

Trademark Opposition Procedure in Thailand

Overview

A trademark application which, after examination, is considered acceptable for registration by the Registrar shall be published in the Trademark Gazette. Under Section 35 of the Thai Trademark Act B.E. 2534 (1991) as amended, within 60 days from the publication date, an opposition can be filed with the Trademark Office, Department of Intellectual Property.

Details and considerations

Reasons for opposition

- (1) Better rights or better title
- (2) Lack of distinctiveness
- (3) Prohibited mark
- (4) Identical or confusingly similar to a prior mark
- (5) The application does not conform to any provision of the Trademark Act

Person eligible to file an opposition

For the first ground, i.e. better rights or better title, the person who thinks he has better rights may file an opposition. For the remaining grounds, any person may file an opposition.

Deadline to file an opposition

The deadline to file a notice of opposition is 60 days from the publication date. The deadline to file a notice of opposition cannot be extended.

Opposition procedure

A notice of opposition must be filed with the Trademark Office using the form required by law along with all the supporting information. The official fee to file an opposition is 2,000 Baht.

A notarized Power of Attorney is required to file an opposition on behalf of the opponent.

The opponent may request an extension of 60 days to submit additional evidence in support of the opposition.

After an opposition is filed, the Registrar shall serve a copy on the applicant by registered post. The applicant has 60 days from the date of receipt to file a counter statement with the Registrar. There is no official fee for filing a counter statement. If no counter statement is filed within 60 days, the application will be deemed abandoned. The deadline to file a counter statement cannot be extended.

The applicant may request an extension of 60 days to submit additional evidence in support of the counter statement.

After the parties have filed their notice of opposition and counter statement along with their supporting evidence, the Registrar will consider arguments of both parties and issue a decision. Based on recent statistics, for straight forward cases with not much evidence, it usually takes about 10 months for a decision to be issued. For complex cases or opposition with huge amounts of evidence, it could take 16 months or more for a decision to be issued. The written decision will be sent to both parties.

If a party disagrees with the decision of the Registrar they may file an appeal to the Trademark Board within 60 days from date of receipt of the Registrar's decision. The official fee to file an appeal with the Trademark Board is 4,000 Baht.

The appellant may request an extension of 60 days to submit additional evidence in support of the appeal. The appeal is ex-parte and the other party cannot submit a response.

After the appeal is filed, the Trademark Board will consider the appeal and issue a decision. Based on recent statistics, for straight forward cases with not much evidence, it usually takes about 14 months for a decision to be issued. For complex cases or opposition with huge amounts of evidence, it could take 20 months or more for a decision to be issued. The written decision will be sent to both parties.

If a party disagrees with decision of the Trademark Board they may file an appeal to the Intellectual Property and International Trade Court (IPIT Court) within 90 days from the date of receipt of the Trademark Board's decision. The judgment would be announced in about 12-16 months after the complaint is filed.

Judgment of the IPIT Court can be appealed to the Court of Appeal for Specialized Cases. Parties who are not satisfied with the judgment of the Appeal Court must petition the Supreme Court to hear their case.

Remedies available

The only remedy available in an opposition proceeding in Thailand is the refusal to register a mark. The Registrar and the Trademark Board does not award attorney's fees or costs. The Court can award attorney's fees but the amount is generally very low and does not reflect the actual fees.

Recommendation

It is advisable to file an opposition as it is easier and more cost effective to oppose a trademark than to allow it to proceed to registration and cancel the mark at a later stage.

Sources

1. Trademark Act B.E. 2534 (1991) as amended in B.E. 2543 (2000) and B.E. 2559 (2016)
2. Ministerial Regulation B.E. 2535 (1992) issued under the Trademark Act B.E. 2534 (1991) as amended by Ministerial Regulation No. 5 B.E. 2560 (2017)

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