

TRADEMARK THAILAND





INTELLECTUAL PROPERTY

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Generic considerations & Definitions

For trademark matters, Thailand is bound by the following treaties:

Treaty	Monitoring body	Accession date
Paris Convention for the Protection of Industrial Property (1883)	World Intellectual Property Organization (WIPO)	2008
Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989)		2017
Trade-Related Aspects of Intellectual Property Rights Agreement (1995)	World Trade Organization (WTO)	1995

Trademarks are subject to domestic law, which means that trademark owners must register their trademarks in each country or territory where they seek protection and in doing so, comply with national laws or treaties.

The World Intellectual Property Organization (WIPO) defines a trademark as “*a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises*”. The definition used under Thai law is similar: it is a **mark used or proposed to be used in connection with goods** (for a trademark) **or services** (for a service mark) **to distinguish said goods or services from the goods or services connected to another person’s mark** (Section 4 of Trademark Act (No.3) B.E. 2559). Certification marks¹ and collective marks² can also be registered in Thailand.

Thailand follows the “first to file” system, which means that the ownership of a mark is not established simply using the mark.

¹ Certification mark: used to certify the origin, composition, method of production, quality or other characteristics of such goods or services it is used in connection with (Section 4).

² Collective mark: 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 (Section 4).

Basic registrability criteria

Since the amendments introduced in the Trademark Act in 2016, a mark can be “*a photograph, drawing, invented device, logo, name, word, phrase, letter, numeral, signature, combination of colors, figurative element, sound*” or a combination of those ([Section 4](#)). It must be **distinctive, not prohibited under applicable laws and not similar or identical to pending or registered trademarks of other persons** ([Section 6](#)).

The **prohibitions** under Thai law can be divided into four categories ([Section 8](#)):

- Marks contrary to public order, morality and public policy.
- Marks confusingly similar to well-known marks.
- Geographical indications protected by law.
- Marks using seals, emblems, flags, names and the like, related to or used by the Thai government, the Thai royal family, foreign states and international organizations.

The **distinctiveness requirements are usually strictly enforced in Thailand**, and business owners should be mindful of choosing a mark, whether word, device, picture, or even sound, that makes no direct reference to the character or quality of the goods or services it is tied to ([Section 7](#)). In other words, descriptive marks should be avoided.

However, a trademark that is not distinctive per se may acquire **distinctiveness through use** if it can be demonstrated that it has been widely sold or advertised in Thailand for a significant period of time. As it was established through case law that a 2-year period of use was not sufficient, a period of 5-year of use is required as a rule of thumb.

The Department of Intellectual Property (DIP) may accept the following as evidence of use in Thailand (examples): receipts of sales of products or services; receipts of marketing and advertisement of the mark; purchase orders. The evidence should relate to either the sales of the products or services and/or the expense for advertisement of said products or services.

To ensure that the prospective mark is not **identical or similar to a prior mark** (pending or registered) belonging to a third party and used with the same type of goods or services, the applicant is advised to conduct a **trademark availability search** prior to filing a new application. In Thailand, the search can be done using the DIP online database (Thai language only).³ Such search engines are also available for trademark data in ASEAN countries⁴ and internationally on WIPO's website.⁵

Consent letters and co-existing similar marks

The registrar will generally **not admit** letters demonstrating that the applicant obtained the consent of the owner of a prior similar mark: two similar or identical marks having a different owner cannot coexist.

A few exceptions are tolerated by law when special circumstances and **honest use of identical or similar marks** make it “proper” to allow registration of such identical or similar marks. For instance, when two trademarks have been used in two distinct geographical areas and the owners of these trademarks cannot be considered as competitors. It can also occur if a trademark had not been renewed but was used continuously until its original owner re-files the trademark application.

Assignment or inheritance of a trademark may also lead to this “honest co-existence”: if the assignor of a trademark later applies for the registration of a trademark that is similar to the one assigned, a consent letter from the assignee (current owner of the first trademark) may be accepted to allow the registration of the later trademark.⁶

³ <https://tmonline.ipthailand.go.th/DipInternetWeb/trw/01/trw00q001/index.jsf> (last accessed 21/03/2021).

⁴ <http://www.asean-tmview.org/tmview/welcome> (last accessed 21/03/2021).

⁵ <https://www3.wipo.int/branddb/en/> (last accessed 21/03/2021).

⁶ Section 51(1).

Filing requirements

To register a trademark, an application form (“Kor.01”, in Thai language) must be filed by the applicant or their agent with an **office or address in Thailand** at the DIP or via the DIP online filing platform.

Online filing of trademark applications

The Thai DIP set up an online filing system, which can be used to file trademark applications and for most trademark prosecution matters. While only the electronic copies of the required documents need to be submitted, the original must be kept on hand in case they are requested by the registrar.

The following documents and information are required:

1. A copy of a notarized **Power of Attorney** (executed by the applicant or their legal representative) appointing the agent in Thailand – this document will cover required information on the applicant (name, address and nationality or country of incorporation).

If the applicant is a Thai national/corporation, a Power of Attorney (simply signed – no notarization needed) can be submitted together with a signed copy of the applicant’s national identity card (for individuals) or of the company registration certificate issued in the last 6 months (for corporations).

2. The **specimen of the mark** (word, picture, sound):
 - If it is a graphical representation, the specimen should be clear.
 - If it is in a word mark in a foreign language, the meaning and transliteration must also be indicated in Thai; if the registrar has any doubt regarding the translation provided, a certified translation may be required following examination.⁷
 - For a 3D mark, 7 views must be submitted (front, back, left, side, top, bottom and perspective).
 - If the mark is a sound or contains a sound element, the sound should be described and a recording not exceeding 30 seconds should be provided.

⁷ Section 12(2).

Black & white or colors?

A mark registered in black and white or using a grayscale will be protected in all other color combinations (Section 45). On the other hand, a mark registered in two or more colors will only be protected with the colors claimed. Therefore, it is advisable not to register the mark in color to provide the widest protection possible to the mark.

3. An enumeration of the **goods and/or services** to be used in connection with the prospective mark; multi-class filing is possible under Thai law.

Classification of goods and services in Thailand

Although Thailand has not endorsed the Nice Agreement on the International Classification of Goods and Services (1957), it uses the 11th edition of the Nice classification⁸ as a guideline, with some peculiarities.

As a result, many provisional refusals are issued against incoming Madrid applications since the designated goods and/or services are not a perfect match with the list used by the Thai Trademark Office. This significantly slows down the registration process for trademark applications introduced through the Madrid system. For instance, the item “pharmaceutical preparations” (in Class 5) will not be accepted, as it is considered too broad. Examples of acceptable items would be “pharmaceutical preparations for slimming purposes” or “...for skin allergies”.

Late filing of the copy of the Power of Attorney is possible upon request, within **90 days** from the date of filing the trademark application.

The **official filing fee** is calculated based on the number of designated goods or services (if not more than 5 items per class, THB1,000/item) or the number of classes (THB9,000/class). All official fees are indicated on the DIP website.⁹

⁸ <https://www.wipo.int/classifications/nice/nclpub/en/fr/> (last accessed 21/03/2021).

⁹ <https://www.ipthailand.go.th/en/trademark-006.html> (last accessed 21/03/2021).

While most formal elements of the application can be amended after filing (such as the address of the applicant), the list of goods and services can only be amended to include additional items at the registrar's request (that is if the initial list does not comply with local practices), or to delete some items ([Section 52](#)). The specimen of the mark can also only be amended at the registrar's request, usually to remove a specific element appearing on the logo.

Certification marks particulars

Besides the basic trademark filing requirements and registrability criteria, certification marks must comply with a few additional provisions.

Firstly, the application should be filed with the following additional documents ([Section 82](#)):

1. The regulations on the use of the certification mark: these must include the origin, composition, method of production, quality or other characteristics which are to be certified, and detail the rules, procedures and conditions for granting the certification.
2. The license or authorization provided by the relevant administrative body allowing the applicant to act as a certifying entity.

In addition, the owner of the certification mark cannot use their mark in connection with goods or services that they are providing, as they are to act solely as a certifying body.

Whenever new parties are "certified" and therefore authorized to use the certification mark, this authorization must be made in writing and signed by the owner of the certification mark.

Claiming priority

Thailand accessed the Paris Convention for the Protection of Industrial Property (1883) in 2008 and is also a member of the WTO. Therefore, the owner of a trademark that has been filed or registered in a country who also signed the Paris Convention and/or is a member of WTO, may claim the first foreign filing date as the filing date in Thailand, if the application is filed in Thailand within **6 months from the first filing date** (Section 28).

In addition to the documents listed above, a separate form must be submitted at the time of filing (in Thai language), along with:

1. The original certified copy of the foreign application (issued by the foreign trademark office); and
2. The statement asserting that the former application has not been abandoned or withdrawn (original required).

Late filing of these two documents is possible upon request, within **90 days** from the date of filing the trademark application.

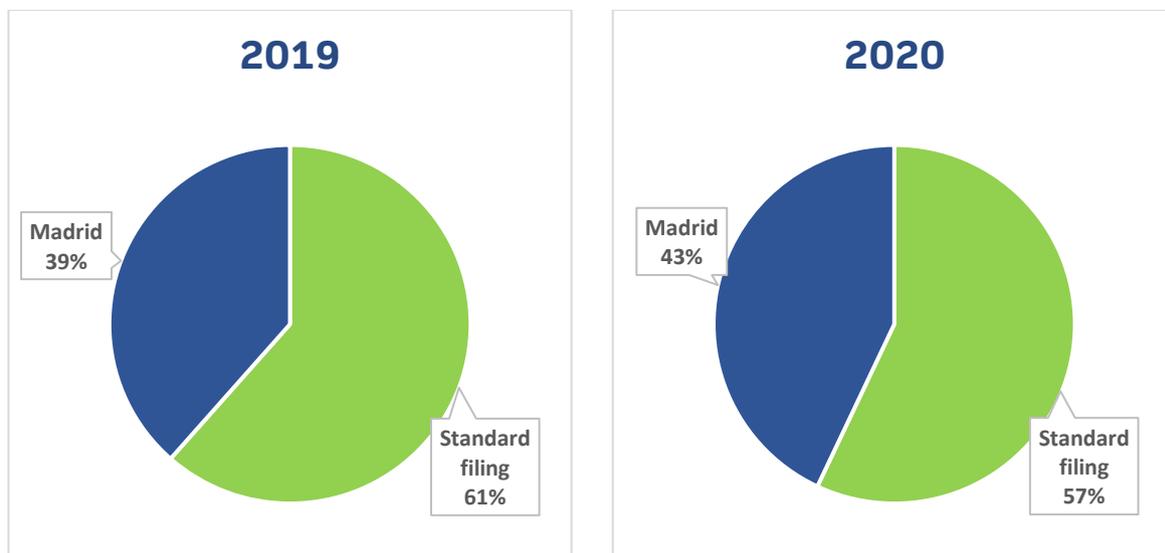
The assignment of a priority right is not possible for trademark applications.

Thailand and the Madrid Protocol

Thailand accessed the Madrid Protocol in 2017. As such, trademark applications can be filed in and out of Thailand via the so-called “Madrid system”, allowing for the filing of one trademark in several designated signatory states with the payment of one set of fees transiting through WIPO.

In **2019**, more than 8,000 applications designating Thailand have been filed via the Madrid System, which represented **38.5% of foreign applications** in Thailand; in **2020**, this number was down to 6,700 but represented **43% of foreign applications**.

APPLICATIONS WITH FOREIGN APPLICANTS FILED IN THAILAND



Incoming applications

A substantial number of incoming “Madrid applications” are objected by the Thai DIP due to Thailand’s specific requirements regarding the listing of goods and services. This generates additional cost for the applicants who should carefully select the items on the list of goods and/or services prior to file a trademark application in Thailand via the Madrid system.

If no objection is made by the registrar upon examination of the international application, the trademark will be published. If it is objected, a provisional refusal will be issued and forwarded to the applicant via WIPO.

If the basic application or registration is abandoned, rejected or cancelled, the applicant or trademark owner may file a national application in Thailand within 3 months. Provided that this application covers identical goods or services, the national filing date will be deemed to be the international registration date of the application or registration that has lapsed.



Outbound applications

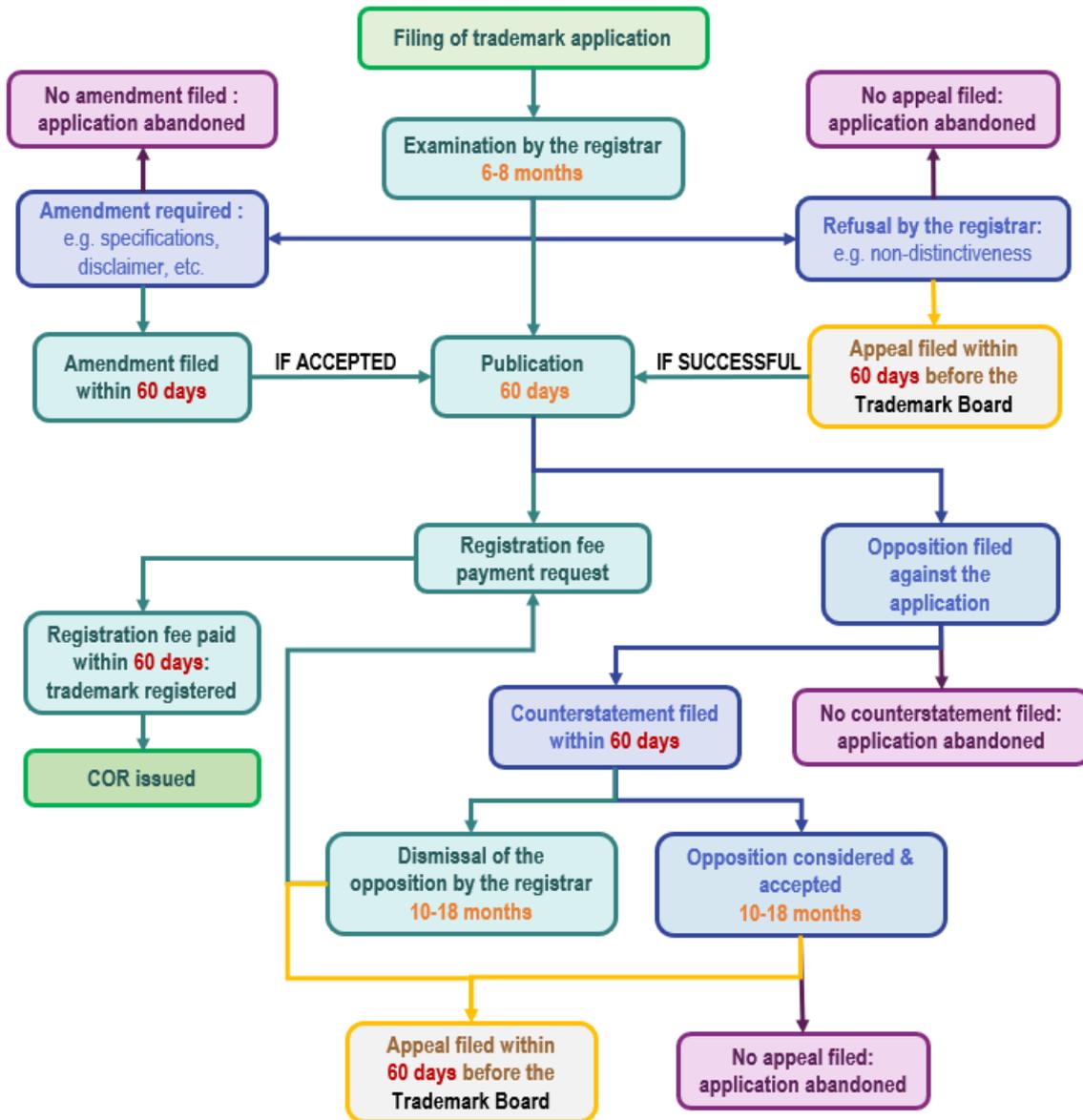
An international application can be filed in Thailand by a person who is the owner of a pending application or registered trademark in Thailand, and who either (a) is a Thai national or juristic person incorporated in Thailand; (b) is domiciled in Thailand; or (c) has an industrial or commercial establishment in Thailand.

When filing a Madrid application in Thailand, the DIP will collect an additional fee of THB2,000 per application.

Prosecution procedure

The trademark registration process in Thailand takes approximately **12 to 16 months**.

FROM FILING TO REGISTRATION - FLOWCHART



Protection of unregistered marks

During the prosecution of a trademark application, the mark is not protected under the Trademark Act, but Section 46 leaves the door open for the applicant to bring legal proceedings against any person for “passing off”. The applicant has thereby access to some legal defense mechanisms, under the provisions of the Civil and Commercial Code (Section 420) allowing them to seek financial compensation and under Section 272 of the Criminal Code (under the claim “Offences relating to Trade”, punished with imprisonment not exceeding 1 year and a fine not exceeding THB2,000).

Formal and substantive examination

After filing the application, the registrar will check whether it complies with the formal and substantive requirements set out by the above-mentioned laws and regulations. If any inconsistency is found, the registrar will either:

- Issue a **refusal** to register the mark if it is deemed prohibited, non-distinctive or similar/identical to prior marks (Sections 13 & 16), or
- Issue an **office action** to request the applicant to amend the application (Sections 15 & 17) or provide additional documents (Section 12).

In both cases, the applicant will have **60 days** from the date of receipt of the notification to answer the registrar:

- An **appeal** can be filed before the Trademark Board against a refusal to register the mark or a request to disclaim any non-essential element of the mark. It takes around **2 to 3 years** for the Trademark Board to issue a decision in appeal (see appeal flowchart in Annex).
- An **amendment** needs to be filed to comply with the registrar’s order to amend the specifications, modify the address of the applicant or the agent on record, or disclaim any non-essential element of the mark, as the case may be. In practice, it takes **3 to 6 months** to process the amendment, after which the application is published.

If the applicant fails to answer the registrar’s order within 60 days, the application is deemed abandoned.

Disclaimer good practice

It is advisable to file a disclaimer when the mark includes one or more words or device elements that are descriptive of the goods or services with which they will be used (or “common to the trade”), provided that the word(s) or shape(s) disclaimed constitute a non-essential part of the mark.

Filing a disclaimer together with the application will save cost and up to 6 months in the registration procedure, as the registrar will most likely issue an office action to request the applicant to disclaim the words (whether in English, Thai or other languages) or shapes that refer to the goods or services or that are considered “too generic”.¹⁰

As a result, the mark will still be protected as a whole, but the specific words or shapes disclaimed may be used by other parties providing similar goods or services. In other words, the owner of the mark will not have exclusive rights over the elements disclaimed.



Publication of the application and opposition proceedings

If the registrar has not raised any objection, the application will be published in the Thai Trademark Gazette within 9 to 10 months after the filing date.

The Trademark Gazette is published on the DIP website 4 times per month, in Thai language.¹¹

The publication period will last 60 days, during which any third party may raise an objection against the suggested trademark on the following grounds (Section 35):

- If they have better rights in the trademark than the applicant.
- If the application does not comply with the Trademark Act.

¹⁰ Section 17.

¹¹ <https://tmonline.ipthailand.go.th/DipInternetWeb/trw/01/trw00q004/index.jsf> (last accessed 21/03/2021).

Once the applicant is notified of the opposition by the registrar, they will have 60 days to issue a counterstatement, failing which the application will be deemed abandoned ([Section 36](#)).

In practice, the registrar will take about 1 year to issue its decision regarding the opposition, which will be notified to the applicant and the opponent. Both will have 60 days from the day they are notified to appeal the registrar's decision before the Trademark Board, whose decision can further be appealed before the Court of Appeal for Specialized Cases, whose judgment can, in turn, be contested before the Supreme Court.



Registration of a trademark

If no opposition is raised during the publication period, the registrar will request the applicant to pay the registration fee, which is THB600 per item (for not more than 5 items in 1 class) and THB5,400 per class. The applicant has 60 days from the day of receipt of the registrar's order to process the payment.

A Certificate of Registration can be obtained at the DIP simultaneously with the payment of the registration fee. The trademark will be registered for 10 years from the Thai filing date (or foreign filing date if priority is claimed), renewable indefinitely every 10 years.

The rights conferred to the owner of a registered trademark are as provided in the TRIP Agreement (Article 16), in essence, the exclusive right to use the trademark in connection with the designated goods and services and to prevent any third party from using a similar trademark for similar services and goods.

Single class or multi-class application?

Since 2016, trademark owners who wish to protect their trademarks across different classes of goods and services can do so by filing a single application. This procedure has the advantage of alleviating paperwork and reducing service fees at the different stages of the application process.

This might however raise issues in case a refusal is issued relating to one of the classes, as it will slow down the registration for the rest of the classes designated in the application.

Change of name and/or address

The documents required to register a change of name or address are:

1. A copy of a duly executed and notarized Power of Attorney (indicating updated name and address of the owner).
2. For a change name, the DIP requires a document issued by the relevant government office (for a company, the business department, for instance) certifying this change of name. A copy of such document is sufficient if the change of name is filed online.

It usually takes 4 to 6 months for the DIP to record the change and issue a confirmation letter.

Renewal

The renewal request can be filed within 3 months prior to the expiration date ([Section 54](#)). There is no document required unless the agent on record needs to be amended, in which case a copy of a signed and executed Power of Attorney needs to be provided.

Late renewal is possible in the 6 months following the expiration date (grace period) and sanctioned with a 20% surcharge of the official fees due. The standard renewal fee is THB2,000 per item (if not more than 5 items per class) and THB18,000 per class.

A new certificate of registration will be issued 3 to 4 months after the renewal fee is paid.

Assignment

The rights to a pending trademark application or to a registered trademark might be assigned or transferred to another party. This assignment or transfer needs to be registered at the DIP to take effect ([Section 51](#)). The following documents and information are required:

1. The original notarized copy of the merger documents OR the original notarized Deed of Assignment, specifying the name, address and citizenship of the assignor and assignee, the details of the trademark application or trademark being assigned, the territory (Thailand) and the effective date of the assignment, signed by both assignor and assignee. If the assignment request is filed online, only an electronic copy of these documents is required.
2. A copy of a notarized Power of Attorney executed by the assignee.
3. For a registered trademark: the original Certificate of Registration. If the assignment request is filed online, only an electronic copy is required.

The official fee to register an assignment or transfer is THB2,000 per application or per trademark.

The assignment will be effectively registered within 3 to 6 months. For registered trademarks, a new Certificate of Registration in the name of the new owner will be issued.

Trademark licensing

The owner of a trademark can authorize someone else to use their trademark in connection with some of or all the goods and/or services designated in the registration, with a license agreement.

To be effective in Thailand, this license agreement must be registered with the DIP, and include the conditions and terms of the use of the trademark and specify the goods or services with which the trademark is to be used by the licensee ([Section 68](#)). The registration of the license agreement takes 3 to 6 months.

The trademark owner must retain control over the quality of the goods or services provided under the license agreement. Failure to exercise such control can be cause for the cancelation of the license agreement by the Trademark Board, upon request by the registrar or a third party. The license may also be canceled by the Trademark Board if it is demonstrated that the use of the trademark by the licensee either confused the public or is contrary to public order, morality or policy ([Section 72](#)).

By default, unless otherwise provided in the license agreement ([Sections 77 to 79/1](#)):

- The trademark owner will retain the right to use the trademark and to sign license agreements with third parties.
- The licensee will be allowed to use the trademark in the entire country and with all the goods and services designated in the registration.
- The licensee will not be allowed to transfer the agreement to a third party or conclude sub-license agreements.
- Assignment or inheritance of the trademark will not revoke existing license agreements.

Cancellation of a registered trademark

By the owner

The owner of a trademark can request the cancellation of their trademark. There is no document required apart from the cancellation form, unless the agent on record needs to be amended, in which case a copy of a signed and executed Power of Attorney should be provided. If the trademark is the object of a license agreement, the consent of the licensee(s) is required to effectively cancel the registration ([Section 57](#)).

The cancellation of the trademark will be recorded within 3 to 6 months after the request is filed.

By the registrar

The registrar can initiate the cancellation of a registered trademark based on the following grounds:

- If it appears that the owner of the trademark violates or fails to comply with the conditions or restrictions prescribed upon registration ([Section 58](#)).
- If the owner or the agent ceases to have in Thailand the office or address as registered ([Section 59](#)). In this case, the registrar will order the cancellation of the trademark 1 month after notifying the owner or their representative if they fail to give a written explanation.

The owner of the trademark can appeal the cancellation order before the Trademark Board within 60 days from the date of receipt of the notification of the order ([Section 60](#)).

By a third party or the registrar

[If the trademark failed to comply with basic registrability criteria](#)

Any third party or the registrar can petition the Trademark Board to cancel a registered trademark **at any time** if it can be proven that at the time of registration it failed to comply with any of the basic registrability criteria detailed previously ([Sections 61 & 62](#)), i.e.:

- The trademark is not distinctive.
- The trademark contains any of the prohibited characteristics listed under Section 8.
- The trademark is identical or similar to a prior mark used with similar goods or services.
- The trademark is contrary to public order, morality or policy.

⊕ **If the trademark has not been used consistently or adequately**

In addition, while there is no formal requirement as to use of a registered trademark, it may however be canceled upon request, addressed to the Trademark Board, if it can be proven that (Section 63):

- **At the time of registration**, the owner had no bona fide intention to use the trademark with the designated goods or services AND it has in fact not been used with such goods or services; or
- The trademark has **not been used continuously for 3 years** prior to filing the cancellation request for no valid reasons (such as special circumstances in the trade).

After being notified of the petition for cancellation, the owner of the trademark will have 60 days to submit a reply to the Trademark Board (Section 64). After being notified of the decision of the Trademark Board, the parties can appeal the decision before the IP&IT Court within 90 days (Section 65).

Cancellation procedures under Sections 61 to 63 usually last around 6 to 8 months.

⊕ **If any third party has better right in the trademark**

In the **5 years following the date on which the registration of the trademark becomes effective**, any third party may petition the IP&IT Court to cancel the trademark if they consider they have **better rights in the trademark** than its registered owner (Section 67). This petition may concern all classes of goods or services or only some designated goods or services.

Such cancellation procedures last around 1.5 to 2 years.

⊕ **If the trademark has become generic**

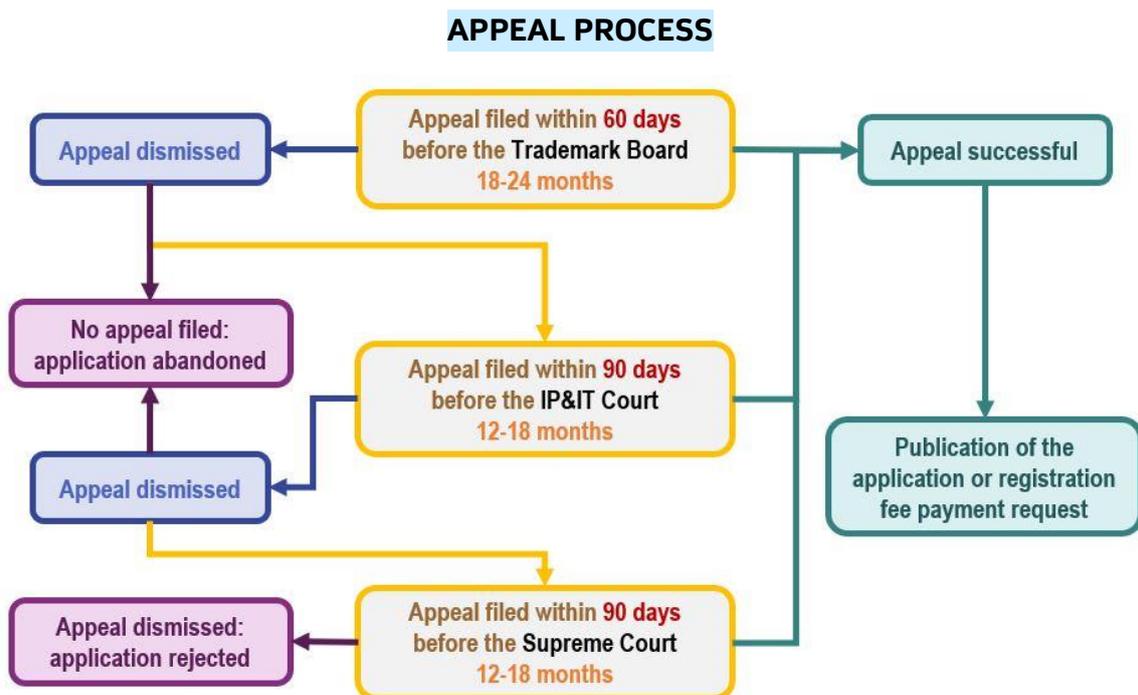
In exceptional cases, a trademark may be canceled by the IP&IT Court following a petition brought by the registrar or any third party ([Section 66](#)) demonstrating that the trademark has lost its meaning as a trademark and has become too common for the trade of goods or services it is used in connection with.

Examples of trademarks that became generic internationally are “Aspirin” or “Escalator”. Trademark erosion is a risk for well-known marks that become used figuratively, as mere dictionary words or elements of common language.

Annex 1 – Official fees

Type	Amount (THB)
Filing fee	Up to 5 items: 1,000/item More than 5 items: 9,000/class
Late filing fee	0
Priority claim fee	0
Registration fee	Up to 5 items: 600/item More than 5 items: 5,400/class
Amendment fee (application)	200
Renewal fee	Up to 5 items: 2,000/item More than 5 items: 18,000/class
Change of name or address	200/application 400/trademark
Opposition fee	2,000
Appeal fee (Trademark Board) (non-distinctive, similar or disclaimer)	4,000
Appeal fee (Trademark Board) (other grounds of refusal)	2,000
Petition for cancellation of other's trademark	1,000
Assignment of application or trademark	2,000
Recording license agreement	1,000

Annex 2 – Trademark appeal flowchart



We assist our clients in protecting their trademarks and other graphic signs used to distinguish their company, services or products. For more information, advice or quotation, please do not hesitate to contact us at trademark@tmp-ip.com.