

Judicial Symposium on  
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# Answer to Q1

- Principle of Territoriality, registration in Thailand – protection
- No registration no protection for defendant
- Ask for injunction -stop using Defendant's trademark on Defendant's products
- Request compensation for damages of loss—possible profit of the sale of products

# Answer to Q2

- First-to-use trademark ,actual use in commerce before
- Plaintiff's intention to use and register defendant's trademark have not done in good faith.
- Counterclaim for cancellation of trademark's registration of plaintiff under Section 61 of the Trademark Act B.E. 2534 (1991)

# Answer to Q3 1)

- Good faith of both parties
- Even no application was filed under the Madrid Protocol, the case needs to be considered whether the Defendant's trademark has been registered in the ABCM Corp. home country or other countries and for how long to determine the good faith
- The Well-known mark of the trademarks under Section 8(10) of the Trademark Act B.E. 2534
- (In case the Defendant make an issue) whether the plaintiff's registered marks in Thailand are valid under Section 6 of the Trademark Act B.E. 2534

## Answer to Q3 2)

- Yes, the considering factors are the same, while the most important factor is good faith of both parties.

# Answer to Q4—two separate stages

- Infringement stage
  - Section 44, 68 of the Trademark Act B.E. 2534 owner has exclusive right, allow others—breach of the agreement
  - On the contrary, the other party might argue a better right in the trademark, it has been unlawfully registered.
- Damages stage
  - After a success in infringement stage—proof of actual damage in business caused by infringer is required.

# Answer to Q5

- No specific provision in the Trademark Act B.E. 2534 , Section 438 of the wrongful act in the Civil and Commercial Code applies
- Cannot prove damage—no damages granted
- Can prove damage but fails to prove the amount of damages—the court can determine the damages considering circumstances and the gravity of the infringement—not exceeding the requested damages

# Answer to Q6

- Thailand adopts the principle of first-to-file system for registration of trademark.
- Subject to cancellation of a trademark petition on a non-use basis under Section 63 of the Trademark Act B.E. 2534



# Answer to Q7

- Dismiss the case and may cancel the plaintiff's trademark registration if the defendant requesting for cancellation of the registration
- The trademark law should be interpreted to protect the actual owner of the trademark (reading Section 44)
- Distributor of the goods v. actual owner—misunderstanding of the ownership or the origin of the goods.
- The plaintiff—not in good faith, no right in trademark and, no right to sue

# Answer to Q8

- The Trademark Act (No.3) B.E. 2559 (2016) to amend the Trademark Act B.E. 2534 adding the definition of “Mark” protected under the Act to include “sound”
- Accede to the Madrid Protocol Concerning the International Registration of Marks

# Answer to Q8

- Primary Registrations: Trademark Act BE 2534 (1991)
- Governing Body Control the Registration Process:  
The Department of Intellectual Property
- Examining Body: Trademark registrar
- Reviewing body: The Trademark Board
- Appellate Body: Central Intellectual Property and International Trade Court (IPIT Court), the Court of Appeal for Specialized Cases(IPIT Case Division), the Supreme Court (IPIT Case Division)