



**NON-USE CANCELLATION AGAINST TRADEMARK
REGISTRATION IN THAILAND**

BY

MISS JEERAKARN NAKARAT

**A THESIS SUBMITTED IN PARTIAL FULFILLMENT OF
THE REQUIREMENTS FOR THE DEGREE OF MASTER OF
LAWS IN BUSINESS LAWS (ENGLISH PROGRAM)**

FACULTY OF LAW

THAMMASAT UNIVERSITY

ACADEMIC YEAR 2015

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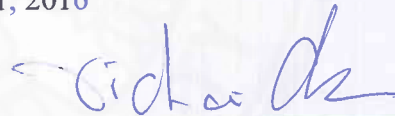
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IN THAILAND

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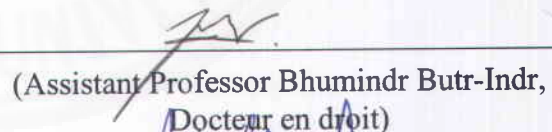
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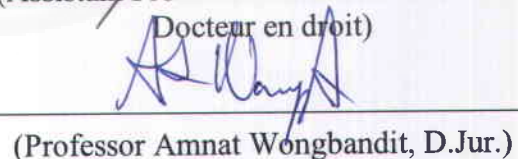
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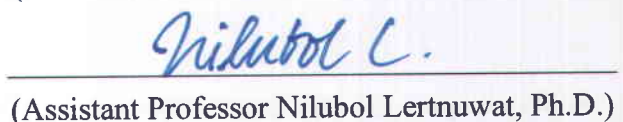
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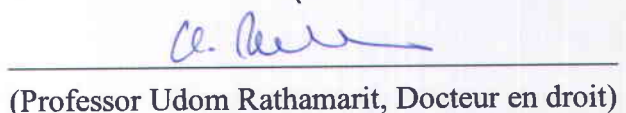
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Degree	Master of Laws
Major Field/Faculty/University	Business Laws (English Program) Faculty of Law Thammasat University
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Academic Years	2015

ABSTRACT

Trademark is a business tool that plays a vital role in the economic and trading system. It is created for the use in course of trade as a symbol to identify the owner of goods or services provider. Consumers can recognize the product as from seeing its trademark and are able to distinguish which product belongs to which manufacturer through the use of trademarks. Without the use, the products cannot be recognized by and known among the public.

Thailand adopts the 'First-to-File' system, where the protection of trademark is granted on a first come first serve basis. Sometimes, trademark owners may early file an application in order to be the first one who register it and receive the exclusive rights to use such trademark as a legal protection, but in fact, the registrant may not have used the registered trademark in commerce or have no intention to use it. The registrant only holds the registration as a paper in hand but does not utilize the protection received from its trademark. This kind of registration is considered as a defensive registration that has affected to many aspects i.e. cluttered registry records, non-economic improvement, especially it may be considered as monopoly right given to the first registrant and unfair competition to the later comer as being set as a barrier preventing others who may actually use the same or similar trademark in commerce to

apply for the registration due to the obstacle of such prior unused registered trademarks.

Although Trademark Laws have provided a solution for any affected party to revoke the prior registration of a trademark based on the ground of non-use, in some countries such as Thailand, non-use cancellation is rarely overcome because the burden of proof for such non-use lies on the petitioner who has no access to the facts and information on whether the registered trademark owner has or has not used its trademark since registration. In addition, the high standard of proof required by the Board of Trademark puts more burden to the petitioner.

This thesis will study on the general requirements for non-use cancellation and practices in international laws i.e. Paris Convention and the TRIPs Agreement as well as four selected foreign laws i.e. the United States of America, the United Kingdom, Japan and the People's Republic of China, which are the countries that non-use cancellation are efficiently implemented. Then, the thesis will demonstrate situations of non-use cancellation proceeding in Thailand by pointing out the problems arising in practice according to the burden of proof and high standard of proof required by the Board of Trademark, as well as mainly focus on specific provision pursuant to Section 63 of Trademark Act B.E. 2534 (1991) as amended by Act (No. 2) B.E. 2543. In comparison with foreign laws and practical proceedings under other countries, the Author will provide side-by-side proposed alternative solutions that could be beneficial to resolving problems and will respond to all potential issues.

Keywords: Trademark, Non-use Trademark, Cancellation, Non-use Cancellation

ACKNOWLEDGEMENTS

It was an amazing educational experience to be a part of this LL.M. program at Thammasat University. This thesis could not have been achieved without help and support from many people. First of all, I would like to express my deepest gratitude to my thesis advisor and all members of committee for devoting their valuable time and providing the precious advices which enabled me to complete this thesis. I am honored to have this invaluable opportunity to work under their guidance.

My most appreciation goes to my parents, Dr. Chakrawan Nakarat for supporting my dreams, and Mrs. Kanokporn Nakarat for her unconditional love and care. They are the reason I have put so much effort to write this thesis. Without their greatest encouragement, I could not be strong as I am today.

In addition, I would like to express my thankfulness to my colleagues and friends at Trademark2u (Thailand) Co., Ltd., most importantly, to Mr. Yanaphat Chiaosiriphatthanakun and Miss Thaneeya Lalitkulthorn for their kindness. I am grateful for all opportunities they have given to me. It has been a pleasure journey to have this privilege working with them. Besides, I would never have discovered this topic if I had not worked here. They are the important part of this success.

Apart from that the thesis would not have been possible without help and supports from all LL.M. staffs and friends. Especially, I would like to give my special thanks to Miss Maytiya Phoklin for these so many years of friendship, and Miss Au-arpa Sittipong for always understanding the situation that I have been through and cheering me up during this tough time.

Finally, I am thankful to have Mr. Phi Ploenbannakit as my business and life partner who is always by my side and believes in me even when the time I lose my faith. I would have not accomplished this thesis without him.

Miss Jeerakarn Nakarat
Thammasat University
Year 2015

LIST OF ABBREVIATIONS

Symbols/Abbreviations	Terms
CTMO	China Trademark Office
DAU	Declaration of Actual Use
DIP	Department of Intellectual Property
EU	European Union
IPIT	The Central Intellectual Property and International Trade Court
	Japan Patent Office
TRAB	Trademark Review and Adjudication Board
TRIPs	Agreement of Trade-Related Aspects of Intellectual Property Rights
SOU	Statement of Use
UK	The United Kingdom
US	The United States of America
USPTO	The United States Patent and Trademark Office
WIPO	World Intellectual Property Organization

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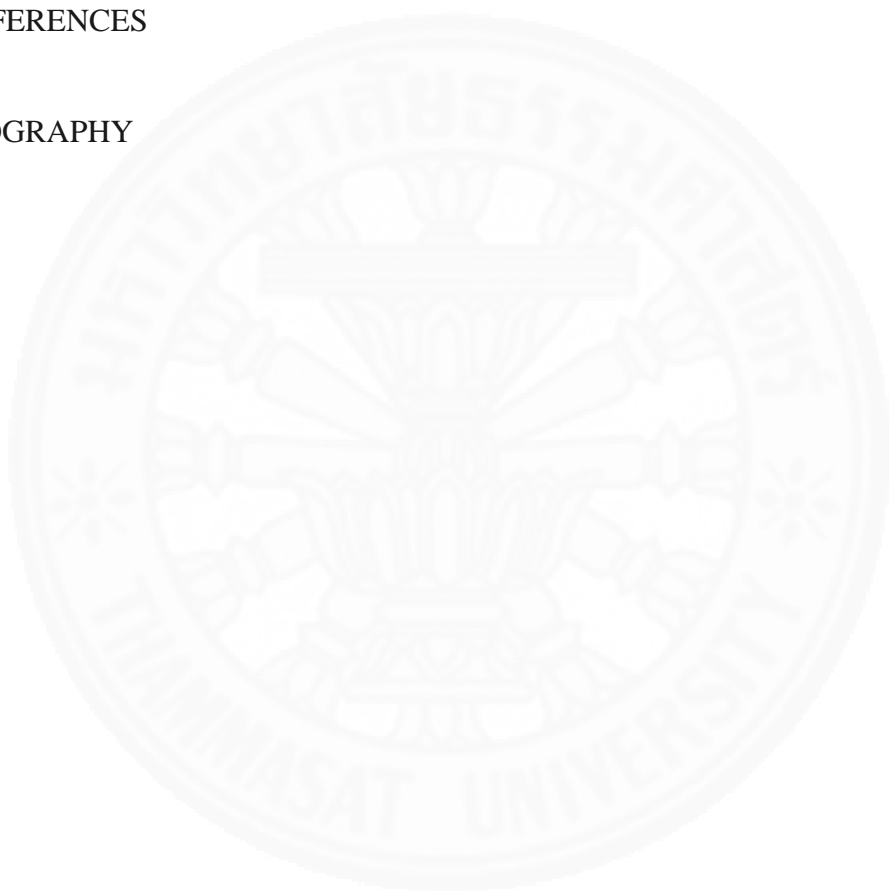
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CHAPTER 1

INTRODUCTION

1.1 Background and Problems

Trademark is a kind of intellectual property that is created for the use in course of trade as a symbol to identify the origin or source of goods and to enable the owner of a service to differentiate their products from those belonging to others. Consumers will recognize the products by seeing its trademark and are able to distinguish which products belong to each respective manufacturer. According to this form of recognition, consumers are subsequently able to decide which products to purchase based on the previous manufacturer's reputation and to ensure that they will receive the same quality under the same trademark. Therefore, a trademark functions as a tool that both facilitates trade and encourages economic growth.

The owner of a trademark may seek legal protection by applying for registration in order to receive a tangible evidence that proves title and ownership of the trademark that was created. Upon registration, the owner of the registered trademark will have exclusive rights over its use and also possess the right to prevent others from using such trademark. This protection also covers those identical or similar marks that resemble to the trademark that has been duly protected, which may be misleading or cause confusion amongst the public regarding the rightful owner or the origin of the products.

Occasionally, a trademark owner may early file an application in order to be the first party who registers it, and secures the protection, even if the owner might not have used such registered trademark in commerce or have no intention of using it. This type of registration is considered a defensive registration which places a barrier preventing others from registering the same or similar trademark. Therefore, such owner of the registered trademark only holds the registration on paper, but they do not utilize the protection received for their trademark in the course of trade.

Thus, on this basis, if a trademark is filed for protection by means of official registration, such trademark should receive proper protection in respect to the use of it. The trademark must respond to its functions in such a manner so as to distinguish the goods or services under this trademark from other goods or services under trademarks belonging to others. However, if the mark that is legally protected, but has not been genuinely used in the course of trade, such trademark cannot perform its function, and thereby, such protection cannot be beneficial to trade. Consequently, the unused trademark shall not be worth having the registration protection.

Such unused trademarks has affected to many negative aspects i.e. cluttering up Registry records, not stimulating or improving economy development, and in particular, it may also be considered as monopoly protection given to the first registrant. This creates unfair competition as it adversely affects the later applicants who may genuinely intend to use the trademark in commerce, but they cannot secure a legal protection because their application will be refused due to the obstacle of such prior registered trademark.

Non-use cancellation is a legal proceeding for cancelling the registration of trademark based on the claim that such trademark has no commercial use by the registrant. Due to the limited resources of trademark, non-use cancellation scheme can be a significant method for cleaning up cluttered Registry records, and help in revoking the registration of unused trademarks from the system. This could, in turn, provide opportunities for later trademark applicants to register their trademark which will be utilized commercially.

Thailand adopts the First-to-File system, wherein trademarks are registered on a first-come-first-serve basis. Under this system, the applicant who files a trademark application first will be eligible to enjoy the legal protection under Thai Trademark Law, with 10 years of protection, without any requirement to force the trademark owner to use its registered trademark in commerce within any prescribed period.

As a result of there being no requirement for the trademark owner to genuinely use the trademark imposed under Thai Trademark Law, some trademarks that have been registered and recorded as existing trademarks in the Registry records, may in fact have never been used in course of trade in relation to the goods or services for which it was secured during the registration protection.

Although Thailand has a legal provision under Section 63 of the Thai Trademark Act B.E. 2534 (1991), which stipulates that later applicant or any interested person, is entitled to file a petition for non-use cancellation against the registered trademark. The petitioner must bear the burden of proof to produce the evidences proving such non-using of the registered trademark that belongs to the other party. Thus, it would appear that it is difficult to overcome this requirement, since the petitioner does not have access to the requisite facts and information pertaining to the use of the trademark in question. Considering on the standard of proof constantly required by the Board of Trademark's determinations, the petitioner must provide the concrete evidence which firmly shows the actuality of non-using of the trademark in commercially purpose. In addition, the petitioner is also required to prove the lack of bona fide intention of the registrant to genuinely use the trademark in relation to the registration. These burdens to prove in term of such negative facts seem to be impossible for the petitioner, and not many petitioners have been satisfied with the outcome. The difficulties of overcoming the burden and standard of proof result in the ineffectiveness of the non-use cancellation proceeding in Thailand. Where the non-use cancellation rarely succeeds, the unused trademark would be as a barrier for the new investors to put in effort and invest their business in the country where their trademarks could, perhaps, not be protected.

Whereas in some foreign countries, the non-use cancellation provisions have placed the burden of proof against such unused trademark on the trademark owner, who has full access to the facts and information to defensively prove whether the mark, in fact, is being used or not. This burden of proof that is placed on the trademark owner does not impose too high standard of proof rendering the non-use cancellation efficient and successful. In addition, some countries also have legal

requirements relating to genuine use of a trademark in order to ensure the certainty that a registered trademark, which was given a protection, is actually being used in the course of business and in a manner that is beneficial for trade and the public. These requirements would encourage the trademark owner to genuinely use its trademark in exchange of avoiding the revocation of rights and maintaining its registration.

From time to time, Thailand has amended several of its legal provisions to adjust to current issues which arise from to problems related to legal procedures and practical proceeding, including to enhance its domestic law to be equivalent to the foreign countries and international rules. However, the legal provision regarding non-use cancellation proceeding under Thai Trademark Law is an unresolved problem. It has been a difficult proceeding that hardly succeeds considering on the existing precedents, Board of Trademark decisions and related Court judgments. Since the oldest Trademark Law up until current version, the law has never been changed or paid much attention in resolving this obstructive proceeding. It still remains as such due to the new Trademark Act, Trademark Act B.E. 2534 (1991) as amended by Act (No.3) B.E. 2559 (2016), which has been recently announced this year, has not mentioned this provision as a subject-matter to be amended.

Therefore, it is the time for Thailand to seriously consider the legal measures that could reduce the burden of proof and eliminate the barrier posed by the non-use cancellation scheme in Thailand. Moreover, providing a legal requirement to prevent the defensive registrations wherein the marks are not genuinely used by the registrant, would give later trademark applicants, who intend to use the mark, the opportunity of overcoming the obstructive registration. Lastly, looking for the alternative solutions could be implemented as important parts in encouraging trademark owners to use their registered trademarks in commerce, and thus could result in balancing between the rights given to the trademark owner and public interest, as well as supporting the improvement of trade and economic growth.

1.2 Hypothesis

Non-use cancellation in Thailand is a difficult procedure and rarely succeeds due to the burden of proof lies on the petitioner who has no access to the facts and information pertaining to use of the registered trademark as well as the high standard of proof required by the Board of Trademark's determination are more burden to the petitioner. Therefore, providing the recommended solutions to amend the Thai Trademark laws, by highlighting the practical problems and comparing these practices with proceedings that are adopted in foreign countries, will formulate the guidelines to facilitate non-use cancellation in Thailand. When the non-use cancellation proceeding is effective, the scheme will play as a vital role to encourage trademark owner to be aware of using their registered trademark in order to maintain their registration and benefit to the economy growth as well as to give an opportunity for the later trademark applicant who actually uses the identical or similar trademark to be granted a protection.

1.3 Objectives of study

- a. To study the general concept of use and non-use of trademarks, focusing on the requirement relating to genuine use of a trademark registration.
- b. To study the proceeding of non-use cancellation in foreign countries, namely the United States of America, the United Kingdom, Japan and the People's Republic of China, by analyzing existing provisions, practical proceeding models, and the benefits of placing burden of proof on the registrant.
- c. To study the provision of law relating to non-use cancellation in Thailand, the existing precedents, Board of Trademark decisions and related Court judgments, as well as to address the problems arising from existing law and standard of proof required by the Board which affect to burden of proof in practical proceedings.
- d. To propose legal solutions to amend existing law and practical proceeding in order to reduce the obstacles that impede non-use cancellation against trademark registration in Thailand.

1.4 Scope of study

This thesis will focus on legal problems relating to non-use cancellations in Thailand, by analyzing existing provisions cited in Section 63 of the Thai Trademark Act B.E. 2534 (1991), studying decisions of the Board of Trademark and related Court judgments, and comparing with existing foreign laws and proceeding methods, including the principle of requirement for genuine use of a trademark, to ascertain whether these could be more effective to facilitate non-use cancellation proceedings.

1.5 Methodology

The study methodology is based on documentary research which places emphasis on legal texts, Thai and foreign legislative provisions including the international rules, court judgments, Board of Trademark decisions, legal articles and publications, online databases, as well as the opinions of legal practitioners in the field of Trademark and Intellectual Property laws and procedures.

1.6 Expected Results

- a. To understand the general principles of trademark protection concerning use and non-use.
- b. To understand the requirement of use and proceeding for non-use cancellation against registered trademarks, as well as the provisions existing in international rules and foreign countries, including to understand the burden of proof and how to proceed against non-use trademarks.
- c. To understand the law and situations involving non-use cancellation against registered trademarks in Thailand.
- d. To understand the problems of Thai Trademark Law, and the determination of the Board of Trademarks, which are impediments against non-use cancellation proceedings in Thailand, and whether Thailand should adopt legal measures prevalent in other foreign countries to benefit the practice in legal proceeding.

CHAPTER 2

GENERAL PRINCIPLES OF TRADEMARK LAW, REQUIREMENT OF GENUINE USE AND NON-USE CANCELLATION

"Trademark" is a kind of intellectual property which plays a vital role with industrialization and become a key factor in the modern world to the economic and trading system. As being represented as a symbol to identify the owner of the products, a trademark enables the consumers to distinguish which product belongs to whom and which products belong to those of competitors. The use of trademark \exists as long as the trade itself. Without the use of trademark, the products cannot be recognized by and known among the public and consumers.

As growth and development of trade and economic, Trademark law has also been developed to provide a legal protection for traders' interests along with protecting the public and consumers from confusion or misleading by various uses of trademark. The law in this area restrains others from applying the owner's brand to their goods and services.¹ It is called "exclusive" rights that given to the owner in order to prevent others from using his intellectual property without any authority.²

There are two systems providing trademark owners to earn their legitimated rights. By common law, most countries usually adopt the 'First-to-Use' system, where the rights in trademark are based on use and goodwill.³ While another system, 'First-to-File', is mostly adopted by civil law countries, the trademark owner's rights are protected by statute, when registers it with government authorities.

Nevertheless, either in common law or civil law system, a trademark can be applied by registration to the Trademark Office within the jurisdiction. The

¹ Marisa Cremona. **Intellectual Property Law**. 88. (4th Edition. Palgrave Macmillan Law Masters, 2006)

² *Id.* Page 2.

³ *Id.*

government officer, so called as 'Registrar', will then has a duty to review and examine the proposed mark's application, whose authority is also to determine whether the mark is qualified for registration according to the law. One of prohibitions that a trademark cannot be registered is to identical with or similar to any others' prior registered trademark which has been recorded by the Registrar. The reason behind this prohibition is because, if two identical or nearly similar trademarks belonging to the different owners can be both registered and used with the same goods or services in the same market, they may likely cause confusion to the public and consumers from those similarity at the time of purchasing such goods. Since the first registrant is given an exclusive right as a legal protection to use such trademark, the later application of second comer will be then rejected. On the contrary, if a proposed mark is not appeared to be identical with or similar to those already registered and passes the Registrar's examination, the application will be published in the Official Gazette, where any third party, who believes to be affected by the registration of such proposed mark, will have an opportunity to oppose the registration. Unless the opposition is filed during the period of publication, a registration certificate will be issued and granted the protection to such trademark owner.

The process of trademark registration seems to be easily understandable and efficient for the trademark owner to have its trademark recognized and protected under the intellectual property laws, whereas there are still some problems that occur from such registration process i.e. registration in bad faith or registration without use or intention to use of trademark. Given such problems, in some countries, Trademark law has provided legal procedures allowing any third party, or an aggrieved party, to have an opportunity to revoke such defensive registrations from the Registry's records i.e. cancellation of trademark registering in bad faith or so called 'revocation for invalidation', or cancellation against trademark registration based on the claim of non-use or so called 'non-use cancellation'. These cancellation procedures can equalize between the rights of the first trademark registrant to ensure that the registration is worth protecting and using trademark in commerce and the rights of the second comer to have an opportunity to eliminate the obstacles and be able to register the same or similar trademark that could be more benefits to the trade and economic.

This Chapter will give a general idea of what is a trademark and how important it must be used in course of trade, as well as the usefulness of trademark by emphasizing on its functions that essentially benefit to the trade and economic. In addition, it will provide the basis principles of trademark law i.e. the concept of trademark protection, the acquisitions of rights by comparing rationale backgrounds along with pros and cons between 'First-to-Use' and 'First-to-File' system. This Chapter also emphasizes on requirement of genuine use of trademark which required in many countries to ensure that the registered trademark is put in genuinely used by the rights' owners. If a registered mark has not been genuinely used in commerce, it shall not be worth for the registration and even be an obstacle to the later applicant who may potentially use the same or similar trademark. Therefore, this Chapter will lastly provide a preparation of knowledge on non-use cancellation proceeding, how it works and why it is so important, as well as the problem of burden of proof for non-using trademark in some countries which impedes the successful of this cancellation and the effects that may be arising if such cancellation is hardly succeed.

2.1 Historical Background of Trademark

The use of trademark has a history of existence since the ancient world⁴ and has been existed for as long as trade itself.⁵ The origin of trademark can be traced back as far as the beginning of the circulation of goods, which is nearly as old as the histories of mankind and religion.⁶ According to archaeological evidences, there is the use of trademark since the era of ancient Egypt and the Roman Empire. Scientists have come across excavated artifacts with various symbols carved thereon for religious and superstitious reason in places of ancient Egypt.⁷ The Romans embossed their pottery or impressed it with a mark and merchants have used marks ever since to

⁴ World Intellectual Property Organization (WIPO). **Background Reading Material on Intellectual Property**. 67. (2nd Edition. WIPO Publication, 2008)

⁵ Jon Holyoak&Paul Torremans. **Intellectual Property Law**. 8. (Butterworths, 1995)

⁶ Dr. Shoen Ono. "*Overview of Japanese Trademark Law 1 (2nd ed., Yuhikaku Publishing 1999)*" http://www.iip.or.jp/e/e_publication/ono/ch2.pdf (accessed on April 14, 2016)

⁷ *Id.*

distinguish their goods.⁸ Trademarks had become to be extensively used in Western Europe.⁹

Trademark was firstly used for the purpose of 'Proprietary mark' that functioned as a proof of proprietary rights of products ownership or title of the goods e.g. the craftsmen applied their names, unique drawings, or simple inscriptions to identify goods they created¹⁰, or the farmers marked their own animals so that it could indicate the owner and distinguish which animals belonged to whom.¹¹ Such mark that helped indicating ownership of goods was particularly important for owners so that they could claim back their goods when the loss occurred.¹²

Around the 10th century, the proprietary mark function had been called as 'Merchants mark' which significantly increased and appeared to be used as symbols attached to the goods among traders and merchants¹³ for indication of origin and distinguishing its goods from those of others in the market.

In the middle ages, function of mark has been developed from 'Proprietary mark' and 'Merchants mark' that only had a duty as an indication of ownership of the goods to become known as 'Production mark', which served as quality controller. The goods that a manufacturer who produced a low quality goods or not meet the requirement would be punished.¹⁴ These production marks helped consumers to identify the producers and claim for the responsibility of inferior products.¹⁵

⁸ *Supra* note 5. Page 8.

⁹ วัส ดิงสมิธ. คำอธิบายกฎหมายเครื่องหมายการค้า. 2. พิมพ์ครั้งที่ 1. กรุงเทพมหานคร : สำนักพิมพ์นิติธรรม. 2545. (Wat Tingsamit. **Explanation of Trademark Law. 2.** (1st Edition Bangkok: Nititham, 2002))

¹⁰ *Supra* note 6.

¹¹ *Id.*

¹² Mark P. McKenna, "The Normative Foundations of Trademark Law." 82. **Notre Dame L. Rev.** (2006-2007).

¹³ *Supra* note 9.

¹⁴ *Id.*

¹⁵ *Id.*

Mark which affixed to the goods became a compulsion and obligation to the owner to take responsible for the quality and superiority of certain goods. They did not act only to distinguish between sources of goods and indication of ownership, but to serve as an indicator of quality as well.¹⁶ Trademark had developed to be known as "Responsibility marks", which were more burdensome than real property,¹⁷ and could not be changed easily once the mark had been adopted. Consumers became more relying on trademark which could help them to decide whether or not to repurchase of such goods or services based on a previous pleasurable experience or manufacturer's reputation for quality.¹⁸ This influence had changed the consumers' behavior to buy products by seeing only the trademark of the manufacturer. However, not only the consumers benefit from the use of trademark, but also the owner of trademark and manufacturer themselves can give a guarantee to the consumers by its use of trademark that the products under this trademark are real and belongs to them, and ensure that the consumers will certainly enjoy the same quality of goods. In this case, a trademark then can be used as a proof to differentiate the authentic and counterfeit products.¹⁹

Therefore, it is so important that the product owner and manufacturer should seek for the protection of their trademark to earn the exclusive rights to be the only one who can use this particular mark and prevent others from using the same mark to similar goods in the market. According to the long history of trademark, it shows that why using of trademark is so important to the trade and why the trademark should be properly protected for the sake of products' owners and manufacturers as well as for the public and consumer protection.

¹⁶ *Id.*

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Supra* note 12. (citing Ruth E. Annad & Halen E. Norman, Blackstone's Guide to the Trade Marks Act 1994. 1. London: Blackstone Press Limited, 1994)

2.2 Definition of Trademark

Trademark is a kind of intellectual properties which is categorized as an industrial property.²⁰ As defined in Black's Law Dictionary, a definition of "Trademark" is a word, phrase, logo, or other sensory symbol used by a manufacturer or seller to distinguish its products or services from those of others.²¹ Therefore, a trademark can be in any form of creativity either a word, phrase, logo as a picture that attached to the packaging of the products or to be representing for services, or even other sensory symbol, such as taste, smell, sound, color, touch, mark, shape of goods or their packaging.²²

Especially, a trademark is an identifier of one person's goods or services.²³ It is necessary that a trademark must be put in genuinely used by the owner who may be manufacturer or seller to represent as a symbol allowing public and consumers to distinguish its products or services from products or services belonging to others.

2.3 Functions of Trademark

As the history of trademark that existing along with the trade since the ancient time, it appears that a trademark is used as a symbol for exchanging of goods and providing services. Trademark then has its duties to be utilized to the trade and economic and to facilitate the owner and producers of the products to put a signature

²⁰ กรมทรัพย์สินทางปัญญา. 99 ปี เครื่องหมายการค้าไทย. 16. พิมพ์ครั้งที่ 1 พ.ศ. 2556 (Department of Intellectual Property, 99 Years of Thai Trademark. (1st Edition, 2013))

²¹ Bryan A. Garner. Thompson Reuters. **Black's Law Dictionary**. 16. (10th Edition. The United State of America. West Publishing and Co., 2014)

²² UK Trademark Law, The 1994 Act. Section 1(1).

"a 'trade mark' means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."

²³ Amada Michaels. **A Practical Guide to Trademark Law**. 88. (3rd Edition. London Sweet & Maxwell, 2002)

marked on its goods and services. In addition, trademark is used to inform the public and consumers to track back the producers of these goods or services.

Nowadays, in modern economy, due to the numbers of trademarks in the market, producers are increasingly forced to rely upon its trademarks and advertising to identify their products, where this is the mode of communication with the consumer²⁴ to promise that the goods under the same trademark will have the same quality and guaranteed by the producer. For the same reason, the consumers rely increasingly upon personal experience, recommendation or advertisement, to identify a product or to repeat purchases.²⁵ A trademark now has its responsibility to properly function and make the best benefit to either the manufacturer and to the public or consumers.

In general, "Trademark" is used for 4 functions²⁶, which can be described as 1) Indication of origin function; 2) Product differentiation function; 3) Guarantee function; and 4) Advertisement function. However, in the Author's view, there is another function that trademark will play a vital role due to nowadays business enabling a trademark to become valuable marketing tool²⁷ and worth as an investment for business reputation, which is considerable as 5) Investment vehicle function.

2.3.1 Indication of Origin Function

The vital characteristic of the mark necessary to permit it to carry out "origin" or "product identification" function is its distinctiveness, whether the protection depends upon a trade mark registration or upon the common law protection of passing off.²⁸ Therefore, this is a preliminary function and oldest reason why the trademark should exist.

²⁴ *Id.* Page 2.

²⁵ *Id.*

²⁶ *Supra* note 12. Page 3.

²⁷ *Supra* note 23. Page 2. (citing speech of Lord Nicholls in *Scandecor Developments AB v. Scandecor Marketing AB* [2001] 2 C.M.L.R. 30; [2001] E.T.M.R. 74 at 12.)

²⁸ *Supra* note 23. Page 3.

"Trademark" is used for the purpose of indication of the origin of products or services which bear under such particular trademark.²⁹ This is the main purpose of a trademark which is to designate the source of products³⁰ in order to inform the consumers where the products come from and who is owner. It is to say that a trademark is the commercial substitute for one's signature³¹ that representing the owner and indicating the source of origin of products or services.

2.3.2 Product Differentiation Function

Similarity or lacking of differentiable ability between two or more products is the problems of trading system both to the producers themselves and to the consumers who rely on a trademark. Without the product differentiation, the consumers would be subject to confusion and deceptive information to decide which products they should purchase. Therefore, differentiating function of trademark is crucial to allow the public and consumers making their choice between the various goods available on the market and buying the right product under the right producer.

"Trademark" is used to differentiate which product under which trademark is belonging to whom. It is for the purpose of consumer's recognition in case there are products belonging to different owners, the trademark affixed on each product will be functioned to inform the consumers which product is belong to whom and make the consumers to be able to distinguish a product under trademark A is different from a product under another trademark owner³², which for example trademark B. As from this function, the trademarks will enable the consumers to differentiate the origin of the products and not to be misled or confused by the products under different owners.

²⁹ *Supra* note 9.

³⁰ *Supra* note 21.

³¹ *Id.*

³² *Supra* note 9. Page 2.

2.3.3 Guarantee Function

Another essential function of trademark is being as a guarantee or a promise from the producers to the public and consumers. "Trademark" is seen as a badge of origin and a guarantee of consistency and carrying an implied assurance of quality of products³³ to ensure the consumers that if they buy the products with the same trademark, they will get the same quality, because the products must come from the same source which be produced or manufactured by the same owner. The consumer who purchases goods and receives services is more relying on trademark which could result the repurchase of goods or services based on a previous pleasurable experience or manufacturer's reputation for quality.³⁴ This influence changes the consumers' behavior to buy products by seeing only the trademark of the manufacturer. Consumer always expects that the product under the same trademark is living up to the standard found in the earlier product by relying upon the believe that the producer's economic interest in maintaining the value of his mark, by maintaining the quality of the goods sold under his mark.³⁵ Such guarantee function is arisen from personal experience of the products, word-of-mouth recommendation or the image of the marked product projected by advertising.³⁶ In another word, a trademark enables a consumer to make an informed choice³⁷ to decide which products they should purchase.

Being as a guarantee to the public and consumers, trademark also plays a vital role in encouraging traders and producers to set and maintain quality standard³⁸ of the products that sold under its trademark. Due to the facts that if the product under the same trademark has been produced below their quality standard that they used to be, the consumers will not satisfy and may change their minds in re-

³³ *Supra* note 23

³⁴ *Supra* note 9

³⁵ *Supra* note 23 (citing *Scandecor*)

³⁶ *Id.*

³⁷ *Id.*

³⁸ *Id.*

purchasing. Therefore, this function is not only benefiting to the traders or producers themselves, but it benefits to public interest and plays a role as consumer protections.

However, trademark cannot guarantee that a product under a particular trademark will have better quality than another product under different trademark.³⁹ If the consumers feel like a product under a trademark has better quality, it may be an effect from the previous experiences in goods that they used to consume or an effect of advertisement between the competitors.⁴⁰

2.3.4 Advertisement Function

In a society that public and consumers increasingly obsessed with style or image, brand names, trademarks have become valuable marketing tools⁴¹ for the producers or traders to present their products or services in order to catch the public and consumers' eyes. "Trademark" is used to facilitate the product advertisement to be more effective by enabling the consumers to recognize the products and its brand name easily in a short period of time and be encouraged to purchase such products from seeing the trademark.⁴² This function of advertisement is so called as "Promotional of sales" of the products or services bearing trademark⁴³.

On the other hand, in some cases, people or regular consumers will purchase the products because of its brand and reputation. Even the owner of well-recognized trademark launches the new products which are different from its previous one, but under the same brand name and use the same trademark, the consumers will recognize the trademark and decide to purchase these new products because of the representing of trademark. Therefore, it is to say that a trademark itself can be an advertisement for the products and brand's reputation.

³⁹ *Supra* note 9.

⁴⁰ *Id.*

⁴¹ *Supra* note 23.

⁴² *Supra* note 9.

⁴³ *Id.*

2.3.5 Investment Vehicle Function

Due to a large number of similar products in the competitive market and the change of commercial practices, the consumers will recognize the products and decide to purchase it by looking at its brand or trademark, it is now to say that the trademark is functioned as a method of promoting of sell through product reputation. A trademark becomes more powerful and is defined as a valuable asset, and it is worth as an investment for business reputation. In business, a company may decide to invest in purchasing a trademark and brand name which is already well-known to the public from previous owners rather than putting money and effort in building up new brand name and invest in lots of product advertisement that does not guarantee whether the new brand and its trademark will be successfully recognized and acquainted to consumer's attention. Therefore, at present, a trademark itself can be seen as an object which can be sold, assigned, licensed and be the subject of security.⁴⁴

This implication reveals that today the trademark is a vital component of the whole structure of business operation as it represents the advertisement and function as the marketing tools of a strong feature in the commercial scene.⁴⁵ In other words, Trademark is now a value part of the goodwill of the business which they are associated.⁴⁶ It may be worth fortune and become a valuable asset for the business owner to invest a huge amount of money in their trademark and treat it as an investment vehicle for their business reputation.

⁴⁴ Nirisa Aeimamnuay. Damages for Trademark Infringement in Thailand. 14. Thesis for the Degree of Master of Law in Business Laws (English Program), Faculty of Law, Thammasat University, (2014).

⁴⁵ *Supra* note 4. Page 67.

⁴⁶ *Id.*

2.4 Trademark Protection

The intellectual property protection has several purposes, which can be described into 3 major reasons.⁴⁷ Firstly, given the progress and well-being of humanity rest on its capacity to create and invent new works, a protection is therefore a pride that creators receive from the attempt they had put in their creations. If there is no protection to the extent of the created work, no one will satisfy with the outcome of their effort.⁴⁸ Therefore, the protection of intellectual property is served as a reward for human's creativity. Secondly, once a person receives a protection for his first creation and prevent others to use or imitate the same work that was created, the others will put more efforts to seek for further creations of new works, which may establish the developed methods and more efficient works in order to gain their own protections. Therefore, an intellectual property protection can be a tool to encourage the human to create new creations and commitment of additional resources for further innovation.⁴⁹ Thirdly, as a result of the competition among the creators, the public will be benefit by utilizing such created works and enhancing the growth of economic, which leads to quality and enjoyment of life of the humanity.

Legal recognition of intellectual property is provided by a negative form of protection.⁵⁰ The legislation will usually describe the owner's right as "exclusive", thus by implication, is giving the owner the right to exclusively use the trademark⁵¹ and to restrain others from using his intellectual property without authority.⁵²

⁴⁷ World Intellectual Property Organization (WIPO). *"What is Intellectual Property?"* WIPO Publication No. 450(E) http://www.wipo.int/edocs/pubdocs/en/intproperty/450/wipo_pub_450.pdf (accessed on April 14, 2016)

⁴⁸ Au-arpa Sittipon. *Legal Problems on Parody in Trademark Law*. 8. Thesis for the Degree of Master of Law in Business Laws (English Program), Faculty of Law, Thammasat University, (2014).

⁴⁹ *Supra* note 47.

⁵⁰ *Supra* note 1. Page 2

⁵¹ World Intellectual Property Organization (WIPO). *"What is a trademark?"*. <http://www.wipo.int/trademarks/en/> (accessed on April 14, 2016)

⁵² *Id.*

Like, the protection of trademark, according to Article 16⁵³ of TRIPs Agreement which stipulates a definition of 'Rights Conferred' for trademarks as follows:

"The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion."

As defined above, a negative form of protection as 'exclusive rights' is also provided to the owner of registered trademark by ensuring that the owner will be the only one who can use such trademark to identify goods or services, or to authorize others to use them in return of payment.⁵⁴ In addition, as a result of exclusive rights granted, the owner can prevent all third parties, who were not authorized by the owner, to use its trademark in the course of trade. The protection shall cover those of the others' identical or similar marks that nearly resemble to the one that have been protected, which may be resulting in causing mislead or confusion to the public of the owner of trademark or origin of the products between those trademarks.

Nevertheless, the TRIPs Agreement has provided an exemption over the protection of registered trademark that shall not prevail an existing prior right of those of trademarks that have been used before the registration date. In other words, in the country that providing a protection of trademark bases on 'prior use' principle, the protection shall be granted to such prior used trademark, not the one that later have registered.⁵⁵

⁵³ TRIPs Agreement. Article 16.

⁵⁴ *Supra* note 4. Page 67.

⁵⁵ TRIPs Agreement. Article 16.

"The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use."

Giving an exclusive right as a legal protection to a creator or an owner of prior used or registered trademark may however cause an unavoidably effect to the economic since the monopoly power will be given to only those protected,⁵⁶ who may utilize such power in abusing way and cause damage to others. Therefore, the laws should provide the proper solutions to prevent any possibility of negative use from monopoly rights and stipulate the legal measures to deal with the occurrence of these potential problems.

Another crucial principle of providing trademark protection is 'principle of territoriality'⁵⁷, by meaning that the intellectual property rights do not extend beyond the territory of the sovereign that has granted the rights in the first place. Each country has its own territorial decision to provide a legal protection for a trademark within its jurisdiction. Even a trademark earns a protection in one country does not guarantee that they will get the same protection in another country. Therefore, in order for a trademark to be protected in each country, the owner must register the trademark and comply with rules and conditions of each particular country to obtain the protection.⁵⁸

Different goods and services that apply for the registration of trademarks are classified by the Nice Classification ("NCL"), an international classification established by the Nice Agreement (1957).⁵⁹ This classification is specified by the World Intellectual Property Organization, which has been recognized by numerous countries, to designate and limit the scope of trademark protection by determining which goods or service are covered, and to unify the classification for trademark registration around the world.

⁵⁶ ไชยยศ เหมะรัชตะ. ลักษณะของกฎหมายทรัพย์สินทางปัญญา. 13. พิมพ์ครั้งที่ 10 พ.ศ. 2559 (Chaiyod Hemaratchata, **Characteristics of Intellectual Property Law**. 13. (8th Edition, 2010)

⁵⁷ วิชัย อริยะนันทกะ. "ข้อสังเกตบางประการเกี่ยวกับกฎหมายเครื่องหมายการค้าและการป้องกันการแข่งขันที่ไม่เป็นธรรม" วารสารกฎหมายทรัพย์สินทางปัญญาและการค้าระหว่างประเทศ. 2545. (Vichai Ariyanuntaka. "Some observations on the legal protection of Trademarks and Unfair competition law." Intellectual Property and International Trade Law Journal. 2002.)

⁵⁸ *Supra* note 47.

⁵⁹ World Intellectual Property Organization (WIPO). "Nice Classification" <http://www.wipo.int/classifications/nice/en/> (accessed on July 19, 2016)

2.5 Trademark Acquisition

Even though, the fundamental and general principles of trademark laws in every country is likely similar, however there are two systems of acquisition for trademark protections which either adopted by each country differently.⁶⁰ The two systems of trademark acquisitions are (1) First-to-Use System; and (2) First-to-File System.⁶¹ Both systems have pros and cons depending on different factors within each country.⁶² The systems are designed for every country's trademark law which addresses the difficult choice between the two values of "justice" and "efficiency".⁶³ If "justice" prevails, the doctrine of use will usually be adopted. On the contrary, the "first-to-file" system or the "registration" principle is accepted since it is believed to be more efficient and operational.⁶⁴ However, irrespective of two systems, an acquisition for the right of trademark protection must be based on act in good faith, whether first use in good faith or first register in good faith.⁶⁵

2.5.1 First-to-Use System

"First-to-Use" system is providing protection based on the facts of use of trademark. The countries that adopt this first-to-use system will grant the protection to the owner of trademark that was used first, even though the trademark is registered or not. This system emphasizes on encouraging the person to genuinely use trademark. The person who uses the trademark first will be given superior rights and be protected under Trademark Law, over a person who files a trade mark

⁶⁰ บุญมา เตชะวณิช. "กฎหมายเครื่องหมายการค้า" ตำรากฎหมายทรัพย์สินทางปัญญา. 1. เนติบัณฑิตยสภาในพระบรมราชูปถัมภ์. พิมพ์ครั้งที่ 1. กรุงเทพมหานคร : บริษัทด้านสุทธการพิมพ์ จำกัด. 2555 (Boonma Techawanit. "Trademark Law." **Textbook of Intellectual Property Laws**. 1. The Thai Bar Under The Royal Patronage. 1st ed. Bangkok: Daansutthakarnpim Co., Ltd. Publishing. (2012).)

⁶¹ *Id.*

⁶² *Id.*

⁶³ Radchada Amarangkul. Legal Measures Against Trademark Registration in Bad Faith. 15. Thesis for the Degree of Master of Law in Business Laws (English Program), Faculty of Law, Thammasat University, (2012).

⁶⁴ *Id.*

⁶⁵ *supra* note 60. Page 116.

application at the later day.⁶⁶ This First-to-Use system is on the basis that if there is no use of trademark in commerce, the consumers will not be able to know and recognize such trademark and the trademark will not function as its duty to identify the owner of products and differentiate from the products belonging to other manufacturers.⁶⁷

The countries that apply First-to-Use system are mostly common law countries, i.e. the United States of America, the United Kingdom Canada, Australia, New Zealand,⁶⁸ including Hong Kong, Malaysia and Singapore.⁶⁹

The pros for this "First-to-Use" system seems to be a rational idea that the protection is granted to the one who actually first created intellectual works and reserved the rights in a mark as a symbol representing its used in trade.

Notwithstanding, even of the "First-to-Use" system seems to be fair for the prior user who is the genuine creator of intellectual property works, the drawbacks for this system is that there is no guarantee that a person claiming himself as the prior user would not be challenged by the other party claiming himself as the earlier or earliest one to use such trademark. In order to prove the prior use in case there is a dispute, the legitimate owner of trademark is required to establish the evidence that he is undoubtedly the first one to use the disputed trademark for

⁶⁶ Australia Government. *"IP for Business: IP Protection in the USA"*. <http://www.ipaustralia.gov.au/understanding-intellectual-property/ip-forbusiness/doing-business-overseas/ip-protection-in-the-usa/> (accessed on April 14, 2016)

⁶⁷ เอกรินทร์ วิริโย. "ปัญหาการเพิกถอนการจดทะเบียนเครื่องหมายการค้าด้วยเหตุที่เจ้าของเครื่องหมายการค้าไม่ใช้เครื่องหมายการค้า". *วารสารนิติศาสตร์*. 737. ปีที่ 44 ฉบับที่ 3. กรุงเทพมหานคร : โรงพิมพ์มหาวิทยาลัยธรรมศาสตร์. กันยายน 2558 (Aggarin Viriyo. *"Problems on Trademark Cancellation on the Ground that the Trademark Has Not Been Used"* **Thammasat Law Journal**. 737. Volume 44 No. 3. Bangkok : Thammasat University Publishing. September (2015).)

⁶⁸ International Trademark Association (INTA). *"Global Protection and Enforcement of Trademarks Presentation"*. <http://www.inta.org/TrademarkBasics/Documents/INTAGlobalProtectionEnforcementPresentation.ppt> (accessed on December 10, 2015)

⁶⁹ *Supra* note 60. Page 1.

commercial purpose either trade in goods or trade in services, as the case may be. This chronological requirement causes the difficulty in proving as to when the mark was actually used in commerce if the trademark in dispute is not widely recognized. More importantly, without the documentary evidences in place, it is not easy to trace back the history to the first or earliest date of use, and even if this can be done, it is still difficult to establish a clear cut between the time, frequency, and intensity of use of the mark in question.⁷⁰

Due to the above difficulties, some countries prefer to apply both of the "First-to-Use" and "First-to-File" system in parallel to encourage the fair trial, i.e. Belgium and the United Kingdom.⁷¹

2.5.2 First-to-File System

First-to-File system is providing protection based on first come first serve basis, which require the act of filing a trademark application for registration. The countries that adopt this first-to-file system will grant the protection for applicant who first files a trademark application with Trademark Office in such particular country. The first registrant is presumed to have prior rights over the party who comes later.

According to the principle of First-to-File system, it encourages the owner of trademark to earlier files the application in order to have priority rights and registers its trademark registration in order to have a legal certainty.⁷² The owner will be persuaded by the legal protection over its intellectual property rights. The owner will be perceived as more secure by receiving a tangible protection of its trade name and logo as registered mark, as well as to be ensured that they can prevent anyone else

⁷⁰ *Supra* note 63. Page 17. (citing Alexander Tsoutsanis, Trade Mark Registrations in Bad Faith 34-35 Oxford University Press, 2010)

⁷¹ *Id.*

⁷² Japan Patent Office. Outline of Japanese Trademark System.

http://www.jpo.go.jp/torikumi_e/hiroba_e/pdf/136th_inta/pamphlet.pdf (accessed on December 10, 2015)

from infringing their legitimate rights. It is to say that "registration" provides a legal certainty and reinforces the position of the right holder.⁷³ In addition, under the "registration" model, a prior mark is recorded in the Registry database, which allows the others to conduct a prior search before applying the trademark application in order to avoid the risk in registering or creating a mark that may conflict with others.

However, the trademark protection under this system will be granted to the person who firstly files the application, frequently regardless of use of the mark in commerce. Therefore, this system may affect the rights of later applicant who may use the trademark first before filing. In addition, regardless of the actual use or examining the genuineness of ownership, this system may be jeopardized as it can be used as a tool for unethical applicants to defeat the rights of genuine trademark owner by filing a bad faith registration which is a registration without actual use of trademark in commerce, for the purpose of obstructing the genuine trademark owner and the others from registering the identical or similar marks.

The countries that apply First-to-File system are mostly civil law countries i.e. France, Germany, China, Japan,⁷⁴ etc. including Thailand⁷⁵.

2.6 Use of Trademark

As a symbol to distinguish the products between different owners, a trademark must be genuinely used in the course of trade in order to perform its functions. It is to say that without use, the mark cannot be known among the public and consumers. The mark must be used in commerce by representing its origin and owner. The term of "use in commerce" means that the bona fide use of a mark in the ordinary course of trade, not just made merely to reserve a right in a mark.⁷⁶ If the mark is used for goods, it must be attached to the goods as placed in any manner

⁷³ World Intellectual Property Organization (WIPO). *"What is a trademark?"*. <http://www.wipo.int/trademarks/en/> (accessed on April 14, 2016)

⁷⁴ *Supra* note 68.

⁷⁵ *Supra* note 67.

⁷⁶ US Trademark Law. § 45 (15 U.S.C. § 1127).

either on the tags or label.⁷⁷ If the mark is used for services, it must be used or displayed in the sale or advertising.⁷⁸

In some countries, there are requirements for the trademark owner to use its trademark in commerce in order to obtain or retain its protection. However, in some countries including Thailand, there is no requirement of genuine use to force the trademark owner who receives the protection through registration to actually use the trademark in trade. Therefore, without the use in commerce, the trademark cannot perform its functions whether to identify of origin of the products, differentiate the owners of products, including other functions as indicating the distinctive name in trade that the presenting the products or services in market, guarantee quality, purpose of advertisement,⁷⁹ or as an object for investment. Therefore, it can be defined that "Use" of trademark is the heart and basis of trademark.⁸⁰

In addition, a person who receives the trademark protection will be granted an exclusive right to be the one who can solely use the trademark and prevent others to use the same or similar trademark as protected. Therefore, if the one who has the exclusive right to use, but never genuinely use it in commerce, the protection obtained will not be benefit to the trademark owner itself as well as the others i.e. owner of later mark, consumers and public interest.

The use of trademark can be performed by other authorized party, for examples, a product distributor in case of representing as agent for distribution of product under such mark within other jurisdiction or, a licensee in case of licensing agreement, etc.

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Supra* note 67. Page 738.

⁸⁰ *Id.*

2.7 Requirement for Genuine Use of Trademark

Even though it is not compulsory for trademark laws, in some particular countries, to provide a requirement for genuine use of trademark as a condition to apply or register a trademark within jurisdiction. However, the ultimate reason for trademark protection is for a trademark to be functioned as a tool to distinguish the goods on which the trademark is used from the other competitors in the market.⁸¹ It will make no economic sense to protect trademarks by registration without imposing the obligation for the owner to use them.⁸² Unused trademarks are considered as the barrier to the registration of new trademarks. Therefore, obligation of use is needed to be provided by the trademark law.⁸³

The concept of requirement for genuine use of trademark is provided in responding to the significant functions of trademark, which are to encourage owner to genuinely use the mark in commerce, allowing the consumers to indicate the origin of the goods or services under trademark, differentiate the goods or services under a trademark from other different sources, guarantee the product's quality, as well as in economic perspective of being a method for advertisement and investment vehicle for enhancing the economic growth.

"Genuine use" can be defined as "substantial and genuine use judged by ordinary commercial standard."⁸⁴ The ordinary used as commercial standard can be a use of trademark to represent its origin and owner of the products or services to the public and consumers in commercially way. The use that can establish trademark rights must be a public use, not just a token use.

⁸¹ *Supra* note 4. Page 77.

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *Supra* note 1. Page 107. (citing *imperial Group Ltd. v. Philip Morris & Co., Ltd.*)

The purpose for requirements of genuine use are also benefit to keep the Trademark Register records uncluttered and limit the use of trademark to the owners who actually use as registered.

There are two policies exist for each jurisdiction to adopt the concept of requirement of genuine use of trademark e.g. optional or mandatory.⁸⁵ In the optional system, there is no requirement concerning the use of trademark to obtain or to maintain its registration.⁸⁶ In the mandatory system, the country adopts this system imposes the necessity of using the trademark whether before or after the registration in order to keep its validity.⁸⁷

Consequently, for the countries that adopt mandatory system, the requirement of genuine use of trademark can be divided into 4 steps of registration as follows:

1) Requirement for genuine use or intention to use at time of filing trademark application

The requirement for genuine use or intention to use at the time of filing trademark application is required by the Trademark Office in form of statement of declaration or filling information in the application. The countries that has requirement for this kind of use are the following samples:

United States of America:

Under the US Trademark Law, it is stipulated in Section 1 that:

*"..(2) The **application shall include** specification of the applicant's domicile and citizenship, **the date of the applicant's first use of the***

⁸⁵ Elisabeth Kasznar Fekete, "Use of Unregistered and Registered Trademarks: The Brazilian System" **The Trademark Reporter**. 1267. The Law Journal of the International Trademark Association. Vol. 104 No. 6. November-December 2014.

⁸⁶ *Id.*

⁸⁷ *Id.*

*mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark...*⁸⁸

In case the applicant has used trademark before filing for registration, the US Trademark requires the applicant to include the status of using trademark i.e. 1) date of the applicant's first use of the mark, and 2) date of the applicant's first use of mark in commerce in United State of America with the goods as used, in the application form.

However, if the applicant has not used the mark at the time of filing, the applicant is required to identify that the applicant has intention to use trademark, which the US trademark office will later require the statement of use from applicant once the application is examined and accepted for registration but before issuing of certificate.

Singapore:

Under the Singapore Trademark Act, the requirement for genuine use is stipulated in Section 5⁸⁹ that:

"(2) **The application shall**

(e) **state** —

- (i) *that the **trade mark is being used in the course of trade, by the applicant or with his consent, in relation to those goods or services; or***
- (ii) *that the applicant **has a bona fide intention that the trade mark should be so used.***"

According to Singapore's regulation of filing trademark application, it requires the applicant to state that whether (i) the trademark is being

⁸⁸ § 1 (15 U.S.C. § 1051).

⁸⁹ Singapore Trademark Act 2007. Section 5.

used in course of trademark or (ii) in case of non-using at the time of filing, the applicant must state that the applicant has intention to use trademark in good faith.

2) Requirement for genuine use before obtaining Certificate of trademark registration

The requirement for genuine use before proceeding for registering trademark and obtaining Certificate of Trademark Registration is required by the Trademark Office in form of statement of declaration or declaration of use. The countries that has requirement for this kind of use are, for example, United States of America and Canada. The provision is stated follows:

United States of America:

Under the US Trademark Law, it is stipulated in Section 1⁹⁰:

"(d) (1) Within six months after the date on which the notice of allowance...the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce..., a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration..."

The US, as well as Canada, trademark registration proceeding, after the application has been examined and accepted for registration, the Trademark Office

⁹⁰ § 1 (15 U.S.C. § 1051).

will issue a notice of acceptance to the applicant and requires the applicant to submit, if it is indicated in the application that the mark is not used but the applicant has intention to use, another statement before issuing the Certificate of Trademark Registration. The said statement is the statement confirming the use of trademark, which requires the applicant to provide (1) picture of mark on the products as used in commerce; (2) the date of applicant's first use. If the applicant fails to do so, the Trademark Office will not issue the Certificate of Registration for the applicant.

3) Requirement for genuine use after obtaining Certificate in order to maintain the registration

The requirement for genuine use after obtaining the Certificate of Trademark Registration in order to maintain the registration is required by the Trademark Office in form of statement of declaration or declaration of use. The country that has requirement for this kind of use is as follows:

Philippines:

Rule 204 for Declaration of Actual Use stated that:

"The Office will not require any proof of use in commerce in the processing of trademark applications. However, without need of any notice from the Office, all applicants or registrants shall file a declaration of actual use of the mark with evidence to that effect within three years, without possibility of extension, from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the register by the Director motu proprio."⁹¹

The Philippines' trademark registration process does not require for statement of use of trademark before issuing the Certificate. Therefore, in case the

⁹¹ Philippines Trademark Law. Rule 204.

mark is registrable, the Trademark Office will grant a Certificate and protection for the applicant. However, after received the Certificate as a trademark registration protection, the applicant must provide, within 3 years as from the filing date of the application, a Declaration of Actual Use which is a statement declaring that the mark has been used and effective with attached of evidences of showing use to the Registry. If the applicant fails to do so, the application shall be refused or the registration of trademark will be withdrawn and the mark shall be removed from the Register.

In addition, according to Rule 801, the Trademark Office will once again require Second Declaration of Actual Use from the registrant as stated that:

*"A certificate of registration shall remain in force for ten years; Provided, That, without need of any notice from the Office, **the registrant shall file a declaration of actual use and evidence to that effect, or shall show valid reasons based on the existence of obstacles to such use, as prescribed by these Regulations, within one year from the fifth anniversary of the date of the registration of the mark. Otherwise, the Office shall remove the mark from the Register. Within one month from receipt of the declaration of actual use or reason for non-use, the Examiner shall notify the registrant of the action taken thereon such as acceptance or refusal.**"⁹²*

The Registry will once again require the Declaration of Actual Use at the time of 5 year anniversary, which is within the period of 1 year after the trademark application is protected for 5 years. If the Registrant fails to file a declaration of actual use within the prescribed period without the valid reason for the obstacles to such non-use, the Philippines Trademark Office shall remove the mark from the Registry. It is to say that according to the Philippines Trademark Law, the actual and genuine use of trademark as registered is required for the trademark owner to maintain the registration.

⁹² Philippines Trademark Law. Rule 801.

4) Requirement for genuine use at time of renewal

The requirement for genuine use at time of renewal for continuing registration protection is required by the Trademark Office. The registrant must provide the evidences showing use in order to renew its trademark protection. Without the evidence showing that the trademark has been used in the course of trade during the registration period, the trademark cannot be renewed.

The countries that has requirement for this kind of use are samples: the Philippines⁹³, Indonesia⁹⁴, Mexico⁹⁵ and Argentina⁹⁶, etc.

⁹³ Philippines Intellectual Property Code Republic Act No. 8293 (Extracts) as amended by Act No. 9502 of 2008

Section - 145. Duration

A certificate of registration shall remain in force for ten (10) years: Provided, That the registrant shall file a declaration of actual use and evidence to that effect, or shall show valid reasons based on the existence of obstacles to such use, as prescribed by the Regulations, within one (1) year from the fifth anniversary of the date of the registration of the mark. Otherwise, the mark shall be removed from the Register by the Office. (Sec. 12, R.A. No. 166a)

⁹⁴ Indonesia Trademark Law as amended by Law No. 15 on August 1, 2001

Article 36 - *A request for the extension of the protection period shall be approved if:*

a. The relevant mark is still used on the goods or services as stated in the Mark Certificate; and

b. The goods or services as referred to in (a) are still produced and traded.

⁹⁵ MEXICO INDUSTRIAL PROPERTY LAW (AS AMENDED UP TO DECEMBER 26, 1997).

Article 134 - *Renewal of the registration of a mark shall proceed only if the person concerned submits proof of payment of the appropriate fees and makes a sworn statement in writing attesting his use of the mark on at least one of the goods or services to which it is applied, such use not having been interrupted, without just cause, for a period equal to or longer than that provided for in Article 130 of this Law.*

Article 130 - *If for three consecutive years a mark is not used for the products or services for which it was registered, there shall be grounds for the lapse of the registration thereof, except where the owner or registered licensee has used it during the three consecutive years immediately prior to the filing of the request for the administrative declaration of lapse, or where a situation has arisen that is beyond the control of the owner of the mark and constitutes an obstacle to the use thereof, such as the restriction of imports or other government requirements applicable to the goods or services to which the mark is applied.*

The registration of a trademark can be renewable indefinitely⁹⁷, which the protection period is normally provided, for each time, for 10 years, or between 7-15 years depending on each country's domestic law. These periods are long enough for a business to start and operate its use of trademark. The trademark owners should already put a registered mark in genuine use in course of trade, and certainly obtain the proofs of its use in hands which easily to be provided with the Trademark Office. No ability to provide the evidences of use when the time of renewal could help ensuring that the trademark owner may not have used such trademark during the protected period. Providing a renewal rights to extend the protection for another 10 years without requiring any proof of use may resulting that the given protection is not worth. Consequently, it is very important to require a proof of genuine use of trademark at the time of renewal.

2.8 Non-Use Cancellation

Cancellation is a legal proceeding that allows and provides the opportunity for a party who believes that they are affected by the prior registered trademark to file a petition to remove an existing registration⁹⁸ of such prior mark from the trademark registry records. In other words, the cancellation for trademark registration does not mean only erasing of the trademark in registry records itself, but also means the

⁹⁶ Argentina Law on Trademarks (Law No. 22,362 – Official Gazette January 2, 1981)

Article 20 – Applications for renewal of registration shall be made in accordance with the provisions of Article 10 and shall be filed together with an affidavit, which shall state whether the mark was used during the period established in Article 5 in at least one of the relevant classes, or whether it was used as a designation, indicating, as appropriate, the good, service or activity in question. When a decision has been issued to approve the registration or renewal, the relevant certificate shall be delivered to the applicant.

⁹⁷ TRIPs Agreement.

Article 18 - Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.

⁹⁸ International Trademark Association (INTA). “Cancellation of a Registered Trademark”. March 2016.

<http://www.inta.org/TrademarkBasics/FactSheets/Pages/CancellationofaRegisteredTrademarkFactSheet.aspx> (accessed on December 5, 2015)

erasing all the rights of the trademark owner that come along with it in which obtained from such registration.⁹⁹

Non-use cancellation is a legal proceeding for cancelling against the registered trademark based on the claim that such registered trademark has no commercial use by the registrant. It is on the basis that if a trademark is filed for protection on registration, the trademark should be protected for the use of it in order to prevent others to use the same trademark, with the same goods, in the same course of trade. The trademark needs to respond to the function of trademark, which is to distinguish the goods or services under this trademark from the other goods or services under other's trademarks. However, if the mark is protected, but in fact, it is not used in commerce, the protection cannot work.

2.8.1 Purpose of Non-Use Cancellation

The purpose of cancellation process in Trademark Law is to revoke the registration of trademark that should not be registered in order to eliminate the barrier of other trademark in which should be accepted for registration instead.

For the Non-use cancellation, it is because the trademark in which is registered shall be genuinely used in commerce in order to perform its functions as to indicate the origin of the products and differentiate it from the others. However, if the trademark which has been registered is not used in commerce, the trademark cannot perform its functions and not worth having the registration protection. In other words, a failure to use a registered trademark for a relatively long period of time should be considered as contrary to the public interest by meaning that it prevents the third parties, particularly the competitors, using the registered non-used trademark in the same market. If the other has used such identical or similar trademark in commerce

⁹⁹ Robin N. Brenner. *"Use it or Lose it! Burdens of Proof in Non-Use Cancellation Actions: A Call for Balance in the Trademark Laws of Thailand, Indonesia and India"*, **Cardozo Arts & Entertainment Law Journal**. 491.(Vol. 27 Issued 2, 2009)

and benefit to the commercial and economic, more than the registrant who registered an unused trademark, such person should have the protection instead.

Therefore, the non-use cancellation scheme is enacted to remedy the defect of registration system that grants the protection and exclusive right to use to the first come first serve basis which effects to the rights of later trademark owner. Moreover, this scheme may help to maintain a clean and efficient trademark registry in order to facilitate a true reflection of the commercial reality¹⁰⁰ as well as to keep the Trademark Register records uncluttered. It is to say that non-use cancellation scheme is also benefit to urge the registrant to commercially use the trademarks and to support the public interest by relieving the imbalance between the shortage of trademark resources and the strong demand for trademarks.¹⁰¹

2.8.2 Non-Use Cancellation Proceeding

The person who is entitled to file a request for non-use cancellation against the registered trademark must be an aggrieved party whose interest is affected from such existing registration. In this case, the third party whose interest is effected may be the owner of later trademark which identical with or similar to such prior registration, so that they cannot register their new trademark because of the obstacle of prior registration. If the prior trademark is not used in commerce, the later trademark owner or the Registrar may constitutes the petition of non-use cancellation against such registered trademark in question.

According to Article 19 of TRIPs Agreement, which is the international agreement stipulating the minimum standard to the member countries,

¹⁰⁰International Trademark Association (INTA). *"Standing Requirements in Connection With Non-Use Cancellation Actions"* November 13, 2013 <http://www.inta.org/Advocacy/Pages/StandingRequirementsNonUseCancellationActions.aspx> (accessed on December 5, 2015)

¹⁰¹Hui Gao. CCPIT Patent & Trademark Law Office. *"Protection of Registered Trademarks in Non-Use Cancellation Cases in China"*. January 23, 2015 <http://www.lexology.com/library/detail.aspx?g=2c55e192-5ffe-47e3-823b-c4a3c285aca5> (accessed on July 15, 2016)

requires that a registration may be cancelled only after an uninterrupted period of at least 3 years of non-use¹⁰². Therefore, from the word "at least 3 years" means that the member countries may enact their internal trademark law by stipulating that the non-use cancellation is available after 3 years as from the date of registration or more. In this matter, most countries apply the timeframe of 3 years periods for non-use cancellation. In some countries i.e. India¹⁰³, Indonesia¹⁰⁴, they may apply at least 5 years period as from the date of registration to allow the non-use cancellation scheme.

In most countries, the non-use cancellation request must be filed as a petition with the Trademark Office in each country. However, in some countries, a non-use cancellation is considered as a litigation process which must be filed as a lawsuit with the Court within particular jurisdiction i.e. Indonesia¹⁰⁵ and Malaysia¹⁰⁶.

2.8.3 Burden of Proof for Non-Using of Registered Trademark

The burden of proof and requirement for standard of proof is upon each internal regulations of Trademark Law and practice in each countries, which in some countries, the burden of proof lies on the petitioners, but in some countries, the trademark owner will bear such burden. According to some experts' opinions, a tendency of imposing a burden of proof for such non-using trademark should be bound by the registered owner, rather than the petitioner.¹⁰⁷ It is very difficult for any third party who has no access to the facts and information of the use of trademark to prove its non-use. It was opined that in case of removing a deadwood from the registry records as this method of non-use cancellation, such a reversal of the burden of proof seems to be justified.¹⁰⁸

¹⁰² TRIPS Agreement. Article 19.

¹⁰³ Indian Trademark Law. Article 46.

¹⁰⁴ Indonesian Trademark Law. Article 69

¹⁰⁵ *Id.*

¹⁰⁶ Malaysian Trademark Law. Article 46

¹⁰⁷ *Supra* note 4. Page 78.

¹⁰⁸ *Id.*

The burden of proof and requirement for standard of proof are the crucial factors to determine the effective of the non-use cancellation proceeding in each country. In the countries that the burden and standard of proof are not set too high, the non-use cancellation can be efficiently succeed. However, some countries may impose conditions of proving non-use strictly than others¹⁰⁹, which could set as a barrier for a petitioner to overcome this proceeding.

For examples, in Indonesia, a petitioner, who files the non-use cancellation application, bears the burden to prove not only the actuality of non-using of trademark in commerce but also the last date of using of such trademark in question.¹¹⁰ This high standard of proof is strictly interpreted from the Indonesian Trademark Law, Article 61(2)(a)¹¹¹, regarding the cancellation of registered trademark based on non-use claim, which stated that:

"Article 61(2) - The nullification of a mark registration on the initiative of the Directorate General may be made if:

(a.) the mark which has not been used for 3 (three) consecutive years in trade of goods and/or services from the date of registration or of the last use, except there is an excuse which is acceptable to the Directorate General;"

Nevertheless, according to the Article 61(2)(a), the law was written by using the word "*or*" of the last use, which should be an option for the petitioner to prove the date of last use when the date of registration cannot be proved.¹¹² Therefore, this interpretation for standard of proof that required by the Court and Indonesia Trademark Law is extremely high for the petitioner to prove and even put more burden to the petitioner to locate such undiscovered information.

¹⁰⁹ *Supra* note 67. Page 735.

¹¹⁰ *Supra* note 67. Page 750. (Citing *Intel Corp. v. Pt. Panggung Electric Corp.* No. 017 PK/Pdt.Sus/[2008]).

¹¹¹ Indonesian Trademark Law. Article 61(2)

¹¹² *Supra* note 67. Page 751.

Same as in India, the petitioner is not only required to prove the non-using of registered trademark during the registration time but also needed to prove that there was no bona fide intention of the registrant himself to use trademark in relation to the goods or services for the time being registered.¹¹³ According to Section 47 (1)¹¹⁴ of India Trademark Act 1999, the law has stipulated the requirement for proving a non-use of trademark as follows:

"Section 47 - (1) A registered trademark may be taken off the registration in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the Appellate Board by any person aggrieved on the ground either-

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trademark is actually entered in the register or longer had elapsed during which the trademark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being."

Pursuant to the above provision, the law has clearly stipulated the burden of proof for the petitioner to prove both of actuality of non-using of trademark and also the intention in mind of the registrant that there must have been no bona fide to use it with the trade in relation to those goods or services as registered. The intention in mind of the registrant is hardly to identify. Moreover, the Indian Court has defined the definition of 'use' of trademark by extending to merely use for promotional and advertisement of the goods or service or stipulate the price are sufficient to be considered as the use of trademark, regardless of actuality use for

¹¹³ *Id.* (citing *Hardie Trading Ltd. v. Addisons Paint & Chemical Ltd.* [2003] 4 L.R.I. 77).

¹¹⁴ India Trademark Act 1999. Section 47.

sale.¹¹⁵ It is quite easy for the trademark owner to rebut the dispute and escape himself from the revocation of his trademark that alleged by non-use cancellation proceeding.

2.8.4 Effects on Problems of Non-Use Cancellation

Even though, non-use cancellation scheme is available and stipulated by Trademark Law, but in some jurisdictions i.e. Indonesia, India and including Thailand, burden of proof for non-using of registered trademark is laid on the petitioner who is not the trademark owner and the burdensome to be proved is very high and difficult to overcome. Where the cancellation for a non-use trademark is so difficult, many effects may be caused by the problems of such proceeding.

Firstly, a mark shall be used in commerce to function as the tool to indicate the origin of the products, differentiate products of the different manufacturers, promote and advertise the products for consumer's recognition, etc. If a registered mark has not been used in trade, the mark cannot perform its duties and it is useless to grant such protection through registration. .

Secondly, if there are many registered trademarks on the Registry records, even though, the protections as so granted is not worth the trade and public due to the non-using of trademark, whilst the Registry still maintain these non-used trademarks on the systems, the Registry records will be cluttered.

Thirdly, the registered trademark owner may not be afraid of its registration becoming revoked¹¹⁶, which may indirectly stimulate the trademark owner not to use such trademark in commerce, and may continue preventing others to use such trademark as well.¹¹⁷

¹¹⁵ *Supra* note 112.

¹¹⁶ *Supra* note 67. Page 735-736.

¹¹⁷ *Id.*

Fourthly, the prior registration will block the others to apply or use the trademark that is identical with or similar to those existing trademarks. This because when the cancellation for registration of a trademark is so difficult, the chance of success for the later applicant to register the new trademark which happens to be similar to an existing mark will be extremely low. This difficulty of non-use cancellation will be an obstacle for later applicant who may actually use the trademark in trade, which benefit to the economy, to register and have the protection of their trademark.

Fifthly, according to these difficulties and problems, the second comer will be afraid that their intellectual property may not be protected upon registration as it is identical or similar to the existing trademark having been earlier registered.¹¹⁸ Then, the second comer who may use the trademark in commerce would decide not to enter into the market because of such obstacle. This will have a large impact on the market competition and economic growth.

Lastly, if the registration is hard to be challenged and difficult to be cancelled, it will cause the monopoly of right that the first registrant solely owned the trademark registration. Such monopoly right to the first registrant will also result in unfair competition to the later trademark owner that cannot use or register its trademark.

¹¹⁸ *Supra* note 67. Page 756.

CHAPTER 3
NON-USE CANCELLATION AGAINST TRADEMARK
REGISTRATION UNDER INTERNATIONAL RULES
AND FOREIGN LAWS

By its very nature, intellectual property requires protection at the international level.¹¹⁹ There have been a number of international agreements in existence since the nineteenth century to protect intellectual property owners globally. Many international agreements are established for the purpose of harmonization between nations and regulating the proper criteria for the protection that can be mutually applied among the member states. However, Intellectual property owners must still enforce their rights through the local court of each jurisdiction and thus rely on the various procedure protection each local court may apply,¹²⁰ which may result in the double standards and more or less protection comparing to what the owner of intellectual property would expect at the home country.

Trademarks, like all other intellectual property rights, are national rights¹²¹, which means that a trademark, once it is registered, it only offers protection against the unauthorized use by third parties within the jurisdiction of the country of registration.¹²² Therefore, it means that there is no guarantee that an owner of trademark who can protect its intellectual property in one country can do the same in another country. It will depend on the standard and practice in each country, subject to jurisdictions between common law and civil law, trademark acquisition systems between first-to-use and first-to-file, as well as the practicing of burden of proof according to domestic law and regulations.

¹¹⁹ *Supra* note 1. Page 3.

¹²⁰ *Id.*

¹²¹ *Id.* Page 150

¹²² *Id.*

The determination of use and non-use of trademark are also required differently in each country. Some have requirement for genuine use of trademark to force the trademark owner actually use its trademark in commerce. Some do not have such requirement, however, the intension to use trademark are still required for registration. Same as non-use cancellation proceeding that has different standard of examinations and requirement for the burden of proving use or non-use of trademark, which may lie on the registrant of trademark, so called a trademark owner or the petitioner who commences the cancellation. In some countries, i.e. the United Kingdom, Japan and the People's Republic of China, the burden lies on the registrant who has fully access to the facts and information whether the mark is used or not. Therefore, it is not difficult for the trademark owner to provide the proof of its use. In addition, for example in the United States of America, even the burden of proof first lies on the petitioner, but once the prima facie evidence for abandonment of trademark is proved, the burden has shifted to the trademark owner to rebut himself, which demonstrates that the standard of proof for non-using are not set too high to overcome. For these reasons, in those countries, the non-use cancellation process is mostly efficiently successful. On the other hands, in some countries i.e. India, Indonesia, including Thailand, non-use cancellation is rarely succeed because the burden of proof lies on the side of petitioner who has no access to the facts and information and the high standard of proof are required by the Board of Trademark or the Court.

Therefore, this Chapter will be dealing with the international conventions and agreements as to the regulation concerning non-use cancellation, which will be focusing on Paris Convention and the TRIPs Agreement. In addition, the Author has selected four foreign countries i.e. the United States of America, the United Kingdom, Japan and the People's Republic of China, which are the countries that non-use cancellation are efficiently implemented, to study the laws how they are supportive to non-use cancellation, in order to compare and take the useful advantage to adapt with Thai law.

3.1 International Convention / Agreement

There are many treaties and international agreements that have been enforced and regulated on trademark matters i.e. Paris Convention, the TRIPs Agreement, Madrid Agreement and Madrid Protocol, Vienna Agreement, Nice Agreement on International Classification, etc., which set up for the purpose of harmonization between nations and regulating the proper criteria for the protection that can be mutually used and protected between countries.

As from the above mentioned treaties and international agreements, Thailand is a member to Paris Convention and TRIPs Agreement, and is now also becoming as a member to Madrid Protocol. For this research, the Author would like to emphasize on the rules and regulations regarding the non-use cancellation that set forth against the trademark registration on Paris Convention and TRIPs Agreement as the main treaty and international agreement.

3.1.1 Paris Convention for the Protection of Industrial Property (Paris Convention)

3.1.1.1 Overview and Rationale Background

The Paris Convention for the Protection of Industrial Property ("Paris Convention") is the main and oldest international treaty regarding the protection of rights concerning intellectual property, adopted since 1883. The substantive provisions of the Convention fall into 3 main categories: 1) National Treatment; 2) Right of Priority; 3) Common rules.¹²³ The most important rule that concerned in this Convention is National Treatment, which each Contracting State

¹²³ World Intellectual Property Organization (WIPO). *"Summary of the Paris Convention for the Protection of Industrial Property (1883)"*. http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (accessed on April 14, 2016)

must grant the same protection to nationals of other member countries as same as the protection the granted to its own nationals.¹²⁴

Thailand ratified the Paris Convention on 10 January 2008 and thereafter become bound on 2 August 2008 among 176 contracting states upon the submission of legal instrument of accession by the Thai Ministry of Foreign Affairs to World Intellectual Property Organization (“WIPO”).¹²⁵

Given the conditions for filing and registration of trademark is not regulated by Paris Convention the contracting states therefore determine and enforce their own procedures under the domestic law.¹²⁶ This brings about the uncertain result of trademark registration filing in one contracting state and in the other contract states as it does not always mean that once the trademark is lawfully registered under one jurisdiction, such trademark would be acceptable under the other jurisdiction, even if it is the same mark. In other words, each country has its own discretion to independently accept or deny the application for trademark registration within its jurisdiction, without considering on the affecting of validity or invalidity of registration in other countries. Therefore, the result of trademark application in one country no matter it is favorable or unfavorable to the applicant, would not always be expected to apply to or automatically correspond with a trademark application or registration in other countries.

The Paris Convention states some provision regarding the use of trademark that is compulsory for the trademark owner in contracting States to use its registered mark. In case the marks is not used, if pass a reasonable period of time, a registration may be cancelled due to the non-using, unless the owner can prove his justification of such inaction.

¹²⁴ *Id.*

¹²⁵ World Intellectual Property Organization (WIPO). “*Administered Treaties*”. http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=2 (accessed on July 25, 2016)

¹²⁶ *Supra* note 123.

3.1.1.2 Regulations concerning Non-Use Cancellation

Under the Paris Convention, the requirement of use and provision regarding non-use cancellation are specified in the Article 5 sub-section C., which stipulated as follows:

"Article 5:

C.—

(1) If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction."¹²⁷

According to the Paris Convention as stipulated above, it demonstrates that the Convention has enacted the rules and regulations for cancellation against trademark registration based on non-use. The conditions are 1) The registration may be cancelled only after a reasonable period; and 2) Only if the person concerned does not justify his inaction.¹²⁸ However, the Convention does not describe or regulate the conditions concerning the exact period of time for non-use cancellation request can be filed as well as nor the defense, pleading, or burden of proof for the trademark owner to justify that why the trademark has not been using. Therefore, each contracting state \ must adapt its domestic laws to pursue the rule of non-use cancellation scheme as stipulated in this international treaty.

3.1.2 Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)

3.1.2.1 Overview and Rationale Background

The Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPs") is an international agreement administered by the World

¹²⁷ Paris Convention. Article 5 sub-section C.

¹²⁸ *Supra* note 67. Page 742.

Trade Organization ("WTO") that enforced to all contracting states and came into effect on January 1, 1995.¹²⁹ The substantive feature of this Agreement is the TRIPS set out the minimum standards of protection to be enforced and requiring each member countries to enact and regulate the domestic provisions in order to provide at least protection as stipulated in TRIPs agreement. As its requirement for only minimum standards, the contracting states may provide any higher provision standard than what TRIPs requested, but shall not contradict to the TRIPs statement.¹³⁰

Given that Thailand is a member of the WTO, Thailand is also bound by TRIPs Agreement in addition to the Paris Convention. Since TRIPs Agreement is incorporated with the substantive provisions of the Paris Convention, Thailand as one of the contracting states to TRIPs Agreement is repeated with the obligations already prevailed under the Paris Convention in which it has also ratified.¹³¹

3.1.2.2 Regulations concerning Non-Use Cancellation

Under the TRIPs Agreement, the requirement of use and provision regarding non-use cancellation are specified in the Article 5 sub-section C., which stipulated as follows:

***"Article 19:
Requirement of Use***

¹²⁹ World Trade Organization. "Overview: The TRIPs Agreement". https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (accessed on July 25, 2016).

¹³⁰ Article 1.1

"Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice."

¹³¹ *Supra* note 129.

*1. If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reason based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognized as valid reason for non-use."*¹³²

The Article 19 of TRIPS Agreement shows that TRIPS has supported the non-use cancellation scheme and the important of use of trademark registration that if the registered trademark is not used, the registration may be cancelled. According to the provision, TRIPS has stipulated the minimum standard for the requirement of non-use cancellation as two aspects:

1) The timeframe of filing non-use cancellation:

The registration may be cancelled only if after uninterrupted period of at least three years of non-use. This provision has stipulated the minimum period that a trademark registration which is vulnerable to be cancelled must be registered at least 3 years as from the date of registration, and during such period, the trademark must not be used at all time. If during of 3 years period, there is any use of trademark even a short period or small amount, it is still considered as use of trademark that interrupted between the period, therefore, the mark shall not be cancelled.

2) Rights of trademark owner to show the reason of non-use:

TRIPS Agreement has clearly stipulated that the trademark owner of a registered trademark in question has a right to show a reason why his trademark is not used. If there is an obstacle of such non-use arising independently

¹³² TRIPS Agreement. Article 19.1.

from the intention of the owner, such as import restrictions on or other government requirements i.e. permission to sale the goods or permission to operate the services in which it registered, these reasons will be considered as valid reasons for non-using, and the trademark shall not be cancelled due to these circumstances. However, if the trademark owner cannot prove any reliable reason of non-use or such non-using occurs from the intention of the owner himself, the trademark registration still be vulnerable to the risk of cancellation.

The provisions concerning requirement of use and non-use cancellation stated in both Paris Convention and TRIPS Agreement demonstrate that the international treaties and agreements recognize the importance that the registered trademarks must be used in commerce with the products and services in which it registered, otherwise, such registration may be cancellable. However, both Paris Convention and TRIPS Agreement have only set the rules and requirements of non-use cancellation in broad picture and have not determined the burden of proof of the parties involved in the process of such kind of cancellation.¹³³ Each country members will have to further define in its domestic laws in accordance with this settled minimum standard.¹³⁴

3.2 Laws of Foreign Countries

As mentioned that the international treaties and agreements only set forth the non-use cancellation scheme in broad picture as a minimum standard and basic elements. Each country members must further adapt its domestic laws to pursue the rules of non-use cancellation scheme in accordance with not below than the minimum standard requirement. Therefore, the non-use cancellation scheme in each country are stipulated in different ways, in term of requirement of use, the party who bearing the burden of proof, and standard of proving which required differently in each jurisdiction.

¹³³ *Supra* note 67. Page 743.

¹³⁴ *Id.*

In this chapter, Author will exemplify the foreign laws by demonstrating and comparing the countries that requiring not high burden of proof i.e. United States of America, United Kingdom, and the People's Republic of China, which the non-use cancellation are valuable proceeding and mostly succeed.

3.2.1 The United States of America

3.2.1.1 Overview and Rationale Background

The trademark registration and claim for the lawful ownership approach in the United States of Americas (“US”) is based on the First-to-Use system.¹³⁵ That is to say that basically, any person who firstly use the trademark is assumed to have the lawful ownership of the trademark. The First-to-Use doctrine is generally recognized in the US Trademark Law by the implementation of regulations over the jurisdiction governing trademark acquisition and enforcement. The trademark registration in the US can filed at the intrastate level and federal level.¹³⁶ In light of obtaining the legal protection at the federal level, the trademark owner can file the application to the United States Patent and Trademark Office (“USPTO”), where is the authority of the federal agency that is responsible for granting the trademark and patent protection, to establish the tangible evidence of title by receiving a Certificate of Trademark Registration. On the other hand, the trademark owner is not necessarily required to file the application for trademark registration at the intrastate level as long as the trademark is used in commerce.¹³⁷ That is to say that if the trademark is used for commercial purpose within the jurisdiction of that state, it is potentially qualified to automatically obtain the legal protection without official registration. Notwithstanding, the federal trademark registration is still important because the Certificate of Trademark Registration as a tangible evidence can be

¹³⁵ *Supra* note 65.

¹³⁶ International Trademark Association (INTA). *"State Trademark Registration in the United States"*. July 2014.

<http://www.inta.org/TrademarkBasics/FactSheets/Pages/StateTrademarkRegistrationsUSFactSheet.aspx> (accessed on April 14, 2016)

¹³⁷ *Id.*

brought up to affirm the rights of the trademark owner which is assumed to be overwhelming against other claims by the unregistered owner.

In response to the recognition and implementation of the First-to-Use doctrine, the US Trademark Law relies on the genuine use of trademark towards the trademark registration process given that there are also registered trademarks which are not used for commercial purpose. Thus, the US Trademark Law and practice applies the non-use cancellation scheme to solve this problem on a prima facie basis with the lower standard of requirement of proof, where the second comer as the petitioner is merely required to prove abandonment of the trademark in question. In other words, the registered trademark can be simply challenged by a proof of abandonment based on prima facie evidence by the second comer. Then, the trademark owner will be required to defend the cancellation claim by proving the actual and genuine use of trademark or provide justifiable cause for the non-use.

3.2.1.2 Ground for Non-Use Cancellation

The provision concerning non-use cancellation is provided in the US Trademark Act 1946, also known as the Lanham Act, as follows:

"Section 1064. Cancellation

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter...

(3) At any time if the registered mark ... has been abandoned...¹³⁸

¹³⁸ US Trademark Law. § 14 (15 U.S.C. § 1064).

"Section 1127 (1) Abandonment of mark.

A mark shall be deemed to be "abandoned" if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark."¹³⁹

As stipulated in Section 1064(3), the Lanham Act provides that a petitioner to the non-use cancellation may be filed, at anytime, by an interested person who believes that he is or will be damaged if the registration of trademark, which abandoned by the owner. According to the US Trademark Law, the mark which shall be deemed abandoned can be considered under following circumstances as: 1) the mark that has been discontinued its use by the owner and the owner has no intention to resume the use of it; 2) the mark has not been used for 3 consecutive years. These two circumstances of presumed as abandonment constitute the ground for non-use cancellation in US.

3.2.1.3 Non-Use Cancellation Proceeding

The non-use cancellation in US may be filed at any time if the registered trademark has been presumed to be abandoned, as the circumstances according to Section 1127(1)¹⁴⁰. The process is started with the interested party files the request with the reason for cancellation with the Trademark Trial and Appeal Board. The request application must be made in similar form as the complaint in court proceedings, which stating why he believes that he is or will be damaged by the unused registered trademark, such as he cannot register his trademark which happens to be considered as identical with or similar to the unused trademark which has been

¹³⁹ US Trademark Law. § 45 (15 U.S.C. § 1127).

¹⁴⁰ *Id.*

prior registered.¹⁴¹ After the non-use cancellation is requested, the trademark owner will be able to file an argument against allegation that the owner still uses the trademark or trademark has never been abandoned. If the owner of such alleged trademark does not submit an argument within the prescribed period, the Board may consider revoking such registration against trademark in question pursuant to the request of petitioner.¹⁴²

3.2.1.4 Burden of Proof for Non-Using of Registered Trademark

According to the Court's judgment in case *Auburn Farms, Inc. V. McKee Foods Corps*¹⁴³, the burden of proof for the case of non-use cancellation is set forth that the petitioner has to prove only a prima facie evidence that the owner of registered trademark in question has abandoned the trademark pursuant to the provision of Section 1127¹⁴⁴ whether the use of trademark is discontinued with no intention of the owner to resume such use or the trademark has not been used for at least 3 consecutive years. Once the petitioner can prove such prima facie evidences of abandonment, the burden of proof will be shifted to the trademark owner who bears the duty to rebut that the trademark is still in use or has intention to resume the use.¹⁴⁵ For this matter, since the petitioner has only burden of proving prima facie evidence of abandonment, which can be demonstrated through the act of not providing statement of use when the time requested or etc., it shows that the petitioners may find such evidences, not too difficulty. Then, the trademark owner shall bear the burden to rebut the allegation by submitting the evidences showing use of his or her own trademark and/or the intention to continue to use it, which the evidences shall be in hands if the mark and business regarding this mark is actually being operated. This process shows that the US Court does not stipulate too high standard of proof for both petitioners and trademark owners. Therefore, the burden of proof for non-use cancellation in US is not too difficult to overcome.

¹⁴¹ *Supra* note 67. Page 745.

¹⁴² *Id.*

¹⁴³ *Supra* note 67. Page 745 (Citing 51 U.S.P.Q. 2d 1439, 1443 (1999))

¹⁴⁴ US Trademark Law. § 45 (15 U.S.C. § 1127).

¹⁴⁵ *Supra* note 67.

3.2.2 The United Kingdom

3.2.2.1 Overview and Rationale Background

The United Kingdom (“UK”) is a common law country, which basically adopts a 'First-to-Use' trademark acquisition system to be base for its trademark protection.

The reason why the Author has chosen to study the non-use cancellation proceeding in the UK is due to the fact that the law of Thailand had firstly given a provision regarding non-use cancellation in the Trademark Act B.E. 2475 (1931), which this Act was enacted by, at that time, followed UK trademark law, Trade Mark Act 1905.¹⁴⁶ Therefore, the non-use cancellation proceeding in Thailand has its roots from the UK's trademark law.

Nevertheless, On October 31, 1994, the statutory element of trademark law in the UK was substantially changed by the entry into force of the Trade Marks Act 1994. The 1994 Act had two main aims: first and foremost, to give effect to European Directive 89/104, harmonizing national trade mark laws, and secondly to pave the way to the UK's ratification of the "Madrid Protocol" on the International Registration of Marks.¹⁴⁷ Therefore, as a member state in the European Community, UK, even though a common law jurisdiction, needed to compromise its trademark acquisition and registration system by adopting by adopting a registration system in order to meet with the common practice of the rests of the Community, which most of the members are 'First-to-file' system countries. It is to say that the trademark acquisition system in the United Kingdom has been a mix with "First-to-use" and "First-to-file".

¹⁴⁶ *Supra* note 20.

¹⁴⁷ *Supra* note 23. Page 1.

However, upon the current situation, due to the result of "Brexit" referendum¹⁴⁸ on June 26, 2016, the majority votes of the United Kingdom had decided to leave the European Union. As starting process of leaving the EU could take several years, there are still remaining of unanswerable questions as to how UK could stipulate the internal laws in many issues and how this would affect to trademark registration system and other intellectual property rights in the future, after cooperated and adjusted with European Community for so long.

For this thesis, the Author has been studied on the current effective statute, Trade Marks Act 1994, which the Author will emphasize on the non-use cancellation proceeding and significantly focus on the matter of burden of proof stipulated by the UK's law that lies on the trademark owner side, not the petitioner. This burden that put on the person who has fully access to the information of use of trademark could facilitate the outcome of non-use cancellation to be more effective. Unlike Thailand, even though the provision of non-use cancellation was originated from the UK's law, but the burden of proof regarding this matter is formulated differently.

3.2.2.2 Grounds for Non-Use Cancellation

Even the United Kingdom is a common law country, a requirement for evidences of genuine use from the trademark owner at the time of filing or obtaining registration of trademark were not required. However, in order to maintain the registration, the genuine use is compulsory required in the UK,¹⁴⁹ otherwise the registration may be revoked based on non-use.

¹⁴⁸ Brian Wheeler & Alex Hunt, BBC News, "*Brexit: All you need to know about the UK leaving the EU*" <http://www.bbc.com/news/uk-politics-32810887> (accessed on July 21, 2016). (Citing "*It is a word that has become widely used as a short way of saying the United Kingdom is leaving the European Union by merging of the two words Britain and Exit*".)

¹⁴⁹ AIPPI. "The requirement of genuine use of trade marks for maintaining protection : United Kingdom". 25 April 2011. https://aippi.org/download/committees/218/GR218united_kingdom.pdf (accessed on December 5, 2015)

The ground for non-use cancellation is stated in Section 46 of the Trade Marks Act 1994 as follows:

"Revocation of registration.

(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;...¹⁵⁰

The ground for non-use cancellation in UK may be filed in order to request a removal of trademark registration if a trade mark:

- (a) has not put in the genuine used within United Kingdom in period of five years since the date it was registered, or
- (b) the use has been suspended for any uninterrupted period of five years.

In addition, there must be with no proper reasons of such non-using, which are considering on whether it is outside the control of the trade mark proprietor, such as export or legal restrictions.¹⁵¹

¹⁵⁰ UK Trademark Act 1994, Section 46

¹⁵¹ UK Intellectual Property Office. *"FAQ - Revocation (Non-use): Proceeding before trademark tribunal."*

http://www.gov.uk/government/uploads/system/uploads/attachment_data/file/308759/revokingnonuse.pdf (accessed on December 5, 2015)

3.2.2.3 Non-Use Cancellation Proceeding

Any person may apply for the revocation, which the non-use cancellation proceeding in UK may be either made to the Registrar with United Kingdom Trademark Office or Court.¹⁵²

In the previous provision of Trade Mark Act 1938¹⁵³, it was possible to attack a mark for non-use at any time, upon the basis that a trademark in question had been registered without a bona fide intention to use it and no use had subsequently been made of it.¹⁵⁴ However, according to Section 46(1)(a) of current Trade Mark Act 1994, it is clearly not possible to attack a mark that have been registered for less than five years. If a petitioner faced with a conflicting mark that has been registered less than five years, the only possible manner that such petitioner could proceed is to seek a declaration of invalidity of the mark pursuant to Section 47¹⁵⁵ on the ground that trademark owner had lacked of bona fide intention to use the mark at the time of registration so that his application had been made in bad faith.¹⁵⁶

In the Section 46(1)(a) of current Trade Mark Act 1994, an application for revocation can be made only if a trademark in question has been registered for at least five years with the earliest date of revocation being the day following the fifth anniversary of the registration date.¹⁵⁷ This means that the period of five years counts from the date of completion of the registration procedure, rather

¹⁵² UK Trademark Act 1994. Section 46 (4).

An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

¹⁵³ UK Trademark Act 1938. Section 26.

¹⁵⁴ *Supra* note 23. Page 77.

¹⁵⁵ UK Trademark Act 1994. Section 47.

¹⁵⁶ *Supra* note 23. Page 77.

¹⁵⁷ UK Intellectual Property Office. "*Guidance: Revocation (non-use) proceedings*" <https://www.gov.uk/government/publications/trade-marks-revocation/revocation-non-use-proceedings> > (accessed on May 12, 2016)

than from the date of filing of the application.¹⁵⁸ If non-use is alleged, it is for the trademark owner to show what use, if any, has been made of the mark.¹⁵⁹

It is also possible to apply to remove the entire registration in respect of all list of goods, or only some of the goods or services for which the trade mark is registered.¹⁶⁰ By cancelling only some of the goods or services as registered in the application is for the aspect that only some of goods or services are concerned to be deemed as non-use as per the ground for revocation, therefore the revocation shall only relate to those goods or services, not all the items listed in the application.

3.2.2.4 Burden of Proof for Non-Using of Registered Trademark

Pursuant to Section 100, burden of proving use of trademark is stipulated as follows:

"If in any civil proceedings under this Act, a question arises as to the use to which a registered trademark has been put, it is for the proprietor to show what use has been made of it."

The UK's Trade Mark Act 1994 has clearly stipulated the burden of proof specifically for the non-use cancellation that the burden must bear by the trademark owner, not a petitioner. What must be established is some genuine and commercial use that has been made of the mark.¹⁶¹ The evidences which can be a demonstration of financial sales records for using trademark in course of trade during the relevant five years period, the goods or services has been advertised under trademark, proportion of use, and geographical areas in which the trademark has been

¹⁵⁸ *Supra* note 23. Page 77.

¹⁵⁹ *Supra* note 23. Page 78.

¹⁶⁰ UK Trademark Act 1994. Section 46 (5).

Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

¹⁶¹ *Supra* note 23. Page 78.

used by the registered proprietor or with his consent.¹⁶² In addition, only offering goods for sales under the mark is suffice, even if no actual sales can be proved.¹⁶³ The acts which can describe as preparatory to launching goods under the mark onto the market may also be considered as sufficient evidence.¹⁶⁴

Under Trade Mark Act 1994, the use of trademark that requires the proprietor to prove does not need to be very extensive, as long as it is genuine. However, in order to describe the terms of genuine use, the mark must be used with the goods or services as it was registered. The promotional use for other goods or services will not sufficient to be counted as genuine use of this particular trademark.¹⁶⁵ According to Subsection 46(1)(a) and (b), the use of mark may not have been made only by the trademark owner. It is sufficient to prove the use of mark that has been made by a licensee or another authorized person within the owner's consent.¹⁶⁶

Besides, pursuant to Subsection 46(2)¹⁶⁷, the use made of trademark does not have to be exactly the same in the form in which it is registered.¹⁶⁸ As long as the use of mark does not alter the distinctive character of the mark, the evidences presented should be suffice. There was a case, *Second Skin*¹⁶⁹, the mark was registered as "Second Skin" but it had been used as "2nd Skin", this use was considered as properly interchangeable forms in which the proprietor can do for the business and found to be sufficient to overcome the alleged non-use cancellation. On

¹⁶² *Supra* note 150.

¹⁶³ *Supra* note 23. Page 78. (citing *Hermes trade mark* [1982] R.P.C. 425.)

¹⁶⁴ *Id.*

¹⁶⁵ *Supra* note 23. Page 78. (citing *Elle* [1997] R.P.C. 529 at 534.)

¹⁶⁶ *Supra* note 23. Page 79.

¹⁶⁷ UK Trademark Act 1994. Section 46(2).

"For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes."

¹⁶⁸ *Supra* note 23. Page 78.

¹⁶⁹ *Id.* (citing *Second Skin* [2001] R.P.C. 30.)

the contrary, if the use of mark has significantly changed the distinctive characteristic i.e. changing from the stylized capital letter to lower case with different type-face¹⁷⁰ or changing the device that use differently from what was registered¹⁷¹, the mark will be found as having been in non-used.

Subsection 46(3)¹⁷² is dealing with the situation where a mark had not been put in genuine use for more than five years but the owner has just started or resume the use prior the non-use cancellation has alleged. Any commencement or resumption of use which is made within three months period prior the filing date of non-use cancellation seems to be disregard as the use of trademark, unless the owner of such mark can show that there is a preparation for such commencement or resumption has been began with unaware of the application of revocation.¹⁷³ This subsection appears to concern on the time of starting or resuming the use as well as to see the bona fide intension of use of the trademark owner. It is designed to prevent the owner from preserving his mark by hastily starting to make a use of the mark once he knows that an application for revocation is threatened.¹⁷⁴

However, in case of having a proper reason for non-use, a mark may not be revoked. For example, in *Magic Ball*,¹⁷⁵ there was a difficulty of developing the new machinery that necessary to produce the innovative products

¹⁷⁰ *Supra* note 23. Page 78. (citing 'Elle.')

¹⁷¹ *Supra* note 23. Page 78. (citing *United Biscuits (UK) Limited V. Asda Stores Limited* [1997] R.P.C. 513)

¹⁷² UK Trademark Act 1994. Section 46(3).

"The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made."

¹⁷³ *Supra* note 23. Page 79.

¹⁷⁴ *Id.*

¹⁷⁵ *Supra* note 23. Page 79. (citing *Magic Ball* [2000] R.P.C. 439)

intended to be sold under the mark, this was a proper reason that accepted for non-use. On the other hand, the Court held in *Cabanas Habana*¹⁷⁶ that a restriction of U.S. trade embargo had come into effect for many years, therefore it is not a temporary disruption to trade and could not be considered as a proper reason for non-use. The mark on Cuban cigars thus were revoked.

3.2.3 Japan

3.2.3.1 Overview and Rationale Background

Japan is a civil law country that adopts the principle of first-to-file system for registration of trademark, which a trademark filed earlier has priority for registration.¹⁷⁷

Under Japanese Trademark Act 1959, there is no explicit provision that genuine use is a requirement for obtaining and maintaining protection.¹⁷⁸ As the renewal proceeding, the requirement for proof of use is also not required at the time of renewal. Therefore, it is to say that, in Japan, use of trademark is basically not a requirement for arising or continuation of trademark rights.¹⁷⁹

However, according to Article 1¹⁸⁰ of Trademark Act, it is stated that *"the purpose of this Act is, through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks and thereby to contribute to the development of the industry and to protect the interests of*

¹⁷⁶ *Supra* note 23. Page 78. (citing *Cabanas Habana* [2000] R.P.C. 26)

¹⁷⁷ *Supra* note 72.

¹⁷⁸ AIPPI. "The requirement of genuine use of trademarks for maintaining protection: Japan". 8 June 2011. http://aippi.org/wp-content/uploads/committees/218/GR218_japan.pdf (accessed on December 5, 2015)

¹⁷⁹ *Id.*

¹⁸⁰ Japanese Trademark Act (Act No.127 of April 13, 1959). Article 1.

"The purpose of this Act is, through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks and thereby to contribute to the development of the industry and to protect the interests of consumers."

consumers". As from this Article, even though there is no explicit provision pertaining to genuine use, but it may be considered that the genuine use of trademark is required as the aim of trademark protection to ensure that the business has maintained its operation and the protection has been given to a trademark owner who actually use the trademark in commerce for the development of the industry and protecting public and consumers' interests.

As ruled by Tokyo High Court decision in *Vuitton* case¹⁸¹, what is to be protected under the Trademark Act is confidence that increasing built through the use of trademark. When a trademark has not been used for a certain period, a confidence in business shall not be protected.¹⁸² Moreover, the public interest may be unreasonably violated by the grant of exclusive rights to unused trademarks.¹⁸³ In addition, the existence of such unused trademarks may possibly cause a limitation of people's choices, who wish to use a trademarks in course of trade, to choose a name and create a mark that is not identical or similar to the one that already taken. Seeing from the above Court's judgment, it is clearly demonstrated that Japanese Trademark Law expressly concerns on the issue of non-used trademark and emphasizes that the protection granted must be worth to the economic and industry through the use of trademark.

Comparing on trademark acquisition systems, it seems like Japan and Thailand have similar trademark system i.e. both are civil law countries that adopt the 'First-to-File' system which significantly grant the protection on basis of first registration, and both countries has no explicit for requirement of genuine use of trademark in order to obtain and maintain the registration. However, focusing on the non-used trademark, Japan has given a priority to an efficiency of cancellation process by stipulating the burden of proof lying on the trademark owner. While in Thailand, the non-use cancellation is difficult to overcome as to the obstacles of

¹⁸¹ *Supra* note 178. (citing *Vuitton* Tokyo High Court decision, 30 November 1993, Heisei 04 (Gyo-Ke) No.144)

¹⁸² *Id.*

¹⁸³ *Id.*

burden of proof and high standard of proving non-use. It is interesting to study why both countries which have such similar trademark system, but resulting in different procedures in non-use cancellation process.

3.2.3.2 Grounds for Non-Use Cancellation

According to Article 50 of Japanese Trademark Law, a registered mark which has not been used in Japan in connection with any of the designated goods or services for more than three years in Japan, the registration is vulnerable to a third party's cancellation request based on non-use. The provision concerning Trial for rescission of trademark registration in Japan is clearly stated as follows:

"Article 50 (Trial for rescission of trademark registration)

(1) Where a registered trademark (including a trademark deemed identical from common sense perspective with the registered trademark, including a trademark consisting of characters identical with the registered trademark but in different fonts, a trademark that is written in different characters, Hiragana characters, Katakana characters, or Latin alphabetic characters, from the registered trademark but identical with the registered trademark in terms of pronunciation and concept, and a trademark consisting of figures that are considered identical in terms of appearance as those of the registered trademark; hereinafter the same shall apply in this article) has not been used in Japan in connection with any of the designated goods and designated services for three consecutive years or longer by the holder of trademark right, the exclusive right to use or non-exclusive right to use, any person may file a request for a trial for rescission of such trademark registration in connection with the relevant designated goods or designated services."

3.2.3.3 Non-Use Cancellation Proceeding

In Japan, any person may file a non-use cancellation request with the Court in order to request for a trial for rescission of trademark registration. Like, Japan Patent Office ("JPO"), whenever the JPO has a reasonable doubt as to whether the applicant is currently conducting the business or whether has any concrete plans to conduct the business in the future in connection with the designated goods or services, may file an application to respond to the issue of non-use trademark.¹⁸⁴

A non-use cancellation request may be filed with respect to all of the designated goods or a part of the designated goods or services in the registration.

3.2.4.3 Burden of Proof for Non-Using of Registered Trademark

The burden of proof for non-using of registered trademark is on the Registrant of trademark. The use in which the Registrant must provide needs to be used in a manner connecting with each of designated products or services as applied for registration.¹⁸⁵ In case, a trademark has not been put in actual use but the owners have a concrete plan to use such trademarks in connection with the goods or services as applied in future, the applicants must submit a document certifying that they are conducting or plan to conduct business in future. The documents can be printed material pertaining to advertisement of goods or services i.e. newspapers, magazines, catalogs, or sales documents i.e. invoices, orders, delivery statements, or certificates of proof issued by public organizations i.e. national government, local governments, embassies in Japan, or chamber of commerce and industry, etc.

¹⁸⁴ *Supra* note 72.

¹⁸⁵ *Supra* note 178. (citing *Dale Carnegie*, Tokyo High Court decision, 28 February 2001, Heisei 12 (Gyo-Ke) No.109.)

However, use only as a business name is not considered to be used as a mark to distinguish its goods and services from those of others.¹⁸⁶ Along with the use for only merchandising, for examples, distributing T-shirts printed "Startrek" to the consumers with free of charge for the purpose of advertising a movie is not probably judged as a genuine use for clothing.¹⁸⁷ Therefore, these uses may not be sufficient to be considered as a use to maintain its registration.

On the other hand, use on the internet is basically accepted and constituted as use of trademark in relation to the trial for non-use cancellation as long as the posted website is easily accessible through the internet from within Japan and goods or services can be purchased from within the country, regardless the server provider is located in a foreign country.¹⁸⁸

In consideration of degree of use, the number of transactions should be determined case by case based on trade circumstances and nature of products in the field of goods in which it was registered. A small amount of transaction may be sufficient to be proved as use of trademark i.e. there was a case where a single transaction of one product bearing trademark in connection with "exterior of an artificial skin for a robot" is sufficient because the products are used for a very specific purpose.¹⁸⁹

Article 50 (3)¹⁹⁰, like the UK Trademark Act Section 46(3)¹⁹¹, if a trademark is used just prior to a trial, which is during a period between

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

¹⁸⁸ *Supra* note 178.

¹⁸⁹ *Id.* (citing ("*KOKORO*", IP High Court decision, 27 June 2007, Heisei 19 (Gyo-Ke) No.10084)

¹⁹⁰ Japanese Trademark Act (Act No.127 of April 13, 1959). Article 50(3).

"(3) Where the registered trademark in connection with the designated goods or designated services pertaining to the request under paragraph (1) has been used in Japan by any of the holders of trademark right, exclusive right to use or non-exclusive right to use, during the period from three months prior to the filing of the request for a trial under paragraph (1) to the date of the registration of the filing of the request, and where the demandant proves that the registered trademark has been used after

three months before the date on which a request for cancellation was filed, solely for the purpose of avoiding the challenge of non-use cancellation, such use shall not constitute as the use of trademark and evidences provided will not be considered as a defense of the trademark owner if the petitioner can prove that the trademark owner was aware of and has already knew that the cancellation proceeding was filed against its registration.

3.2.4 People's Republic of China

3.2.4.1 Overview and Rationale Background

Given the large scale economy, China is a fast developing country attracting massive investment from the local and foreign investors whose objective is to invade the local market and/or base the production lines for import and export including domestic trade. Thus, the number of trademark registrations by the manufacturers and service providers has rapidly increased towards the Chinese economic growth as the legal protection is critically needed for the preventive measure against potential infringement which would cause a huge damage to the business of trademark owner taken into account of the market capacity.

The First-to-File system is adopted and implemented within the jurisdiction of the People's Republic of China for trademark registration.¹⁹² Like the First-to-File system in other countries, Chinese trademark registration on this first-come-first-serve basis allows a trademark owner to firstly file the application in order

the user became aware of the fact that the said request for a trial would be filed, the use of the registered trademark shall not fall under the use of the registered trademark provided in paragraph (1); provided, however, that this shall not apply to the case where the demandee shows just causes for the use of the registered trademark."

¹⁹¹ UK Trademark Act 1994. Section 46(3).

¹⁹² Lexology. "Protection of registered trademarks in non-use cancellation cases in China.<http://www.lexology.com/library/detail.aspx?g=2c55e192-5ffe-47e3-823b-c4a3c285aca5>> (accessed on December 5, 2016)

to claim the legal protection for his trademark, even if such trademark may have not yet been used in commerce. That is to say that the trademark registration can be filed regardless of the owner's intention or any plan to actually use it for commercial purpose. This First-to-File system causes a loophole for registering a non-used trademark. This kind of registration is considered as defensive registration that set as a barrier preventing others to register the same or similar trademark.

Chinese Trademark Law does not require the genuine use of trademark for the applicant to obtain the registration, along as the renewal proceeding which the requirement for proof of use neither required at the time of renewal. However, the registered trademark is vulnerable to be cancelled by non-use cancellation, which surprisingly most of them are successful.

On August 30, 2013, the top Chinese legislative assembly which is known as the Standing Committee of the National People's Congress, concluded the session resulting in the adoption of a third amendment to the Trademark Law, which thereafter came into force on May 1, 2014.¹⁹³ The provision and regulation concerning non-use cancellation then has been slightly changed on the rights of third parties who can commence on the request of such non-use cancellation against registered trademark due to the current situation of increasing of defective registrations without use in China.

3.2.4.2 Grounds for Non-Use Cancellation

The regulation of non-use cancellation under the New Trademark Law of the People's Republic of China (as amended up to Decision of August 30, 2013, of the Standing Committee of National People's Congress on

¹⁹³ Hogan Lovells. *"China issued Amended Implementing Regulations of the New Trademark Law"*. March 2014.
http://www.hoganlovells.com/files/Uploads/Documents/China_new_trademark_law_March_2014_HKGLIB01_1085309.pdf (accessed on December 5, 2016)

Amendments to the Trademark Law of the People's Republic of China), is stipulated in Article 49 Paragraph 2 as follows:

"Article 49 Paragraph 2

*Where a registered trademark is becoming a generic name in a category of approved goods and the mark has not been used for a period greater than three years without any justifiable reasons, any organization or individual may request that the Trademark Office make a decision to cancel such registered trademark. The Trademark Office shall make a decision within nine months from its acceptance of an application for the cancellation of a registered trademark due to non-use. If an extension is needed, upon the approval of the department of industry and commerce administration under the State Council, the time limit can be extended for a further three months.*¹⁹⁴

In China, the legal ground for filing non-use cancellation is straightforward.¹⁹⁵ The allegation for non-use may be filed against a registered trademark if the use of such trademark has ceased for a period greater than three consecutive years. In addition, it is provided that it must be without any justifiable reasons rebutted for such non-using.

3.2.4.3 Non-Use Cancellation Proceeding

Referring to the previous Chinese Trademark Law¹⁹⁶, a third party who may initiate a non-use cancellation proceeding must be an interested person. However, according to new regulation of non-use cancellation, Article 49 paragraph 2 stated that *"any organization or individual may request that the*

¹⁹⁴ Trademark Law of the People's Republic of China. Article 49.

¹⁹⁵ Management, Markets and Legal Consulting Group. "China Trademark Law : Non-Use Cancellation Actions". HG.org Legal Resources. <http://www.hg.org/article.asp?id=33278> (accessed on July 15, 2016)

¹⁹⁶ Trademark Law of the People's Republic of China (as amended up to Decision of October 27, 2001). Article 44.

Trademark Office make a decision to cancel such registered trademark."¹⁹⁷ Therefore, there is no special limitations on the petitioner.¹⁹⁸ The petitioner can be any person or entities, that may not have to be an aggrieved person and not required to prove its legal interest.¹⁹⁹

An application for cancellation against a registered trademark based on non-use in China must be filed with China Trademark Office ("CTMO"), which will have the discretion to make a decision whether to cancel the registration of trademark in question. It is a simple statement that the mark has not been used for at least three consecutive years prior to the filing date of the cancellation application.²⁰⁰ In support of the application, the petitioner can submit the result of a brief internet search, for instance, a print-out from a popular search engine i.e. BAIDU, GOOGLE, etc., showing that there is no 'hits' resulting from a search of the owner in relation to the goods or services under the disputed trademark.²⁰¹

Chinese trademark registration is, not only classify the list of goods according to the class designated by the Nice Classification, but also dividing the goods or services as applied into sub-classes. This means that each designated goods even in the same classification however may be subject to different sub-classes depending on its nature of goods, characteristics, purposes of use, etc. In case, there are two trademark application in which its designated goods fall under the same classification, but determined in different sub-classes, both trademark can be registered in China as the reason that they might not be causing any confusion or mislead to the public and consumers due to its differences in nature. Therefore, the co-existence of similar trademark for the same classification is possible in China.

¹⁹⁷ *Id.*

¹⁹⁸ Lexology. "*Protection of registered trademarks in non-use cancellation cases in China.*" <http://www.lexology.com/library/detail.aspx?g=2c55e192-5ffe-47e3-823b-c4a3c285aca5> (accessed on December 5, 2016)

¹⁹⁹ *Supra* note 194.

²⁰⁰ Hatty Cui. "*Brief review of 'non-use' trade mark cancellation proceedings in China.*" China Daily. June 14, 2012 http://ipr.chinadaily.com.cn/2012-06/14/content_15502882.htm (accessed on July 15, 2016)

²⁰¹ *Id.*

Consequently, pertaining to non-use cancellation proceedings in China, if the grounds for cancellation is sustained for some of the goods or services for which trademark is registered, it is acceptable that an application request can be filed in respect of cancelling only partial of designated goods or services.²⁰² In this case, the registration of such trademark can be cancelled in part.²⁰³ However, in case a petitioner decides to file a non-use cancellation against all the list of goods as registered, but the owner of registered trademark can only demonstrate the use of some of the goods, not all of the sub-classes for which it was registered, the trademark should therefore be cancelled only for those sub-classes for which the owner has not produced sufficient evidences.

Once a cancellation request is filed, the CTMO shall notify to the Registrant and require the Registrant to provide proof of use of such registered trademark in question within 2 months of receiving the notice, in order to rebut the cancellation claimed. If the Registrant cannot provide either the appropriate evidences of using or legal justification for proper reason of non-using, the CTMO will decide to remove the registered trademark in such dispute from the Registry records.²⁰⁴

According to Article 50 of this new Trademark Chinese Law, however, the CTMO shall not approve any later trademark application for registration that is identical with or similar to such cancelled trademark within this period.²⁰⁵ Therefore, even though the disputed trademark registration has been decided to be cancelled by the CTMO due to the non-use cancellation request, it is to

²⁰² *Id.*

²⁰³ Freshfield Brucks Haus LLP. "*Cancelling Registered Trademark in China for Non-Use*". 23 May 2012

<http://www.freshfields.com/knowledge.aspx?language=en®ion=china&PageSize=70&pageNumber=14> (accessed on April 14, 2016)

²⁰⁴ *Id.*

²⁰⁵ Trademark Law of the People's Republic of China. Article 50.

"Where a registered trademark has been cancelled, invalidated or has not been renewed upon expiration, the Trademark Office shall not approve any application for the registration of a trademark that is identical to or similar with the said trademark for a period of one year from the date of cancellation, invalidation, or the date of expiration."

say that the protection of such cancelled trademark still enforce for further period of one year as from the date of cancellation. A later trademark owner, who may have been effected from the prior registered trademark and proceed with non-use cancellation, still has to wait for another one year after the date of cancellation is succeed, to be granted the protection.

3.2.4.4 Burden of Proof for Non-Using of Registered Trademark

After the CTMO accepts the cancellation application and notifies to the Registrant, the burden of providing valid evidence of use of the trademark in question in relation to the designated goods or services rests with the trademark owner.²⁰⁶ The Registrant or the trademark owner must submit the evidences showing the use of trademark in order to rebut the allegation of petitioner.

In the past, the CTMO had adopted a 'formality-based approach' for the trademark owner to be simply required to provide a proof of having used of trademark, regardless to the significance of the concept of 'use of a trademark within the meaning of the Trademark law'. It was often that the trademark owners try to forge the evidences in order to keep their mark from being cancelled.²⁰⁷

In April 2010, there is a formal opinion that the Supreme People's Court has given the guidance on what are the evidences which can be considered as of 'use of a trademark within the meaning of the Trademark law' that could defend the non-use cancellation once it is alleged. The Supreme People's Court opined that the trademark owners need to produce the evidence that shows '*public, genuine and lawful*' use of the trademark in commerce.²⁰⁸ The term 'public' means a trademark owner must produce evidence of use of trademark in commerce that indicates the source of origin of the goods for the people of the public are able to distinguish the owner or market entities that providing such goods. It is required

²⁰⁶ *Supra* note 200.

²⁰⁷ *Id.*

²⁰⁸ *Supra* note 203. (citing *Dianhong Phamaceutical Group v. Kangwang* (2008).)

public's perception of a mark as an indicator of source.²⁰⁹ 'Genuine use' is the actual use of trademark, which shall be determined in accordance with the legislative spirit of Trademark Law. Only an assignment, a licensing agreement, a publication of trademark registration information or an announcement of exclusive owner of the registered trademark are not sufficient to convince that there is an actual use of trademark within the meaning of the Chinese Trademark Law. 'Lawful', the registrant of this alleged trademark must be genuine owner of the mark, otherwise the application for invalidation revocation can be filed to cancel this registration based on registration in bad faith pursuant to Article 45²¹⁰. Therefore, under the Supreme People's of Court's guidance, China has adopted a more stringent standard, so called 'substance-based approach' to determine the use of trademark, which has been commonly affirmed by the CTMO, the TRAB, and the Courts in the People's of China.²¹¹

The Supreme People's of Court also opines that the use of trademark in a 'slightly different' form from the one in which it is registered is also regarded as use of trademark, provided that there has been no substantial alteration to the distinctive features of trademark²¹² i.e. the use of plain letters might be enough to preserve its validity of a stylized version of the same mark.²¹³

However, in case the Registrant does not provide the evidences showing use of trademark within the deadline in prescribed periods or evidences as submitted are considered as not sufficient to demonstrate the actual and genuine use of the trademark in accordance with the Supreme People's Court's guidance, the CTMO shall issue the decision to cancel such registered trademark.

On the other hands, if the trademark has been in reasonable of non-using, the Registrar must provide the evidences showing proper and legal

²⁰⁹ *Supra* note 200.

²¹⁰ Trademark Law of the People's Republic of China. Article 45.

²¹¹ *Supra* note 200.

²¹² *Supra* note 203.

²¹³ *Id.*

justifications of such non-use. The proper reason for non-using are either force majeure, government's policy or the restrictions to sell the products or operate the services, bankruptcy liquidation, other proper reasons not attributable to the Registrant, etc.²¹⁴ Moreover, in the case that a trademark owner has a real intention to use trademark and has made necessary preparations to use it but has not yet used the registered trademark due to other objective factors, this also shall be deemed that such trademark owner has justified reason for non-use.²¹⁵ Resulting from being able to produce the appropriate evidences or the justifiable reason for non-use, the registration will be satisfied to be maintained.²¹⁶

The above foreign laws show that the standard of proof for non-use cancellation is not significantly high. In some jurisdictions i.e. United Kingdom, Japan and the People's Republic of China, the burden of proof lies on the trademark owner who has full ability to access to the information whether the trademark is used or not, including the facts regarding a legal justification if the non-using was caused by a justifiable reason, not the intention of trademark owner. While, in the United States of America, the petitioner bears only the prima facie to show the abandonment of trademark or preliminary cause of non-using. Then, the burden of proof will be shifted to the trademark owner to produce the evidences rebutting that the trademark has been genuinely used or there is any special circumstances why the trademark cannot be used.

According to these less burdens, a chance was given to the petitioner to be able to overcome the non-use cancellation and such unused trademark registration can be revoked. Subsequently, this proceeding can provide a great opportunity to the later comer, who may have used in commerce, to register its trademark and receive the guaranteed protection. The successful of non-use cancellation will encourage the trademark owner to use its registered trademark and benefit to enhance the economic growth in those jurisdictions.

²¹⁴ *Supra* note 193.

²¹⁵ *Supra* note 203.

²¹⁶ *Supra* note 195.

CHAPTER 4

NON-USE CANCELLATION AGAINST TRADEMARK REGISTRATION UNDER THAI TRADEMARK LAW

Trademark law in Thailand has a long history of providing protection, particularly relating to trademarks, that can be traced back to over 100 years ago. However, even though Thailand has its own law dealing with trademark matters, the law still requires constant development in order to follow up with unresolved problems along with new issues continually being raised.

Non-use cancellation against trademark registration under Thai Trademark Law is an example of unresolved problem. It has been a difficult proceeding that rarely succeeds due to the burden of proof for non-using of registered trademark being the responsibility of the petitioner, not the trademark owner. Since the oldest Trademark Act up until this current version, the law has not changed and there has not been much attention paid to resolve this obstructive proceeding. It still remains a problem. The new Trademark Act B.E. 2534(1991) as amended by Act No. 3 B.E. 2559(2016), that has been recently announced this year, has not mentioned this issue as a subject-matter to be amended.

In this Chapter, the thesis will be discussing on the provisions in Thai Trademark Law, particularly as prescribed in Trademark Act B.E. 2534 (1991) as amended by Act (No. 2) B.E. 2543 (2000) for general concepts of trademark, rights of the registered trademark owner, what is the use of trademarks, and more emphasize on existing provision for non-use cancellation in Section 63. Then, the Author will focus mainly on problems that need to be considered due to the ineffective non-use cancellation proceeding in Thailand. After studying the problems, the Author will propose alternative solutions that could be helpful in resolving the ineffective non-use cancellation proceeding in Thailand by comparing it with similar proceeding being practiced under foreign laws. The problems and solutions will be compared side by side and recommendations will be offered that shall respond to all potential issues.

4.1 Overview for Protection of Trademark in Thailand

4.1.1 Historical Background of Trademark Law in Thailand

In the past, Thailand was an agricultural country, where people mostly were farmers. Therefore, there was no concrete evidence showing the history of trademark when it became an important part to the Thai society. However, it was presumed that trademarks had play a vital role when Thailand began to trade with foreign countries.²¹⁷ The exchanging of goods and foreign investors had lead to the use of trademark, which affixed to the products that brought from foreign countries and applied with the products sold in Thailand.²¹⁸ Therefore, the King Rama V had considered that it was necessary to create a system to ensure a legal protection for trademarks to foreign merchants and investors.²¹⁹

In the year 1908, Thailand first provided a trademark protection that was, at that time, merely a criminal offence in the Penalty Code 1908 (B.E. 2451) (R.E. 127). This Penalty Code was the first law code enacted in the reign of Rama V.²²⁰ The penalties were imposed for the offences of acts occurred from counterfeiting and imitating trademarks, including the importing and distributing goods affixed with such counterfeited and imitated trademarks.²²¹ In the subsequent year of 1910 (B.E. 2453), the Bureau of Trademark Registration was established for the purpose of providing the trademark registration for such foreign investors. The first Trademark Act of the Kingdom of Thailand, 'Law on Trade Marks and Trade Name', was enacted and enforced in the year of 1914 (B.E. 2457).²²² This law was written in English to provide a legal protection for foreigner who registered their trademarks in Thailand.²²³ The first law was later replaced by the more complete

²¹⁷ *Supra* note 20. Page 8.

²¹⁸ *Id.*

²¹⁹ *Id.* Page 10.

²²⁰ *Id.*

²²¹ *Supra* note 56. Page 305.

²²² *Supra* note 20.

²²³ *Id.*

Trademark Act in the year of 1931 (B.E. 2474).²²⁴ However, since it had been in enforcement for long time, approximately sixty years, its out-of-date provisions and insufficient protection, in the year of 1991 (B.E. 2534), the new Trademark Act became effective and is still enforced to this day.

The Trademark Act B.E. 2534(1991) provides several clearer rules regarding trademark registrations, the rights of the owners of the registered marks, duties, and authorities of the Registrar and the Board of Trademark. Moreover, this version of the Trademark Act provides the provisions pertaining to trademark licensing in order for the Thai Trademark Law to live up to the international standard of intellectual property laws and support the growth of economic both in domestic and international level.²²⁵ When Thailand became a member of WTO and a party to TRIPs agreement, TRIPs' influence has forced Thailand to amend some provisions in harmonizing with the provisions regarding new perspective of intellectual property rights. In the year of 2000 (B.E. 2543), Thailand then announced an amendment to Trademark Act B.E. 2534 (1991).²²⁶

For more than 15 years, the Trademark Act B.E. 2534(1991), as amended by Act No. 2 B.E. 2559(2016), has been implemented to enforce and stipulate the provision regarding trademarks e.g. trademark application filing, rules and regulations for trademark registration, opposition, cancellation against registration of trademark, etc. However, at present, the Trademark Act had new amendment added in Act No.3 which was recently announced in Government Gazette on April 29, 2016. This new version has significantly changed the provisions by adding protection of non-graphical trademarks i.e. the shape and sound of goods. It includes other sections that provide protection for the packaging of goods. The amendment also enables the owner to prove distinctiveness of the marks through its widely use and abolishes the provision for registering associated marks.

²²⁴ *Supra* note 56. Page 306.

²²⁵ *Id.*

²²⁶ *Id.*

However, as mentioned earlier, the provision regarding non-use cancellation has not been amended. The Section 63 of Trademark Act B.E. 2534 (1991), as provided in the provision concerning non-use cancellation, is still applied.

4.1.2 Definition of Trademark

Trademark Act B.E. 2534 (1991) defined "Trademark" in Section 4 as follows:

"Section 4 - Trademark" means a mark used or proposed to be used in connection with goods to distinguish the goods in which included the trademark from other goods under another person's trademark"²²⁷

As stated above, it clearly appears that the definition of "Trademark" under Thai Trademark Laws responded to the functions of trademark as it is prescribed internationally. The phrase *"distinguish the goods in which included the trademark from other goods under another person's trademark"* meets the purpose of indicating the original function and differentiates the quality of the products under such trademark as the quality indicator functions. The phrase of *"a mark used or proposed to be used in connection with goods"* meets the function of a method of advertisement and investment vehicle as per use in commerce.

4.1.3 Trademark Acquisition

Thailand adopts the First-to-File system, which the protection of trademarks will be granted to the person who files the application and register it first. Therefore, in Thailand, it is important that the trademark owner shall early file the application with the Trademark Office in order to secure a protection in accordance with the law.

²²⁷ Trademark Act B.E. 2534 (1991) Section 4.

The elements of marks that can be registrable as a trademark in Thailand are provided in Section 6, which stated follows:

"Section 6 - To be registrable, a trademark must

(1) be distinctive;

(2) not be prohibited by this Act;

(3) not be identical or confusing similar to another registered mark²²⁸

Therefore, under Thai Trademark Act, Section 6 (3), when the trademarks belonging to different owners are identical with or similar to each other file for registration in Thailand, the prior applicant who filed first will be entitled to maintain ownership of the trademark.

4.1.4 Rights of Registered Trademark Owner

The rights of registered trademark owners are stipulated in Section 44 of Thai Trademark Act, which stated that:

*"Subject to Section 27 and Section 68, a person who register as **the owner of a trademark shall have the exclusive right to use it for the goods for which it is registered.**"²²⁹*

In virtue of Section 44, a trademark owner who registers its trademark with the Trademark Office is to be provided an exclusive right to use the trademark with the registered goods. The exclusive rights to use its trademark means only the owner who registered this particular trademark has the rights to use the mark. If anyone else, unless they receive authorization from the owner, uses this trademark, the owner will have the right to prevent use and can commence legal proceedings. Using a trademark without authorization is considered trademark infringement.

²²⁸ Trademark Act B.E. 2534 (1991) Section 6

²²⁹ Trademark Act B.E. 2534 (1991) Section 44

In Section 6, in regards to the elements of a registerable trademark, an owner of a trademark who registers it first has the rights to prevent anyone else who later files a trademark application with identical characters from registering. This protection also extends to a trademark that contains confusingly similar characters as well, by virtue of Section 13²³⁰ of Thai Trademark Act providing that the Registrar may refuse a trademark application if finds that it is so similar to a registered trademark of another person that the public might be confused or misled as to the owner or origin of the goods even if such application is for the goods that fall under different class. This is the prior rights protection of the registrant who first filed application and registered trademark.

4.1.5 Use of Trademark

According to Section 4 of the Thai Trademark Act, the law stipulates that a trademark means a mark that has been "*used or proposed to be used in connection with goods*"²³¹. Therefore, it can be interpreted that, under Thai Trademark Law and Practice, a mark is not required to be registered as having a prior use or has been used with the goods or services at the time of filing an application.²³² The trademark owner must only have an intention to use the applicable trademark in the future. This application is considered acceptable for registration.

Trademarks must be attached with goods or used for the advertisement and promotion of services with the intention of distinguishing and differentiating the products under this trademark from other similar ones.²³³ If the owner has used the trademark with a different purpose, such as use as the name of the company or to indicate which spare parts or apparatus can be used with the products

²³⁰ Trademark Act B.E. 2534 (1991) Section 13.

²³¹ *Id.*

²³² วีส ดิงสมิธ. เครื่องหมายการค้า : ตัวบทพร้อมข้อสังเกตเรียงมาตราและคำพิพากษาศาลฎีกา. 3. พิมพ์ครั้งที่ 2. กรุงเทพมหานคร : สำนักพิมพ์นิติธรรม. กันยายน 2543. (Wat Tingsamit. **Trademark Law: Principle with notes on respective sections and Supreme Court's Judgements.** 3. (2nd Ed. Bangkok : Nititham., September 2000))

²³³ *Id.* Page 7-8.

under said trademark, it may not be considered an appropriate use of the trademark.²³⁴ This is affirmed by the precedent held by the Supreme Court in case no. 547/2558 as known as “MITA” which declared that:

*“The Defendant produced the toner to be used with the photocopy machines without using any specific trademark for such toner despite the descriptions on the packaging that it is suitable with the photocopy machines of the Plaintiff’s trademark, hence, the Defendant did not use the Plaintiff’s trademark as the trademark by its nature of use.”*²³⁵

The use of trademark, in sense of the determination according to Thai Trademark Law, does not need to be extensive use. The Supreme Court ruled, in case no. 4006/2553, that the use of mark even for a short period of time and in relation to a small number of products still constitutes use.²³⁶ In addition, even though the products are exclusively for exportation and not being sold in Thailand, the trademark attached to such products constitutes as use in Thailand.²³⁷

4.1.6 Requirement for Genuine Use of Trademark

Under the Thai Trademark Act, there is no provision that expressly requires a registrant of trademark to use its trademark with the goods or services as registered within any certain period before or after obtaining registration in order to maintain the registration.²³⁸ An applicant can file an application without being required to submit evidence of prior use. It is the same at the time of renewal. The

²³⁴ *Id.* Page 8.

²³⁵ Supreme Court Judgment no. 547/2538

²³⁶ Supreme Court Judgment no. 4006/2553

“The plaintiff has use its trademark with the products by distributing the samples to consumers and public in Thailand, for the purpose of determining whether the products will receive well-response from the public, is considered as use of trademark, in spite of only in a short period of time and with a small number.

²³⁷ Supreme Court Judgment no. 3498/2528

²³⁸ Nettaya Warncke. *“The requirement of genuine use of trademark for maintaining protection”*.<http://aiippi.org/wp-content/uploads/committees/218/GR218thailand.pdf> (accessed on December 9, 2015)

evidence of use is not required to be submitted for a trademark registration to be renewed. Therefore, it is to say that under Thai Trademark Law, there is no requirement for genuine use of trademark that will force the trademark owner to be aware of using the mark that is registered.

Nevertheless, the registration of trademark can be challenged to be revoked on the grounds of non-use pursuant to the cancellation petition filed by an interested person or the Registrar in virtue of Section 63 of Trademark Act B.E. 2534 (1991).

4.2 Existing Provision for Non-Use Cancellation in Section 63 of Trademark Act B.E. 2534 (1991)

The Trademark Act B.E. 2534 (1991) has provided a provision for cancellation against trademark registration based on the grounds of non-using in Section 63, which states as follows:

"Section 63 - Any interested person or the Registrar may petition the Board to cancel a trademark registration if it is proved that at the time of registration the owner of the trademark has no bona fide intention to use the trademark with the goods for which it was registered and in fact there was no bona fide use whatsoever of the trademark for such goods or that during the three years prior to the petition for cancellation there was no bona fide use of the trademark for the goods for which it was registered unless the owner can prove that such non-use was due to special circumstances in the trade and not to an intention not to use or to abandon the trademark for the goods for which it was registered.²³⁹

²³⁹ Trademark Act B.E. 2534 (1991) Section 63

The purpose of this Section 63 for the provision of non-use cancellation is to allow the law to revoke a registration of trademark that has not been used in order for the trademark owner to be aware of using the registered trademark for the benefit of trade, rather than carelessly holding such registration as an obstacle to the later trademark application or the use of identical or similar trademarks by others.²⁴⁰

4.2.1 Historical Background for Non-Use Cancellation in Thailand

Before the Trademark Act B.E. 2534 (1991), the principle of non-use cancellation against trademark registration was stated in Section 42 of Trademark Act B.E. 2475 (1931).

Section 42²⁴¹ of Trademark Act B.E. 2475 (1931) allows any injured person to file a petition to the court in case the trademark owner has registered the mark in bad faith without the intention to apply it to the products given that nobody has ever applied such mark in good faith to any products or the mark has never been applied to such products within a 5-year period as from the date of filing an application, unless the trademark owner can prove that the non-use is due to the special circumstance in course of trade and without the intention to not apply nor abandon such mark with the products.²⁴²

Notwithstanding, the interested party or the registrar may directly request for the cancellation of trademark with the Board of Trademark by virtue of the new enactment under Section 63 of Trademark Act B.E. 2534 (1991). This differs from the previous one in that they would be able to seek for such relief by filing a

²⁴⁰ *Supra note 60*. Page 152.

²⁴¹ Trademark Act B.E. 2475 (1931) Section 42

²⁴² สัตยะพล สัจจเดชะ. "การเพิกถอนการจดทะเบียนเครื่องหมายการค้าด้วยเหตุแห่งการไม่ใช้" **บทบัญญัติ** **นิตยสารของเนติบัณฑิตยสภา**. 35-36. เล่มที่ 71 ตอน 1. กรุงเทพมหานคร : บริษัท ศูนย์การพิมพ์เพชรรุ่ง จำกัด. มกราคม-มีนาคม 2558. (Satyapon Sachdecha. "*Non-Use Cancellation*" **The Thai Bar Law Journal**. 35-36. (Volume 71 Part 1. Bangkok: Petchrung Publishing Center Co., Ltd., January-March 2015) (Referring to Regulation of Board of Trademark on Procedure of Appeal and Cancellation Petition B.E. 2545 Clause 22).

petition merely to the court. The non-use period has also been reduced to 3 years instead of 5 years. In addition, the appeal may be lodged against the order given by the Board of Trademark regardless of its order whether to cancel the mark or not under Section 65 Paragraph 2. In this regard, the applicant must have not allowed others to use his trademark and such trademark has been used in course of the grantee's business.²⁴³

4.2.2 Grounds for Non-Use Cancellation

According to Section 63, there are two grounds for an interested person or Registrar to file a petition with the Board of Trademark requesting a cancellation against a trademark registration based on claims that such trademark is a non-used trademark, which are:

(a) At the time of registration the owner of the trademark has no bona fide intention to use the trademark with the goods for which it was registered and in fact there was no bona fide use whatsoever of the trademark for such goods.

This ground is considered on the time of filing the application and obtaining the registration of the owner of the trademark. Under this ground, a petitioner must prove the non-using of trademark in question by satisfying two elements:

- 1) Intention of use by the owner of trademark in good faith;
- 2) The facts show no use whatsoever of trademark in good faith.

If the petitioner is able to prove that the trademark, in facts, has never been used whatsoever, but fails to prove whether the owner of registered trademark has no intention at all to use the trademark in future, these will not be sufficient for the Board to cancel the trademark registration as claimed.

²⁴³ Trademark Act B.E. 2534 (1991) Section 63 and Section 65

(b) During the three years prior to the petition for cancellation there was no bona fide use of the trademark for the goods for which it was registered.

This ground is considered during the period after registration. A petitioner must prove the facts that during three years before the petitioner filed a non-use cancellation request, the trademark was not used during those prescribed three years period.

4.2.3 Non-Use Cancellation Proceeding

The proceedings of non-use cancellation in Thailand can be divided into two steps of proceedings. First, filing a petition with the Board of Trademark at the Department of Intellectual Property, by means of Section 63.²⁴⁴ Second, a party, who is satisfied with the Board of Trademark's decision, may appeal the order, whether to cancel or not to cancel a trademark registration, with the Court for reconsideration according to Section 65²⁴⁵.

4.2.3.1 Filing a petition with the Board of Trademark

The provision, Section 63, provides that a party who may request a petition to cancel a trademark registration must be an interested person or the Registrar²⁴⁶. An interested person can be an individual or an organization that can prove damages are or will be occurred if the existing trademark cannot be cancelled.

²⁴⁴ Trademark Act B.E. 2534 (1991) Section 63.

²⁴⁵ Trademark Act B.E. 2534 (1991)

"Section 65 - An order of the Board whether to cancel or not to cancel a trademark registration, under Section 61, Section 62, or Section 63 shall, without delay, be notified in writing to the petitioner for cancellation, the owner of the trademark, or licensee, if any.

The petitioner for cancellation, or the trademark owner or licensees may appeal the order of the Board under the first paragraph to the court within ninety days from the date of receipt of the notification. If no appeal is filed within the prescribed period, the order of the Board shall be deemed final."

²⁴⁶ *Id.*

A non-use cancellation petition must be filed with the Board of Trademark together with evidence supporting the petition at the time of filing. If the petitioner submits the evidence after the petition is filed, the Board of Trademark will not consider and determine such evidence.²⁴⁷ Therefore, all the allegations and evidences must be submitted all together.

After receiving non-use cancellation petition, the Board must notify to the owner of alleged trademark to submit the explanation within 60 days from the date of receiving said notification.²⁴⁸ According to Section 63²⁴⁹, once the owner of alleged trademark receives the notification of non-use cancellation, the owner may submit the evidences and explanation to prove that the trademark has been used in commerce or such non-use was caused by special circumstances in the trade as opposed to the intention not to use or to abandon the registered trademark. If the trademark owner can prove such proper causes for special circumstances of non-using, the trademark registration shall be maintained. This procedure allowing the trademark owner to rebut the allegation of non-use corresponds to the international rules and regulations for non-use cancellation as prescribed in the Paris Convention²⁵⁰ and the TRIPS Agreement.²⁵¹

However, according to the precedent orders of the Board of Trademark, it is not a compulsory request for the owner of the alleged trademark to response to the notification of non-use cancellation. Even if the owner does not submit the evidence to demonstrate the use of trademark or provide an explanation for special circumstances of such non-use, still, the non-use cancellation proceeding is not easy to overcome. This differs from the China's practice that the Trademark Office will remove the registration if the trademark owner does not respond to the notice of cancellation. Failure to respond to such notice may result as a negative effects to the trademark owner. The Chinese law is similar to US Trademark Law

²⁴⁷ *Supra* note 242. Page 37.

²⁴⁸ *Id.* (Referring Trademark Act B.E. 2534 (1991) Section 64.)

²⁴⁹ Trademark Act B.E. 2534 (1991) Section 63.

²⁵⁰ Paris Convention. Article 5 sub-section C.

²⁵¹ TRIPS Agreement. Article 19.1.

which may issue a decision to cancel the registered trademark if the trademark owner does not file an argument within prescribed period.²⁵² The Board of Trademark will unilaterally consider the petition and the supporting evidences and issue the decision based on ex parte proceeding.²⁵³

The ex parte proceeding of the Board of Trademark shows that, under the Thai Trademark Law, the success of non-use cancellations will be solely depending on the allegations and evidences to be supported by the petitioner on whether they can clearly demonstrate the actuality of non-using of the trademark in question or not. If the evidence produced by the petitioner cannot demonstrate that the registered trademark has not been completely used in commerce with the entire list of goods or services as registered or it cannot be proved that the trademark owner has no intention to use it whatsoever, the cancellation shall not prevail.

Contrary to the procedure for considering the opposition if the applicant of the alleged trademark does not submit the argument against the opposition within 90 days from the date of receiving the copy of opposition, it shall be deemed that the applicant has abandoned the application according to Section 36.²⁵⁴ This requirement imposes the applicant to rebut the allegations made by the opponent, and ensure that he or she still desires to acquire the trademark registration, with good faith and definite intention to use it. In other words, if the applicant has no intention to use it or has filed the application in bad faith, it might not be worth it for him to continue the registration. However, it is fair to say that if the applicant has a genuine desire to use the trademark in commerce, or in case they have been using it already, the applicant should comply with the requirement to file a counterstatement, otherwise the application will be deemed abandoned.

²⁵² *Supra* note 67. Page 748.

²⁵³ *Supra* note 242. Page 38. (Referring to Regulation of Board of Trademark on Procedure of Appeal and Cancellation Petition B.E. 2545 Clause 29).

²⁵⁴ Trademark Act B.E. 2534 (1991)

4.2.3.1 Appealing the Board's order with IPIT Court

Pursue to Section 65²⁵⁵, after the Board has considered the opposition and the relevant evidences, based on either the ex parte proceeding or in case of countering by the counterstatement of the applicant, the Board will issue a decision, whether or not to cancel or not to cancel the alleged non-used trademark, to inform the concerning parties. In case, the Board has considered that the non-use cancellation petition has proved the reliable ground for non-use, the Board will issue an order to revoke the trademark registration. While the Board has considered that the petitioner cannot provide the satisfied evidences establishing a ground for non-using of registered trademark, the Board will issue an order not to cancel the registration of such trademark in question and dismiss the cancellation petition.²⁵⁶

A party, who has not been satisfied with the outcome and been affected by the Board's order, either a petitioner, the trademark owner, or the licensee, may appeal such order with the first instance court, The Central Intellectual Property and International Trade Court ("IPIT"), within ninety days as from the date of receiving the copy of notification of such order, in according with Section 65 second paragraph.²⁵⁷ Nevertheless, if there is no appeal filed against the Board's order, within the prescribed period of ninety days, the order of the Board shall be deemed as final.²⁵⁸

According to the Author's research, as well as the article written by another author²⁵⁹, the non-use cancellation has never been an issue that brought against the Board's order, whether an alleged trademark has been used or not, at the stage of court procedure. Notwithstanding, there are some cases of Supreme Court's judgments that dealing with other issues raised concerning the proceeding.

²⁵⁵ Trademark Act B.E. 2534 (1991) Section 65.

²⁵⁶ *Supra* note 242. Page 38. (Referring to Regulation of Board of Trademark on Procedure of Appeal and Cancellation Petition B.E. 2545 Clause 30).

²⁵⁷ Trademark Act B.E. 2534 (1991) Section 65.

²⁵⁸ *Id.*

²⁵⁹ *Supra* note 67. Page 749.

The question of an issue that 'who should be sued' had been taken into account. As ruled by the Supreme court's judgment²⁶⁰, the person whom the appeal should file against is the Board of Trademark. The reason of the supreme court's judgment is that because the Board is the one who made the order, that affects to a party's rights, to cancel or not cancel the trademark registration. Therefore, the plaintiff that requests revoking such order should be filed against the person whom the order was made by. In case, the plaintiff is the trademark owner or licensee whose the rights in trademark was cancelled, the plaintiff does not need to file a lawsuit against the petitioner who filed a petition for non-use cancellation at the stage of Board of trademark's determination.²⁶¹ On the contrary, in case the plaintiff is the petitioner who was not satisfied with the Board's order that not to cancel the trademark registration as claimed, it is not necessary for the plaintiff to file a lawsuit against the trademark owner.²⁶²

Another issue, even as per the provision Section 63 has stipulated that the person who may file a non-use cancellation can be either 'an interested person' or the Registrar. The Supreme court has ruled in a judgment²⁶³ that

²⁶⁰ Supreme Court Judgment no. 2880/2551

"In consideration of appealing the Board's order with the court in accordance with Section 65 of Trademark Act B.E. 2534, although the law does not stipulate 'whom should the appeal be filed against as the defendant of the case', but the person who issues the order to cancel the plaintiff's trademark registration was the Board of Trademark. When the plaintiff has requested the court to revoke Board of Trademark's order, which was an administrative request, the plaintiff therefore must file a lawsuit against Board of Trademark. In this case, the plaintiff, which was made by the trademark owner, was not filed against the Board of Trademark, but sued against the petitioner as the defendant, is not accurate."

²⁶¹ *Id.*

²⁶² Supreme Court Judgment no. 2500/2548

"In case of filing lawsuit requesting the revocation of Board's order in virtue of Section 65 paragraph two and Section 61 of Trademark Act B.E. 2534, there is no necessity to file such lawsuit against the trademark owner (meeting no. 11/2004)"

²⁶³ Supreme Court Judgment no. 1041/2522

"Requesting a cancellation against registration based on Section 42, that the registration was not for the intention to use it in good faith as a trademark, must be made due to the rebutting of rights and the petition must be made as a plaintiff."

In this case, the plaintiff has described the plaintiff that the defendant has no bona fide intention to use a trademark as registered, which is a plaintiff made in virtue

the plaintiff must be made based on the fact of rebutting of rights. The plaintiff must be challenged or affected by the defendant's trademark registration i.e. the plaintiff would like to register a trademark but was rejected due to the obstacle of the prior registration of the defendant that may not have been put in genuine use. In case, the plaintiff has described the plaintiff that his trademark is not similar to the defendant's trademark, which would not cause any confusion or mislead, the plaintiff would have been in considering that he has no standing rights or power to sue the defendant due to the his rights has not been refused.

4.2.4 Burden of Proof for Non-Using of Registered Trademark

The consideration of the Board of Trademark in Thailand has been in accordance with the Supreme Court's Judgment based on the concept of the burden of proof in the accusatorial system that *the person who asserts the matter must prove it*," where the precedent held by the Supreme Court.²⁶⁴ Therefore, pursuant to Thai Trademark law and the practical proceedings in accordance with the Supreme Court's Judgment, either an interested person or registrar, who requested for the cancellation of a trademark registration based on the ground of non-using, must bear the burden.

In addition, the petitioner must not only prove the actuality of non-using of the trademark in commerce, but, according to Section 63, the law imposes the word '*and*' to stipulate that the petitioner is also required to prove the intention in mind that the trademark owner has no bona fide intention to commercially use the registered trademark whatsoever.²⁶⁵ Only once the petitioner can clearly demonstrate that the registered trademark owner has no bona fide intention and no actual use of trademark in commerce was found, the burden of proof will be later bound by the

of Section 42, there must be a rebutting of rights. In other words, the plaintiff must have the intention to use the trademark in the same or similar form in which the defendant has registered, but the plaintiff described in the plaintiff that his trademark is not identical with or similar to the defendant's trademark as registered. Therefore, the defendant did not challenge or cause an effect to the rights of the plaintiff. The plaintiff has no standing rights or power to sue this case according to Section 42."

²⁶⁴ Supreme Court Judgment no. 7774/2540

²⁶⁵ Trademark Act B.E. 2534 (1991) Section 63.

trademark owner to rebut such allegations. Only then will the trademark owner have to argue if such non-use was unintentionally happened due to special circumstances in the trade and the trademark owner has no intention to abandon such registered trademark.

However, proving the intention of the trademark owner or the actual of non-use of the registered trademark is quite difficult in Thailand since the Board of Trademark has settled on the decision that once the trademark is registered, it is presumed that the trademark owner has the intention to use said trademark.²⁶⁶

4.3 Problems on Non-Use Cancellation in Thailand

According to Section 63 in regard to the regulation of trademark protection in Thailand, it appears that there are some problems with the practical proceedings in case of non-use cancellation. This leads to difficulties of overcoming the requirement of proof which affects the rights of later trademark owners as well as decelerate of economic investments.

From the Author's perspective, the problems of non-use cancellation proceeding in Thailand that need to be considered are as follows:

- 1) No Requirement for Genuine Use of Trademark;
- 2) Burden of Proof for Non-Using of Registered Trademark;
- 3) High Standard of Proof required by the Board of Trademark;
- 4) Requirement of Proof for Non-Using on Every Items of Goods or Services under Registration.

²⁶⁶ Dana Bergling and Vipa Cheunjaipanich, Thai System Shows How Hard Cancellation Of A Registered Trademark Really Is!, 2001. <http://mondaq.com/x/13406/Thai+System+Shows+How+Hard+Cancellation+Of+A+Registered+Trademark+Really+Is> (accessed on December 9, 2015).

4.3.1 No Requirement for Genuine Use of Trademark

As the facts that there is no requirement for genuine use of trademark in Thailand, whether at the time of filing and even after obtaining registration and renewal. It is to say that Thai Trademark Act and its legal proceeding do not require a registrant to use the trademark and submit the evidences of such use of the trademark at any time. However, according to the Board of Trademark's decision, the law has presumed that the registrant has used the trademark or has real intention to use its trademark since the time of filing the application.²⁶⁷ But, without the requirement to force the trademark owner to provide the evidence showing use, how the law can be assured of such use of trademark.

The requirement for genuine use of trademark can be a process that force the registrant to utilize the given protection by using the registered trademark in course of trade. Without this requirement, the registrant may not be afraid of losing its rights of protection. As per Section 44²⁶⁸, the owner of the registered trademark will have exclusive rights as the legal protection to be the only who can use the trademark with the registered goods, even if they do not actually use or have no intention of using the trademark in commerce. The act of non-using may be considered doing it as an act of defensive registration that has been set as a barrier and cause a monopoly right to the registrant to prevent later applicant to use or register the same or similar trademark.

Concerning to the benefit for non-use cancellation, this requirement for genuine use can be a tool for the petitioner to find a reliable evidence and ensure whether the trademark in question has been genuinely used or not, before filing a petition. For example, in the US, a petitioner bears a burden to prove only a prima facie evidence showing that the registrant has abandoned the trademark. Therefore, as the requirement for genuine use, if the registrant fails to provide any proof of use of the registered trademark when the time request, this failure of ability to provide the

²⁶⁷ *Id.*

²⁶⁸ Trademark Act B.E. 2534 (1991) Section 44

proof of use could be an important evidence allowing any third person, who would like to begin the cancellation, to demonstrate the abandonment or discontinuing use of such trademark, which constitutes the ground for non-use cancellation in the US. On the other hand, if the registrant has provided the proof of use as required, this could rescue his protection from the challenging cancellation.

4.3.2 Burden of Proof for Non-Using of Registered Trademark

According to Supreme Court's Judgment no. 7774/2540²⁶⁹, the Judge rules that:

*"...The Defendant has registered that trademark in question. It must be considered that the Defendant is an owner having rights to use such trademark for goods in particular classification which registered. Therefore, when the Plaintiff claimed that the Defendant has not used trademark in question been registered, in which causing a ground for cancellation against such Defendant's trademark registration, **the Plaintiff who claimed such allegation is obliged to attest evidences that Defendant has not used such registered trademark as alleged.** Although, it is an attest in term of negative fact, the obligation of proving is bear by the Plaintiff to prove such allegation."*

In the above Supreme Court's Judgment, the Judge clearly stated that the burden of proof for non-using of registered trademarks lies on the petition who files a cancellation. The reason of this judgment was because the petitioner is the one who initially alleged that trademark in question has not been used²⁷⁰, which goes against other's legitimate rights. Consequently, the petitioner should bear the burden of proof for the truth of its allegation.²⁷¹

²⁶⁹ Supreme Court Judgment no. 7774/2540

²⁷⁰ *Supra* note 242. Page 39.

²⁷¹ *Id.*

For these circumstances, the petitioner is obliged to produce the evidence of non-using that caused by others. They must provide not only the proof that the trademark owner has not used the registered trademark in commerce, but also must prove that the owner has no intention to use such trademark as well.²⁷² However, as the facts and information whether the trademark in question is used or the owner intends to use it or not is subject to the proprietor of trademark. As stated in prior item 4.3.1, Thailand does not require a registrant to submit any proof of use of trademark. It is presumed that the registrant has used or has intention to use its trademark in order to acquire the protection by filing application. Seeking for the evidences to rebut such presumptions, the petition must provide evidences of non-existence of use or prove that the trademark owner has no intention to use it whatsoever. It can be very difficult to prove the facts in such negative way.

Furthermore, as provided in last sentence of Section 63²⁷³ which states that:

"...the owner can prove that such non-use was due to special circumstances in the trade and not to an intention not to use or to abandon the trademark for the goods for which it was registered."

According to the non-use cancellation proceeding in Thailand, after receiving non-use cancellation petition, the Board must notify to the owner of alleged trademark to submit the explanation within 60 days from the date of receiving said notification.²⁷⁴ It reveals that the Trademark Act gives an opportunity to the owner of trademark registration to invalidate the allegation for non-use brought by the petitioner. The reason of non-using can be due to a special circumstances in trade, and not because there is no intention to use or abandon the trademark that was registered.

²⁷² *Supra* note 67. Page 747-748.

²⁷³ Trademark Act B.E. 2534 (1991) Section 63

²⁷⁴ *Id.* Referring Trademark Act B.E. 2534 (1991) Section 64.

Nevertheless, it is not a compulsory request for the owner to response to the notification. If a response is not filed, the Board of Trademark will unilaterally consider the petition and the supporting evidences and issue the decision based on *ex parte* proceeding.²⁷⁵ This proceeding differs from the requirement in some countries i.e. the US and the People's republic of China. In those countries, if a response to a non-use cancellation is not filed, the logical deduction, in sense of business operation, that would opine that the holder of the registered trademark either: a) no longer wishes to continue utilizing the trademark, b) no longer in business, or c) no longer is alive.²⁷⁶

As the process of non-use cancellation in Thailand does not strictly require the owner to response to the cancellation notification, it is to say that the Board allows for the perpetuation of unused trademarks.²⁷⁷ This is contrary to the nature of trademark protection that even though the registrant of a trademark does not care enough to reply to the notification of cancellation in order to argue on such allegation of non-use and prevent from losing his own registration, but the Board assumes, in favor of the registrant, that the registrant still has intention to use the registered trademark²⁷⁸, regardless of the facts to support such presumption.

In other words, even not explicitly said by the Board of Trademark, it seems that the burden, that ought to be bound by the registrant of alleged trademark to prove the reasonable cause of non-use, is really not his burden at all.²⁷⁹ The burdens, either to prove the actuality of non-using and lack of the intention by the registrant to use trademark, all rest on the petitioner's shoulders.²⁸⁰ It is nearly impossible for the petitioner to prove the intention in mind of the owner that has no intention. In addition, to seek for the evidences to support that the trademark owner has no

²⁷⁵ *Supra* note 242. Page 38. (Referring to Regulation of Board of Trademark on Procedure of Appeal and Cancellation Petition B.E. 2545 Clause 29).

²⁷⁶ *Supra* note 266.

²⁷⁷ *Id.*

²⁷⁸ *Id.*

²⁷⁹ *Supra* note 99. Page 495.

²⁸⁰ *Id.*

intention to use the trademark is also almost impossible for the petitioner. Any proof in which is produced by the petitioner will always be refused by the trademark owner and be rejected by the Board of Trademark since it is not enough to demonstrate that the trademark owner has no bona fide intention to use its trademark whatsoever with the goods or services as registered or prove that it has, in facts, never been used in commerce.²⁸¹

The provision of non-use cancellation in Section 63 and the Supreme Court Judgment²⁸² have placed too much burden to the petitioner regardless of the facts that the petitioner has no access to the information of use and intention in mind of the owner of alleged trademark. These burdens of proof may not be the appropriate method for this kind of cancellation and may not serve the rights of later trademark owner whose rights are rejected due to such prior registered trademark.

4.3.3 High Standard of Proof Required by the Board of Trademark

Under Section 63 of Thai Trademark Act, it is clearly stated that:

"Any interested person or the Registrar may petition the Board to cancel a trademark registration if it is proved that..."²⁸³.

The phrase *"if it is proved that"* shows the requirement of proof as to the non-use of registered trademarks in Thailand which requires a petitioner who files a cancellation request to prove the actual non-use of the registered trademark. A petitioner must produce concrete evidence to demonstrate, without doubt, that the owner of the registered trademark never uses nor has the intention to use this trademark for 3 consecutive years prior to the date of filing the cancellation request.

In addition, the Board of Trademark, as the authority whom that cancellation action must be filed with, at the stage of first commencement of filing a

²⁸¹ *Supra* note 242. Page 39-41.

²⁸² Supreme Court Judgment no. 7774/2540

²⁸³ Trademark Act B.E. 2534 (1991) Section 63

non-use cancellation, has decided in many precedents and directed the trends for its consideration showing high standard of proof which requires the petitioner to present the absolute of non-use of trademark before rendering its decision to cancel. This high standard of proof also was explained by a Thai attorney as follows:

*"The petitioner's burden of proof is much more onerous in Thailand than it is in other jurisdictions. The Board [of Trademarks, an administrative tribunal of the Department of Intellectual Property] seems to be motivated to protect the rights of the owner of the registered mark and ensure absolute non-use before rendering its decision to cancel the mark. Therefore, the Board requires extensive evidence to prove nonuse and is willing to consider broad special circumstances justifying the non-use."*²⁸⁴

As the burden of proof lies on the petitioner, it is nearly impossible for the petitioner to produce concrete evidence for such actual non-use of trademarks. Because the petitioner does not have access to the information or the facts on whether or not the trademark owner has put the trademark in the market or has use it anywhere. Most of the evidences that the petitioner can provide to prove such non-using come from results for conducting survey i.e. internet search showing no selling or marketing of goods or services under such particular registered trademark of the owner²⁸⁵, survey on market place such as department stores where such kind of goods or services should be selling²⁸⁶, survey on customer's recognition whether group of customers knows and recognize this trademark on products selling and services²⁸⁷.

²⁸⁴ *Supra* note 99. Page 494. (Referring to E-mail from Threenuch Chatmahasuwan, Tilleke & Gibbins International Ltd., to author (September 15, 2008).)

²⁸⁵ Order of Trademark Board no. 2/2552

²⁸⁶ Order of Trademark Board no. 3/2552

²⁸⁷ Order of Trademark Board no. 15/2552 and Order of Trademark Board no. 31/2552

According to the precedent decisions of the Board of Trademark, the Board usually requires excessive evidences of non-use from petitioner.²⁸⁸ Therefore, the Board mostly claims in their verdicts that the evidences produced by the petition are not sufficient and cannot prove actuality of non-using of the trademark on the registered goods and services of trademark owner, without the need to consider the registrant's rebutting evidences.²⁸⁹ For examples, the result of conducting survey on internet search, market place or customer's recognition, which is conduct within a time period or certain areas²⁹⁰, may not be able to prove that the owner of the registered trademark has no intention to use of trademark or, in fact, that there is no actual use of this trademark in good faith in any other area or at all time. Therefore, taking into account of the precedents issued by the Board of Trademark, the non-use cancellation petitions in Thailand are mostly rejected due to there is no sufficient evidences provided to demonstrate the actuality of non-using.

In addition, even if the petitioner can produce the evidences showing that the owner of trademark, in case registered under juristic person, had completely dissolved and liquidated a company's account by submitting the company affidavit indicating the date of dissolution and liquidation, but the Board of Trademark's verdict is that it is not sufficient to prove that the owner of registered trademark has no intention to use or in fact have never used the trademark in good faith for such registered goods. Therefore, there is no cause to cancel the registration of trademark's owner.²⁹¹

According to the Supreme Court Judgment no. 4006/2533²⁹², the Judge ruled that:

"...use of the mark even for a short period of time and in relation to a small number of products still constitutes use."

²⁸⁸ *Supra* note 238.

²⁸⁹ *Id.*

²⁹⁰ Order of Trademark Board no. 1/2552

²⁹¹ Order of Trademark Board no. 32-36/2552

²⁹² Supreme Court Judgment no. 4006/2533

Referring to the Supreme Court Judgment, the rights of owner of registered trademark are protected without the requirement forcing the owner to use the trademark at all time or with the large amount of numbers. Only used with a short period of time and small quantity, in form of test marketing, clinical trials, or in relation to free promotional goods, can at least show the intention to use²⁹³ and is considered appropriate as use of the trademark. Once the trademark is proved to be used as mentioned, trademark registration will be precluded from revocation.

The petitioner is obliged to prove that there is no use of trademark, which is considered as proving of negative fact.²⁹⁴ Therefore, the possibility to prove and produce the evidences showing the fact of non-use of trademark is seldom successful.

Nevertheless, in rare cases, the Board of Trademark's verdict to cancel the registration of trademark happens only on cases that goods or services under protection are required to be permitted to produce, sell, or allowed to operate by the government agencies.²⁹⁵ For examples, medication products need to be registered with Bureau of Drug Control for authentic medicinal registration before produce or import to sell within territory of Thailand.²⁹⁶ If it is proved to the Board that the medication products under registered trademark have not been registered with drug registration, the Board will cancel the trademark registration. Furthermore, in case of operating a hotel business, which prohibits operating unless receiving a license from Registrar.²⁹⁷ If the petitioner can provide the evidence to the Board that the owner of service mark registration has not been licensed by the Registrar to operate such hotel business, therefore, the Board will then cancel such service mark's registration since the Board is convinced that the owner does not use the service mark as applied and registered.

²⁹³ *Supra* note 238.

²⁹⁴ *Supra* note 242. Page 39.

²⁹⁵ *Id.* Page 41.

²⁹⁶ *Id.* Referring to Drug Act B.E. 2510 (1967) Section 79

²⁹⁷ *Id.*

In summary, in accordance with the Section 63 of Trademark Act B.E. 2534 (1991), the legitimate clause "*if it is proved that*" gives such strict requirements for concrete evidence needed to be provided. It is difficult for the petitioner, who has burden to prove the facts of non-use trademark in term of negative way, to overcome this high standard of proof.²⁹⁸ This principle therefore may be considered as an obstacle for the investments and free trade²⁹⁹ and not justified for later trademark owners who actually uses trademark in commerce, but are refused for registration because of the prior registered non-use trademark.

4.3.4 Requirement of Proof for Non-Using on Every Items of Goods/Services under Registration

Under Section 44³⁰⁰, the right of trademark owner who registered its trademark is an exclusive rights to use the trademark with goods as registered and prevent others from using the same trademark in the same market. In addition, in virtue of Section 13³⁰¹, this protection extends to cover those trademarks that are considered as containing similar characters even they fall under different classes. Therefore, sometimes, the registrar has refused a later trademark application that applies for different classes if finds that it may cause confusion or mislead to the public and consumers, due to the goods or services could be sold in related market. The refusals by the registrar pertaining to this matter of what are considered as related goods have been frequently argued by the affected party i.e. in term of filing appeal with Board of Trademark against the registrar's order in relation to refusal based on section 13.

In the business world, there are several different lines of business that may happen to use the same or similar trademarks. Taken into account of good advertisement and different channel of distributions, the public and consumers can

²⁹⁸ *Id.*

²⁹⁹ *Id.*

³⁰⁰ Trademark Act B.E. 2534 (1991) Section 44.

³⁰¹ Trademark Act B.E. 2534 (1991) Section 13.

easily distinguish the owners and producers of the goods sold in the market, without confusion. Therefore, the goods or services that fall under same or different classifications, which are defined as related goods or services according to registrar's determination, may be different in nature, purpose of use, and channel of distribution that, in fact, could not cause the confusion or mislead to the public and consumers. Thus, in some countries, the co-existence, as well as the partial cancellation, of trademark registrations are acceptable due to this reason.

In the matter of facts, sometimes, the petitioner who may be a later trademark applicant only desires to use a similar mark with some similar designated goods or services, but not all the goods and services are in the same course of business. The petitioner may recognize whether there is the use of trademark only in the same course of business that sharing the same market. Therefore, it is possible that the petitioner can prove of non-using of registered trademark for the goods that in the same course of business for which the petitioner wishes to register.

However, under Section 63 of Thai Trademark Act, the law has stipulated the requirement of proof for non-using trademark on every items of goods or services under registration. The interpretation comes from the phrase "*with the goods which it was registered*", which demonstrates that Thailand does not allow partial cancellation.³⁰² In practice, the Board of Trademark requires a petitioner to prove not only a particular good or service that is considered similar to and in conflict with the petitioner's operation, but also for non-using of every item of goods or services that fall under the protection of trademark registration. Therefore, even though the petitioner is able to prove the non-use of one item, but not all as registered, the Board will not cancel such trademark registration and will hold that it is insufficient to prove the owner of the registered trademark has no intention to use or, in fact, have never used the trademark in good faith for such other registered goods.

³⁰² *Supra* note 238.

As a result of this requirement, it is considered that the use in relation to some of the goods is enough for the registrant to maintain the entire registration.³⁰³

In case, an applicant files a trademark application containing large amount of numbers of goods or services, it will be almost impossible for the petitioner to provide the evidences for such negative use of all the goods and services.

4.4 Proposed Alternative Solutions for Non-Use Cancellation in Thailand

As per the problems of non-use cancellation in Thailand stated above, the Author would like to provide the following suggestions by comparing with the non-use cancellation proceeding under other foreign laws and encouraging Thai Trademark Law to adopt some of the legal measures for solutions to the problems in practical of non-use cancellation in Thailand.

4.4.1 Implement the Requirement for Genuine Use of Trademark

As the problem in item 1, Thailand has no requirement for genuine use of trademark that force the registrant to actually use and provide the evidences of use in commerce to support the registration at the time of filing as well as after receiving registration. For this reason, the registrant may not be aware of using trademark in the course of trade.

This Author would like to suggest that Thailand should adopt the requirements for genuine use of trademark as stipulated in some countries to enforce the registrant to provide substantive evidences of proving use of their trademark in order to obtain and maintain registration. Especially, after receiving registration, the Law should enforce to the trademark owner in urging the actual use of trademark in commerce. Therefore, the suggestion would be provided on three steps of trademark registration as follows:

³⁰³ *Id.*

4.4.1.1 Requirement for use or intention to use at time of filing trademark application

Even though Thailand is a First-to-File country that does not require the use of trademark at the time of filing application, it is recommended that there should be a regulation for the applicant to declare that the mark has been used in course of trade or the applicant has a bona fide intention to use trademark in future. Like, the United States of America³⁰⁴, Canada and Singapore³⁰⁵, the statement of use or intention to use must be stated in the application form. Although the declaration that comprises of only the intention to use a mark in future will not be an enforceable guarantee that the trademark owner will do as they have declared. However, in the legal sense, the trademark owner will be aware that they will have to use a trademark once they sign the statement of declaration and indicate the intention to use in the application. Therefore, this requirement may be a tool for notice of awareness to the trademark owner.

³⁰⁴ US Trademark Law. § 1 (15 U.S.C. § 1051).

"Application for registration; verification

(2) *The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.*

(3) *The statement shall be verified by the applicant and specify that—*

(C) the mark is in use in commerce; and "

³⁰⁵ Singapore Trademark Act as amended by Act no.3 of 2007. Section 5 (2) (e)

"Application for registration of trade mark

5. Application for registration

(2) *The application shall*

(e) state —

(i) that the trade mark is being used in the course of trade, by the applicant or with his consent, in relation to those goods or services; or

(ii) that the applicant has a bona fide intention that the trade mark should be so used. state that the trade mark is being used in the course of trade, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used."

4.4.1.2 Requirement for genuine use before obtaining Certificate of trademark registration

Like the United States of America and Canada, if the applicant indicated in the application that the trademark was not used at the time of filing the application, but intended to use it afterwards, there must be a requirement for the applicant to submit the statement of use demonstrating that the trademark as applied has been genuinely used in course of trade during the time after applied for a registration in order for the Trademark Office to grant the Certificate of Trademark Registration. This proceeding will ensure that the Trademark Office will issue the Certificate of Registration and will grant legal protection to the applicant only if the trademark has been in used during trade. Therefore, if Thailand adopts this requirement to the Thai Trademark practice, it will help decreasing the numbers of defensive trademark registration or so called "ghost registration" of the trademark in which the owner has no intention to use it.

4.4.1.3 Requirement for genuine use after obtaining Certificate in order to maintain the registration

Like the Philippines, the applicant or the registrant in case a trademark has been registered is obligated to use the trademark within 3 years as from the date of filing application. The Trademark Office will require a declaration of actual use from the applicant or registrant with the evidence showing use. This process will force the trademark owner to actually use the trademark in commerce as soon as within 3 years period. If the registrant fails to use or fails to submit the evidences within prescribed period, the application that still in process will be refused or in case the trademark is registered, the registration will be revoked and the mark shall be removed from the Registry records.

Likewise, the requirement for declaration of actual use at fifth anniversary after registration, the registrant must provide the evidences showing use of registered trademark in commerce. If the Registrant fails to do so without the

valid reason, the Philippines Trademark Office shall remove the mark from the Registry.

According to these requirements, it is compulsory for the trademark owner who has intention to file a trademark application for the protection to be aware of using the trademark, especially within the stipulated time. This process is very useful for the Registry to determine that which trademark is used and which one is not. If the applied trademark or registered trademark is not used, the Registry will immediately clean such trademark from the system, which make the Registry records uncluttered and benefit to reduce the obstacle for the later trademark owner.

If Thailand could adopt this requirement to the Thai Trademark practice, it will usefully help decreasing the numbers of unused trademark from the Registry records. In addition, non-submitted declaration of actual use could be tangible evidence in non-use cancellation process to prove that the trademark owner has not used the registered trademark and has no intention to use it by not reply to the requirement of law. Therefore, in Author's opinion, the requirement for genuine use in the step of after obtaining registration could be helpful as a proof for non-use registered trademark and facilitate the cancellation proceeding in Thailand.

4.4.1.4 Requirement for genuine use at time of renewal

Regarding to the previous Board of Trademark's decision, if the trademark registration had been renewed by the registrant, the Board would have held that the renewal of registration is sufficient to consider that the registrant has no intention to abandon the mark.³⁰⁶ However, it cannot be proved that the trademark is actually being used. In Author's view, after 10 years of registration, it should not allow the trademark owner to show only the intention to use or no intention to abandon. The period of 10 years is very long period for the business to be operating in trade, without any excuse of any special circumstance. Therefore, the trademark

³⁰⁶ *Supra* note 238. (Referring to Order of Trademark Board no. 43/2540)

owner should be able to provide the evidences of using of trademark to support. The trademark who have registered for period of 10 years, but is unable to submit the evidences of use, it should be presumed that the mark has not been in genuinely used and the registration is a defensive registration, which should not allow being renewed the protection.

Therefore, if Thailand could adopt the requirement of genuine use at the time of renewal, it could benefit to the Trademark Registry to keep following up whether the trademark that granted protection has been valuable for the economy as well as to be ensured that the renewal of protection will be worth. In addition, it is also benefit to the non-use cancellation process as non-submitted evidence of use at the time of renewal could be a tangible evidence to show that the trademark is not or no longer used in course of trade, therefore, the Registry should cancel the registration of unused trademark and allow the later trademark application to be registered instead for balancing limited sources.

4.4.2 Shifting Burden of Proof for Non-Using of Trademark to Registered Owner

As stated in item 4.2.2 as the problem of non-use cancellation procedure in Thailand, the burden of proof for non-using trademark is obligated by the petitioner who has no access to the facts and information whether the trademark in question is used or not. In addition, the standard of proof for non-use cancellation in Thailand is very high. The petitioner is not only required to prove solely the actuality of non-use of trademark in commerce, but also required to prove that the owner has no intention to use such trademark as well. Therefore, it is impossible for the petitioner to prove the intention in mind of the owner as well as to seek for reliable evidences to demonstrate such negative intention. In case, the petitioner cannot seek any reliable evidence to support the allegation, it is not a certain fact that the trademark is deemed to be used in course of trade, including it cannot guarantee that the trademark owner is presumed to have the intention to use it.

Unlike the United Kingdom, Japan and the People's Republic of China, the burden of proof lies on the trademark owner who has fully access to the information whether the trademark is actually used or not as well as the intention in mind of the trademark owner and their proper reason that causing legal justification of non-use. Therefore, if the trademark owners cannot prove the use of trademark even if they must have the evidences in hands, nor cannot provide any proper cause justifying to the reason of non-using of trademark, it is believable that the trademark owner has neither actual use nor intention to use such registered trademark. If it was otherwise, the trademark owner would have provided such evidences in order to maintain its registration protection.

Therefore, it is highly recommended to shift the burden of proving for non-using of trademark in dispute from the petitioner to the owner of registered trademark in order to facilitate the non-use cancellation and to ensure that the decision of Board will not be over-presumption for the benefit of the trademark owner.

The question is, according to Thai law system, whether it is possible or not to shift the burden of proof from the person who asserts the allegation to the person whom the allegation is filed against. By virtue of Section 84/1 of Civil Procedure Code of Thailand stated the provision regarding the burden of proof in the civil action as follows:

"Section 84/1

A party who asserts a disputed fact to the supporting of its pleading must bear the burden of proof of that fact. In case, there is a presumption prescribed by law or a presumption that ought to be happened in ordinary course of event which is the advantageous to one party, such party shall prove only that he or she has completely complied with the conditions which are beneficial to it."

According to the provision in the Civil Procedure Code of Thailand, it stipulates the concept of burden of proof in Thailand as the accusatorial system that *"the person who asserts the matter must prove it."* This accusatorial procedure is also

correspondent to the Supreme Court's Judgment no. 7774/2540³⁰⁷ regarding the trademark case based on non-use allegation that *"the Plaintiff who claimed such allegation is obliged to attest evidences that Defendant has not used such registered trademark as alleged."*

However, Section 84/1 of Civil Procedure Code of Thailand also provides the exceptions that a party who asserts a disputed fact does not have to bear the burden of proof. The two exceptions to this Section are so called '*legal presumption*' and '*factual presumption*'.

Legal presumption is a presumption stipulated by law which is an advantage to one party. For example, a tort case in which damage caused by motor vehicle, Section 437³⁰⁸ of Civil and Commercial Code of Thailand. The law presumes that a person who has such motor vehicle in his possession or control is responsible for the damage or injured caused by it, unless that person can prove otherwise i.e. damages occurred from *force majeure* or fault of the injured persons themselves, etc. When a party who asserts a disputed fact obtains the benefit of a presumption by law, the burden of proof is shifted to the other side to produce the evidences to rebut this presumption.³⁰⁹

³⁰⁷ Supreme Court Judgment no. 7774/2540

"Given the Defendant has already registered the trademark, it shall be deemed that the Defendant is the owner of the mark and entitled to apply such mark to the class of products already registered. Since the Plaintiff claims that the Defendant has never used the trademark in dispute which is the cause to cancel the Defendant's trademark registration, it is the duty of the Plaintiff as the accuser to prove that the Defendant does not use the registered mark as per the complaint. This burden of proof still belongs to the Plaintiff even if it is in term of proving the negative facts"

³⁰⁸ Section 437 of Civil and Commercial Code of Thailand

"A person is responsible for injury caused by any conveyance propelled by mechanism which is in his possession or control; unless he proves that the injury results from force majeure or fault of the injured person. The same applies to the person who has in his possession things dangerous by nature of destination or on account of their mechanical action."

³⁰⁹ ธาณี สิงหนาท. คำอธิบาย พยานหลักฐานคดีแพ่งและคดีอาญา. บริษัท กรุงสยาม พับลิชชิ่ง จำกัด. พิมพ์ครั้งที่ 9 พ.ศ. 2554 (Thanee Singhanat. Explanation on Evidences in Civil case and Criminal case. Krung Siam Publishing Co., Ltd. (9th Edition, 2011.))

Factual Presumption is a presumption relies on the facts that ought to be happened in ordinary course of event. This is on the basis on Roman idiom that '*Res ipsa loquitur*' or the principle of 'thing speaks for itself'. This principle always used to apply in tort on negligence as in civil case, not criminal case. For example, an injured party, plaintiff, who is affected from a negligence of the defendant. Normally, the plaintiff as a person who asserts the disputed fact must bear the burden of proof in the case. However, it is harder for the plaintiff to prove that, at the time of this case; the defendant was negligently act and intentionally caused damage to the plaintiff. Therefore, in such circumstance, the facts should be happened in ordinary course of event that the defendant was negligently acted otherwise the damage would not have occurred. Therefore, the plaintiff should have the benefit of such presumption according to the facts occurred and the burden of proof for non-negligence action should be shifted to the defendant.

The principle '*Res ipsa loquitur*' or 'thing speaks for itself' could not be more clearly explained other than the Supreme Court Judgment no. 292/2542³¹⁰ as the facts that in the event the plaintiff as a patient was not satisfied with the result of the plastic surgery that performed by the defendant. The plaintiff filed a lawsuit against the doctor on negligence. In this case, there is no legal presumption that could be beneficial to the plaintiff. Therefore, the plaintiff has the burden of proof to produce the evidences to the court how the doctor was negligently acted. However, the court considered on how difficult the plaintiff could prove that the doctor, as a defendant, was negligent because the act was in the closed room. There is a denial by the defendant that he did not act against the ordinary course of event. Therefore, the court ruled that the defendant has the burden of proof.

According to the exceptions of Section 84/1 of Civil Procedure Code regarding the factual presumption and principle of '*Res ipsa loquitur*' or 'thing speaks for itself', it seems to be appropriate to adopt this exception to shift the burden of proving for non-using of trademark in dispute from the petitioner to the owner of

³¹⁰ Supreme Court Judgment no. 292/2542

registered trademark in case of non-use cancellation in trademark law. Comparing to Supreme Court Judgment no. 292/2542³¹¹, the plaintiff who was a patient had no specific knowledge of medical treatment and surgery as well as could not access to the facts and information of the doctor's normal practice. Moreover, the plaintiff was not able to prove the negligence of the doctor due to the intention in mind and the act that he or she could not know what happened. Therefore, the doctor who denied the action that caused from an ordinary course of event shall bear the burden of proof.

Like in case of non-use cancellation in trademark law, the petitioner must bear the burden to prove the actual of non-using of trademark, notwithstanding that petitioner has no knowledge of use of the mark in specific type of business. The petitioner also has no ability to access to the facts and information whether the registered trademark has been use or not, in which all the evidences must be in the possession of the trademark owner. Furthermore, it is very hard to prove the intention in mind that the registered trademark owner has intention to use or not use the trademark at all. Resulting from these comparisons, the petitioner to non-use cancellation case seems to have the same duties to prove the facts like a lawsuit against the doctor on negligence. Therefore, the burden of proof in non-use cancellation case should be treated the same as Section 84/1 of Civil Procedure Code, in which the burden of proof can be shifted to the other side, a registered trademark owner, to produce the evidences showing use of trademark instead.

However, in some countries i.e. the United States of America, the petitioner bears only the *prima facie* to show the abandonment of trademark or preliminary cause of non-using. Then, the burden of proof will be shifted to the trademark owner to produce the evidences rebutting that the trademark has been in genuinely used or there is any special circumstances for the proper reason why the trademark cannot be used.

³¹¹ *Id.*

Therefore, if, under Thai Trademark Law, cannot shift the burden of proof to the trademark owner at the beginning of non-use cancellation process, at least, the petitioner should bear only a prima facie evidences or preliminary cause of non-using, then the burden of proof should be shifted to the trademark owner to rebut the cancellation.

Moreover, due to the non-compulsory requirement for the trademark owner to file a response to the non-use cancellation action to prove the justified reason of non-using, the Board solely decides the case based on the evidences provided by the petitioner. The petitioner then has more burdens to prove, not only the actuality of non-using but also the reason of lacking intention to use trademark of the registrant. This differs from the opposition proceeding that requires the applicant of the opposed trademark to respond to the opposition by filing a counter-statement.³¹² Otherwise, it shall be deemed that the applicant has abandoned his trademark and no longer wishes to continue to registration proceeding.

In the Author's view, the compulsory requirement for the opposition proceeding is recommended to be applied to the non-use cancellation proceeding likewise. It seems to be uncertain that Board of Trademark assumes the intention to use of trademark of the registrant and decides to maintain the protection to such person even if he does not care enough to reply to the cancellation. Therefore, this may be the time that the legislators should consider changing the law by implementing the compulsory requirement for the registrant of alleged non-use trademark to file response to the notice of cancellation. This compulsory requirement could help the Board of Trademark and the petitioner to be certain on whether the trademark in question has been genuinely used by the registrant or not. If the registrant has used the trademark, he would have all the evidences showing the use in hands and ready to be provided. On the other hand, in case the registrant cannot provide the necessary proofs showing the use of trademark, the Board shall be convinced that there is no genuine use.

³¹² Trademark Act B.E. 2534 (1991) Section 36.

4.4.3 Eliminate the High Standard of Proof by Applying the Principle of Preponderance of Evidence (Balance of Probability)

As the problem indicated in item 4.3.3, in Thai Trademark Law, the legitimated word "*if it is proved that*" shows a strict requirement for the petitioner to provide concrete evidences to prove negative fact of non-using trademark and the Board of Trademark usually request for the excessive evidences of such non-use. As from these requirements, it is very difficult for the petitioner who cannot access to the facts and information to produce the sufficient evidences to satisfy the requirements. Therefore, the Board always rejects the non-use cancellation.

In the Author's perspective, it is highly recommended that, if the burden of proof cannot be shifted to the trademark owner, at least, the standard of proof for the petitioner should not be high as required the concrete proof and excessive of evidences.

In criminal case, when someone is accused as committed a criminal crime, the prosecutor who asserts the case, on behalf of the people or government, must produce the evidences to the standard of 'beyond reasonable doubt' that such accused person had committed a crime as alleged. If there is still a doubt during the process, the accused person should not be found guilty. The court or jury must feel sure of the accused person's guilt. If there is a doubt, the benefit of the doubt shall be given to the accused. This is because criminal penalty effects to the life and freedom of the accused person. The law is preventing wrong convicting to the innocent person. Therefore, the standard of proof for the criminal case is high.

On the other hand, in civil procedure, the party, who bears a legal burden of proof, must prove only for the 'balance of probability' or so called 'balance of preponderance' in disputed fact. In this case, the court has to compare and weigh the evidences produced by both parties, and which party has more probability, then the case go to that party. It does not have to be a 100% sure for the court to decide the case, just only more than even, where 51% is enough to decide.

Cancellation to revoke a trademark registration based on claim that such registered trademark has not been in commerce should have an effect only to the trademark owner's intellectual property rights in terms of business operation and benefit in trading. Due to its nature, such proceeding shall be considered as a civil action, not action in criminal offense. The principle of preponderance of evidence shall be suggested to apply for this proceeding.³¹³ The Board may consider the evidences produced by the petitioner by weighing whether they are reliable to demonstrate that the trademark may have not been in used. It does not need to be an absolute fact that the trademark has not been used at all or the registrant has no intention to use from the beginning. According to the Board of Trademark's previous decisions, if the petitioner cannot provide the absolute non-use of the registered trademark, the Board has given the benefit of the doubt to the trademark owner. The requirement for concrete and absolute proof may seem to be the proof for criminal offense as to clear all the doubt, not for the civil action as the nature of this kind of cancellation.

Therefore, the balance of probability or preponderance of evidences seems to be an appropriated choice for standard of proof to this particular proceeding. This will allow the petitioner who has the legal burden to proof have more chance in overcoming the cancellation.

4.4.4 Allowing Partial Cancellation and Providing Legal Measure for Limitation of Registration on Unrelated Goods/Services

As the problem mentioned in item 4.3.4, non-use cancellation in Thailand does not allow a partial cancellation. The petitioner must prove to the Board of Trademark that every designated goods or services as listed under the registration have not been used. If the petitioner can only prove non-use of some designated goods, the cancellation still cannot prevail. This requirement has placed the difficulty

³¹³ *Supra* note 242. Page 42.

to the petitioner to overcome the registration for all designated goods and prove for the non-using of the goods that not in relation with the petitioner's course of trade.

An applicant who applies for trademark registration to cover a large amount of goods and service, but does not use the trademark with all the items as designated, can be considered as trying to apply for defensive registration to block others from using and registering identical or similar trademarks. If the registered trademark have not been used for some of designated goods or services, the protection received from its trademark should not cover those of non-use cases.

In some countries i.e. the United Kingdom and the People's Republic of China, it is possible for the petitioner to apply for partial non-use cancellation to remove only some of the goods or services are deemed to be non-use. Therefore, the cancellation shall only relate to those goods or services, not all the items as the entire registration.

In the Author's view, by giving a secured legal measure, Thailand could adopt the partial cancellation proceeding to remove registration only some designated goods and maintain protection for the rest of the unrelated goods. This would allows the later trademark application to register for the similar goods that were cancelled. However, there may be an issue of confusing similar trademarks in the registrations of prior trademarks for the goods which are not cancelled and the registrations of later trademarks for the goods that have been cancelled. Therefore, to prevent this problem, Thailand should also consider adopting further legal measure for the limitation of registration. For example, Thailand may publicly publish the announcement declaring that the prior registration has been partially cancelled for the removed designated goods or service, and that the later trademark registration has been accepted for those cancelled goods.

Trademark coexistence is also a solution to be taken into account. This is a situation in which two different enterprises use an identical or similar trademark with the same market of product or service without necessarily interfering

with each other's business.³¹⁴ In nature, trademarks are often used by multiple enterprises in good faith³¹⁵ on the purposes of which specific market they would like to sell their products, or which regional customers base, or within a limited geographical area.³¹⁶ Therefore, none of these situations lead to conflict of interest or confusion of trading and marketing, as long as the trademarks in question continue to perform their main function which is to indicate the source of goods and to distinguish their goods from those of competitors.³¹⁷ Nevertheless, in some cases, to avoid any conflict or confusion in business matters, the two companies, that are aware of using similar trademarks, may choose to amicably conclude a formal co-existence agreement in order to prevent the future use of the two trademarks that may be overlapping in a way as to become undesirable or infringing activity.³¹⁸

Similarly to the Chinese trademark registration determination, the system of dividing list of goods and services into sub-classes allows the co-existence of trademarks for dissimilar designed goods or services. In case the cancellation concerns only some goods or services which deemed to be non-used, the petition can request to revoke only part of registration concerning the goods or services that fall under the same sub-class.

Under this circumstance, if Thailand adopts the same system of sub-classes as the Chinese practice, it could facilitate the petitioner to prove only the non-using of such designated goods or services in relation to such sub-class. This provides more opportunity for the petitioner to be able to produce the sufficient evidence that may comfortably acquire from the same kind of business and have a chance to overcome the non-use cancellation.

³¹⁴ World Intellectual Property Organization (WIPO). *"IP and Business: Trademark Coexistence"*. http://www.wipo.int/wipo_magazine/en/2006/06/article_0007.html/ (accessed on April 14, 2016)

³¹⁵ *Id.*

³¹⁶ *Id.*

³¹⁷ *Id.*

³¹⁸ *Id.*

4.5 Problems that could probably be arising from the Proposed Alternative Solutions for Non-Use Cancellation in Thailand

Even though some legal measures may be utilized in some countries within the scope of their legal systems, jurisdictions and practical methods, it may not always perfectly fit or apply smoothly to Thailand.

As Thailand is a first-to-file system country, the requirement for genuine use may not be applicable to its filing system. Since the exclusive rights and protection will be granted to the first person who files the application, the trademark owner will be urged to early file an application before using it. This case mostly happens to the foreign business owners who want to use their trademarks from their original country and to seek international trademark protection where the countries they have exported the products to. These foreign business owners usually make a long term plan to expand their business and first file the trademark application in selected nations before putting the actual product into the market. Therefore, there will be no use of trademark before and during the process of registration. In this situation, the requirement for evidence of genuine use during the time of application filing and the time before being issued a certificate may create obstacles in granting trademark protection for these foreign business owners.

However, the requirements of evidence for genuine use after 3 or 5 years since receiving the certificate and at the time of renewal are still recommended. Even though the foreign business owner may not be able to operate the business in the beginning, after receiving a certificate they should be able to prove sufficient use after 3 or 5 years and especially after 10 years during the time of renewal. If the business could not be operated at these times, it may consequently shows that the owner has no intention of doing business in Thailand. Consequently, it might be the case that the business was not successful and trademark registration is not worth renewing.

Second, as a civil law system country, suggestions to shift the burden of proof may be hard to follow in practice. In Thailand, people, including lawyers and

professionals in this field, habituate to the old knowledge which perpetuating the tradition and believe that a party who asserts the disputed fact must prove the case. Therefore, they may not be aware of, or desire, this suggested procedure.

As to the standard of proof of the Board of Trademark, it is suggested to apply the balance of probability or preponderance of evidence into the process of consideration for the cancellation. However, as it does not have to be unanimous of 100% certainty for the court to decide the case, just only 51% of probability is enough to decide, there could be a chance to revoke the wrong trademark registration which could effect to the trademark's owner's rights and protections.

For the last proposed alternative solution, the limitation of registration on unrelated items of goods or services is recommended. However, the information of such limitation of similar trademark registrations will only be recorded in the Registry system. Without goods and widespread announcements to the public, consumers may not be aware of such limitations. Confusion may occur if there are two similar trademarks. For example, one of them might be limited to the registration protection on selected goods or services while the other one covers other goods. This may cause the confusion and mislead to the public and customers regarding to which owner is the real protected owner of which goods.

Taking the advantages of goodness from the provisions and practices regarding non-use cancellation applied in above selected countries could efficiently simplify the burden of proof and standard of proof for the petitioner to overcome the non-use cancellation in Thailand. Still, Thailand needs to be careful in adopting these proceedings into Thai trademark system and provides some appropriate legal measures to prevent these problems that might be occurred along the way.

CHAPTER 5

CONCLUSION AND RECOMMENDATIONS

5.1 Conclusion

As per the significant functions of trademark, which is created for the use in course of trade, a trademark must be utilized by the trademark owner in order to perform its functions and benefit to the trade. If a trademark has not been used in course of trade, such trademark could be considered as useless creation.

Thailand has adopted the First-to-File system of trademark acquisition as the registration is granted to the person who files the application first. The basis of "*first comes first serves*" seems to be fair from a competitive perspective in trading system that allows the person who makes the most effort by filing the application early with Trademark Office should earn a pride from its creation and be given the protection as a reward of its attempt. The protection which is rewarded to a trademark owner is the exclusive rights to be the only one who can use such trademark and the rights to prevent others from using it. This protection also covers those of identical or similar trademarks that may resemble to the one being protected.

However, one of the problems arising from this First-to-File system is granting the protection for an unused trademark. This is a defensive registration that creates a barrier preventing others from registering the trademark that happens to be identical with or similar to the existing trademark that has been recorded as a prior registration.

According to the Paris Convention and the TRIPs Agreement, there are provisions for requirement of genuine use of trademarks that are registered and the provisions regarding cancellation of trademark registration based on the ground of non-use. Non-use cancellation is a legal proceeding allowing any person or interested party to challenge the registered trademark based on the claim that such trademark has

no commercial use by the registrant. Due to the limited resources, non-use cancellation scheme can play a vital role as a method to clean the cluttered Registry's records and revoke the registration of unused trademark from the system, which could give an opportunity for the later trademark applicant to register its using trademark that reflected to the commercial reality.

Thailand has provided a regulation in regard to non-use cancellation proceeding in Section 63 of Thai Trademark Act B.E. 2534 (1991). However, from the Author's perspective and studying, it appears that there are some problems with the practical proceedings in case of non-use cancellation in Thailand. These problems lead to the difficulties of overcoming the requirement of proof which affect the rights of later trademark owners as well as decelerate of economic investments.

Firstly, according to the law and practice in correspondence with the Supreme court judgment, the concept of burden of proof in Thailand applied the accusatorial system that *"the person who asserts the matter must prove it"*. Therefore, under Thai Trademark Law, it is clearly stipulated that a petitioner who file a cancellation petition must bear the burden of proof of the alleged non-use of the disputed trademark. In addition, not only must prove the actuality of non-using of trademark for at least 3 consecutive years prior to the date of filing a cancellation petition, but the law also requires the petitioner to prove that the registrant has no intention to use the trademark whatsoever. These requirements place too much burden to the petitioner and contrary to the fact that the petitioner does not have sufficient access to the required evidences and the truth whether the registered trademark is used or not. Furthermore, proving the intention in mind of other person is almost impossible. Therefore, the likelihood. that the petitioner could be able to produce sufficient evidences, which belong to others, to demonstrate the actuality of non-using of disputed trademark, including the intention in mind of the registrant that has no absolute intension to use the trademark, is very low. It has been a difficult proceeding for the petitioner to bear the obligation of proving in term of such negative fact. The possibility to prove and produce the evidences showing the fact of non-use and no intention to use of trademark is seldom succeeded.

Secondly, studying from the precedent decision of the Board of Trademark, the Board has placed the high standard of proof that strictly require the petitioner to prove the concrete evidences demonstrating, beyond doubt, that the registrant never use such registered trademark and has absolutely no intention to use it. Any proof in which is produced by the petitioner is repeatedly refused by the Board of Trademark. The Board mostly claimed and verdict that the evidences produced by the petition are not sufficient and cannot prove actuality of non-using of trademark on the registered goods and services of trademark owner, without the need to consider the registrant's rebutting evidence. Furthermore, referring to the Supreme Court Judgment, it was defined that only use of trademark with a short period of time and small quantity, either in form of test marketing, clinical trials, or in relation to free promotional goods can at least show the intention to use the trademark of the registrant. Therefore, it is very difficult for the petitioner to overcome this requirement.

Thirdly, by the interpretation of the phrase "*if it is proved that...with the goods which it was registered*" as imposed under Section 63 of Thai Trademark Act, the law has set the requirement of proof for non-using trademark on every items of goods or services under the registration. Therefore, even though the petitioner is able to prove the non-use of one item, but not all of those that are registered, the Board will not cancel such trademark registration and will hold that it is insufficient to prove the owner of the registered trademark has no intention to use or, in fact, have never used the trademark in good faith for such other registered goods. As a result of this requirement, it is considered that the use in relation to some of the goods is enough for the registrant to maintain the entire registration and prevail the cancellation.

Fourthly, there is no requirement for genuine use of trademark that force the trademark owner to be aware of pushing its registered trademark in commercial use. Under Thai Trademark Law and the Board of Trademark's consideration, the registered trademark owner is presumed to have used or has the intention to use the trademark with all of the goods and services as listed in the application at the time of filing application. This presumption also applies to the circumstance that if the

registrant continues to renew its protection at the time of renewal. Therefore, it put difficulty on the petitioner to produce the evidence rebutting this presumption of law, which provides the monopolization of rights to the first registrant. Due to the fact that there is no evidence of use supporting to this presumption, the question is how the law can be assured of such use of trademark and guarantee that the protection given to the first registrant is worthy. Giving the exclusive and absolute rights only to the first registrant, without assuring that the rights given has been properly utilized, may cause the abusing of trademark's functions in sense of not being able to represent the owners and non-benefit to the trade, and also may jeopardize the good will of trademark registration system.

Where the cancellation for a non-use trademark is so difficult, there are many effects that may be caused by such problems such as cluttered registry records or a registered trademark that preserves the rights to block others from utilizing it. This obstructs later trademark owners who wish to be protected the under the same registration. Facing such extreme difficulties when canceling one's trademark also results in monopoly rights being given to the first registrant, which may indirectly cause the trademark owner to not be afraid of losing their registration as well as create unfair competition to the subsequent users that may not be able to enter into the market because of the presence of the already existing registered trademark.

Whereas in some of foreign countries i.e. United Kingdom and the People's Republic of China, the burden of proof lies on the trademark owner who has full access to the information regarding whether the trademark is used or not as well as if the non-use that was justified. The trademark owner has the proper information regarding the legal justifications needed to show that such non-usage is not caused through the intent of the trademark owner. On the other hand, in some jurisdictions i.e. the United States of America, the petitioner bears only the prima facie to show the abandonment of the trademark or preliminary causes of non-usage. In this case, the burden of proof will be shifted to the trademark owner to produce evidence proving that the trademark has been genuinely used or that there is a special circumstances in which the trademark cannot be used.

5.2 Recommendations

From the Author's perspective, the problems of non-use cancellation proceeding in Thailand arise from the strict requirements that place the burden of proof on the petitioner, with high standard of requiring the concrete evidences showing absolute non-use of trademark and intention in mind of the trademark owner. Therefore, it is the time for Thailand to seriously consider on legal measures that could reduce such burden of proof and eliminate the barrier imposed by the precedents of Supreme court's judgments and the consideration as per the Board of Trademark's decision, including the provision regarding the non-use cancellation itself. The recommendations are as followed.

5.2.1 Implement the Requirement for Genuine Use of Trademark

The requirements for genuine use of trademark have been stipulated in some countries i.e. the United States of America, to force the registrant to use the trademark in commerce by requiring the substantive evidences proving of their use, before obtaining or maintaining their registration. Non-submission of evidences of genuine use when the time is requested could be a cause to presume that the trademark owner has not used the trademark in real business. This would be a tangible evidence, in the way of providing a significant certain evidence when the trademark has not been used or the registrant has no intention to use it by not reply to the requirement of law. In addition, this principle of requirement for genuine use could facilitate the Registry to follow up with the trademark owner whether the registration protection will be utilized in course of trade and for the registrant to be aware of using its trademark, not just only reserve the rights of protection as a defensive registration.

The Author opines that the requirement for genuine use could encourage the trademark owner to rapidly and constantly use the trademark in commerce in order to obtain or maintain its registration rights. Therefore, it is

recommended for Thailand to adopt the schemes of requirements for genuine use to implement in Thai Trademark Law.

There are 4 steps of registration that the requirement of genuine use of trademark can take place, e.g. at the time of filing an application, before obtaining the Certificate, within a prescribed period after obtaining the Certificate, and at the time of filing renewal. Each step can ensure the use of trademark in different time

However, due to the First-to-File system, the requirement for genuine use at the early stage of applying for trademark registration may not be applicable to this filing system. Since the exclusive rights and protection will be granted to the first person who files the application, the trademark owner will be urged to early file an application before using it. The requirement for evidence of genuine use during the time of filing the application and the time before being issued a certificate may, somehow, create the obstacles in granting trademark protection. The Author then would suggest that the requirements of evidence for genuine use at the stage after receiving the certificates and at the time of filing the renewals should be applied to Thai Trademark Law. These suggestions are made in accordance with the facts that after 3 or 5 years from the date of receiving a certificate and especially after 10 years from protection, the trademark owners should have used the trademark to represent their businesses and all the evidences pertaining to such use must be possessed in hands. Therefore, if the owner does not prove sufficient use of its trademark, it may consequently shows that the owner has no intention of doing business in Thailand and the protection that granted to such trademark would not be worth renewed.

5.2.2 Shifting Burden of Proof for Non-Using of Trademark to Registered Owner

The burden of proof for non-using is specified differently among the countries. In Thailand, it is a major problem which causing an inefficient proceeding for non-use cancellation that the law requires the petitioner to bear the burden of proof. Due to the facts that the petitioner has no access to necessary information and

evidences whether the trademark in question is used or not, it is extremely difficult for the petitioner to prove the absolute non-use of the trademark that owned by others. In addition, according to the precedents of Board of Trademark and Supreme court's judgment, the petitioner is also required to prove that the owner has no intention to use such trademark, which is almost impossible for the petitioner to seek for reliable evidences demonstrating such negative intention of the others.

Even though Thailand applies the concept of burden of proof in Thailand as the accusatorial system that *"the person who asserts the matter must prove it."* However, according to Section 84/1 of Civil Procedure Code, it also provides the exceptions that a party who asserts a disputed fact does not have to bear the burden of proof. *"Factual Presumption"* is a presumption relies on the facts that ought to be happened in ordinary course of event. It also affirms on the principle of *'Res ipsa loquitur'* or *'thing speaks for itself'*.

In case of non-use cancellation, the person who possesses all the evidences pertaining to the use of trademark and has full knowledge whether the trademark is used or not, is the trademark owner, not the petitioner. Therefore, these facts and information shall be considered as the facts that ought to be happened in ordinary course of event, which shall be bound by the owner. Therefore, it seems to be appropriate to adopt this exception to the Thai Trademark Law and shift the burden of proof for non-using of disputed trademark from the petitioner to the owner of registered trademark.

Like adopted by many countries i.e. the United Kingdom, Japan and the People's Republic of China where the non-use cancellation proceedings are mostly efficient and successful, the burden of proof has been placed on the trademark owner. This side of burden can convince the Board of Trademark of actuality of non-use trademark if the owner cannot provide the evidences of use to rebut the allegation brought by the petitioner. In addition, if the trademark owner does not care enough to respond to the action that may revoke its registration, it can be considered that the

trademark owner no longer desires to use its trademark or has no intention to use it. The registration of such believable to be unused trademark shall be cancelled.

However, in some countries i.e. the United States of America, the petitioner bears only the *prima facie* to show the abandonment of trademark or preliminary cause of non-using. Then, the burden of proof will be shifted to the trademark owner to produce the evidences rebutting that the trademark such non-use was caused by any special circumstances and justified by the proper reason.

Consequently, if, there is some opinions that it is not appropriate for Thai Trademark Law to change the accusatorial system and the burden of proof should be bound by trademark owner at the beginning of non-use cancellation process, at least, it is recommended to adopt the *prima facie* principle, requiring the petitioner to establish a preliminary cause of non-using. If the preliminary cause is established, then the burden of proof shall be shifted to the trademark owner to deny the challenged cancellation.

In supporting to the *prima facie* principle and enhance the efficiency of non-use cancellation, Thailand shall consider changing the law by implementing the compulsory requirement for the registrant of alleged non-use trademark to file response to the notice of cancellation, in virtue of Section 64. This compulsory requirement could help the Board of Trademark and the petitioner to be certain on whether the trademark in question has been genuinely used by the registrant or not.

In addition, providing examples of what could be considered as "special circumstances" that justify the proper reasons for non-using may set the pattern for the Board of Trademark, the petitioners, as well as the trademark owners themselves to be in the same page of the definition of use and non-use. This aims to reduce the conflict of understanding and the arguments that usually come along with such different interpretations.

5.2.3 Eliminate the High Standard of Proof by Applying the Principle of Preponderance of Evidence (Balance of Probability)

As the legitimated clause "*if it is proved that*" and according to the Board of Trademark's decisions, the strict requirement has set the standard of proof very high. The Board usually requests for the concrete and excessive evidences demonstrating the actuality of non-use and lack of intention to use of the trademark owner, to ensure the absolute non-use before rendering its decision to cancel the trademark. This requirement shows that the Board has put the standard of 'beyond reasonable doubt', as commonly applied in criminal cases, to the petitioner.

However, cancellation to revoke a trademark registration based on non-use of trademark in commerce should have affected only to the trademark owner's intellectual property rights in senses of business operation and trading system. This is a private right. Therefore, this procedure should fall under civil procedure.

Therefore, the Author would suggest that if the law still affirms to place the burden of proof on the petitioner, it should eliminate such high standard of proof by applying the principle of preponderance of evidence or so called 'Balance of Probability' to the petitioner. Under this scheme, the Board may consider the evidences by weighing whether they are reliable to demonstrate the reasonable facts of non-using of the disputed trademark. This will allow the petitioner who has the legal burden to proof have more chance in overcoming the cancellation.

5.2.4 Allowing Partial Cancellation and Providing Legal Measure for Limitation of Registration on Unrelated Goods/Services

Occasionally, many trademark applications have listed many items of goods or services, it is nearly impossible for the petitioner to prove the non-use for all items. This requirement has placed the difficulty to the petitioners to seek for the evidences that may be beyond their normal course of trade and do not concern with the sharing market in which they will launch the products under their trademarks.

In some countries i.e. the United Kingdom, Japan and the People's Republic of China, it is possible for the petitioner to apply for partial non-use cancellation to remove only some of the goods or services are deemed to be non-use and concern with the goods they aim to apply for protection.

In the Author's view, it should be possible for Thailand to allow partial cancellation, like the proceedings in other countries. However, in order to prevent occurrence of confusing trademarks, Thailand should also consider giving the secured legal measures for the limitation of registration preventing these problems i.e. providing good public announcements.

Trademark coexistence is also a solution that should be taken into account. In Chinese trademark registration, they specify the list of goods and services by dividing into sub-classes. This sub-classification system allows the co-existence of trademarks to register in the same class for dissimilar designed goods or services. In the Author's perspective, Thailand could consider adopting the same system as the Chinese practice. In case the cancellation concerns only some goods or services which deemed to be non-used, the petitioner then can choose to partially revoke only the goods or services that fall under the same sub-class.

In this thesis, the Author does not aim to force Thailand to completely change its domestic law regarding non-use cancellation provisions. But in fact, the Author aims to study the practical problems that Thailand may overlook to resolve it. Providing the advantages and goodness of non-use cancellation proceedings from other countries could enlighten Thailand to see the significant necessity to eliminate the obstacles that block the foreign investor to come invest in Thailand and impede the economic growth. The proposed recommendations could be the guidelines for Thailand facilitate the non-use cancellation proceeding and balance between the owner's right and public interest. Still, Thailand needs to be careful in adopting these proceedings and provides the legal measures to be appropriately adjusted with its existing practice.

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5.5 Thailand

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5.6 The Philippines

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5.7 The United Kingdom

Trade Marks Act 1994

5.8 The United States of America

Trademark Act of 1946

5.9 International Laws

Paris Convention for the Protection of Industrial Property (“Paris Convention”)

Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”)



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