, royal monograms, royal initials
2.4 representation of the King, Queen or royal descendants
2.5 names, word, words or sign which are representative of the king, queen, royal descendants or royal families.
2.6 official sign, emblems of the Red "Cross" or "Geneva Cross"
2.7 a trademark which is contrary to public order, morality or public policy
2.8 a trademark which is the same as a generally famous trademark in accordance with the rules designated by the Ministry by notification or so similar thereto that the public may be confused as to the proprietor or origin of goods, regardless whether the trademark is registered.

(3) not be the same as or similar to a trademark registered by another person

The Act also requires that goods and services for protection must be specifically itemized. A broad description of goods or services might not be accepted.

Thailand utilizes the International Classification System in order to comply with its obligations to the World Intellectual Property Organization and as set forth in the TRIPs Agreement.

Registration

The trademark applications for registration must be filed with Department of Intellectual Property (DIP). Trademark applications are required to contain:

(1) A power of attorney executed by an authorized person and notarized by either a notary public or Royal Thai Embassy in the Jurisdiction where the person resides;

(2) A complete applicant information indicating applicant's name, address, country of resident and other contact information;
(3) Detailed specification of goods or services including information on international classes under which protection is sought;
(4) 20 specimens of the mark (should not larger than 5X5 centimeters in size)

Priority Claims

In some cases, the applicant may claim the priority date of the date of the first application outside the Kingdom be deemed the date of application in the Kingdom. In

order to qualify for a priority claim in Thailand, the following documents must be submitted within thirty days after the Thailand filing date

(1) certified true copy of the first application issued by the foreign trademark office;
(2) an official document issued by the foreign trademark office demonstrating that the trademark application was the proprietors' s first application;
(3) an official notification issued by the chief of the foreign trademark office in the jurisdiction where the application was originally filed indicating that the foreign country grants the same priority rights to Thai applicants filing trademark applications in that foreign country (Please note that Japan, South Korea, Switzerland, Spain, the United Kingdom and the United States of America are specifically excluded from this requirement due to reciprocal agreements between Thailand and those countries.)

All the above documents must be submitted to the DIP within six months after the first filing date in the foreign country

Trademark Search

As mentioned above, the trademark must not be identical with or similar to the registered trademark of another proprietor. The proprietors of the trademark should conduct an intensive search to ensure their trademark has not been previously registered. The search may be conducted in various forms, including by official publication, computerized datum (for text and graphics) and microfiche. The search is to be conducted at the DIP. There is an hourly official fee imposed by the DIP to conduct the search.

Proof of Use

Sometimes unexpected difficulties associated with similar or identical trademark, such as lack of distinctiveness, objections raised by the Registrar or challenges to ownership filed by the third parties and counter meatures may occur during the registration stage. To reduce the likelihood of these unexpected difficulties, the client should submit supporting documents which demonstrate the trademark existing reputation in the Thailand. The supporting documents should consist of copies of the mark's registration certificates or pending applications in other jurisdictions, evidence of advertising materials and/or invoices (showing the proprietor has formerly sold products containing the trademark). (Please note that in order to demonstrate distinctiveness, the Thai law requires that these supporting documents must be submitted to the Registrar within thirty days after filing date. We are available to provide assistance in collecting and preparing these supporting documents for an additional fee).

Time Frame

Normally, if no complications associated with the trademark application emerge, the Registrar shall grant registration of the mark within 10 to 12 months.

Fee & Expenses

The official government charges and our standard professional fees are presented in our attached fee schedule. Our professional fees may vary depending upon the number of applications to be filed and the number of goods and/or services in which the proprietor is seeking protection in each application. Please note that our professional fee and expense will be subject to 7% value added tax (VAT). All other

services we provide shall be charged on an hourly basis. Our professional fee, depending on the attorney in charge ranges from US$ 50 to US$ 200 per hour.

Recordal of the Assignment Agreement of Trademark

Either a trademark with an application pending or a trademark already granted registration can be assigned to any individual or juristic person. The required documents for recordal of the assignment of the mark are:

(1) an assignment Agreement executed by assignor and assignee;
(2) original Certificate of Trademark Registration (if any);
(3) a notarized Power of Attorney executed by assignee;
(4) a notarized Power of Attorney executed by assignor;
(5) the assignor and assignee's identification documentation.

Recordal of the Licensing Agreement of Trademark

The proprietor of trademark may grant a license of the mark to any third party. After the license is executed the licensee's use of the trademark shall be considered as use by the proprietor. The Trademark Licensing Agreement must be a written contract and registered with the registrar at DIP. The required documents for recordal of the Licensing Agreement of the Mark are:

(1) License Agreement of the Trademark executed by Licensor and Licensee which contains
- provision that owner can control quality of goods bearing the licensed mark;
- exclusive or non-exclusive right of licensee;
- period of licensing (definite or indefinite period).

(2) original Certificate of Trademark Registration.
(3) a notarized Power of Attorney executed by licensee.
(4) licensee's identification documentation.