

PROBLEMS ON THE PROHIBITION OF TRADEMARK REGISTRATIONS
CONSISTING OF FOREIGN COUNTRY NAMES AND/OR FOREIGN COUNTRY
ABBREVIATIONS UNDER TRADEMARK ACT B.E. 2534 (1991) AMENDED BY
TRADEMARK ACT (NO.2) B.E. 2543 (2000) AND TRADEMARK ACT (NO.3)
B.E. 2559 (2016)*

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Abstract

The name and/or abbreviation of a country has the ability to unify business in a particular country under one banner, allowing trademark owners to benefit from the reputation and heritage of the country. However, under the Trademark Act B.E. 2534 (1991) as amended by the Trademark Act (No.3) of B.E. 2559 (2016), marks consisting of foreign country names and foreign country abbreviations can be either prohibited by law as per Section 8 (6) or can be considered non-distinctive as per Section 7 Paragraph 2 (2), depending on the official's discretion. Without solid provisions controlling such discretion, officers may select one or both

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grounds for rejection of an application. This causes inconsistency in registration of marks comprised of foreign country names and/or foreign country abbreviations. In addition, the only route to overcome Section 8 (6) “unless permission is given by the competent officer of the foreign country” is also difficult to comply with in practice as the current law does not define who constitutes a “competent officer of the foreign country”.

This Article will aim to find the root of the prohibition grounds for marks consisting of foreign country names and foreign country abbreviations in Thai trademark law and compare Section 8 (6) of Trademark Act B.E. 2534 (1991) as amended by the Trademark Act (No.3) of B.E. 2559 (2016) with Article 6ter of the Paris Convention and the trademark law of other foreign countries such as the United Kingdom, the United States of America and the Republic of Singapore in order to find a recommendation for Thailand. The study will also include judgments of the Supreme Court, Trademark Board Decisions and Trademark Registrar’s Instructions together with the opinion of an intellectual property lawyer and related authorities to find better alternatives to Section 8 (6).

The analysis elaborates that United Kingdom, the United States of America and the Republic of Singapore do not prohibit the registration of the mark consisting of “foreign country name” and “foreign country abbreviation” This can be adopted into Thailand by simply omitting the words “foreign countries” and “or” of Section 8 (6) of the current Thai Trademark Act.

Keywords: Trademark, Prohibition, Foreign Country Name, Foreign Country Abbreviation

1. Introduction and Background

Due to the drive from the globe, specifically the developed countries, claiming that it is necessary to make a change in the intellectual property law so that the global trade can move forward, a number of new intellectual property laws were enacted in accordance with the needs and requirements of the trade.¹ Thailand has enacted trademark law to regulate the registrability of marks several times in order to conform to the objectives of the TRIPs Agreement and Paris Convention. In the year 2000, Article 6ter of the Paris Convention was implemented in Section 8 (6)² in B.E. 2543 extending the prohibition to a mark consisting of “national emblems and flags of foreign countries, emblems and flags of international organizations, emblems of head of foreign countries, official emblems and quality control and certification of foreign countries or international organizations, names and abbreviations of foreign countries or international organizations”. The only route to overcome this ground for rejection is to receive permission from a competent officer of the foreign country or international organization.

When comparing the provisions in the Act of B.E. 2534 with that of the amended Act in B.E. 2543, the study found that several new items were prohibited in Section 8 (6):

- (1) flags of international organizations;
- (2) emblems of head of foreign countries;
- (3) official emblems and quality control and certification of foreign countries;

¹ Jumpol Pinyosinwat and Bhumindr Butr-indr, *Prawatsart Lae Naewkid Kiewkub Sapsin Thang Panya [History and Concepts of Intellectual Property]* (2nd edn, Faculty of Law Thammasat University 2018) 176-177 (จุมพล ภิญโญสินวัฒน์ และภุมินทร์ บุตรอินทร์, *ประวัติศาสตร์และแนวคิดเกี่ยวกับทรัพย์สินทางปัญญา* (พิมพ์ครั้งที่ 2, โครงการตำราและเอกสารประกอบการสอนคณะนิติศาสตร์ มหาวิทยาลัยธรรมศาสตร์ 2561)) 176-177

² Legislative Assembly Report of Group 1 No. 2 (79/2541) 53/2541 concerning Draft Trademark Act (No. ...) B.E. ... (1998) 9

- (4) official emblems and quality control and certification international organizations;
- (5) names of foreign countries;
- (6) abbreviations of foreign countries;
- (7) names of international organizations;
- (8) abbreviations of international organizations.

2. Legal Problems after the Implementation

It is understandable and reasonable to extend the prohibitions in Section 8 (6) to meet the purpose of Article 6ter of the Paris Convention. However, the author found that the prohibition extension to “foreign country names” or “foreign country abbreviations” is not aligned to Article 6ter and its objective. In addition, the author cannot find the rationale behind the extension of the prohibition of marks to include those consisting of “foreign country names” or “foreign country abbreviations”.

2.1 The Terms “Foreign Country Name” and “Foreign Country Abbreviation” are Undefined

Although there is no definition of the terms “foreign country name” and “foreign country abbreviation” in the current Trademark Act, some trademark officers³ and trademark practitioners⁴ believe that both the terms “foreign country name” and “foreign country abbreviation” stated in Section 8 (6) have to be the official terms given by the respective government of the particular country in question. For example, the country Singapore’s official name is the “Republic of Singapore” and official

³ Interview with Siriwan Tantispupaphol, Trademark Registrar with 25 years of Experience in Intellectual Property Practice, Department of Intellectual Property (Bangkok, Thailand, 21 March 2019)

⁴ Interview with Nathapong Tongkaew, Partner / Attorney at Law with 14 years of Experience in Intellectual Property Practice, Domnern Somgiat & Boonma Law Office Ltd. (Bangkok, Thailand, 14 March 2019)

abbreviations are “Singapore”, “SG” (two-letter country abbreviation) and “SGP” (three-letter code).

This is unlike the definition of the term “geographical name” in Section 7 Paragraph 2 (2), which has clearer meaning, as Ministerial Regulations have already expanded and specified what the term “geographical name” means, although there are a series of amendments re-specifying the term.

2.2 Problems Due to the Vague Term of “Competent Officer”

The only solution to overcome a prohibition under Section 8 (6) for a trademark consisting of a “foreign country name” and/or “foreign country abbreviation”, is that the trademark owner must seek authorization from a “competent officer of the foreign country”. However, there is no definition of the term to identify who such a person may be, as the Trademark Act does not specify who can be a competent officer.

2.3 Problems Due to the Inconsistent Use of the Provision

It is interesting to note that the prohibition grounds under Section 8 (6) for trademarks consisting of foreign country names and/or foreign country abbreviations was not used during the very first year of the amendment of this provision. The Trademark Registrars once viewed and considered that foreign country names and foreign country abbreviations were within the scope of geographical names and should be rejected due to their lack of distinctiveness under Section 7 Paragraph 2 (2).⁵

The frequent use of Section 8 (6) has started only in recent years. In some scenarios, the Registrars rejected the mark solely on the grounds of prohibition under Section 8 (6) as they viewed that the mark, consisting of a foreign country name and/or foreign country abbreviation, should not be registered unless there is authorization from a competent officer.⁶

⁵ Interview with Siriwan (n 3)

⁶ Interview with Nathapong (n 4)

However, in some other cases, the Registrars rejected the mark on the grounds of prohibition under Section 8 (6) together with Section 7 Paragraph 2 (2). The overlapping use of these two provisions causes a huge burden on an applicant to overcome both of these grounds. To overcome Section 8 (6), as said above, the applicant needs to find a competent officer of the country in question to authorize him to use the country name as a trademark, and who that person may still be undefined. Additionally, in order to overcome Section 7 Paragraph 2 (2), an applicant would be required to file a huge amount of evidence in order to prove that the mark has acquired distinctiveness through use, specifically in Thailand. In addition, the consideration on grounds of acquired distinctiveness is done on case by case basis with regard to the whole combination of the mark, rather than as isolated elements.⁷ There are no general rules or standard regulations to consider this matter.⁸

2.4 Two Major Supreme Court's Judgments Reflecting that having Section 8 (6) Blocking the Registration of the Word "Foreign Country Name" and/or "Foreign Abbreviation" is Problematic in Practice

(1) Supreme Court's Judgment No. 9971/2558 "SINGAPOREAIR"

The Plaintiff attested that the Plaintiff invented the word "SINGAPOREAIR" by combining the words "SINGAPORE" and "AIR", thereby

⁷ Chaiyos Hemrachata, *Laksana Khong Kodmhai Sapsin Thang Panya Phuentarn Kwam Roo Thuapai Likasit Sithibat Kruangmai-Karn-Kar Kwamrub Thang Karn Kar Semiconductor Chip Phunpued Mai* [General Characteristics of Trademark: General Knowledge of Copyrights, Patents, Trademark, Trade Secret, Semiconductor Chip, New Plants] (4th edn, Nititham Publishing House 2002) 280 (ไชยยศ เหมรัชตะ, ลักษณะของกฎหมายทรัพย์สินทางปัญญาพื้นฐานความรู้ทั่วไป ลิขสิทธิ์ สิทธิบัตร เครื่องหมายการค้า ความลับทางการค้า เซมิคอนดักเตอร์ชิป พันธุ์พืชใหม่ (พิมพ์ครั้งที่ 4, นิตธิธรรม 2545) 280

⁸ What Tingsamitr, *Kham Athibai Kodmhai Kruangmhai Karn Kar* [Trademark Law] (Bangkok, Nititham Publishing House 2002) 10-11 (วัส ดิงสมิตร, คำอธิบายกฎหมายเครื่องหมายการค้า (2545) 10-11

creating a new word which has no dictionary meaning. Even though the word that the Plaintiff invented is new, general public still calls it “SINGAPORE AIR” which is the pronunciation of the mark. The word “SINGAPORE” according to the dictionary and the knowledge of general public refers to “SINGAPORE (country)” and “AIR” refers to “air (regarded as necessary for breathing)”. Thus, the point that the mark does not have the dictionary meaning that the Plaintiff introduced is not acceptable. Since the Service Mark “SINGAPOREAIR” the Plaintiff uses is in relation to Class 39 services “air transportation services; people transportation; products transportation etc.”, the mark must be directly descriptive of the character of services. Thus, the mark is not distinctive as per Section 7 Paragraph 2 (2) of Trademark Act B.E. 2534.

The word “SINGAPORE” refers to the Republic of Singapore which is the country name. Thus, this can be considered that the Service Mark “SINGAPOREAIR” of the Plaintiff contains the country name. Since there is no fact provided that the Plaintiff has the permission of the competent officer of the foreign country to use the word “SINGAPORE” as a trade name, the mark should not be registered in accordance with Section 8 (6) of Trademark Act B.E. 2534.

(2) Supreme Court’s Judgment No. 5402/2551 “SOUTH AFRICAN AIRWAYS”

The service mark of the Plaintiff comprises of 2 terms “SOUTH AFRICAN” and “AIRWAYS”. Even though the first term is not a direct geographical name as per the Ministerial Notification, it has a definition in relation to South Africa which can be considered a common word in relation to South Africa. The word “AIRWAYS” has the dictionary meaning as well, referring to “a route of air transportation services” and “an organization providing a regular public service of air transport on one or more routes” which is known in general. This can be considered descriptive of the characteristic of services. Thus, the service mark of the Plaintiff is non-distinctive. Moreover, the word “AIRWAYS” refers

to services in relation to air transportation including the installation, maintenance, and repair of airship and also includes other services in Classes 37 and 39 which are related to main services of the Plaintiff. Considering the mark in respect of each Class, the Service Mark of the Plaintiff is still descriptive of the character of services.

Even though the Service Mark of the Plaintiff has a direct relation to the meaning “Airline of South Africa”, the Service Mark of the Plaintiff relates to services in relation to air transportation which directly leads to the character of services. Trademark Act does not regulate that the mark can be registered if the Service Mark of the Plaintiff has been used as a trade name and the state as an entrepreneur who holds shares agrees to use such name. In contrast, the law has no intention to register the words or signs in relation to foreign countries. Thus, the mark should be prohibited in accordance with Section 8 (6).

2.5 Other Registration Case Examples

In trademark consideration, the Registrar viewed that the trademark application “”⁹ should be prohibited pursuant to Section 8 (6) since “UK” refers to “United Kingdom” which is a foreign country abbreviation unless the applicant agrees to delete the element “UK”. It was also found in Board of Trademarks Decision No. 11/2557, where the Board

considered that the mark “” contains the letters “UK”, an abbreviation of “United Kingdom” and considered that a foreign country abbreviation and should be considered non-registrable under Section 8 (6). However, some other marks containing letters “GB” were registered without any objection on ground of prohibition under Section 8 (6), for examples, “



⁹ Thai Trademark Application No. 827146 in Class 14

¹⁰ Thai Trademark Application No. 755947 Registration No. Kor345801 in Class 3

3. International Instruments and Laws of Foreign Countries

International instruments and laws of foreign countries hereunder help illustrate a larger picture of the trademark registration system. Yet, they also lead to the origin of Article 6ter which is the origin of Section 8 (6) of the current Thai Trademark law and how other countries implement Article 6ter into the trademark law in their respective jurisdictions. Laws of foreign countries also help reveal other related grounds with regards to marks consisting of country names and/or country abbreviations.

3.1 International Instruments

The 1986-94 Uruguay Round¹⁴, the largest trade negotiation ever, brought about the world's trading system by introducing a set of rules and principles to cover all global trade. This included the introduction of intellectual property rules into the multilateral trading system for the first time in the TRIPs Agreement. Since Thailand became a member of the General Agreement on Tariffs and Trade (GATT) in 1982, and later one of the founding members of WTO in 1995, during the Uruguay Round of negotiations, Thailand had to ensure that their standard of intellectual property protection followed the TRIPs Agreement and Paris Convention or at least met the minimum standard as far as global standards were concerned.

3.1.1 The TRIPs Agreement

¹¹ Thai Trademark Application No. 170109731 Registration No. 181127791 in Class 3

¹² Thai Trademark Application No. 756304 Registration No. Kor336308 in Class 19

¹³ Thai Trademark Application No. 969365 Registration No. Kor419544 in Class 9

¹⁴ The Uruguay Round was the 8th round of Multilateral Trade Negotiations (MTN) conducted within the framework of the General Agreement on Tariffs and Trade (GATT), spanning from 1986 to 1994 and embracing 123 countries as "contracting parties".

On December 11, 1995, arrangements for the implementation of the obligations under the TRIPS Agreement stemming from the incorporation of the provisions of Article 6ter of the Paris Convention (1967) were made. The implementation only included certain prohibitions with regard to the registration and use of state emblems, official hallmarks and emblems of intergovernmental organizations trademarks.¹⁵ Article 3 of the Agreement was completed on December 22, 1995 between the World Intellectual Property Organization and the World Trade Organization. This Article provided procedures in regards to the communication of emblems and transmittal of objections under Article 6ter of the Paris Convention for the purposes of the TRIPs Agreement.¹⁶

3.1.2 Paris Convention

The initial purpose of Article 6ter, as part of common rules mentioned above, was to protect the following items:

- (1) armorial bearings of the State party to the Paris Convention
- (2) flags of the State party to the Paris Convention
- (3) other State emblems of the State party to the Paris Convention
- (4) official signs of the State party to the Paris Convention
- (5) hallmarks indicating control and warranty adopted by the State party to the Paris Convention

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¹⁵ Decision of the Council for TRIPS, document IP/C/7.

¹⁶ The text of the Agreement can be found in IP/C/6.

- (2) flags of the State party to the Paris Convention
- (3) other State emblems of the State party to the Paris Convention
- (4) official signs of the State party to the Paris Convention
- (5) hallmarks indicating control and warranty adopted by the State party to the Paris Convention

Preventing the registration and use of marks representing emblems or official signs characteristics (as mentioned above), whether at a similar or identical level, is the objective of Article 6ter of the Paris Convention.¹⁷ The Article does not actually oblige Paris Convention member states to reject or cancel the registration and prohibit the use of service marks consisting of or having characteristics of emblems or official signs.¹⁸ Likewise, state members may include the prohibition of said emblems and signs. On this issue, Article 16 of the Trademark Law Treaty (TLT)¹⁹ mentions that states which are member countries of the Treaties are obliged to provide Article 6ter protection against registration and use of service marks having the characteristics of state emblems or other official signs.²⁰ Thus, currently, the prevention of registration and use of marks representing emblems or official signs characteristics covers both trademarks and service marks.

Under the Paris Convention, member countries may freely choose the way they prohibit marks consisting of flags and emblems of states

¹⁷ Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Fifteenth Session, Geneva, November 28 to December 2, 2005 - art 6ter of the Paris Convention: Legal and Administrative Aspects (WIPO/SCT/15-3 REV. 10, 2005)

¹⁸ World Intellectual Property Organization, 'Article 6ter' (WIPO)

<<https://www.wipo.int/article6ter/en/>> accessed 20 July 2019

¹⁹ Singapore Treaty on the Law of Trademarks, art 16 (Service Marks):

Any Contracting Party shall register service marks and apply to such marks the provisions of the Paris Convention which concern trademarks.

²⁰ World Intellectual Property Organization, 'Trademark Law Treaty (TLT)' (WIPO)

<<https://www.wipo.int/treaties/en/ip/tlt/>> accessed 31 March 2019

that are party to it. However, Article 6ter does not extend the protection to foreign country names and foreign country abbreviations at present.

3.2 Laws of Foreign Countries

The implementation of Article 6ter of the Paris Convention in trademark law the United Kingdom, the United States of America and the Republic of Singapore shall be studied as they are all developed countries that have a strong foundation in intellectual property. The author would like to present other provisions in relation to the registrability of trademarks consisting of foreign country names and foreign country abbreviations.

3.2.1 The United Kingdom (“UK”)

Pursuant to Sections 56 - 59 of the Trade Marks Act 1994 Part II Community Trade Marks and International Matters, an applicant cannot register a mark consisting of any emblem which has protection under an international agreement. One of the essential agreements available in the Act regarding this matter is the Paris Convention.

Having reviewed Sections 56 – 59 of the Act, the author found that all Sections are available to protect and prevent the registration and use of marks which are identical with, or very similar to the following objects:

- (1) armorial bearings
- (2) flags and other State emblems
- (3) official signs
- (4) hallmarks
- (5) other emblems
- (6) abbreviations of international intergovernmental organizations and
- (7) names of international inter-governmental organizations

It is important to note that UK trademark law does not mention that the names and abbreviations of foreign countries are items to be protected under Article 6ter of the Paris Convention, the law does not include the prohibition of such items. Unlike the listed items, the prohibition of marks consisting of such items is provided under Sections 56 - 59 of Trade Marks Act 1994.

Foreign country names and foreign country abbreviations do not form a separate category of protected elements under the current legislation applicable to the United Kingdom but they are regarded as being an indication of geographical origin, and thus prevented from registration under Article 3(1)(c) of the UK Trade Marks Act 1994.²¹ This is because the name of the geographical location and its reputation are potential to create an “expectation” among potential consumers that could possibly lead them to a deceptive understanding in cases where such expectation cannot be fulfilled. Objection to registration under Section 3(3)(b) happens at the first examination stage for both names of geographical locations and figurative trademarks which indicate geographical origin, and the variations of them, where the reputation of the geographical location is known for the goods or services²², for example: SWISSTEX for “Watches and horological instruments” because Switzerland is famous for high quality watches. For some circumstances, the use of a geographical name where it has a reputation can create an “expectation” in the minds of the consumers and

²¹ Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Protection of Country Names Against Registration and Use as Trademarks: Practices, Approaches and Possible Areas of Convergence – Comments by Members (WIPO/ SCT/37/3 REV. 8, 2017)

²² Submission by the Delegation of the United Kingdom

this may lead consumers to “deception” if their expectation is not fulfilled by the goods/services.²³

3.2.2 United States of America (“U.S.”)

The United States is a member of the Paris Convention for the Protection of Industrial Property, as per the revisions made in Stockholm on July 1967, their membership created a Union for the protection of industrial property and the Paris Convention for the Protection of Industrial Property Article 6ter of March 20, 1883.

(1) As per the U.S. Trademark Act of 1946, as Amended, Section 1052. Trademarks registrable on principal register; concurrent registration (a) and (b)²⁴, it appears that the United

²³ Olga Kreshchenko, 'Protection of Official Names of States and Prevention of their Registration and Use as Trademarks' (IPWatchdog, 12 July 2016) <<https://www.ipwatchdog.com/2016/07/12/official-names-states-trademarks/id=70718/>> accessed 5 October 2018

²⁴ 15 U.S.C. §1052 Trademarks Registrable on the Principal Register; Concurrent Registration:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

...

States has agreed to reject or instruct the registration to be an invalid one, and to prohibit the unauthorized use of trademarks or elements of trademarks consisting of the following items:

armorial bearings

(2) flags and

(3) other State emblems

(4) official signs and hallmarks indicating control and warranty adopted by

member countries, and

(5) any imitation from a heraldic point of view

The same discretion also applies to armorial bearings, flags, emblems, abbreviations, and names of intergovernmental organizations which one or more countries of the Union are members, except for the items that are subject of international agreements ensuring their protection for example Red Cross is under the protection of the Geneva Convention of August 12, 1949.

In the view of the same Act, marks which have foreign country names and/or foreign country abbreviations cannot be registered right away as per the following grounds for rejection and related provisions available in Section 1052. Trademarks registrable on principal register; concurrent registration (a) and (e)²⁵:

²⁵ *ibid*, 15 U.S.C. §1052:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title,

(1) Deceptively misdescriptive: under § 1052(e), deceptively misdescriptive marks refer to marks that are an incorrect description of the designated goods/services. Marks which have this characteristic have the potential to lead consumers to incorrect information about the underlying goods/services.

(2) Deceptive: an absolute bar shall arise at the time of considering the registration of the mark which has “deceptive” character under § 1052(a) together with Section 2(a) on either the Principal Register or the Supplemental Register.²⁶

(3) Primarily geographically descriptive: a mark would be geographically descriptive if it portrays an idea of where the goods or services are derived from. In order for the requirements to be met, the mark must contain the features in Trademark Manual of Examining Procedure (TMPEP) § 1210.01 like (a) the essential element (known as “primary significance”) of the mark indicates a generally-known geographical location and (b) the mark demonstrates an idea that such goods or services are derived from (or else it could be primarily geographically misdescriptive) said location; and (3) consumers would base their purchasing decisions on the geographical location of such goods or services.

(4) Geographically deceptively misdescriptive: illustrations of the concepts of “geographically deceptively misdescriptive” includes a mark that is deceptive about the place of origin of the goods for instance: HAVANA CLUB for cigars that are not from CUBA or NEAPOLITAN for sausages that should be made in Naples, but are actually made in Florida. However, unless it has misled a certain amount of people, it would not be considered as geographically deceptively misdescriptive. Below is an example of this concept.

(5) Any of the marks above shall be registered if the mark can prove a secondary meaning: marks that are merely descriptive, deceptively misdescriptive, or primarily geographically descriptive, are

²⁶ See *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 241 (TTAB 1975)

registrable only on the condition that the mark can acquire a secondary meaning as per Section 1052. Trademarks registrable on principal register; concurrent registration (f)²⁷. In practice, the secondary meaning can be constituted by a five-year exclusive and The USPTO would allow the Trademark to be registered only if it is subjected to certain conditions which are to disclaim certain parts of the Trademark that lack distinctiveness or are generic under the application.²⁸ Along with the status of less distinctive marks, merely descriptive and generic marks share different characteristics.

²⁷ 15 U.S.C. §1052 (n 25):

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act. A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be cancelled pursuant to a proceeding brought under either section 14 or section 24.

²⁸ Danielle Weitzman, 'Significance of Disclaimers in U.S. Trademark Law' (Ladas, 9 October 2014) <<https://ladas.com/education-center/significance-disclaimers-u-s-trademark-law/>> accessed 5 October 2018

3.2.3 The Republic of Singapore (Singapore)

The provision implemented by Article 6ter of the Paris Convention in Singapore Trade Marks Act is provided under Section 7(11) which is in connection with Sections 56²⁹ and Section 57³⁰. Both provisions are concerned with the protection of emblems of Paris Convention member countries and of intergovernmental organizations. In the Singaporean Trademark Act the member countries are called a “Convention country” which is defined in Section 2(1) of the Act as “a country or territory, other than Singapore, which is a party to the Paris Convention or a member of the World Trade Organization.”³¹

Trademarks containing the flags of member countries are prohibited from registration automatically under the law. On the other hand, state emblems will only gain protection once there is a notification following the procedure found in Section 58³². A member country has to notify Singapore of its desire to obtain protection for the subject emblem. Consequently, the Singapore Trademark Office will allow such notification by accepting the application within or around 2 months after the notification has been submitted. Once Singapore has accepted the notification of the protection of the emblems the Trade Marks database will

²⁹ Singapore Trade Marks Act (Chapter 332, Revised Edition 2005) s 56:

National emblems, etc., of Convention countries: Article 6ter of Paris Convention, etc.

³⁰ Singapore Trade Marks Act (Chapter 332, Revised Edition 2005) s 57:

Emblems, etc., of certain international organisations: Article 6ter of Paris Convention, etc.

³¹ Intellectual Property Office of Singapore, ‘Other Grounds for Refusal of Registration’ (IPOS, June 2017) <https://www.ipos.gov.sg/docs/default-source/resources-library/trade-marks/infopacks/tm_work-manual_11-other-grounds-of-refusal_jun2017.pdf> accessed 7 April 2019

³² Singapore Trade Marks Act (Chapter 332, Revised Edition 2005) s 58:

Notification under Article 6ter of Paris Convention, etc.

collect data for future appropriate search during the examination process, so that the emblems will be revealed as protected elements.

While a formal notification for emblems is required, flags of other countries do not need any notification for protection as per Article 6ter of the Paris Convention which states that notification for flags of countries of the Union is not necessary. Thus, for trademark examination in Singapore, flags of countries should be researched outside of the Trade Marks database to identify flags belonging to the member countries.

At the time of the trademark examination, if a mark similar to an emblem as notified is found, the examination would look at the next step, whether the emblem was notified for the designated goods or services, or if the sign is generally prohibited from use as a mark. For flags, coats of arms and emblems of a country, they apply to goods and services in all classes. This is unlike the protection for the signs of intergovernmental organizations and signs of warranty that have limited goods and/or services. For instance, a hallmark designated for metal goods cannot cause confusion for an application for use of a mark on textile goods.

For examination purposes, the Trademark Registrar will raise the following objection under section 7(11) of the Trade Marks Act if the mark consists of/contains:

- (1) a flag of a Convention member country
- (2) the state emblem of a Convention member country
- (3) an official sign or hallmark adopted by a Convention member country
- (4) the armorial bearing/flag/emblem of an international intergovernmental organization
- (5) the abbreviation/the name of an international intergovernmental organization

The rejection of the mark can overcome with the consent of a competent authority of the country/organization concerned. The consent must be made in the written form.

Any trademark consisting of a geographical name should not be registered as it is considered the “designation of geographical origin” under Section 7(1)(c)³³. Singapore trademark law allows the designation of geographical origin to be open to be used freely by all traders as an indication of origin which connects with the country name.

In order to determine whether a mark is registrable or it is a geographical origin of the goods/services subject to the grounds of distinctiveness, the Singaporean authority has to consider the followings points:

- (a) The geographical location: the authority would consider the reputation of the geographical location associated with the designated goods/services;
- (b) The characteristics of the geographical origin: the authority would consider the characteristics of the geographical origin and determine whether they have the potential to indicate where the place is or to become a geographical source for the designated goods/services in the application; and
- (c) The reputation of the geographical name as known by the people of Singapore: how well the location is known to the particular target group of people in Singapore – and at what point it is known.

The authority would make their assessment on the basis of the balance of probabilities. The mark may be registrable in cases where the particular group of people related to the trade or potential consumers are unable to assume with their knowledge where the goods/services originate from. The test would be whether the name is “simply because some place

³³ Singapore Trade Marks Act (Chapter 332, Revised Edition 2005) s 7:

Absolute grounds for refusal of registration;

(11) A trade mark shall not be registered in the cases specified in sections 56 and 57.

upon the earth's surface had been called it" (Magnolia Metal Company [1897] 2 Ch 371). If the geographical name has no connection with the designated goods or services, the mark itself must be distinctive enough and can be registered. In contrast to this, in cases where the people concerned may associate the goods and services with the geographical name, the mark may be rejected on this ground, even if, the goods in fact do not originate from that location.

After studying the trademark law in the United Kingdom, the United States, and Singapore, which are related to the implementation of Article 6ter in their local trademark legislation, the author cannot find any problems concerning the prohibition of trademarks consisting of foreign country names and foreign country abbreviations as none of law in the aforementioned countries specifically prohibit registration of trademarks that contain foreign country names and foreign country abbreviations. Likewise, the trademark law of all the selected countries considers foreign country names and foreign country abbreviations to be geographical names falling into the grounds of non-distinctiveness.

4. Analysis of the Problems on the Prohibition of Trademark Registrations Consisting of Foreign Country Names and/or Foreign Country Abbreviations under the Thai Trademark Act B.E. 2534, as Amended by Thai Trademark Act (No.3) B.E. 2559

It is understandable and reasonable to extend the prohibition in Section 8 (6) to the point where it meets the purpose of Article 6ter of the Paris Convention. However, the author found that the prohibition extension to "foreign country names" or "foreign country abbreviations" is not aligned with Article 6ter and its objective. In addition, the author cannot find the rationale behind the extension of the prohibition of marks to those consisting of "foreign country names" or "foreign country abbreviations".

The author believes that the following points are possibilities for the reasoning behind the extension of the prohibition of marks to include “foreign country names” or “foreign country abbreviations” under Section 8 (6):

(1) Misunderstanding of Article 6ter of the Paris Convention

The legislative assembly might have believed that the prohibition against marks consisting of “foreign country names” or “foreign country abbreviations” would meet the purpose of Article 6ter of Paris Convention as well as Article 2 of the TRIPs Agreement which, in fact, is untrue as there is no prohibition of such items.

(2) Over-extension of the protection beyond Article 6ter of Paris Convention

The prohibition in accordance with Article 6ter might have been viewed as too weak and in need of further extension to prohibit marks consisting of “foreign country names” and “foreign country abbreviations”. This might have been considered reasonable as the intention would have been to treat “foreign country names” and “foreign country abbreviations” as equal to flags and emblems of foreign countries

By this reasoning on the idea of over-extension of Article 6ter, it comes into question whether the name of our country, “Thailand” and its abbreviation e.g. “TH” or “THA”, should also be prohibited similarly to the current practices regarding foreign country names and foreign country abbreviations. The author cannot find the rationale behind this unequal treatment of these trademark registrations.

The amendment of Section 8 (6) causes an extra burden on the applicant to register the mark. Previously, it was already difficult to overcome distinctiveness issues as “foreign country names” and “foreign country abbreviations” were considered “geographical names”. Yet, additionally, new Section 8 (6) requires the applicant to find a competent authority to authorize him to use such elements. In practice, the applicant

needs to overcome both grounds. If the applicant can overcome one ground and cannot overcome another, the mark is refused registration.

5. Conclusion and Recommendations

5.1 Conclusions

It is understandable from a conservative point of view that no one should have exclusive rights over the use of a country name and/or country abbreviation as a trademark as no one should be able to exclude others from using the name and abbreviation of their country. At the same time, in the context of business, country names and country abbreviations can effectively assist the whole mark function as they can clearly refer to the country of origin, nationality or any special connections to that country, helping consumers who see the mark to recognize it and imagine about certain characteristics of the country in connection with the goods or services. The names of countries and/or their abbreviations are now widely used in most business sectors. Thus, with some reasonable conditions, marks containing foreign country names and/or foreign country abbreviations should be allowed registration. However, currently registering a mark consisting of a foreign country name and/or foreign country abbreviation is still uncertain since the second amendment of the Act in year 2000, and unfortunately this problem was not resolved even when the Thai Trademark Act was amended in 2559 (2016).

The core of this thesis has been studying the problems arising from Section 8 (6) of the current Thai Trademark Act, specifically the prohibition of trademarks consisting of foreign country names and/or foreign country abbreviations, who is a competent authority and what does the permission from the competent authority look like, and how the freedom of choice for Thai authorities and the inconsistency resulting from such freedom when considering whether a mark consisting of foreign country name and/or foreign country abbreviation should be rejected on prohibition grounds

under Section 8 (6) or other grounds. The implementation of Article 6ter of Paris Convention in the United Kingdom, the United States and Singapore does not prohibit marks consisting of foreign country names and foreign country abbreviations, so these selected countries do not have problems with defining the words foreign country name and foreign country abbreviation, as well they do not have problems in defining who is an authorized person, and the form of authorization required in order to overcome prohibition rejections. Although marks of this type in the selected countries do not have this prohibition problem, marks still cannot be registered smoothly as foreign country names and foreign country abbreviations still fall under the umbrella of “geographical names” which cannot be registered unless the applicant can prove distinctiveness through use or accepts the disclaimer requirement in cases where the foreign country name or a foreign country abbreviation are a minor element of the mark.

Though the implementation is obviously smooth in all the selected developed countries, Section 8 (6) of Thai Trademark Act still further extends to the terms “foreign country names” and “foreign country abbreviations”. According to the study, it is obvious that the implementation goes too far beyond the purpose of Article 6ter of the Paris Convention *which was “to provide a degree of legal protection to armorial bearings, flags and other State emblems as well as official signs and hallmarks indicating control and warranty adopted by States that are members of the Paris Union. The protection was extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations, of which at least one member State is a*

member of the Paris Union.”³⁴ As we can see from the purpose of the Convention, the protection of foreign country names and foreign country abbreviations is not described in the Article. In addition, the author found that the responsible authorities have a difficult time dealing with the overextended provision in Section 8 (6) as the authorities cannot find solid terminology defining “foreign country name” and “foreign country abbreviation” reflected from Supreme Court’s Judgment No. 5402/2551 “SOUTH AFRICAN AIRWAYS” above that the discretion of the authority was extended to words in relation to the nation e.g. nationality. The vague terms result in inconsistent discretion of the authorities in considering whether the mark should be rejected on prohibition grounds under Section 8 (6) or non-distinctiveness grounds under Section 7 Paragraph 2 (2). Without clear practice, both provisions remain open for the authorities to use at their discretion, as they can freely reject the mark on either one of the two possible grounds or both grounds altogether.

5.2 Recommendations

In order to promote trademark registrations consisting of foreign country names and foreign country abbreviations, and to bring about consistency in the decisions rendered by the Thai authorities, the author proposes the following amendment of the Thai Trademark Act B.E. 2534 to successfully implement Article 6ter of Paris Convention into Section 8 (6) of the Act:

Section 8 “Trademarks having or consisting of any of the following characteristics shall not be registrable:

³⁴ Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, The Protection of Country Names Against Registration and Use as Trademarks (WIPO/Strad/INF/7, 2015).

(6) national emblems and flags of foreign countries, emblems and flags of international organizations, emblems of head of foreign countries, official emblems and quality control and certification of foreign countries or international organizations, names and abbreviations of ~~foreign countries~~ or international organizations, unless permission is given by the competent officer of the foreign country or international organization;”

The main objective of this amendment is only to re-implement Article 6ter of Paris Convention into Section 8 (6) of the Thai Trademark Act to meet the purposes of the Article. The author believes that any obstacles to registration caused by the over-extended part of Article 6ter without reasonable legislative answer, like this prohibition of foreign country names and foreign country abbreviations is not acceptable.

Note that choosing to omit the words “foreign countries” and “or” simply removes rejection of marks consisting of such words by the current Section 8 (6). The author believes that other provisions, aside from Section 8 (6), are sufficient enough to deal with this matter, they are as follows:

- Grounds of distinctiveness as names and abbreviations of foreign countries are geographical names detailed in Section 7.
- For cases where the names and abbreviations of a foreign country appear in the mark with doubt as to whether the mark misleads the public as to the place of origin of the goods/services, the authority may instruct to reject the mark on the grounds of prohibition under Section 8(13) of the current Trademark Act together with Clause 2(2) of the Ministerial Notification No. 5 B.E. 2543 (2000) stating that “trademarks, service marks, certification marks and collective marks which has the following characteristics shall not be

registered (2) marks and descriptions which cause confusion or mislead to type of goods or services or confuse or mislead with regard to place of origin or ownership of goods or services.” In addition, the consideration of whether confusion might occur should rely on public perception, not solely rely on the discretion of the authority.

The best outcome of this solution is to avoid inconsistency resulting from individual authorities exercising their discretion when considering whether a mark should be rejected on grounds of distinctiveness or on the grounds of prohibition since there will be only distinctiveness grounds left for the authority to consider. In addition, this solution makes it unnecessary to accurately define the terms or interpret the definitions of names and abbreviations of foreign countries as they will not be available in Section 8 (6). In this regard, the author suggests that Thailand should omit the words “foreign countries” and “or” from Section 8 (6) of the current Thai Trademark Act.

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