

# Tilleke & Gibbins

bangkok | hanoi | ho chi minh city | jakarta | phnom penh | vientiane | yangon

# Issues on the Protection & Enforcement of NTTMs

IP KEY SEA CONFERENCE ON TRADEMARKS

Bangkok, Thailand  
15 October 2019

Presented by Michelle K. Ray-Jones  
Consultant

# NTTM Protection in Thailand

<b>REGISTRABLE</b>	<b>NOT REGISTRABLE/NOT LIKELY TO BE REGISTRABLE</b>
<b>Combination of Colors</b>	<b>Single Color</b>
<b>Sound</b>	<b>Touch</b>
<b>Three Dimensional</b>	<b>Smell</b>
	<b>Taste</b>
	<b>Motion</b>
	<b>Position</b>
	<b>Hologram</b>

# Successful NTTMs in Thailand

# Marks Consisting of a Group of Colors



Class 42  
Convenience store  
services



Class 9  
Glasses,  
sunglasses, etc.

# Sound Marks

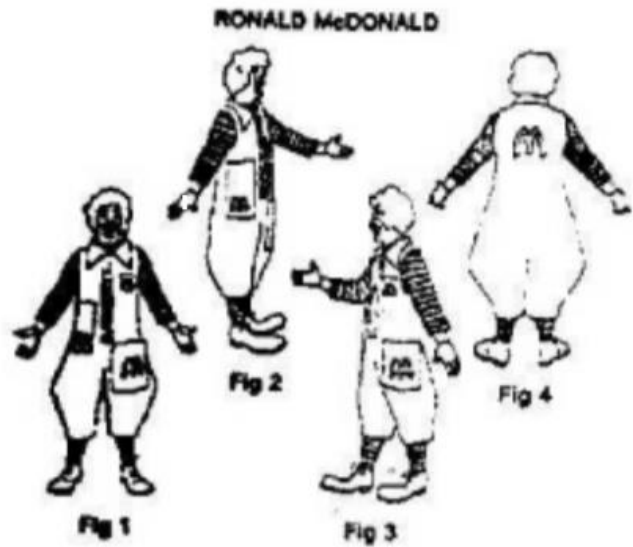


**Class 5: Sanitary napkins, tampons, etc.**



**Class 5: Baby diapers, etc.**

# 3D Marks



Class 43  
Restaurant Services,  
etc.



Class 30  
Tea, coffee, etc.

# INTA

## Non-Traditional Marks Committee

- ❑ Develops and advocates INTA's policy regarding protection of NTMs.
- ❑ Monitors developments in treaties, cases, legislation, and regulations, and completes analyses and proposes policy recommendations to the INTA Board.






# INTA

## East Asia & Pacific NTTM Subcommittee

- ❑ Policy Dialogue in Beijing
- ❑ Comments on draft laws and countries that need improvement in NTTM protection
- ❑ Matrix of information on NTTM protection in APEC, ASEAN and Greater China (available to INTA members on [inta.org](http://inta.org))

# Matrix of NTM Protection (inta.org)



		Australia	Brunei	Indonesia	Japan	Korea	Malaysia	New Zealand	Philippines	Singapore	Thailand	Vietnam
	Statutory / case law prohibition / allowance?	Provided for under Sections 6 & 17 of the Trade Marks Act 1995.	Section 4(1) of the Trade Marks Act (Cap 98) expressly provides that it is eligible for registration.	Not explicitly mentioned in the law, but in practice (implicitly) assumed to be not eligible for registration.	Indicated in Trademark Law Act 2 (1)	Indication in Trademark Law Act 2 (1) i, ii	Not expressly provided in the Trade Marks Act 1976 although definition of "mark" is non-exhaustive	Provided for under Section 5 of the Trade Marks Act 2002 and Part 2 of the IPONZ Practice Guidelines.	Explicitly foreseen by Section 121 (1) of the IP Code as registrable as long as the color is defined by a given form.	Explicitly foreseen by law as per Section 2(1) of the Trade Marks Act as eligible for registration.	Not explicitly mentioned in the law, but in practice (implicitly) assumed to be not eligible for registration.	Single colors are not eligible for registration unless they combine with literal/figurative elements or are presented in forms of characters/shapes (IP Law).
Single Color	Inherent / acquired distinctiveness?	Some have been considered inherently distinctive; evidence of acquired distinctiveness prior to the filing date is usually required.	Evidence of distinctiveness may be required if an objection is raised.	May not be registered in either event.	Acquired distinctiveness	Acquired distinctiveness	Generally not registrable as deemed not distinctive	Only registrable on evidence of acquired distinctiveness.	May be inherently distinctive. Examiners may require a sample of the colour on paper, the designation of the colour using its common name or a description of how the colour is applied to the goods or services.	May be inherently distinctive, the Registrar will determine on a case by case basis if acquired distinctiveness must be proven.	May not be registered in either event.	Unregistrable without exception.
	Examples	Trade Mark No. 704779 	N/A	No registered marks so far.	No registered mark as of March 30, 2018	Registration No. 1183777 	N/A	Trade Mark No. 211575 	DEVICE Registration No. 42015008271 	Registration No. T9900636A 	N/A	No registered marks so far



Name Michelle Ray-Jones  
Telephone 02 653 5555  
E-mail michelle.r@tilleke.com



For more information please visit our website:

[www.tilleke.com](http://www.tilleke.com)



[www.facebook.com/tillekegibbins](http://www.facebook.com/tillekegibbins)



[twitter.com/tillekegibbins](http://twitter.com/tillekegibbins)