

THAILAND

REGISTRATION OF MARKS

GENERAL NOTES

The Trademark Act 1991 was amended by the Trademark Act 2000. The amended Trademark Act took effect on June 30, 2000. The Act provides for registration of the following:

- ◆ TRADEMARKS
- ◆ SERVICE MARKS
- ◆ CERTIFICATION MARKS
- ◆ COLLECTIVE MARKS
- ◆ TRADEMARK/SERVICE MARK LICENSE/USER AGREEMENTS

Groups of colors, shapes of objects, or three-dimensional marks are registrable as marks if they are distinctive as required by the Act.

Unregistered marks are not protected under the Trademark Act. A trademark registration is valid for 10 years from application date, renewable for successive 10-year periods.

INSTRUCTION NOTES

1. GENERAL

All words in a mark and all documents required for filing an application must be translated into Thai. All translations will be prepared by Tilleke & Gibbins.

2. SEARCH

Before filing of applications, it is advisable to conduct a search of the marks which require registration to ascertain whether they are available for registration.

3. APPLICATION FOR TRADEMARK/SERVICE MARK REGISTRATION

In a mark application, the full class heading of the International Classification of Goods and Services cannot be used. In other words, an application cannot be filed for a whole class. The goods must be specifically listed in detail, and the government fee is calculated based on this listing.

After an application is filed and processed, it is published in the official *Trademark Journal*. If there is no objection within 90 days of publication, registration is granted in due course, dated as of the day of application. Barring any problems, it takes approximately 10 months for an application to be registered.

Along with instructions to apply for a trademark/service mark registration, the following documents are required.

- (1) A recently executed Power of Attorney complete with notarial acknowledgment. Sample formats are shown on pages 5 and 6 respectively.
- (2) A specimen of the mark. If the mark is in color, the specimen must be in color. Thirty originals of the specimen for each class of goods in which the mark is to be registered should be supplied. Alternatively, the required number of specimens can be printed here at a nominal cost. The size of the specimen should not be over 5 cm. (2 in.) in height or length; otherwise, there will be an additional government charge.

- (3) A detailed list of the goods/services to be covered by the application is necessary, as the full class heading of the International Classification of goods is not allowed.
- (4) An English translation of any non-English words in the mark, notarized Power of Attorney, and other documents which are not in English.
- (5) Evidence of prior use, if any, should also be submitted to the Registrar within 30 days from the filing date of application.

Priority can be claimed on applicant's first application filed abroad if the Thai application is filed within 6 months of the first filing date, provided that the applicant meets one of the following criteria:

- (1) The applicant is a national of a member country of an international convention or treaty for the protection of trademarks of which Thailand is also a member.
- (2) The applicant is a national of a country that grants the same right to Thai nationals or juristic persons whose principal offices are located in Thailand.

The following documents are required when claiming priority:

- A copy of the law stating that priority is granted to Thai nationals and persons whose head office of business is in Thailand in case the applicant's country is not a member country of an international convention or treaty for the protection of trademarks of which Thailand is also a member.
- A copy of the trademark application first filed abroad for the same trademark and goods as in the application filed in Thailand. The copy must be certified by a person with the authority to approve trademark registrations in the country of first application.
- A statement certifying that the application has neither been rejected (by the Registrar) nor withdrawn or abandoned by the applicant.

4. APPLICATION FOR CERTIFICATION MARKS

This application is for the protection of marks used for certifying the origin, components, manufacturing method, quality or other characteristics of goods, or for certifying the nature, quality and type or other characteristics of services. The filing procedure and required documents are similar to those for trademark and service mark applications. A copy of the regulations concerning the use of the certification mark and a document showing that the applicant is well qualified to certify the merit of the goods or services in the regulations are also required.

5. APPLICATION FOR COLLECTIVE MARKS

This application is for the protection of trademarks/service marks used or proposed to be used by companies, societies, associations, cooperatives, unions or federations, a group of persons or any private or government sector. The filing procedure and required documents are similar to those for trademark and service mark applications. A document showing the relationship of the joint authorized users of the collective mark is also required.

6. ABANDONMENT

It is provided that an application shall, after due notice from the Registrar, be deemed abandoned if no action is taken in accordance with the Registrar's instructions. No extension of time can be obtained.

7. AMENDMENTS, DISCLAIMERS, ENDORSEMENTS

Amendments and disclaimers are initially required by the Registrar regarding deletion of portion(s) of marks, amendment of specification of goods, disclaimers of generic terms, numerals and conflicting portions appearing on marks to avoid conflict of marks. Endorsement is required when an amendment is made on the registration.

8. RENEWAL

Application for renewal can only be made within 90 days prior to the expiration date. The following documents are required:

- (1) A duly notarized Power of Attorney issued by the applicant.
- (2) In case of renewal of trademark registration for whole goods or whole class under the old trademark law, a new itemized listing of the specific goods which will be reclassified under the International Classification of Goods or Services is necessary. The wording "**whole goods**" or "**whole class**" can no longer be used. The government fee is calculated from the list of goods. If reclassification results in specific goods falling under different classes, new additional mark applications may be required.
- (3) The original or a copy of the latest trademark registration certificate is required for endorsement.

9. ASSIGNMENT AND MERGER

A notarized Power of Attorney from the assignee and a certified Deed of Assignment are required. Signatures of both the assignor and assignee must be acknowledged before a Notary Public. In addition, the original or a copy of the latest trademark registration certificate is required for endorsement.

10. CHANGE OF NAME

A certified copy of the Certificate of Change of Name and Power of Attorney from the corporation/company in its new name are required. The Power of Attorney must be notarized. The original or a copy of the latest trademark registration certificate is required for endorsement.

11. LICENSE/USER AGREEMENT REGISTRATION

Owners of trademarks or service marks registered in Thailand who license other parties to use their trademarks or service marks for any or all of the goods or services for which the marks are registered are legally required to register the license agreements with the Trademark Office. License agreements which are registered are recognized under the trademark law. The benefit from such registration is that the use of the trademark or service mark by the licensee will be deemed as use of the mark by the licensor (the owner of the mark) which can be raised as a defense in the event of a cancellation action for non-use.

License agreements must be in writing and registered with the Trademark Office. To be registrable, the license agreement must contain the following particulars.

- The terms and conditions of the agreement between the owner of the registered mark and the authorized licensee, which conditions must actually enable the former to control the quality of goods manufactured or services rendered by the latter.
- The goods or services for which the licensed mark is used.
- Whether the authorized licensee has the exclusive right to use the mark or whether the owner of the mark can license other parties to use the mark.
- Other particulars, if any.

Trademark or service mark license agreements are governed by the provisions of the Trademark Act 1991 (Sections 68-79), the Ministerial Regulations, and the general laws of contract under the Civil and Commercial Code. Generally, the contracting parties can adopt any terms and conditions they deem to be appropriate and agreeable, as long as these terms and conditions are not contrary to public order, morality or government policy.

The documents required to file an application for registration of a license agreement are as follows:

- (1) Powers of Attorney from the licensor and licensee with notarial acknowledgment. Sample formats are shown on pages 7 and 8 respectively. If the licensee is a Thai company, a specific Power of Attorney form as shown on page 9 is required. This Power of Attorney does not require notarization. The Powers

of Attorney must be signed by the same authorized directors of the licensor and licensee who executed the license agreement.

- (2) The original license agreement executed by the authorized directors of the licensor and licensee or a certified copy of the license agreement notarized by a Notary Public, along with a Thai translation which can be prepared by us.
- (3) A copy of the latest certificate of trademark or service mark registration or renewal in Thai.

12. POWER OF ATTORNEY

A single notarized Power of Attorney is good for all applications having the same owner, but it is valid only for the calendar year of signature.

13. OPPOSITION AND CANCELLATION

Opposition can be lodged against trademark applications published in the Trademark Journal within 90 days from the date of publication. A time extension cannot be obtained.

In case of mark piracy, a cancellation petition can be initiated and submitted to the Board of Trademarks against a mark registration on the grounds of conflict with a well-known mark. Alternatively, a cancellation action may be filed directly with the court, claiming a better right over a mark and seeking cancellation of a mark registration within 5 years from the date the Trademark Registrar issued an order for such registration.

A cancellation petition against a mark registration on the grounds of non-use can be filed with the Board of Trademarks by requesting the Board to cancel such registration if it can be proven that the mark has not been used for 3 consecutive years following its registration and before such petition.

14. APPEAL

An appeal may be filed with the Board of Trademarks if the applicant is not satisfied with the Registrar's ruling. The appeal must be filed within 90 days from the date of receipt of the official notice. A time extension cannot be obtained.

15. SUBMISSION OF PROOF OF USE

If a trademark is not distinctive, the applicant is strongly urged to submit evidence of use, if any exists, together with the application or within 30 days of filing it. Proof of use may come in the form of leaflets, pamphlets, brochures, advertising and promotional materials, invoices, etc. Proof of use may be compiled by us if the applicant so requires.

IN WITNESS WHEREOF we have hereunto set our hands this _____ day of _____ in _____.

(Grantor)

Name:

Title:

NOTARIAL ACKNOWLEDGMENT
(Suggested Contents)

Before me, the undersigned Notary Public, on this _____ day of _____, _____, appeared Mr. _____, well known to me to be the person whose name is subscribed on the foregoing Power of Attorney, as being the _____

(Title)

of _____

(Name of Corporation/Limited Company)

which is likewise known to me to be incorporated (registered) under the laws of _____

(Place of Incorporation)

and to be actually in existence at this date.

(Signature of Notary Public)

(Notarial Seal)

NOTARIAL ACKNOWLEDGMENT
(See page 8 for suggested contents.)

POWER OF ATTORNEY

LICENSE REGISTRATION

KNOW ALL MEN BY THESE PRESENTS that we _____

_____ of _____

(Company Name)
(Full Address)

do hereby nominate and appoint **TILLEKE & GIBBINS INTERNATIONAL LTD. and/or MRS. DARANI VACHANAVUTTIVONG and/or MS. THIPARAT BURANAPHAN and/or MS. SONTAYA SUNKAPONGSE and/or MR. SRILA THONGKLANG and/or MR. NUTTAPHOL ARAMMUANG** of No. 1011, Supalai Grand Tower, 20th-26th Floors, Rama 3 Road, Chongnonsi Sub-District, Yannawa District, Bangkok 10120, Thailand, to be our true and lawful attorney or attorneys for us and in our name:

To apply for the registration of our license agreements; to withdraw our applications for registration of our license agreements; to file appeal petitions with the Board of Patents or the Board of Trademarks; to alter and amend the applications or registrations of our license agreements; to file petitions for the cancellation of license agreement registrations; to file counterstatements against cancellation petitions of license registrations; to enter into consent and compromise; to prosecute and defend license agreement registrations before the Registrar, the Examiner, the Board of Patent, the Board of Trademarks and the Courts of Thailand.

For the aforesaid purposes, in our name to sign and lodge all papers and writings which they or any of them in their aforesaid capacity may deem necessary or desirable; to alter and amend documents relating to the applications or registrations of our license agreements; to attend and appear on our behalf at Thailand government offices or elsewhere, or before any court or judicial officer in Thailand; to appoint a substitute or substitutes under him or them for the performance of any or all of the aforesaid acts, and the same at pleasure to remove, including previous attorney or attorneys; and generally to do all such acts, deeds and things as they or any of them may in their discretion think fit for the carrying out of these presents.

AND we hereby confirm and ratify whatsoever our said attorney or attorneys, substitute or substitutes may lawfully do by virtue of these presents.

IN WITNESS WHEREOF we have hereunto set our hands this _____ day of _____ in _____.

Name: _____ (Grantor)
Title: _____

NOTARIAL ACKNOWLEDGMENT (Suggested Contents)

Before me, the undersigned Notary Public, on this _____ day of _____, _____, appeared Mr. _____, well known to me to be the person whose name is subscribed on the foregoing Power of Attorney, as being the _____
(Title)

of _____
(Name of Corporation/Limited Company)

which is likewise known to me to be incorporated (registered) under the laws of _____
(Place of Incorporation)

and to be actually in existence at this date.

(Signature of Notary Public) (Notarial Seal)

NOTARIAL ACKNOWLEDGMENT (See page 8 for suggested contents.)

NOTARIAL ACKNOWLEDGMENT

(Suggested Contents)

City: _____)

State (Province): _____) SS:

Country: _____)

Before me, the undersigned Notary Public, on this _____ day of _____, _____, appeared Mr. _____, well known to me to be the person whose name is subscribed on the foregoing Power of Attorney, as being the _____

(Title)

of _____

(Name of Corporation/Limited Company)

which is likewise known to me to be incorporated (registered) under the laws of _____

(Place of Incorporation)

and to be actually in existence at this date.

Furthermore, I am aware that the foregoing Power of Attorney was signed on behalf of that Corporation (Limited Company) by authority of its Board of Directors (General Committee) and the said _____

(Name of Signer)

acknowledged that it was so subscribed by him as the free act and deed of that Corporation (Limited Company).

(Signature of Notary Public) (Notarial Seal)

POWER OF ATTORNEY

LICENSE REGISTRATION

KNOW ALL MEN BY THESE PRESENTS that we _____

_____ of _____

_____ (Company Name)

_____ (Full Address)

do hereby nominate and appoint **TILLEKE & GIBBINS INTERNATIONAL LTD. and/or MRS. DARANI VACHANAVUTTIVONG and/or MS. THIPARAT BURANAPHAN and/or MS. SONTAYA SUNKAPONGSE and/or MR. SRILA THONGKLANG and/or MR. NUTTAPHOL ARAMMUANG** of No. 1011, Supalai Grand Tower, 20th-26th Floors, Rama 3 Road, Chongnonsi Sub-District, Yannawa District, Bangkok 10120, Thailand, to be our true and lawful attorney or attorneys for us and in our name:

To apply for the registration of our license agreements; to withdraw our applications for registration of our license agreements; to file appeal petitions with the Board of Patents or the Board of Trademarks; to alter and amend the applications or registrations of our license agreements; to file petitions for the cancellation of license agreement registrations; to file counterstatements against cancellation petitions of license registrations; to enter into consent and compromise; to prosecute and defend license agreement registrations before the Registrar, the Examiner, the Board of Patent, the Board of Trademarks and the Courts of Thailand.

For the aforesaid purposes, in our name to sign and lodge all papers and writings which they or any of them in their aforesaid capacity may deem necessary or desirable; to alter and amend documents relating to the applications or registrations of our license agreements; to attend and appear on our behalf at Thailand government offices or elsewhere, or before any court or judicial officer in Thailand; to appoint a substitute or substitutes under him or them for the performance of any or all of the aforesaid acts, and the same at pleasure to remove, including previous attorney or attorneys; and generally to do all such acts, deeds and things as they or any of them may in their discretion think fit for the carrying out of these presents.

AND we hereby confirm and ratify whatsoever our said attorney or attorneys, substitute or substitutes may lawfully do by virtue of these presents.

IN WITNESS WHEREOF we have hereunto set our hands this _____ day of _____ in _____.

(Grantor)

Company seal

(Authorized Representative)

(Grantor)

(Authorized Representative)

(Witness)

(Authorized Representative)

(Witness)

(Authorized Representative)

(Authorized Representative)

(Authorized Representative)