

Headline: **Qualification and protection of a well-known mark**

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With regard to the legal basis of trademark protection in Thailand as a member state of the Paris Convention, a trademark will be granted full protection only in case that such trademark has been registered. Thus, trademark protections are mostly provided to the owners of the marks under "Registration System".

Despite the above, an unregistered trademark may still be protected due to its status as a well-known mark. Such protection is obliged for the member states of the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPs Agreement).

### **Well-known marks in Thailand**

Due to the Thai Trademark Act does not provide specifically definition of "well-known marks", the Thai Department of Intellectual Property defines the extent of a well-known mark by referring to the criterias of World Trade Organization (WTO) and TRIPs Agreement i.e. 1) recognition by the general public; or 2) recognition of the public in related field of goods/services; or 3) consumer acceptance in the reputation of trademark.

### **Scope of the protection for well-known marks in Thailand**

Whereas the scope of protection of an ordinary registered trademark is limited to the designated goods/services for a renewable term of 10 years, the scope of protection of a well-known trademark extends to all classes and all kinds of goods/services for unlimited period.

### **Recordation of well-known marks in Thailand**

In order to record the status as a well-known trademark on the Register, the trademark owner may request the DIP by filing an application for recordation of well-known trademark along with evidences to prove that the trademark has been extensively used in Thailand, and the public has already recognized this trademark. If the Board of Well-known Trademark is satisfied with the provided evidences, such trademark will be included in "the official List of Well-Known Trademarks". One of the purposes of such record is to use as evidence against other similar marks in case of conflict, whereas the unlisted well-known trademark would require further investigation on the well-known status in the Court.

### **Qualifications for a recordable well-known mark**

1. A well known mark can be a trademark, service mark, certification mark, collective mark or mark used with objects other than for the goods or services;
2. Can be either a registered mark or an unregistered mark;
3. Be a mark which has been continuously and extensively used for goods or services by ways of distributions, advertisements or other means up until present time;
4. The uses of trademark can be either in Thailand or foreign countries that enable the public or related persons to recognize such trademark or accepted by consumers;

5. The trademark may be used by the trademark owner, a representative or a licensee whether in Thailand or in foreign countries.

*Please note that the Trademark Office has withheld the recordation of well-known trademark as of December 2014 due to the upcoming changes in legislation regarding this matter. However, the owner of a well-known trademark can still claim the protection through presenting evidences to prove the status in Court should any conflict occur.*