



PROBLEMS OF NON-TRADITIONAL TRADEMARKS PROTECTION
UNDER THAI LAW: A CASE STUDY OF MOTION
AND MULTIMEDIA MARKS

BY

MR. SUTTHAWIT PAERUANG

AN INDEPENDENT STUDY 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 2020
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ENTITLED

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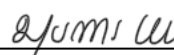
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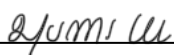
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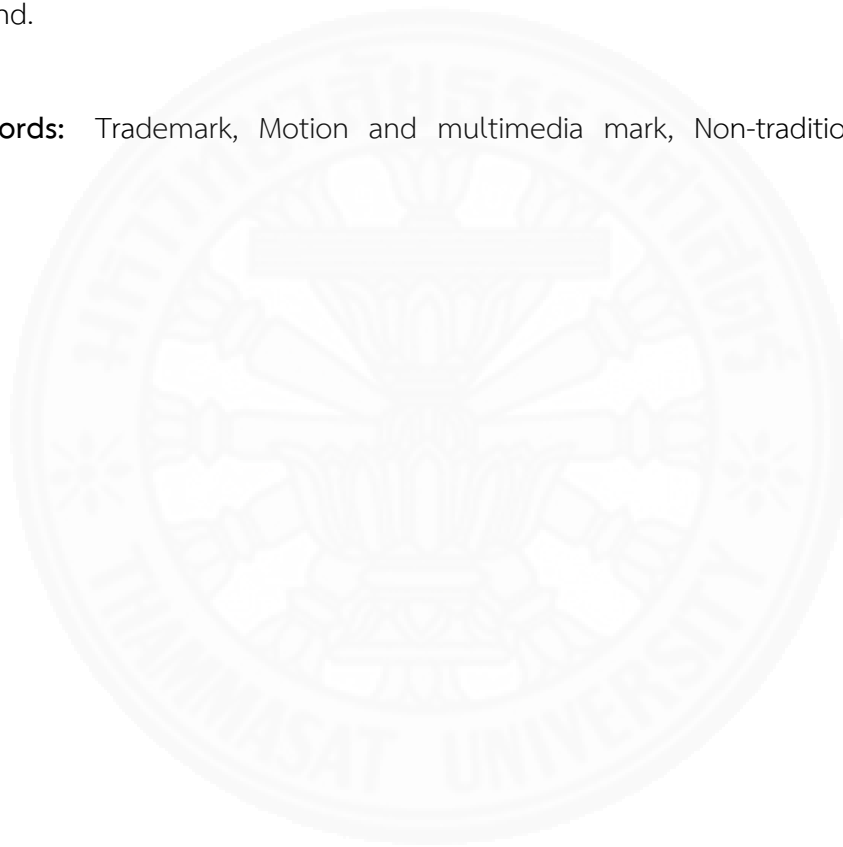
ABSTRACT

Motion and multimedia marks are categorized as non-traditional trademarks. European Union Trademark Regulation defined motion mark as a mark consisting of series of certain sequential images or pictures, and multimedia mark as a mark which is a combination of images and sounds. Like other marks, motion and multimedia marks can be used as an indication of original sources of products and to distinguish similar products in a marketplace. Therefore, the provision of trademark protection for these two marks will not only benefit business players and traders in strengthening their investments, increasing the ability to enhance the products reputation through a wider distribution channels, but also enable customers to recognize and distinguish their goods or services from those of others which can then help reduces consumer search cost. However, the Trademark Act B.E. 2543 has laid out a legal concept that trademark can only be those marks that has been defined by law. Currently, the definitions of the term 'mark' are written in a way that is too narrow to allow for the protection of motion and multimedia marks. This legal limitation created an obstruction for investors and traders from creating and using motion and multimedia marks with their businesses and investments. Moreover, other relevant legal provisions that provide requirements for trademark protection, in particular, the

distinctiveness requirements under Section 7, and legal prohibitions under Section 8 are not yet extended to cover the protection of motion and multimedia marks.

This study aims to demonstrate the existing problems for the protection of motion and multimedia marks in the context of Thai trademark law, to provide an overview of the legal concept and practical trademark protection in various areas including international rules, regional protections, and foreign domestic laws, and to analyze and anticipate the most appropriate measures in resolving the legal dilemma at hand.

Keywords: Trademark, Motion and multimedia mark, Non-traditional trademark



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LIST OF ABBREVIATIONS

Symbols/Abbreviations	Terms
DIP	Department of Intellectual Property Ministry of Commerce
EUTMD	Directive approximating the laws of the Member States relating to trade marks
EUTMIR	European Union trade mark implementing regulation
EUTMR	European Union trade mark regulation
Paris Convention	Paris Convention for the Protection of Industrial Property
SLTL	Singapore Treaty on the law of Trademark
TLT	Trademark Law Treaty
TRIPS Agreement	WTO Agreement on Trade – Related Aspects of Intellectual Property Right
UKIPO	The Intellectual Property Office of United Kingdom
USPTO	United States Patent and Trademark Office

CHAPTER 1

INTRODUCTION

1.1 Background and Problems

Trademark is considered as an important business tool that help traders and business operators present their products or services in a manner that can capture consumer's attraction and causes them make references to the products or services for which the trademark is applied to. In this respect, trademark enables consumers to recognize the source of products or services and distinguish such products or services from one another. Nowadays, technological advancements and digitalization play a crucial role in all societies. Consequently, technological devices and digital platforms play a role in every steps of human lifestyle, including an interaction between company branding campaign and consumers. Furthermore, the economic growth has resulted in modern consumers having access to larger communication mediums such as online platforms, especially social media platforms. This led consumer's demands to be satisfied in a more extensive and sophisticated manners. In doing so, marketers must show their creativities in introducing new ideas and modern marketing strategies to make consumer experiences with the brand come in all senses. For that reason, modern business models are prone to be presented on electronic devices, online medias, or digital platforms through animations, moving images, physical movements, short movies or advertisements, virtual pictures, holograms, and other multimedia signs which are capable of convincing consumers in more ways than tradition billboards, banners, pieces of papers, product's containers and packaging, or other traditional presentations of products and services than before.

The remarkable technological development, digitalization, and online economic growth change the ways consumers interact with brands and merchandises sold under the brands. Many countries are now more likely to accept the protection of motions, animated films, short motion pictures, animations, and others multimedia signs as a trademark. However, the protection of motion and multimedia signs remains

silent under Thai law. Although, Section 4 of the Trademark Act B.E. 2534 indicates that the term “mark” means “a photograph, drawing, invented device, logo, name, word, phrase, letter, numeral, signature, combination of colors, figurative element, sound or combination thereof,” Neither this provisions, nor the provisions relating to trademark registrable characteristics and other relevant provisions specifies that motion or multimedia sign are included under the term “mark” to constitute a trademark, and they are also silent in referring to the motion and multimedia marks under its scope of protection. Moreover, neither other legislations nor cases, whether in the level of the registrar, Trademark Board, or the Court deal with the possibilities of the motion and multimedia marks protection in practical. As a consequence of this legal loophole, the power of business sectors to create connection between traders, investors, consumers and third parties with the brand is significantly limited. This does not grapple with the digitalization in the current social context and creates obstacle for foreign investors in settling an investment in Thailand. Furthermore, in an international contexts, the substantive trademark protection which are the Paris Convention, TRIPS Agreement and the subordinate instruments for administrative procedure which are the Trademark Law Treaty and the Singapore Treaty on the Law of Trademarks did not prohibited the protection of non-traditional marks including motion and multimedia marks. Thus, Thailand, as a member of the World Trade Organization (WTO), whose obligation is to be bound to conform with any signed International rules, should review and revise the existing law to ensure compliance with international rules it has taken part of as a signatory.

For all reasons, the problems and possibilities of the motion and multimedia mark protection under Thai law is one of the interesting legal issues that should be explored whether the suitability of the definition of the term “mark” , the interpretational guidelines of said definition, the relevant registrable subject matters, the practical requirements and guidelines for registration and protection of motion and multimedia marks under Thai laws in comparison to the international minimum standard of non-traditional trademark protection under Paris Convention and the TRIPS Agreement, the regional protection of the European Union (EU), and foreign countries

such as United States, and United Kingdom) that expands the scope of their trademark protection to include motion, animations, short movies and other multimedia signs in order to find the concrete differences among them, to determine the possibilities of Thailand to provide protection for motion and multimedia marks, to analyze whether the existing provisions conform with minimum international standards of non-traditional trademark protection and to find an appropriate resolutions for business development, to uplift Thai's trademark protection in order to cope with digitalization and encouraging the confidence of both domestic and foreign investors in conducting businesses in Thailand.

1.2 Hypothesis

The provisions of the Trademark Act of B.E. 2534 are inadequate for the protection of non-traditional marks in various forms, particularly motion and multimedia marks since there is no specific definition referring to the motion and multimedia marks and do not allow the motion and multimedia marks to be served as trademark or constitute a trademark. Furthermore, the relevant provisions concerning the criteria of a registrable trademark and the existing practical measures lack of reference to, and do not provide for the protection of motion and multimedia marks as a trademark, even though they can be perceived by the consumers in a similar way to traditional marks. Nonetheless, the similarity in the criteria of each type of intellectual properties, specifically the overlapping criteria between trademark and copyright, may influence the determination of motion and multimedia marks. In addition, the existing criminal protection for trademark emphasizes the protection of a registered trademark and only touches a few protections for unregistered trademark. In mere specific cases, if motion and multimedia marks cannot be registered, the protection of such marks under criminal law will also become unobtainable. Accordingly, if the motion and multimedia marks are still allowed to be considered as non-registrable marks, their use will not be suitable and will be incompatible with the increasing commercial and industrial benefits that the marks comprised. Hence,

Trademark Act B.E. 2534 should be amended in order to extend the scope of trademark protection to include motion and multimedia marks and allow for their registration.

1.3 Objectives of Study

1. To study the background and overview of trademarks
2. To study the criteria of trademark under the Thai Trademark Act B.E.2534 and its relevant regulations concerning the definition of the term “mark”, the interpretational guidelines of such term, the registrable characteristics of trademarks, the Supreme Court Decision regarding trademark protection, the decision of the Trademark Board and the practical rules of the registrar or the trademark examiner under Department of Intellectual Property and other sequential issues relating to motion and multimedia marks protection such as the overlapping protection the trademark and copyright, and the scope criminal protection concerning trademark.
3. To study the characteristics of “mark” or “sign¹” which can constitute a trademark that is registrable and protected as a trademark under TRIPs agreements, and the Paris convention. Moreover, to study an acceptable representation and description formats of such mark or sign under the Trademark Law Treaty, and the Singapore Treaty on The Law of Trademarks. In addition, to conduct a comparative study on the scope of trademark protection, the criteria of registrable and protectable trademarks, the practical procedure relating to the registration, the overlapping between trademark and copyright, and the criminal protection of trademark, focuses on the protection of motion and multimedia marks under both regional trademark law, are European union (EU) and foreign national trademark laws such as the law of the United States (US) and the United Kingdom (UK).
4. To analyze the current inadequacy to include and provide a protection for motion and multimedia mark of the definition and interpretation of the term

¹ The terms “mark” and “sign” will be used interchangeably or collectively in this paper

“mark” under Section 4 of Trademark Act B.E. 2543, and possible obstacles which may be the cause of such inadequacy in comparison to the international, regional, and foreign national countries.

5. To propose solutions and suggest alternatives in improving the existing interpretational guideline. As well as to propose an amendment or extension of the definition of “mark” under Section 4 to be inclusive of motion and multimedia marks, and to also propose an amendment to an existing trademark criteria to create a more inclusive framework which will allow for motion and multimedia marks to be registrable.

1.4 Scope of study

This paper will mainly focus on the legal problems and obstacles relating to the protection of non-traditional marks, especially on the case of motion and multimedia marks in Thailand, the characteristic of registrable trademarks under the Trademark Act B.E. 2534, the relevant Supreme Court Decisions and other relevant criteria, and the practical interpretations and guidelines on the proof of distinctiveness in the case of motion and multimedia in Thailand. Furthermore, this research will analyze the possibility of motion and multimedia marks protection under Thai laws comparing to trademark laws and relevant criteria of the motion and multimedia marks protection in international rules, European Union (EU) trade mark², and foreign nationals trademark of the United States (US) and the United Kingdom (UK) in order to propose the most appropriate recommendations and solutions for broadening the scope of Thai trademark protection to cover motion and multimedia marks.

² The term “trade mark” is used in European countries to refer the term “trademark”

1.5 Research methodology

This study methodology concerns documentary research by examining and analyzing legal texts and commentary regarding conceptual trademarks, international trademark laws, Thai and foreign legislations, the judgements of the court, academic papers on trademark available through online databases, and legal opinions from the experts or practitioners who are experienced in area of trademark laws.

1.6 Expected Outcome

1. To present the historical background and conceptual overview of trademarks protection
2. To understand the characteristic of “ mark” or “ sign” which are registrable and can be protected as a trademark, particularly motion and multimedia mark. To illustrate the possibilities of motion and multimedia marks protection as a trademark under Thai and Foreign laws.
3. To understand the problems, effects of motion and multimedia marks protection through the views of business operators, consumers, and other relevant parties.
4. To present and propose solutions and alternatives for the protection of motion and multimedia marks in Thailand, in order to provide appropriate measures for business toolkit and uplift traders and investors’ trademark protection in the context of Thai laws, economics and emerging digital societies.

1.7 Independent Study Structure

The structure of this independent study will be consisted of the followings:

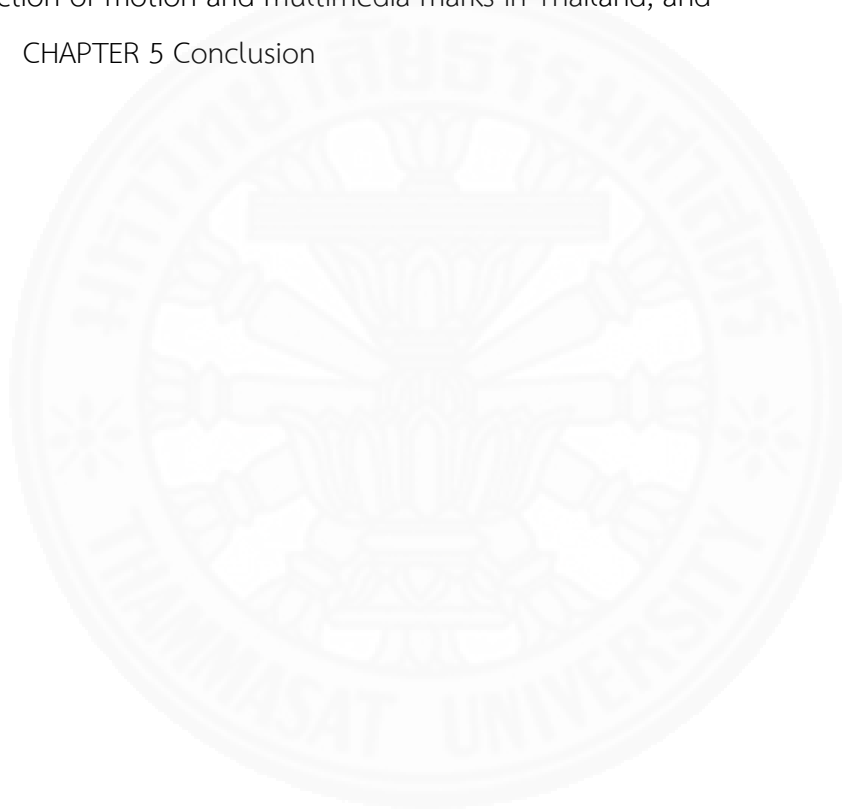
CHAPTER 1: Introduction, background and problems, hypothesis, objective of study, scope of study, methodology, expected outcome, and independent study structure;

CHAPTER 2: History and concept of trademark, motion and multimedia signs, protection of trademark in Thailand, and problems of motion and multimedia marks protection;

CHAPTER 3: Motion and multimedia marks protection in international rules, European Union (EU) and the foreign national laws of the United States (US), and the United Kingdom (UK);

CHAPTER 4: Critical analysis of legal problems, obstacles and possibilities of the protection of motion and multimedia marks in Thailand; and

CHAPTER 5 Conclusion



CHAPTER 2

GENERAL PRINCIPLES OF TRADEMARK PROTECTION

2.1 Introduction

This chapter aims to explain both historical and conceptual aspects of trademark by exploring the development of traditional trademark from the initial recognition of marks or signs to the signs or marks being used in the course of trade as trademark. This chapter will observe and describe the transition from an early stage of trademark to non-traditional trademark in both international and national level including Thailand in order to establish a fundamental information to further dive into exploring the general criteria of trademark, protectable criteria under Thai trademark law, the basic knowledge of motion and multimedia marks, and the illustration of motion and multimedia marks as a trademark. The previous chapter of this paper discussed about the legal uncertainties and legal dilemmas arisen from the insufficient protection provided under Thai trademark law in order to provide a clear boundary for the scope of studying.

2.2 History and Concept of Trademark

Trademark was developed from a normal sign and later used with products or merchandises in trade. To understand the nature and application of trademark, it is only proper that the study begins from exploring the historical background of trademark, the development of both traditional and non-traditional trademarks in both international and national level. Later, the study will further explore the conceptual basis of trademark from the definition of trademark, the functions of trademark, the protection basis and the general criteria of trademark protection in theoretical view.

2.2.1 Historical Background of Trademark and Development of Non-Traditional Trademark

For ease of explanation, the contents of this part are divided into two parts being; the historical background of trademark and the of development of non-traditional trademark.

2.2.1.1 Historical Background of Trademark

In the early of mankind history, the first discovery of marks emerges in the primitive era, when mankind began learning to communicate in the absence of alphabet system like today³. Such marks can be found in the form of wall and cave painting.⁴ In addition, there are several appearances of marking in an ancient world. For example, branding of cattle and other animals in the ancient Egypt⁵, reference on literary character named “Cain”, who was placed on earth by the Lord after killing his brother Abel in the Book of Genesis⁶, quarry marks and stonecutters’ signs appeared in Egyptian structures and the Temple of Solomon in Jerusalem⁷, and ancient potteries which were found in China, Greece and Rome.⁸ Later, in the fourteenth to sixteenth centuries (so-called Middle ages), the development of marking are widespread as a result of advancement of trade.⁹ In this era, the main function of marks were to identify and differentiate one product or service from others, which may derived from marks that are already available in the nature, but has scarcely been used. Marks which can be found within this era can be categorized into three types as follows:

³ South African History Online, ‘The Oldest Forms of Human Communication’ (8 February 2017) <<https://www.sahistory.org.za/article/oldest-forms-human-communication>> accessed 18 January 2021

⁴ L. E. Daniels, ‘The History of the Trade-Mark’, (1911) 7 TM Bull 239.

⁵ J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (5th ed., 2020). § 5:1

⁶ Sidney A Diamond, ‘The Historical Development of Trademarks’ (1975) 65 Trademark Rep 265, 269-270.

⁷ Preserving History: Trademark Timeline, (1992) 82 Trademark Rep. 1022.

⁸ Sidney A Diamond (n 6) 267-268.

⁹ *ibid* 272.

First, the personal marks, these marks often appear on the house stamp, emblems, or house mark to identify the individual or family members of such household. In addition, if the house is in business, whether as a shopkeeper, a carpenter, or a hotel owner such marks are often labeled to attract customers to use the services.¹⁰ However, such marks are not only used for commercial identification purposes, but also for distinguishing one person from another, for example by placing such marks on a slave or a prisoner.¹¹

Second, the proprietary marks, which is usually used by merchants by attaching them to merchandise,¹² so that workers who are unable to read will be able to recognize who the merchandise belongs to, or if the merchandise is owned by their employers.¹³ Such marks are also used for the benefit of identifying the real owner of cargo in the event of a danger to a transported or transited vehicle, such as a shipwrecked or pirates' robbery. This is so that in the event that products carried within such vehicles are lost, the owner will be able to claim ownership and retrieve such products.¹⁴

Third, the regulatory production marks, these marks are marks that are governed by law or regulation to appear on products in order to identify the true origin of such products. This is especially useful in the event where the products are imported illegally or are defective works, which would render the true owner of such imported products to be punished by law.¹⁵

By view of trademark enforcement in the early year, infringement of marks and punishment were recognized in many countries. For example, in the law of Parma, prohibition and death penalties are inflicted upon artisan who used same or similar

¹⁰ Ibid

¹¹ Ibid 273

¹² Frank I. Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 Harv. L. Rev. 813, 814.

¹³ See Diamond (n 6) 272-273

¹⁴ See Schechter (n 12) 814-815.

¹⁵ Ibid

mark to other artisans¹⁶. The same penalties can also be found in England on those who used false trademark on cloth of gold or silver¹⁷. Not only that, in the early of 1584, the protections relating to trademark were recognized for the first time in *Southern v. How*¹⁸ by the dictum of Judge Dodderidge, it is worth noting that this is not the first trademark related case, however it was the first to have reached a verdict that recognized the theory of a trademark protection.¹⁹ However, there were some comments²⁰ on the suitability of referring to such case as the first present case law on trademark, as the ambiguity to such reference is presented in the oldest law book named *Sandforth's Case*.²¹

In the Modern time, during an industrial revolution, the manufacturing business is shifting from employing hand work with in sufficient ability to produce a product with large scale quantities to adopting industrial method, that is more capable of producing a mass production with the same or higher quality than that of hand worker. Following this, an important economic revolution has occurred, the widespread use of trademark for indicating the origin of goods came consequently with the broad availability of products in the marketplace.²² A concrete example of modern trademark development can be found in Anglo – American countries²³, particularly in England and United State of America. In England, following the case of *Southern v. How*, the protection against trademark fraud was referred to by Lord Mansfield in deciding the 1783 case of *Singleton v. Bolton*.²⁴ In 1824, the case of *Sykes v. Sykes*²⁵

¹⁶ See Diamond (n 6) 279.

¹⁷ Preserving History: Trademark Timeline (n 7)

¹⁸ *Southern v. How*, Popham's Reports at 143, 79 Eng. Rep., 1243-1244.

¹⁹ Keith M. Stolte, 'How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter's Conundrum', (1997) 8 Fordham Intell. Prop. Media & Ent. L.J. 505, 507.

²⁰ See Frank I. Schechter, *The Historical Foundations of The Law Relating to Trade-Marks* (1925), 123

²¹ *Sandforth's Case*, Cory's Entries, BL MS. Hargrave 123, fo. 168 (1584)

²² Sidney A Diamond (n 6) 280 – 281.

²³ McCarthy (n 5) § 5:2.

²⁴ *Singleton v. Bolton*, 99 Eng. Rep. 661 (K.B. 1783).

²⁵ *Sykes v. Sykes*, 107 Eng. Rep. 834 (K.B. 1824).

established a fundamental ground for future trademark law cases by providing that the defendant who uses plaintiff's "Sykes Patent" on inferior powder flasks²⁶ have infringed the plaintiff's property rights. The case was decided by the old English common court. Unlike *Southern v. How*, this case has been honored by many scholars as the first reported landmark case relating to the protection of trademark owner's right, although this case was decided only two centuries after *Southern v. How*²⁷.

In nineteenth century, the protections of trademark infringement were seen primarily as a fraud and deceit case law that the trademark owner would claim that their businesses were injured by the deprivation of customers resulted from fraudulent act and deception made by their competitor in using the mark of the trademark owner without permission.²⁸ However, the essence of the case presented by the trademark owner would emphasize only on enforcing their exclusive right as their property right, rather than accentuating trademark imitation through a view of public eyes²⁹. In deciding the case, even though both public deception and harm to plaintiff's property were found on the court's consideration³⁰, it can be said that public injury was not a main factor that the court render its decision. Specifically, the court weigh in the fraudulent intention of the defendant over the confusion caused by the imitation of trademark.³¹

In the development of Trademark legislation in UK, protection against trademark infringement was first prescribed as a statutory criminal offence under the Merchandise Mark Act 1862³², such statutory law provided that a person who forge, or

²⁶ *ibid*

²⁷ Schechter (n 20) 137.

²⁸ M.P. McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 Notre Dame L. Rev. 1839, 1857

²⁹ Robert G. Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law' (2006) 86 B.U. L. Rev. 547, 561.

³⁰ *Knott v. Morgan*, 2 Keen 213, 48 Eng. Rep. 610, 1836

³¹ *McCarthy* (n 5)

³² The Merchandise marks act, 1862. 25 & 26 Vict. c. 88.

counterfeit a mark, or falsely apply any trademark with intent to defraud or to induce another to defraud, shall be guilty as committing a misdemeanor.³³ Nonetheless, apart from criminal offences against trademark and the definition of the mark provided³⁴, the Act did not provide, in essence, a rule of registration that is applicable to trademark. Not until 1875, that the Trade Marks Registration Act 1875 was passed, the Act has become the first appearance of a registration system in the UK in order to facilitate practical convenience.³⁵ As a consequence, the first registered trademark in UK was introduced as a triangle logo owned by The Bass & Co. Pale Ale in 1876.³⁶ Later, the UK legislation concerning trademark was reviewed and the same concept has been adopted several times in other act with the same goal to protect the public and owner's right. An example of such adoption are such as the Patents, Designs, and Trade Marks Act 1883, Patents, Designs, and Trademarks Act 1888. Later, the Trade Marks Act 1905 was adopted, such Act introduced the first comprehensive system for trademark protection in England.³⁷ The 1905 Act was amended by Trade Marks Act 1919, which was also amended by the Trade Marks Act 1938. Not until the Trade Marks Act 1938 came into force, that the system of trademark in England was incredibly modified. An example of such modification are such as, the introduction of the registration basis of intent-to-use, and the creation of the process of examination and publication of trademark application.³⁸ Moreover, such Act also introduced a new trademark system

³³ Merchandise Marks Act 1862, s 2

³⁴ Merchandise Marks Act 1862, s 1

³⁵ Wood, J. Bigland, *The Law of Trade Marks: Including the Merchandise Marks Act, 1862, and The Trade Marks Registration Act, 1875, with the Rules Thereunder, and Practical Directions for Obtaining Registration; with Notes, Full Table of Cases, and Index* (London : Stevens and Sons 1876) 7.

³⁶ UKIPO Reg. No. 1

³⁷ Dima Basma, 'The Nature, Scope, and Limits of Modern Trademark Protection: A Luxury Fashion Industry Perspective' (Ph.D. Thesis: The University of Manchester 2016) 98.

³⁸ Shoen Ono, 'Overview of Japanese Trademark Law,' (2nd edn, Yuhikaku 1999) < <https://www.iip.or.jp/e/translation/pdf/ono/ch2.pdf> > accessed 26 February 2021 refer to the development of trademark in England.

such as ‘consent to-use system,’ associated trademarks system, and non-claiming right system.³⁹ Due to the modern concept of the 1938 Act, it has become the model law of Trademark legislation that is followed by in many countries including the United State of America and Japan.⁴⁰ Not only that, but the first trademark to ever be registered in UK was also recorded with an Intellectual Property Office, which was also known as the Patent Office in 1938. However, due to an implementation of the EU Directive⁴¹ and several unsuitable provision of the 1938 Act such as the multiple classes protection of one trademark application and the limitation of the trademark protection domain, the Trade Marks Act 1994 was introduced, repealing the former 1938 Act and applies to any trademarks registered in the UK.⁴²

Like the UK trademark emergence, the US trademark was seen primarily as fraud and deceit case law employed from the UK case law in eighteenth and nineteenth century as mentioned earlier.⁴³ At first, the perception of trademark emphasizes on the protection of the trademark owner rather than the protection of consumers against confusion as a public view. There are two different viewpoints raised by two scholars on the formative characteristic of trademark in the nineteenth century.⁴⁴ On the one side, the scholar sees that trademark was primarily protected as a property right of trademark owner, this is supported by the early aim of trademark law where the injury of trademark owner is the main focus, whereas consumer interest was merely a secondary intention.⁴⁵ Unlike the other side where another scholar argued that the protection of trademark owner against imitation and the protection of

³⁹ Basma (n 37)

⁴⁰ Ono (n 38)

⁴¹ Council Directive 89/104/ EEC of the 21 December 1988 [1989] OJ L 40

⁴² Hector MacQueen and others, *Contemporary Intellectual Property: Law and Policy* (2nd edn, Oxford University Press 2011) 582.

⁴³ McCarthy (n 5) § 2:1.

⁴⁴ *ibid*

⁴⁵ M.P. McKenna (n 28) 1841.

consumer from confusion should be mutually considered in order to provide the best protection for both goals.⁴⁶

During the development of Trademark legislation in the US, a federal Act relating to trademark registration was first enacted in the mid-1870⁴⁷, five years before the UK Trade Marks Registration Act 1875 was passed. Unfortunately, only nine years after, in 1879, the federal Act became effective, such Act was decided unconstitutional by the U.S. Supreme Court due to the reason that the Act grant power to the Congress in relation to the decision on trademark registration for both intrastate and interstate commerce that is broader than the scope of power under the Congress's commerce power.⁴⁸ As a solution, the U.S. Congress later in 1881, enacted a new Act that deals with the registration and protection of trademarks which are used in commerce by excluding the interstate commerce.⁴⁹ Even though the U.S. Congress has enacted various versions of statute that deals primarily with trademark, the prior statutes were still considered as an archaic trademark law. Later to modernize the federal trademark registration, the U.S. Congress passed the Act of 1905, which is applied to advance trademark registration. Nevertheless, due to the narrow scope of protection under this Act which only allowed for fanciful and arbitrary marks to be registered, and the lack in advancement of legal measures which fails to cope with the context of the global market in the early twentieth century⁵⁰, the Lanham Act is established. The original version of this Lanham Act 1946 was enacted with the purpose to unify and codify trademark laws in the United States⁵¹, to tackle unfair competition, to provide a federal trademark registration system, to protect the benefit and goodwill of trademark

⁴⁶ Robert G. Bone (n 29) 560-561.

⁴⁷ Act of August 14, 1870, 19 Stat. 141.

⁴⁸ See Trade-Mark Cases, 100 U.S. 82, 99, 25 L. Ed. 550 (1879)

⁴⁹ Act of March 3, 1881, 21 Stat. 502.

⁵⁰ McCarthy (n 5) § 5:3.

⁵¹ Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 72 L. Ed. 2d 606, 102 S. Ct. 2182, 214 U.S.P.Q. 1 (1982).

owner⁵², and to enhance free trade competition.⁵³ The Lanham Act has been amended times after times to ensure that it is still effective in dealing with dynamic shifting situations. One of the dominant amendments to the Lanham Act was the enactment of Trademark Counterfeiting Act of 1984, which was the first to have added and provided grounds for criminal trademark protection.⁵⁴

2.2.1.2 Development of Non-Traditional Trademark

As a result of economic growth and technological advancement, modern consumers have a large number of communication channels, including multiple online marketing and social media platforms, to find instruments that meet their needs in a more complex and comprehensive way.⁵⁵ To catch up with more sophisticated consumer needs, the marketers have to come up with and launch new ideas and more modern marketing strategies to ensure that consumers experiences their brand in a broader senses.⁵⁶ For this reason, the sphere of what can constitute a trademark has expanded beyond traditional trademarks. An example of such expansion in trademarks are the use of words, phrases, and figurative devices that are more complex and possess non-traditional features.⁵⁷ These expanded trademark comprises of one or more non-traditional notion of signs, and is also known as “non-traditional trademarks”. In general, non-traditional trademark comprises of marks or signs that has more potential to communicate origin of products or services in a wider sense. Such senses that can be divided into a variety of types such as colors, scents, flavors, tactile,

⁵² See *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198. (1985)

⁵³ See *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 531.

⁵⁴ 18 U.S.C.A. § 2320

⁵⁵ Martin Lindstrom, *BRAND Sense: Build Powerful Brands Through Touch, Taste, Smell, Sight, and Sound* (2005), 3

⁵⁶ Iren Calboli and Martin Senftleben (eds), *The Protection of Non-traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) 2.

⁵⁷ Andrew Beckerman-Rodau, ‘The Problem with Intellectual Property Rights: Subject Matter Expansion’ (2010) 35 *Yale Journal of Law & Technology* 11, 11-14.

sounds, motions, three-dimensional shapes, and holograms.⁵⁸ In order to provide a better understanding of these non-traditional marks, the following paragraphs will explore the recognition and development of the non-traditional marks through both national and international levels.

In a national level, various jurisdictions extended the protection of trademark to non-traditional trademarks and does not exclude the protection of such marks even when, evidently, only a few cases were protected. The US trademark law regime, for example, has a remarkable progress in the recognition of non-traditional trademark. This can be identified in *Qualitex Co. v. Jacobson Products Co.*⁵⁹, where the U.S. Supreme Court found a non-traditional single colour signs to be qualified for and constituted as a trademark. Not only that, but the U.S. Supreme Court has also made notes on what can constitute a trademark stating that “it is the source-distinguishing ability of a mark – not its ontological status as color, shape, fragrance, word or sign – that permits it to serve basic purposes.” It can be said that this case was recognized as a landmark case that has provided the recognition of non-traditional marks as a trademark. Nonetheless, the recognition of non-traditional mark as a trademark is still being considered as uncommon even though, the protection of such marks can be found in many domestic levels cases. The first recognition of such mark embodied in a legal issue concerning the problems and resolution of uncertain trademark registration procedures in both national and regional levels, and not an issue of substantial protection.

In an international level, the recognition of non-traditional trademark began indirectly from the broad concept of what can constitute a trademark and what can be eligible for trademark protection under the TRIPS Agreement, such concept has then become an issue that is recognized in many countries. The attempt to find a solution to resolve the problem regarding legal uncertainty of administrative conditions

⁵⁸ Jerome Gilson, Anne Gilson LaLonde, ‘Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks’ (2005) 775.

⁵⁹ *Qualitex Co. v. Jacobson Products Co., Inc* 514 US 159, 164 (1995)

within trademark registration.⁶⁰ In order to standardize and harmonize the administrative requirements in all jurisdictions and ensure that a reasonable expectation of the trademark owners is protected, the Trademark Law Treaty (the “TLT”) was concluded and adopted as a solution to the previously mentioned issue and method to achieve the goals to ensure the protection for reasonable expectation of trademark owner among different principles and limitations of the registration procedures in each trademark law regime.⁶¹ However, due to the narrow scope of the TLT, it applies, limitedly to visible signs⁶² and excludes non-visible sign such as sound marks and olfactory marks.⁶³ Not only that, but the application of such treaty also excludes hologram marks, even though it is also considered to be a visible sign.⁶⁴ Moreover, Article 3 of the TLT, only imposes the general requirements on the application and statement to the application of color and three-dimensional trademarks,⁶⁵ while remains silence on other types of non-traditional marks. A limited criteria of the TLT shows that the TLT can neither sufficiently recognizes the appearance of non-traditional trademark nor imposes appropriate and adequate measures for both visible signs and non-visible signs. Besides, the increasing protection of non-visible signs and three-dimensional marks appears in various jurisdictions around the world, together with the introduction of electronic filing systems through national intellectual property offices. Thus, it is necessary to launch a more concrete instrument which may be applied to these types of marks. In the late 2006, remarkable advances have been made in the recognition of non-traditional trademark, the Singapore Treaty

⁶⁰ WIPO, ‘Trademark Law Treaty (TLT)’ <<https://www.wipo.int/treaties/en/ip/tlt/index.html>> accessed 14 February 2021

⁶¹ Denis Croze, ‘Making a Large Universe Visually Perceptible: The Development of Non-Traditional Trademarks in WIPO Treaties’ in Iren Calboli and Martin Senftleben (eds) *The Protection of Non-traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) 15.

⁶² Trademark Law Treaty, art 2 (1a)

⁶³ Trademark Law Treaty, art 2 (1b)

⁶⁴ *ibid*

⁶⁵ Trademark Law Treaty, art 3 (1ax), (1axi)

on the Law of Trademarks (the “STLT”) was finalized and adopted to resolve the said legal loophole arisen in the TLT. Unlike the TLT, the STLT applies to all types of marks including visible signs and non-visible sign which can be registered in the Contracting Countries jurisdictions.⁶⁶ This quality has caused the STLT to become the first international rule relating to trademark law that concretely recognizes the existence of non-traditional trademarks.⁶⁷ In detail, the domain of STLT covers many administrative procedures such as the filing of trademark applications⁶⁸, the division of applications or registrations⁶⁹, the recording of changes in details⁷⁰, and the renewal of registrations.⁷¹ Apart from the substantial provisions which deals directly with administrative procedures, there are other regulations published under the STLT that facilitate the practical enforcements of STLT in more details.⁷² Rule 3 of the STLT, for example, deals with details concerning the trademark application. It lays down the form of representations required for each type of mark.⁷³ Notwithstanding the position as a first international instrument relating to non-traditional trademark, the STLT does not create an obligation for contracting countries to abide by the same concept.⁷⁴ In another word, each contracting countries have the alternative to determine whether to provide for the registration of the said new types of marks.⁷⁵ It should be noted that even if the STLT came with remarkable development on the recognition of non-traditional trademarks, numerous unresolved issues that deal with registration

⁶⁶ See Singapore Treaty on the Law of Trademarks, art 2(1) and art 3

⁶⁷ Croze (n 61) 1.

⁶⁸ Singapore Treaty on the Law of Trademarks, art 3

⁶⁹ Singapore Treaty on the Law of Trademarks, art 5

⁷⁰ Singapore Treaty on the Law of Trademarks, arts 10 and arts 11

⁷¹ Singapore Treaty on the Law of Trademarks, art 13

⁷² Regulations Under the Singapore Treaty on the Law of Trademarks

⁷³ WIPO, *The Singapore Treaty on the Law of Trademarks (STLT): Questions and Answers* (WIPO Publication 2015) 1

⁷⁴ *ibid*

⁷⁵ Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks, Mar. 27, 2006, para 3, S. Treaty Doc. No. 110-2

procedure of these marks are still existed,⁷⁶ however, these issues were brought up in many meeting sessions of the standing committee on the Laws of Trademarks, Industrial Design and Geographical Indications, a forum to discuss issues, enhance cooperation and provide guidance on the advancement of international law on trademarks, industrial designs and geographical indications.⁷⁷ One of the remarkable advances of non-traditional trademark in the context of international level is the endeavor of the standing committee to categorize disrupted types of these marks on the basis of whether such mark are visually perceptible under the terms of the TRIPS Agreement.⁷⁸ As a result of these meeting sessions, non-traditional trademark can be divided into two groups, which are visual marks (i.e., three-dimensional, motion and multimedia signs, holograms, position, gesture, color, slogans, titles of films and books) and non-visual marks (i.e., texture, taste, scent, sound, and feeling)

In Thailand, the use of marks in ancient times can be found on crockery plates and mediums of exchange such as ancient money and bullet coins called ‘Pot duang’.⁷⁹ However, the development of marks used on goods or products are still in question.⁸⁰ In the early 1900s, the development of marks firstly taken place as one of an offence in trade, under the Penal code of the Kingdom of Siam R.S. 127 (1908).⁸¹ Later, in 1910, Thai Government has established Trademarks Register Office as one of an internal department under the Ministry of Agriculture⁸², and in 1914, four years following the establishment of such office, the first legislation or the Act on trademark

⁷⁶ See Croze (n 61) 19.

⁷⁷ WIPO, ‘Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)’ < <https://www.wipo.int/policy/en/sct/> > accessed 15 February 2021

⁷⁸ WIPO, New Types of Marks, WIPO Doc. SCT/16/2, para 72 (2006).

⁷⁹ Bank of Thailand, ‘About BOT Museum’ <<https://www.bot.or.th/English/MuseumAndLearningCenter/BOTMuseum/AboutMuseum/Pages/default.aspx>> accessed 21 January 2021

⁸⁰ Sukhprem Sachadecha, ‘Arbitration of Trademark Disputes in Light of Thai Laws’ (Master Degree Thesis: Thammasat University 2012) 11.

⁸¹ Penal code of the Kingdom of Siam R.S. 127 (1908), ss 236-238.

⁸² รัชชัย ศุภผลศิริ, *คำอธิบายเครื่องหมายการค้า* (กรุงเทพมหานคร, สำนักพิมพ์นิติธรรม, 2536) [Thatchai Supaponsiri, *Commentary of Trademark Law* (Nititham 1993)] 2.

known as the Law on Trade Marks and Trade Name B.E. 2457 (1914) was followingly enacted and became effective. This Act intended to be applied only to the registration of trademarks and trade names.⁸³ It has been reported that the first trademark to be registered under such act was the Crown Brand held by Asiatic Petroleum (Siam) Co. Ltd.⁸⁴ After the promulgation of the 1914 Act and the establishment of Trademarks Register Office, the development of Trademark law in Thailand gradually flourished along with the transition of the Trademark Office. Ten years from the date of establishment of the Trademark Register Office, the Thai government began to recognize the role of the Trademark Register Office in domestic trade and in connection with International affair. In 1923, during the reign of King Rama VI, the Department of Business Registration was established replacing the former Trademark Office. Such establishment causes the whole registration affairs that were previously under the responsibility of Trademark Register Office to be transferred to the department of business registration under an oversight of the Ministry of Agriculture. Later, due to the progress of the competent trademark office and the enormous growth of trade in Thailand, the new Thai Trademark law, also known as the That Trademark Act B.E. 2474 (1934) was enacted to fulfill the criteria of the latest Trademark law to be more appropriated to the social context in such moment. The 1934 Act was influenced by the English Trademark Act 1905.⁸⁵ It is worth noting that, the 1934 Act was not only inspired by the English Act but also acted as the model Trademark law in Thailand,

⁸³ Department of Intellectual Property, 'Historical Background of the Department of Intellectual Property' (25 July 2016) <<http://ipthailand.go.th/th/design-patent-009/item/%E0%B8%9B%E0%B8%A3%E0%B8%B0%E0%B8%A7%E0%B8%B1%E0%B8%95%E0%B8%B4%E0%B8%81%E0%B8%A3%E0%B8%A1%E0%B8%97%E0%B8%A3%E0%B8%B1%E0%B8%9E%E0%B8%A2%E0%B9%8C%E0%B8%AA%E0%B8%B4%E0%B8%99%E0%B8%97%E0%B8%B2%E0%B8%87%E0%B8%9B%E0%B8%B1%E0%B8%8D%E0%B8%8D%E0%B8%B2.html>> accessed 21 January 2021

⁸⁴ *ibid*

⁸⁵ Supaponsiri (n 82) ; วีส ดิงสมิต, *คำอธิบายกฎหมายเครื่องหมายการค้า* (กรุงเทพมหานคร, สำนักพิมพ์นิติธรรม 2545) [Wat Tingsamit, *Commentary of Trademark Law* (Nititham 2002)] 5.

which is considered one of the crucial pinpoints of the Thai Trademark regime.⁸⁶ The Act 1934 has been enforced for over a period of 60 years, until few provisions of the Act became outdated and unable to provide sufficient protection for the trademark owner. Unlike the 1934 Act's ability to provide protection for trademark, the 1934 Act was silence in providing substantial protections for service marks, certified marks, and trademark licensing which were widely protected in many other countries around the globe. In addition, the existing provisions regarding the registration procedures of trademarks under the 1934 Act were unclear in many instances. For example, the provisions about power of the Trademark Registrar, the Trademark Board, and the right of the trademark applicant are still obscure.⁸⁷ Apart from the above, there are no criminal protection for trademark specified under the 1934 Act. Therefore, the criminal protection for trademark must be governed by the provision of criminal offenses against trade under the general criminal law, which was, at that time the Criminal Code B.E. 2499 (1956) which cannot provide sufficient measures for trademark protection.⁸⁸ As a result, the current Thai Trademark Act B.E. 2534 (1991) was established to resolve all these aforementioned concerns.⁸⁹ The 1991 Act was amended three times, and is still the current enforceable law governing the use of trademarks in Thailand.

2.2.2 Definition of Trademark

In general, trademark, as well as other Intellectual property are subjected to the principle of territoriality, that causes trademark acquirement and protection to be based on the country where rights of such trademark have been acquired or registered. As a result, each jurisdiction can impose different requirements depending on the country's policies and economic statuses. To illustrate this topic in both inter-state level and intra-state level, the definition of trademark should first be explored

⁸⁶ ไชยยศ เหมะรัชตะ, *ลักษณะของทรัพย์สินทางปัญญา* (พิมพ์ครั้งที่ 11 กรุงเทพมหานคร, สำนักพิมพ์นิติธรรม 2560) [Chaiyos Hemarajata, *The Nature of Intellectual Property* (Nititham 2017)] 304.

⁸⁷ Note of the Thai Trademark Act B.E. 2534 (1991)

⁸⁸ Hemarajata (n 86) 306.

⁸⁹ Draft of the Thai Trademark Act B.E. 2534

through the view of old domestic definitions and the definition provided by international rules for harmonizing and standardizing the criteria and subject matter of trademark acquirement and protection, and then explores the definition developed in compliance with the international rules once again in order to conclude the core and fundamental criteria of “trademark” in an international and theoretical view.

The first remarkable advances of trademark law can be perceived to have started from the Anglo-American trademark regimes, particularly in the UK and US trademark law. Each country defines “trademark” in different ways. Under the US trademark law, trademark was defined as “any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.” Whereas under UK trademark legislation, trademark was defined as “a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trademark, a mark registered or deemed to have been registered under Section 31 of this Act.”⁹⁰ Based on the information above, it can be seen that the definition of trademarks, and also what can constitute a “mark” varies in different jurisdictions. The US definition of trademarks comprises of both indicating and distinguishing aspects, whereas in the UK, trademark definition deals only with indicating aspect, while the distinguishing aspect is not at all a concern. The difference in definition among each jurisdiction creates uncertainties and adds extra costs in linking the gaps between each domestic trademark law in the context of economic growth.⁹¹ To resolve these problems, WTO was established, and TRIPs agreement was drafted. It is designed to create minimum standards for intellectual property, including trademark in order to facilitate and harmonize the rules relating to trademark by

⁹⁰ Trade Marks Act 1938

⁹¹ Graeme B. Dinwoodie, ‘Territorial Overlaps in Trademark Law: The Evolving European Model’ (2017) 92 Notre Dame L. Rev 1669, 1673-1674.

turning them into a multilateral trade system.⁹² in regard to the definition of trademark, even though the TRIPs agreement does not define, specifically, what trademark is, it includes trademark as one of protectable subject matter by stating that “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.”⁹³ Due to the fact that many trademark provisions of the TRIPS Agreement are closely linked to an agreement governed by the WIPO⁹⁴, the definition of trademarks has also been concluded by the WIPO that “A trademark is any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitors.”⁹⁵

From the definition of trademark given by the WIPO, trademark consists of two basic elements characterized by their functions. First, trademark must be able to enhance the individualization of the goods. Second, trademark must be capable of helping consumer or public in differentiating the good under the trademark from other goods. The definition of “trademark” as provided under TRIPs Agreement, combining with the definition given by the WTO, the main underlying purpose of trademark is trademark must be able to be used for distinguishing the source of one marked goods from other goods.⁹⁶ Thus, distinguishability of trademark is considered as a crucial function that any trademark must serve. However, since there are many functions that trademarks must serve in theoretical view, the details of the distinguishability functions and how it works shall be given in the part of trademark functions.

⁹² Taubman A, Wager H and Watal J (eds), “Trademarks” in Antony Taubman, Hannu Wager, Jayashree Watal (eds) *A Handbook on the WTO TRIPS Agreement* (Cambridge University Press 2012) 58, 59-60.

⁹³ TRIPs agreement, art 15

⁹⁴ UNCTAD-ICTSD, *Resource Book on TRIPS and Development* (Cambridge University Press 2005) 257.

⁹⁵ WIPO, *WIPO Intellectual Property Handbook* (WIPO 2004) 68.

⁹⁶ *ibid*

2.2.3 Functions of Trademark

Any signs can be used in a course of trade at trader's satisfaction, but not all signs can serve as trademark. Signs which can constitute or serve as trademark must be able to show that they can perform a function of trademark in trade. In theory, there are arguably, four different functions that any signs sought to be trademark should be able to perform which are distinguishing and indicating function, quality function, advertising function, and economic function.

2.2.3.1 Distinguishing and Indicating Function

Due to the economic growth of business resulted from industrialization, the intensity of trade competition follows. It enables stakeholders in the market access to raw materials, which can be processed and manufactured it into a finished product. As a consequence, same types of products from the different traders and manufacturers can be commonly found as new competitors enter into the market. Nevertheless, several products in the same category do not share the same level of price, quality, and packaging. In this situation, trademark plays an important role in individualizing the products sold under trademark, and enabling the consumer the ability to distinguish one product sold under the mark from other. These then help the consumers in deciding and choosing the goods that are the most closely align with their level of satisfaction.⁹⁷ In addition, the function of indicating the origin of product is also associated with the function of distinguishing.⁹⁸ In order to differentiate the product sold in the market, source or origin of the trademarked products must be identifiable by the consumers. It can be seen that consumer's knowledge of where the products were made are not only there to help the consumers make informed choices between various competing products with different elements and qualities which are difficult to indicate at the moment of purchase⁹⁹ but also to assure the

⁹⁷ WIPO, *Introduction to Trademark Law & Practice: The Basic Concept* (2nd edn, WIPO 1993) 10.

⁹⁸ WIPO (n 95) 68.

⁹⁹ See Barton Beebe, Jeanne C. Fromer, 'Are We Running Out of Trademarks?: An Empirical Study of Trademark Depletion and Congestion' (2018) 131(4) Harv. L. Rev. 945, 954.

consumers who put their trust in the brand that any products sold under the chosen brand will meet their level of expectations.¹⁰⁰

2.2.3.2 Quality Function

Although the main function of trademark is to indicate the source of the marked goods or services and distinguishing one goods or services from others, this function is no longer a standalone function of trademark in the modern economic system. By view of consumers, due to the growth of production capabilities, trademark has become an instrument that encourages the consumers in making decisions relying on trademark without hesitation.¹⁰¹ In the meantime, trademark should enable consumers to assume and expect the same quality standards from goods sold under the same mark.¹⁰² In this sense, trademark should be considered as a license of guarantee for the consistency in quality of products under the same trademark.¹⁰³ It should be noted that even if there is no legal rule forcing the trademark owner to maintain the quality of their products under the trademark, and the owner is free to increase or decrease the quality of their products, the effort on such part is solely at the trademark owner's will.¹⁰⁴ Hence, the use of trademarks became one of an essential part of trading activities through its ability in providing sufficient information and assuring the quality of products and services.¹⁰⁵

2.2.3.3 Advertising Function

Due to the evolution of the use of mark, modern trademarks were used as marketing tools in conveying the desire of consumers upon a product, the trademarks were no longer being applied only onto goods and services to identify their sources

¹⁰⁰ *ibid*

¹⁰¹ McCarthy (n 5) § 18:40

¹⁰² *ibid*

¹⁰³ See *Eva's Bridal Ltd. v. Halanick Enterprises, Inc.*, 639 F.3d 788, 790 (7th Cir. 2011)

¹⁰⁴ *Wagmana Ltd v City Centre Restaurant Plc* [1996] ETMR 23.

¹⁰⁵ *Scandecor Developments AB v Scandecor Marketing AB* [2001] UKHL 21.

but were also used for their potential to convey emotional allures to consumers.¹⁰⁶ One of the main reason for the functional change of trademark is the transformation of the presentation of marks, namely, marks which were early appeared in the form of signal presenting general and easy meaning, were turned into symbols which deal with more branches of elements and convey more complex meaning.¹⁰⁷ With the distinctive characters and financial worth of marks, the function of indicating source of goods have transformed substantially into the function of advertising. In other word, advertising function, in essence, is the state where a trademark becomes a conveyance of interaction with the consumer through the use of trademarked products which would represent qualities of the merchandise.¹⁰⁸ In that sense, trademark will eventually be used as a tool of approaching the attention of consumers leading them to recognize the mark and the product in connection with the mark.¹⁰⁹

2.2.3.4 Economic Function

Economic affection of trademark underly the goals of trademark to uplift economic efficiency¹¹⁰ by facilitating consumers in linking information based on the trademark to the products and services and essentially allowing them to express their preferences and tastes more accurately.¹¹¹ Such reassurance came from an assumption that producers would protect their reputation in the market by maintaining the standard of their goods and services, which will, in return, benefit them in the long

¹⁰⁶ Lionel Bently and Brad Shermam, *Intellectual Property Law* (3rd edn, Oxford University Press 2009) 712.

¹⁰⁷ see Thomas D Dreshcer, 'The Transformation and Evolution of Trademarks - From Signals to Symbols to Myth' (1992) 82 Trademark Rep 301

¹⁰⁸ Case R-283/99-3 Souza Cruz SA v Hollywood SAS [2002] ETMR (64) 705.

¹⁰⁹ Hector MacQueen and others (n 42) 574.

¹¹⁰ William M. Landes, Richard A. Posner, Trademark Law: An Economic Perspective, (1987) 30 J.L. & ECON 265, 265.

¹¹¹ Stacey L. Dogan, Mark A. Lemley, The Merchandising Right: Fragile Theory of Fait Accompli?, (2005) 54 Emory L.J. 461, 467.

run in their investment.¹¹² In this regard, the more brand companies can relate to an emotional connection of the consumers, the more brand loyalty from consumer will arise.¹¹³ In doing so, brand companies should provide sufficient information to consumers in all multisensory approaches¹¹⁴ in order to enable actual satisfactions for consumers, as precise responses from consumers are directly linked to the approached chosen by the producers of products.¹¹⁵ Brand reputation resulted from trademark is therefore, considered as a crucial pinpoint as it enables consumers to discern on their past experiences and other available information about products and services sold under the brand, ensuring consumers' confidence on what they purchase¹¹⁶ and reducing the risk of misleading consumers to unintentionally purchase products or services.¹¹⁷ In doing so, the economic value of brand image called "goodwill"¹¹⁸ will benefit the brand owner in a long haul¹¹⁹, and products and services sold under trademark will be easily searchable and perceivable by consumer as well.¹²⁰ Consequently, consumer search cost of the products or services associated with mark

¹¹² Barton Beebe, Jeanne C. Fromer (n 99)

¹¹³ Martin Lindstrom (n 55) 219-20.

¹¹⁴ Gilson, LaLonde (n 58) 775.

¹¹⁵ Glynn S. Lunney, Jr., 'Trademark Monopolies' (1999) 48 Emory L.J. 367, 417.

¹¹⁶ WIPO Economics & Statistic Series, 'World Intellectual Property Report: Brands – Reputation and Image in the Global Marketplace'

<https://www.wipo.int/edocs/pubdocs/en/intproperty/944/wipo_pub_944_2013.pdf> accessed 7 March 2021

¹¹⁷ Robert G. Bone, 'Enforcement Costs and Trademark Puzzles' (2004) 90 VA. L. REV. 2099, 2108.

¹¹⁸ In *Commissioner of Inland Revenue v Muller & Co's Margarine Ltd* [1901] AC 217, 223 (HL).

Lord MacNaghen held the term "goodwill" that "[T]he benefit and advantage of the good name, reputation and connection of a business. It is attractive force that brings in business."

¹¹⁹ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 376.

¹²⁰ William M. Landes, Richard A. Posner (n 110)

with a strong sense of goodwill will be decreased.¹²¹ Moreover, in the view of producers, trademark plays a role in enhancing their incentives to maintain their informational branding value by investing in ensuring the same quality among their many products.¹²² In this economic function, it can be concluded that trademarks are nothing more than ordinary signs that can convey branches of informational content that are emphasized by the branding company to their consumers.¹²³

2.2.4 Protection Basis and General Criteria of Trademark Protectability

Since each country can independently provide their own protection basis and eligible criteria for acquiring trademark protection, this part will present available protection bases of trademark right acquisition and general criteria of trademark protectability as a basic framework of understanding in concept.

2.2.4.1 Protection Basis of Trademark

Trademark protection, as one of intellectual property protection, is governed by the principle of territoriality, in respect to the territorial sovereignty of each state to recognize and decide their own policy on trademark protection, even if it is different from other countries.¹²⁴ In present, though trademark protections are likely to comprise both of the registration and the use as a prerequisite for acquiring

¹²¹ See Stacey L. Dogan, Mark A Lemley, Trademarks and Consumer Search Costs on the Internet, (2004) 41 Hous L. Rev 777, 786; William M. Landes & Richard A. Posner, *The Economic Structure of Intellectual Property Law* (Harvard University Press 2003) 166-168.

¹²² See Paul Milgrom & John Roberts, 'Price and Advertising Signals of Product Quality' (1986) 94 J. POL. ECON., 796, 796.

¹²³ Carolina Castaldi, 'The Economics and Management of Non-Traditional Trademarks' in Iren Calboli and Martin Senftleben (eds) *The Protection of Non-traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) 259.

¹²⁴ Wertheimer HW, "The Principle of Territoriality in the Trademark Law of the Common Market Countries" (1967) 16 International and Comparative Law Quarterly 630, 631.

trademark right,¹²⁵ the protection of trademark can generally be acquired by two different bases.

On the one hand, trademark protection can be acquired based on use. For example, under US trademark law regime, it can be seen from the definition of “trademark” provided under the Lanham Act that trademark must fulfill not only the indicating and distinguishing functions, but trademark must also be used in commerce. The requirement for trademark to be used in commerce shows that the US trademark law regime employ the protection based on use. In this respect, the scope of use would be an indicator for the scope of protection.¹²⁶ Also, the owner of a trademark will have a right to use the symbols “TM” for goods or “SM” for services.¹²⁷ Besides, the first user of a trademark will have acquired a civil trademark protection at a federal level from false or misleading representation that causes confusion or commercial misrepresentation of nature, characteristics, qualities, or source of origin.¹²⁸ Therefore, this means that, even if a trademark has already been registered, the proprietor who brings the case into the Court for trademark dispute, and receive a favorable judgement will be considered as the first commercial user prior to the registered trademark holder.¹²⁹ Nonetheless, it should be noted that even if the protection under the US law requires use in commerce as the fundamental element of becoming a “trademark,” it does not mean that trademark registration is absent under the US trademark law regime. Since the Paris Convention imposes signatory countries under the obligation to provide for a trademark register. US as one of signatory country must

¹²⁵ WIPO (n 95) 77.

¹²⁶ The Committee on the Judiciary United States Senate One Hundredth Congress, *Trademark Law Revision Act of 1987: Hearing Before the Subcommittee on Patent, Copyright and Trademarks* (1988), 257.

¹²⁷ United States Patent and Trademark Office, ‘Protecting Your Trademark: Enhancing Your Right Through Federal Registration’ (2020) <<https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf>> accessed 27 February 2021

¹²⁸ 15 U.S. Code § 1125 (a)

¹²⁹ WIPO (n 95) 77.

provide registration for trademark to facilitate the trademark owner to secure full trademark protection.¹³⁰ Under US law, though trademark registration is not primary prerequisite in seeking for trademark protection, trademark registration still plays a role in ensuring the acquiring of trademark right through its used¹³¹, and benefits trademark user in obtaining additional advantages from full trademark protection which is acquired from a registration. For example, a registered trademark would be presumed as a valid mark, it entitles the trademark holder to use the federal registration symbol “®”¹³² and enforce the rights of a registered trademark in all states. The protection basis based on use is not only available under the US national law, but it is also available under Article 16.1 of the TRIPS Agreement where an exclusive right of the owner conferred from its trademark registration shall not affect the possibility of the WTO members to provide the acquirement of rights on the basis of use. In other word, apart from exclusive right acquired from the trademark registration, the said right is eligible to be acquired from the use of trademark as well. However, it should not be confused between the protection basis of use and the distinctiveness acquired through use. The protection basis of use is an additional basis to the registration basis, which imposes the use of mark as a condition of trademark protection and trademark right acquirement, while the concept of acquiring distinctiveness through use is the concept for additional acquirement of distinctiveness which is one of the criteria for a mark to be registrable, not a trademark protection based on use.

On the other hand, trademark protection can also be acquired based on registration, this protection basis is a typical method for acquiring trademark right in most countries.¹³³ Trademark registration is the traditional method of acquisition of rights and record of ownership in many countries.¹³⁴ Later, the registration basis was

¹³⁰ *ibid*

¹³¹ *ibid*

¹³² 15 U.S.C. 1111

¹³³ WTO, ‘Module III Trademarks’ <https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/modules3_e.pdf> accessed 26 February 2021

¹³⁴ See further in the part of historical background of Trademark

ensured by the Paris Convention which imposed Contracting Countries with an obligation to provide for trademark registration.¹³⁵ Since trademark protection is territorial, each jurisdiction has a full discretion to determine the conditions for trademark filing and registration as they see appropriate. In general, the applicant must file a trademark application to a competent office, generally called “Industrial Property Office” or “Trademark Office,” in the destination countries where the protection is sought.¹³⁶

2.2.4.2 General Criteria of Trademark Protectability

Although trademark protectabilities may be provided differently in each country, the criteria of trademark protectability are similar among them. In general, the requirement of trademark protectability can be divided into two different conditions.¹³⁷ First, trademark must be used on goods or services to create distinction. In general, indication and distinguishing are the fundamental functions of any trademark along with other functions as mentioned earlier. However, based on the definition of trademark concluded by the WTO, the distinguishing function is the most important element of trademark. Trademark must be able to help consumers or public in recognizing products or services sold under the trademark and make them distinguishable, not only from the same or similar products sold by other traders or competitors but also among different products or services. To ensure that this function can be found in all marks, distinguishing requirement therefore becomes the first condition for a trademark to be registrable. Second, trademarks must not fall under absolute grounds for registration denial. According to Article 6quinquies B of the Paris Convention, there are three grounds that contracting States can claim for registration denial as follows:

¹³⁵ Paris Convention, art 6.

¹³⁶ WIPO (n 95) 79.

¹³⁷ See WIPO (n 95) 71-77.

(1) the nature of mark infringes any others right of third-party acquired in the country where protection is claimed.¹³⁸ For example, if a third-party in the country where protection is claimed has acquired the right of trade name or copyright, and the applicant's trademark comprises of signs or words that would infringe the rights previously available to the third-party,¹³⁹ the country where protection is claimed can refuse to register such mark regardless of the mark's ability to fulfill other requirements.

(2) the trademark per se has misleading characters comprising with three following approaches for refusal:

(2.1) Trademarks that “devoid of any distinctive character,¹⁴⁰” or fails to serve as distinctive. As the purpose of trademark and the main reason of trademark protection is to assist consumers in indicate and distinguish the goods and services of trademark owner from that of others, trademark which lacks distinctiveness, therefore, cannot serve this function.¹⁴¹ In determining whether a mark is distinctive, consumers ability to recognize and identify the origin of goods or services based on the appearance of such mark is taken into account.¹⁴² In this respect, trademark's distinctiveness can be classified into two categories. Firstly, inherent distinctiveness, which is when a trademark in itself, is capable of distinguishing goods or services of one origin from those of others. Secondly, acquired distinctiveness or secondary meaning or distinctive through use, is when a mark lacks inherent distinctiveness per se, but their distinctiveness are later gained when public or consumers start identifying or associating such mark with certain goods or services.¹⁴³ In general, level of inherent

¹³⁸ Paris Convention, a 6quinquies B (1)

¹³⁹ G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property: As Revised at Stockholm in 1967* (BRIP 1968) 113-115.

¹⁴⁰ Paris Convention, a 6quinquies B (2)

¹⁴¹ WIPO (n 95) 72.

¹⁴² *ibid*

¹⁴³ Luis H. Porangaba, *Acquired Distinctiveness in the European Union: When Non-Traditional Marks Meet a (Fragmented) Single Market*, (2019) 3 *Trademark Rep.* 619, 620.

distinctiveness can be divided into these following levels¹⁴⁴: (i) Generic marks: marks which define a class of things using common terms, due to the fact that such mark only indicate the goods or services without the capability to identify their sources or origins. A generic mark, therefore, could not serve as protectable trademarks.¹⁴⁵ An example of generic marks are the use of the terms CHAIR for chair, Drinking Water for drinking water, or SHOE for shoe; (ii) Descriptive mark: marks that convey an immediate idea of ingredients, qualities, or characteristics of related products or services. In order for a descriptive mark that is closely connected to the marked products or services to be protectable, the owner of such mark must be able to show the proof of acquired distinctiveness or secondary meaning in the marketplace. For example, AMERICAN AIRLINES for a U.S. national airline; (iii) Suggestive mark: marks which, when applied to products or services, require imagination, thought, perception to reach a conclusion as to the nature of their concerned products or services. For example, GREYHOUND for a bus service, JAGUAR for automobile, PLAYBOY for magazine. In the US, Suggestive mark can be registrable by first use without having to demonstrate acquired distinctiveness;¹⁴⁶ (iv) Arbitrary mark: means marks which is used without obvious relation to product or service. For example, APPLE for computer; and (v) Fanciful mark: means meaningless marks, made-up word or symbol marks, in other words, fanciful marks are marks without inherent meaning¹⁴⁷, it could also be said that it is the strongest protectable marks. Example of such marks are, KODAK for images or films, XEROX for printing and document services.

(2.2) trademarks that “consists of exclusively signs or indications which may serve to designate the kind, quality, quantity, intended purpose, value, and place either of origin or time of production.”¹⁴⁸ In other word, trademark used to describe goods under the trademark would be considered as descriptive mark. To find whether

¹⁴⁴ *Abercrombie & Fitch Co. v. Hunting World, Inc.* 537 F.2d 4 (2nd Cir. 1976).

¹⁴⁵ Dustin Marlen, *Visual Metaphor and Trademark Distinctiveness* (2018) 93 Wash. L. Rev. 767, 796.

¹⁴⁶ U.S. Patent & Trademark Office, TMEP, Section 1209.01(a)

¹⁴⁷ Dustin Marlen (n 98) 798.

¹⁴⁸ (n 140)

the mark is generic, consideration must be taken from the view of consumers as to whether they are likely to be reminded by sign, of reference to source of goods or services, characteristics of goods or services, or their geographical sources of origins.¹⁴⁹ In this respect, such trademark would be regarded as descriptive whether such descriptions were in the form of either written descriptions or pictures.¹⁵⁰

(2.3) trademarks that “have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed.”¹⁵¹ In this situation, such trademark would be considered as a generic mark.¹⁵² For example, the word “chair” for the goods which are chairs, or the use of the word “drinks” to describe teas in a broader sense, and vice versa the use of the word “hot tea” to narrow down the categories for teas.¹⁵³ It should be noted that where marks have fallen into grounds of descriptive and generic mark as mentioned above, they would not only be considered as prohibited marks in the ground that they are descriptive, but rather as they lack distinctiveness because they are descriptive¹⁵⁴, and failed to serve the distinguishing function of trademark.¹⁵⁵

(3) the trademark per se concerns elements that are “contrary to public orders or good morals.”¹⁵⁶ In this respect, this refusal approach comprises with concepts of the terms “public order” and “good moral”. Trademarks that violated public order often exemplified as marks comprising of emblems of forbidden political ideology or unappropriated symbol of religious entities. While, trademarks that violate

¹⁴⁹ WIPO (n 95) 73.

¹⁵⁰ Bodenhausen (n 139) 115.

¹⁵¹ (n 140)

¹⁵² Bodenhausen (n 139) 116.

¹⁵³ WIPO (n 95)

¹⁵⁴ Bodenhausen (n 150)

¹⁵⁵ *ibid*

¹⁵⁶ Paris Convention, a 6quinquies B (3)

good moral are often cited, for example, as marks containing pornographic images or represents an obscene gesture.¹⁵⁷

In conclusion, these three requirements of trademark protectability shared by all national and regional trademark law regimes and accepted as a fundamental criterion of protectability should exist in all jurisdictions.¹⁵⁸ However, due to the fact that trademark protection basis employs the principle of territoriality, criteria for trademark protectability shall not necessarily be limited to only the said requirements. Rather, each jurisdiction can impose any other criterions to broaden or limit their scope of trademark protection as appropriate to their national policy. The protection of a well-known mark, for example, introduced by Article 6bis of the Paris Convention that imposes an obligation to the Contracting Countries to protect unregistered well-known mark recognized by other Member countries, or the functionality doctrine developed by the US trademark regime to prevent the unfair competition.

2.3 Motion and Multimedia

Due to the extensive scope of trademark in theory, any signs can constitute a trademark as long as they possess trademark functions as mentioned earlier. Similarly, motion and multimedia signs should also be considered as trademark so long as they serve the same functions. To illustrate the concept of motion and multimedia marks, the study will explore the nature, definition, and characteristic of motion and multimedia marks in general, the process of producing motion and multimedia, and later explore the possibility of motion and multimedia marks to be applied as a trademark.

¹⁵⁷ Bodenhausen (n 150)

¹⁵⁸ WIPO (n 95) 71

2.3.1 Historical Background of Motion and Multimedia

Motion was described in many scopes of knowledges. In psychology, motion is one of a studying subjects concerning the perception of motion or movement.¹⁵⁹ In theory, although animal can perceive movement in various senses, including but not limited to visual system, auditory system, gustatory system, or olfactory system. Motion is still considered to be a movement that animal eyes can most effectively captured. However, among diversity of animal types, each animal has different level of capabilities in perceiving movements.¹⁶⁰ In a visual system, apart from the perception of still images, human being can also perceives motion on the ground of optical phenomena where the eyes's retina create a visual processing from the lights that are passed within the eyes.¹⁶¹ However, even though the retina in human eyes is the central of visual perception of movement, human eyes have a limitation of capturing or processing 10 to 12 separate images per second, and images will only be remaining for fifteenth seconds prior to their disappearance from the eyes sight. This happens even if the images are apparent at the time of capturing.¹⁶²

¹⁵⁹ Christopher D. Blair, Peter U. Tse, Gideon P. Caplovitz, 'Interactions of Form and Motion in The Perception of Moving Objects' in Johan Wagemans (eds) *Oxford Handbook of Perceptual Organization* (Oxford University Press 2015) 542

¹⁶⁰ Robbie S. Wilson, Jerry F. Husak, Lewis G. Halsey, Christofer J. Clemente, Predicting the Movement Speeds of Animals in Natural Environments, *Integrative and Comparative Biology*, Volume 55, Issue 6, December 2015, Pages 1125–1141, <<https://academic.oup.com/icb/article/55/6/1125/2363919>> accessed 5 March 2021

¹⁶¹ Louis Jolyon West, 'Illusion Perception' in *Encyclopedia Britannica* (19 June 2017), <https://www.britannica.com/topic/illusion>. accessed 5 March 2021.

¹⁶² National Film and Television School (NFTS), 'Persistence of Vision: How Does Animation Work?: How Does Persistence of Vision Work In Animation?' <<https://www.futurelearn.com/info/courses/explore-animation/0/steps/12222>> accessed 2 February 2021

With this limitation, the motion occurs in numbers of times that are too rapid to be perceived though human eyes.¹⁶³ As a solution, human tried to generate devices or inventions to help capture face paced motions, this endeavor can be seen in many ancient heritages, for example, the paleolithic cave paintings having livestock overlapping each other¹⁶⁴, drawing of the five continuous images painted on a Persian pottery in Iran¹⁶⁵, drawing of an Egyptian mural in burial chamber.¹⁶⁶ Apart from drawing and painting, motion was also shown as shadow puppets projected to illustrate moving images or animations on the screen.¹⁶⁷

One of the most important development of motion came from the discovery of the principle of persistence of vision. It was first raised and described by Peter Mark Roget in the early 1820s that if an image on the retina is sufficiently clear, the impression will remain for a certain amount of time after the cause has already lapsed.¹⁶⁸ In doing so, it would create a state of optical illusion by replacing previous image with subsequent images within the period of fifteenth seconds in order to continue a longer period for which picture remains in human brain.¹⁶⁹ In this respect, the principle of persistence of vision does not only challenge the biological limitation

¹⁶³ Chienchi Chen and Yutian Chen. "Visual Perception Survey Project: Perceiving Motion and Events." (2008) < https://www.ics.uci.edu/~majumder/vispercep/paper08/Perceiving_Motion_and_Events.pdf > accessed 5 March 2021

¹⁶⁴ Martin Paul Gray, 'Cave Art and the Evolution of the Human Mind' (2010) (Victoria University of Wellington: Master Degree Thesis) 3

¹⁶⁵ The Persian pottery consists five pictures of a goat going steps toward a tree, climbs to eat the leaves.

¹⁶⁶ Picture of Egyptian Burial Chamber Mural shows the ancient sport that two guys play alike wrestling

¹⁶⁷ G. Liao, 'Creative Animation Design for Inverse Kinematics Motions of Shadowgraphs Shadow Puppets in Taiwan' in *the 2nd International Conference on Design Creativity (ICDC2012)* (Glasgow 2012) 185-186

¹⁶⁸ Roget Peter Mark, 'V. Explanation of an Optical Deception in the Appearance of the Spokes of a Wheel Seen Through Vertical Apertures' (1825) *Phil. Trans. R. Soc.*, 115, 131-140

¹⁶⁹ National Film and Television School (NFTS) (n 162)

of human's visual perception but it is also a fundamental and crucial inspiration of production of both animation and cinematography of the following generation.¹⁷⁰

Due to the discovery of the persistence of vision, human's effort to create motions increases drastically. In 1820s, a British Physician, John Ayton Paris was recorded as the first inventor of "Thaumatrope,"¹⁷¹ a cardboard disc with two different printed images on each side that was tied up with a piece of rope or cord attached to opposite points near the edge. The thaumatrope is operated through a simple twisting rotation of the cord which would then spin the disk consolidating the images on each side of the disc together. This then presented an illusion of a complete image.¹⁷² In 1832, Joseph Plateau and Simon von Stampfer invented a device called "Phenakistoscope," a Victorian parlour toy for children.¹⁷³ This device works through an uncomplex spinning of the cardboard disc¹⁷⁴ which, as a result would show a repeated reflection of images moving through the rotation of the disc against the mirror as an illusion of moving image such as a man with a horse, a boy waking, and a couple dancing.¹⁷⁵ In 1834, two years following the invention of the pioneer "Phenakistoscope", William George Horner invented the "zoetrope," a drum with sequential still animations facing inward around the circumference.¹⁷⁶ The sequential

¹⁷⁰ See Kehr, Dave. "Animation". Encyclopedia Britannica, 28 February 2020, <<https://www.britannica.com/art/animation>> accessed 4 February 2021; see David A. Cook, Robert Sklar "History of Film". Encyclopedia Britannica, 20 November 2020 <<https://www.britannica.com/art/history-of-the-motion-picture>> accessed 4 February 2021.

¹⁷¹ History of Science Museum, 'Thamatrope' <<http://www.mhs.ox.ac.uk/exhibits/fancy-names-and-fun-toys/thaumatropes>> accessed 2 February 2021

¹⁷² Stephen Herbert, 'The Thaumatrope Revisited: A Round About Way to Turn'M Green' <<http://www.stephenherbert.co.uk/thaumatropeTEXT1.htm>> accessed 4 February 2021

¹⁷³ The Public Domain Review, 'Phenakistoscopes', <<https://publicdomainreview.org/collection/phenakistoscopes-1833>> accessed 4 February 2021

¹⁷⁴ *ibid*

¹⁷⁵ *ibid*

¹⁷⁶ Reframing Photography, 'How To Make A Zoetrope' <<https://www.reframingphotography.com/content/animating-photographs>> accessed 4 February 2021

still images on the opposite wall can be seen through an equal spaced viewing slots light up by the opening top illuminating the images. As a consequent of spinning the drum, the Stroboscopic effect and the illusion of moving image would appear.¹⁷⁷

It could be said that these developments become the cornerstone of making and producing motions in the new era. These developments illustrate the importance of motion as the media in enhancing viewer experiences with entertaining and attracting purposes. For this reason, motion takes on an important role as the key factor of both animation and cinematography. In order to straighten the understanding of motion and demonstrate the development of motion in the context of multimedia, brief historical overview of these fields should be examined.

Cinematography and animated film, prior to the innovation of photography, began from an achievement of the positive photographic process called “daguerreotype,” the first photographic process presented an image on a silvered copper plate, made by Louis-Jacques-Mandé Daguerre in 1839.¹⁷⁸ Later, numerous inventions of motion pictures were invented. In 1878, a British American photographer Eadweard Muybridg used 12 cameras to take a sequential pictures of a horse in motion.¹⁷⁹ In 1882, a French physiologist Étienne-Jules Marey took the first series photographs with a single chronophotographic gun that recorded 12 sequential photographs per second.¹⁸⁰ It should be noted that early films were made without sound composition, and are called the silent films era which means all films were produced without dialogue. In doing so, the film maker must dramatically emphasize

¹⁷⁷ *ibid*

¹⁷⁸ The Franklin Institute, ‘Daguerreotype Photography’ <<https://www.fi.edu/history-resources/daguerreotype-photography>> accessed 7 March 2021

¹⁷⁹ Randy Alfred, ‘June 15, 1878: Muybridge Horses Around With Motion Pictures’ (15 June 2009) <<https://www.wired.com/2009/06/dayintech-0615/>> accessed 7 March 2021

¹⁸⁰ Paul Sorene, ‘Étienne-Jules Marey: Filming Life on The Move Through An All-Seeing Eye’, 3 September 2015 <<https://flashbak.com/etienne-jules-marey-filming-life-on-the-move-through-an-all-seeing-eye-39491/>> accessed 7 March 2021

on visual language acted in their film.¹⁸¹ During such time, all films were made without sound, causing the period to be called “the silent era.” However, the remarkable advance of film in relation to sound occurred when Thomas Edison was able to invent the first device relating to sound called “Phonograph.” Following Thomas Edison invention of a device for the mechanical recording and reproducing sound called “Phonograph,” Dickson tried to combine sound with the motion-picture by inventing the Kinetograph¹⁸², the first camera to take motion pictures on a moving strip of film. After the Kinetograph was publicized, it inspired the Lumière brothers, Auguste and Louis, to invent the first viable projector called “cinématographe”¹⁸³, a motion picture film camera used as both camera and projector. Not only that, in 1896, Robert W. Paul made the theatrograph, also known as animatograph, a Britain fist motion-picture projector used in music hall.¹⁸⁴ After the remarkable change of sound composition, the silent era of film is awoke, and the endeavor of Dickson to combine sound into film has become an inspiration for the followed inventors and directors to compose sound into film, which is also known as sound synchronizing. The Chronophone invented by Léon Gaumont, for example, were inspired by Dickson with an endeavor to produce several synchronizing sounds into animated film before 1912, or Oskar Messter who started to compose and added the recorded musical scores into his films in 1908.¹⁸⁵ Even though there are various problems, particularly technological limitations, regarding the film produced in connection with sound in the early time, including but not limited to the range limitation of microphones, and problems on

¹⁸¹ Annabel Lagasse, *An Exploration of the Creative Challenges in Representing Human Movement in Digital Animation*, (PhD Thesis: Nottingham Trent University and Southampton Solent University 2015) 87.

¹⁸² Cook, Sklar (n 170)

¹⁸³ *ibid*

¹⁸⁴ Ned Hémard, ‘New Orleans Nostalgia: Remembering New Orleans History, Culture and Traditions’ <https://www.neworleansbar.org/uploads/files/Vitascope%20Hall%205_8_13.pdf> accessed 7 March 2021

¹⁸⁵ Cook, Sklar (n 170)

camera noise¹⁸⁶ which makes sound recording and editing for films become more complicated. Most of these technical problems were resolved by special techniques underlying the technological development.

Apart from the motion devices mentioned above, there are other devices made to create motion, for example, flip book; a small book consists of many pages, each page having images placed near its untied margin in a sequence of motion. The flip book was first invented by John Barnes Linnett and has been patented as the kineograph in 1868. The user bends all the pages back, normally with their thumb, then by a gradual motion of the hand allows them to spring free one at a time. Unlike phenakistoscope, zoetrope and praxinoscope, the illusion created by the Flip book shows the substitution of each image by the next images in the same sequential series by the hand of user without requiring any other devices. Similar to the Zoetrope, the praxinoscope is the first projector that is capable of projecting animated figures onto the background. It was made by a French inventor Charles-Émile Reynaud in 1876. With the purpose of putting animations on films, proxinoscope was further developed into his Théâtre Optique (the so-called Optical Theater) which is an animated moving picture system with hand-painted colorful pictures in a long strip pierced with holes wound between two spools. Because of the fame Optical Theater received in context of film, the first film projected by the Théâtre Optique named *Pantomimes Lumineuses* was introduced in 1892.¹⁸⁷ With this development, it can be noted that *Pantomimes Lumineuses* became a crucial pinpoint of the later animation on films in the early 1900s. Later, animation has started to play a role in cinemas where stop motion short films as can be seen from *Le théâtre de Bob* produced by Segundo de Chomón in 1906 and *The Haunted Hotel* produced by J. Stuart Blackton in 1907. Following such development, motions did not only stand as a key factor of cinematography and animated films, but also took various roles in many industrial fields including multimedia. This will further be captured under the development of multimedia.

¹⁸⁶ *ibid*

¹⁸⁷ Glenn Myrent, "Emile Reynaud: First Motion Picture Cartoonist" (1989) 3 Film History 191, 191–202

For multimedia, remarkable advancement of multimedia concretely arose in the late twentieth centuries even though it was influenced by the early development of animation and cinematography. Multimedia was first explained in a computing sense using the old term called “hypermedia” originated from the idea that devices should allow a user to trace freely through a variety of information sources¹⁸⁸, which would help then verify a connection between document and allow readers to follow a the progress of ideas more easily.¹⁸⁹ Following the emergence of hypermedia, the term “multimedia” was introduced in a marketing sense following the rise of computing development when the head of Apple company, Sueanne Ambron plan to sell their Macintoshes computers dealing with sound and graphic to educational institutions, she comfortably uses the term “multimedia” to describe how the Macintoshes computer works instead of the old term hypermedia. As multimedia employs many different modality including writing, visual, sound, movement and spatiality¹⁹⁰, this research would like to focus the study of multimedia only in the sense of it being used as a non-traditional trademark, the study therefore will focus on historical background of multimedia in the fields of visual, sound, and movement.

In Thailand, the development of motion and multimedia marks can be divided into two phases which are a period before the twentieth century and a period after the twentieth century. Before the twentieth century, Thai animated film was first presented in 1943 in the advertisement of “Boriboon balm” introduced by the Sanpsiri Advertising Agency owned by Mr. Sanpsiri Viriyasiri, one of the most well-known Thai journalist.¹⁹¹ However, the year where such film was created was still unclear, as

¹⁸⁸ Vannevar Bush, ‘As We May Think’ (1945) The Atlantic JULY 1945 ISSUE <http://mnielsen.github.io/notes/kay/assets/bush_1945.pdf> accessed 7 March 2021

¹⁸⁹ Theodor Nelson, *Literary Machines* (Mindful 1982), 2

¹⁹⁰ Anne Cranny-Francis, *Multimedia: Texts and Contexts* (SAGE 2005) 2

¹⁹¹ วิสิฐ จันมา, *ประวัติศาสตร์และพื้นฐานการออกแบบภาพเคลื่อนไหว* (สำนักพิมพ์จุฬาลงกรณ์มหาวิทยาลัย 2558) [Visit Janma, *History and Basic of Animation* (Chula Press 2013)] 30

another reliable source has recorded that this advertisement was made in 1962.¹⁹² After that, even if numerous animation advertisement were launched by the Sanpsiri Advertising Agency, the first animated film of Thailand named “*Het Mahasajan* (Amazing Incidents)” was the first shown on screen at Sala Chalermtai in 1955. This film was directed by Payut Ngaokrachang, an animated director who made several early Thai animated films such as *Hunuman Pachern Phai* (Hanuman faces new threat)(1957), *Dek Kub Mhee* (The boy and the bear) (1960), and the first Thai long-period animated film “*Sud Sakorn*” (1979).¹⁹³ After that, in the early of the twentieth century, several Thai modern animated films were launched broadcasting on either screen or television such as *Kaew Jom Gan* (2001), *Pangpond the animation* (2002), *Dracula Tok* (2003), *4 Angles* (on television) (2006), *Khan Kluay* (2006), *Nak* (2008), *Echo* (2012), and *Yak* (2013).

2.3.2 Definitions and Characteristics of Motion and Multimedia

In general, the term “Motion” has a few general meanings such as “the act or process of moving or the way something moves” or “a particular movement made usually with your hand or your head, especially to communicate something.” In addition to the general meaning, there are many fields of study that deals with the study of motion or movement in numerous different aspects depending on the context of each field. The following descriptions show a good example of motion as the object of study. In Psychology, motion would be considered in an aspect of the perception of movement or motion called “motion perception”, the term “motion perception” can be defined as the process of inferring the speed and direction of objects based on

¹⁹² Film Archive (Public Organization), ‘โฆษณาขี้ผึ้งบริบูรณ์บาล์ม ชวดหนูหล่อพ่อเขาพาไปดูหมี (The Advertisement of Boriboon Balm: Noo Lhor, His Father Brings Him to See the Bear)’ <<https://www.fapot.or.th/main/archive/101>> accessed 17 February 2021

¹⁹³ John A. Lent, “A Screw Here, a Crank There”: Payut Ngaokrachang and the Origins of Thai Animation’ in *Animation World Magazine*, Issue 2.1, April 1997
<<https://www.awn.com/mag/issue2.1/articles/lent2.1.html>> accessed 17 February 2021

visual input.¹⁹⁴ Motion perception is a crucial ground of studying the detection of image motion by human brain cells which leads to motion after-effect perceived as optical illusion.¹⁹⁵ Later, in Anatomy, motion was described as “movement” of human body. There is a study on musculoskeletal system as one of anatomy’s branches dealing with the movement of the upper limb or lower limb and those of the head, neck, and body.¹⁹⁶ In a dramatic work, motion was described as movements and actions in the art performing, particularly dancing. Physical movements are crucial elements in the nature of dancing because without such, dancing cannot be performed.¹⁹⁷ Dancing is described as activities normally conducted by human in either natural movements or movements inspired from imagination.¹⁹⁸ In fact, there are various types of performing art around the world in both Eastern dancing and Western dancing. For example, Thai dancing is an art influenced by Indian performing arts¹⁹⁹, the postures of Thai dancing was described in the Sanskrit treatise named “Natya Shastra²⁰⁰,” while Ballet dancing is a western performance dance originated from Italian Renaissance prior to becoming a famous dance in France and furtherly developed into a well-known dance around the world. In physics, motions or movements are an object of studying in various fields. In classical mechanics, the subject deals with the study of the motion of things that

¹⁹⁴ Boundless Psychology, ‘Advanced Topics in Perception’ <<https://courses.lumenlearning.com/boundless-psychology/chapter/advanced-topics-in-perception>> accessed 7 March 2021

¹⁹⁵ George W. Mather, ‘Motion Perception, Psychology of’, 29 June 2009 <http://www.lifesci.sussex.ac.uk/home/George_Mather/Papers/MatherMotion.pdf> accessed 6 February 2021

¹⁹⁶ Nigel Palastanga, Derek Field, and Roger Soames, *Anatomy and Human Movement: Structure and Function* (Heinman Medical Books 1989), 1

¹⁹⁷ Haig Khatchadourian, ‘Movement and Action in the Performing Arts’, (1978) 37 *Journal of Aesthetics and Art Criticism* 25, 25

¹⁹⁸ *ibid*

¹⁹⁹ Watcharapong Soongpankhao, Naret Kuntawong, Wantana Khutchan, ‘Thai Classical Dance’, 10 February 2017 <https://repository.rmutp.ac.th/bitstream/handle/123456789/2181/LARTS_60_07.pdf?sequence=3&isAllowed=y> accessed 7 March 2021

²⁰⁰ *ibid*

are larger than an atom or a molecule²⁰¹ the subject described the term motion as a state of an apparent change of a body in its position with time.²⁰² While quantum physics subject deals with the study of physics in atomic scale.²⁰³ Lastly, fluid and thermodynamics subject deals with the study of motions of fluids.²⁰⁴ In journalist and mass communication, motion was described in the sense of multimedia as the term “motion graphic” or “animation.” To understand the meaning of motion in the sense of mass communication, the definition of these two terms should be considered. In fact, it is impossible to draw a line as to what is the exact meaning of the term motion graphic. Motion graphics are sometimes defined as encompasses movement, rotation, or scaling of image, video, and text over time on screen, usually accompanied by a soundtrack.²⁰⁵ Separately, the definition of the word motion alone can also be closely linked to a description of an animation, which means “the artificial creation of the illusion of movement in inanimate lines and forms.”²⁰⁶ Moreover, animation can practically be defined as a film made by hand, frame-by-frame, providing an illusion of movement which has not been directly recorded in the conventional photographic sense.²⁰⁷

Due to the remarkable development of technology, it has penetrated every aspect of human lives. Accordingly, technology is also used with multimedia for creating interaction between content creators and users. Animation or motion,

²⁰¹ Julio Gea-Banacloche, ‘University Physics I: Classical Mechanics’ Open Educational Resources (2019) <<https://scholarworks.uark.edu/oer/3>> accessed 6 February 2021

²⁰² Richard P. Feynman, Robert B. Leighton, Matthew Sands, ‘The Feynman Lectures on Physics: Mainly Mechanics, Radiation, and Heat (1964) <https://www.feynmanlectures.caltech.edu/III_01.html> accessed 6 February 2021

²⁰³ *ibid*

²⁰⁴ Alessandro Bettini, *A Course in Classical Physics 2: Fluids and Thermodynamics* (Springer: 2016), 1

²⁰⁵ Ian Crook, Peter Beare, *Motion Graphic: Principle and Practice from The Ground Up* (Bloomsbury: 2016) 20

²⁰⁶ Paul Wells, *Understanding Animation* (London: Routledge, 1998), 10

²⁰⁷ *ibid*

including sound and videos, were no longer stand alone on the field of cinematography. Instead, motion and animation were adapted as multimedia to represent more variety and sophisticated information to enhance human learning potentials. Therefore, motion and animation should be explored in parallel with multimedia in order to fulfill the understanding of motion and multimedia marks.

The term multimedia is defined differently through various points of view and aspects. Generally, multimedia has a computing definition which Oxford dictionary defined as the state of using sound, picture, and film in addition to text on a screen. However, there are many other definitions available for such term, for example, it is defined as “any combination of text, graphic art, sound, animation, and video that is delivered by computer”, or as “something that combines the capabilities of technologies that used to be separate – such combination ranges from text, graphics, sounds and still or motion pictures, and are combined in a smooth way to present information, print, telecommunications, video, broadcasting and computers.”²⁰⁸ Apart from the computing definition, the field of teaching and art also defined this term in the sense of using different ways to provide information.²⁰⁹ Unlike computing, in teaching and art, multimedia would not be considered as systems or product but rather as a sense of communication. This is because, unlike media that uses only one communication channel, multimedia consists of application that uses multiple modalities to their advantage, including text, images, drawing, graphics, animation, video, sound (including speech) and most likely interactivity of some kind.²¹⁰

In context of law, particularly law on trademark, the definition of motion and multimedia would be given in accordance with functions of trademark, the law therefore defines the term “motion” and “multimedia” in a different way transforming the term “motion” and “multimedia” into separate legal technical terms. The

²⁰⁸ Bart Dahmer, “When Technologies Connect”, (1993) Training and Development 46, 46

²⁰⁹ Oxford Dictionary defined the term “motion” and “multimedia” in various meaning depends on the relevant field.

²¹⁰ Ze-Nian Li, Mark S. Drew, and Jiangchuan Liu, *Fundamental of Multimedia* (2nd edn, Springer 2014) 3

definitions of motion and multimedia in a legal context will be further explained in part 2.3.4.

2.3.3 Production Process of Motion and Multimedia Signs

Although there are no concrete and strict rules in making motion and multimedia marks, the process of making motion or animation can be divided into three essential phases. Throughout this part, the terms motions and animations may be used interchangeably or collectively, the meaning of which are intended by the author to be the same.

First, the pre-production phase, this phase involves the designing and planning of concrete framework for animation or multimedia works.²¹¹ Since motion is mainly aimed at entertaining audiences, it should therefore be represented in a clear and unambiguous way.²¹² In doing so, the producer should first prepare a plot of a story the motion will be telling, and prepare a storyboard. Under certain circumstances, if the motion comprises with sound, then sound composing, designing, and editing should also be planned together with a storyboard and script.²¹³

Second, the production phase, this phase is the most essential process of motion productions, many principles of motion, processes, and techniques are used in this phase. To illustrate the production process of motion, the explanations of this phase will start with the basic principle of making a motion or animation. In making a motion or animation, there are twelve fundamental principles of animation developed by the Walt Disney Studio as a basic guideline for producing hand-drawn animation.²¹⁴ First, no rigid shape can be found in motion, the producer should first

²¹¹ Andrew Selby, *Animation* (Laurence King Publishing 2013) 26-27

²¹² John Lasseter, 'Principles of Traditional Animation Applied to 3D Computer Animation' <<https://www.utdallas.edu/atec/midori/Handouts/Lasseter.pdf>> accessed 16 February 2021

²¹³ *ibid*, 125

²¹⁴ Frank Thomas, Ollie Johnston, 'The Principles of Animation' in *The Illusion of Life: Disney Animation* <<https://www.utdallas.edu/atec/midori/Handouts/Principles.pdf>> accessed 16 February 2021

follow the *Squash and Stretch* concept which deals with emphasizing the actual rigidity and mass of objects during the time when they will be moving. Next, *Timing* will come into play with the declaration of meaning which underly each movement, the speed of an action shows weight and size of objects, and the personality of character which helps ease the audience understanding. Right before the movement begins, the third concept of *Anticipation* will be used in conjunction with the first concept of *Squash and Stretch* to prepare an appropriate action that will lead the audience thinking process. The fourth concept is *Staging*, which express or represent a clear idea in an exact order which can be recognizable by the viewer. The fifth concepts is *Straight Ahead Action and Pose-To-Pose Action*, this concept described an approach of the movement creation, comprising of the *Straight Ahead Action* where the producer works literally straight ahead from the first hand-drawing toward the end of the scene. In doing so the producer can add new ideas or take off any drawing he want in process. Similarly the *Pose-to-Pose Action* is where the producer make an action plan to find out which drawing to be animated and create relationship between the drawings. The sixth concept is *Follow Through and Overlapping Action*, this process creates a continuing relationship between the first action and the following actions in order to maintain the natural look of actions and give a feeling of weight and living form. The seventh concept is *Slow in and Out*, this concept deals with the spacing in between the drawings and extreme poses to achieve exquisite movement and timing. The eighth concept is *Arcs*, this concept can be described as the visual path of action from one position to another. The nineth concept is the *Secondary Action*, this concept can be described as a dependent action that directly results from and surrounds the primary action so as to compel the interest of such movement. The tenth concept is *Exaggeration* which can be described as a way of stressing an important idea through actions and designs. The eleventh concept is *Solid Drawing*, which is the traditional concept of a drawing which must be precise in position and angle.²¹⁵ The last concept is *Appeal*, this concept can be described as creating a design

²¹⁵ ibid

and action that attract the audience to help serve the entertainment purpose of motion. It should be noted that even though these principles were generally described as a fundamental principle of hand-drawing animation, these principles can also be applied to computing animation in certain circumstances.²¹⁶ Aside from principles of motion or animation as mentioned above, the process of production should be explored through the view of motion techniques for production as well so that reader can understand the whole process of motion production. In this respect, techniques for creating motion can be divided in the following ways:

(1) Ancient technique, as mentioned in the historical background the creation of motion in an ancient time comprises of various basic techniques. Puppet animation, for example, is one of the oldest techniques used to produce motion. At first glance, puppet animation was used for shadow playing and was developed to play with the tangible nomination using human control.²¹⁷ Another technique is the Zoetrope, an ancient motion technique which was known to created Phenakistoscope. This technique is a mixture of work between hand-drawing, paper collage and the cylinder shape of Zoetrope. This technique employs principle of the persistence of vision to create loop animation and crucially inspires others relevant techniques employing persistent of vision such as camera less motion on Flip book.²¹⁸

(2) Line animation, a traditional technique of creating motion which deals with hand-drawing. This motion technique, also known as “two-dimensional draw animation,” made by drawing a picture on a two-dimension plane such as drawing on paper or board. Moreover, this technique employs two principles of motion which are Squash and Stretch concepts and Timing concept as an essential concept in creating line animation.²¹⁹

(3) Simple cut-out animation, this traditional technique can be used in conjunction with various other techniques including drawing and painting, camera less,

²¹⁶ John Lasseter (n 199)

²¹⁷ Janma (n 191) 83

²¹⁸ Reframing Photography (n 164)

²¹⁹ Janma (n 191) 94-97

sound in production, and computer graphic.²²⁰ In essence, this technique can be performed by placing pieces of paper or other cut out materials on a plane or surface. Then, the producers can add or take off the pieces to create movement they desired.²²¹

(4) Camera motion, this technique can widely explained any methods of creating motion by camera. Pixilation, for example, is one of a camera technique using either still image camera or motion picture camera to take picture or record human action, using such actions as a master of motion. The same can be achieve suing Stop motion technique, a technique using camera as the main medium of recoding, this works by using a camera to capture motion of actor or actress one by one, then combining the footage by editing them frame-by-frame turning them into motion picture. Stop motion can create both two-dimensional or three-dimensional outcome, and can be worked together with other techniques such as cut-out animation, clays animation, puppetry animation, or oil-and-sand animation.²²² It should be noted that both of Pixilation and Stop motion can work well with devices. In cinematography, Stop motion was famous for its use in production of motion pictures throughout the twentieth century, and remain widely used in the twenty-first century.²²³

(5) Oil and sand animation, this technique works by painting oil or sand onto two-dimensional glass plane, the producers can use oil or sand as a medium of painting instead of pencil or colour.²²⁴

(6) Computing animation, is a technique of creating motion by computer which can be presented in both two-dimensional and three-dimensional computing animation. For two-dimensional computing animation, it is generated from creating, producing, and editing using digital technology.²²⁵ Most two-dimensional computing

²²⁰ *ibid* 87

²²¹ Selby (n 211) 138

²²² *ibid*

²²³ See Janma (n 191) 90-91

²²⁴ Selby (n 211) 137

²²⁵ *ibid* 133

animation are generated by using computer to draw lines in a flat and simple form, but only length and width of motion be shown. Similarly, three-dimensional computing animation employs computer graphic technique²²⁶ in generating and expressing the length, width, and depth of motion which is more sophisticated than two-dimensional animation.²²⁷

Third, post- production phase, this phase takes is the most time consuming phase to complete because it is a guarantee that animation satisfies the purpose of entertainment and the expectation of the audience and target group. This paper would further explore and accentuate on the process of production in other part.²²⁸ However, in brief, the development of an existing raw work can be achieved by putting the environmental elements such as natural phenomenon, visual effects, relevant motion graphics, and sound composition into the main movement.²²⁹

Due to the fact that multimedia is a combination of two or more types of current media, production process of multimedia should not be touched lightly. Instead, multimedia production should explained each and all types of medias. However, to serve the point that this paper emphasizes to explore, the explanation would be focus only on the production process of videos and any medias relating to sound composition aside from the production process of animation which is only one type of multimedia as described.

2.3.4 Motion and Multimedia as a Trademark

Due to the technological development and enormous trade globalization, motion and multimedia no longer only stand in the fields of media, computer, and cinematography. Motion as a physical movement which can be found in normal human life began to be considered as utilizable for commercial and trade

²²⁶ Janma (n 191) 100

²²⁷ แอนนา พายัพัต, *มัลติมีเดีย เพื่อการนำเสนอ* (พิมพ์ครั้งที่ 2 กรุงเทพฯ : โอเดียนสโตร์ 2558) [Anna Payupat, 'Multimedia for Presentation' (2nd eds, Odient Store Publisher 2015)] 78

²²⁸ Selby (n 224)

²²⁹ See Janma (n 191) 47

purposes to satisfy consumers attraction, and create value to the brands and enterprises. One field that strongly recognizes the economic value of movement is sport industry, which is directly related to physical movement. Some scholars have raised the value of movement or motion saying that particular sport moves can possibly secure an exclusive right in the legal community as an intellectual property.²³⁰ Even if this opinion is made only in the sense of a sport move, the author understands that it such recognition shows that movement in any forms may be eligible in securing an exclusive economic right in the fields of IP law. As a response, all fields of intellectual property should open the door for motion to secure its rights if subject-matter requirements of each intellectual property can be met. Patent, for example, should protect a movement if such movement meets all patentable subject matters such as novelty, inventive step, and industrial applicability. Similarly, Copyright should allow the protection of motions which are creative and original.²³¹

Turning the focus on to trademark, since key purpose of trademark is to serve the function of indicating and distinguishing, this means that any signs which are capable of indicating the source of products or services and distinguishing a product or service from others, should be eligible for trademark protection. This notion is accepted by the U.S. Supreme Court in *Qualitex Co. v. Jacobson Prods Co.*, as mentioned above that anything can constitute a trademark as long as it has a potential to distinguish and identified one good or service. The concept underlying the Court decision is that, the actual domain of trademark protection, regardless of the public policy to provide protection by each state, is theoretically comprehensive. With regard to motion and multimedia signs, it was claimed as a feature of use in commerce for helping consumers to recognize and distinguish one product from several similar products in the same marketplace. Owing to the similar capability in distinguishing and identifying the source in a manner that is similar to other signs which can constitute a trademark. Thereby, motion and multimedia signs should be considered as one of the

²³⁰ Robert M. Kunstadt, Are Sports Moves Next in IP Law?, (1996) NAT'L L.J., 20, 20

²³¹ F. F. Scott Kieff, Robert G. Kramer, Robert M. Kunstadt, It's Your Turn, But It's My Move: Intellectual Property Protection for Sports Moves, (2012) 25 Santa Clara High Tech. L.J. 765, 767

comprehensive types of non-traditional trademark.²³² Because of technological advancement, the complexity of marketing strategies increases to capture the mind of consumer, this causes branding companies to spend a lot of money on advertising and representing their products or services in a new platform.²³³ In doing so, motion and multimedia marks play an important role and are used and appeared on various form of products and services. For example, motion graphics and real time videos were increasingly attached on goods, packaging, advertisements, and internet websites.²³⁴ This can be done because of the unique feature of motion and multimedia advertising which is the capability to be represented on many multimedia channels. Motion and multimedia marks therefore, have a strong visual capacity to capture the attention of consumers.²³⁵ Through a strong symbolic representation of motion marks, motion and multimedia marks serve as a powerful business tool for branding company capturing interests of consumers and leaving memorable representation.²³⁶ As a result, motion marks aided consumers in relating with the producers or trademark owners on multiple unique levels.²³⁷ Moreover, visualizations of motion and multimedia marks can be applied in a similar way as the traditional marks to attract the consumer, causing consumers to promptly remember the associated products or services of a recognizable mark.²³⁸

In details, motion and multimedia marks appeared in various forms which can be divided into three forms as follows:

²³² *ibid*, 261

²³³ See *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423 (7th Cir. 1985)

²³⁴ Kieff, Kramer, Kunstadt (n 231) 785.

²³⁵ Lesley Matty, 'Rock, Paper, Scissors, Trademark: A Comparative Analysis of Motion as a Feature of Trademarks in the United States and Europe' (2006) 14 *Cardozo J Int'l & Comp L* 557, 563.

²³⁶ Gilson, LaLonde (n 58) 64-65.

²³⁷ Seiko Hidaka et al., 'A Sign of the Time?: A Review of Key Trade Mark Decision in the European Court of Justice and their Impact upon National Trade Mark Jurisprudence in the EU (2004) 94 *Trademark Rep.* 1105, 1120.

²³⁸ Gilson, LaLonde (n 58) 5.

First, computer generated animation, also known as computing animation, which is associated with an appearance of motion in the field of multimedia. As mentioned earlier, computing animation can be consisted as a sequence of images and can sometimes be composited with sounds or colours depending on the methods or messages that the producer tried to convey. This form is often represented in film, television, and other digital platforms such as internet website, and social media platforms. With the ease of approaching, motion and multimedia marks have become one of the most effective marketing tools in reaching the public because the marketer are able to create representation of their products through various marketing channels such as digital platforms, online advertisement, electronic billboards, and movie theatre previews.

Second, motion produced by goods, which is a form of motion generated from the product itself. For example, the motion marks of the Lamborghini doors conversion²³⁹, or the motion marks of the Yamaha speed boat.²⁴⁰ these two motion marks were registered in the U.S. jurisdiction.

Third, motion as a gesture sign, this deals with the physical movement of human. In general, gesture motion marks are often presented through a hand movement. Due to the primitive way of interaction and communication by human, gestures motion marks have rapidly become one of the most promising marketing strategies that branding company used to capture consumers attention as it is the easiest way to induce consumers to remember, recognize, and imitate such gesture sign.²⁴¹ For example, the gesture of Salt Bae, twiddled his fingers backward and forward to sprinkle salt is used as a trademark of the Turkish chef named Nusret Gökçe, also known as “Salt Bae”. The registration was approved by the European Union Intellectual Property Office (EUIPO) for clothing, accessories, and seasoning products even if it was rejected for restaurant²⁴², or the Nokia mark “Connecting people” which

²³⁹ USPTO Reg. No. 2793439

²⁴⁰ USPTO Reg. No. 1946170

²⁴¹ Matty (n 235) 569

²⁴² Case R 2661/17-5 Motion of A Chef Adding Salt to A Piece of Meat (08/06/2018)

is the gesture marks depicted in the movement of two hands coming together that presented on the screen of a cellular phone.²⁴³

However, as trademark registrations, particularly the U. S. law are subjected to the principle of non-functionality, the applicant for gesture motion mark has a high risk of being refused on the ground of functionality because gesture motion may not be essential to the use and purpose of a device.²⁴⁴ Furthermore, even if the motion and multimedia marks were clearly categorized as a type of trademark, the protection and enforcement of motion and multimedia remains unclear and are often confused with other types of marks due to the nature of motion and multimedia signs that it is a mixture of other signs.²⁴⁵ In Lamborghini case²⁴⁶, The OHIM first Board of appeal, the current EUIPO, had refused the registration of the motion Lamborghini “scissor” doors signs on the grounds that such signs are the characteristic features of a car which is a shape of product, although such sign is sought to be protected as a movement of sign, not a feature. However, Lamborghini succeed in registering the said motion sign of scissor door in the US.

2.4 Protection of Trademark in Thailand

Like other fields of intellectual properties apart from copyright, trademark is protected under Thai law on a registration basis. However, this does not mean that any signs can per se, secure trademark rights. In doing so such mark must be able to fulfill all legal requirements to be protected as trademark. This part will explore more on the fundamental Thai trademark law, particularly on the definition of the term “mark” and “trademark”, their protectable criteria, and legal effects of a registration. Later, this part will also issue legal dilemmas relating to the problems and possibilities of motion and multimedia mark protection under Thai law.

²⁴³ USPTO Reg. No. 2623913

²⁴⁴ Matty (n 235) 567.

²⁴⁵ *ibid* 573-574.

²⁴⁶ Case R-772/01-1 Automobili Lamborghini Holding S.p.A's Application 43 ETMR 544

2.4.1 Definition of Mark and Trademark

In Thai Trademark law, the term “trademark” was defined as “a mark used or proposed to be used on or in connection with goods to distinguish the goods with which the trademark of the owner of such trademark is used from goods under another person’s trademark.” Not only that, but the law also employs the general criteria of trademark on other relative marks protected under the law including service mark; a mark used or proposed to be used to services instead of goods, or certification mark; a mark used or proposed to be used to certify the origin, composition, method of production, quality or other characteristics of goods or services, or collective mark; a mark used or proposed to be used by companies or enterprises of the same group or by members of an association, cooperative, union, confederation, group of persons or any other state or private organization. To understand the characteristics of trademark, its essential characteristics can be divided into three elements.²⁴⁷

First, trademark must be generated from a mark as defined by law.²⁴⁸ Second, trademark must be used or proposed to be used with goods. It should be noted that the law does not strictly imposed that the trademark must be used by the trademark owner prior to the registration of such trademark. Therefore, a mark proposed to use in the future can also be protected under the Thai Trademark law. However, in the case of a used trademark, the element of using in good faith has become one of the major concern in securing a protection under Thai law by employing the general criteria under the Civil and Commercial Code,²⁴⁹ even though this concept was not specifically provided for in the *sui generis* law.²⁵⁰ Third, the use of trademark must appear on goods or in connection with goods in order to serve distinguishing and indicating functions of trademark.²⁵¹ In contrast, if trademark is used with purposes other than in connection to goods, such mark will not be considered as

²⁴⁷ Supaonsiri (n 82) 16; Tingsamit (n 85) 7.

²⁴⁸ Tingsamit (n 85) 5; Hemarajata (n 86) 293.

²⁴⁹ Civil and Commercial Code, s 5

²⁵⁰ Tingsamit (n 85) 7; Hemarajata (n 86) 297.

²⁵¹ See Supaonsiri (n 82) 16.

trademark and cannot be protected by the Thai Trademark law. For example, in *Changdao flipflops* case, the plaintiff used a mark of elephant drawing within the star as trademark and secured a trademark, however when filing for a second mark using drawing of elephant within a Thai cursive pattern to be used on goods, such mark cannot be registered as a trademark although the second mark appeared on the exact same position with the first mark.²⁵² A curved strip within a rectangular frame are sometimes used as an aesthetic pattern on the goods and can be considered that it is not intended to be used as a trademark. Therefore, the said mark shall not be registrable.²⁵³

As we noted that in determining what can constitute a trademark under Thai law, the given trademark must pass the first qualification of being a mark as defined by law. To explore the answer of the said question, the consideration should be taken on the definition of the term “mark” as provided. According to Section 4 of the 1991 Act, the term “mark” means “Photograph, drawing, invented device, logo, name, work, phrase, letter, numeral, signature, combination of colors, figurative element, sound or combination thereof.”

According to the Section 4 of such Act, it can be seen that the definition of ‘mark’ strictly define marks which can constitute a trademark. Regardless of whether a mark meets the registrable requirements as provided by law or not, such mark must first falls under the definition of ‘marks’ under Section 4. The definition of the term ‘mark’ that can constitute a trademark was not define in a broad sense using phrase such as “trademark means...” instead it uses the phrase “trademark including...”. Thus, any signs whether capable of distinguishing or differentiating goods or services sold by one entrepreneur from others or not, if such sign does not fall under the definition of

²⁵² Supreme Court Judgement No. 958-959/2506

²⁵³ Trademark Board Decision No. 258/2529

‘mark’ as previously mentioned, it will not be registrable as a trademark under Thai Trademark Law.²⁵⁴

Taken into account the protection of non-traditional trademarks in international trademark law context, combination of colors and figurative marks (so-called shape mark) was however classified as non-traditional marks as well as sound marks.²⁵⁵ In Thai Trademark regime, combination of colours and figurative mark was only recently protected under Thai Trademark law following when Thailand has become member of WTO and a signatory of the TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights) as part of the WTO agreement in 1995. As a result, Thailand is obligated to ensure that Thai domestic Trademark law is in compliance with TRIPs Agreement. In essence, Article 15.1 of the TRIPS Agreement set a minimum standard of protectable subject-matters which can constitute a trademark by given lists of examples marks which can be eligible for registration and protectable as a trademark. As exemplified by the TRIPS, the list also includes “figurative elements” and “combination of colours.”²⁵⁶ To comply with this requirement in accordance with the TRIPS Agreement, the version of the Trademark Act at that time was amended particularly on the definition of “mark” under the law and other relevant provisions by including these two marks within the definition of what can constitute a trademark and also added the provision relating these two types of marks in order to provide sufficient protection for these two marks in accordance with the required minimum standard imposed by the TRIPS Agreement.²⁵⁷ However, according to the definition of the term “mark” under the Thai Trademark Act, it can be said that the current trademark protection is intended to be provided for marks that are visually perceptible, so called “visible mark,” and only visible mark shall constitute a

²⁵⁴ วิชัย อริยานันทกะ, ข้อสังเกตบางประการเกี่ยวกับกฎหมายเครื่องหมายการค้าและการป้องกันการแข่งขันที่ไม่เป็นธรรม, ใน *ทรัพย์สินทางปัญญาในยุคโลกาภิวัตน์ (เล่ม 1)* (Vichai Ariyanuntaka, Observations on Trademark Law and Prevention of Unfair Competition, *Intellectual Property in Globalization*) 8.

²⁵⁵ Gilson, LaLonde (n 58) 774.

²⁵⁶ TRIPS Agreement, art 15.1

²⁵⁷ See Thai Trademark Act (No.2) B.E. 2543 (2000), ss 3, 6

trademark. The protection does not include non-visible or perceptible mark.²⁵⁸ Although a combination of colour marks and figurative and shape marks are the first non-traditional marks to ever receive a trademark protection in Thailand, the nature and character of these marks can be visually perceptible per se and were categorized as non-traditional visible mark. However, at this time, the Thai trademark law is still silent on the protection of non-traditional mark in the types of non-visible marks. Until the 2016, the effective of Thai Trademark Act 1991 which was amended by the Trademark Act (No.3) B.E. 2559 (2016) the definition of the term “mark” was amended to also include “sound”. By doing this, it makes a sound mark, for the first time, can now constitute a trademark under Thai jurisdiction. Not only this amendment widen the scope of application of trademark protection under Thai law to sound which is one type of a non-traditional trademark, but it was also the first acceptance of non-visible sign protection under Thai trademark law which changes the ways of trademark protection from trademark which is visually perceptible to trademark which is perceptible by non-visual sense.²⁵⁹

Nevertheless, even if the scope of trademark protection under Thai Trademark law are stretched to also protect sound mark, the applicant of sound mark still have the duty to provide a graphical representation that the sound marks are capable of indicating original source or using as a benchmark of observation, recognition and differentiation from other sound.²⁶⁰ Aside from the combination of colour, figurative, and sound ability to constitute a trademark, there are attempts to

²⁵⁸ Supaponsiri (n 82) 15.

²⁵⁹ อุดมวุฒิ อุดมกิจอารี และ จุมพล นันทศิริพล, การให้ความคุ้มครองเครื่องหมายการค้ายุคใหม่, 5 วารสารวิชาการสถาบันเทคโนโลยีแห่งสุวรรณภูมิ (สาขามนุษยศาสตร์และสังคมศาสตร์) 649, 650 – 651 (Udomwut Udomkijaree and Jumpol Nandhasiripol, ‘The Protection of Nontraditional Trademarks’ (2019) 5 Journal of Suvarnabhumi Institute of Technology (Humanities and Social Sciences) 649, 650-651.

²⁶⁰ อมรินทร์ ม่วงมณี, การแสดงให้เห็นเป็นรูปธรรมในเครื่องหมายการค้าเสียงและเครื่องหมายการค้ากลิ่น (Amarin Muangmanee, ‘Graphic Representation in Sound marks and Scent marks’, <<http://www.ipat.or.th/images/Articles/DocTH/graphic.pdf>> accessed 18 January 2021)

broaden the scope of trademark protection under the Thai trademark regime to other types of non-traditional marks such as smell or olfactory mark.²⁶¹ However, due to considerable objections and arguments raised from many relevant parties,²⁶² particularly Ministry of Public Health, the Cabinet which has an authority under the law to approve any enactment of law, reaches the conclusion to return the draft of the amendment to the law to the Ministry of Commerce as the proponent of the said draft amendment to jointly reconsider the draft with the Ministry of Public Health.²⁶³ After the draft has been reviewed, the part to add “olfactory” into the definition of the term “mark” was eventually withdrawn.

In conclusion, even though the scope of trademark under the Thai Trademark regime remains limited, the development of non-traditional protection in both visible sign and non-visible sign can continually be found, and Thailand are likely to accept and broaden the scope of its trademark protection to cope with dynamic situations.

2.4.2 Criteria of Trademark Registrability

Trademark protection can be obtained through two different approaches namely registration basis and use basis. Thai Trademark law regime provides trademark protection system on the basis of registration. In doing so, not all trademarks will be protected under Thai Trademark law but rather only if it is registered with the

²⁶¹ สำนักงานเลขาธิการสภาผู้แทนราษฎร, ‘เอกสารประกอบการพิจารณาร่างพระราชบัญญัติเครื่องหมายการค้า (ฉบับที่...) พ.ศ. ...’ (2555) อ.พ. 16/2555 หน้า 1 – 4 (The Secretariat of the House of Representatives, ‘Supporting Document for the Draft of the Thai Trademark Act (no. ...) B.E. ...’ (2012) Aor. Por. 16/2555, 1-4) <https://library2.parliament.go.th/giventake/content_hr/hr24/apl016-2555.pdf> accessed 21 January 2021

²⁶² อภิรดา มีเดช, ‘จับตา! พาณิชย์เตรียมเสนอร่าง พ.ร.บ.เครื่องหมายการค้า จดทะเบียนกลิ่น-เสียง เข้าครม.’ (Apirada Meedech, Watch! Ministry of Commerce Prepares to Present a Draft of the Thai Trademark Act about Registering Smell and Sound Marks to the Cabinet) 11 November 2012 <<https://waymagazine.org/trademark>> accessed 21 January 2021

²⁶³ มติคณะรัฐมนตรีที่ พณ 12 พฤศจิกายน 2557 (The Cabinet Resolution No. Por Nor 12 November 2014)

Trademark Office. According to the Thai Trademark Act B.E.2534 (1991), there are three indispensable characters of trademark registrability which a mark registrable mark must possess.²⁶⁴ In other word, lack of either one or more characters would render a mark non-registrable and trademark protected under Thai Trademark law cannot be obtained.

2.4.2.1 Being a Distinctive Trademark

The first registrable requirement of trademark is distinctiveness. Distinctiveness is an essential character of trademark since it will sufficiently fulfill the function of distinguishing and indicating origin of product.²⁶⁵ Although there is no particular definition of ‘distinctiveness’ in legal definition of the Thai Trademark Act B.E. 2534 (1991), the term ‘distinctiveness’ was described in Section 7 of the Thai Trademark Act B.E. 2534 (1991) as a trademark that can lead people or user of goods to recognize and understand that goods used under such trademark are different from others.²⁶⁶

Nonetheless, in determining whether a trademark falls under distinctive requirement or not, consideration should be based on a distinctive character of each type of marks and each class of goods or services which such mark was used with. This is because a trademark can be inherently distinctive for certain goods, and lacks distinctiveness for other goods.²⁶⁷ Apart from the paragraph one of the Section 7, the Act provides more requirements on the criteria of distinctiveness, stating that if trademark has one or more following characteristics as specify in paragraph two of Section 7, then such trademark shall be considered as a trademark that is deemed to

²⁶⁴ Thai Trademark Act B.E. 2534 (1991), s 6

²⁶⁵ See Supaponsiri (n 82) 19; Tingsamit (n 85) 10.

²⁶⁶ Thai Trademark Act B.E. 2534 (1991), s 7 para 1

²⁶⁷ กรมทรัพย์สินทางปัญญา, คิดเครื่องหมายอย่างไร...จึงจะจดทะเบียนเป็นเครื่องหมายการค้าได้, เอกสารเผยแพร่ หน้า 58 (Department of Intellectual Property (DIP)), How to Think of the Mark That Can Be Registrable As a Trademark <https://www.ipthailand.go.th/images/781/tm_specific_2.pdf> accessed 7 March 2021)

be distinctive. These characteristics of a deemed distinctive trademark can be categorized based on the types of mark under Section 4, and into following manners:

In still image marks, namely photograph, drawing, and invented device, if they employ any similar characteristics as follows:

(1) an image of the applicant or third person with his/her approval or in the case where such person is dead, an approval must be given by his or her ascendants, descendants, or spouse, if any;²⁶⁸

(2) an invented device;²⁶⁹ it should be noted that an invented device means any devices invented from thinking, making, creating, or imagination. However, although there is a case explaining that if the device was invented outstanding from a normal character, such device complies with the distinctive requirement under the law²⁷⁰, the rule of invented device remains unclear.²⁷¹

(3) having no direct references to the characteristics or qualities of products;²⁷²

(4) not an image of maps or images which expresses the geographical location as prescribed by the Minister of Commerce who is in charge and have control over the execution of the Thai Trademark Act;²⁷³

In letter or numeral marks, the only characteristic required to satisfied the requirement of a deemed distinctiveness is being stylized.²⁷⁴ The description of being stylized is when letters and number are not shown in their respective normal form.²⁷⁵ In determining whether a mark shall be deemed distinctive in the stage of the registrar,

²⁶⁸ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (7)

²⁶⁹ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (8)

²⁷⁰ Supreme Court Judgement No. 3861/2531

²⁷¹ Supaponsiri (n 82) 42-43.

²⁷² Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (9)

²⁷³ *ibid*

²⁷⁴ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (4)

²⁷⁵ Supaponsiri (n 82) 33; Tingsamit (n 85) 19

being stylized are exemplified as being attached, being shallow or deep, written or drawn in pattern, and being shadow from its overlapped.²⁷⁶

In word or phrase marks, deemed distinction can be divided into two cases. In case of word mark, the word which can be deemed distinctive must be invented²⁷⁷, or having no direct reference to the characteristics or qualities of products and being not a geographical name as prescribed by the minister.²⁷⁸ It should be further noted that invented word means a made-up word without meaning or translation.²⁷⁹ Some scholars gave their opinion on the definition of deemed distinctive word mark as a combination of two meaningful words which are unusual and untranslatable and made up a new word²⁸⁰, and the initial of legal person that is written up in literately but is untranslatable²⁸¹ can also be considered as an invented device.²⁸² On the other hand, any translatable or meaningful words and misspelled word intended to have the same or similar pronunciation as a meaningful word, shall not be considered as an invented device.²⁸³ Moreover, if the mark has characteristics of geographical name located in either Thailand or other countries, such character is not only an indication that such mark fails to be deemed distinctive, but also render such mark unregistrable. Whereas, in the case of phrase marks, the only characteristic prescribed by the law is to have no direct references to the characteristics or qualities of products.²⁸⁴

²⁷⁶ สำนักเครื่องหมายการค้า กรมทรัพย์สินทางปัญญา, คู่มือแนวทางการพิจารณาสิ่งการของนายทะเบียนสำนัก
เครื่องหมายการค้า พ.ศ. 2559 หน้า 9 (Thai Trademark Office of the DIP, *Examination Manual of the
Trademark Office Registrar B.E. 2559* (DIP 2016), 9

²⁷⁷ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (3)

²⁷⁸ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (2)

²⁷⁹ Thai Trademark Office of the DIP (n 276) 8

²⁸⁰ Supreme Court Judgement No. 1333/2529

²⁸¹ Trademark Board Decision No. 172/2529

²⁸² Supaponsiri (n 82) 39-40; Tingsamit (n 85) 20

²⁸³ Thai Trademark Office of the DIP (n 276) 8

²⁸⁴ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (2)

In name or signature marks, deemed distinction can be divided into two cases. In case of name mark, if such mark comprises of either a personal name, a last name of natural person that is not considered an ordinary last name, a full name of juristic person, and tradename that employs the same crucial characteristic of having no direct reference to characteristics or qualities of products, then it can be considered as deemed distinction.²⁸⁵ While, in case of signature mark, whether such mark is a signature of the trademark applicant, his or her predecessor, or others with their approval shall be considered as a deemed distinctive trademark.²⁸⁶

Additionally, the provisions which deals with non-traditional marks can be divided into the three following categories:

First, in combination of colours marks, the said marks will fall into a distinctive character when the combination of colours are represented in a special manner.²⁸⁷ It this senses the requirements of being represented in a special manner means that a combination of colours must be specialized in different manners from an ordinary arrangement of line and strip of colours. For example, combination of colours represented in natural colour of products, or represented by functional and using of products shall not be considered as being represented in the special manner as required by law.²⁸⁸

Second, in figurative element marks, the said marks will be distinctive if a figure or shape per se is not a feature of the products or essential to the technical function of the products or increases the value of the products.²⁸⁹

Third, in sound marks, these marks will become distinctive if the sound has no direct references to the characteristics or qualities of products or is not a feature of the products or generated from functions of products.²⁹⁰

²⁸⁵ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (1)

²⁸⁶ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (6)

²⁸⁷ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (5)

²⁸⁸ Thai Trademark Office of the DIP (n 276) 10

²⁸⁹ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (10)

²⁹⁰ Thai Trademark Act B.E. 2534 (1991), s 7 para 2 (11)

The deemed distinctive characters as imposed by law employs several key concepts of trademark in the underlying characteristics. The first concept is “the spectrum of inherent distinctiveness,” which was established by the US Court of Appeals for the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World*. In essence, the US Court divided the level of distinctiveness for trademark into five categories, which are fanciful, arbitrary, suggestive, descriptive, and generic marks. Only fanciful, arbitrary, and suggestive marks are eligible for trademark registration and protection as an inherently distinctive trademark.²⁹¹ For fanciful and arbitrary marks, it is because they have no essential connection to the products being applied to,²⁹² while for suggestive marks, it is because they required the exercising of imagination from the consumer in parallel with the mark to relate to the products under the said mark.²⁹³ On the other hand, descriptive mark conveys an immediate idea of and identifies the ingredients, qualities or characteristics of the products²⁹⁴ with no need for the consumer to exercise their imagination²⁹⁵ therefore, they will not be considered as an inherent distinctive trademark per se, but such marks may be eligible for trademark protection if it can demonstrate an acquired distinctiveness through use or secondary meanings.²⁹⁶

Under Thai law, even if the Trademark Act is silence on which level of distinctiveness would be accepted as a distinctive trademark, the characteristic of “having no direct reference to the characteristics or qualities of products” which appears as the distinctive requirement for many types of mark such as name mark, word or phrase mark, and still image marks. This requirement requires “no direct reference” between the mark and the products under such mark which is in line with

²⁹¹ See *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 221 (3d Cir. 2000)

²⁹² See *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001)

²⁹³ See (n 270); see also *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001)

²⁹⁴ *Ibid* (n 270); see also *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1014 (9th Cir. 1985)

²⁹⁵ *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1145. (9th Cir. 2002), para 1141-42

²⁹⁶ Thai Trademark Act B.E. 2534 (1991) (n 270)

the meaning of descriptive mark as imposed by the US court. Thus, it can be concluded that a descriptive mark as previously mentioned, will be considered as having direct reference to the characteristics or qualities of the products they are related to, and shall not be considered as inherently distinctive under paragraph 2 of Section 7 of the Thai Trademark Act. However, the question that remains unresolved is whether suggestive mark is considered as directly referring the mark to the characteristics and qualities of the products under Thai law or not. To resolve this question, Supreme Court held that “the consideration should be taken on whether the mark which is used as a trademark conveys the public to their related goods or if the public can immediately make such reference because the mark is generic for such goods, or if the mark only requires mere exercise of imagination to refer the marks to the goods on which they are used, then the mark would be considered as having direct reference to the characteristics or quality of goods. Conversely, if the public still needs to exercise reasonable imagination to connect the mark with the designated goods, then such mark is merely to be suggestive. Hence, the mark shall not be considered as having direct reference to the characteristic or quality of goods”²⁹⁷ or “if the mark is only an indirect description of characteristics or quality of products and the consumer needs to take more steps of thinking and imagining, or translating to connect the mark with the designated goods, even if such mark is refer the characteristics or qualities of the designated goods, it may be considered as an indirect reference and capable of receiving protection under the law”.²⁹⁸ Nonetheless, in the administrative registration procedure, even if the details in determining whether a trademark has no direct reference to the characteristic or quality of goods as provided by the trademark manual of examination will be conformed with as the criterion given by the court judgments, the registrar including the Trademark Board still refuse to register trademark which may be considered as suggestive in many practical cases for a reason that the suggestive mark directly refer to the characteristics and qualities of goods, and it is not distinctive. For example, service mark application of the word “MY CLOUD” for electronic data

²⁹⁷ Supreme Court Judgement no.2040/2552

²⁹⁸ Supreme Court Judgement No. 2828/2561

collecting service on computer²⁹⁹, trademark application of the word “Superdry” for cloths and garments.³⁰⁰ Later, though the applicant of these two cases would file a lawsuit to the court for revocation of the order of the trademark registrar and the court decided to revoke the order of the registrar or the Trademark Board, and register these two marks due to the fact that the word “CLOUD” is a multiple-meaning word, it is therefore a word which the public can only merely make reference from the mark to the services, or needs to exercise enough reasonable imaginations to connect the word with the characteristics or qualities of services.³⁰¹ Similarly, the word “Superdry” is not directly connected to the quality of the products because the qualification of dryness is not a special quality of the clothing products in comparison to the functions of the attractive and fashionable design.³⁰² However, if suggestive marks are still being rejected in the administrative level and the applicant must always file a case to the court for revocation, not only the litigation cost and time for protection seeking would increase, but it would also make investors and trademark owners become more hesitant to make an investment in Thailand due to the uncertainty in trademark protection.

Apart from the characteristics of inherent distinctiveness under the first two paragraphs of Section 7, Section 7 still provides an additional requirement for a mark to be considered deemed distinctive. According to paragraph 3, the said requirement provided that although a mark without the said characteristics under paragraph two (1) to (11), if the trademark applicant can prove that his or her mark falls under all of the following requirements, such mark shall be deemed distinctive.³⁰³ First, the applicant shall demonstrate the widespread selling and advertising of the products under the mark in accordance with the rules prescribed by the notification

²⁹⁹ Order of the Trademark Registrar no.0704/18359; Appealing Decision of the Trademark Board No. 297/2560

³⁰⁰ Order of the Trademark Registrar no. (por nor) 0704/18091, dated 9 August 2553, and the Appealing Decision of the Trademark Board No. 558/2554

³⁰¹ Court of Appeal for Specialized Cases Judgement No. 9085/2562 (Decided Case)

³⁰² Supreme Court Judgement No. 15020/2558

³⁰³ Thai Trademark Act B.E. 2534 (1991), s 7 para 3

of the Minister.³⁰⁴ Second, the applicant must demonstrate that rules provided by the law have been satisfied. Such rules can be divided into the three following indispensable elements.

The first element is that the goods or services under the trademark must be widely sold and advertised for reasonably long period, enough to be known and understood by the general public or the particular public in the relevant sector that such goods or services are different from that of the others. In this respect, the term “general public” refers to a common target group or non-particular consumer,³⁰⁵ whereas the term “particular public in the relevant fields” merely refers to targeted consumer group of the products or services.³⁰⁶

The second element is the selling, widespread, or advertising of those goods or services popularizes the trademark on those goods or services in Thailand, and causes the said trademark to be deemed as distinctive for their specific goods or services. It must be noted that this examination of the widespread of the mark will neither be applied to products or services sold under the other registered marks, nor products or services without evidence of use regardless of the actual usage.³⁰⁷

The third element is the mark which can be entitled to the prove of use must be the same as the mark applied for trademark registration. In this respect, the Supreme Court held that the word “same” means that the two marks must carry

³⁰⁴ ประกาศกระทรวงพาณิชย์ เรื่อง หลักเกณฑ์การพิสูจน์ลักษณะบ่งเฉพาะตามมาตรา 7 วรรคสาม แห่งพระราชบัญญัติเครื่องหมายการค้า พ.ศ. 2534 แก้ไขเพิ่มเติมโดยพระราชบัญญัติเครื่องหมายการค้า (ฉบับที่ 2) พ.ศ. 2543 ณ 25 ธันวาคม 2555 (Notification of Ministry of Commerce Concerning Examination Criteria of Distinctiveness under the Thai Trademark Act B.E. 2534 (1991) as amended by the Thai Trademark Act B.E. 2534 (No.2) B.E. 2543 (2000) as into force on 25 December 2012)

³⁰⁵ บุญมา เตชะวณิช ‘กฎหมายเครื่องหมายการค้า’ ในหนังสือตำรากฎหมายทรัพย์สินทางปัญญา ของเนติบัณฑิตยสภา (สำนักอบรมศึกษากฎหมายแห่งเนติบัณฑิตยสภา 2555) [Boonma Tejavaniya, Trademark Law in *Thai Bar Association Intellectual Property Law Handbook* (Thai Bar Association under the Royal Patronage 2012)] 121.

³⁰⁶ *ibid*

³⁰⁷ Thai Trademark Office of the DIP (n 276) 15.

complete likeness by having precisely the same set of characteristics.³⁰⁸ Nonetheless, some scholars see that the term “same” means only bearing likeness in essence with the trademark applied for registration.³⁰⁹ Moreover, in case of word mark, another scholar describes that essential feature of word mark is the pronunciation, if the applicant can demonstrate that the examined mark and the trademark applied for registration employs identical pronunciation even if these two marks are arranged in differently³¹⁰, or the examined mark was used in a different way.³¹¹

Based on the registrability of distinctiveness under Section 7, it can be concluded that Thai law employs both general principle of distinctiveness which are inherent distinctiveness and acquired distinctiveness or secondary meaning. This is because, even if the third paragraph of Section 7 uses the term “shall be deemed distinctive” which is similar to the wording used in the second paragraph, a deemed distinctiveness under the third paragraph is not considered the characteristics of trademark per se, it is however concerned with the requirement of widespread use and advertisement. Thereby, if the applicant has proven that the trademark was widely used or advertised in accordance with the rule as prescribed, the such trademark shall acquire distinctiveness through use, and not inherent distinctiveness.

Section 7 does not only laid down the key-frame for the principle of distinctiveness under Thai law, but also creates several legal uncertainties and legal dilemmas in the Thai trademark law regime. As the impropriety of the legislative

³⁰⁸ Supreme Court Judgement No. 5402/2551

³⁰⁹ Tejavaniya (n 305)

³¹⁰ นันทน อินทนนท์, ‘บทบาทของศาลในการตีความและวางหลักกฎหมายเกี่ยวกับลักษณะบ่งเฉพาะของเครื่องหมายการค้า’ ในวารสารกฎหมายทรัพย์สินทางปัญญาและการค้าระหว่างประเทศ [Nandana Indananda, ‘The Role of Judge in Interpreting and Laying Down The Principle of Law Regarding Trademark Distinctiveness’ in *The Intellectual Property and International Trade Law Forum: Special Issue 2012*] 204.

³¹¹ Central Intellectual Property and International Trade Court Judgement No. Tor Por 46/2548 (Decided Case))

method, the inexplicitness of provisions, and inconsistency of interpretation,³¹² there are issues to be explored as follows:

First, in view of evidence law, paragraph 2 of Section 7 provides that if trademark fall into one or more following eleven characteristics, it shall be considered as “deemed distinctive.” It should be noted that the term “deemed” in the context of Thai law, uses an irrebuttable presumption³¹³, which means that the trademark shall be immediately considered as an inherent distinctive trademark if the trademark applicant can prove that all requirements have been met.³¹⁴ The difference between irrebuttable and rebuttable presumption should be noted here, as a rebuttable presumption is merely a preliminary presumption of fact, and the burden of prove of the alleged fact will be on those who are going against the presumed fact. While, irrebuttable presumption provides a much higher standard where trademark applicant must be able to provide a fact that is undisputable.³¹⁵ Not only the burden of prove will be on the trademark owner, but the trademark owner must also provide a prove that is undisputable. This means that, if there are any other party that can provide even the slightest dispute on the facts initially provided by the trademark owner, then the trademark owner will be deemed as not having provided an irrebuttable presumption of fact and the Court will be bound to decide the case based on such deemed fact provided by such other party.³¹⁶ Due to the distinctive characters provided on the basis of each type of mark, the question whether the mark having characteristics, in addition to characteristics as listed in the second paragraph, will automatically be considered as a mark that is lack of distinctiveness under the second

³¹² Indananda (n 310) 176

³¹³ วีระพล ตั้งสุวรรณ, ‘การใช้ข้อสันนิษฐานตามกฎหมายในคดียาเสพติดภายใต้หลักนิติธรรม’ (2558) (Veerapol Tungsuwan, ‘The Application of Legal Presumption in Narcotic Offences Cases under the Rule of Law’ (2013)) (28 January 2021) <https://institute.constitutionalcourt.or.th/occ_web/ewt_dl_link.php?nid=1431> accessed 27 February 2021

³¹⁴ Thai Civil Procedure Code, s 84/1

³¹⁵ Thai Civil Procedure Code, s 84 (2)

³¹⁶ See Supreme Court Judgement No. 2903/2548

paragraph or can such mark still be considered as having an inherent distinctiveness under the first paragraph. In other words, it is unclear whether the law intended to protect only particular cases of distinctiveness as provided under the second paragraph or to provide an example of distinctive characters without limiting the character of an eligible marks only to those characters as provided in the second paragraph and allows the applicant to prove that his or her mark has fulfilled all conditions of distinctiveness under the first paragraph as well. For this question, in an absence of the Supreme Court judgment, many scholars explained that several characters as provided under the second paragraph only aims for convenience and to illustrate the registrar's consideration criteria.³¹⁷ The characteristics were provided as an absolute ground for acceptance, and not a ground for refusal. Meaning that the registrar is bounded to accept that the mark which can fulfill the all distinctiveness requirements listed in the law without any discretion for each separate application needed. However, the law did not intend to provide such characteristics as a ground for refusal.³¹⁸ Thus, the characteristics as listed in the law were only a non-exhaustive example of distinctive characters, in addition, the applicant can also prove the inherent distinctiveness of the mark in accordance with the first paragraph to satisfy the distinctive requirement for trademark registrability under Section 6.³¹⁹

Furthermore, legal issues regarding the prove of acquired distinctiveness through use under the third paragraph, even if the principle of “acquired distinctiveness” or “secondary meaning” applied to fulfill the distinctive requirement in the Thai trademark regime as well as the inherent distinctiveness, this principle still being insufficient in the actual application in the Thai trademark protection due to legal dilemma that has arisen from the incomprehensive provision. According to the third paragraph, the law permits trademark applicants to prove that their marks have acquired distinctive through use only in the case that the said marks did not fall within

³¹⁷ Tingsamit (n 85) 10.

³¹⁸ Indananda (n 312)

³¹⁹ Central Intellectual Property and International Trade Court Judgement No. 131/2563 (Decided Case))

any characteristics as provided in the second paragraph. As a result, the question may arise whether a mark which neither contains characteristics under the second paragraph nor serves the requirement under the first paragraph can prove its acquired distinctiveness through use or not.

2.4.2.2 Being Not Prohibited by Law

The second requirement for trademark registrability is the mark must not be a prohibited mark. The Thai trademark law imposes grounds for refusal for prohibited mark in thirteen cases comprising both absolute grounds for refusal and relative grounds for refusal in the case where the applicant is not a trademark owner.³²⁰ Among several incompatibilities of the marks, prohibition based on the types of mark can be separated into these following categories:

(1) Prohibited seals and emblems: state seals or emblems, royal seals, official seals, Chakkri emblems, insignia and emblems of the royal decorations and orders, seals office, seals of ministries, bureaus, departments, or provinces³²¹, official emblems of foreign states or of international organizations without their allowance given by their competent officer;³²²

(2) Prohibited flags: Thai national flags, royal and official flags, official flags of foreign states or international organizations without their allowance given by their competence officer;³²³

(3) Prohibited names and monograms: royal names or monograms, abbreviations of royal names or monograms,³²⁴ names identifying or referring the members of royal family.³²⁵ Noted that the term “royal names” means the name of the king, while the term “monogram” means the name of the Queen, the Heir to the

³²⁰ Supaponsiri (n 82) 22; Tingsamit (n 85) 25

³²¹ Thai Trademark Act B.E. 2534 (1991), s 8 (1)

³²² Thai Trademark Act B.E. 2534 (1991), s 8 (6)

³²³ *ibid*

³²⁴ Thai Trademark Act B.E. 2534 (1991), s 8 (3)

³²⁵ Thai Trademark Act B.E. 2534 (1991), s 8 (5)

Throne, and including other members of the royal family even though this term is not particularly defined by law.³²⁶ Moreover, in case of names or abbreviations of the foreign states or international organizations, if such names or abbreviations of names are used without allowance of their competent officer, the marks containing such names or abbreviations of names shall be prohibited.³²⁷ Additionally, any marks which employs similar characteristics as all the said mark shall be prohibited as well.³²⁸

(4) Prohibited words and phrases: words or phrases identified or referred to the member of the royal family³²⁹, and any marks which similar with the said marks shall be prohibited from trademark registration.³³⁰

(5) Prohibited images and representations: photographs or portraits of the King, Queen, or the Heir of the throne.³³¹ Prohibited characters also covers any marks similar to the said marks as well.³³²

(6) Other prohibited characteristics:

(6.1) Official marks of the foreign states or international organizations, quality control and certified mark of foreign states or international organizations without allowance of their competent officer.³³³ In addition, it includes an official marks and emblems of the Red Cross or appellations “Red Cross” or “Geneva Cross.”³³⁴ Notes that even if there is no particular definition of the term “official marks,” the said mark was commonly known being the marks as imposed by law to be an official symbol of the government officer³³⁵ or to be used in government affairs,

³²⁶ Supaonsiri (n 82) 48; Tingsamit (n 85) 26

³²⁷ (n 328)

³²⁸ Thai Trademark Act B.E. 2534 (1991), s 8 (11)

³²⁹ Thai Trademark Act B.E. 2534 (1991), s 8 (5)

³³⁰ Thai Trademark Act B.E. 2534 (1991), s 8 (11)

³³¹ Thai Trademark Act B.E. 2534 (1991), s 8 (4); Supaonsiri (n 82) 48; Tingsamit (n 85) 27; Thai Trademark Office of the DIP (n 276) 19.

³³² Thai Trademark Act B.E. 2534 (1991), s 8 (11)

³³³ Thai Trademark Act B.E. 2534 (1991), s 8 (6)

³³⁴ Thai Trademark Act B.E. 2534 (1991), s 8 (7)

³³⁵ Thai Trademark Board Decision No. 23/2528

and the said mark must be registered and notified by the Government Gazette to be an official marks under the Official Mark Act B.E. 2482 (1939).³³⁶ Not only that, but the prohibited characteristics also covers any marks employs the similar characteristics as contains in the said marks.³³⁷

(6.2) Marks identical to or similar to a medal, diploma, certificate, or any other marks awarded in the trade exhibition or contest executed by the Thai government, government officials, state enterprises, or any other department under the supervision of the Thai or foreign state government, or international organization unless the applicant obtained the said medal, diploma, certificate, or any others as an award for the products and was used in combination with the trademark by indicating the awarded year.

(6.3) Any marks which is contrary to public order, morality, and public policy.³³⁸ In this case, it should be noted that the Supreme Court laid down the rule for interpretation that this does not only includes marks that are contrary to the prohibited elements per se, but also includes marks that are derived or resulted in bad faith while also being contrary to these prohibited elements. For example, the applicant who uses the copyrighted work owned by other person without such person's permission, even if the law does not particularly prohibited the use of a copyrighted work owned by other person as a trademark, the trademark applicant shall be considered as using copyrighted work owned by other persons in bad faith, and infringing copyright of the copyright owner as long as the copyright owner intended to use the said original work as a copyrighted work in good faith. Trademark made in bad faith and resulted from copyright infringement will be inconsistent with the purpose of trademark law and contrary to public order, good moral, and public policy. Thus, such trademark will be prohibited from trademark registration.³³⁹

³³⁶ Tingsamit (n 85) 29; Thai Trademark Office of the DIP (n 276) 21.

³³⁷ Thai Trademark Act B.E. 2534 (1991), s 8 (11)

³³⁸ Thai Trademark Act B.E. 2534 (1991), s 8 (9)

³³⁹ Supreme Court Judgement No. 4588/2552

(6.4) Any trademark that is identical or similar, which likely can create a confusion to the owner or the public, to the well-known marks as prescribed by the notification of the Minister whether the well-known marks were registered.³⁴⁰ The protection of well-known marks widen the scope of protection to the trademark known by the public for its goods or services used and even if it is not registered in any jurisdictions.³⁴¹ This protection was provided in Article 6bis of the Paris Convention that the Contracting Countries obliged to refuse or cancel the registration and also to prohibit the use of the trademark which is, in whole or in essential part, identical or similar to create a confusion to the well-known marks owned by another person. Thailand adopts this principle to be the provisional ground for refusal of registration of trademark which is identical or similar to a well-known mark either because they are used on the same or similar goods or services regardless of whether the said well-known marks are registered in Thailand or not. In details, due to the fact that the Thai Trademark Act does not define the term “well-known mark,” the criteria for what can be a “well-known mark” was prescribed by the Notification of Ministry of Commerce that in determining whether any marks are well-known, any goods or services used under such mark must be widely distributed, used, or advertised in good faith either by the mark’s owner, his or her representatives, or the authority and either in Thailand or abroad. Not only that, but the mark which can become the well-known mark must also be acceptably famous by the consumers.³⁴²

(6.5) Geographical indications protected under another *sui generis* law on geographical indications.

(6.6) Other marks as prescribed by the notification of the Minister.

³⁴⁰ Thai Trademark Act B.E. 2534 (1991), s 8 (10)

³⁴¹ Ariyanuntaka (n 254) 130.

³⁴² ประกาศกระทรวงพาณิชย์ เรื่อง หลักเกณฑ์การพิจารณาเครื่องหมายที่มีชื่อเสียงแพร่หลายทั่วไป ณ วันที่ ๒๑ กันยายน พ.ศ. ๒๕๔๗ (Notification of Ministry of Commerce Concerning the Determination Criteria of Well-Known Mark as in force on 21 September 2004)

2.4.2.3 Being Not Identical with or Similar to a Registered Trademark

According to criteria for trademark registrability under Section 6, the law provided that trademark which can be eligible for trademark registration shall not be identical or similar to a registered trademark of other persons. In doing so, the law provides an additional criterion for the said registrability which can be divided into two different cases. First, the trademark shall not be identical with a registered trademark of other persons; and second, trademark shall not be similar to a registered trademark of other persons. However, these two cases employ different criteria as follows:

Trademark which is identical to other registered trademarks means that a trademark applying for a registration contains the full likeness characters and same elements with the registered trademark³⁴³, if these trademarks are intended to be used with the same class of goods or services or different classes of such goods or services but associated with one another, the trademark applied for registration will not be registrable, and the Trademark registrar must refuse to register the said mark. For example, the shopping bag which is the goods in class 18 and the garment in class 25, even though these two products are categorized in different classes but the two classes are associated with each other, therefore, if a trademark is being register for a shopping bag and it is identical to the trademark already registered to be used with a garment, such trademark will not be registrable.³⁴⁴

For the trademark which is similar to other registered trademarks, the term “similar” means “looking or being almost, but not exactly, the same.”³⁴⁵ Nonetheless, the law does not requires that the trademark applied for registration must not be similar to the other registered marks in any cases, but the law specified that the trademark applied for registration which is similar to the other registered trademark shall not be registrable only if the similarity “might be confusing or misleading as to the owner or the sources of production for the public.”³⁴⁶ These

³⁴³ Thai Trademark Office of the DIP (n 276) 24

³⁴⁴ Thai Trademark Act B.E. 2534 (1991), s 13 (1)

³⁴⁵ Thai Trademark Office of the DIP (n 276)

³⁴⁶ Thai Trademark Act B.E. 2534 (1991), s 13 (2)

requirement as provided in the Thai law is in accordance with the principle of “likelihood of confusion” as explained in the part of the general registrability of trademark. Apart from the element of the mark’s characteristic, the law also requires the element of the class of goods or services for which the trademark will be registered where if any two marks will be used for the same class or different classes of goods or services but such two classes are associated with one another³⁴⁷, the trademark that comes later in applying for registration shall not be eligible for registration.

One essential consideration regarding the registrability is how far should the consideration whether any two trademarks are identical or similar, which might be confusing or misleading as to the owner or the source of production of the goods or services, to the other registered trademark goes. To fill this legal loophole, the Supreme Court has given criteria for consideration that in determining whether any two trademarks are identical or similar to other registered trademarks under Section 13, the consideration should be taken on the whole essential quality of a registered trademark which includes essential part, pronunciation, products used in association with the mark, distributive channels, and the consuming public.³⁴⁸ Furthermore, each consideration as mentioned above contains different details based on each types of marks, if the trademark applying for registration and the registered trademark is the same types, these considerations can be applied directly. In case of word marks, for example, the consideration shall be taken on the composition of words or phrases and the pronunciation,³⁴⁹ if the accent of each syllable is different, the consideration shall be given to the syllable that is accented the most.³⁵⁰ On the other hand, if the two comparing trademarks are different in types, for example, one is a picture mark while the other is a sound mark, some scholar noted that the consideration should be essentially taken on the pronunciation rather than other factors.³⁵¹ The invented

³⁴⁷ Supreme Court Judgement No. 6657/48; 1793/49; 3623/49; 7831/49; 571/52

³⁴⁸ Supreme Court Judgement No. 4784/2549, 10657/46, 1868/2559, 1606/2561

³⁴⁹ Thai Trademark Office of the DIP (n 276) 26

³⁵⁰ Tejavanija (n 305) 131

³⁵¹ Indananda (n 310) 186-187

device mark of lion, for example, can be similar to the word mark of “Lion” because the word “Lion” can be articulated by each other.³⁵² For the criteria of taking consideration on the whole essential quality of a trademark, this rule is in accordance with the “Anti-dissection Rule” which the Court, in essence, bound that in determining the meaning of words, it cannot be separately made on word by word basis but it must be made on the meaning of the whole words. However, this rule does not absolutely prohibit the Court from separating the words in its consideration. Rather, it allows the court to separate out the whole words in preliminary searching for the consumer perception for the trademark as a whole, but the decision made by the Court must not rely only on the meaning of each separate word. This rule also ensures that the term “identical” of the two explored marks does not required a complete likeness, and only a likelihood of confusion is adequate.³⁵³ In fact, this rule does not only applied for consideration of the misleading character, but it can also be applied for distinctive characters.

Although the same and similarity of trademark applying for a registration and the other registered trademark is a ground for the registrar to refuse trademark registration, this principle is not applicable for when both trademarks were used in good faith by each owner of the trademark. For example, the trademark applied for registration was used coincide with the use of the registered trademark, or the trademark applied for registration was used before the registered trademark was used, or when the applicant did not intend to imitate the registered trademark even if the use of the trademark applied for registration happens afterward.³⁵⁴ Apart from these examples, there are many other circumstances that the registrar can deem a mark eligible for registration even when such mark has an identical or similar character with a registered trademark. For example, the products used with the trademark are widely sold and advertised in Thailand without any oppositions claims against such use.³⁵⁵ In

³⁵² *ibid*

³⁵³ Supreme Court Judgement No. 2041/2552, 2042/2552, 2590/2553

³⁵⁴ Thai Trademark Office of the DIP (n 276) 29

³⁵⁵ *ibid*

order for the registrar to accept trademark registration for mark of such kind, the registrar can do so by imposing addition conditions and limitations for the use of such trademark as appropriate.³⁵⁶

2.4.3 Legal Effects of Trademark Registration

As the Thai trademark law regime based its protection on registration, the right of registered trademark owner shall be automatically protected by the Thai Trademark Act B.E. 2534 (1991) as long as such mark is registered. However, this means that unregistered trademark will not be entitled to be used or is no longer protected under Thai law. The purpose of this part is to compare the difference between the right entitled by law for the registered trademark owner and the unregistered trademark owner in order to point out the different level of protection and any legal risks that unregistered trademark owner may have in the context of Thai law.

2.4.3.1 Rights of the Registered Trademark Holder

Under Thai law, the full protection of trademark is based on registration, where the owner of a registered trademark shall be protected expansively in various protection area, this allow the trademark owner to exercise his or her right within the fields of economic, civil, and criminal as follows:

First, in an economic field a trademark is entitled for an exclusive right to be used with the products for which such mark is registered,³⁵⁷ on a condition that the scope of protection for the owner of a registered trademark shall only be protected for particular products in either one class or different classes specified in the application for registration³⁵⁸ which have been registered under the law³⁵⁹, the owner of such mark cannot claim for protection over other products which were not specified in the application for registration or those that are specified but are non-registrable.

³⁵⁶ Thai Trademark Act B.E. 2534 (1991), s 27

³⁵⁷ Thai Trademark Act B.E. 2534, s 44

³⁵⁸ Thai Trademark Act B.E. 2534, s 10

³⁵⁹ Thai Trademark Act B.E. 2534, ss 40, 41

Second, in the field of civil law an owner of a registered trademark shall be entitled to exercise rights relating to trademark exclusively, and to file a lawsuit for protecting such rights from trademark infringement. For example, a registered trademark owner shall be able to file a claim against unauthorized trademark user and seek for eradication of products sold under such infringing trademark from the marketplace or cancelling the use of infringing trademark on any products.³⁶⁰ Not only that, but the registered trademark owner shall also be able to claim for compensation to recover any damages caused by such infringement.³⁶¹

Third, in the field of criminal law an owner of a registered trademark will be entitled to a criminal protection under the Thai Penal Code and the *sui generis* law which is the Thai Trademark Act. The details of protection for trademark will be further clarified under topic 2.3.3.3.

2.4.3.2 Rights of the Unregistered Trademark Holder

In unilateral aspect, trademark protection depends on the categories of protection basis chosen by each jurisdiction. Unlike the unilateral level where trademark protection in multilateral level did not concern only the registered trademark but also emphasize on unregistered trademark, in spite of a non-complete protection under certain circumstances. According to the Paris Convention for the Protection of Industrial Property, the first unregistered trademark protection appeared as a protection of a well-known mark that Contracting Countries are bound to protect such well-known mark even if it is unregistered. This can be done by refusing or cancelling the registration, prohibiting the use of a trademark which may create confusion to a well-known mark.³⁶² This concept is not only protected under the Paris

³⁶⁰ อรพรรณ พันธ์พัฒนา, “การให้ความคุ้มครองแก่เครื่องหมายการค้าต่างประเทศภายใต้กฎหมายไทย”

(Orabhund Panuspatthna, Legal Protection of Foreign Trademark under Thai Law)

<<https://ipitc.coj.go.th/th/content/category/detail/id/10366/iid/192630>> accessed 21 February 2021 59

³⁶¹ Thai Trademark Act B.E. 2534, s 46 para 1

³⁶² Paris Convention, art 6bis

Convention, but it is also protected under the TRIPS Agreement which ensure the *mutatis mutandis* application for the well-known mark protection of the Paris Convention.³⁶³ In a conceptual basis, well-known marks are protection based on the concept of preventing unfair competition which imposes obligation on the Contracting Countries to prohibit any actions of competition contrary to the honest practice including but not limited to creating confusion, discrediting a competitor, and misleading the public for ensuring the effective protection against unfair competition.³⁶⁴ This concept has become fundamental grounds for Contracting Countries to create measures to prevent this state of trade competition. One of the measures underlying this concept is the passing off, which emphasizes the protection of a reputation or good will of the trademark owner from misrepresentation made by traders in the course of trade to his prospective consumer or to ultimate consumers in which the trader supplied.³⁶⁵ In order to comply with the TRIPS Agreement, the Thai Trademark Act has accepted and enforced these two concepts in order to protect the rights of an unregistered trademark in both the stage of registration and enforcement.

In the stage of registration, it can be divided into the following sub-stage for consideration. In pre-registration stage, the protection of unregistered trademark can be found in the protection of well-known marks. According to Section 8 (10) of the Thai Trademark Act, the concept of protection for well-known marks was provided as an absolute ground for refusing trademark registration in accordance with Section 6 which provided the subject matters for a registrable trademark. In doing so, the trademark registrar is bound to refuse the registration for applying trademark if the said mark may create public confusion and misleading for the well-known mark. However, the question arisen from this prohibition is how can a protection of a well-known mark be applied in two countries which employs different grounds on what can constitute a trademark. For example, if the characteristic of a well-known mark in one contracting

³⁶³ TRIPS Agreement, art 16 (2), (3)

³⁶⁴ Paris Convention, art 10bis

³⁶⁵ Advocaat [1979] F.S.R. 397, 405.

countries is motion, while the characteristic of an unmovable trademark is not eligible for protection in Thailand, can the owner of a well-known mark secure a well-known mark protection in Thailand, and how does this apply. The answer to this question remains unclear even with all the researches through Thai textbooks, papers, and the Supreme Court Judgment. Nonetheless, the author understands that even if the purpose of a well-known mark protection is to prevent unfair competition and encourages consumer protection³⁶⁶, the protection of a well-known mark for an unregistered trademark stands on the provision of the Section 8 (10) which comprises of the word “well-known” and “mark.” In the interpretation, although there is no particular definition of a term “well-known”, the law provided a specific definition of the term “mark” which can be eligible for protection under Thai Law. For that reason, though the well-known status of a mark is recognized by the relevant sector of the public in the forms other than what can constitute a mark under Thai law both in Thailand and abroad, the consideration of a well-known mark as a ground for refusal can only be given on the categories of mark which are eligible for protection under Thai law.

In post-registration stage, apart from the appearance of unregistered trademark protection as a ground for refusing trademark registration concerning with the protection of a well-known mark, the protection of unregistered trademark indirectly appears as the right of the owner of unregistered well-known trademark to revoke the trademark registration.³⁶⁷ The protection of unregistered trademark in Thailand first appears in Section 61 of the Thai Trademark Act, the law allows a stakeholder or the registrar to file petitions to the Trademark Board for the revocation of a registered trademark by demonstrating that the registered trademark failed to meet one or more requirements of trademark registrability at the moment of registration. The law does not only provides for the revocation by the Trademark Board, but also permits the stakeholder to file petitions to the Court for the revocation of trademark by demonstrating that the stakeholder has better right in trademark than

³⁶⁶ Tingsamit (n 85) 32.

³⁶⁷ See Supreme Court Judgement No. 6329/2559

the owner of a registered trademark pursuant to Section 67 of the Trademark Act.³⁶⁸ It can be seen that even though these two provisions entitled the same person to make a request for revocation, referring to such person as a “stakeholder,” the reason for revocation as provided in these two provisions are different, as Section 61 provides for the lack of requirements for trademark registrability while Section 67 provides for the preferential status of the stakeholder. The Supreme Court laid down the rule in determining the preferential status under Section 67 to see whether a person who petitions to the Court has a better right than the owner of a registered trademark ruling that if the said person is an actual owner of the trademark and uses the trademark with products sold in Thailand before the owner of a registered trademark file an application for registration of such trademark. Then, the prior user of the trademark has a better right than the owner of a registered trademark.³⁶⁹ However, some scholars have given the opinion that the term “better right” should mean the better right in trademark registration instead of use.³⁷⁰ On the other hand, there is no clear legal rule to describe the term “stakeholder” under Section 61 which provides the claims for lacking requirements for trademark registrability. The author understands that even if there is no legal definition of the term “stakeholder” and the reason for revocation of Section 61 is different from the reason of Section 67, the prior user of the trademark as given by the judgement of the Supreme Court which rule that a person having a better right than the owner of a registered trademark may be considered as a “stakeholder” under Section 61. However, in using the prior user requirement, the stakeholder must petition a claim directly to Trademark Board instead of the Court for revocation of trademark registration on the ground that the trademark is lacked of requirements for trademark registrability instead of using the claim on preferential status.

In the stage of enforcement, the owner of an unregistered trademark are entitled to bring legal proceedings in several circumstances. For example, the owner

³⁶⁸ Thai Trademark Act B.E. 2534 (1991), s 67 para. 1

³⁶⁹ Supreme Court Judgement No. 1274/2501; 1361/2527; 3142/2532; 5565/2548; 2179/2559

³⁷⁰ Supaponsiri (n 82) 145.

of an unregistered trademark can make a request to prohibit the later user of trademark to apply for registration, revoke their trademark application, or make a request to the Court to decide whether that the prior user have a better right.³⁷¹ Apart from this, the Thai Trademark Act also ensure the protection of unregistered trademark owner from passing-off by allowing trademark owner to bring legal proceedings against any person for passing-off goods which are the same or similar to those of the trademark owner.³⁷² The passing-off protection is provided for owner of an unregistered trademark whether such trademark has not been registered in Thailand, or registered in Thailand for goods or services other than the goods or services for which the misrepresentation is impress upon,³⁷³ and even if the misrepresentation is not directly caused by the identical or similar trademark but by the approximate mark which the public might be confused as to the source of products or services without a careful consideration.³⁷⁴

2.4.3.3 Criminal Protection of the Registered Trademark

To consider trademark in criminal aspect, there are currently the two legislations which can be applied for criminal offences against trademark of other persons, which are the Thai Trademark Act B.E. 2534 (1991) and the Thai Penal Code B.E. 2499 (1956). On the one hand, criminal offences which are associated with trademark under the Thai Trademark Act are provided under Chapter VI Penalties which imposes the penalties for trademark crime, and also criminalized certain civil trademark infringement as criminal offenses. In essence, there are six categories of substantial criminal offences applicable to trademark under the Thai Trademark Act. On the other hand, criminal offences under the Thai Penal Code are provided under title eight and regarded as criminal offences relating to trade. Under the Thai Penal Code, there are four categories of criminal offences against trademark of other persons. To emphasize substantive criminal offences relating trademark under these two

³⁷¹ Supaponsiri (n 82) 104-105.

³⁷² Thai Trademark Act B.E. 2534, s 46 para. 2

³⁷³ Supreme Court Judgement No. 3145/2560

³⁷⁴ Supreme Court Judgement No. 677/2532

applicable laws, this part will look into the consideration for criminal offenses particularly intended to protect trademark owner, which are offences relating to trademark counterfeiting and imitating, offences relating to the misuse of trademark on goods, and offences relating to a mark which can misled consumer into believing that it is a registered trademark. For the offences relating to trademark counterfeiting and imitation, it can be divided into two different offences which are trademark counterfeiting and trademark imitating. These two offences contain different details as follows:

Section 108 of the Thai Trademark Act recognized trademark counterfeiting as a criminal offences by stating that “any persons who counterfeits a trademark, including service mark, certified mark, and collective mark, registered in Thailand owned by another person shall be criminally liable.” Whereas this offence was also imposed in Section 273 of the Thai Penal Code which stated that “any person who counterfeits a trademark registered in either Thailand or abroad owned by another person shall be criminally liable.”

Separately, trademark imitating was imposed in Section 109 of the Thai Trademark Act which states that “any persons who imitates a trademark, including service mark, certified mark, and collective mark, registered in Thailand owned by another person in order to mislead the public into believing that its marks owned by such other persons shall be criminally liable.” While Section 274 of the Thai Penal Code imposed that “any persons who imitates a trademark registered either in Thailand or abroad which are owned by another person in order to mislead the public into believing that the mark is owned by such other persons shall be criminally liable.” After reviewing the elements which are subject-matter of these two legal provisions, it can be seen that offences under the Thai Trademark Act, whether they are trademark counterfeiting or trademark imitating can be committed only against “a trademark registered in Thailand.” In other words, the criminal protection under the Thai Trademark Act is only provided for trademark owner who has registered their mark in Thailand. Consequently, neither trademark counterfeiting nor imitating committed against a trademark that is registered abroad are protected under the Act. Nonetheless,

the criminal protection under the Thai Penal Code is significantly broader than the criminal protection under the Act due to the territoriality of protection that person who committed trademark counterfeiting and imitating shall be liable under the provision of the Thai Penal Code regardless of where such trademark is registered.

In addition to the territoriality protection, trademark counterfeiting and imitation under these two different legal sources imposed different protection and the extent of penalties. This can be explained as follows.

For the domain of protection, the Thai Trademark Act broaden its criminal protection to cover service marks, certified marks, and collective marks in the same level as trademark, while the Thai Penal Code limits its criminal protection only to trademark, neither service mark, certified mark, nor collective mark are protected under the Thai Penal Code even if the said marks are registered in Thailand.

To the extent of penalties, the Thai Trademark Act imposed the penalties on any person who committed trademark counterfeiting giving the penalties of “imprisonment not exceeding four years or a fine of not exceeding four hundred thousand baht or both,” while the penalties for trademark imitating of such Act was an “imprisonment not exceeding two years or a fine of not exceeding two hundred thousand baht or both.” On the other hand, the Thai Penal Code imposed the penalties for any person committed trademark counterfeiting as “imprisonment not exceeding three years or a fine of not exceeding six thousand baht or both,” whereas the penalties for trademark imitating was an “imprisonment not exceeding one year or a fine not exceeding two thousand baht or both.”

Due to the differences in the elements of the offence and penalties of the two compared law, legal issue may arise that whether trademark counterfeiting and imitating under the Thai Penal Code, which is a law that was enacted earlier on, were implied to be repealed by the provision of the Thai Trademark Act, which is the later law or not. There are two legal opinions on this legal dilemma given by many lawyers. First, offences under the Thai Penal Code were not yet implied to be repealed by the Thai Trademark Act. The reasons underlying this opinion are that these two laws were enacted with different purposes, namely the Thai Trademark Act is mainly

aims to protect an exclusive right of the trademark owner from unauthorized use, utilizing, and exploitation of the mark without permission of the trademark owner by other persons, while the Thai Penal Code aims at protecting the public from likelihood of confusion from the counterfeited or imitated marks rather than to protect an exclusive right of trademark owner.³⁷⁵ Furthermore, there is no provision in the Thai Trademark Act which expressly repeal the provision of the Thai Penal Code, and therefore it shall not be deemed that the Thai Penal Code was implied to be repealed by the Trademark Act as, because the Trademark Act which is a later law is not conflict or contrary to the Thai Penal Code.³⁷⁶ Instead, the scope of the two law is merely different from each other. For these given reasons, the sections of the Thai Penal Code relating to trademark offences shall not be implied to be repealed by the Thai Trademark Act. Secondly, there are contrasting opinions on this matter which see that the Thai Penal Code is implied to be repealed by the Thai Trademark Act, since the Thai Trademark act is a law enacted later than the Thai Penal Code. This is because the general protection of trademark, like other intellectual property protection, is subjected to the principle of territoriality where trademark shall only be protected under the jurisdiction where such mark was registered. This means that trademark protection is considered to be a domestic protection save for the worldwide protection of well-known marks.³⁷⁷ Not only that, but the TRIPS Agreements and other relevant international rules do not address Thailand as a member of WTO, therefore there are no obligation to broaden the scope of domestic protection to trademarks which are registered outside its jurisdiction.³⁷⁸ Because of these, offences under the Thai Penal Code is inconsistent with the purpose of the special law applicable to trademark.

³⁷⁵ Panuspatthna (n 360)

³⁷⁶ Supreme Court Judgement No. 1835/2546

³⁷⁷ Panuspattana (n 360)

³⁷⁸ Ariyanuntaka (n 254) 130

Hence, the Thai Penal Code shall be implied to be repealed and no longer enforceable by the effect of the Thai Trademark Act.³⁷⁹

For offences against unregistered trademark, the Thai Penal Code provided criminal protection to the owner of an unregistered trademark under certain circumstances, whereas the Thai Trademark Act does not provide any criminal protection for the owner of an unregistered trademark due to the fact that Thai trademark regime based its trademark protection on registration which means that the trademark owner shall be protected only if the trademark has been registered under Thai jurisdiction. For criminal protection of the owner of an unregistered trademark under Thai law, although the law does not provide a particular definition of the term “unregistered trademark owner” in the Thai Penal Code, the protection of the owner of an unregistered trademark was described as “any persons use names, figures, artificial marks or phases in the carrying on trade of the other person, or appears the said marks with products, packaging, covering, advertisements, price tags, trade letters, and likewise to mislead the public into believing that is products of the such others shall be criminally liable.”³⁸⁰ In consideration, even if the law does not use the same definition for the term “trademark” as offences relating to trademark counterfeiting and imitating, the Supreme Court held that the term “figures, artificial marks” as provided under such law means trademark regardless of whether it is registered or not.³⁸¹ As a result, any persons who use or show a registered or unregistered marks as provided by law³⁸² knowingly of all elements of the offences and with the special intention to misleading the public to believe that the goods or services are owned by them, such persons have committed an offence under this provision. It should be noted that this criminal offence aims to protect the owner of unregistered trademark

³⁷⁹ Central Intellectual Property and International Trade Court Judgement No.2108/2548 (Decided Case)

³⁸⁰ Thai Penal Code, s 272 (1)

³⁸¹ Supreme Court Judgement No. 1556/2495; see also Supreme Court Judgement No. 782-783/2508; see also Supreme Court Judgement No. 1236/2517; Supapnonsiti (n 82) 190;

³⁸² Supreme Court Judgement No. 1731/2506

in a similar way as the civil protection of passing off,³⁸³ which allows the owner of an unregistered trademark to claims for compensation or file a lawsuit to the Court against any persons who misleads the public that such persons are the true owner of the trademark applied to the goods or services.³⁸⁴ Nonetheless, the major issue regarding this provision is that the term “artificial marks” does not cover all types of trademark due to the reason that the Thai Penal Code imposed this offence only on traditional marks as can be found on the definition of the term “mark” under the Thai Trademark Act³⁸⁵, this led the scope of the meaning of the term “artificial mark” to not include non-traditional trademark. In addition, some scholar explained that the term “artificial mark” only means image marks.³⁸⁶ Apart from the artificial mark, other marks as provided by the law are name, figure, words, and phrases which are already clear in definition where it does not includes any other marks per se. Therefore, any types of marks other than those as provided in such provision, particularly non-traditional trademark, shall not be criminally protected under such provision.

The offence that is related to the use of counterfeited or imitated trademark with products is the offence of importing, distributing, or possessing of the product using counterfeit or imitate trademark. According to the Section 110 of the Thai Penal Code, the law provided that “any person who imports, distributes, offers for distribution, or possesses for distribution products appearing a counterfeit or imitate trademark shall be criminally liable.” Likewise, Section 275 of the Thai Penal Code provided that “any person who imports, distributes, or offers to distribute products used names, figure, artificial marks, or phases as provided in Section 272(1) or products used with counterfeit or imitate trademark shall be criminally liable.”

For the offence relating to misleading others into believing that an imitated or counterfeited mark is a registered trademark or the use of such mark with the products generally sold under a registered trademark, the Thai Trademark Act

³⁸³ Tingsamit (n 85) 142-143.

³⁸⁴ Thai Trademark Act B.E. 2534, s 46 para. 2

³⁸⁵ Hemarajata (n 86) 355.

³⁸⁶ Tingsamit (n 85) 140.

provided that “Any person who uses the packaging or container showing a trademark registered in Thailand which is in fact, owned by another person for their products in order to mislead the public into believing that it is the products using the trademark or collective mark of the real owner, or products authorized to use the certified mark, shall be criminally liable.” It should be noted that this offence appears only in the Thai Trademark Act, and is not available in the Thai Penal Code.

2.5 Problems of Motion and Multimedia Marks Protection

This part will present the problems regarding the protection of motion and multimedia mark in the current Thai law. Referring to an existing trademark criteria, There are many legal loopholes and uncertainties that boasted insufficient protection to motion and multimedia marks. Such loopholes are the definition of the term “mark,” the relevant trademark criteria, the overlapping protection between trademark and copyright, the criminal protection of trademark, and the practical administrative proceeding of trademark registration.

2.5.1 Definition of Mark

Since Thai trademark protection is based on the registration of trademark, any sign sought to be protected under Thai law must fulfilled all requirements of the protectable subject matter for registration. To secure the trademark right under Thai law, the first step of consideration is that a mark must be a mark that is capable of constituting a trademark as provided in Section 4 of the Thai Trademark Act. However, the definition of the term ‘ mark’ under the Thai Trademark Act, which provides the domain of what can constitute a trademark, this is one of the major concerns for registration of motion and multimedia marks due to the exhaustive definition provided by the law on which type of marks can constitute a trademark. Such narrow scope of protection forces trademark owners sought to register their trademark to only uses marks or combination of marks that can constitute a trademark under the law. As such any other marks which are not marks that are under the definition provided by the law

cannot constitute a trademark without any other considerations for registrability even if such mark is strongly capable of distinguishing goods or services. This reason shows that the strict definition provided by the law limited the scope of various business instruments in becoming a trademark and is not compatible with the economic growth and technological advancement which modern brandings are trying to introduce new ideas and modern marketing strategies to enhance consumer's experiences among the overflowing challenging trade competition of other identical or similar products.³⁸⁷ Moreover, most of the mark which can be considered as a "mark" as defined under Section 4 of the Thai Trademark Act is a visible sign this is in accordance with the protection of trademark that is visually perceptible under Article 15.1 of the TRIPS Agreement. Despite the visual perception of motion and multimedia marks, the definition of "mark" does not include including motion signs, series of picture, short films, or multimedia signs to be able to constitute a trademark under Thai law, though motion and multimedia signs are capable of attracting consumers in a similar way as what traditional marks did to consumer. With the lack of protection for a visible motion and multimedia signs, legal problems whether this statutory definition comply with or is inconsistent with minimum standard requirement of the TRIPS Agreement which Thailand as a member of WTO is bound to implement may arise. Furthermore, the last phrase of such provision uses the term "combination thereof", which raises another legal issue concerning the application of this term, which is how to combine one or more prescribed marks, can an applicant combine two or more still images to make a series of still images or can an applicant combine still images with sound in order for such combination to be registrable as trademark. In this respect, there is no publicly available examples of a trademark application that the Competent officer registered combination of images, series of drawing or invented devices as a trademark. In addition, there is no Supreme Court Judgement rendering the principle as to whether an interpretation of the term "combination thereof" includes a combination of numerous images or not. Likewise, in the case of multimedia marks, even if the

³⁸⁷ Calboli, Senftleben (n 56).

definition of the term ‘mark’ is widen to cover ‘sound’ is considered to be one of remarkable changes in Thai Trademark law to broaden the scope of protection for non-traditional trademark, in particular non-visible mark. In practical, the combination of sound marks with other marks is still silence in the view of Competent officer or the Court.

2.5.2 Criteria of Trademark Registrability

As Thai trademark protection is based on registration, it is sensible that any trademark registrability will be imposed on the basis of marks as provided by the law. However, as a result of incomprehensive definition of what can constitute a mark, it automatically means that the existing trademark registrability provide insufficient measures to protect the business operators who uses motion and multimedia marks although the only difference of such marks from still images is only the composition of movements. Thus, problems regarding the criteria of trademark registrability will be elucidated as consequential problems of the definition of the term “mark.”

2.5.2.1 Uncertain Statutory Provision Regarding Distinctiveness

Seeing that Thai law imposes indicating and distinguishing function as an element of the term “trademark” and describes the term “distinctive trademark” focusing on the capacity of the trademark to help the consumer differentiate sources of products. Several legal uncertainties and legal dilemmas under Thai trademark law have arisen from an unclear statutory provision of Section 7 as mentioned earlier, which resulted in insufficient protection for all type of marks. Since motion and multimedia marks are not considered to be included under the term ‘mark’ under Thai law, therefore it is impossible for such marks to be considered as possessing a characteristic of a “deemed distinctive trademarks.”

2.5.2.2 Incomprehensive Grounds of Being Prohibited Trademark for Refusal Registration

According to Section 8 of the Thai Trademark Act, there are many cases where a character is prohibited from being registered in visible signs. One of the closet characters of motion and multimedia marks is the representation of the royal family member under Section 8(4), the law provided that the trademark which has or composed of such character shall be refused to be registered. However, the representation as the law provided concerned only a still representation. The question whether the said characters represented in the form of movements such as videos, short films, or other multimedia forms shall be considered as having or consisting of a prohibited character or not may be raised.

2.5.2.3 Negative Effect of the Well-Known Mark Protection from The Strict Definition of Mark

As the protection of well-known mark under Thai trademark law was recognized as a ground for refusal. It is unclear as to whether such protection can also be applied to and protect a moving well-known mark. The author understands that, in the current context of the law this protection is only applicable for marks which are still image or unmoving marks, and therefore see that the criteria for the protection of motion and multimedia marks remains inappropriate.

2.5.3 Practical Administrative Proceeding of Trademark Registration

The problems of the registration of motion and multimedia marks are not only about the improper definition of ‘mark’ and uncovered provisions under the law, but the registration procedure of trademark under Thai law is also one of the gigantic obstacles as well.

In Thailand, If an applicant wishes to file his or her trademark application for registration, the applicant must present the mark sought to be registered by submitting a registration application with a picture of the trademark applying for the

registration in Kor.01 form as an original document.³⁸⁸ Moreover, special supporting documents along with trademark application shall be required in the case where the trademark filed is made from figurative marks, or combination of colors.³⁸⁹ It can be seen that the applicant cannot practically submit series of images or marks in other formats as a supporting document, and there is no clear principles for the application of motion and multimedia marks whether in the case where a mark is made from series of pictures or combination of a series of pictures and sounds. Furthermore, in order to file a trademark application, even if an applicant can file a trademark application using electronic methods (E-filing) where an applicant can submit relevant documents in electronic form, an applicant is still required to submit pictures of such mark in all points of view if the mark is in the format of a picture, drawing, image, invented device or consists of such format thereof and can attach an audio file as required by the Competent officer in the case of a sound mark.³⁹⁰ The acceptance of other specimen of trademark representation such as series of still images, screenshots or video clips which is easier to prove the distinctiveness of filed mark remains silence in practical e-filing application.

³⁸⁸ Notification of Department of Intellectual Property: Determination on the application form for registration of trademarks, service marks, certified mark, collective mark and other application, No.2.1

³⁸⁹ Department of Intellectual Property, ‘Supporting Document for Trademark Registration’ (2016) <<https://www.ipthailand.go.th/th/trademark-002/item/%E0%B9%80%E0%B8%AD%E0%B8%81%E0%B8%AA%E0%B8%B2%E0%B8%A3%E0%B8%9B%E0%B8%A3%E0%B8%B0%E0%B8%81%E0%B8%AD%E0%B8%9A%E0%B8%81%E0%B8%B2%E0%B8%A3%E0%B8%A3%E0%B8%B1%E0%B8%9A%E0%B8%88%E0%B8%94%E0%B8%97%E0%B8%B0%E0%B9%80%E0%B8%9A%E0%B8%B5%E0%B8%A2%E0%B8%99%E0%B9%80%E0%B8%84%E0%B8%A3%E0%B8%B7%E0%B9%88%E0%B8%AD%E0%B8%87%E0%B8%AB%E0%B8%A1%E0%B8%B2%E0%B8%A2%E0%B8%81%E0%B8%B2%E0%B8%A3%E0%B8%84%E0%B9%89%E0%B8%B2.html>> accessed 12 June 2020

³⁹⁰ Department of Intellectual Property, ‘User Manual for Trademark Registration in Electronics’ (2020) <https://sso.ipthailand.go.th/assets/user-manual/UserManual_e-filing_Trademark_v.1.3.pdf> accessed 12 June 2020

2.5.4 Overlapping Protection between Trademark and Copyright

There are many types of protection provided in an intellectual property law such as copyright, patent, or trademark. Also, the principle of acquirement of the rights under each type of intellectual property protection are provided separately from one another. In spite of the separation of each type of intellectual property protection, the subject matter of each type of protection and the properties in acquiring a protections are not clearly divided.³⁹¹ Consequently, overlaps of intellectual property protection may arise in the case where one product or service can become the subject-matter of more than one type of intellectual property protection. In particular, a mark that is capable of both distinguishing goods or services and showing aesthetical attraction can afford to be protected under both copyright and trademark. Based on this scenario, it is unclear whether the author or owner of such mark should receive both trademark protection and copyright award or not. This legal complexity and uncertainty existed because of the overlapping protection which could be costly for a mark owner. If a copyrighted work is also trademarkable, it could create imbalance quality control costs for a mark that receive both protection in oppose to mark that only receive copyright protection.³⁹² On the other hand, this may allow owner of the protected mark to have a dominant position in the market by having a mark with a stronger and wider scope of protection and therefore be allowed to monopolized trade competition.³⁹³

The rise of recognition of the protection for non-traditional marks have caused the current scope of what can constitute a trademark to be broader than

³⁹¹ Martin Senftleben, 'A Clash of Culture and Commerce – Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation' in Iren Calboli and Martin Senftleben (eds), *The Protection of Non-traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) 368.

³⁹² ไชยยศ เหมะรัชตะ, 'ปัญหาบางประการในการบังคับใช้กฎหมายทรัพย์สินทางปัญญา' (2554) 4 วารสารราชบัณฑิตยสถาน 599, 602 (Chaiyos Hemarajata, 'Some Issue in Intellectual Property Law Enforcement' 4 The Journal of the Royal Institute of Thailand' (2011) 599, 602)

³⁹³ *ibid* 603.

typical words, phrases, or unique designs that are available in most traditional trademarks.³⁹⁴ It can be seen that most of the non-traditional marks such as devices, shapes, three-dimensional shapes, sounds, motions and multimedia cannot be protected as a trademark, but such signs may be qualified for a copyright protection as an artistic and musical work. For motion and multimedia marks, computing animation may be considered as a motion mark, melody of the song as composition of the multimedia mark can also be considered as a sound mark or multimedia marks as well.³⁹⁵

Under Thai law, if a trademark applicant uses a copyrighted work owned by others in applying for trademark registration without such persons authorization, even if such work is considered as an original work that has not been registered as a trademark, such work will still be considered as a trademark which is prohibited by law on the grounds that it is contrary to good moral and public order under Section 8(10) corresponding with Section 6(3) of the Thai Trademark Act. On the other hand, if the copyright owner intends to use his or her copyrighted work as a trademark, it is arguable that whether his or her copyrighted work can be protected in parallel with trademark under Thai law or not. In this respect, an acceptance of overlapping intellectual property protection is still unsettled due to the unresolved issue on the statutory provisions of each type of intellectual property protection. Moreover, the reason given by the Supreme Court in many cases remains unresolved for the problem of ambiguous overlapping protection in each type of intellectual property protection. For example, in the “Big Head Boy” case³⁹⁶, the plaintiff claims to be the creator of “Big Head Boy” work which is automatically protected when the work has been created and argues that the defendant infringes the plaintiff’s copyright by using the picture of a boy with big head in registering a trademark without permission or license from the

³⁹⁴ Gary Myers, ‘Statutory Interpretation, Property Rights, and Boundaries: The Nature and Limits of Protection in Trademark Dilution, Trade Dress, and Product Configuration Cases, (2000) 23 COLUM.-VLA J.L. & ARTS 241, 241

³⁹⁵ Case C-283/01 Shield Mark BV v. Joost Kist [2003] ECR I-14313

³⁹⁶ Supreme Court Judgement no. 6270/2554

plaintiff. The Court held that “the purpose of protection between trademark and copyright is clearly separated from each other, in this case the plaintiff uses ‘Big Head Boy’ with goods and products which can be implied that it is intended to be used as trademark, the ‘Big Head Boy’ shall therefore not be an applied art which secures automatic protection of copyright.” The Court’s reasoning does not resolve or provide an answer to the question where one particular work is capable of satisfying the subject-matter of at least two type intellectual property right shall be protected by each type intellectual property or not. Shifting the focusing to motion and multimedia marks, the nature of motion and multimedia marks is an artistic work because motion mark is a combination or series of images or drawing, and multimedia mark is also a combination of motion marks and sound marks, these two types of marks are not only used for commercial purposes but also used in aesthetical attraction. Therefore, this uncertain measure for overlapping intellectual property protection may be one of the concerns which obstruct the expansion of protection for motion and multimedia marks.

2.5.5 Criminal Protection of Trademark

Considering the criminal protection concerning to trademark in Thai law, there are currently two criminal laws that can be applied to the infringement of trademark. On the one hand, there is the Thai Penal Code which is a general criminal law applicable for all criminal acts. On the other hand, there is a chapter of penalties available under the Thai Trademark Act which is a *sui generis* law applicable only to trademark. However, legal uncertainties and complexities arisen from the inconsistency of these statutory provisions where the criminal offences under both laws are only provided for trademark that has already been registered. Additionally, criminal offences under the Thai Trademark Act only provide criminal protection for trademarks which are registered in Thailand, while the protection under the Thai Penal Code applies to trademarks which are registered both in Thailand and abroad. Even if the statutory provisions under these two applicable criminal laws comply with the basis that Thai trademark protection employs, which is the registration basis, it reflects negatively on

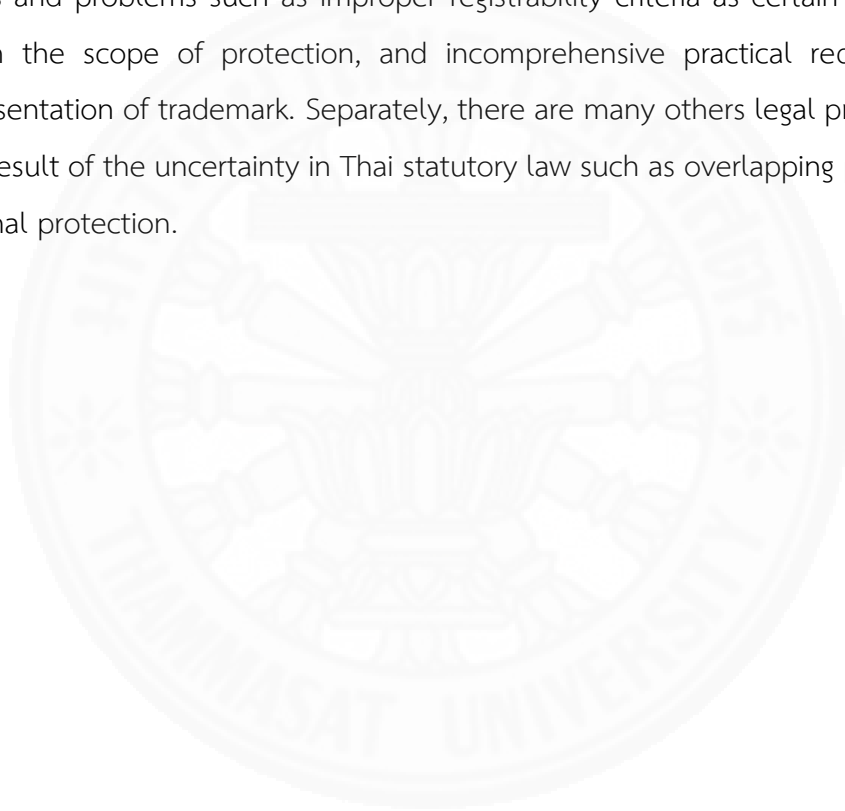
the trademark owner or the entrepreneur who are using motion and multimedia sign in their course of trade as a trademark, as it has never been protected under the Thai trademark law for the reasons as explained throughout this paper. As a result of the insufficient protection for the owner or user of motion and multimedia marks, the owner and entrepreneur are unable to bring a criminal case to the Court to penalize the counterfeiter and imitator when their trademarks are counterfeited or imitated in Thailand.

Furthermore, even if the offences relating to trademark counterfeiting and imitation under the Thai Penal Code are applicable to both trademarks registered in Thailand and abroad,³⁹⁷ which may include the registered motion and multimedia marks which are protected under other jurisdictions, the legal enforcement of this statutory provision is still uncertain due to the argument on whether these offences have been repealed by the later criminal offence under the Thai Trademark Act which cannot sufficiently assure criminal the protection against motion and multimedia marks owners, traders, and investors. Although the offence under Thai Penal Code provided a criminal protection for the use of “artificial marks” as a trademark which the Supreme Court held as having the same meaning as trademark to broaden the scope of protection to also cover the unregistered trademark, the question that remains unresolved is that the term “artificial marks” shall be construed to include the non-traditional trademark, particularly motion and multimedia mark or not. In conclusion, all legal dilemmas as mention above illustrated that the Thai trademark law provided insufficient measures to protect motion and multimedia marks and also reflected the uncertainty of criminal application and enforcement regarding trademark under Thai law.

³⁹⁷ See Supaponsiri (n 82) 192-198; Tingsamit (n 85) 130; See also Supreme Court Judgement No. 1835/2545

2.6 Conclusion

The strict definition of the term “mark” under the Thai trademark law limits the possibility of providing sufficient protection for the business sectors and company branding in conducting their businesses in Thailand. For that reason, it is not only a large barrier to register any non-traditional marks, including motion and multimedia marks, other than mark as listed by law, but it also leads to several following legal issues and problems such as improper registrability criteria as certain marks are not within the scope of protection, and incomprehensive practical requirements for representation of trademark. Separately, there are many others legal problems arising as a result of the uncertainty in Thai statutory law such as overlapping protection and criminal protection.



CHAPTER 3

INTERNATIONAL RULES AND FOREIGN LAWS ON TRADEMARK

3.1 Introduction

The purpose of this chapter is to explore the recognition of non-traditional trademark, particularly the protection of motion and multimedia marks in both international, regional, and foreign national level in order to make comparison with the scope of trademark protection under Thai trademark law, divide the similarities and differences between Thai trademark law and each territorial trademark protection. As for international level, this chapter aims to study both minimum standard of protection in substantive international trademark law and minimum requirements for administrative procedure concerning trademark registration. While in regional level, this chapter intends to study the recognition of motion and multimedia marks and the role of regional trademark law in relation to the domestic law of each country which is a signatory of each targeted international rules. Lastly, for national level, this chapter aims to explore the foreign trademark laws and their protection for motion and multimedia marks in order to find a suitable protection which can be applied to motion and multimedia marks protection in Thailand.

3.2 International Rules

In the level of International rules, non-traditional trademarks were recognized in both substantive protection and subsidiary measures. Substantive protection of trademark rights comprises of two international instruments which are the Paris Convention for the protection of industrial property and the TRIPS Agreement. While the subsidiary measure of trademark protection deals primarily with the Singapore Treaty on the law of Trademark.

3.2.1 Paris Convention for the Protection of Industrial Property

Paris Convention is known as the first international instrument to deal with the protection of intellectual property. In the absence of legal construction concerning industrial property, this convention was adopted to create legal certainty for intellectual property protection in widest sense as an industrial property, including trademarks, service marks, trade names, geographical indications, patents, industrial designs, utility models and the handling of unfair competition³⁹⁸, and to assure creator of intellectual property that their works are appropriately and sufficiently protected in all contracting countries.³⁹⁹ In essence, the Paris Convention comprises with three core categories of substantive rules as follows:

First, the Paris Convention contains the principle of “national treatment,” which requires contracting countries to provide the same treatment given to their own nationals to that of other contracting countries national.⁴⁰⁰

Second, the Paris Convention contains the principle of “the right of priority” that gives priority to the proprietor to base their subsequent application in other jurisdictions on the date of the application of industrial property first filed within a certain period of time as provided by law depends on each of the industrial properties.⁴⁰¹

Third, the Paris Convention provides general substantive rules providing the rights and obligations for each category of industrial properties that should be applied in all contracting countries. To focus on trademark, the Paris Convention laid down a criteria on the determination of the prerequisites of trademark registration⁴⁰²,

³⁹⁸ WIPO, ‘Summary of the Paris Convention for the Protection of Industrial Property (1883)’
<https://www.wipo.int/treaties/en/ip/paris/summary_paris.html> accessed 13 February 2021

³⁹⁹ WIPO, ‘Paris Convention for the Protection of Industrial Property’
<<https://www.wipo.int/treaties/en/ip/paris/>> accessed 13 February 2021

⁴⁰⁰ Paris Convention, art 3

⁴⁰¹ Paris Convention, art 4

⁴⁰² Paris Convention, art 6

the protection of well-known marks⁴⁰³, the grounds for refusal or invalidate a trademark registration⁴⁰⁴, and relative criteria applicable to service marks⁴⁰⁵, collective marks⁴⁰⁶, and trade names.⁴⁰⁷

In applying the Paris Convention, it should be noted that the extent of Paris Convention is limited to national preferences and domestic interests of each contracting country, all contracting countries have their own freedom to legislate the law regarding industrial property pursuant to their own policies.⁴⁰⁸

Except the general prohibition and denial of trademark registration, the Paris Convention is silent on the concrete definition on what can be a trademark and the strict and precise trademark protectable subject matter. Instead, the determination of trademark prerequisites of filing and registration can be freely determined by each contracting country under their national legislation so long as it does not fall within the ground for refusal.⁴⁰⁹ Not only that, but the Paris Convention also does not provide the definition and subject matter regarding non-traditional trademark, including motion marks and multimedia marks, due to the fact that the recognition of non-traditional trademark came into spotlights many years after the conclusion and adoption of the Paris Convention.⁴¹⁰ However, the Paris Convention does not exclude the possibility of non-traditional trademark protection, this is because the Paris Convention neither provided non-traditional trademark as an element for denial of registration, nor does it invalidate the registration of such mark. In addition, the Paris Convention ensures the protection of trademark in an interstate level where if trademarks, including non-

⁴⁰³ Paris Convention, art 6bis

⁴⁰⁴ Paris Convention, art 6ter and art 6quinquies

⁴⁰⁵ Paris Convention, art 6sexies

⁴⁰⁶ Paris Convention, art 7bis

⁴⁰⁷ Paris Convention, art 8 and art 9

⁴⁰⁸ Bodenhausen (n 139) 15.

⁴⁰⁹ (n 266)

⁴¹⁰ Croze (n 61) 14-15.

traditional trademarks, were accepted for protection in the original country, it would not be denied of protection and filing in other contracting countries.

In respect of criminal protection, the scope of the Paris Convention does not regard trademark and other industrial properties in a criminal sense. Thus, the criminal protection and enforcement concerning trademarks remain unavailable in the Paris Convention.

In conclusion, even if there is no ground for non-traditional trademarks protection under the Paris Convention, there is also no ground for refusal of such marks under the Paris Convention. Further, criminal protection relating to trademark is not yet a common concern under the scope of the Paris Convention.

3.2.2 WTO Agreement on Trade – Related Aspects of Intellectual Property Right (TRIPS Agreement)

According to Article 15 of the TRIPS Agreement, the concepts of trademark underlying this provision can be divided into three main concepts which are first what can constitute a trademark, second what can be eligible for trademark registration, and third registrability as a prerequisite for trademark registration.

First, the concept of what can constitute a trademark is associated with drawing a certain scope of definition for trademark protection. The scope of definition can be derived from the first sentence of Article 15 as “any sign, or combination of sign ... shall be capable of constituting a trademark.” In this respect, this definition widens the scope of protection to cover all signs that can be perceptible by human regardless of if they are visually perceptible or non-visually perceptible such as textures, tastes, scents, and sounds.⁴¹¹ Not only that, in determining whether such mark can constitute a trademark, the consideration should also be taken on its capacity to distinguish the goods or services from one provider to those of other providers.⁴¹² This requirement means that the consumer must be able to determine that the goods

⁴¹¹ UNCTAD-ICTSD (n 94) 228.

⁴¹² TRIPS Agreement, art 15.1

or services indicated by the mark is different from others, and not that the consumer must be able to specify the sources of such goods or services.⁴¹³

Second, what can be eligible for trademark registration, this concept aims to set forth lists of minimum types of mark that the WTO members have an obligation to protect.⁴¹⁴ According to Article 15, the second sentence begins with the phrase “in particular” and followed by the lists of subject matter which contain many visual signs which are “words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs.” All signs listed under such article are visual signs, whereas non-visual signs have not been mentioned in the Article. Besides, when reading the second sentence in conjunction with the fourth sentence, the WTO Members are allowed to widen their prerequisite for registration of visual perceptibility which is broader than the signs listed in the second sentence.⁴¹⁵ In this respect, it should be noted that non-visual sign such as textures, tastes, scents, and sounds are not to be the minimum requirement for trademark protection under the TRIPS Agreement.

Third, concept deals with registrability as a prerequisite for trademark registration, this concept imposes many obligations on the contracting country. For distinctive character, the TRIPS Agreement addressed this requirement under the capability of sign.⁴¹⁶ According to Article 15.1, when the first sentence is read in conjunction with the third sentence the following understanding can be derived, signs that are inherently capable of distinguishing one goods or services from those of others must be registrable, whereas if those signs are not inherently capable of distinguishing goods or services they may be registrable if distinction have been acquired through use. It should be noted that this requirement is directly associated with the degree of

⁴¹³ Carlos Maria Correa, *Trade-Related Aspects of Intellectual Property Rights: A Commentary on the TRIPS Agreement* (2nd edn, Oxford University Press 2020) 162.

⁴¹⁴ UNCTAD-ICTSD (n 94)

⁴¹⁵ *ibid*

⁴¹⁶ Correa (n 417) 163.

distinctiveness in the recognition of consumers.⁴¹⁷ It permits members of WTO to provide trademark protection for sign which fails to satisfy the reasonable level of inherent distinctiveness such as descriptive marks to acquire its distinctive status through its use. For other registrability requirements, the TRIPS Agreement employs the general criteria on trademark protection under the Paris Convention. According to Article 15.2, the TRIPS agreement guaranteed that trademark registration would not be obstructed by the WTO Member unless refusal or invalidation grounds are provided under the Paris Convention. Grounds for refusal under Article 6quinquies B of the Paris Convention which is employed to be applied under the TRIPS Agreement are for example, trademark which infringes any others right of third-party acquired in the country where protection is claimed, is comprised of misleading characters, and is contrary to morality or public order. Moreover, WTO members have an obligation to refuse the registration for well-known marks owned by third party⁴¹⁸, and refuse the registration for state annorial bearings, flags, other emblems.⁴¹⁹

In regard to the provision of the TRIPS Agreement in the context of non-traditional trademark protection, there are a few legal issues that should be explored.

First, what can constitute a trademark, it can be seen that the concept of trademark underlying the provision of the TRIPS Agreement provided a scope of marks which can constitute a trademark by only using the term “any signs or combination of signs,” this is ensured by the next sentence which stated that “such signs, in particular...” This essentially means that the list of the most traditional visual signs as mentioned under the TRIPS Agreement are a non-exhaustive list of what can constitute a trademark that is eligible for trademark registration. In other words, non-traditional marks such as two or three-dimensional shapes, holograms, scents, sounds, and motion marks can be recognized as trademarks and can be registrable if they can fulfill

⁴¹⁷ UNCTAD-ICTSD (n 94) 231.

⁴¹⁸ Paris Convention, art 6bis; see also TRIPS Agreement, art 16.3

⁴¹⁹ Paris Convention, art 6ter

all other requirements such as distinctiveness, and visual perceptibility pursuant to the underlying trademark concept of the TRIPs Agreement.⁴²⁰

Furthermore, problems of non-traditional trademarks protection, particularly motion and multimedia marks, are directly associated with the possibility of graphic representation of these marks. However, it should be noted that Article 15 of the TRIPs Agreement does not provide that trademark must be represented graphically.⁴²¹ Rather, the provision only permits WTO Members to impose the visual perception of the sign per se as a precondition for trademark registration.⁴²²

In respect of dual protection among intellectual property rights, the TRIPs Agreement is silent on the concept of parallel protection of intellectual properties whether in the sense of permission or prohibition. In other words, this concept is not prohibited by the TRIPs Agreement. Thus, if an intellectual property can fulfill all protectable subject matters as required by each category of intellectual properties, there are no grounds for refusal on the overlapping protection among various intellectual property protections.

In regard to the criminal protection of trademark, it was first recognized by the TRIPs Agreement provided within the fifth section under an enforcement part to impose all WTO Members with an obligation to provide criminal procedures and penalties to be applied in particular cases. According to Article 61, the following cases are the cases in which the WTO Members shall provide criminal procedures and penalties for: (1) willful acts of trademark counterfeiting; and (2) such act committed on a commercial scale.⁴²³ It should be noted that the phrase “shall provide for criminal procedures and penalties to be applied” was further interpreted by the Panel in *Saudi*

⁴²⁰ Mitchell Adams, Amanda Scardamaglia, ‘Non-Traditional Trademarks: An Empirical Study’ in Iren Calboli and Martin Senftleben (eds), *The Protection of Non-traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) 75.

⁴²¹ Croze (n 410)

⁴²² TRIPs Agreement, art 15.1

⁴²³ TRIPs Agreement, art 61 para 1

*Arabia – IPRs*⁴²⁴ which provided that the existence of criminal written law deals with commercial scale piracy does not fall automatically in compliance with Article 61, the WTO members still also have an obligation comply with such article. Besides the term “commercial scale” was given the meaning by the Panel as “the magnitude or extent of typical or usual commercial activity with respect to a given product in a given market.”⁴²⁵

Furthermore, the TRIPS Agreement provided that member countries must have in place a criminal sanctions against trademark counterfeiting which must at least includes imprisonment and/ or monetary fines sufficient to provide a deterrent, consistently with the level of penalties applied for crimes of a corresponding gravity. Apart from the said criminal sanctions, remedies may be extended to cover a seizure, forfeiture, and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offence.

It should be noted that there are many approaches where WTO Members are able to fulfill this obligation. In the US, for example, criminal offences and penalties are imposed both in the level of federal law and certain state law.⁴²⁶ Furthermore, the provision of the TRIPS Agreement does not specify whether trademark which can be protected from counterfeiting must be a registered trademark. The WTO Members have a discretion to set a criteria for the application of these criminal standard that is corresponding to their own national context.⁴²⁷

3.2.3 Trademark Law Treaty

After the minimum standard of trademark protection for each and all member countries were harmonized by the Paris Convention and the TRIPS Agreement,

⁴²⁴ Saudi Arabia — Measures concerning the Protection of Intellectual Property Rights, WT/DS567/8 (5 October 2020)

⁴²⁵ China- Measures Affecting the Protection and Enforcement of Intellectual Property Rights, WT/DS362/15 (13 April 2010)

⁴²⁶ UNCTAD-ICTSD (n 94) 620.

⁴²⁷ *ibid*

the next step for the protection of non-traditional marks is the development of practical administrative procedure for trademark registration where the consumer should be treated in the same level when seeking for registration under the territory of each member country. For this reason, the Trademark Law Treaty (the “TLT”) was concluded and adopted to standardize and harmonize an administrative requirement in all jurisdictions and to ensure a reasonable expectation of the trademark owners. However, the boundary of the TLT is explicitly limited to certain visible signs. According to the Article 2 in conjunction with Article 3 of the TLT, the law obviously intended to create harmonizing effect on the form and means of representation of three-dimensional marks⁴²⁸ and color as a feature of a mark among the contracting parties of that treaty⁴²⁹ and explicitly excludes non-visible marks.⁴³⁰ Not only that, but the law also excludes the application of the Treaty upon holograms, sounds, and olfactory marks.⁴³¹ Therefore, even if there is an attempt to create more recognition towards the protection of non-traditional marks, the procedural measures provided under this treaty are still insufficient and is inappropriate on the protection of non-traditional signs.

3.2.4 Singapore Treaty on the law of Trademark

The Singapore Treaty on the Law of Trademarks (the “STLT”) was adopted by WIPO to resolve any unresolved legal loopholes that existed in the TLT. It can be seen from Article 2.1 of the STLT that this treaty is applicable to all types of marks either visible marks or non-visible marks that can be registered under the jurisdiction of contracting countries. Even though the STLT contains similar provisions to the TLT, STLT avoid mentioning non-traditional marks due to the differences of trademark eligibility between domestic law of STLT member states dealing with the non-traditional trademark registration, the STLT intended to cover any new categories

⁴²⁸ Trademark Law Treaty, art 2(a)

⁴²⁹ Trademark Law Treaty, art 3

⁴³⁰ Trademark Law Treaty, art 2(b)

⁴³¹ *ibid*

of marks which may appear in the future.⁴³² For that reason, the representational details of each types of non-traditional trademarks would be specify in a sub regulation issued under the STLT. Focusing on the motion and multimedia signs, there are two additional provisions under the regulations of the STLT regarding the representation of motion and multimedia signs: First, Rule 3(5) applies to motion marks and other marks such as holograms, colors, and position marks which allow contracting party to further prescribe the requirements on the reproduction of such mark and additional details concerning the mark under their domestic law.⁴³³ Second, Rule 3(6) of the Regulations to the STLT is applicable to marks consisting of any non- visible sign, including multimedia sign which is a combination of image and sound, the rule allows contracting party to further require one or more representations of the mark, an indication of the type of marks and details concerning the mark, which can be prescribed by the law of such contracting party.⁴³⁴ This means that a trademark applicant of a non-visible signs can now submit a representation in both graphic and photographic reproduction of a mark and any other means of representation such as electronic data files or descriptions to a competent office.⁴³⁵ However, it should be noted that The STLT does not harmonize the representation of motion mark, the IP Office of any contracting party can still request for a statement related to the application concerning the type of mark applied for and may also provide other additional requirements concerning the reproduction or representation of the mark act their discretions.⁴³⁶

⁴³² Croze (n 61) 18.

⁴³³ Regulations under the Singapore Treaty on the Law of Trademarks, Mar. 27, 2006, S. Treaty Doc. No. 110- 2, Rule 3(5)

⁴³⁴ *ibid* Rule 3(6)

⁴³⁵ See WIPO, Notes on the Basic Proposal for a Revised Trademark Law Treaty and Regulations Thereunder, WIPO Doc. TLT/ R/ DC/ 5, Note 3.09 (2005).

⁴³⁶ Croze (n 76)

3.2.5 European Union Legislation on Trademark (EU Trade Mark)

This part intended to explore and study the protection of trademark in the context of European Union which is one of the progressive trademark regimes. The research shall be given into the historical background of trademark protection, the role of EU legislation, the protection basis, the scope of protection, the registrable subject matter, and other relevant issues regarding the protection of motion and multimedia marks.

3.2.5.1 Historical Background of the EU Trade Mark Protection

In the context of European countries, trademark protection has been recognized by several individual European countries. Prior to the establishment of the European Union, even though continental Europe countries such as France, and Germany, are inspired by the patterns and trends of modern trademark protection in UK⁴³⁷, such countries provide different protection for trademark under their jurisdiction based on the unique historical background, legal cultures and ideology, and the patchwork in establishing their regime.⁴³⁸ In 1988, the EU trademark law was established by the First EU Trade Mark Directive to approximate the laws of the Member States relating to trade mark⁴³⁹, followed by the adoption of the first Community Trademark Regulation⁴⁴⁰ to establish the Community Trade Mark (CTM), presently known as EU Trade Mark (EUTM), that allows any traders to secure trademark rights by registering a community trade Mark in order to be effective throughout the territory of EU. These two primary EU instruments are intended to encourage trade

⁴³⁷ Catherine Seville, 'The Emergence and Development of Intellectual Property Law in Western Europe' in Rochelle Dreyfuss, Justine Pila (eds) *The Oxford Handbook of Intellectual Property Law* (Oxford University Press 2018) 186-187.

⁴³⁸ *ibid*

⁴³⁹ Council Directive 89/104/EEC of 21 December 1988

⁴⁴⁰ Council Regulation EC No 40/94 of 20 December 1993 (OJ [1994] L 11/1)

liberalization with borderless European trade market, and to eliminate any obstacles of free movement of goods or services and ensuring fair trade competition.⁴⁴¹

3.2.5.2 System of European Union Legislation

In order to understand the EU trademark law, the forms of EU legislation should first be considered due to the complexity of the EU legal system. EU legal texts are embodied in three different forms namely regulations, directives, and decisions. In essence, regulation would be directly applicable as soon as it become effective and it would be automatically implemented throughout the entire union. Consequently, all EU member states are to comply with the regulation. Unlike regulations, directives would not be directly applicable to each member state upon becoming effective, instead directives will become applicable to each member states when such member states have implemented the directives into their domestic laws.⁴⁴²

3.2.5.3 Protection Basis of EU Trade Mark

As a result of an expansion of rules under the principle of territoriality, trademark rights, along with other intellectual property rights under EU region will share equal effects of normative content, uniform of protection, and protectable subject-matter for invalidity and revocation under the EU Trade Mark (EUTM), formerly known as the Community Trade Mark (CTM).⁴⁴³ To secure a trade mark right within EU territory, the EUTMR provided that EU trade mark shall fundamentally be acquired from registration pursuant to Article 6. This part will explore the normative criterions of trademark protection under the EU trademark regime starting from the legal definition,

⁴⁴¹ Verena von Bomhard, Alexander von Muhlendahl (eds), *Concise European Trade Mark Law* (Kluwer Law International BV 2018), Introduction

⁴⁴² Mark Holah, Patricia Collis, *The European Union Trade Mark: A Practical Guide* (Globe Law and Business Ltd 2016)

⁴⁴³ Dev Gangjee, Trade Marks and Allied Rights in Rochelle Dreyfuss, Justine Pila (eds) *The Oxford Handbook of Intellectual Property Law* (Oxford University Press 2018) 525.

protectable subject-matter, grounds for refusal of trademark registration concerning all categories of trademarks and additional commentaries for non-traditional trademarks, particularly motion and multimedia marks.

3.2.5.4 Legal Definition of What Can Bear a Trade Mark

According to Article 4 of the EUTMR, the law defined “trade mark” in two different compositions, namely, the characteristics of mark, and the capabilities of mark. Regarding the characteristics of mark, the EUTMR defined the term “trade mark” by using a comprehensive definition which can be seen from the use of the word “any signs.” Even though various types of sign are written after the said word, these numerous types of sign would only be considered as an example of such word as such example are written after the word “in particular”. Furthermore, when this definition is read in conjunction with the provision of representation of the trademark under Article 3 of the EUTMR, it can be concluded that any other types of marks can be considered as “other mark” under the approaches provided by Article 3 (4).⁴⁴⁴

Apart from types of mark as exemplified under paragraph 1 of Article 4 of EUTMR in conjunction with Article 3(3) of EUTMR, the definition of the term “trade mark” under the EU is likely to emphasize on provisionary elements regarding the capability of signs rather than the types of signs. According to Article 4 of EUTMR, signs which can be considered as a trademark under the EU trademark law must satisfy the following requirements. First, a sign must serve the distinguishing function of trademark where it must be capable of distinguishable goods or services of one source from other sources.⁴⁴⁵ Second, a sign must be representable in a manner that facilitate public and other competent authorities to set a clear and precise subject-matter of the protection provided by the trademark applicant as a proprietor.⁴⁴⁶

⁴⁴⁴ EUIPO, Guidelines for Examination of European Union Trade Marks: Part B Examination (Version 1.0: 2020) 301.

⁴⁴⁵ EUTMR, art 4 (a)

⁴⁴⁶ EUTMR, art 4 (b)

3.2.5.5 Criteria of Trade Mark Protectability

(1) Grounds for refusal

Under EU trademark law, the protectable subject matters do not impose as any preconditions that trademark sought to be registered must fulfill prior to its registration. Rather, the EU law only provided the definition of the term “trade mark” and grounds for refusal where trademark sought for registration must not fallen under. The EUTMR provided two different categories of the ground for refusal which are absolute grounds, which is the grounds for preventing registration of a trademark fallen within a prima facie based on the character of the mark itself, and relative grounds, which is the grounds for preventing registration of a trademark sought to be registered by determining such mark in connection with the other registered marks.⁴⁴⁷

In general, due to requirements of trademark in Article 4, the general absolute ground for refusal is signs which do not conform with the requirements of Article 4.⁴⁴⁸ In this respect, if a sign does not have a distinguishing capacity or fails to represent sources of origins, for example, a sign lacking of ability to distinguish one products from another shall be refused to be registered under Article 7.1(a) of the EUTMR. The author understands that any trademark that can fulfill all requirements of the trade mark under Article 4 of the EUTMR shall be presumed to be eligible for registration without any other prerequisites to be met, unless it falls within the scope of other exclusive grounds for refusal.

(2) Distinctiveness

Distinctiveness are provided under Articles 7.1(b), (c), and (d) of the EUTMR. However, the absolute ground for refusal does not apply in a case of acquired distinctiveness in the sense of Article 7.3 of the EUTMR which will be further explained in the parts to be followed.

⁴⁴⁷ Safet Emruli, Agim Nuhiu, Besa Kadriu, Trademark Protection, Absolute and Relative Grounds for Refusal of Trademark, (2016) 2 European Journal of Multidisciplinary Studies 291, 294.

⁴⁴⁸ EUTMR, art 7.1(a)

According to Article 7.1.(b) of the EUTMR, the ground of ‘devoid of any distinctive character’ correspond to Article 4.1(b) of the Directive approximating the laws of the Member States relating to trade marks (EUTMD), the concept underlying this ground is to guarantee the indicating function of a trademark sought to be registered, if such mark fails to satisfy the ‘origin function’ in connection with the products or services, it will not be registrable.⁴⁴⁹ Trademark sought to be registered must pass the test whether a mark is devoid of any distinctive character from the assessment of a relation between a mark and the goods or services which such mark is sought to be registered for, and the perception of the relevant public on the capacity of a mark to identify sources of origins and distinguish goods or services from one another.⁴⁵⁰

Other concepts of distinctiveness provided that trade marks will not be registrable if such mark “consisted exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of the rendering of service, or other characteristics of the goods or service”⁴⁵¹, and if such mark “consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.”⁴⁵² In brief, the first ground provided that if a mark is merely descriptive or indicating geographical origin and the second ground provided that the mark is generic⁴⁵³, such marks shall be refused of trademark registration. Unlike the concept of devoid distinctive character which intended to protect the public interest, these two grounds aim to protect consumers⁴⁵⁴, encourage

⁴⁴⁹ See Case C-191/01 P Doublemint [2001] ECR II-417 para 27

⁴⁵⁰ Bomhard, Muhlendahl (eds), (n 441)

⁴⁵¹ EUTMR, art 7.1(c)

⁴⁵² EUTMR, art 7.1(d)

⁴⁵³ Bomhard, Muhlendahl (eds), (n 441)

⁴⁵⁴ See Case C-259/04 Elizabeth Florence Emanuel v Continental Shelf 128 Ltd [2006] ETMR 56 para.46

the free trade competition and prevent market dominance which create unfair trade practices.⁴⁵⁵

Apart from the consideration of a mark that is devoid of any distinctive characters, Article 7.3 of the EUTMR ensure the registration of trade mark which acquired distinctiveness through use where if such mark is capable of indicating and distinguishing products or services by the relevant public it shall also be registrable. In doing so, the absolute grounds regarding an inherent distinctiveness whether devoid of distinctive character under Article 7.1(b), the descriptive trade mark under Article 7.1(c), or generic term under Article 7.1(d) shall not be applied to marks which can be registrable under Article 7.3 of the EUTMR.

(3) Functionality

According to Article 7.1(e) of the EUTMR, signs which consist exclusively of: (i) the shape, or another characteristic, which results from the nature of the goods themselves; (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (iii) the shape, or another characteristic, which gives substantial value to the goods. Similar to the reason behind the distinctiveness under Article 7.1(c) and (d), the underlying concept of such provision is to maintain a free trade competition atmosphere.⁴⁵⁶ By doing this, if a relevant public perceives that a sign represents the technical function of products or services, or that a sign is primarily functional coincides with the technical reality and if the sign is exclusively composed of functional elements⁴⁵⁷, this refusal ground shall be applied.

(4) Contrary to public policy or morality and other absolute grounds for refusal.

According to Article 7.1(f) of the EUTMR, in corresponding to Article 4.1(f) of the EUTMD, signs shall be refused if it contrary to public policy or to an accepted

⁴⁵⁵ Bomhard, Muhlendahl (eds), (n 441)

⁴⁵⁶ *ibid*

⁴⁵⁷ *ibid*

principles of morality, this provision contains the general criteria for trademark protectability under the Paris Convention. This statutory ground is intended to balance the right of a private person to conduct their business and certain fundamental values of society.⁴⁵⁸ Apart from the violation of public policy and morality, there are several other grounds that a trade mark sought for registration under the EU law must avoid. If a landscape of a mark, for example, deceive the public about the nature, quality, or origin of the products or services such mark is associated with, such mark will be called a deceptive trade marks⁴⁵⁹, or if the mark deals with an unauthorized use of official badges, emblems or escutcheons⁴⁶⁰, these marks will not be registrable under the EU trademark law.

(5) Relative grounds for refusal

The relative grounds for refusing a registration of a trademark can also be considered based on a comparison between an earlier trademark and the later trademark. In this case an earlier trademarks are marks that have been registered both under domestic law of EU member states or under the consolidated EU trademark law.⁴⁶¹ This refusal grounds are provided in the Article 8 of the EUTMR, in corresponding to Article 5 of EUTMD which consisted of many grounds such as marks which create likelihood of confusion, marks applied for registration without consent. The term “likelihood of confusion” existed under the EU trademark Law, where a trade mark shall not be registered if the likelihood of confusion exists between the earlier trademark and the trade mark sought for EU registration. However, in determining the existence of likelihood of confusion, the consideration must be taken on the overall impression and components of the mark which can be perceived in the mind of an average consumer for such types of products or services⁴⁶² and applied to all factors

⁴⁵⁸ See Case R 495/05-G *Jabaraj Kenneth Trading as Screw You* [2007] ETMR 7 para. 13

⁴⁵⁹ EUTMR, art 7.1(g)

⁴⁶⁰ EUTMR, art 7.1(h)(i)

⁴⁶¹ EUTMR, art 8.2

⁴⁶² See Case C-251/95 *Sabel v Puma* [1997] ECR I-06191

relevant to the circumstances of the case.⁴⁶³ An example of which is the perception of an earlier mark on the market, the distinctive level of an earlier mark⁴⁶⁴, the degree of similarity between an earlier and the latter mark, the similarity or difference of the goods or services⁴⁶⁵, and the interdependence between the similarity of products and the similarity of the mark.⁴⁶⁶

3.2.5.6 Practical Administrative Proceeding of Trade Mark Registration

According to the Article 4 (b) of the EUTMR, the law provided that a mark which can constitute a trademark must be capable of being represented in the EUTM registration, this provision is supplemented by Article 31.3 of the EUTMR that a mark must be able to provide a representation that is in compliance with the formal requirements laid down under both the EUTMR and the implementing regulation called EUTMIR, which is a subsidiary regulation of the EUTMR. Thus, the form of representation is considered as an important factor to secure a trademark right under the EU trademark law. To effectively understand the representation requirement of EU non- traditional trademark, the development and current principles of the trademark representation should be explored. Prior to 1 October 2017, the old version of the EUTMR and also the EUTMIR prescribed that an EU trade mark may consist of any signs capable of being represented graphically⁴⁶⁷, however, if a mark is consisted of a sign that is graphically representable, such mark must also, in itself, be able to be represented graphically as well.⁴⁶⁸ Nonetheless, since 1 October 2017, the EUTMR

⁴⁶³ See Case T-502/07 McKenzie [2011] ECR II-00138 para. 50 for visual sign; see also Case T-99/01 Mixery [2003] ECR II-00043 para.47 for phonetic sign

⁴⁶⁴ See Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-03819

⁴⁶⁵ See Case C-39/97 Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc., [1998] ECR I-5507 para. 17-18.

⁴⁶⁶ *ibid*

⁴⁶⁷ Commission Regulation 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark, r 3 [1995] OJ L 303

⁴⁶⁸ Bomhard, Muhlendahl (eds), (n 441)

together with the EUTMIR, and the European Union Trade Mark Delegated Regulation⁴⁶⁹ were revised to expand the scope of trademark representation to allow any marks to satisfy the Article 4(b) of EUTMR by being represented in “any appropriate form using generally available technology and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”⁴⁷⁰ The seven factors of the appropriate representation test, so-called “Sieckmann criteria” has been developed from the European Court of Justice (CJEU) *Ralf Sieckmann* law case⁴⁷¹ which the CJEU given these seven factors as a helpful requirements for graphic representation. To illustrate the provision of Article 4(b) of the EUTMR with respect to Recital 10, Article 3(1) of the EUTMIR provides more details on the manner which enables the registration and the public determination of the clear and precise subject matter of the protection that they can be any appropriate forms that is in compliance with the judgment of the CJEU. Moreover, the law required that “the representation of the trade mark shall define the subject matter of the registration”⁴⁷² in order to ensure the fulfillment of seven factors, and the applicant have an alternative to complete the representation by describing the details of how the signs represented the products for position marks⁴⁷³, pattern marks⁴⁷⁴, and combination of colours.⁴⁷⁵ However, the said description are only provided for the representation and cannot broaden the scope of protection that is provided for trade mark.⁴⁷⁶

⁴⁶⁹ Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 [2017] OJ L 205/1

⁴⁷⁰ Recital 10 of EUTMR

⁴⁷¹ Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 55

⁴⁷² EUTMIR, art 3 (2) and art 3 (3)

⁴⁷³ EUTMIR, art 3(d)

⁴⁷⁴ *ibid*, art 3(e)

⁴⁷⁵ *ibid*, art 3(f)(ii)

⁴⁷⁶ *ibid*, art 3(2)

For the effect of trademark representation regarding non-traditional mark, according to the legal rationale of the EU statutory trademark law stated to provide flexibility of trademark representation in accordance with Article 4 (b) and recital 10 of the EUTMR and Article 3 (1) of the EUTMIR, the form of representation as revised intended to systemize the representation of trademark in the same direction with the Article 3 of the Regulations under the Singapore Treaty on the Law of Trademarks.⁴⁷⁷ With this respect, this formal representation criteria aims to apply to both traditional and non-traditional trade marks in the broadest sense. It can be seen from Article 3.4 of the EUTMIR that the law provided general form of representation under Article 3.1 and description as an alternative to apply with any types of trade marks other than those listed types in Article 3.3. Therefore, even when Article 3.3 of the EUTMIR provided numerous lists of trade mark types including word, figurative, shape, position, pattern, color, sound, motion, multimedia, and hologram marks,⁴⁷⁸ it must be regarded as a non-exhaustive list which may bring more certainty for users and the public, and make searching of trade marks easier⁴⁷⁹. Also, it allows any other trade mark types to be represented in any appropriate form using generally available technology pursuant to Article 4 (b) and recital 10 of the EUTMR and Article 3 (1) of the EUTMIR.

Focusing on motion and multimedia marks, prior to the revision of EUTMIR, even if the motion and multimedia marks are not explicitly provided under Article 4 of the EUTMR, these marks could still be filed as “other types of marks.” However, following the remarkable revision of EU legal texts, motion and multimedia marks have received more recognition and started having major roles under the EU trademark law. According to Article 3.3 (h) of the EUTMIR, motion marks are defined as “trade mark consisting of, or extending to, a movement or a change in the position

⁴⁷⁷ Regulations under the Singapore Treaty on the Law of Trademarks (as in force on November 1, 2011), r 3.

⁴⁷⁸ *ibid*, art 3 (3).

⁴⁷⁹ Inês Ribeiro da Cunha, Jurgita Randakevičiūtė-Alpman, ‘New types of marks available after the European Union Trade Mark Reform: An Analysis in the light of the U.S. Trade mark law,’ (2019) <<https://www.jipitec.eu/issues/jipitec-10-3-2019/5032/cunha.pdf>> accessed 28 February 2021

of the elements of the mark,” while under Article 3.3 (i) of the EUTMIR multimedia marks are defined as “trade mark consisting of, or extending to, the combination of image and sound”. To comply with recital 10 of the EUTMR, the EUTMIR provides appropriate form of representation on basis of available technology that motion marks can optionally be represented by series of sequential still images or by submitting a video file to show their movements or change of position accompanied with a description explaining the sequences⁴⁸⁰, whereas multimedia marks can be represented by submitting an audiovisual file which contains the combination of sounds and images.⁴⁸¹ It can be seen that even if the EU trademark law had abolished the requirement of graphic representation for registration, it only creates a positive impact to the mere non-visible marks, the most appropriated representation form of motion and multimedia mark remains a graphical form due to the nature of its visibility.⁴⁸²

3.2.5.7 Overlapping Protection between Trade Marks and Copyrights

Under EU intellectual property law, the parallel protection among several intellectual property rights are permitted such as the overlapping protection between patent and plant variety, design and patent, or trademark and copyright. For the overlapping between trademarks and copyright, Article 7.1(e) of the EUTMR, in corresponding with Article 4.1(e) of the TMD ensure that the trade mark consists exclusively of functional shapes or characteristics shall not exclusively be protectable only as a trademark. Rather, it can be protected both as a trademark, patent, designs or copyrights.⁴⁸³ In *Infopaq* case⁴⁸⁴, for example, the EUCJ decided that a single word can also be protected as a copyright if it is original, or the EUCJ accepted that a shop

⁴⁸⁰ EUTMIR, art 3.3 (h)

⁴⁸¹ EUTMIR, art 3.3 (i)

⁴⁸² Cunha, Alpman (n 479)

⁴⁸³ Estelle Derclaye, ‘Overlapping rights’ in Rochelle Dreyfuss, Justine Pila (eds) *The Oxford Handbook of Intellectual Property Law* (Oxford University Press 2018) 625.

⁴⁸⁴ Case C-5/08 *Infopaq International A/S v Dankse Dagblades Forening* [2009] ECR I-6569, para 45

layout could also be trademarkable in the *Apple* case.⁴⁸⁵ Moreover, in *Dior* case⁴⁸⁶, the EUCJ further held that if products can pass all registrability requirements of both copyright and trademark, exhaustive of the earlier protected right cannot be obstructed by the protection of a later right.

3.2.5.8 Criminal Protection of Trade Mark

Even though the concept of trademark infringement by counterfeiting are mentioned in the objectives of the EUTMR and the EUTMD ensuring and strengthening trade mark protection and combating counterfeiting more effectively⁴⁸⁷, the concept of trademark criminal protection have not been harmonized by any EU legislations in respect of the territoriality of each EU member. Thus, the EU members are permitted to freely impose criminal enforcement measures and the trademark holders are able to bring any criminal enforcement proceeding into the national Court level under relevant national law of the EU members.⁴⁸⁸

3.2.5.9 Examples of Motion and Multimedia Marks

Based on publicly available information⁴⁸⁹, several motion and multimedia trademarks have already been registered in the European Union. This part aims at providing examples of such registered motion and multimedia marks in EU.

(1) Cases of Registered Motion and Multimedia Marks

(1.1) Motion marks

⁴⁸⁵ Case C-421/13 *Apple v Deutsches Patent- und Markenamt* [2014] ETMR 48

⁴⁸⁶ Case C-337/95 *Parfums Christian Dior v Evora* [1997] ECR I-6013

⁴⁸⁷ EUTMR Objectives “(20) In order to enable proprietors of EU trade marks to combat counterfeiting effectively”; EUTMD Objectives “(21) In order to strengthen trade mark protection and combat counterfeiting more effectively,”

⁴⁸⁸ Michael Hawkins, Tobias Dolde ‘Trademark enforcement in the European Union’ (April 10 2019) <<https://www.lexology.com/library/detail.aspx?g=7fd8d410-c2ce-4276-90e7-15d7ab75b008>> accessed 5 March 2021

⁴⁸⁹ EUIPO, ‘Trade marks examples’ <<https://euipo.europa.eu/ohimportal/en/trade-marks-examples>> accessed 30 January 2021

a. Outline of a red apostrophe on a white background, over which appears the slogan ‘The future is exciting’, which is then replaced with the word ‘Ready?’⁴⁹⁰



Figure 1 The Future is Exciting motion mark.

b. The words ‘WIN WIN’ represented with changing letter sizes.⁴⁹¹



Figure 2 Win Win motion mark.

c. An animated sequence with two flare segments which are joined in the upper right portion of the mark. During the animation sequence, a geometric object moves up adjacent to the first segment and then down adjacent to the second segment, while individual chords within each segment turn from dark to light. Stippling shown in the mark is for shading only. The entire animated sequence lasts between one and two seconds.⁴⁹²

⁴⁹⁰ EUTM No. 17 894 840

⁴⁹¹ EUTM No. 17 894 400

⁴⁹² EUTM No. 5 338 629



Figure 3 Two flare segments motion mark

d. The word 'TIMEQUBE' underneath a cube, on an empty background. The colours of the cube altered from white to green to yellow to brown to red, and many other shades.⁴⁹³



TIMEQUBE

Figure 4 TIMEQUBE motion mark.

e. A round green shape rotating on a black background.⁴⁹⁴



Figure 5 A round green motion mark

⁴⁹³ EUTM No. 17 911 214

⁴⁹⁴ EUTM No. 17 279 712

(1.2) Multimedia mark

a. A white- blue swatch slowly falling into full blue square as a background, and three dark-blue letters namely; U, O, and C slowly appearing in front of the blue background sticking in different positions. The word ‘Universitat Oberta de Catalunya’ between two white-blue strips in vertical gradually separating out from the letter U, O, and C on the right-hand side.⁴⁹⁵



Figure 6 ‘Universitat Oberta de Catalunya’ multimedia mark

b. A figure of one-eyed ball bouncing and moving back and forth on a spotlight on a black background, accompanied with a voice saying ‘Bingo’.



Figure 7 Bingo multimedia mark

c. A hat, the band of which is stuffed with bank notes, moving slowly backwards to reveal a blue and white balls, all accompanied by drum rolls.⁴⁹⁶

⁴⁹⁵ EUTM No. 17 635 293

⁴⁹⁶ EUTM No. 17 411 315



Figure 8 A hat with bank notes multimedia mark

d. A Fahren - Gärtner mascot standing with arms akimbo, he waves his right hand and turns right to left, at a meantime he prostrates himself and waves his left and turns left to right and right-hand thumps up. Then the scenario changes into Fahren - Gärtner logo slow weaving.⁴⁹⁷



Figure 9 Fahren – Gärtner multimedia mark

e. The shoe with a verbal element 'Callaghan' changes the colour at tread, composited with a beat in time with the impact which makes shock waves alongside the sole shoe.

⁴⁹⁷ EUTM No. 17 451 816



Figure 10 Callaghan multimedia mark

f. A beating heart made from various mechanical elements, including a moving handle and a key, accompanied by beating sounds. At the sounds of a swoosh, the heart moves to the left, and the word expression ‘IFORI INTELLECTUAL PROPERTY & ICT LAW’ appears.⁴⁹⁸

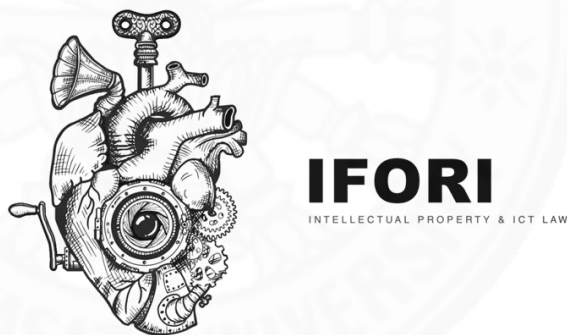


Figure 11 IFORI INTELLECTUAL PROPERTY & ICT LAW’ multimedia mark

(2) Cases of Refused Motion and Multimedia Marks

Even though there are many motion and multimedia marks which have been successfully registered under the EU trademark laws, there are however various applications of motion and multimedia marks which have been refused by the

⁴⁹⁸ EUTM No. 17 279 704

Examiner Officer or the Board of Appeal.⁴⁹⁹ One major ground for refusal is the application fails to establish the precise movement from the description provided together with the graphic representation under Article 4 EUTMR since each consumer would interpret such mark in a different way and the mark would be subjected to a different sequence of movement mark.⁵⁰⁰ The following cases will illustrate examples of refused motion marks. In Salt Bae case⁵⁰¹, Nusret Gökçe, also known as “Salt Bae”, a famous steak house chef applied for a three second motion of a chef preparing a meat and twiddling his fingers back and forth to sprinkle salt on to such meat to be a motion mark within the European Union. This application was submitted for three classes of the Nice Classification of products and services which are Class 25 which includes garments and accessories, Class 30 which includes coffee and chocolate-based beverages, rice, noodles and pasta, bakery and seasoning products, and Class 43 which includes food and drink services, restaurants, cafés, canteen services, bars, catering, food service equipment and temporary housing accommodations. The Office accepted the application only for a trade mark in Classes 25 and 30 but rejected the application for Class 43 (food and drink services) because the mark applied for registration was found to be devoid distinctiveness under Article 7(1)(b) of the EUTMR by the reason that this motion is “nothing more than a common and ordinary scene of a chef preparing meat with a pinch of salt.” Not only that, but the Office also rejected the claim that such marks acquires distinctiveness through use with the reason that “both the chef and other sports personalities are seen performing similarly” and no evidence provided by the applicant can indicate that “a significant proportion of

⁴⁹⁹ Rebecca Santana Davies, ‘Protection and Examination of Trade Marks in the EU Recent trends’ in presentation for CARIFORUM Intellectual Property Rights and Innovation (carlPI) (27 January 2020) <https://euipoef.eu/sites/default/files/arise-docs/2020/carlPI_jan2020_27-3-EUTMS-barbados.pdf> accessed 30 January 2021

⁵⁰⁰ EUIPO, Guidelines for Examination of European Union Trade Marks: PART B Examination (version 1.0) <<https://guidelines.euipo.europa.eu/binary/1803468/2000140000>> accessed 28 February 2021

⁵⁰¹ Kunstadt (n 230)

the relevant public identifies the contested services as originating from a particular undertaking because of the mark.⁵⁰² Salt Bae appealed to the EU's Fifth Board of Appeal that the motion acquired distinctiveness through its internet presence. Many of social media evidences including total numbers of following and commentaries to his videos were produced to the Board. The Fifth Board noted that there is no link between the EU territory and the user within EU territory because the evidence shown that the use occurred in Turkey which is a non-EU country and none of this report took place within the EU even if there was a few press coverages in the UK who reported on the success of such video on the internet. As for the acquired distinctiveness, the Board agrees with the reason of the Office that the applicant failed to show linkage between the movements and the recognition and sources identification of consumers which means that the acquired distinctiveness of such mark has not been established in all or a substantial parts of the Union.⁵⁰³ In conclusion, the Board dismissed the appeal on the grounds of devoid distinctiveness under Article 7 (1)(b) of the EUTMR and the motion mark cannot be registered.

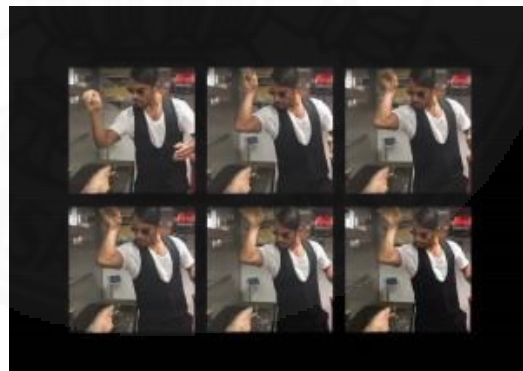


Figure 12 Salt Bae motion mark

In Bang & Olufsen A/S branches motion mark⁵⁰⁴, hand gestures motion marks were refused by the examiner for the reason that such gestures are perceived

⁵⁰² Matty (n 245) 4

⁵⁰³ *ibid* 12

⁵⁰⁴ EMTM No. 17 280 215; 17 280 249; 17 280 264; 17 280 281

as a mere instruction for operation/activation of the goods and highlighting of positive and advanced aspects of the products in question. Consequently, such gesture causes such mark to fall under the ground for refusal of trademark registration which is devoid of distinction.⁵⁰⁵

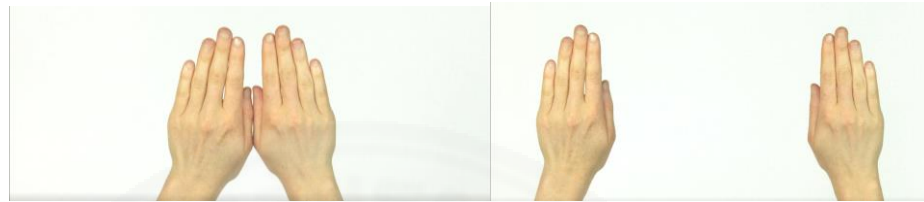


Figure 13 Bang & Olufsen A/S motion mark

As for the refused multimedia marks, they can be found in the following cases: In the EURO (€) case⁵⁰⁶, the applicant filed an application of a sign presenting several monetary amounts in a continuous manner within colour balls, the negative amount had red backgrounds, while the positive amount had green backgrounds. The applicant aimed to register such mark as a multimedia mark for goods and services in Classes 9, 36, 41 and 42. Prior to an appeal, this mark was refused for being devoid of distinctiveness under Article 7 (1) (b) of the EUTMR for the reason that such mark would be perceived as a mere “advertising message of a trading platform,” although it can be used in connection with financial goods and services.⁵⁰⁷ The applicant appealed such decision to the Board of Appeal and the Board of Appeal decided that the mere sequences of amounts in Euro is a common and obvious combination of ordinary and non-distinctive elements, such mark is incapable of conveying any messages that can capture or suggest the consumer with the goods or services which enable consumers to differentiate them of others. Hence, the appeal was dismissed by the Board of Appeal, and the application was again, rejected.

⁵⁰⁵ EUTMR, art 7 (1) (b)

⁵⁰⁶ Case R-2024/18-5 Eine Blase Mit Einem Farbwechsel Von Rot Zu Grün (29 August 2019)

⁵⁰⁷ EUTM No. 17 889 338



Figure 14 Euro (€) multimedia mark.

3.3 Foreign Laws

This part aims to explore the basic framework of trademark and the recognition of non-traditional trademark in the United States and United Kingdom as a two of the most influential trademark regimes in the world. The research will explain, in sequence from the scope of definition of trademarks, the general criteria of trademarks, the overlapping between the protection of trademark and copyright, the criminal protection available for trademarks, and the practical administrative procedures of both the United States and United Kingdom trademark law.

3.3.1 United States (US)

Under the US trademark law, the law based its trademark protection on use, the use in commerce shall be considered as the prerequisite to a federal registration. This protection basis guarantees a real connection between goods or services and the trademark used in association with them. It would not only be benefit the business user who firstly bring their goods into the marketplace, but it would also help the USPTO as a competent office to prevent a proliferation of unused marks.⁵⁰⁸ However, trademark registration system under the US trademark law plays an important role in entitling the rights of trademark owner to declare his or her intention to use a trademark in commerce. The trademark registration will subsequently occur when an actual use has been verified by the USPTO.⁵⁰⁹ The period between the date of filing a trademark application and the date of registration will be called the “intent-

⁵⁰⁸ UNCTAD-ICTSD (n 94) 232-233.

⁵⁰⁹ 15 U.S.C. §1051(b)–(d)

to-use period.” In this period, the applicant shall be entitled to claim for constructive use of the mark and impede any third parties from making a claim for federal trademark right.⁵¹⁰

3.3.1.1 Definition of Mark

In the US trademark law, with a comprehensive language of the Lanham Act⁵¹¹, trademark is defined to include any words, names, symbols, devices, or any combination thereof – (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies for a registration based on the principal established by the Lanham Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the sources of such goods or services, even if such source is unknown. In respect of non-traditional trademarks, the broad definition of “trademark” under the Lanham Act does not refuse the protection of non-traditional trademarks.⁵¹² This concept underlying legal definition has been ensured by the U.S. Supreme Court that anything can be considered as a trademark if they are capable of identifying and distinguishing products or services of one origin from others and also capable of indicating the substantial origin of such products or services.⁵¹³ In short, as long as a mark is capable of identifying one source of goods or products from others and does not fall under the ground for refusal such as functionality, or non-distinctiveness, they may be registrable under the US trademark law.

Moving trademarks or motion marks are two categories of non-traditional indicators recognized in the United States as being capable of distinguishing the sources of goods or services.⁵¹⁴ Unlike the EU trademark regime, even if the term “multimedia marks” was not commonly used or known as a categories of trademark in the US law,

⁵¹⁰ 15 U.S.C. §1057(c)

⁵¹¹ 15 U.S.C. § 1127 (2005).

⁵¹² Gilson, LaLonde (n 58) 774.

⁵¹³ *ibid*

⁵¹⁴ Matty (n 235) 558

such marks was, however, not denied for registration and shall be protected as long as they meet all the requirements as provided by the law due to the expansive definition of trademark. In view of the Public, motion and multimedia marks are commonly known as the closest in character to traditional marks of all the non-traditional trademarks because the public will only be perceiving a dimension of movement in addition to the still images form.⁵¹⁵

Under the US law, motion mark was first registered for “the audio and visual representation of a coin spinning on a hard surface, used in TV advertising,” issued on February 19, 1957.⁵¹⁶ However, this mark is registered under the provision of the US code of Federal Regulations governing Rules of Practice in Trademark Cases ensure that trademark include motion until the Code was amended in 1999,⁵¹⁷ but the term ‘motion mark’ was actually included in the 2003 amendment of the Code.⁵¹⁸

3.3.1.2 Criteria of Trademark Registrability

To secure complete protection from trademark infringement under the US trademark law, even though the US trademark regime based its protection on the use, trademarks can be eligible for federal registration on the Principal Registrar if such mark can be qualified for all of the following requirements:

(1) the trademark must be capable of distinguishing the products or services of an applicant from the products of others. This requirement came from the broadest scope of what can constitute a mark under the U.S. law, the mark sought for registration shall serve the key-function of trademark which is the indicating and distinguishing function as provided by the law.⁵¹⁹

(2) the trademark sought to be registered must actually be used in commerce before the registration date, which means that the goods bearing the

⁵¹⁵ Gilson, LaLonde (n 58) 806

⁵¹⁶ USPTO. Reg. No. 0641872

⁵¹⁷ USPTO. Reg. No. 48920

⁵¹⁸ USPTO. Reg. No. 55574; TMEP, s 807.11

⁵¹⁹ 15 U.S.C.A. § 1052

trademark must have already been sold in an interstate commerce.⁵²⁰ This requirement came from the definition of trademark under the factor that it must be “used by a person” or “which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,” even if the law does not require that the mark must be used before the date of filling an application and allows the filling of application for bona fide intention to use trademark in commerce, no marks will be registered until the applicant successfully filed a verification statement that the mark has indeed, already been used in commerce and specifying the date of first use in commerce and the goods or services specified in the notice of allowance on or in connection with which the mark is used.⁵²¹ Otherwise, the applicant for bona fide intention shall be refused for registration and abandoned unless fallen under other exceptions as provided by law.⁵²²

(3) the trademark sought for registration must be directly badged on the products or the products containers or the tags or labels affixed thereto in accordance with the statutory definition of the term “use in commerce” as defined by law.⁵²³

(4) the trademark which are registrable must comply with the statutory registrable subject matters and the application must be in accordance with the specified administrative procedures.

Regarding the registrable subject matters under the US trademark law, most of registrable subject matters are developed from the definition of trademark in Section 45 of the US Trademark Act⁵²⁴, the Act provides elements of what can constitute a mark, elements of “use in commerce” and “use to identify and distinguish goods.” With respect to these statutory elements, there are branches of underlying concepts to be explored. First, the goods or services sold or used under the trademark

⁵²⁰ McCarthy (n 5) § 19:10

⁵²¹ 15 U.S.C.A. §§ 1051(b)(2), (d)(1)

⁵²² *ibid* § 1051(d)(4)

⁵²³ *ibid* § 1027

⁵²⁴ *ibid*

sought for trademark registration must be “goods or services in commerce,”⁵²⁵ which means any items that the applicant uses in his or her course of business, and does not include items sold or transported in commerce for use by others.⁵²⁶ Without such element, an exclusive trademark right will not be given to the seller or the producer of such trademark.⁵²⁷ Second, the capacity of indicating and distinguishing, this underlying concept comprises of three principles in examining whether a mark serves as a trademark are distinctiveness, functionality, and likelihood of confusion as a ground for refusal of trademark registration.

The principle of distinctiveness is a fundamental condition for the protection of exclusive trademark rights under both federal and state laws⁵²⁸ and for registration on the federal principal register. In essence, even if the term “distinctive” has not been defined by the Lanham Act⁵²⁹, the distinctiveness was conceptualized by the Court in *Abercrombie & Fitch Co. v. Hunting World*. Under this case the Court categorized the level of trademark distinctiveness, also known as Spectrum of inherent distinctiveness of the marks, into five categories which are arbitrary, fanciful, suggestive, descriptive, and generic. Fanciful marks are whole made-up words.⁵³⁰ Arbitrary marks are common words, symbols, pictures, etc., which are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services.⁵³¹ Due to the nature of fanciful and arbitrary marks which do not create any connection between the mark

⁵²⁵ 15 U.S.C. § 1052(f)

⁵²⁶ USPTO, ‘Non-Traditional Marks at The U.S. Patent and Trademark Office’
<https://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf> accessed 27 February 2021

⁵²⁷ (n 59) para 162

⁵²⁸ See Trade-Mark Cases, 100 U.S. 82, 92 (1879)

⁵²⁹ Lisa P. Ramsey, ‘Descriptive Trademarks and the First Amendment’ (2005) University of San Diego Law and Economics Research Paper Series. 9 1096, 1107

⁵³⁰ See *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1058 n.19 (9th Cir. 1999)

⁵³¹ See *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 n.18 (3d Cir. 1991)

and the products or services used in association with such mark⁵³², whether such connection would be a description or suggestion, these two categories of distinctions can therefore, be seen in the strongest marks in serving the indicating and distinguishing function of trademark.⁵³³ Next, suggestive marks are marks which suggest a quality, ingredient, or characteristic of products, and conveys an impression of a product⁵³⁴, even if suggestive mark has a connection with the products or services sold under such marks, it requires consumer to take one further step at their imagination, thought or perception in order to determine what products or services such marks are relaying or reaches a conclusion as to the nature of related products or services.⁵³⁵ As a result of the nature of these three types of marks, they are considered as marks that can serve to identify a particular source of products or services,⁵³⁶ and the US trademark law therefore, considered them as having inherent distinctiveness. Any marks that can fall under these three types of marks can be eligible for registration and protection under the US trademark law.⁵³⁷ Apart from the three types of marks mentioned above, the last two categories of marks are generic and descriptive marks. Generic marks are marks using generic terms, while descriptive marks are marks which is merely descriptive⁵³⁸ or directly convey an immediate idea of the ingredients, qualities or characteristics of the goods or services⁵³⁹, or describe the intended purposes, functions or usage of the

⁵³² See *Brookfield Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1058 n.19 (9th Cir. 1999); see also *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 221 (3d Cir. 2000)

⁵³³ Ramsey (n 504) 1110.

⁵³⁴ See *Checkpoint Sys.*, 269 F.3d at 282; see also *Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001)

⁵³⁵ See *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 221-22 (3d Cir. 2000); see also *Brookfield*, 174 F.3d, 1058

⁵³⁶ *Two Pesos*, 505 U.S., 768

⁵³⁷ Ramsey (n 504) 1107.

⁵³⁸ 15 U.S.C.A. § 1052(e)

⁵³⁹ *A & H Sportswear* (n 510) 222.

goods or services, their sizes, classes of users, or the end effect upon the user.⁵⁴⁰ As a result of the ordinary term uses in generic mark, such mark is considered to be lacking of distinguishing capacity and cannot served as a trademark,⁵⁴¹ whereas descriptive mark is closely relating to goods or services which the mark is used in association with, therefore this type of mark cannot, in itself inherently distinguish goods or services as coming from a particular source, however such mark may be able to demonstrate a secondary meaning if the consumers can recognize products or services sold under such mark to be a product or service of a certain manufacturer.⁵⁴² In conclusion, the border line of distinctiveness drawn by the US Court provided two approaches for a mark to be considered as distinctive, such approached are inherent distinctiveness and acquired distinctiveness through secondary meaning. If a mark can be qualified as distinctive through any of the two approached, then it will be considered to be eligible for trademark registration and protection under the US trademark law.

The principle of Functionality is a doctrine of art indicating a legal criteria regarding the particular nature or degree of technical features or competitive importance of a product.⁵⁴³ In substance, if the mark sought to be registered is essential to the use or purpose of the product or if it affects the cost or quality of the product⁵⁴⁴, it is considered to have a functional feature. Due to the perpetual renewing of trademark under US law, the concept underlying this principle is to prevent the trademark registration of the functional feature of the products to avoid the everlasting extension of the period of protection under patent law and maintain a suitable balance between patent and trademark law that the expired utilitarian product feature will not be unlimitedly protected as a trademark by registration and will become the right in public domain for encouraging the free and open competition.⁵⁴⁵ In theoretical

⁵⁴⁰ Ford Motor Co. v. Summit Motor Prods., Inc., 930 F.2d 277, 292 n.18 (3rd Cir. 1991)

⁵⁴¹ Two Pesos (n 536) 768-69.

⁵⁴² Abercrombie & Fitch Stores, 280 F.3d at 635-36

⁵⁴³ Gangjee (n 443) 530.

⁵⁴⁴ Traffix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001)

⁵⁴⁵ USPTO (n 526)

aspects, functionality character can be divided into two categories which are utilitarian functionality and aesthetic functionality. Utilitarian functionality is the legal term defined and determined by the Court as a mechanism for insuring access to competitively necessary product features and the extent of utility patent law on the mere utilitarian features.⁵⁴⁶ While aesthetic functionality is developed from the underlying concept that many visual attractiveness and aesthetical pleasant are categorized as a “functional” of the designs which the public are free to copy and imitate it without any substantial barrier in competition.⁵⁴⁷

The principal of likelihood of confusion is a standard rule applicable to the statutory test of both trademarks registration and trademark infringement.⁵⁴⁸ In context of trademarks registration, the concept of likelihood of confusion is a basis of a refusal ground which is known as “confusingly similar.” According to Section 1052(d) of the Lanham Act, a mark which is similar to a registered mark or an effective mark used in US by another person and when such mark, used on or in connection with the goods or services they are intended to be registered for, the similarity of the mark creates confusion, or induces mistake, or deception, shall be refused from registration on the principal register, and also refused on the supplemental register.⁵⁴⁹

Apart from the said principles, the trademark sought for registration must also not fall under other grounds for refusal in Section 1052 of the Lanham Act which is mostly dealing with mark that is contrary to the public policy or morality such as the flag or coat of arms or other insignia of the United States⁵⁵⁰, and the name, signature, or portrait of a deceased President of the United States.⁵⁵¹

⁵⁴⁶ Mark McKenna, (Dys)Functionality, (2012) 48 Hous. L. Rev. 823, 824.

⁵⁴⁷ McCarthy (n 5) § 7.79

⁵⁴⁸ 15 U.S.C.A. § 1114(1)

⁵⁴⁹ 15 U.S.C.A. § 1091

⁵⁵⁰ 15 U.S.C.A. § 1052(b)

⁵⁵¹ 15 U.S.C.A. § 1052(c)

3.3.1.3 Practical Administrative Proceeding of Trademark Registration

Due to the broad scope of the trademark definition, there is no statutory barrier regarding the registration of motion and multimedia marks if the applicant can represent the capacity of such mark in distinguishing the products or services bearing such marks from the products or services of others. In doing so, the applicant must provide sufficient description of the nature of the mark and the drawing of such mark pursuant to the requirements under an administrative procedure. According to the Trademark Manual of Examining Procedure guidelines for trademark examination, a motion mark, either a mark containing motion or including motion, shall be registered by submitting a detailed written description of such mark, and either a drawing which shows a single point of movement, or several “freeze frames” showing the movement in sequences.⁵⁵² The examination of motion marks registration can be analogized to trade dress that the mark “is protectable if its subcomponents are distinctive and if the entire image has a limited duration.”⁵⁵³ It should be noted that the US trademark examination only requires drawing and description for registration, there are no other requirements provided as a guideline or particularly imposed on registering of a motion mark under the US trademark law.⁵⁵⁴

3.3.1.4 Overlapping Protection between Trademark and Copyright

Trademark and copyright serve different aims to provide the protection for different subject-matters.⁵⁵⁵ Objectively, copyright aims to provide exclusive right for creator who express his or her ideas⁵⁵⁶ into creative works fulfilling the requirements of originality⁵⁵⁷, whereas trademark aims to facilitate consumers to identify one good

⁵⁵² 37 C.F.R. s 2.52 (3); TMEP s 807.11

⁵⁵³ Erik H. Kahn, On the ‘Net, Unusual Marks Gain In Importance, (1998) NAT’L L.J., C13

⁵⁵⁴ Matty (n 235) 571.

⁵⁵⁵ Craig S. Mende & Belinda Isaac, ‘When Copyright and Trademark Rights Overlap’, in Neil Wilkof & Sbamnad Basheer (eds) *Overlapping Intellectual Property Rights* (2012) 158.

⁵⁵⁶ *CDN Inc. v. Kapes*, 197 F.3d 1256, 1261–62 (9th Cir. 1999).

⁵⁵⁷ The doctrine of originality is the fundamental requirement for copyright

or service from others and eliminate confusion of consumers on the same or similar types of goods or services. Thus, it can be concluded that the goal of copyright is to protect the holder in exercising his or her exclusive right upon the copyrighted work, while trademark's main purpose is to provide protection against consumers confusion by allowing for a registration of a mark that can help in identifying and distinguishing sources and protecting the goodwill of the trademark authorized user or producer, and not to protect a trademark itself.⁵⁵⁸

Even though these two areas of intellectual property protection employ the different subject-matters required under their protections, certain trademarks can have also have the objectives to be an original work, and theoretically should be able to also secured a protection under copyright.⁵⁵⁹ Thus, the dual protection under these areas may be available. The overlapping protection between trademark and copyright often happens in an artistic creative work due to the growth of technological disruption and visualization, artistic work can also serve an aesthetic purposes and also capture consumer's attractions in differentiating the sources of goods or services.⁵⁶⁰

Under the US law, the cross protection between copyright and trademark directly deals with the protection of creative artistic work such as fictional characters, video clips, pictures, and songs in different circumstances.⁵⁶¹ In doing so, various fictional characters have been registered as a design mark such as MICKEY MOUSE⁵⁶²,

⁵⁵⁸ Jane C. Ginsburg, irene Calboli, "Intellectual Property in Transition: The Several Sides of Overlapping Copyright and Trademark Protection" in Niklas Bruun, Graeme B. Dinwoodie, Marianne Levin, Ansgar Ohly (eds) *Transition and Coherence in Intellectual Property Law: Essay in Honour of Annette Kur* (Cambridge University Press 2020) 309-310.

⁵⁵⁹ Jane C. Ginsburg, irene Calboli, "Overlapping Copyright and Trademark Protection in the United States: More Protection and More Fair Use?" in Irene Calboli and Jane C Ginsburg (eds) *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge University Press 2020) 437.

⁵⁶⁰ *ibid*

⁵⁶¹ Irene Calboli, Overlapping Copyright and Trademark Protection: A Call for Concern and Action, (2014) Ill. L. Rev. Slip Opinions 25, 25.

⁵⁶² USPTO Reg No. 3598848

RONALD MCDONALD⁵⁶³, and BATMAN.⁵⁶⁴ Fulfillment of subject-matters of these two protection is not only accepted in theoretical sense, creative and original works can secure both copyright and trademark as long as they can fulfill all subject-matters, this dual protections can be seen in the following cases.

In *Planters Nut & Chocolate Co. v. Crown Nut Co.*⁵⁶⁵, the court held that the distinguishing and indicating functions of a trademark used in Peanut can also be considered as a fanciful picture of humanized Peanut. This has quickly become a crucial turning pinpoint in which the court ensured the existence of trademark and copyright's overlapping. Not only that, in *Frederick Warne & Co. v. Book Sales, Inc.*⁵⁶⁶, the U.S. District Court insisted that "dual protection under copyright and trademark law is particularly appropriate for graphic representations of characters with respect to the famous character of Peter Rabbit."

Among numerous case law addressing the possibility of overlapping protection between trademark and copyright, it does not mean that copyrighted work can be used in an unlimited space since the protection of copyrighted work will continue to exist for another 70 years after the death of an author, and later become the work in public domain which the public can recreate at no cost. This period is much shorter than the perpetual protection for trademarks, therefore in balancing the public interest and exclusive right of the author's protection, the court must ensure that the copyrighted work will be used under appropriated grounds without continuing the protection of such work after it has expired.⁵⁶⁷ In *Daster Corp v. Twentieth Century Fox Film Corp.*⁵⁶⁸, the case concerns a perpetual copyright protection which has been addressed by the Supreme Court that an applicant cannot bring an expired copyright work to claim or secure a protection under trademark as this would be considered as

⁵⁶³ USPTO Reg No. 0874861

⁵⁶⁴ USPTO Reg No. 4871024

⁵⁶⁵ *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916 (CCPA 1962)

⁵⁶⁶ *Frederick Warne & Co. v. Book Sales Inc.*, 481 F. Supp. 1191, 1196–97 (S.D.N.Y. 1979)

⁵⁶⁷ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U. S. 141, 150-151 (1989)

⁵⁶⁸ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 U.S. 2041, 2048 (2003)

turning an expired copyright into mutant copyrights in the form of trademark. Nonetheless, it should be noted that the court merely underscored this concern in order to weight the public interest against the exclusive right upon expired original work of the author and make a decision in favor of public domain, the Court does not prohibit the dual protection between trademark and copyright.⁵⁶⁹ Thus, the dual protection under U.S. trademark and copyright law can still be applied, if it is done so in an appropriate manner taking into account the respect for each purpose and realm.

3.3.1.5 Criminal Protection of Trademark

Under the US law, legislation deals with criminal protection against trademark is the federal Trademark Counterfeiting Act (the “TCA”) which was enacted to provide criminal enforcement by increasing the penalties for criminal commitment against trademark infringement and counterfeiting alongside with the civil protection provided in the form of liabilities for trademark infringement and counterfeiting. In essence, while the civil protection allows both registered and unregistered trademark owner to claim for damages caused by civil infringement and counterfeiting, criminal protection is only provided for a federal registered trademark and against the committing of criminal offenses with trafficking counterfeit goods or services.⁵⁷⁰ According to § 2320 of the Lanham Act, the criminal offense against trademark counterfeiting comprises of two elements, namely, intentional trafficking of goods or services, and knowingly uses a counterfeit mark on or in connection with the said goods or services.⁵⁷¹ To understand what is a counterfeit mark, the definition of the term “counterfeit mark” should first be explored. As provided under the law, counterfeit mark means a spurious mark registered on the principal register and in use

⁵⁶⁹ Ginsburg, Calboli (n 561) 310

⁵⁷⁰ Mark P. McKenna, ‘Criminal Trademark Enforcement and the Problem of Inevitable Creep’ <[https://www.law.berkeley.edu/files/McKenna_-_Criminal_TM_Enforcement_\(IPSC_Draft\).pdf](https://www.law.berkeley.edu/files/McKenna_-_Criminal_TM_Enforcement_(IPSC_Draft).pdf)> accessed 12 February 2021

⁵⁷¹ 18 U.S.C.A. § 2320 (a)

regardless of whether the registration were known.⁵⁷² Thus, in the absence of a criminal protection for owner of an unregistered trademark, it can be seen that owner of an unregistered trademark can only claim for protection under civil trademark infringement although the US trademark law, as mentioned earlier, based their domestic trademark protection on use.

3.3.1.6 Examples of Registered Motion and Multimedia Marks

As mentioned earlier, the US trademark law does not provide a separate category for multimedia marks and motion marks, the examples of registered motion marks therefore include the registered of multimedia marks. Many formats of motion marks have been registered with the USPTO, including the following illustrations:

(1) The Columbia motion mark, a personification of the United States motion mark in the format of iconic multimedia.⁵⁷³ Some source claims that this is the oldest motion and multimedia mark to ever be registered under the US trademark law.⁵⁷⁴ Such mark consists of a moving image of a flash of light where the rays of such light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by a lady on a pedestal. The word "COLUMBIA" appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady.⁵⁷⁵

⁵⁷² 18 U.S.C.A. § 2320 (f) (1) (A)

⁵⁷³ Belinda J. Scrimenti. 'Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around the World' (2020) <<https://www.lexisnexis.com/lexis-practical-guidance/the-journal/b/pa/posts/animated-motion-trademarks-grow-in-popularity-and-legal-protection-around-the-world>> accessed 28 February 2021

⁵⁷⁴ *ibid*

⁵⁷⁵ USPTO Reg No. 1975999



Figure 15 COLUMBIA motion mark.

(2) The Peabody Duck March, a mark consists of live visual and motion elements of a Peabody duck march performing at The Peabody Hotels which includes a red carpet being rolled out, the ducks and uniformed Duck master appears at the elevator door, getting down on the red carpet, stepping up toward the fountain and swimming. Moreover, the mark also includes the surrounded fanfare in sequence.⁵⁷⁶ Even if it risks of being opposed on the functionality as it is registered with a hotel service, this mark is honored as one of an incredible unique mark which can represent endless creative possibilities that motion marks can afford for manufacturers and service providers.⁵⁷⁷



Figure 16 The Peabody Duck March motion mark.

⁵⁷⁶ USPTO Reg No. 2710415

⁵⁷⁷ Matty (n 235) 567.

(3) The Y? mark, a mark having motion as a feature and consists of a stylized capital letter "Y" within a loosely defined circle orbited clockwise by a second smaller, loosely defined circle containing a stylized question mark.⁵⁷⁸



Figure 17 Y? motion mark

(4) The stylized eye mark, a mark having motion as a feature and consists of a pair of stylized eyes moving horizontally back and forth. The drawing consists of four freeze frames showing the mark at various points in its movement, pursuant to an application guideline, rules 37 C.F.R. 2.52(a)(2)(iv).



Figure 18 The stylized eyes motion mark.

3.3.2 United Kingdom (UK)

The United Kingdom established its trademark law in compliance with the EU trademark regime as it is formerly a member of the EU. Most of criteria of the UK trademarks are similar to trademark principle as provided in the EU. However, although the UK national rules and EU rules are similar, they are not entirely identical. This part will only emphasize on the special UK national rules on trademark registrability without repeating the EU protectable subject matters which has already been mentioned in this paper under the part of EU.

⁵⁷⁸ USPTO Reg No..2709214

3.3.2.1 Definition of the Term “Trade Mark”

Since the EU Directive is only intended to provide an approximate standard law for EU members, and is not intended to harmonize the laws of EU members,⁵⁷⁹ the definition of trade mark under the UK is defined in compliance with the EU Trademark Directive which provides the framework of trademark law for EU member countries.⁵⁸⁰ Even though the Community Trade Mark regime widely protects any categories of non-traditional marks, the Community Trade Mark regime is independent from the UK national regime.⁵⁸¹ To explore the UK national trademark regime, specifically on the allowance or refusal of non-traditional trademark protection, the criterion of UK national trademark should be taken into account. According to Section 1(1) of the UK Trade Marks Act 1994, trade mark means “any sign represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.”⁵⁸² With respect to this definition, the criteria on what can constitute a trade mark under the UK law can be divided into three elements, which are first, the mark must be a sign, second, the mark must be capable of graphical representation, and third, the mark must be capable of distinguishing goods or services.

For the distinguishing capacity, like all countries, the minimum requirement of a mark sought to be registered as a trade mark must be able to satisfied is such mark must serve the indicating and distinguishing function of a trademark.

For the criteria that trade mark must be a sign, the statutory definition gave a comprehensive definition of mark where even if the second sentence of Section 1(1) lists several categories of signs which can constitute a trade mark such as words, personal names, designs, letters, numerals, colours, sounds or the shape of goods or their packaging,⁵⁸³ the statutory provision used the term “A trade mark may, in

⁵⁷⁹ Recitals of the EUTMD

⁵⁸⁰ Council Directive 2008/95/EC of 22 October 2008 relating to trade marks [2008] OJ L299/25

⁵⁸¹ Hector MacQueen and others (n 42) 599.

⁵⁸² Trade Marks Act 1994, s 1(1)

⁵⁸³ *ibid*

particular, consist of...” instead of using the term “means” which extends the scope of trademark registration to any types of signs or marks. For that reason, like the EU trade mark law, the issue of what can constitute a trade mark under the UK law creates barely any legal problematic dilemmas, and various categories of non-traditional signs were accepted by the UKIPO for a registration as trademark.⁵⁸⁴ Moreover, in the context of case law, non-traditional trademarks were first recognized in *Koninklike Philips Electronics NV v. Remington Consumer Products Ltd.*,⁵⁸⁵ which the Court held that “There is no categories of marks which is not excluded from a registration...thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”⁵⁸⁶ It can be concluded that so long as the mark is capable of distinguishing the goods of the proprietor from others, it can fulfill the significant purpose of ensuring the source of product, hence it can become a trade mark.⁵⁸⁷

For the criteria that a trade mark must be represented graphically, this requirement is explicitly inconsistent with the EU trademark law which where graphic representation was abolished by the EUTMR, as amended. However, the graphic representation is considered as a big obstacle to acquire protection for non-traditional sign, particularly non-visible signs, the UK law employs the Sieckmann seven criteria as mentioned in the part of EU to be used as a minimum standard of graphic representation in UK.⁵⁸⁸

3.3.2.2 Criteria of trademark protectability: Ground for refusal

Based on the fact that the UK was once an EU member and the EU has published the 1994 act revised for implementing the EU directive as mentioned above,

⁵⁸⁴ Hector MacQueen and others (n 42) 600.

⁵⁸⁵ Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2002] ETMR 955

⁵⁸⁶ *ibid* para.40

⁵⁸⁷ *ibid* para.48-50

⁵⁸⁸ Hector MacQueen and others (n 42) 604-607.

the UK therefore employs a similar statutory criteria as provided under EU trademark law. Regarding the grounds for refusal, it can be divided into absolute grounds for refusal⁵⁸⁹, and relative grounds for refusal.⁵⁹⁰ For absolute grounds for refusal, many of general trademark eligibilities for registration such as fulfilling all requirements of being a trade mark⁵⁹¹, distinctiveness requirement⁵⁹², functionality⁵⁹³, contrary to public policy or morality, and public deception⁵⁹⁴ as well as the EU trademark criteria are adopted, however this part will not repeat the explanation of this refusal grounds as it has already been described in the part of EU grounds for refusal. However, one unique criteria which does not provided in the EUTMR but is provided in Article 3(2)(d) of the EUTMD is the requirement that a trade mark sought to be registered “shall not be registered if or to the extent that the application is made in bad faith.”⁵⁹⁵ To register the trademark, the applicant must pass the test that the Court shall decide by balancing the dishonesty of the applicant⁵⁹⁶ against the standard of acceptable commercial behavior observed by reasonable and experienced persons in the commercial area⁵⁹⁷ to determine whether the applicant has acted in bad faith or not. For relative grounds for refusal, the UK trademark Act 1994 implemented the concept of “likelihood of confusion” under Article 8 of the EUTMR, in corresponding to Article 5 of EUTMD to be one of refusal grounds relating to the earlier mark owned by another person that a trade mark sought to be registered shall be refused if such trademark is identical with an earlier trade mark whether the classes of goods or services for which

⁵⁸⁹ Trade Marks Act 1994, s 3

⁵⁹⁰ *ibid*, s 5

⁵⁹¹ *Ibid*, s 3(1)(a)

⁵⁹² *Ibid*, ss 3(1.1)(b) for devoid distinctiveness, (c) for descriptive terms, (d) for generic terms, 3(1.2) for acquired distinctiveness

⁵⁹³ *Ibid*, s 3(2)

⁵⁹⁴ *Ibid*, ss 3(3), 4

⁵⁹⁵ Trade Marks Act 1994, s 3(6)

⁵⁹⁶ *Twinsectra Ltd v Yardly* [2002] 2 AC 164 para 36 “[D]ishonesty requires knowledge by the defendant that he was doing would be regard as dishonest by honest person”

⁵⁹⁷ *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367

the trade mark is applied to are the same or similar classes, while if such identical mark will not be applied to the similar or the same classes of goods, such mark may not be registrable only in the case that such earlier mark is reputable in the UK or European Community in the case of community trademark.

3.3.2.3 Practical Administrative Proceeding of Trademark Registration

Under UK trademark law, due to the fact that there are various important changes to the UK Trademark law in January 2015 in order to comply with the 2015 EU directive⁵⁹⁸, an applicant is able to submit his or her motion marks, including hologram and sound marks, using multimedia format instead of graphical representation.⁵⁹⁹ The United Kingdom Intellectual Property Office (UKIPO) designates an acceptable filing format for each categories of marks. For motion and multimedia marks, a MP4 video file format is acceptable, also series of still sequential images showing the movement or change of position in JPEG, TIFF, GIF, PNG format are also available as an optional admissible file format for motion mark, whereas multimedia mark, as the combination of image and sound, can be represented by submitting an audio-visual file via e-filing.⁶⁰⁰ However, the MP4 video file should not exceed 8,000 Kbps (kilobytes per second) and 20 MB (Megabytes) and a motion mark description must contain still images, image depicting the changes in appearance, complete sequence of movements, and sequential order of the images in accordance with and subject to the scope of representation.⁶⁰¹ As for representation, UKIPO requirements of trademark representation complies with the EU Sieckmann seven criteria where marks must be represented in a clear, precise, self-contained, easily accessible,

⁵⁹⁸ Council Directive 2015/2436 of 16 December 2015 relating to trade marks [2015] OJ L 336, 1–26

⁵⁹⁹ EIP, 'First multimedia 'motion' trademark registered in UK' (12 August 2019) <https://www.eip.com/de/updates/article/first_multimedia_motion_trademark_registered_in_uk.pdf> accessed 30 January 2021

⁶⁰⁰ UKIPO, 'Manual of trade marks practice: New applications' (January 2021) <<https://www.gov.uk/guidance/trade-marks-manual/new-applications>> accessed 28 February 2021

⁶⁰¹ *ibid*

intelligible, durable and objective manner as to enable the competent authorities and the public to clearly and precisely indicate the subject matter of the protection afforded to its proprietor.⁶⁰²

3.3.2.4 Overlapping Protection between Trade Mark and Copyright

In the UK, the parallel protection between trademark and copyright is permitted in many circumstances. In *Unilever plc v Griffin*,⁶⁰³ for example, the Court considered the infringement of Unilever right onto grounds of both trademark⁶⁰⁴, passing off⁶⁰⁵, and copyright⁶⁰⁶ in order to protect the Unilever which is the plaintiff, or In *Karo Step* case⁶⁰⁷, the Court permitted the co-existence of copyright and trademark. The opinion on this issue given by Judge Whitford that “For many applications are made for registration of marks new and unused, ..., The proprietors of a mark in which copyright exists can, I think, only be the owners of the copyright in the mark.” This case can be regarded as a landmark case of the trademark and copyright overlapping protection under the UK.

In the UK, neither statutory law nor case law resolve the issue whether the UK allows the situation that the inconsistency in the dual protection under trade mark and copy right which is resulting from the difference in period of protection, where trademark can be renewed indefinitely while copyright expires at the end of protection period. Consequently, a copyright work that is also granted a trade mark protection could be protected for a longer period, while a trademark that has already been expired based on non-use or later lack of distinction may still enjoy the protection under the period of copyright. Thus, the UK is silence on the sequent of overlapping between trademark and copyright. However, due to the lack of general

⁶⁰² *ibid*

⁶⁰³ *Unilever plc v Griffin* [2010] EWHC 899 (Ch)

⁶⁰⁴ *ibid* para 9-16

⁶⁰⁵ *ibid* para 20

⁶⁰⁶ *ibid* para 17-19

⁶⁰⁷ See *KARO STEP Trade Mark* [1977] RPC 255.

rule regulating the relation between these overlapping IP rights in, copyright creates sometimes obstacle for trademark law such as principle of use in the course of trade, and requirement of confusion in some cases, because the distinguishability is not an essential elements in constituting a copyright. Likewise, trademark law will also limit the enjoyment of copyright. It can be seen that the requirement of using in the course of trade as a subject-matter of trademark may conflict with the copyright objective for originality. Similarly, trademark allows private trademark use while copyright law does not. Thus, privately using a trademark that is also a copyright work may infringe the copyright.⁶⁰⁸ For exception of infringement, The UK Court applies parody exception onto both copyright and trademark cases, this means that a parody may be allowed under copyright, while the parody argument will only work in trademark law when the parody “is a vehicle for non-commercial speech” for the primary purpose of political or satirical comment. Thus, if a fair use exception on parody applies, but the use of an identical mark without reputation on identical goods, the trademark regime will override the copyright regime.⁶⁰⁹

3.3.2.5 Criminal Protection of Trade Mark

Under UK law, the substantive criminal protection of trademark is provided under Section 92 of the UK trademark Act for unauthorized use of trade mark in reference of products or services and Section 95 of the UK trademark Act for falsely representing trade mark as registered. One important concern for these statutory provisions is that the UK trademark law only criminally protects a registered trademark. In penalties, a person who committed criminal offences under Section 92 shall be criminally liable for imprisonment for a term not exceeding six months, or to a fine not exceeding the statutory maximum which is currently 5000 British Pound⁶¹⁰, or both on summary conviction or to a fine or imprisonment for a term not exceeding ten years,

⁶⁰⁸ Derclaye (n 483) 635.

⁶⁰⁹ Ibid 636

⁶¹⁰ Criminal Justice Act 1982, Introduction of standard scale of fines

or both on the conviction on indictment as the case may be.⁶¹¹ On the other hand, For Section 95, a person who committed a falsely representing trademark offences shall only be criminal liable to fine not exceeding level 3 of the standard scale⁶¹² which is currently not exceeding 5000 British Pound under the UK Criminal Justice Act 1982.⁶¹³ However, the criminal provisions are rarely relied upon, or against, legitimately trading businesses in practical.⁶¹⁴ It should be noted that unregistered trademarks shall be protected by the law of passing off in civil case.⁶¹⁵ However, the criminal law is still absent on the protection of unregistered trademark.

3.3.2.6 Examples of Registered Motion and Multimedia Marks

In January 2019, criteria on trademark registration was essentially changed in various aspects. The Japanese gigantic electronic company “Toshiba” becomes the first brand which can register a motion mark under the new trademark system in UK.⁶¹⁶ For such reason, Toshiba motion mark has become the first to have its distinctive multimedia ‘motion’ mark registered under changes to UK trade mark law.⁶¹⁷



Figure 19 Toshiba motion mark.

⁶¹¹ UK Trade Mark Act 1994, s 92 (6)

⁶¹² *ibid*, s 95 (3)

⁶¹³ UK Trade Mark Act 1994 (n 611)

⁶¹⁴ Peter Houlihan, ‘The Trademarks Law Review: United Kingdom’ in Jonathan Clegg (eds), *The Trademarks Law Review* (4th edn, 2021) <<https://thelawreviews.co.uk/title/the-trademarks-law-review/united-kingdom>> accessed 28 February 2021

⁶¹⁵ *ibid*

⁶¹⁶ UKIPO Reg. No. 3375593

⁶¹⁷ Intellectual Property Office, ‘First UK multimedia motion mark revealed by IPO on British IP Day (Press release: 5 August 2019)’ <<https://www.gov.uk/government/news/first-uk-multimedia-motion-mark-revealed-by-ipo-on-british-ip-day>> accessed 30 January 2021

Following the registration of ‘Toshiba’ motion mark, branches of trademark owned by the real estate developer St. Modwen Properties PLC were also registered as a motion mark with the UKIPO in the same year.⁶¹⁸ These marks were the longer and more sophisticated motion marks than the Toshiba mark. The mark starts from a blue-linear swan logo sitting above the word “St. Modwen” slowly disappeared into the scene full of various types of construction drawn on the light-blue background.



Figure 20 ST. MODWEN motion mark.

Prior to this, there were a few cases of motion marks registered with the UKIPO. The mark owned by Bradford & Bingley Plc, for example, was registered in 1998, this mark was categorized as other types of mark on the record of the UKIPO. In detail, the mark representation describes the characteristics of such mark as comprising of two characters which appeared gradually raising and replacing their hats.⁶¹⁹ It should be noted that such mark was represented in the form of the eight-frames sequences. Although the UKIPO does not specify the type of such mark, this mark can be considered as a motion mark from the mark description.⁶²⁰

3.4 Conclusion

As studied, in both international level of the Paris Convention and the TRIPS Agreement, regional level of European Union, and foreign national level of the US and

⁶¹⁸ UKIPO Reg. No. 3395854; 3395859; 3395864

⁶¹⁹ UKIPO Reg. No. 2130164

⁶²⁰ IP & Business, ‘Beyond Tradition: New Ways of Making a Mark’ (2004) 4 WIPO Magazine 16, 18.

UK trademark law, all the trademark regime mentioned under the study used the exhaustive definition of trademark instead of the strict definition and provided criteria for trademark registrability on the grounds of trademark concept such as distinctiveness, functionality, contrary to public policy, and likelihood of confusion instead of specifically providing the characteristic requirement to fulfill for securing protection and specific prohibition on the ground of each type of marks. In the absence of the minimum international requirements for what can constitute a trademark, the comprehensive definition of the term “trademark” is likely to be commonly used for imposing the boundary of trademark protection by all levels of international, regional, and national. Under international minimum standard, both the Paris Convention and the TRIPS Agreement provides a broad registrable subject matter on the basis of trademark criteria, unlike Thai law which impose trademark criteria on basis of the sign, as such other jurisdictions considered the possibility of an unexpected form of trademark where one trademark can consist of various type of signs. This international recognition was adopted into trademark protection of EU, US, and UK that choose to state trademark criteria on the basis of sign. For the concern on an overlapping of copyright and trademark, although this issue does not arise in an international consideration, the regional protection of EU and the national protection of US and UK allow the parallel protection of trademark and copyright as long as the creative manner can fulfill all requirements of each field. As for the criminal protection of trademark, the TRIPS Agreement addressed that the WTO member must provide criminal procedures and penalties for willful trademark counterfeiting, even though it does not specify that the protection must be only for a registered trademark, all the regime which are subject of the study chosen to protect only a registered trademark due to a legal security of such trademark. While for the concern of practical filing, EU and UK shared the Seickmann seven criteria in accordance with the recital 10 of the EUTMR and the EUTMIR to admit any appropriation form of representation, while the US law has provided that trademark sought to be registered must be represented only by the drawing and description. There is a concern in the relationship between EU and UK, although most of trademark criteria of the UK are influenced by the minimum

protection of EU trademark law, in June 2016, however, due to the referendum of the UK to leave the European Union, which is also known as the “Brexit”, like other legal communities, it creates uncertain legal status and protection for the UK jurisdiction. As a result, the territorial scope of EU trade mark upon the UK is likely to be reduced,⁶²¹ this creates many legal implications in dealing with the registering EU trademark arisen following the UK Brexit where pending applications will be treated differently.



⁶²¹ Bomhard, Muhlendahl (eds), (n 441)

CHAPTER 4

CRITICAL ANALYSIS OF THE PROBLEMS OF MOTION AND MULTIMEDIA MARKS PROTECTION UNDER THAI LAW

4.1 Introduction

The purpose of this part is to analyze and criticize the problems of motion and multimedia marks protection in Thailand regarding the nature and features of the said mark as well as the suitability of such mark in being used as a trademark, and the legal uncertainties of the Thai statutory provisions in terms of the concept, definition, and allied criteria in comparison to the international rules and foreign laws. Moreover, this part will emphasize the economic impact of motion and multimedia marks protection in Thailand in both negative and positive aspects in order to provide reasonable proposals to resolve and fulfill any legal uncertainties and loopholes under Thai trademark law.

4.2 Analysis of The Problems of Motion and Multimedia Marks Protection under Thai Law

The review of problems of motion and multimedia marks protection under Thai law can be explained on these following bases:

4.2.1 Definition of “Mark”

In consideration of the definition of trademark under Thai trademark law, the law does not only provide a legal framework in defining what can constitute a trademark, but it also limited the scope of protection only to the marks which are listed under the law.

To analyze whether motion and multimedia marks are suitable to be included into the definition of the term “mark” under Thai trademark law, several following aspects should be considered, first the capacity of the said marks to serve

as trademark, second the criteria of trademark in an international level, third the potentiality of creating and accessing of the motion and multimedia marks for traders and consumers, and fourth the economic impacts of motion and multimedia marks.

4.2.1.1 Capacity of Motion and Multimedia Signs to Serve as Trademark

In regard to the question whether the motion and multimedia signs can serve as a trademark, the consideration should be given on two different aspects which are the nature and feature of the signs, and the suitability to be a trademark.

(1) Nature and Feature of Motion and Multimedia Signs

In the nature and feature of motion and multimedia signs, Jerome Gilson, an American well-known trademark lawyer and the original author of the multivolume trademark law books, has given his opinion on the nature and feature of motion and multimedia marks by stating that “Motion marks are typically the closest to traditional logo marks of all the nontraditional trademarks; they just add the dimension of movement.” This opinion shows that motion and multimedia signs is simply an increasing complex format of still logos protected as trademark such as still images, invented devices, or figures, the public perception for these type of marks are the closest to the public perception of tradition marks. Thus, as long as it is capable of indicating the source and distinguishing one product from other identical or similar products, such marks will be able to be used as a trademark. Moreover, motion and multimedia signs interact with everyday life of consumers as a communication medium, psychological perception, physical movement, and others. The perception for motion and multimedia sign by consumers are, consequently, no difference from any other visible signs. Furthermore, motion and multimedia signs can reach the mind of consumer no less than the recognition created through the use of other marks. In particular, comparing motion and multimedia signs with non-visible signs such as sound, taste, and smell, motion and multimedia signs are more likely to capture consumer attraction between the sign and product that the sign is applied for than

the non-visible signs. Thus, there is no reason to avoid protection of motion and multimedia signs in the sense of its nature per se.

(2) Suitability of Motion and Multimedia Signs Protection as Trademark

In the suitability of protection for motion and multimedia sign as trademark, Lesley Matty, a legal counsel of a well-known company in the US has listed many disadvantages of motion and multimedia sign protection such as higher price in developing and promoting the mark charged and spent by the investor for making a stronger brand, unclear guideline as to the actual protection of the said marks, the failure of indicating specific movement in its description, and the insufficient available representation formats. However, these legal opinions can be opposed by many reasons.

For the increasing cost arguments, it is clear that the higher price of creating the brand logo or advertisement will be a burden that any business operators have to pay in strengthen their brand. Due to the main purpose of maximizing profits deriving from its business and investment, the increasing of costs is not an unexpected cost that the investors and traders have to face with. So long as it does not lead to unfair competition, even if the money spent cannot guarantee the outcome of the investment, this is a necessary price that the investors and traders must and are willing to pay.

For the unclear guideline as to the actual protection of the said marks, although one major concern that should be taken into account is the concrete possibility of legal application and enforcement in giving the protection for such marks, the absence of a clear guideline should not become an indication that such marks do not serve or should not be protected as trademark. Giving the sufficient protection to the trademark owner does not only provide protection for trademark holder from trademark infringement, but also create the full protection of economic exclusive right of the trademark owner in using, utilizing, and advertising the mark and also products or services associated with such marks. The omission in providing enough protection for the motion and multimedia signs would become a barrier in the complete exercise of an owner's exclusive right and would fissure the protection shield to the trademark

owner in exercising their economic rights. To weight the increasing price of creating motion and multimedia signs as trademark against any legal risks which may come up with the deficiency of protection, in the author's view, the price of these legal risks will become more expensive than the price of creating motion and multimedia marks. Thus, the price of creation of marks and their legal risks should be weighted in favor of providing appropriate protection for trademark owners for all types of signs including motion and multimedia signs.

For the argument concerning description and representation, this argument deals with the practical problems on the protection of motion and multimedia signs, the analyzation and critics will be given in the part of practical problems.

4.2.1.2 Scope of Trademark in the International Level

To consider international rules concerning substantive minimum protection for trademark, the consideration of problems of motion and multimedia marks protection should be given on the Paris Convention and the TRIPS Agreement which is the substantive international rules for trademark. Under the Paris Convention, even if Article 6 allows the contracting countries to determine the precondition for filing and registration of trademark under their own jurisdiction, the TRIPS Agreement will be applied to limit the discretionary power of Paris Convention member states by providing that any WTO member shall be bound to determine the prerequisite for filling and registration of trademark no less than the minimum standard protection as provided by the TRIPS Agreement. According to Article 15.1 of the TRIPS Agreement, the last sentence of the first paragraph permits WTO members to require a visual perception of a sign as a perquisite for trademark registration. For this latter, the author understands that this provision is intended to provide a clear guideline for WTO member to determine the minimum protection for certain signs instead of protecting all signs. The signs which can become a basic framework of protection is a sign which is visually perceptible, it should therefore be considered that the TRIPS Agreement aims to protect visible sign as the minimum standard of protection that any WTO

member, including Thailand, is bound to provide protection for. For that reason, even though the WTO members choose to protect some particular signs, and neglect to protect others visible sign, such choice will not automatically be considered as infringing an obligation under the TRIPS Agreement because it is their discretionary power to impose registration precondition, the absence of some visible signs, particularly motion and multimedia signs, which can be commonly perceptible by the public in a similar level as traditional visible sign, may be considered that the existing measures for trademark protection under Thai law, while not infringing the TRIPS Agreement, is inconsistency with the purpose of such agreement.

4.2.1.3 Potentiality of Creating and Accessibility of the Motion and Multimedia Signs of Traders and Consumers

In developing countries, even if the expensive cost are associated with the protection of these marks, and the accessibility of these marks for consumer through a high sophisticated technology platform are the major concerns for traders, consumers and the competent office, the motion and multimedia signs are developed through a combination of fundamental production of still image or picture and available technology. This simple combination which created motion and multimedia marks can, therefore, be produced by any persons.

Conceptually, to utilize motion and multimedia sign as a trademark can simply be acquired if such motion and multimedia signs are also used in the course of trade. Such utilization of the sign as a trademark does not require that the mark must be original work like in copyright or must include an inventive step like in patent. However, this concept has not been sufficiently provided for in Thailand. Therefore, the law should provide additional approach for traders in securing their economic rights. Moreover, the protection of non-traditional motion and multimedia signs are not an instrument that generate economic disparity between the wealthy and working class person and does not lead one business operator or one business sector into a dominant position which may cause unfair trade competition. This is because the mediums of motion and multimedia signs can be universally accessed through various

neutral digital platforms. This, therefore, means that any person can be in contact with the medium used in accessing the motion and multimedia signs, even though the quality of such signs may be different through each medium.

4.2.1.4 Economic impacts

Nowadays, motion and multimedia signs play an important role in allowing consumers to become more relate to a brand in which the products or services are applied to. The branding companies are increasingly using motion and multimedia advertisement in digital platform and social medias, thus, nowadays it has become a famous way of communication between branding companies and consumers. According to this paper, the United State and European Union as big players in global trade widely provides a tangible protection for motion and multimedia used as a trademark, while Thailand who is also an important player in South-East Asia is still silent in protecting the said sign. In doing so, the refusal to provide protection for motion and multimedia marks will not only create a barrier for domestic investors that desires to conduct their business and communicate with consumers through cutting-edge technology, but it also indirectly discourages foreign investors who uses animated marks in their business or having marketing strategies to use such marks. This is because the protection provided for both Thai and foreign investor's reputation and good will associated with their motion and multimedia marks are insufficient and inappropriate. For example, a motion or multimedia mark that is registered to cover broad scope of protection in a foreign country may only enjoy a protection as a still image mark. Another example is where a well-known motion or multimedia mark will only be able to claim their widely used mark as a separate still image mark and sound mark, even though such mark is composed of both motions and sounds.

4.2.1.5 Statutory Definition under Thai Trademark Law

Referring to this paper, the scope of trademark protection under international, regional, and foreign trademark law shared the same definition of

exhaustive scope of trademark protection by providing a comprehensive definition for marks which can constitute a trademark. The TRIPS Agreement, for example, uses the comprehensive definition to define the eligible subject matter for trademark as “Any sign, or any combination of signs, ... , shall be capable of constituting a trademark,” even if the agreement listed out series of example of signs stating that “Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks,” it is only considered as an example of signs and this term is subjected to the concept of comprehensive protection underlying the first sentence that any signs and combinations of signs can constitute a trademark. Moreover, the EUTMR also uses the comprehensive definition for the term “trade mark” stating that “EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds,” even if this definition provides a list of signs, it is only subjected to the word “EU trade mark may consist of any signs” which provides a similar effect to the TRIPS Agreement. Furthermore, the US Lanham Act defines the term “trademark” as “includes any word, name, symbol, or device, or any combination thereof—.” In this respect, the term “includes” under the definition of the term “trademark” shows that the US Lanham Act also does not limit or impose any particular scope of trademark as it merely indicates the composition of trademark instead of exclusively defining what can constitute a trademark and each given element uses a broad term such as symbol, or device which can construe in various ways. In addition, the UK Trade Mark Act 1994 defines the term “trade mark” by beginning with the phrase “means any sign...,” which can be seen that, regardless of the chosen word “means,” the law meant any types of sign which can fall under the word “sign” which means any sign can constitute a trademark. The author understands that the common way of using comprehensive definition of the term “trademark” instead of strict definition can widen the scope of trademark protection to any unexpected or more complex signs which is too sophisticated to single a legal definition. On the other hand, the Thai Trademark Act B.E. 2534 (1991) choose to define the term “mark” separately from the

term “trademark” by applying the term mark as a scope of what can constitute a trademark under Thai law. In a view the definition the term “mark,” Thai trademark law uses the strict definition to define the term “mark” stating that it “means a photograph, drawing, device, brand, name, word, letter, manual, signature, combinations of colors, shape or configuration of an object or any one or combination thereof.” Unlike the UK’s definition of “trade mark”, even if it shares the use of the word “means” in defining the scope of trademark, the UK law allow any signs to constitute a trademark, whereas the Thai law only allow specific signs as listed to constitute a trademark. In historical aspects, although Thai trademark law is significantly influenced by the UK trademark law, the use of strict definition in Thai law derived from the former UK trademark Act 1938, the law which was effective at the time the Thai Trademark Act 1991 became effective. However, the said UK trademark law was repealed since 1994, three years after the Thai law is enacted. After which, it has been almost 30 years in which the old strict way of defining the term under Thai trademark law has not been changes and even though the said definition was amended many times, only the particular sign will be added each time without broadening the scope of trademark protection to any signs. For that unresolved issue, it does not only make the way of defining out of dated but it also leads to major revision such as legal definition, distinctive characters, and prohibited characters under every amendment due to the inappropriate existing provisions. For this concern, even though arguments may be raised that national policy of Thailand, as a developing country, is considered to protect agricultural and SME industrial sectors by averting to provide exclusive economic rights to the one or specific group of private sectors which may lead to trade monopoly for certain types of mark such as smell marks or taste mark. Such concern should not obstruct the Thai government from providing trademark protection for any signs, as a simple solution to this is to provide an exclusive protective measure for such agricultural and SME industrial sectors by imposing an legal exclusion for such mark from the scope application of an amended law.

Apart from the appropriation of the legal definition under Thai trademark law, another big concern for the definition of the term “mark” is an unclear guideline

on the application of the phrase “combination thereof”. Due to the nature of motion and multimedia signs, they can be represented in various format such as videos, short films, gestures, product movements, and moving images. If an owner of motion and multimedia marks desires to seek a protection for such mark as a moving image consisting of several still sequential images or consisting of numerous sequential images and sound, the question on how the protection of an existing Thai law applies may arise. There are currently no clear rules, guidelines, Supreme Court Judgement, or legal commentary which envisages this issue. To answer this unresolved question, the author understands that the application of such term should be compared with the legal application under the US law. The term “any combination thereof” is also provided by the definition of the term “trademark” under the US Lanham Act, the US law accepts the registration of motion and multimedia marks as the ultimate mixture of signs in various forms, including but not limited to a moving image or an animation, even though motion and multimedia signs are not specifically mentioned under such law. Nevertheless, it cannot be found that Thai law permits the registration of moving images or multimedia sign using combination of sequential still images or the combination of images and sounds in the Thai Department of Intellectual property (DIP) by the registrar, the Trademark Board or the court. This is because the conceptual protection of Thai trademark is based on the still or immovable marks and there are no applicable legal criteria or available practical representation format provided for motion and multimedia marks.

4.2.2 Criteria of Trademark Registrability

Aside from the consideration on the definition of the term “mark”, the mark shall be registrable as a trademark when it fulfills other subject-matter requirements in addition to falling within the scope of the term “mark”. Legal problems regarding trademark registrable criteria can be explained and discussed on both the requirement of distinctiveness and the prohibit character for unregistrable trademark.

For distinctive requirement, in the conceptual basis of the studied trademark regimes, there is no requirement under international rules and jurisdiction whether EU trademark, US trademark, and UK trademark requiring that a mark must contain specific characteristic to be considered as an inherently distinctive trademark. Instead, all the studied jurisdictions shared the same concept of providing distinctive requirement as an absolute ground for refusal and only comprehensively imposed that the mark shall not be registrable if it is devoid of any distinctive characters. The author understands that any signs which can constitute a trademark within each jurisdiction shall be generally presumed as being inherently distinctive unless it falls within the exception for refusal. This basis came with the presumption that any signs having distinguishable capacity can express their own distinctive character in various senses, therefore there is no need to characterize what each sign must show in order to be considered as distinctive. This is because, regardless of such character, during an application process an applicant will have to eventually display an actual inherent distinctiveness of the trademark to secure distinctive character. For motion and multimedia marks, in determining whether such marks have an inherent distinctiveness, the same consideration criteria as other signs will be applied. If motion and multimedia marks fail to show their distinctive character, they shall not be registered as trademark. In *The Ride* US case⁶²², for example, the motion mark of a dancing businessman which is sought to be registered fails to display a distinctive character as it can be perceived as part of services rather than a mark designating the source of the services. In Thai law, the law not only describes the statutory character of distinctive trademark, but also specifies characteristics of a deemed distinctiveness of each mark which is too narrow and is inconsistent with the diversified distinguishing capacity of a single sign and combination of signs. In order to increase and equally harmonize the possibility of trademark distinctiveness of each mark, the law should provide the distinctive requirement in the broadest sense, and the specific characteristic of each mark in performing its distinctive character should only be a framework for controlling the

⁶²² In re *The Ride*, LLC, 2020 WL 564792 (T.T.A.B. 2020)

discretionary power of the competent authorities in applying the law, which can be adequately provided in a subordinate legislation. Such character should not be a precondition of distinctive requirement for registration.

For prohibitory character, grounds for refusing the registration in both international, regional, and domestic law are similar to that of Thai law. It mainly depends on the specific prohibition such as unauthorized emblem, flags, or badge of government official, foreign states, or international organization, and prohibition for the mark contrary to public policy or morality. Nonetheless, the likelihood of confusion or confusingly similar concept relatively considered the prior protected trademark is also applied as one of refusal ground. Furthermore, movement is not a prohibitory character of trademark in all such jurisdictions. Thus, the protection of motion and multimedia marks does not create any legal inconsistency in the Thai law regime.

4.2.3 Practical Administrative Proceeding of Trademark Registration

For practical aspect, there are two aspects to be concerned which are the submission of a file and the representation. In the past, even though there are concerns of additional cost for developing countries charged from the representation and description of non-traditional trademark raised by the Sixteenth Session of the Standing Committee on the Laws of Trademarks, Industrial Design and Geographical Indications⁶²³, this concern cannot bar the diversified trends of signs based on five human senses made by available technologies used to satisfy human demands. Not on that, but more accessible technologies are to the public and the competent office the more enabling the relevant sectors are to make their acquaintance to tackle the current situation. In the level of international instruments and regional law, the step-forward of Singapore Treaty on the Law of Trademarks for trademark registration procedure which provides that any signs can be represented in an appropriate form depending on the available technology instead of only allowing for the use of graphic

⁶²³ WIPO, New Types of Marks, WIPO Doc. SCT/16/2, para 72 (2006)

representation and the abolition of the requirement of graphic representation from the EUTMR and EUTMIR are good examples of the adaptation.

In the case of Thailand, even if the current application submission process is adopted to be more flexible for the available technology, the application form will be submitted, in practical, to the DIP commonly by a paper form and even if the applicant can currently file a trademark application using Electronic methods (E-filing) instead of filing in person, the E-filing system requires merely picture or image showing all points of view of an applying trademark and is still silence on the submission of videos, moving or even series of images, which is not practical for the motion and multimedia marks holder. To compare this with the representation form and acceptable file format under other legal jurisdictions, it can be seen that the EU, US, and UK measures for trademark representation are more flexible and suitable for non-traditional trademark, particularly motion and multimedia marks than the current measures available in Thailand. Hence, the practical procedure is also one of the major concerns that should be concretely reviewed and revised.

4.2.4 Overlapping Protection between Trademark and Copyright

Due to the nature of registered signs or marks, which is originally made by creators associated with business owners, it can be received intellectual property protections from both copyright and trademark. From the international views, apart from the sufficient measure of trademark protection as provided in Paris Convention, protectable subject matter as provided in the TRIPS Agreement, and the appropriate representation of trademark sought to be registered in the Trademark Law Treaty and Singapore Treaty on the law of Trademark, the concept of copyright and trademark overlapping protection remains silenced in the context of international laws. The author understands that international laws aim only to widen the scope of substantive protection and harmonize the applicable rules to all member countries. The silence on the reference of an overlapping protection in the international laws does not mean that the international laws deny the possibility of an overlapping protection. Thereby,

so long as the requirements for the indicating and distinguishing functions of trademark and the expression of original idea of copyright are met, a parallel protection between these intellectual property rights should be available. For overlapping intellectual property protection in Thailand, even if legal concept of overlapping intellectual property protection is still unsettled, this concept has been referred to by the Supreme Court Judgement that the intellectual protection between as a trademark under the Trademark Act and as a copyright under the Copyright Act depends on the difference conceptual purpose, copyright aims to protect an original work created by skill, labour, and judgement of the creator in expressing his idea, whereas trademark is intended to protect a mark used with goods or services in the course of trade. With this respect, if a work can be proven to be intended for the use in commerce to distinguish goods or services one from others, it shall not be considered as an Applied Art which is one of the protected categories of copyright. It can be seen that even if the Court does not lay down the acceptance of overlapping intellectual property in Thailand and does not said that such work can be registered or protected as a trademark or not, the Judgement implies that if any Artistic works, which is naturally protected under copyright law by aesthetic purpose, were used in commercial purpose for distinguishing goods or services, such work shall not be able to acquire copyright protection as an Artistic work and it can be further implied that the protection of work such does not depend on the nature of work, but rather on the intended use for such work.

Although the motion and multimedia marks have not yet been protected as a trademark, it can be considered as an Artistic work under copyright law. If motion and multimedia marks will be added into the definition of the term “mark” under the Thai trademark law which causes them to be capable of acquiring trademark protection and where such marks have also been used for commercial purposes with goods or services as a trademark, such mark can possibly receive dual protection under both trademark and copyright laws.

4.2.5 Criminal Protection of Trademark

Owing to the legal uncertainty of the criminal offences in Thailand in concern with trademark, it creates inconsistency for legal enforcement in many circumstances. If motion and multimedia marks that are registered abroad, for example, was counterfeited or imitated in Thailand, the motion and multimedia mark shall be criminally protected in Thailand under Thai Penal Code if the provisions of which are not deemed to be repealed by the Thai Trademark Act. On the other hand, if such provisions were repealed, such mark that is not a registered trademark in Thailand will not be protected under the Thai Trademark Act. This legal inconsistency exists not only between the registered trademark in Thailand and the unregistered trademark in Thailand which registered abroad, but it also exists in the unregistered trademarks neither in Thailand or abroad because the unregistered trademarks shall be protected under Thai Penal Code only for names, figures, artificial marks or image marks and phases, the protection does not extend to other signs including motion and multimedia signs. For these reasons, it shows legal uncertainties in the application of Thai Criminal law relating to trademark. However, it can be found from many studied jurisdictions that criminal protection is only provided for registered trademark even if the US protection for trademark is based on use. Even though criminal protection for other jurisdictions are provided only for a registered trademark, the application of their laws is clear and consistence. Unlike Thailand, where the criminal protection of a trademark is only provided for certain types of marks. Consequently, this criminal provision should be reviewed and revised along with other provisions under the Thai Trademark Act.

4.3 Recommendation for Problems of Motion and Multimedia Marks Protection under Thai Law

In order to provide adequate and appropriate protection for motion and multimedia marks, the author propose four recommendations to increase the standard of trademark protection and harmonize such standard with international standards to

encourage the businesses and foreign investors confident in making an investment in Thailand. Such recommendations are as follows:

(1) Amending the definition of the term “mark” for which can constitute a trademark under Thai law. Since an existing definition is too strict and too narrow to comprehend varieties of signs which is discouraging for investors whose trademarks are adapted to a more advance technology. Accordingly, the definition of the term ‘mark’ under Section 4 of the Thai Trademark Act should be amended to use a comprehensive definition to cover any diverse and unexpected signs which may be available in the future. Such comprehensive definition can be provided by adopting the use of the word “includes” as available under other studies jurisdictions instead of the word “means” to broaden the scope of trademark which are protectable under Thai law. To illustrate, the Section 4 of the Thai Trademark Act should be revised to:

“mark” includes a photograph, drawing, invented device, logo, name, word, phrase, letter, numeral, signature, combinations of colors, figurative element, sound, motion and multimedia, or combination thereof, unless unprotected marks as prescribed by the Ministerial Notification”

In addition to the given example, the comprehensive definition can share positive and broad definition that do not specify a particular characteristic of mark but instead provides broad list of what can constitute a mark in a similar manner as the UK and EU definition of trademark. As the Thai law defined the term “mark” separately from the term “trademark,” the definition of which would be more suitable and flexible if the definition of the term “mark” is removed and the word “any marks” is inserted in place of the word “a mark” in the definition of the term “trademark.” To illustrate, the Section 4 of the Thai Trademark Act should be revised to:

“mark” (repealed);

“trademark” means any marks unless unprotected marks as prescribed by the Ministerial Notification, that used or proposed to use on or in connection with goods, capable of distinguishing the goods or services of one source from other sources and being represented in the clear and precise manner to the competent office.”

It should be noted that this recommendation may cause concerns in relation to the public policy to protect agricultural and SME industrial sector by depriving the protection for certain marks such as olfactory mark, or taste mark. In resolving such concern, such marks should be excluded from the application of the law in order to not hinder the economic and technological expansion. Moreover, if the scope of trademark protection is amended pursuant to this recommendation, the criminal protection of any signs including motion and multimedia sign will sufficiently be protected under the existing *sui generis* law.

(2) Amending other relevant provisions of registrable requirements for trademark registration, particularly, the distinctive characters under Section 7 and the prohibit characters under Section 8 of the Trademark Act by repealing particular characteristics of the deemed inherent distinctive trademark under the second paragraph and adding such deemed inherent distinctive character on to the prohibited characters as a ground for refusal as the EU, US, and UK uses in providing the eligible subject matter instead. For example, Section 7 paragraph one should read “a distinctive trademark is a trademark which enables the public or users to distinguish the goods with which trademark used from other goods”; paragraph two “(repealed)”; and paragraph three should read “A trademark having no characteristics under paragraph one if used on goods which have been widely sold or advertised in accordance with the rules prescribed in a notification by the Minister and if it is proved that the rules have been duly met, shall be deemed distinctive;” and Section 8 Trademarks having or consisting of any of the following characteristics shall not be registrable:-

(12) geographical indications protected under the law on geographical indications and geographical name as prescribed by the minister;

(13) trademark that devoid any distinctive character under Section 7;

(14) trademark that having or consisting of no direct references to the characteristics or qualities of products;

(15) trademark consist of the shape or another characteristic which results from the nature of the goods themselves, the shape or characteristic of goods which is necessary to obtain a technical result and the shape, or characteristic which gives substantial value to the goods;

(16) trademark consisting of the mark used without authorization; and

(17) other trademarks prescribed by the Ministerial Notifications.

This recommendation carefully taken into account the criteria for obtaining distinctiveness such as invented and stylized. However, the author sees that such criteria are merely a guideline which a mark sought to be registered shall bear burden to prove and should not be listed as a prerequisite for registration. Accordingly, if trademark sought to be registered fail to prove that such mark contain at least one of the criteria for distinction, then it may fall under the devoid distinctiveness under (13) or consisting of no direct references to the characteristics or qualities of products.

(3) Changing the form of representation (so-called supporting requirement) of the application for trademark registration as the current application form both the filing of paper and via E-filing system cannot represent an appropriate form of motion and multimedia marks which consisted of moving pictures or images. The current paper filing forces an applicant to only file a certain image without filing series of images, while for e-filing system an applicant can only submit a certain picture in all point of view but cannot submit series of images or video file which can further represent the functions of such marks. Hence, the author proposes that subsidiary law for trademark procedures should be amended to resolve these problems and provide an appropriate measures for supporting the filing or submitting of series of images or video file as a representation for motion and multimedia marks along with audio files which is already acceptable under Thai law as a representation of sound mark.

4.4 Conclusion

Current provisions of the Thai trademark law cannot and have not dealt with the advancement of digital technologies. Such provisions should be reviewed and

revised in order to raise the standard to meet with the minimum standard provided under international law. Not only that, but the standard should also be adapted to the current and future trends for motion and multimedia marks in a digital protects or services. Recommendation given by the author are to amend the scope of definition to widen the protection scope of trademark law, amend the relevant criteria and practical guidelines according to the focused legal amendment and the international trends to facilitate the business sectors and encourage investors to conduct their business in Thailand.



CHAPTER 5

CONCLUSION

Disruptive digitalization affects every step in the daily life of human being. It plays a significant role of marketing tools in current economics and business situation, it provides more variety channels for advertising and communicating of products or services to consumers among the increasing availability of digital medias. Furthermore, consumers are also more likely to receive marketing information and make electronic purchase transactions as the use of digital medias and technological devices grow. For that reason, digital media is therefore an important medium for businesses to immediately satisfy the diverse demand of consumers. In addition, trademarks, as an image of branding, does not only appear on the physical products, packaging and containers as they were in the past, but are also appears on electronic platforms in conforming to various form of products in the current marketplace which can be represented sophisticatedly by movement on digital platforms. Accordingly, motion and multimedia signs deserve to be enabled in constituting the modern trademark for the diversified representations in the modern society.

Based on the research of the international, regional, and national intellectual property law system, motion and multimedia marks are protected using the same standard as other signs either traditional or non-traditional. In providing such protection, traders and investors will be more likely to pour their investments into the country and will be encouraged to create a powerful medium to communicate with consumer and strengthening their brands in accordance with technological disruptive in economic and social growth.

However, under the current provisions of the Thai Trademark Act, motion and multimedia marks have not been capable of constituting a trademark. In addition, adequate protection has not been provided for such marks under Thai law. To resolve and fulfill the said legal loopholes, the author proposes to amend the scope of trademark protection under Thai trademark law by expanding the definition of such scope to be applied equally among all signs including motion and multimedia signs,

amend the other available requirements for a registrable trademark under Thai law to be in accordance with the amended scope of trademark protection, and change the form of representation to be more flexible and practical for the submission of motion and multimedia marks such as video files or audio-visual files instead of the sequential images on paper or still images form. This legal amendment will not only uplift the standard for the protection of trademark under Thai law to be in accordance with the international, regional, and national standard of United State and United Kingdom and coping with dynamic situation among digitalization, but it will also ensure the full confident of traders and investors in conducting their business in Thailand which will then in returns help encourage the full potential of trade competition.



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EUTM No. 17 411 315
EUTM No. 17 451 816
EUTM No. 17 635 293
EUTM No. 17 894 400
EUTM No. 17 894 840
EUTM No. 17 911 214

US

USPTO Reg. No. 48920
USPTO Reg. No. 55574
USPTO Reg. No. 0641872
USPTO Reg. No. 0874861
USPTO Reg. No. 1946170
USPTO Reg. No. 1975999
USPTO Reg. No. 2623913
USPTO Reg. No. 2709214
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USPTO Reg. No. 4871024

UK

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