

THAILAND TRADEMARK REFORM: THE KEY POINTS YOU NEED TO KNOW

The revised Thai Trademark Act is in force since **28 July 2016**. We have listed below the key changes legal practitioners and brand owners alike need to know about.

THE LEGAL CHANGES	THE PRACTICAL IMPLICATIONS
<p>Multi-class applications are allowed. One application can now cover several classes of products and/or services. It is possible to file either a single-class or a multi-class application.</p>	<p>At first, multi-class applications might be appealing for brand owners in terms of portfolio management, especially those who have a large number of trademarks in Thailand, since there would be only one Certificate with one registration number and one filing/registration date covering several classes.</p> <p>However, multi-class application does not bring any financial incentive since official fees remain the same for each class. There is no difference for official fees between a single-class application and a multi-class application. In addition, the drawback of a multi-class application is that in case an objection is raised by the Examiner or an opposition is filed in respect of some classes, this will affect all the designated classes. The application shall be accepted only if the refusal or opposition for the objected class(es) is overcome.</p> <p>There are pros and cons to both approaches. Careful thought must therefore be given when opting for a multi-class application or a single-class application.</p>
<p>Registration of associated marks is abolished. Similar/identical marks belonging to the same Applicant and applied for registration with similar products/services in the same and related classes no longer need to be registered as associated marks.</p>	<p>Assignment of certain identical/similar marks belonging to the same Applicant is now allowable. However, recordal of such partial assignment will be accepted only on the condition that the Assignor provides a Letter of Consent to the Assignee to be the new owner of such similar/identical mark.</p>
<p>Sound marks (e.g. musical jingle such as Tarzan yell) can now be registered in Thailand.</p>	<p>It remains to be seen how applications for this new type of mark will be examined. The legal requirements are the same as those applicable to the traditional marks, namely a mark must be possible (not forbidden under Thai law), valid (neither generic nor descriptive) and available (not be confusingly similar to and/or identical with prior rights).</p>
<p>Refilling is deemed as trademark infringement. Refilling genuine packaging and containers</p>	<p>This is a welcome development compared with the previous penalties that had little deterrent effect</p>

<p>bearing registered marks with unauthorized products (often for alcohol, shampoos, perfumes etc.) in order to mislead consumers into believing that such goods are those of the registered trademark owners is publishable under the new Thai Trademark Act. The penalties are increased to an imprisonment of up to 4 years and/or a fine of up to THB 400,000 (approximately EUR 10,000).</p>	<p>[under Section 272(1) of the Thai Penal Code, violators faced up to 1 year imprisonment maximum and/or a fine of up to THB 2,000 maximum (approximately EUR 50)] but will ultimately depend on its implementation and enforcement.</p>
<p>New deadlines to respond to Office Actions: 60 days (instead of 90 days) for filing amendments, disclaimers, oppositions and appeals whereas trademark holders are given more time to pay registration fees (60 days instead of 30 days).</p>	<p>These new deadlines would streamline the registration process which is expected to be completed within 16 months (instead of the usual 18-24 months).</p>
<p>Late renewal is now allowed within 6 months from the expiry date (subject to a 20% surcharge of official fees).</p>	<p>This grace period gives leeway to brand owners who missed the deadline for renewal and still wish to maintain protection of their marks.</p>
<p>New official fees for filing, registration and renewal.</p> <p>Filing: 1st -5th items per class: THB 1,000 per item More than 5 items per class: THB 9,000 per class (lump sum) <i>Instead of THB 500 per item.</i></p> <p>Registration: 1st -5th items per class: THB 600 per item More than 5 items per class: THB 5,400 per class (lump sum) <i>Instead of THB 300 per item.</i></p> <p>Renewal: 1st -5th items per class: THB 2,000 per item More than 5 items per class: THB 18,000 per class (lump sum) <i>Instead of THB 1,000 per item.</i></p>	<p>This new fee structure is preferential to brand owners seeking to protect a long list of products and/or services (<u>at least 18 products/services</u> per class when comparing with the previous official fees).</p> <p>It is thus even more crucial to develop a strong filing strategy so as to optimize costs and brand protection.</p> <p>Vidon has extensive experience in designing efficient specifications and managing both local and global IP portfolios. Please contact Ms. Chalinee Sriprasart at csriprasart@vidon.com or Ms. Noemie Sancelme at nsancelme@vidon.com for strategic advice.</p>

There will be another chapter as this new Trademark Act introduces the accession of Thailand to the **Madrid Protocol** (the International Trademark Registration system). The country is currently awaiting the implementing regulations (expected by end of 2016) for this system to be effective. This accession should make it easier for local and foreign businesses alike to expand internationally (by filing the basic application in Thailand which will serve as the basis of the international application) or in Thailand (by designating Thailand in the international application).