

## IP NEWSLETTER

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### UPDATING NEW THAILAND TRADEMARK ACT

The Thai Trademark Act (No.2) B.E. 2543 (A.D. 2000) was amended by Trademark Act (No. 3) B.E. 2559 (hereafter the “Act”), to improve trademark prosecution measures by the Department of Intellectual Property and, more importantly, to encourage Thai and foreign trademark owners to obtain legal protection of their trademarks. The Amendments were published in the Royal Gazette on April 29, 2016 and became fully effective on **July 28, 2016**.

The new amendments have both advantages and disadvantages for trademark owners. Some of the significant changes in the Trademark Act are presented below:-



- **The meaning of a trademark:** The term “trademark” (and its legal protection) extends to “**sound**” and other works which is a combination of device, brand, name, word, letter, numeral, signature, combinations of colors, shape or configuration of an object. “Sound” as a registrable mark is defined in Section 4 of the Act . The distinctiveness features of a “sound trademark” are also added in Section 7, para. 2 (11) of the Act.
- **New facilities for international trademark registration under the Madrid Protocol.** The Act prepares the way for Thailand to become a party to the Madrid Protocol which allows trademark owners to register their marks in many countries at a time through the filing of a single application with the Department of Intellectual Property. However, these provisions will not be effective until Thailand becomes a party to the Madrid Protocol, which is expected to happen in the near future.

- **Distinctiveness of a registrable trademark:** Under Section 7, as amended by the Act, the constituents of distinctiveness of a trademark are listed under each subsection of this Section in order to avoid misinterpretation, e.g.. *“invented word,” “invented letter or numeral,” “combination of colors presented in a special manner,” “picture which does not directly describe the quality and/or appearance of the goods for which the mark is being applied for registration” and “dimensional feature or shape which does not partake the natural characteristics of, or is not essential to the functionality of the goods for which the mark is being applied for registration, , or is not a feature or shape that would add value to the goods for which the mark is being applied for registration.”*
- **A multiple-class application: A multiple-class application is available.**
- **An association of trademarks and related assignments:** The registration of associated trademarks is abolished. All associated trademarks under the previous Trademark Act are nullified as if they were not registered as associated trademarks. As a result, all trademark applications/registrations can now be assigned individually and separately by virtue of the Act.
- **Six months grace period for trademark renewal:** Under the Act, a grace period of six months is allowed for late renewal, subject to payment of a surcharge of 20% of the regular renewal fee.
- **Change of government fees:** All government fees are changed by the Act. Examples of such changes are shown in the comparable table below:-

Works	Government fees under previous Trademark Act (No.2)	Government Fees under new Trademark Act (No.3)	
		For each goods/service in one Class up to 5 goods/services	For 6 or more goods/services in one Class (flat fee)
Filing new trademark application	THB500	THB1,000	THB9,000
Registering trademark	THB300	THB600	THB5,400
Filing renewal application	THB1000	THB2,000	THB18,000
Filing amendment application for "registered trademark"	THB200 per one application	THB400 per one application	
Filing amendment application for "pending application"	THB100 per one application	THB200 per one application	
Filing appeal petition to the Board of Trademarks	<p>THB2,000 per application</p> <p>(This rate is applied for appeal against rejections/instructions under Sections 16, 17, 27 and 37)</p> <p>THB1,000 per application</p> <p>(This rate is applied for appeal against rejections/instructions under other Sections)</p>	<p>THB4,000 per one application</p> <p>(This rate is applied for appeal against rejections/instructions under Sections 16, 17, 27 and 37)</p> <p>THB2,000 per application</p> <p>(This rate is applied for appeal against rejections/instructions under other Sections)</p>	
Filing opposition	THB1,000	THB2,000	