

NON-USE CANCELLATION AGAINST TRADEMARK REGISTRATION IN THAILAND*

*Jeerakarn Nakarat***

ABSTRACT

Non-use cancellation is a legal proceeding for cancelling the registration of trademark based on the claim that such trademark has not been genuinely use in course of trade, within a proper period, by the trademark owner who registers such trademark to commercially utilize to the trade and benefit to the economic. In addition, the cancellation can also claim that such trademark owner has no intention to use the trademark in commerce. This kind of cancellation, non-use scheme, can be a significant method for cleaning up the cluttered Registry records, and help in revoking the registration of unused trademarks from the system. This could, in turn, provide the opportunities for later comer, who may genuinely use an identical or similar trademark in commerce, but its application has been rejected by the Registrar due to the obstacle of the prior registration of such unused trademark. The later comer may file a cancellation to eliminate such obstacle and finally obtain the protection.

In Thailand, although the provision regarding non-use cancellation proceeding has been provided under Section 63 of Thai Trademark Act B.E. 2534 (1991). However, considering on the precedent orders of Board of Trademark and Supreme court's judgment, it appears that the non-use cancellation in Thailand has been a difficult proceeding in practice. Due to the facts that a petitioner, who files a cancellation request, must bear the burden of proof showing the absolute non-use of the registered trademark that

* This article is summarized and arranged from the thesis “Non-use Cancellation against Trademark Registration in Thailand” Master of laws in Business law (English Program), Faculty of Law Thammasat University, 2015.

** Graduate student of Master of Laws Program in Business law (English Program), Faculty of Law Thammasat University.

belongs to the other party. Moreover, the petitioner is also required to prove the intention in mind of the registrant demonstrating lack of bona fide intention to genuinely use the trademark in relation to the registration. These burdens to produce the evidences in term of such negative facts seem to be impossible for the petitioner. In addition, Thailand does not allow partial cancellation, which is resulting that the petitioner must prove the actuality of non-using of trademark on every items as applied in the registration. Besides, the standard of proof required by the Board of Trademark has been set very high. These requirements have put more burden to the petitioner. Where the non-use cancellation rarely succeeds, the unused trademark registration would be as a barrier for the new investors to put invest their business in the country where their trademarks could, perhaps, be in risk of not being protected.

For the above reasons, the Author therefore has studied on the problems in practice of non-use cancellation proceeding in Thailand, by comparing with the provisions and proceedings of this scheme that have been adopted in foreign countries e.g. the United States of America, the United Kingdom, Japan and the People Republic of China. According to the research, the Author found that the burden of proof and requirement for standard of proof in such jurisdictions have been stipulated differently from Thailand, which enable the non-use cancellation in these particular countries are efficiently implemented. It is to say that the successful non-use cancellation scheme is also benefit to urge the registrant to be aware of genuinely use its trademark in course of trade, which plays a vital role in balancing between the rights given to the trademark owner and public interest, as well as supporting the improvement of trade and economic growth. As a result, adopting the advantages and goodness of non-use cancellation proceedings from foreign countries could enlighten Thailand to see the unresolved problem and significant necessity to eliminate the obstacles that block the foreign investor to come invest in Thailand and impede the economic growth.

Keywords: Trademark, Non-use Trademark, Cancellation, Non-use Cancellation

บทคัดย่อ

บทบัญญัติเกี่ยวกับการเพิกถอนทะเบียนเครื่องหมายการค้าด้วยเหตุที่ไม่มีการใช้ (Non-use cancellation against trademark registration) คือ การเพิกถอนการจดทะเบียนของเครื่องหมายการค้าบนข้ออ้างที่ว่า เครื่องหมายการค้าที่ได้รับจดทะเบียนแล้วไม่ได้ถูกใช้ให้เกิดประโยชน์ในทางการค้าอย่างแท้จริง (Genuine use) ภายในระยะเวลาที่เหมาะสมโดยเจ้าของเครื่องหมายการค้าผู้ยื่นขอจดทะเบียน หรืออาจเป็นกรณีการเพิกถอนทะเบียนเครื่องหมายการค้าบนข้ออ้างที่ว่า เจ้าของผู้ยื่นขอจดทะเบียนไม่มีความตั้งใจที่จะใช้ (Intention to use) เครื่องหมายการค้าดังกล่าว ซึ่งกระบวนการเพิกถอนในลักษณะนี้มีความสำคัญที่สามารถช่วยลบล้างเครื่องหมายการค้าที่ไม่ได้ใช้ทั้งหลายออกจากระบบข้อมูลในบันทึกของนายทะเบียน และเป็นการเปิดโอกาสให้บุคคลอื่นที่อาจใช้เครื่องหมายการค้าที่มีลักษณะเดียวกันหรือเหมือนคล้ายกันแต่ไม่สามารถจดทะเบียนได้เนื่องจากมีเครื่องหมายการค้าที่ไม่มีการใช้จริงดังกล่าวจดทะเบียนไว้ก่อนหน้าอันเป็นอุปสรรคขัดขวางการจดทะเบียนของผู้ขอรายหลังนี้ สามารถยื่นคำร้องขอเพิกถอนเพื่อขจัดอุปสรรคดังกล่าวและขอรับความคุ้มครองในเครื่องหมายการค้าของตนได้ในภายหลัง

ในประเทศไทย แม้พระราชบัญญัติเครื่องหมายการค้า พ.ศ. 2534 จะมีบทบัญญัติเกี่ยวกับการเพิกถอนเครื่องหมายการค้าด้วยเหตุที่ไม่มีการใช้บัญญัติไว้ในมาตรา 63 ก็ตาม แต่เมื่อศึกษาถึงแนวทางของคำสั่งของคณะกรรมการเครื่องหมายการค้าและคำพิพากษาของศาลฎีกาในกรณีดังกล่าว จะเห็นได้ว่า การเพิกถอนเครื่องหมายการค้าตามมาตรา 63 นั้นเป็นไปได้ยากในทางปฏิบัติ เนื่องจากผู้ยื่นคำร้องขอ (Petitioner) จะต้องเป็นผู้ที่มีภาระการพิสูจน์ถึงการไม่ได้ใช้เครื่องหมายการค้าที่จดทะเบียนแล้วในทางการค้าอย่างแท้จริง ซึ่งเป็นเรื่องยากที่ทางผู้ยื่นคำร้องขอจะสามารถนำสืบข้อเท็จจริงหรือหลักฐานอันเป็นการพิสูจน์หลักฐานในเชิงปฏิเสธ (Negative facts) เกี่ยวกับการไม่ได้ใช้เครื่องหมายการค้าของบุคคลอื่น ยิ่งไปกว่านั้น ผู้ยื่นคำร้องขอจะต้องพิสูจน์ให้เห็นถึงเจตนาภายในของเจ้าของเครื่องหมายการค้าผู้จดทะเบียนด้วยว่า ไม่มีความตั้งใจโดยสุจริตที่จะใช้เครื่องหมายการค้าดังกล่าวเลข ซึ่งเป็นเรื่องที่แทบจะเป็นไปไม่ได้ อีกทั้ง กฎหมายยังมีข้อกำหนดของกระบวนการอื่นการเพิกถอนที่ทำให้ผู้ยื่นคำร้องขอจะต้องพิสูจน์ถึงการไม่ได้ใช้เครื่องหมายการค้าดังกล่าวกับทุกรายการสินค้าที่ขึ้นขอจดทะเบียนและมาตรฐานของการพิสูจน์นั้นก็ได้อูกำหนดโดยคณะกรรมการเครื่องหมายการค้าไว้สูงมาก อันเป็นการเพิ่มภาระให้แก่ผู้ยื่นคำร้องมากยิ่งขึ้น ในประเทศที่การเพิกถอนการจดทะเบียนเครื่องหมายการค้าที่เป็นอุปสรรคนั้นกระทำได้ยาก การจดทะเบียนของเครื่องหมายการค้าที่ไม่ได้ใช้จริงในทางการค้า

นี้จะส่งผลให้กำแพงซึ่งกีดกันนักลงทุนรายใหม่เข้ามาลงทุนในประเทศ เนื่องจากเครื่องหมายการค้าของเขาเหล่านี้อาจมีความเสี่ยงที่จะไม่ได้รับความคุ้มครอง

ด้วยเหตุนี้ ผู้เขียนจึงได้ศึกษาถึงปัญหาของกระบวนการเพิกถอนการจดทะเบียนดังกล่าวในเชิงปฏิบัติ โดยได้เปรียบเทียบกับบทบัญญัติและกระบวนการเพิกถอนการจดทะเบียนในลักษณะเดียวกันที่ได้ใช้บังคับอยู่ภายใต้กฎหมายในต่างประเทศ อันได้แก่ สหรัฐอเมริกา สหราชอาณาจักร ญี่ปุ่น และสาธารณประชาชนจีน พบว่ามีการกำหนดการพิจารณาในประเด็นดังกล่าวนั้นแตกต่างจากประเทศไทย ทำให้กระบวนการเพิกถอนการจดทะเบียนในประเทศเหล่านี้มักจะประสบความสำเร็จ และส่งผลให้เจ้าของเครื่องหมายการค้าตระหนักถึงการใช้เครื่องหมายการค้าที่จดทะเบียนแล้วในทางการค้าอย่างแท้จริงอันมีบทบาทสำคัญในการสร้างความสมดุลระหว่างการคุ้มครองของเจ้าของเครื่องหมายการค้าและประโยชน์สาธารณะ ตลอดจนสามารถขับเคลื่อนเศรษฐกิจและเติบโตทางการค้าในแต่ละประเทศมากยิ่งขึ้น ดังนั้น หากสามารถนำข้อดีจากบทบัญญัติและกระบวนการเพิกถอนในทางปฏิบัติของประเทศเหล่านี้มาปรับใช้กับกฎหมายและกระบวนการในทางปฏิบัติของประเทศไทยอาจส่งผลให้การเพิกถอนการจดทะเบียนเครื่องหมายการค้าด้วยเหตุที่ไม่มีการใช้ประสบความสำเร็จและมีประสิทธิภาพมากขึ้น

คำสำคัญ: เครื่องหมายการค้า, เครื่องหมายการค้าที่ไม่มีการใช้, กระบวนการเพิกถอนการจดทะเบียนเครื่องหมายการค้า, การเพิกถอนการจดทะเบียนเครื่องหมายการค้าด้วยเหตุที่ไม่มีการใช้

1. INTRODUCTION

Trademark is a kind of intellectual properties which is categorized as an industrial property,¹ which is created for the purpose of indication of the origin of products or services which bear under such particular trademark.² As being an identifier of one person's goods or services,³ it is necessary that a trademark must be put in genuinely used by the owner who may be manufacturer or seller to represent as a symbol allowing public and consumers, who are more relying on trademark, to distinguish its products or

¹ กรมทรัพย์สินทางปัญญา. 99 ปี เครื่องหมายการค้าไทย. 16. พิมพ์ครั้งที่ 1 พ.ศ. 2556 (Department of Intellectual Property, 99 Years of Thai Trademark. (1st Edition, 2013))

² วศ ดิงสมิธ. คำอธิบายกฎหมายเครื่องหมายการค้า. 2. พิมพ์ครั้งที่ 1. กรุงเทพมหานคร : สำนักพิมพ์นิติธรรม. 2545. (Wat Tingsamit. **Explanation of Trademark Law**. 2. (1st Edition Bangkok: Nititham, 2002))

³ Amada Michaels. **A Practical Guide to Trademark Law**. 88. (3rd Edition. London Sweet & Maxwell, 2002)

services from products or services belonging to others. The consumer always repurchases the goods or services based on a previous pleasurable experience or manufacturer's reputation for quality.⁴ On the other hand, the owner and manufacturer is also benefit from trademark to facilitate the advertisement of products by enabling the consumers to recognize the products and its brand name easily in a short period of time and be encouraged to purchase such products from seeing the trademark.⁵ Therefore, a trademark functions as a tool that both benefits to the trade and encourages economic growth.

Trademark law has been developed to provide a legal protection for traders' interests along with protecting the public and consumers. The protection of trademark is provided by a negative form of protection.⁶ It is called "exclusive" rights, which given to the owner in order to prevent others from using his intellectual property without any authority.⁷ Therefore, under such power, the trademark owner tries to seek the legal protection by early applying for registration in order to receive a tangible evidence to present its legal certainty.⁸

Occasionally, a trademark owner may early file an application in order to be the first party who registers it, and secures the protection, even if the owner might not have used such registered trademark in commerce or have no intention of using it. This type of registration is considered as defensive registration which places a barrier preventing others from registering the same or similar trademark. Therefore, such owner of the registered trademark only holds the registration on paper, but they do not utilize the protection received for their trademark in the course of trade.

⁴ *Supra* note 2.

⁵ *Id.*

⁶ Marisa Cremona. **Intellectual Property Law**. 88. (4th Edition. Palgrave Macmillan Law Masters, 2006)

⁷ *Id.*

⁸ Japan Patent Office. Outline of Japanese Trademark System.
http://www.jpo.go.jp/torikumi_e/hiroba_e/pdf/136th_inta/pamphlet.pdf
(accessed on December 10, 2015)

Thus, on this basis, Trademark law imposes a legal proceeding that provides the opportunity for a third party, who believes that they are affected by the unused trademark that have been prior registered as an obstacle to the later application, to file a petition to remove such existing registration.⁹ However, as trademark law is correspond to the 'principle of territoriality'¹⁰, each country has its own territorial decision to provide a legal protection for a trademark within its jurisdiction and impose the its own way to regulate the trademark system to the domestic law. Therefore, the non-use cancellation scheme may be implemented and required differently in each country. Where the requirement for proving use or non-use are not set too high, the non-use cancellation may be efficiently successful. While on the other hand, in some countries where the burden of proof lies on the petitioner and requires high standard of proof, non-use cancellation could be a difficult proceeding.

2. NON-USE CANCELLATION AGAINST TRADEMARK REGISTRATION

The non-use cancellation scheme is enacted to remedy the defect of registration system, "First-to-File system", that grants the protection as an exclusive right to use to the first come first serve basis, regardless on the genuine use of trademark in course of trade. The trademark that have a prior registration, but in facts, is not used to serve the commercial purpose, may affect to the rights of later trademark owner, who may genuinely use the same or similar trademark in course of trade. The later application would be refused

⁹ International Trademark Association (INTA). "*Cancellation of a Registered Trademark*". March 2016.

<http://www.inta.org/TrademarkBasics/FactSheets/Pages/CancellationofaRegisteredTrademarkFactSheet.aspx> (accessed on December 5, 2015)

¹⁰ วิชัย อริยานันท์ทกะ. "ข้อสังเกตบางประการเกี่ยวกับกฎหมายเครื่องหมายการค้าและการป้องกันการแข่งขันที่ไม่เป็นธรรม" วารสารกฎหมายทรัพย์สินทางปัญญาและการค้าระหว่างประเทศ. 2545. (Vichai Ariyanuntaka. "Some observations on the legal protection of Trademarks and Unfair competition law." Intellectual Property and International Trade Law Journal. 2002.)

by the Trademark Office due to the obstacle of prior registration of unused trademark. As a result, if the non-use cancellation scheme is successful, it may facilitate clearing the unused trademark from the Registry's records and being a true reflection of the commercial reality.¹¹ Once the cancelling decision issued, it does not mean only erasing of the trademark in registry records itself, but also means the erasing all the rights of the trademark owner that come along with it in which obtained from such registration.¹² It is to say that non-use cancellation scheme is also benefit to urge the registrant to commercially use the trademarks in order to maintain its legal protection, as well as to support the public interest by relieving the imbalance between the shortage of trademark resources and the strong demand for trademarks.¹³

The party who is entitled to file a request for non-use cancellation against the registered trademark may be anyone or an aggrieved party whose interest is affected from such existing registration, depending on the requirement in each country. According to Article 19 of TRIPs Agreement, it requires that a registration which could be cancelled only when it has been in an uninterrupted period of at least 3 years of non-use¹⁴. However, in some countries i.e. India¹⁵, Indonesia¹⁶, they may apply at least 5 years period as from the date of registration to allow the non-use cancellation scheme.

¹¹International Trademark Association (INTA). *"Standing Requirements in Connection With Non-Use Cancellation Actions"* November 13, 2013
<http://www.inta.org/Advocacy/Pages/StandingRequirementsNonUseCancellationActions.aspx> (accessed on December 5, 2015)

¹² Robin N. Brenner. *"Use it or Lose it! Burdens of Proof in Non-Use Cancellation Actions: A Call for Balance in the Trademark Laws of Thailand, Indonesia and India"*, **Cardozo Arts & Entertainment Law Journal**. 491.(Vol. 27 Issued 2, 2009)

¹³ Hui Gao. CCPIT Patent & Trademark Law Office. *"Protection of Registered Trademarks in Non-Use Cancellation Cases in China"*. January 23, 2015
<http://www.lexology.com/library/detail.aspx?g=2c55e192-5ffe-47e3-823b-c4a3c285aca5> (accessed on July 15, 2016)

¹⁴ TRIPS Agreement. Article 19.

¹⁵ Indian Trademark Law. Article 46.

¹⁶ Indonesian Trademark Law. Article 69

In most countries, the non-use cancellation request must be filed as a petition with the Trademark Office in each country. In some countries, it is considered as a litigation process that must be presented as a lawsuit with the Court within particular jurisdiction.

The burden of proof and requirement for standard of proof is upon each internal regulations of Trademark Law and practice in each countries, which in some countries, the burden of proof lies on the petitioners, but in some countries, the trademark owner will bear such burden. According to some experts' opinions, a tendency of imposing a burden of proof for such non-using trademark should be bound by the registered owner, rather than the petitioner.¹⁷ It is very difficult for any third party who has no access to the facts and information of the use of trademark to prove its non-use. It was opined that in case of removing a deadwood from the registry records as this method of non-use cancellation, such a reversal of the burden of proof seems to be justified.¹⁸

It is also possible to apply to remove the entire registration in respect of all list of goods, or only some of the goods or services for which the trade mark is registered. By cancelling only some of the goods or services as registered in the application is for the aspect that only some of goods or services are concerned to be deemed as non-use as per the ground for revocation, therefore the revocation shall only relate to those goods or services, not all the items listed in the application.

3. COMPARATIVE STUDY: NON-USE CANCELLATION AGAINST TRADEMARK REGISTRATION IN FOREIGN COUNTRIES

¹⁷ World Intellectual Property Organization (WIPO). **Background Reading Material on Intellectual Property**. 78. (2nd Edition. WIPO Publication, 2008)

¹⁸ *Id.*

1. The United States of America

The trademark registration and claim for the lawful ownership approach in the United States of Americas (“US”) is based on the First-to-Use system. That is to say that basically, any person who firstly use the trademark is assumed to have the lawful ownership of the trademark.

The provision concerning non-use cancellation is provided in the US Trademark Act 1946¹⁹, also known as the Lanham Act. It provides that a petition for requesting a non-use cancellation may be filed, at anytime, by an interested person who believes that he is or will be damaged if the registration of trademark, which abandoned by the owner. According to the Court's judgment in case *Auburn Farms, Inc. V. McKee Foods Corps*²⁰, the burden of proof is set forth that the petitioner has to prove only a prima facie evidence that the owner of registered trademark in question has abandoned the trademark pursue to the provision of Section 1127.²¹ Once the petitioner can prove such prima facie evidences of abandonment, the burden of proof will be shifted to the trademark owner who bears the duty to rebut that the trademark is still in use or has intention to resume the use.²²

Since the US has the requirement for genuine use, which is the process that forces the trademark owner to submit evidences proving the use of trademark within the prescribed periods, in order to obtain and maintain the registration. Therefore, the abandonment of trademark, or lack of intention to use trademark by the trademark owner, can be demonstrated through the act of not providing statement of use when the time requested. The petitioners who

¹⁹ US Trademark Law. § 14 (15 U.S.C. § 1064).

²⁰ เอกกรินทร์ วิริโย. "ปัญหาการเพิกถอนการจดทะเบียนเครื่องหมายการค้าด้วยเหตุที่เจ้าของเครื่องหมายการค้าไม่ใช้เครื่องหมายการค้า". วารสารนิติศาสตร์. 737. ปีที่ 44 ฉบับที่ 3. กรุงเทพมหานคร : โรงพิมพ์มหาวิทยาลัยธรรมศาสตร์. กันยายน 2558 (Aggarin Viriyo. "Problems on Trademark Cancellation on the Ground that the Trademark Has Not Been Used" **Thammasat Law Journal**. 737. Volume 44 No. 3. Bangkok : Thammasat University Publishing. September (2015).) (Citing 51 U.S.P.Q. 2d 1439, 1443 (1999))

²¹ US Trademark Law. § 45 (15 U.S.C. § 1127).

²² *Supra* note 20.

request the cancellation based on the claim of such non-use may easily find these information and evidences from the Registrar's records. Once the evidences showing abandonment by the trademark owner is established, then, the trademark owner shall bear the burden to rebut the allegation by submitting the evidences showing use of his or her own trademark and/or the intention to continue to use it, which the evidences shall be in hands if the mark and business regarding this mark is actually being operated. This process shows that the US Court does not stipulate too high standard of proof for both petitioners and trademark owners. Therefore, the burden of proof for non-use cancellation in US is not too difficult to overcome.

2. The United Kingdom

The United Kingdom ("UK") is a common law country, which has adopted a mix of "First-to-use" and "First-to-file" for its trademark acquisition system to compromise with the common practice of the rests of the European Community. However, upon the current situation, due to the result of "Brexit" referendum²³ on June 26, 2016, there are still remaining of unanswerable questions as to how UK could stipulate the internal laws in many issues and how this would affect to trademark registration system. The reason that the Author has studied this UK trademark law due to the facts that the first Trademark Act of Thailand B.E. 2475 (1931), was enacted by, at that time, followed UK trademark law, Trade Mark Act 1905.²⁴ Therefore, the non-use cancellation proceeding in Thailand has its roots from the UK's trademark law.

Any person may apply for the revocation of the non-use trademark in UK may be either made to the Registrar with United Kingdom Trademark Office or Court.²⁵ In the Section 46(1)(a), an

²³ Brian Wheeler & Alex Hunt, BBC News, *"Brexit: All you need to know about the UK leaving the EU"* <http://www.bbc.com/news/uk-politics-32810887> (accessed on July 21, 2016). (Citing *"It is a word that has become widely used as a short way of saying the United Kingdom is leaving the European Union by merging of the two words Britain and Exit"*.)

²⁴ *Supra* note 20.

²⁵ UK Trademark Act 1994. Section 46 (4).

application for revocation can be made only if a trademark in question has been registered for at least five years with the earliest date of revocation being the day following the fifth anniversary of the registration date.²⁶ This means that the period of five years counts from the date of completion of the registration procedure, rather than from the date of filing of the application.²⁷ If non-use is alleged, it is for the trademark owner to show what use, if any, has been made of the mark.²⁸

The UK Trademark Law has clearly stipulated the burden of proof specifically for the non-use cancellation that the burden must bear by the trademark owner, not a petitioner. What must be established is some genuine and commercial use that has been made of the mark.²⁹ Only offering goods for sales under the mark is suffice, even if no actual sales can be proved.³⁰ The acts which can describe as preparatory to launching goods under the mark onto the market may also be considered as sufficient evidence.³¹ However, any commencement or resumption of use which is made within three months period prior the filing date of non-use cancellation seems to be disregard as the use of trademark, unless the owner of such mark can show that there is a preparation for such commencement or resumption has been began with unaware of the application of revocation.³² It is designed to prevent the owner from preserving his mark by hastily starting to make a use of the mark once he knows that an application for revocation is threatened.³³

²⁶ UK Intellectual Property Office. *"Guidance: Revocation (non-use) proceedings"*

<https://www.gov.uk/government/publications/trade-marks-revocation/revocation-non-use-proceedings> > (accessed on May 12, 2016)

²⁷ *Supra* note 3. Page 77.

²⁸ *Supra* note 3. Page 78.

²⁹ *Supra* note 3. Page 78.

³⁰ *Supra* note 3. Page 78. (citing *Hermes trade mark* [1982] R.P.C. 425.)

³¹ *Id.*

³² *Supra* note 3. Page 79.

³³ *Id.*

3. Japan

Japan is a civil law country that adopts the principle of first-to-file system for registration of trademark, which a trademark filed earlier has priority for registration.³⁴ Under Japanese Trademark Act 1959, there is no explicit provision that genuine use is a requirement for obtaining and maintaining protection.³⁵

According to Article 50 of Japanese Trademark Law, a registered mark which has not been used in Japan in connection with any of the designated goods or services for more than three years in Japan, the registration is vulnerable to a third party's cancellation request based on non-use. Any person may file a non-use cancellation request with the Court in order to request for a trial for rescission of trademark registration. Like, Japan Patent Office ("JPO"), whenever has a reasonable doubt as to whether the applicant is currently conducting the business or whether has any concrete plans to conduct the business in the future in connection with the designated goods or services, may file an application to respond to the issue of non-use trademark.³⁶

The burden of proof for non-using of registered trademark is on the Registrant of trademark. The use in which the Registrant must provide needs to be used in a manner connecting with each of designated products or services as applied for registration.³⁷ In case, a trademark has not been put in actual use but the owners have a concrete plan to use such trademarks in connection with the goods or services as applied in future, the applicants must submit a document certifying that they are conducting or plan to conduct business in future.

³⁴ *Supra* note 8.

³⁵ AIPPI. *"The requirement of genuine use of trademarks for maintaining protection: Japan"*. 8 June 2011. http://aippi.org/wp-content/uploads/committees/218/GR218_japan.pdf (accessed on December 5, 2015)

³⁶ *Supra* note 8.

³⁷ *Supra* note 35. (citing *Dale Carnegie*, Tokyo High Court decision, 28 February 2001, Heisei 12 (Gyo-Ke) No.109.)

4. The People's Republic of China

The People's Republic of China is a fast developing country attracting massive investment from the local and foreign investors, therefore the legal protection is critically needed for serving the foreign investors' rights and the preventive measure against potential infringement which would cause a huge damage to the business of trademark owner. The First-to-File system is adopted within the jurisdiction for trademark registration.³⁸ Like in other countries, Chinese trademark registration is provided on this first-come-first-serve even if such trademark may have not yet been used in commerce. However, the registered trademark is vulnerable to be cancelled by non-use cancellation, which surprisingly most of them are successful.

The regulation of non-use cancellation is stipulated in Article 49 Paragraph 2. *"any organization or individual may request that the Trademark Office make a decision to cancel such registered trademark."*³⁹ Therefore, there is no special limitations on the petitioner.⁴⁰ The petitioner can be any person or entities, that may not have to be an aggrieved person and not required to prove its legal interest.⁴¹ An application for cancellation against a registered trademark based on non-use in China must be filed with China Trademark Office ("CTMO"). It is a simple statement that the mark has not been used for at least three consecutive years prior to the filing date of the cancellation application.⁴² In support of the application, the petitioner can submit the result of a brief internet search, for instance, a print-out from a popular search engine i.e. BAIDU, GOOGLE, etc., showing that there is no 'hits' resulting from

³⁸Lexology. *"Protection of registered trademarks in non-use cancellation cases in China."* <http://www.lexology.com/library/detail.aspx?g=2c55e192-5ffe-47e3-823b-c4a3c285aca5> (accessed on December 5, 2016)

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ Trademark Law of the People's Republic of China. Article 49.

⁴² Hatty Cui. *"Brief review of 'non-use' trade mark cancellation proceedings in China"*. China Daily. June 14, 2012 http://ipr.chinadaily.com.cn/2012-06/14/content_15502882.htm (accessed on July 15, 2016)

a search of the owner in relation to the goods or services under the disputed trademark.⁴³ Chinese trademark registration is, not only classify the list of goods according to the class designated by the Nice Classification, but also dividing the goods or services as applied into sub-classes. Consequently, the grounds for cancellation can be sustained for some of the goods or services for which trademark is registered, it is acceptable that an application request can be filed in respect of cancelling only partial of designated goods or services.⁴⁴

After the CTMO accepts the cancellation application and notifies to the Registrant, the burden of providing valid evidence of use of the trademark in question in relation to the designated goods or services rests with the trademark owner.⁴⁵ The Supreme People's Court opined that the trademark owners need to produce the evidence that shows '*public, genuine and lawful*' use of the trademark in commerce.⁴⁶ Resulting from being able to produce the appropriate evidences or the justifiable reason for non-use, the registration will be satisfied to be maintained.⁴⁷

4. NON-USE CANCELLATION UNDER THAI LAW

The Trademark Act B.E. 2534 (1991) has provided a provision for cancellation against trademark registration based on the grounds of non-using in Section 63. From the Author's perspective and studying, it appears that the problems of non-use cancellation proceeding in Thailand that need to be considered are as follows:

1. No Requirement for Genuine Use of Trademark.

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ *Supra* note 42.

⁴⁶ Freshfield Brucks Haus LLP. "*Cancelling Registered Trademark in China for Non-Use*". 23 May 2012 <http://www.freshfields.com/knowledge.aspx?language=en®ion=china&PageSize=70&pageNumber=14> (accessed on April 14, 2016). (citing *Dianhong Phamaceutical Group v. Kangwang* (2008).)

⁴⁷ *Management, Markets and Legal Consulting Group. "China Trademark Law : Non-Use Cancellation Actions". HG.org Legal Resources.* <http://www.hg.org/article.asp?id=33278> (accessed on July 15, 2016)

There is no requirement for genuine use of trademark that force the trademark owner to be aware of pushing its registered trademark in commercial use. Under Thai Trademark Law and the Board of Trademark's consideration, the registered trademark owner is presumed to have used or has the intention to use the trademark with all of the goods and services as listed in the application at the time of filing application. This presumption also applies to the circumstance that if the registrant continues to renew its protection at the time of renewal. Therefore, it put difficulty on the petitioner to produce the evidence rebutting this presumption of law, which provides the monopolization of rights to the first registrant. Giving the exclusive and absolute rights only to the first registrant, without assuring that the rights given has been properly utilized, may cause the abusing of trademark's functions in sense of not being able to represent the owners and non-benefit to the trade, and also may jeopardize the good will of trademark registration system.

2. Burden of Proof for Non-Using of Registered Trademark.

According to the law and practice in correspondence with the Supreme court judgment, the concept of burden of proof in Thailand applied the accusatorial system that *"the person who asserts the matter must prove it"*. Therefore, under Thai Trademark Law, it is clearly stipulated that a petitioner who file a cancellation petition must bear the burden of proof of the alleged non-use of the disputed trademark. In addition, not only must prove the actuality of non-using of trademark for at least 3 consecutive years prior to the date of filing a cancellation petition, but the law also requires the petitioner to prove that the registrant has no intention to use the trademark whatsoever. These requirements place too much burden to the petitioner and contrary to the fact that the petitioner does not have sufficient access to the required evidences and the truth whether the registered trademark is used or not. Furthermore, proving the intention in mind of other person is almost impossible. It has been a difficult proceeding for the petitioner to bear the obligation of proving in term of such negative fact. The possibility to prove and

produce the evidences showing the fact of non-use and no intention to use of trademark is seldom succeeded.

3. High Standard of Proof Required by the Board of Trademark.

The Board has placed the high standard of proof that strictly require the petitioner to prove the concrete evidences demonstrating, beyond doubt, that the registrant never use such registered trademark and has absolutely no intention to use it. Any proof in which is produced by the petitioner is repeatedly refused by the Board of Trademark. The Board mostly claimed and verdict that the evidences produced by the petition are not sufficient and cannot prove actuality of non-using of trademark on the registered goods and services of trademark owner, without the need to consider the registrant's rebutting evidence. Furthermore, referring to the Supreme Court Judgment, it was defined that only use of trademark with a short period of time and small quantity, either in form of test marketing, clinical trials, or in relation to free promotional goods can at least show the intention to use the trademark of the registrant. Therefore, it is very difficult for the petitioner to overcome this requirement.

4. Requirement of Proof for Non-Using on Every Items of Goods or Services under Registration.

By the interpretation of the phrase *"if it is proved that...with the goods which it was registered"* as imposed under Section 63 of Thai Trademark Act, the law has set the requirement of proof for non-using trademark on every items of goods or services under the registration. Therefore, even though the petitioner is able to prove the non-use of one item, but not all of those that are registered, the Board will not cancel such trademark registration and will hold that it is insufficient to prove the owner of the registered trademark has no intention to use or, in fact, have never used the trademark in good faith for such other registered goods. As a result of this requirement, it is considered that the use in relation to some of the goods is enough for the registrant to maintain the entire registration and prevail the cancellation.

5. CONCLUSION AND RECOMMENDATIONS

Where the cancellation for a non-use trademark is so difficult, there are many effects that may be caused by such problems such as cluttered registry records or a registered trademark that preserves the rights to block others from utilizing it. This obstructs later trademark owners who wish to be protected the under the same registration. Like, Thailand, the burden of proof lies on the petitioner who has no access to the facts and information that constitute the use of trademark. In addition, the high standard of proof required by the Board of Trademark, to produce the concrete evidences showing the absolute non-use of trademark as well as the lacking of intention to use trademark by the trademark owner, has put more burden to the petitioner. Facing such extreme difficulties when canceling one's trademark also results in monopoly rights being given to the first registrant, which may indirectly cause the trademark owner to not be afraid of losing their registration as well as create unfair competition to the subsequent users that may not be able to enter into the market because of the presence of the already existing registered trademark.

Therefore, it is the time for Thailand to seriously consider on legal measures that could reduce such burden of proof and eliminate the barrier set by the high standard of proof. The recommendations are as followed.

5.1 Implement the Requirement for Genuine Use of Trademark.

The Author opines that the requirement for genuine use could encourage the trademark owner to rapidly and constantly use the trademark in commerce in order to obtain or maintain its registration rights. Like providing in the United States of America, non-submission of evidences of genuine use when the time is requested could be a cause to presume that the trademark owner has not used the trademark in real business. Therefore, this would be a tangible evidence to prove non-use of trademark. Thailand may consider adopting the schemes of requirements for genuine use to implement in Thai Trademark Law.

5.2 Shifting Burden of Proof for Non-Using of Trademark to Registered Owner

Even though Thailand applies the concept of burden of proof in Thailand as the accusatorial system that *"the person who asserts the matter must prove it"*. However, according to Section 84/1 of Civil Procedure Code, it also provides the exceptions that a party who asserts a disputed fact does not have to bear the burden of proof, so called *"Factual Presumption"*, which also affirms on the principle of *'Res ipsa loquitur'* or *'thing speaks for itself'*. Therefore, in case of non-use cancellation, facts whether the trademark is used or not ought to be happened in ordinary course of event, which shall be bound by the owner, who possesses all the evidences and has full knowledge of use of trademark, not the petitioner. It seems to be more appropriate to adopt this exception to the Thai Trademark Law and shift the burden of proof for non-using of disputed trademark from the petitioner to the owner of registered trademark, like adopted by many countries i.e. the United Kingdom, Japan and the People's Republic of China where the non-use cancellation proceedings are mostly efficient and successful,

However, if, there is some opinions that it is not appropriate for Thai Trademark Law to change the accusatorial system and the burden of proof should be bound by trademark owner at the beginning of non-use cancellation process, at least, it is recommended to adopt the *prima facie* principle, like the United States of America's proceeding. Once the abandonment of trademark or preliminary cause of non-using were established by the petitioner, then, the burden of proof will be shifted to the trademark owner to produce the evidences rebutting that the trademark such non-use was caused by any special circumstances and justified by the proper reason.

In addition, providing examples of what could be considered as "special circumstances" that justify the proper reasons for non-using may set the pattern for the Board of Trademark, the petitioners, as well as the trademark owners themselves to be in the same page of the definition of use and non-use.

5.3 Eliminate the High Standard of Proof by Applying the Principle of Preponderance of Evidence (Balance of Probability)

As the legitimated clause "*if it is proved that*" and according to the Board of Trademark's decisions, the strict requirement has set the standard of proof very high. The Board usually requests for the concrete and excessive evidences demonstrating the actuality of non-use and lack of intention to use of the trademark owner before rendering its decision to cancel the trademark. This requirement shows that the Board has put the standard of 'beyond reasonable doubt', as commonly applied in criminal cases, to the petitioner. However, cancellation to revoke a trademark registration based on non-use of trademark in commerce should have affected only to the trademark owner's intellectual property rights in senses of business operation and trading system. This is a private right. Therefore, this procedure should fall under civil procedure.

Therefore, if the law still affirms to place the burden of proof on the petitioner, it should eliminate such high standard of proof by applying the principle of preponderance of evidence or so called 'Balance of Probability' to the petitioner. Under this scheme, the Board may consider the evidences by weighing whether they are reliable to demonstrate the reasonable facts of non-using of the disputed trademark. This will allow the petitioner who has the legal burden to proof have more chance in overcoming the cancellation.

5.4 Allowing Partial Cancellation and Providing Legal Measure for Limitation of Registration on Unrelated Goods/Services

Occasionally, many trademark applications have listed many items of goods or services, it is nearly impossible for the petitioner to prove the non-use for all items. In some countries i.e. the United Kingdom, Japan and the People's Republic of China, it is possible for the petitioner to apply for partial non-use cancellation to remove only some of the goods or services are deemed to be non-use and concern with the goods they aim to apply for protection.

In the Author's view, it should be possible for Thailand to allow partial cancellation, like the proceedings in other countries. However, in order to prevent occurrence of confusing trademarks, Thailand should also consider giving the secured legal measures for the limitation of registration preventing these problems i.e. providing good public announcements and legal measures to deal with the trademark's co-existence. Moreover, Thailand may consider adopting the sub-classification system as Chinese trademark registration, which could allow the partial cancellation to revoke only the goods or services that fall under the same sub-class.

In this thesis, the Author does not aim to force Thailand to completely change its domestic law regarding non-use cancellation provisions. But in fact, providing the advantages and goodness of non-use cancellation proceedings from other countries could enlighten Thailand to see the significant necessity to eliminate the obstacles that block the foreign investor to come invest in Thailand and impede the economic growth. Still, Thailand needs to be careful in adopting these proceedings and provides the legal measures to be appropriately adjusted with its existing practice.

REFERENCES

BOOKS

English

Amada Michaels. **A Practical Guide to Trademark Law**. 88. (3rd Edition. London Sweet & Maxwell, 2002)

Marisa Cremona. **Intellectual Property Law**. 88. (4th Edition. Palgrave Macmillan Law Masters, 2006)

World Intellectual Property Organization (WIPO). **Background Reading Material on Intellectual Property**. 78. (2nd Edition. WIPO Publication, 2008)

Thai

กรมทรัพย์สินทางปัญญา. 99 ปี เครื่องหมายการค้าไทย. 16. พิมพ์ครั้งที่ 1 พ.ศ. 2556 (Department of Intellectual Property, 99 Years of Thai Trademark. (1st Edition, 2013))

วัศ ดิงสมิธ. คำอธิบายกฎหมายเครื่องหมายการค้า. 2. พิมพ์ครั้งที่ 1. กรุงเทพมหานคร : สำนักพิมพ์นิติธรรม. 2545. (Wat Tingsamit. **Explanation of Trademark Law**. 2. (1st Edition Bangkok: Nititham, 2002))

ARTICLES

English

Robin N. Brenner. *"Use it or Lose it! Burdens of Proof in Non-Use Cancellation Actions: A Call for Balance in the Trademark Laws of Thailand, Indonesia and India"*, **Cardozo Arts & Entertainment Law Journal**. 491.(Vol. 27 Issued 2, 2009)

Thai

วิชัย อริยานันทกะ. "ข้อสังเกตบางประการเกี่ยวกับกฎหมายเครื่องหมายการค้าและการป้องกันการแข่งขันที่ไม่เป็นธรรม" วารสารกฎหมายทรัพย์สินทางปัญญาและการค้าระหว่างประเทศ. 2545. (Vichai Ariyanuntaka. *"Some observations on the legal protection of Trademarks and Unfair competition law."* Intellectual Property and International Trade Law Journal. 2002.)

เอกรินทร์ วิริโย. "ปัญหาการเพิกถอนการจดทะเบียนเครื่องหมายการค้าด้วยเหตุที่เจ้าของเครื่องหมายการค้าไม่ใช้เครื่องหมายการค้า". วารสาร นิติศาสตร์. 737. ปีที่ 44 ฉบับที่ 3. กรุงเทพมหานคร : โรงพิมพ์มหาวิทยาลัยธรรมศาสตร์. กันยายน 2558 (Aggarin Viriyo. *"Problems on Trademark Cancellation on the Ground that the Trademark Has Not Been Used"* **Thammasat Law Journal**. 737. Volume 44 No. 3. Bangkok : Thammasat University Publishing. September (2015).) (Citing 51 U.S.P.Q. 2d 1439, 1443 (1999))

ELECTRONIC MEDIA

- AIPPI. *"The requirement of genuine use of trademarks for maintaining protection: Japan"*. 8 June 2011. http://aippi.org/wp-content/uploads/committees/218/GR218_japan.pdf (accessed on December 5, 2015)
- Brian Wheeler & Alex Hunt, BBC News, *"Brexit: All you need to know about the UK leaving the EU"* <http://www.bbc.com/news/uk-politics-32810887> (accessed on July 21, 2016). (Citing *"It is a word that has become widely used as a short way of saying the United Kingdom is leaving the European Union by merging of the two words Britain and Exit"*.)
- Freshfield Brucks Haus LLP. *"Cancelling Registered Trademark in China for Non-Use"*. 23 May 2012 <http://www.freshfields.com/knowledge.aspx?language=en®ion=china&PageSize=70&pageNumber=14> (accessed on April 14, 2016).
- Hatty Cui. *"Brief review of 'non-use' trade mark cancellation proceedings in China"*. China Daily. June 14, 2012 http://ipr.chinadaily.com.cn/2012-06/14/content_15502882.htm (accessed on July 15, 2016)
- Hui Gao. CCPIT Patent & Trademark Law Office. *"Protection of Registered Trademarks in Non-Use Cancellation Cases in China"*. January 23, 2015 <http://www.lexology.com/library/detail.aspx?g=2c55e192-5ffe-47e3-823b-c4a3c285aca5> (accessed on July 15, 2016)
- International Trademark Association (INTA). *"Cancellation of a Registered Trademark"*. March 2016. <http://www.inta.org/TrademarkBasics/FactSheets/Pages/CancellationofaRegisteredTrademarkFactSheet.aspx> (accessed on December 5, 2015)

International Trademark Association (INTA). *"Standing Requirements in Connection With Non-Use Cancellation Actions"* November 13, 2013
<http://www.inta.org/Advocacy/Pages/StandingRequirementsNonUseCancellationActions.aspx> (accessed on December 5, 2015)

Japan Patent Office. Outline of Japanese Trademark System.
http://www.jpo.go.jp/torikumi_e/hiroba_e/pdf/136th_inta/pamphlet.pdf (accessed on December 10, 2015)

Lexology. *"Protection of registered trademarks in non-use cancellation cases in China"*.
<http://www.lexology.com/library/detail.aspx?g=2c55e192-5ffe-47e3-823b-c4a3c285aca5> (accessed on December 5, 2016)

Management, Markets and Legal Consulting Group. *"China Trademark Law : Non-Use Cancellation Actions"*. HG.org Legal Resources.
<http://www.hg.org/article.asp?id=33278> (accessed on July 15, 2016)

UK Intellectual Property Office. *"Guidance: Revocation (non-use) proceedings"*
<https://www.gov.uk/government/publications/trade-marks-revocation/revocation-non-use-proceedings> > (accessed on May 12, 2016)

Laws and Regulations

China

Trademark Law of the People's Republic of China adopted at the 4th Session of the Standing Committee of the Twelfth National People's Congress on August 30, 2013.

Japan

Trademark Act 1959

Thailand

Trademark Act B.E. 2534 (1991)

The United Kingdom

Trade Marks Act 1994

The United States of America

Trademark Act of 1946

International Laws

Agreement on Trade-Related Aspects of Intellectual Property Rights
(“TRIPS Agreement”)