

## New Fast Track System for Trademark Registration and Trademark Renewal in Thailand

### 'First Action Fast Track'

On 5 April 2021, the Department of Intellectual Property (DIP), Thailand announced a "First Action Fast Track" for expediting the prosecution of trade mark applications wherein the Trademark Registrar can be expected to issue the first office action **within 6 months from the date of filing a trademark application**. This Fast Track is automatically applied to the trademark application at no additional costs if the trademark application satisfies the following criteria;

1. the total number of the applied goods or services must not exceed 10 items;
2. the list of goods or services shall be as listed in the List of goods and services on the DIP's website (<https://tmsearch.ipthailand.go.th/>); and
3. any amendments, recordal of assignment or request for submitting additional evidence to prove acquired distinctiveness through use, according to Section 7 Paragraph 3, shall not be made to the trademark application.

Prior to the "First Action Fast Track" scheme, the first office action will be typically issued within 8 to 12 months and if the Registrar does not raise any objections against an application, the trademark application will be published in the Trademark Gazette for opposition. In the case where there is no opposition filed during the publication period, the Registrar shall order the registration of the trademark upon payment of official registration fees. This process can take between 16 to 18 months in a straightforward case.

With the '*First Action Fast Track*' the applicant may have the application published within 8 months and the trademark may be registered within 12-14 months in a straightforward case.

### 'Trademark Renewal Fast Track'

The DIP also announced a '*Trademark Renewal Fast Track*' for expediting trade mark renewal applications wherein the Trademark Registrar can approve the renewal of the trademark **within 60 minutes** at no additional costs. This Fast Track shall be applied if the following criteria are fulfilled;

1. the total number of the goods or services under the trademark must not exceed 30 items;
2. no amendment made to the particulars of registration, for example, recordal of change of name or address, etc.;
3. the renewal application must be physically submitted to the Trademark Registrar at the DIP by the trademark owner or an authorized agent (the online system is not available);
4. the trademark owner or the authorized agent simply notifies the Trademark Registrar on the intention to use the '*Trademark Renewal Fast Track*'; and
5. the official renewal fees are fully paid to the DIP.

The duration of trademark registration in Thailand is 10 years from the registration date and can be renewed for a further period of 10 years each. In practice, the registrar would take about 4-6 months considering a renewal application. With the '*Trademark Renewal Fast Track*', the applicant can receive the Certificate of Renewal within an hour.

### Updating lists of goods and services on the DIP's website

The DIP has updated the list of goods and services on the DIP's online guide by including some of the items of goods and services from Nice Classification. These items have been considered not too broad/vague to be registered according to Thai Trademark Laws.

The word 'NCL' which stands for 'Nice Classification' will appear under the class number together with the English translation to show that these items are aligned with the Nice Classification.

รายการสินค้าและบริการที่ยื่นขอจดทะเบียนเครื่องหมายการค้าในประเทศไทย List of goods and services for the purpose of filing a trademark application in Thailand			
คำค้นหา เช่น น้ำมัน			
3 พฤษภาคม 2564			
รายการ (Item)	รายการภาษาอังกฤษ (English item)	จำพวก (Classification)	
กรดทาร์ทาริก	tartaric acid	1	NCL
กรดที่มีส่วนผสมของกำมะถัน	sulfurous acid	1	NCL
กรดที่มีส่วนผสมของเบนซีน	benzene-based acids	1	NCL
กรดเทรฟาลิก		1	
กรดแทนนิก	tannic acid	1	NCL
กรดน้ำส้มใช้ในอุตสาหกรรม		1	

Although Thailand has adopted the Nice Classification since 2013, the Thai registrar has not strictly followed the Nice Classification because Thailand has its own practice and guideline for describing goods and/or services as a result of Section 9 of the Trademark Act, providing that an application for registration of a trademark must specify a particular kind of goods and services for which protection is sought. With this update, the number of office actions concerning a description of goods and services may be reduced for national Thai trademark applications. In addition, it would assist in minimising objections for entities which designate Thailand under the Madrid Protocol.