

**PROOF OF USE OF TRADEMARK UNDER SECTION 7 OF TRADEMARK
ACT CONCERNING ACQUIRED DISTINCTIVENESS BY
COMPARATIVE APPROACHES BETWEEN THAI AND FOREIGN
TRADEMARK LAWS***

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ABSTRACT

A trademark is considered a vital aspect of any business as it is used for identifying the goods or services so that consumers are able to recognize such goods or services as originating from a particular source through the trademark. Everything can be used as a trademark, such as letters, numerals, phrases, colors, pictures, symbols, etc., but not everything can be registered as a trademark. One of the most essential requirements for registration of a trademark is distinctiveness. Distinctiveness is important in the eye of trademark law because a distinctive trademark is the tool which creates a connection between the goods or services covered under that trademark with the consumers' perception. According to trademark laws, if a trademark is inherently distinctive, then it is registrable. However, an inherently non-distinctive trademark may also be registrable if such trademark satisfies the requirements of distinctiveness through use, i.e. acquired distinctiveness.

Similar to other trademark systems, Thailand has also adopted the concept of acquired distinctiveness. However, there are certain problems in the Thai laws and regulations regarding proof of use in order to achieve acquired distinctiveness, i.e. problems with the requirements for the proof of use, problems with the evidence to prove use, etc. which obstruct the chances of trademark registrability on this ground.

This Article will focus on the general concept of distinctiveness and the requirements for proving acquired distinctiveness through use of a trademark by using comparative approaches between Thai and foreign laws such as The United States of America, Japan and the Republic of Singapore whose trademark laws, especially regarding proof of use for acquired distinctiveness, are quite comprehensive. This study will be based on the requirements under Section 7

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paragraph three of Thai Trademark Act B.E. 2534 (1991) as amended by Act (No.2) B.E. 2543 (as amended by Act (No.3) B.E. 2559) and Ministerial Regulations for proof of acquired distinctiveness together with judgements of the Central Intellectual Property & International Trade Court and the Supreme Court by comparing the laws, practices from the examination guidelines and the judgements from foreign countries. In this way, the Author will discuss the alternatives for improving the laws and practices for the proof of use for acquired distinctiveness with the expectation that they could increase the chances of trademark registration of inherently non-distinctive trademarks in Thailand.

Keywords: Trademark, Distinctiveness, Acquired Distinctiveness, Proof of Use

บทคัดย่อ

เครื่องหมายการค้านี้เปรียบเสมือนเป็นส่วนหนึ่งของธุรกิจ เนื่องจากว่าเครื่องหมายการค้าได้ถูกนำไปใช้เพื่อเป็นชื่อ เรียกสินค้าหรือบริการ ซึ่งจะทำให้ผู้บริโภคสามารถที่จะจดจำสินค้าหรือบริการนั้น ๆ ได้ จากเครื่องหมายการค้า สิ่งที่จะเป็น เครื่องหมายการค้าได้อ้างเกิดจากคิดประดิษฐ์ขึ้นจาก ตัวอักษร ตัวเลข วลี สี รูปภาพ และอื่น ๆ อีกมากมาก แต่ไม่ใช่ว่าสิ่งที่คิด ประดิษฐ์ขึ้นมาันจะสามารถรับจดทะเบียนพื่อเป็นให้ได้รับการคุ้มครองที่เป็นไปตามเงื่อนไขของกฎหมายได้ ตามหลักกฎหมาย คุณสมบัติประการหนึ่งของ การที่เครื่องหมายการค้านั้นจะได้รับจดทะเบียน คือเครื่องหมายดังกล่าวจะต้องมีลักษณะบ่งเฉพาะ ซึ่งลักษณะบ่งเฉพาะนี้มีความสำคัญเป็นอย่างมากในแง่บุญของกฎหมายเครื่องหมายการค้า เนื่องจากว่าลักษณะบ่งเฉพาะเป็น เครื่องมือที่สร้างความเชื่อมโยงกันระหว่างการรับรู้ของผู้บริโภคกับสินค้าหรือบริการภายใต้เครื่องหมายการค้านั้น ๆ ภายใต้ บทบัญญัติกฎหมายเครื่องหมายการค้า เครื่องหมายการค้าที่มีลักษณะบ่งเฉพาะด้วยตัวของจะได้รับจดทะเบียนเครื่องหมายการค้า แต่สำหรับเครื่องหมายการค้าที่ไม่ได้มีลักษณะบ่งเฉพาะในตัวเอง การได้รับจดทะเบียนเครื่องหมายการค้าจะขึ้นอยู่กับการใช้ เครื่องหมายการค้าภายในช่องทางเดียวกัน ไม่สามารถใช้เครื่องหมายการค้าในช่องทางเดียวกันได้ เนื่องจากว่าเครื่องหมายการค้าสามารถ พิสูจน์ความมีลักษณะบ่งเฉพาะของเครื่องหมายการค้านั้นโดยการใช้ได้แล้ว เครื่องหมายที่ไม่ใช่ว่ามีลักษณะบ่งเฉพาะ ก็จะได้รับ จดทะเบียนและได้รับความคุ้มครองตามกฎหมาย

ระบบการจดทะเบียนเครื่องหมายการค้าในประเทศไทยต่างๆ ทั่วโลก ด้วยกันเพื่อให้เครื่องหมายการค้าต่างๆ รับจดทะเบียนได้ไม่ว่ามีลักษณะบ่งบอกพิเศษด้านใดๆ ก็ตาม ซึ่งระบบเครื่องหมายการค้าในประเทศไทยที่ได้รับเอกสารลักษณะการรับจดทะเบียนมาปัจจุบันนี้เป็นกฎหมายชั้นกัน แต่ในความเป็นจริง กฎหมายดังกล่าวที่บังคับมีปัญหาอยู่ โดยเฉพาะอย่างยิ่งประเด็นปัญหาในเรื่องการพิสูจน์การใช้เพื่อให้เครื่องหมายมีลักษณะบ่งบอกพิเศษอันนี้ที่บังคับใช้ หรือประเด็นปัญหาเรื่องของลักษณะหลักฐานที่ควรรับฟังเพื่อพิสูจน์การใช้เครื่องหมายการค้า และอื่นๆ ที่ก่อให้เกิดคู่ประหาตต่อโอกาสที่เครื่องหมายการค้าจะได้รับจดทะเบียน

คำสำคัญ: เครื่องหมายการค้า, ลักษณะบ่งเฉพาะ, ลักษณะบ่งเฉพาะโดยการใช้, การพิสูจน์โดยการใช้

1. BACKGROUND OF ACQUIRED DISTINCTIVENESS IN TRADEMARK LAW

Generally, distinctiveness is one of the key requirements for registrability of a trademark in order for it to be distinguishable from other trademarks. According to trademark laws, non-inherently distinctive trademarks are not deemed distinctive. Thus, such marks require proof of use in order to acquire distinctiveness. For this reason requirements for proof of acquired distinctiveness have been implemented in order to support the trademark owners, and other concerned persons and establish a common understanding so that the same rules are applied to all.

To achieve distinctiveness for a non-inherently distinctive trademark, the trademark owner has to comply with the provisions described in Section 7 paragraph three of the Thai Trademark Act and the Ministerial Regulations which indicate the requirements for proof of use of a trademark such as the characteristics of use, the designated goods or services, length of use and type of evidence. However, when the requirements are applied in actual practice, it is found that such requirements are not sufficient enough to serve as proof of use for acquired distinctiveness and thus day obstruct the chances of successful trademark registration.

2. LEGAL PROBLEMS OF PROOF OF USE CONCERNING ACQUIRED DISTINCTIVENESS

Upon studying cases of successful and unsuccessful proof of acquired distinctiveness, it is observed that the requirements for proof of use for registering non-inherently distinctive trademarks under Section 7 paragraph three of Thai Trademark Act and its relevant regulations are in sufficient on account as they do not clearly specify what constitutes acceptable evidence of use, for example, the amounts of evidence required, the types of evidence, the length of use or any other significant criteria.

3. FOREIGN LAWS FOR PROOF OF USE CONCERNING ACQUIRED DISTINCTIVENESS

It is undeniable for trading and exchanging goods and services across the countries. IN-COMPLETE SENTENCE - What is undeniable? Therefore, countries have mutually created and agreed upon international rules and regulations to be applied as common requirements amongst countries party to said treaties. The international rules and regulations have set the minimum requirements for member countries to implement in their own national trademark laws.

The member countries of the World Trade Organization (“WTO”) are required to implement their trademark laws based on the minimum standards set by

the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPs Agreement”) and the Paris Convention. Each member country must have requirements on intellectual property, especially trademark law, that is similar to each other; however, higher standards above the requirements under the TRIPs Agreement may be also implemented if they so choose. The requirements concerning acquired distinctiveness are implemented in the national trademark laws of member countries, including the United States of America, Japan and the Republic of Singapore.

3.1 The United States of America (“U.S.”)

For U.S. trademark law, the proof of use for acquired distinctiveness under the U.S. trademark system considers the following criteria: (1) prior registration; (2) length of use; and (3) actual evidence. Prior registration can be used as evidence that the same or similar trademarks, which are registered with adequately similar goods or services, and have been successfully registered before. The key to this evidence is that the prior registration must be the legal equivalent to the designated registration, i.e. the prior registration must be able to create the identical and continuing commercial impact such that consumers can understand that the prior registered trademark and the pending trademarks are the same mark.¹ Also, the prior registration must be in full force and effect in order to be acceptable as proof of use. Still, proof of prior registration is accepted only as *prima facie* evidence which means it is not a compulsory requirement that the trademark owner has to prove, but it is an advantage for the trademark owner seeking to obtain registration of a non-inherently distinctive trademark. Regarding length of use, subject to Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), it is clearly stated that a mark that is used in commerce for five years before the date of the claim of secondary meaning is made, may be acceptable as *prima facie* evidence in the course of proof of acquired distinctiveness. Like the prior registration requirement, the five-year period of use is not a strict rule, in other words, the trademark owner can submit other evidence to prove acquired distinctiveness even though the trademark has been used less than five years. Another requirement is actual evidence. The purpose of which is proving actual use of trademark in connection with the goods or services in the course of trade such as affidavits, declarations, letters from longstanding consumers, turn over figures or nature and extent of advertising, direct evidence that expressly exhibits the predominance of the proprietors’ trademark from others such as surveys² or any other evidence that shows the terms of use, way of use, and the ability of

¹ USPTO Trademark Manual of Examining Procedure (TMEP)
<<https://tmeplive.uspto.gov/rdms/TMEP/print?version=current&href=TMEP31200d1e1003...>> accessed 3 May 2017

² J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* 4th. West Group. 2012 McCarthy § 15:70

distinguishing the goods or services from others.³ Moreover, circumstantial evidence is also acceptable for proving use, for example, long term of use, advertising expenditures, affidavits or declarations indicating the source of a mark, survey and marketing research and the studies of consumer's perception.

3.2 Japan

Under Japanese trademark law, proof of use for acquired distinctiveness is specified in Article 3(2) of the Japanese Trademark Act, there are two requirements for proving acquired distinctiveness: (1) use of trademark and (2) the ability of consumers to recognize the trademark with the goods or services with a particular person. The requirements for proving acquired distinctiveness are clarified in the Japanese Examination Guidelines. Use of the trademark can be considered in two different ways: trademark aspect and goods or services aspect. For the trademark aspect, the trademark used in the evidence must be identical to the trademark in the application; otherwise it is not recognized as use.⁴ In some cases, even though the trademark in the evidence of use is not identical, it may be deemed as use of the trademark if the differences do not affect the identity of the trademark by determining the degree of differences in appearance and the actual states of transaction of the designated goods or designated services.⁵ Examples of trademarks that are recognized as identical are: (1) the difference in the trademark appears only in the describing of vertical writing and horizontal writing; (2) the trademark in the evidence and in the application appear in plain characters and the fonts that both trademarks used are very similar; (3) the appearance of the three-dimensional shapes of the trademark in the application and the evidence has only minor differences.⁶ For the goods and services aspect, the designated goods or services in an application and in the evidence must be identical in order to be recognized as use of trademark. However, the difference of use in the application and in the evidence may be deemed acceptable if such differences do not affect the identity of the designated goods or services in the application together with the consideration of evidence of goods or services in the course of trade.⁷ Another requirement for proof of acquired distinctiveness under Japanese Trademark law is the ability of consumers to recognize the trademark with the goods or services of a particular person. The recognition of the consumer is determined by the perception of consumers with regard to the source of the goods or services throughout the country. The key for measuring consumers' recognition is based on the level of consumers' awareness

³ USPTO Trademark Manual of Examining Procedure (TMEP) (n1) 21-22

⁴ Japan Patent Office, 'Examination Guidelines for Trademark' 51

<http://www.jpo.go.jp/tetuzuki_e/tokyo_e/tt1302-002.htm> accessed 9 December 2016

⁵ Ibid

⁶ Ibid

⁷ Ibid

which can be determined by: (1) the composition and appearance of trademark in the application; (2) the terms of use, quantity of use, period of use and location of use of trademark; (3) the advertising method, duration, areas and proportion, (4) a person who use a trademark either in an application or in evidence, (5) the characteristics of goods or services that are used in the course of trade; and (6) the results from questionnaires indicating consumers' awareness of trademark.⁸ To prove acquired distinctiveness along with the requirements, the trademark owner is required to submit sufficient evidence such as: (1) photographs or movies showing use of the trademark in the course of trade; (2) business documents such as purchase orders, sale receipts, invoices, shipping documents, etc.; (3) all kinds of advertisements published by the applicant; (4) articles in general newspapers showing the trademarks in applications by either the applicant or other parties; (5) reports from surveys of consumers' perception on the trademark owner's trademark.⁹

3.3 The Republic of Singapore (“Singapore”)

According to Singaporean Trademark Law, subject to trademark registration under Section 7(1) of the Singaporean Trademark Act, a non-inherently distinctive trademark can be deemed distinctive if such trademark can acquire distinctive character as a result of use. The requirements for proof of acquired distinctiveness and examples of acceptable evidence are described in “Evidence of Distinctiveness Acquired Through Use” which is the examination guidelines for proving acquired distinctiveness. The factors for trademark examination concerning acquired distinctiveness are: (1) Period of Use: The longer the use of the trademarks grants higher chances to obtain trademark registration. Regarding the guidelines, five years of use together with the proof of extreme sales is generally required. Use shorter than five years may still be acceptable if such trademarks are used extensively and continuously before the date of application. However, less than a 2-year period may not be sufficient enough to prove use.¹⁰ For proof of period of use, the evidence should indicate the date of first use with the goods or services in Singapore. Moreover, sufficient use must be continuous without any interference. In the event that the trademark is transferred, the evidence must show the information of the former owner and indicate the date of acquisition;¹¹ (2) Extent of Use

⁸ Ibid 53.

⁹ Ibid

¹⁰ Intellectual Property Office of Singapore (IPOS). ‘Evidence of Distinctiveness Acquired Through Use’ (Version 1) 2006

<http://www.ipos.gov.sg/Portal0...6%20Evidence%20of%20Use_Nov2015%20v2pdf> accessed 29 December 2016

¹¹ Ibid, 5

(Turnover): Turnover figures are the sale volume of the goods or services under the trademark. The larger the turnover the higher chances of the trademark being registered. Turnover figures should be demonstrated by classifying goods or services in accordance with trademark classifications. The characteristic of goods or services is also of concern if they are special or ordinary goods or services because it will effect the turnover figures, in other words, if such goods or services are special, the number of sales may be lower than the goods or services used for common goods. It will be advantageous to the proof of use if the trademark owner presents the nature and size of the market and the size of the market share so that it shows the rank of the goods or services in the market, if the sales of goods or services become the majority in the market, the better chance of registration the trademark owner may receive. In some events, turnover figures may not be appropriate for certain business such as financial services to prove the extent of use of trademark. Thus, other alternatives to prove use of such businesses would be number of account holders, investors, branches etc.;¹² (3) Advertising expenditure: Advertising figures include any type of advertising or medium such as out-of-home advertising, door-to-door advertising or online advertising etc. Such advertising figures should be five or more years before the filing date.¹³ The breakdown of advertisements in relation to the classification of goods or services is also significant, and the amounts given must be in Singaporean Dollars. The samples of advertisements concerning the goods or services intended to be registered should be involved.¹⁴ In some cases, only evidence of advertising may be acceptable without any proof of sale, for example the sale of aircraft usually starts with intensive advertising before an actual sale.¹⁵ Also, minor and no advertising expenditure may be acceptable, for example, in the case of the sale of a special product that is sold in a limited market;¹⁶ (4) Nature of exhibits: The exhibits should describe the impact or reflection of the trademarks used with the goods or services by specifying the date of use (estimations are also acceptable), and must be used as and for the purpose of trademarks. The exhibits should declare the date or period of use. The use of the trademark shown in the exhibits must be identical to the trademark in the application because if it is different, then it may be questioned whether the trademark in the application has acquired distinctiveness on its own or not. Examples of use are: (1) when a mark composed of non-fundamental parts of the trademark, such mark may be deemed distinctive on its own. The samples of exhibit that are deemed sufficient are articles, brochures, catalogues, balance sheets, statement of accounts, annual reports and so

¹² Ibid, 6

¹³ Ibid, 6

¹⁴ Ibid, 6

¹⁵ Ibid, 7

¹⁶ Ibid, 7

forth;¹⁷ (5) Goods or services claimed: The evidence of use must be in connection with the goods or services trying to obtain registration, and should reflect the goods or services subject to the specifications of goods or services that wish to be registered. That is because if such trademarks are extremely descriptive, the registrar will intensively consider evidence with the items under the specifications.¹⁸

4. ANALYSIS ON THE PROBLEMS WITH PROOF OF USE CONCERNING ACQUIRED DISTINCTIVENESS UNDER SECTION 7 PARAGRAPH THREE OF THE THAI TRADEMARK ACT

Generally, the use of a trademark is not a requirement for acquiring trademark rights. However, use will be applied as evidence of proving acquired distinctiveness in order to fulfill the criteria of trademark registration.

Previously, in the Thai Trademark Act B.E.2534 (1991)(as amended by Trademark No.2 B.E. 2543 (2000)), only trademarks “having or consisting of (1) a personal name, a surname not being such according to its ordinary signification, a name of juristic person or tradename represented in a special manner; or (2) a word or words having no direct reference to the character or quality of the goods and not being geographical name proscribed by the Minister in Ministerial Notification”, if it has been used as trademarks with goods which have been widely sold or advertised according to the rule prescribed by the Minister by notification and if it is proved that the rules have been duly met it shall be deemed distinctive.”¹⁹

Nowadays, the Thai Trademark Act B.E.2534 (1991)(as amended by Trademark No.2 B.E. 2543 (2000))had been amended in July B.E.2559 (2016). Section 7 was also revised by expanding the characteristics of trademarks acceptable for registration, especially non-conventional trademarks, i.e. sound marks. In addition, proof of acquired distinctiveness was also amended to accept all characteristics prescribed in Section 7 paragraph three stating that “trademarks having the characteristics under (1) to (11) which have been widely sold or advertised in accordance with the rules prescribed by the Minister by notification and if it is proved that the rules have been duly met”.²⁰

According to the last paragraph of Section 7 of the Thai Trademark Act, which describes what the trademark which acquired distinctiveness through use has to be prove: (1) the trademarks have been used with goods or services; (2) the

¹⁷ Ibid, 7

¹⁸ Ibid, 9-10

¹⁹ Thai Trademark Act, Section 7

²⁰ Thai Trademark Act, Section 7 paragraph 3

trademark have been widely sold or advertised; (3) such sale or advertising meets the rules prescribed by the Minister.

The rules related to proof of acquired distinctiveness prescribed by the Minister by notification for proving uses are mentioned in the Ministerial Regulations Re: The requirement for proving distinctiveness regarding Section 7 last paragraph of Trademark of Trademark Act B.E. 2534 (1991) as amended by the Trademark Act (No. 2) B.E. 2543 (2012) (the “Ministerial Regulations”)

4.1 Problems on the Registration Procedure

The main problems of the registration procedure, especially in case of the non-inherently distinctive trademark, is that it is time consuming due to the lengthy examination process. If the Registrar considers that the trademark lacks of distinctiveness, the Registrar may request the trademark owner submit evidence to prove acquired distinctiveness. This process takes time because the trademark owner needs to prepare sufficient and persuasive evidence, and after receipt of said evidence, the Registrar has to reconsider the registrability of the trademark and whether the evidence can overcome the requirements for proof of acquired distinctiveness or not. Consequently, the long examination term may obstruct the trademark owner from utilizing or seeking some benefits from using such trademark.

4.2 Problems on Criteria for Proof of Acquired Distinctiveness

4.2.1. Term of use

Subject to Clause 2(1) of Ministerial Regulations, it is stated that “the goods or services has been continuously used with trademark, either by distribution, publication or advertising for the moderate term, such trademark caused the public in general or in the relevant area to be acknowledged and recognized that such goods or services are distinguished from the others.”²¹

According to Clause 2(1) of Ministerial Regulations, the trademark must be used for a moderate term in order to be acceptable as proof of acquired distinctiveness. The undefined term is flexible and it seems to be to the advantage of the trademark owner to prove use in order to obtain acquired distinctiveness after he

²¹ Ministerial Regulations Re: The Requirements for proving the distinctiveness regarding Section 7 last paragraph of Trademark of Trademark Act B.E. 2534 (1991) (as amended by the Trademark Act (No.2) B.E. 2543(2012)), Clause 2(1)

considers that the trademark is capable of distinguishing goods or services from others.

Upon the interpretation of moderate term, the trademark owner may consider the term of use by referencing the Trademark Board's decisions and judgements. In Supreme Court Judgement No. 19480/2556, the Court held that "*Ten-year term of use of trademark is deemed as moderate enough to establish the acquired distinctiveness of trademark*".²² In case of the term of use is less than 10 years, the Court will determine whether the term of use is enough for creating acquired distinctiveness or not. Referring to the Supreme Court Judgement No. 5403/2551, the Court held that "*two years of use is not enough to constitute acquired distinctiveness*".²³ Therefore, to satisfy the criteria of term of use, the trademark owner is required to submit the strong evidence of use together with proof that the trademark is used continuously without any interference. Another concern about the term of use is that in case the trademark is very descriptive; a longer term of use may be required.

Upon the proof of acquired distinctiveness, basically, the longer use of trademark, the higher chance that the mark will be registrable under acquired distinctiveness. According to the Clause 2(1) of Ministerial Regulations, there is no specific period of use for proving acquired distinctiveness, but only states that the trademark is required to be used within moderate term. Nevertheless, the decisions from both the Trademark Board and the Court seem to agree that the acceptable term of use may take a long time i.e. ten years²⁴ in order to overcome the requirement of proof of acquired distinctiveness. Moreover, it is not clear about the length of use that is deemed moderate for the proof of acquired distinctiveness. Consequently, it is difficult for the trademark owner to start the registration procedure of a non-inherently distinctive trademark upon the requirement of term of use because the trademark owner may not know whether the term of use is sufficient enough to constitute the registration of the trademark or not.

4.2.2 Use with goods or services

²² Supreme Court Judgement No. 19480/2556

²³ Supreme Court Judgement No. 5403/2551

²⁴ Supreme Court Judgement No. 3685/2551

Clause 2(2) of Ministerial Regulations states that “the distribution, publication or advertising of any goods or services shall be deemed distinctive only with such goods or services.”²⁵

This clause specifies that the proof of use for a trademark with goods or services is deemed acceptable only with the goods or services that are actually used. This clause, if interpreted strictly, states that if the specification of goods or services in evidence and in the application are not identical, the use of the goods or services cannot be deemed as evidence for proof of acquired distinctiveness.

Therefore, similar goods or services that do not affect to the identity of the goods or service in an application are not registerable. This may cause a problem to the trademark owner as the trademark owner may desire to start their business with limited goods, and then expand their business later, in such a case if the goods that are used with the trademark, and the goods that he plans to sell are not different, the trademark owner should be able to obtain protection upon registration of such goods.

4.2.3 Use of trademark

Referring to Clause 2(3) of Ministerial Regulations, which specifies that “trademark that is proven for acquired distinctiveness according to this Ministerial Regulations must be identical to the trademark filed in an application for the registration.”²⁶

This clause decrees that the trademark appearing in an application and in evidence shall be identical; otherwise it cannot be deemed appropriate for trademark registration. Examples of determination of use of trademark are prescribed in the following judgements:

The Central Intellectual Property and International Trade Court Court Judgement No. 9/2560, the Court held that “...the trademark appeared in the evidence are different from the trademark specified in the application for the registration which is unacceptable to be evidence of this case...” or

²⁵ Ministerial Regulations Re: The Requirements for proving the distinctiveness regarding Section 7 last paragraph of Trademark of Trademark Act B.E. 2534 (1991) (as amended by the Trademark Act (No.2) B.E. 2543(2012)), Clause 2

²⁶ Ministerial Regulations Re: The Requirements for proving the distinctiveness regarding Section 7 last paragraph of Trademark Act B.E. 2534 (1991) (as amended by the Trademark Act (No.2) B.E. 2543)(2012)), Clause 2

The Supreme Court Judgement No. 5402/2551, the Court held that "...the mark that has been published on the media is different from the service mark "SOUTH AFRICAN AIRWAYS." So, it is not clear whether to assume and accept that the service mark of the trademark owner is the service mark that has advertised or published that the people widely knows that trademark ..."

Evidence of use must contain exactly the same characteristics and appearance with the trademarks intended to be registered. In practice, the trademark owner may promote its trademark in a partial form apart from the trademark registered. Even though, the partial trademark cannot be submitted as evidence, it can still lead and imprint on consumers' perception. Thus, rejection of evidence of similar trademarks may cause misconception as to the true duty of a trademark, in other words, if similar trademarks still refer to the substance of a trademark it should not be denied registration.

4.3 Problems of the Examination Guidelines for Proof of Acquired Distinctiveness

The examination guidelines for proof of acquired distinctiveness are specified in Ministerial Regulations that contain substantive requirements for proof of acquired distinctiveness these are: the length of use, the territory of use, the characteristics of the goods and services, the characteristics of use, and acceptable evidence of trademark. The advantage of the examination guidelines is to prescribe the details for proof of acquired distinctiveness but when comparing to the examination guidelines of other countries; it seems that the Ministerial Regulations may not be enough to facilitate proof of acquired distinctiveness. The problems with the examination guidelines are relating to inflexible provisions in connection with the requirements of identical trademark and identical goods or services for proving acquired distinctiveness, the term of use, and lack of examples supporting interpretation except for the examples of evidence.

5. CONCLUSIONS AND RECOMMENDATIONS

5.1 Conclusions

The aim of trademark law is to balance between the benefits of an individual and public interests. In order to protect the benefits of both sides, it is required that trademark owners register their trademarks. Even though the requirements for trademark registration of each country may be different in some certain points, such as the use and intent-to-use requirement, the substantial requirements are the same, i.e. distinctiveness, non-similarity and not prohibited by law. But as discussed, in some cases, the requirements for trademark registration do

not accommodate trademarks that lack inherent distinctiveness, but still can perform as a trademark. Therefore, the requirements for trademarks are extended to cover trademarks that are non-inherently distinctive. In such cases, the requirements and the examination guidelines for proof of acquired distinctiveness play an essential role by giving instruction to the trademark owner, the Registrar, the Trademark Board and the Court to follow with regard to the proof of acquired distinctiveness.

Despite this upon studying the Thai Trademark Act and its relevant regulations regarding proof of use, i.e. the Ministerial Regulations, the Author finds that there are some problems with proof of use concerning acquired distinctiveness specified in Section 7 paragraph three of Thai Trademark Act and the regulations under the Ministerial Regulations. In this regard, upon studying the legal principles of use and grounds for registration for non-inherently distinctive trademarks under foreign laws such as the U.S., Japan and the Republic of Singapore, the Author would kindly propose that adopting the advantages of proof of use of these other countries for use in Thailand would solve the inherent problems with proof of acquired distinctiveness and mitigate the problems of use concerning the proof of acquired distinctiveness as follows:

5.2 Recommendations

5.2.1 To Adopt the Use Requirement for Trademark Registration

Regarding the trademark registration process in Thailand, use or intention-to-use a trademark before filing the application is not required for the registrability of a trademark. However, upon studying the requirements for trademark registration of foreign countries, the Author finds that the use requirement benefits the trademark owner as proof of acquired distinctiveness. Even though the purpose of the submission of declaration of use for trademark registration and the proof of acquired distinctiveness are different, the evidence of use for registration may be useful for the Registrar when considering distinctiveness based on such evidence, provided that the Registrar can request for further submission of evidence to prove acquired distinctiveness and re-examines the trademark based on such evidence.

Hence, the Author would kindly recommend applying use and intent-to-use applications as one of the requirements for registration as use or intent-to-use requirements can guarantee that the trademark is put into use before registration. On this point, use requirements reflect the main purpose of a trademark

which is to be used with the goods or services so that consumers are able to recognize the goods or services from the use of trademark.

5.2.2 To Specify the Term of Use and Accept as Prima Facie Evidence

According to the requirement for proof of acquired distinctiveness specified in Clause 2(1) of the Ministerial Regulations, the terms “moderate term of use” is unclear for the trademark owner to prove use in order to acquire distinctiveness through use of such trademark. Because, nowadays, it is not necessary to spend a long time to create the ability to distinguishing goods or services from others by putting the trademark into promotions and extreme sales and advertising campaigns, and by virtue of internet and social media, consumers can easily recognize and imprint trademarks with the goods or services rapidly. Therefore, referring to the study of foreign trademark laws, especially the U.S. and the Republic of Singapore, the terms of use, according to the practices of the Intellectual Property Office of Singapore, which is specified in the Evidence of Distinctiveness Acquired through Use, indicates that five-years of use is generally required for proof of acquired distinctiveness.²⁷ And for the US trademark law under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) and § 2.14 of T.M.R.P specifies that five-years use of trademark can be accepted as the prima facie evidence for proof of acquired distinctiveness.²⁸ Hence, the Author kindly proposes that it will be more beneficial for establishing proof of acquired distinctiveness if the term of use is set to an exact amount of time, that is five-years of use of the trademark and accept this period as prima facie evidence of proof of acquired distinctiveness. However, prima facie evidence performs as a standard of use that could be changed if the trademark owner can prove that the trademark is already distinctive even it has been used less than five years.

Therefore, the Author would kindly suggest Clause 2(1) of Ministerial Regulations be changed to “goods or services which have been continuously used with the trademark, either by distribution, publication or advertising for at least five years prior to the filing date, and such trademark could cause the public in general or in the relevant area to acknowledge and recognized that such goods or services are distinguished from others.”

²⁷ Intellectual Property Office of Singapore (IPOS), ‘Trademarks info pack’ (2016) 5 <<https://www.ipos.gov.sg/Portals/0/about%201P/trademark/TMInforpack07012016.pdf>> accessed 9 December 2016

²⁸ The Lanham Act, 15 U.S.C. § 1052(f) and § 2.14 of T.M.R.P, Section 2(f)

5.2.3 To Expand the Acceptable Evidence for Proof of Acquired Distinctiveness

5.2.3.1 To Accept Evidence of Similar Goods or Services as Proof of Acquired Distinctiveness

With regard to the Examination Guidelines of Japan, there is an exception for acceptable evidence of use of goods or services that are different from the designated goods or services if such difference does not affect the identity of the specifications of goods as designated in an application.²⁹

In such a case the Author would kindly propose to amend Clause 2(2) of Ministerial Regulations to accept evidence of use that contains the designated goods or services which are not identical to the specification of goods or services in the application. However, the difference of between the designated goods or services and the specification of goods or services in an application should not be substantial so that they do not affect the identity of the designated goods or services in the sense that consumers will still understand that the goods or services in the evidence and those designated in applications come from the same origin. Examples of evidence of goods or services which should be admissible are those that are in the same classification and have almost the same function and appearance, for example, ball pen and fountain pen or hostel and hotel where the prices are not so different.

Therefore, the author's recommendation for the issue of limiting the scope of evidence of similar goods or services is to amend Clause 2(2) of Ministerial Regulations to "the distribution, publication or advertising of any goods or services shall be deemed distinctive only with such goods or services, however the use of trademark with similar goods or services may be acceptable if the difference does not affect the identity of the designated goods or services".

5.2.3.2 To Accept Evidence of Similar Trademarks for Proof of Acquired Distinctiveness

Regarding the Examination Procedures of Japan, there is an exception to accept similar trademarks as proof of acquired distinctiveness if such difference does not affect the identity of the trademark.³⁰

²⁹ Japan Patent Office (n4)

³⁰ Ibid 51

In this regard, the Author would kindly propose to amend Clause 2(3) of Ministerial Regulations to accept similar trademarks as proof of acquired distinctiveness, provided that such difference does not affect the identity of the trademark. That means if the trademark appearing in the evidence is not the same as the trademark specified in an application, but with only slight differences it can be deemed that the trademarks are identical. The acceptable difference could be measured by the perception of consumers, so that even if the trademarks are different, consumers will still consider that they are the same mark with the same source of goods or services.

Examples of similar trademarks which should be admitted as identical are:

- (1) The differences between the trademark in evidence and in the designated trademark applications are vertical writing versus horizontal writing.
- (2) The trademarks are written in two different fonts, but the fonts are closely similar to each other, for example, “HONEY” (Font: Calibri) and “HONEY” (Font: Arial).

Hence, the Author would kindly recommend the revision of Clause 2(3) of Ministerial Regulations to “The trademark appearing in the evidence for proof of acquired distinctiveness according to this Ministerial Regulations shall be identical to the trademark filed in an application, provided that the similarity of the trademark in the evidence does not affect the identity of the trademark in an application it shall be accepted.”

5.2.4 Amend or Implement Clearer Examination Guidelines for Proof of Acquired Distinctiveness

Upon completion of the comparative study of trademark laws and practices of foreign countries, the Author found that not only could appropriate trademark laws facilitate proof of acquired distinctiveness, but also that sufficient examination guidelines could support both the trademark owner and the Registrar to have a common understanding about proof of acquired distinctiveness. Therefore, the Author would kindly recommend to revise the Examination Guidelines following other recommendations for amending the requirements for proof of acquired distinctiveness.

5.2.5 To Indicate the Reason of Trademark Registrability in Trademark Database

The Author finds it is difficult and not very convenient to search for information about trademarks that are registrable through the proof of acquired

distinctiveness from the trademark database. Thus, the Author would kindly recommend that adding remarks in the database about trademarks that are registered by proof of acquired distinctiveness like the trademark databases of foreign countries such as the U.S. or the Republic of Singapore. The purpose of the remarks are for the benefit of searching and studying the registrability of such trademarks, in other words, if such trademarks are registrable based on proof of acquired distinctiveness, then people could search for the method of proof or evidence used for proof of acquired distinctiveness of such trademarks.

With regard to the recommendations in this article, The Author does not expect to immediately and completely change the Thai Trademark Act concerning proof of use for acquired distinctiveness as per the Author's suggestions. The Author aims to indicate that laws and regulations do not accommodate proof of use for acquired distinctiveness. As a result, it obstructs the chance of trademark registrability which may affect economic growth since businessmen cannot seek protection for their trademarks in Thailand, although registration is possible the registration procedure causes both delay and expense in order to obtain registration. In this regard, the Author expects that the proposed recommendations could be the guidelines for improving proof of use for acquired distinctiveness. The guidelines may not resolve all problems of proof of use for acquired distinctiveness; therefore, they should be adjusted to be in alignment with actual practices.

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