Issues on the Protection & Enforcement of NTTMs

IP KEY SEA CONFERENCE ON TRADEMARKS

Bangkok, Thailand
15 October 2019

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# NTTM Protection in Thailand

<table>
<thead>
<tr>
<th>Registrable</th>
<th>Not Registrable/Not Likely to Be Registrable</th>
</tr>
</thead>
<tbody>
<tr>
<td>Combination of Colors</td>
<td>Single Color</td>
</tr>
<tr>
<td>Sound</td>
<td>Touch</td>
</tr>
<tr>
<td>Three Dimensional</td>
<td>Smell</td>
</tr>
<tr>
<td></td>
<td>Taste</td>
</tr>
<tr>
<td></td>
<td>Motion</td>
</tr>
<tr>
<td></td>
<td>Position</td>
</tr>
<tr>
<td></td>
<td>Hologram</td>
</tr>
</tbody>
</table>
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)
# Matrix of NTM Protection (inta.org)

<table>
<thead>
<tr>
<th>Single Color</th>
<th>Australia</th>
<th>Brunei</th>
<th>Indonesia</th>
<th>Japan</th>
<th>Korea</th>
<th>Malaysia</th>
<th>New Zealand</th>
<th>Philippines</th>
<th>Singapore</th>
<th>Thailand</th>
<th>Vietnam</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Statutory / case law prohibition / allowance?</strong></td>
<td>Provided for under Section 6 &amp; 17 of the Trade Marks Act 1995.</td>
<td>Section 4(1) of the Trade Marks Act (Cap 89) expressly provides that it is eligible for registration.</td>
<td>Not explicitly mentioned in the law but in practice (implicitly) assumed to be not eligible for registration.</td>
<td>Indicated in Trademark Law Act 2 (1).</td>
<td>Not expressedly provided in the Trade Marks Act 1976 although definition of “mark” is non-exhaustive.</td>
<td>Indication in Trademark Law Act 2 (1). II</td>
<td>Provided for under Section 6 of the Trade Marks Act 2002 and Part 2 of the IPONZ Practice Guidelines.</td>
<td>Explicitly foreseen by Section 121 (1) of the IP Code as registrable as long as the color is defined by a given form.</td>
<td>Explicitly foreseen by law as per Section 2(1) of the Trade Marks Act as eligible for registration.</td>
<td>Not explicitly mentioned in the law but in practice (implicitly) assumed to be not eligible for registration.</td>
<td>Single colors are not eligible for registration unless they combine with literal/figurative elements or are presented in forms of characters/shape (IP Law).</td>
</tr>
<tr>
<td><strong>Inherent / acquired distinctiveness?</strong></td>
<td>Some have been considered inherently distinctive; evidence of acquired distinctiveness prior to the filing date is usually required.</td>
<td>Evidence of distinctiveness may be required if an objection is raised.</td>
<td>May not be registered in either event.</td>
<td>Acquired distinctiveness</td>
<td>Acquired distinctiveness</td>
<td>Generally not registrable as deemed not distinctive.</td>
<td>Only registrable on evidence of acquired distinctiveness.</td>
<td>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.</td>
<td>May be inherently distinctive, the Registrar will determine on a case by case basis if acquired distinctiveness must be proven.</td>
<td>May not be registered in either event.</td>
<td>Unregistrable without exception.</td>
</tr>
<tr>
<td><strong>Examples</strong></td>
<td>Trade Mark No. 704779</td>
<td>N/A</td>
<td>No registered marks so far.</td>
<td>No registered mark as of March 30, 2018</td>
<td>Registration No. 1103777</td>
<td>N/A</td>
<td>Trade Mark No. 211575</td>
<td>DEVICE Registration No. 42015008571</td>
<td>Registration No. T9900038A</td>
<td>N/A</td>
<td>No registered marks so far</td>
</tr>
</tbody>
</table>
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