



LEGAL PROBLEM ON PATENT PENDING
PROTECTION

BY
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AN INDEPENDENT STUDY SUBMITTED IN PARTIAL
FULFILLMENT OF THE REQUIREMENT FOR
THE DEGREE OF MASTER OF LAWS
(BUSINESS LAWS)

GRADUATE SCHOOL OF LAW
ASSUMPTION UNIVERSITY

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PROTECTION OF MOVING IMAGE MARKS

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Independent Study Title : Protection of Moving Image Marks
Author : Ms. Panita Maneerat
Major : Master of Laws (Business Law)
Advisor : Mr. Sthianrapab Naluang

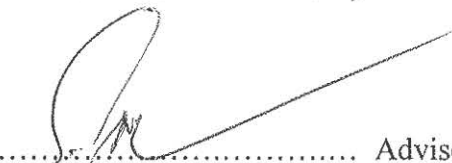
Faculty of Law, Assumption University approves this Independent Study as the partial fulfillment of the requirement for the Degree of Master of Laws.

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ABSTRACT

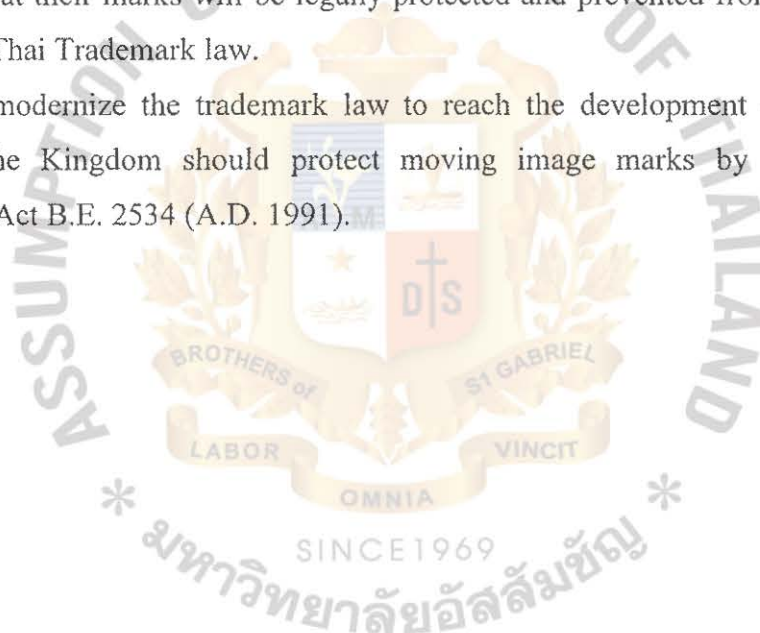
Trademarks are marks which are able to indicate their sources and to distinguish one undertaking's product from another. Generally, marks can be a word, symbol, text, letter, name, number, logo, phrase, slogan, and group of color or any combination of these elements which have a distinctive character. Those marks are called conventional trademarks. However, there are some marks that are not included in the definition of conventional trademarks which are so-called non-conventional trademarks. Non-conventional trademarks are included smell mark, sound mark, scent mark, shape mark, single color, hologram, and moving image mark. At the moment, moving image marks are come to have a role for the trademarks' owners in the market place. Trademarks' owners are usually tricking the consumers for consuming their products. Moving image marks are one popular trick to persuade the consumers' attention. As a result of moving image marks' characteristics that are clearly and accessible to consumers so, they are easily to be recognized in the consumers' mind. Thus, it is necessary to give moving image marks' protection.

Presently, Thailand applies the Trademark Act B.E. 2534 (A.D. 1991) which is amended by Trademark Act B.E. 2543 (A.D. 2000) due to Thailand became member of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) in B.E. 2538 (A.D. 1995). Therefore, Thai obligated to amend the trademark law in line with the TRIPS's standard which sets down the minimum standard for members to comply with its rule.

As researched, after the amendment of the Trademark Act B.E. 2534 (A.D. 1991), nevertheless, moving image marks are not protected under the amended Act yet. Researcher found that there is unclear in the definition of mark under section 4.

Subject to section 4, a 'mark' means a photograph, drawing, ..., or any combination of these items so that there is a problem whether other marks include moving image marks are mark according to the definition of section 4 or not. Besides, there are problems of registration and using moving image marks due to the characteristic of moving image marks that are movable signs. However, in the European Union, United Kingdom, Germany, the United States and Singapore, moving image marks are protected under their legislations. Consequently, Thai trademark law is out of date unlike these countries that accept moving image as trademark under their trademark laws. Hence, giving moving image marks' protection under Thai trademark law is very importance for their owners because moving image marks' owners will be confident that their marks will be legally protected and prevented from unauthorized uses under Thai Trademark law.

To modernize the trademark law to reach the development of the modern business, the Kingdom should protect moving image marks by amending the Trademark Act B.E. 2534 (A.D. 1991).



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Chapter I

Introduction

A. Background and General Statement of the Problems

Trademark is one kind of intellectual property. It is an important advertising tool for sellers and service providers as well as influences consumers' decision regarding their consumption. Consumers usually use products or services that they recognized in their mind. Their decisions rely on trademarks as indication of products or services' quality levels. As a result, trademarks become an indication of products and services' quality. The good products or services will be popular among most consumers and the consumers mostly notice and remember trademarks of their favorite products or services. This behavior will provide them some convenient for future's purchases. As the main function of trademark is to indicate sources of the products or services, it also differentiates particular products or services from others. Consequently, consumers will immediately know sources or owners of that products or services. Thus, in order to establish one business, the owners should carefully consider creating a trademark for their products or services. In today's competitive marketplace, it is more important to distinguish their products from another. Ultimately, trademark is a great way to accomplish this task.

Originally, trademark is a word, name, symbol, or device, or any combination thereof that used by an undertaking on products or services in commerce to distinguish it from products or services of others undertaking. These marks are known as conventional trademarks. As a result of the world's evolution, the use of trademarks in modern society is in a constant state of evolution. As technologies and advertising practices have changed and developed, so the types of marks used by businesses to promote and identify their goods and services have expanded beyond "traditional" trademarks categories. Presently, trademarks can be in the forms of logos, slogans, figurative marks, three-dimension marks, smell marks, sound marks, taste marks, and moving image marks. These marks are known as non-conventional trademarks. The non-conventional trademarks do not belong to pre-existing. Nevertheless, non-

conventional trademarks are widely accepted and protected under the trademark laws of many countries, such as the United State of America, the United Kingdom, Denmark, Switzerland, Finland, and Singapore. Therefore, it is necessary to consider whether the trademarks' protection under Thai law, namely, Trademark Act B.E. 2534 (A.D. 1991), is extended to such non-conventional trademarks or not, especially the moving image marks.

Presently, the Thai Trademark Act B.E. 2534 (A.D. 1991) does not have any specific provision regarding moving image marks and the section 4 also does not clearly express that the mark included moving image marks. This leads to an interpretation's problem of section 4 and this may cause trouble to owners of moving image marks to use the mark. Moreover, moving image marks may be used by unauthorized and may cause damage to consumers because consumers do not obtain products or services that having actual quality. This is considered as an important problem; therefore, this research paper aims to analysis the problem and seeking for appropriate solutions.

B. Hypothesis of Study

According to section 4 of the Trademark Act B.E. 2534 (A.D. 1991), it does not precisely enact for the definition of mark. As a result, there is a problem of interpretation of the word 'marks', whether it includes moving image marks as trademarks or not. Therefore, the term "mark" according to section 4 of the Trademark Act B.E. 2534 (A.D. 1991) should be amended to protect covered moving image marks as trademarks.

C. Objectives of the Study

1. To analyze the problems of moving image marks protection.
2. To study an interpretation of section 4 under the Trademark Act B.E. 2534 (A.D. 1991) concerning moving image marks protection.
3. To propose appropriate method to protect moving image marks.

D. Scope of the Study

The scope of this research is to indicate the protection, using, and registration of moving image marks under the Trademark Act B.E. 2534 (A.D. 1991) as amended by Trademark Act (No.2) B.E. 2543 (A.D. 2000) relating to the topic of “Protection of Moving Image Marks”. This research mostly bases on the Trademark Act B.E. 2534 as amended by No. 2 and in comparison with trademark law of European Union, United Kingdom, Germany, the United States, and Singapore.

E. Study Methodology

The methodology of this research is documentary research. It is a study of the Trademark Act B.E. 2534 (A.D. 1991) as amended by Trademark Act (No.2) B.E. 2543 (A.D. 2000), the UK Trade Marks 1994 Act and the Office for Harmonization in the Internal Market under European Union, the German Trademark Act, the Lanham Act of the United States, Singapore Trademark Law and including decisions of the courts, thesis, research, internet which related to the IS topic.

F. Expectation of the Study

1. To know problems of moving image marks protection.
2. To know an interpretation of section 4 under the Trademark Act B.E. 2534 (A.D. 1991) for a moving image marks protection.
3. To know appropriate method to protect moving image marks

Chapter 2

Background and Characteristics of Moving Image Marks

In this chapter the historical background and characteristics of trademarks and moving image marks are studied. It is necessary to know what are the concept and fundamental principle of trademarks and moving image marks before let having deeply comprehension. As a result, this chapter defines the meaning, functions and development of moving image marks as well as the background of their protection both in Thailand and also in the foreign countries.

A. Definition of Trademark

A trademark or trade mark (represented by the symbol TM) or mark is a distinctive sign or indicator of some kind which is used by an individual, business organization or other legal entity to identify uniquely the source of its products and/or services to consumers, and to distinguish its products or services from those of other entities. A trademark is a type of intellectual property, and typically a name, word, phrase, logo, symbol, design, image, or a combination of these elements. There is also a range of non-conventional trademarks comprising marks which do not fall into these standard categories.¹

Trademark has several specialized terms used to categorize marks that may be subject to protection. The categories are form, mode of use, and, most commonly strength. The four subcategories of strength are arbitrary or fanciful, suggestive, descriptive, and generic.²

¹ Indiana University, Definitions: Trademark (Indiana University Institutional Purchasing Policy.), available at <http://iu.licensing.indiana.edu/trademarkpolicy.pdf>. (last visited 28 July 2008).

² Answer.com, Origins and Development of Trademark Law, available at <http://www.answers.com/trademark#Dictionary>. (last visited 28 July 2008).

Fanciful and arbitrary marks are the strongest marks, which need not acquire secondary meaning. Fanciful marks are inherently distinctive marks because they have no prior meaning. These marks are not to be found in dictionaries because they are invented. For example, 'Nokia' is a fanciful word which is used for the product of mobile phone.

Arbitrary marks are common words used in connection with the products in a way that does not describe such products or suggest anything about them. They are meaningless in the context of their use. For example, 'Apple' is a name of fruit but it is used in connection with the product of computer, MP4, and etc. which are not connection with an apple that is a fruit.

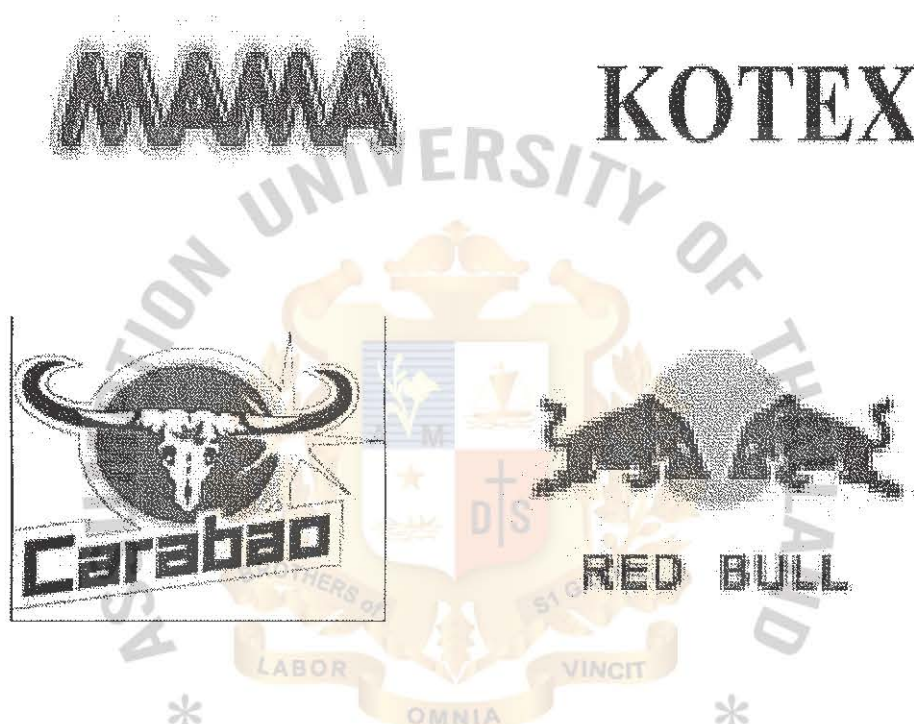
Suggestive marks do not describe a characteristic of the products but they just make a subtle suggestion about the type and the qualities of the products. These marks need the consumers' imagination to identify with their connected products. For example, 'Playboy' is a mark for sexually oriented men' magazine.

Descriptive marks are common words that used to describe something about the products which they related. Therefore, these marks are usually difficult to register as trademarks. However, they may register as trademarks by proving that such marks have become distinctive through use. They have acquired secondary meaning. For example, 'Brand Protect' is a brand belonging to the leading intellectual property protection firm. Such mark described the service in which the firm specializes.

Generic marks are the common name of the products. They will never be considered as a trademark because they are not strong and lack of distinctiveness. For example, the owner of shirt cannot register by using the word 'Shirt' to register as trademark for presenting his product. Nevertheless, there are some marks that do not begin as generic name may later become generic if the public adopt the mark as the general name for such products.³ Examples of marks that were not originally generic but later become so are CELLOPHONE, ASPIRIN, FAB, and XEROX. These marks are inherently distinctiveness; nevertheless, they lost such distinctive marks because of a period of time which make the public confusing between the owners of such distinctive marks from another.

³ Answer.com, Origins and Development of Trademark Law, available at <http://www.answers.com/trademark#Dictionary>. (last visited 28 July 2008).

A good example of popular trademark is Nike's swoosh. If another company tried to confuse consumers by using a symbol that looked like swoosh, that company would be infringing on the Nike's trademark rights. Nike would therefore has ground to sue.⁴ Another trademark logo that is globally recognized is Coca-Cola's wave. Coca-Cola's trademarked logo makes people easily recognize their product when seeing its trademark that is different from the others.



B. Functions of Trademark

The remarkable functions of trademark are;

1. To identify the origins of the products or services

This is the main function of trademark which acts as a device for helping the consumers to know where the products manufactured or whose products or services are. Trademark is a badge of the products or services which helping the consumers to perceive that such products or services belong to the owner of such

⁴Answer.com, Trademark, available at <http://answer.com/investment-dictionary-trademark>. (last visited 28 July 2008).

trademark. The consumers will not misunderstand or complicate in the products or services of the owner of such trademark from the others. Trademark is like a brand of the products' owners when the consumers see the trademarks; they will immediately know the owners of the products although the owners may have various products. For example, when the consumers sees the brand of "Sony" on the product either on the camera, television, or MP4 the consumers will perceive that such product is belonging to the owner of the brand "Sony".

2. To Distinguish the Products or Services of the Owner of such Trademark from the Others

Trademark has another important function that is to differentiate one product or service from the others. In order to register trademark, the registrable marks must not be identical or similar to other registered marks. Therefore, this condition will prevent an imitation of the others and to avoid the consumers' confusion between the products or services of the owners from another. For example, there are many brands of the products of television such as Sharp, Toshiba, DiStar, Panasonic, Sony, and etc. therefore the consumers can choose to buy which brand by seeing the trademark of the products.

3. To Guarantee the Quality of the Products or Services

Trademark provides consumers with the information necessary to assess the qualities of products or services. Normally the consumers will buy or use the products or services that are well known or popular in the market place or the products or services which their brands are recognized in the consumers' mind. This is because they can guarantee and making confident of the products or services' qualities which are accepted by the majority of the consumers that such trademarks measure up to expectation. A good trademark brings of a reputation for quality and reliability. For example, if we talk about a mobile phone, we usually think of the brand "Nokia" because of its reputation. The brand "Nokia" is recognized by a universal due to the acceptance of the users in its quality and functions. Therefore, it is surely that the users choose to buy Nokia rather than any no name trademark.

4. To Advertise the Products or Services

Due to the competition in the business world, trademarks become devices for appealing the consumers to buy or use the products or services of such trademarks.⁵ Typically, consumers are interested in the products or services that attract either by packaging, promotion, or an innovative advertisement. It is primarily by advertising that reputations are created and maintained. Trademarks provide an economical and effective means of advertising, and are, therefore, very useful for promoting products or services.⁶

Therefore, it can be stated that trademarks are significant devices of their proprietors and they are also a valuable property of the owners of such trademarks. Moreover, some trademarks have even become commodities in themselves. At present, well known marks are demanding to the sellers and the dealers for persuading their consumers. Consequently, there are trading of well-known marks.

C. Protection of Trademarks in Thailand

Thailand has been applied the Trademark Act B.E. 2534 (A.D. 1991), anyway this act was not appropriate for trademarks that continuously developed together with social's growth. Therefore, Thailand revised the Trademark Act B.E. 2534 (A.D. 1991) and then established the Trademark Act B.E. 2543 (A.D. 2000) to amend the former Act. This amended Act was result of the Agreement of Trade Related Aspects of Intellectual Property Rights (TRIPS) due to in B.E. 2538, Thailand has been become member of TRIPS which is an international agreement administered by the World Trade Organization (WTO). TRIPS sets down minimum standards for many forms of intellectual property regulation. TRIPS also specifies enforcement procedures, remedies, and dispute resolution procedures. Subject to TRIPS agreement, its members have to comply with its rule. The members maybe either by enact a new law or amend the old one to accompany with the rule.

⁵ Pinita Ansusinha, "Protection of Single Color Trademark," (Master of Laws, Business Law, Graduate School of Laws, Assumption University, 2007), p. 18.

⁶ Catherine Colston, *Principles of Intellectual Property Law*. (Great Britain: Cavendish Publishing Limited) 346 (1999).

As refer to the amended act No.2, the important improvement is to extend the scope for registering as trademark. In section 4 of the new Act expands the definition of a mark to also include “phrases, color combinations and shape or configuration of goods.” This expanded definition may imply that consumers are now more sophisticated in distinguish the goods or services of one proprietor from another than before. However, other types of non-conventional trademarks such as smells, sounds, tastes and moving image marks or motion marks are not yet recognized for registration in Thailand. To be registrable marks, such marks must be capable of distinguishing the trademarks goods or services from those of others. Consequently, non-conventional trademarks are difficult to prove for differentiation so they are not the registrable marks under the Trademark Act B.E. 2534 (A.D. 1991) as amended by No.2.

As a result, the marks that can be registered as trademarks under Trademark Act B.E. 2534 as amended by Trademark Act (No.2) B.E. 2543, they must be marks according to section 4.⁷ Noticeable, under section 4 of the former Act was defined marks as a “photograph, drawing, device, logo, name, word, letter, numeral, signature, or any combination thereof but not including industrial designs under the law of patents.” Under the new section 4, the prohibition against registering on “industrial designs under the law of patents” has been removed. This raises two interesting points: first, although the removal of the prohibition will cause an overflow of applications for marks which may also be considered industrial designs, the change does seem to indicate that some well-known marks that are industrial designs are registered in other countries but are denied registration in Thailand. Anyway, they may now be registered under the amended Act.⁸

Interestingly, there are marks which may be characterized as industrial designs which were registered prior to A.D. 1991 under the old Trademarks Act of B.E. 2474

⁷ Trademark Act B.E. 2534 (A.D. 1991) as amended by Trademark Act (No.2) B.E. 2543 (A.D. 2000), section 4:

“A ‘mark’ means a photograph, drawing, invented, picture, brand, name, word, text, letter, numeral, signature, group of colors, shape or three dimensional objects, or any combination of these items.”

⁸ Trademark Board Decision Nos. 1247/2541 and 1149/2542.

(A.D. 1931) or the Trademarks Act (No. 3) of B.E. 2504 (A.D. 1961) that probably could not have been registered under the Trademark Act of B.E. 2534 (A.D. 1991) due to the prohibitive definition of a mark. Now, it would seem that we have come full circle with the removal of the prohibition.⁹ Even though this mark was published for opposition on June 23, 2000, seven days prior to the June 30 effective dates of the amended Act, it may seem that the Trademark Registrar was already applying the new definition of a mark because the mark would clearly seem to be an industrial design rather than an otherwise distinctive mark.

Secondly, the removal of the prohibition against registering an industrial design as a mark may provide designers with an interesting alternative. A design may be registered as a patent as provided by the Patent Act (No. 3) of B.E. 2542 (A.D. 1991). The term of protection is limited to only ten years from the date the application was filed in Thailand (Section 62 of the Act). Then, the patentee's exclusive rights expire. Suppose a designer chose to protect his design as a mark instead and, registration was granted under the amended Trademark Act. Provided that he complied with all regulations and renewed his registration every ten years as provided by Section 53 of the Trademark Act, the designer / trademark proprietor would have the exclusive right to use the design as a mark in connection with goods and/or services registered for successive 10 year periods, without limitation.¹⁰

As considered the additional issue of industrial design that is now able to be registered as trademark. This is one advantage of the new Act. Then we will now come to learn more detail about marks that can be registered under Thai trademark law. The registrable marks under Trademark Act B.E. 2534 (A.D. 1991) as amended by Trademark Act No. 2 B.E. 2543 (A.D. 2000) shall be marks according to section 4 as aforesaid. Furthermore, such marks shall consist of the following particulars:

1. a distinctiveness;
2. Not being prohibited by Trademark Act; and

⁹ Trademark Gazette, Vol. 1692, page 106, Application No. 401093.

¹⁰ Commentary: Thailand's New Trademarks Act, available at <http://members.tripod.com/asialaw/articles/satyapon.htm>. (last visited 4 August 2008).

3. Not being identical or similar to those registered by others.¹¹

Distinctiveness

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This characteristic is the main function of trademark. The marks shall enable the public or users to distinguish the goods with which the trademarks are used from other goods. Moreover, marks that having or consisting of any one of the essential characteristics according to section 7,¹² shall be deemed distinctiveness.

¹¹ Trademark Act B.E. 2534 as amended by Trademark Act (No.2) B.E. 2543, section 6:

A registrable trademark shall consist of the following particulars:

1. a distinctive trademark ;
2. a trademark which is not forbidden by this Act; and
3. a trademark which is not identical or similar to those registered by others.

Trademark Act B.E. 2534 as amended by Trademark Act (No.2) B.E. 2543, section 7:

A “distinctive” trademark is a trademark which makes the general public or the consumer of goods believes that the goods bearing that trademark are different from those of other persons.

A distinctive trademark shall possess or consist of at least one of the following essential particulars:

1. The name of an ordinary person, first name and surname of an individual which are not ordinarily understood, full name of a juristic person under related laws, or trade name represented in a special or particular manner and having no direct reference to the character and quality of the goods.
2. A word or clause that has no direct reference to the character of the goods and is not a geographical name according to the prescription of the Minister.
3. Group of colors represented in a special or particular manner or an invented letter, numeral or word.
4. The signature of the applicant for registration or that of some predecessor in his business or of another with his or her permission.

In conclusion, there are two types of distinctiveness namely inherent distinctiveness and distinctiveness acquired through use. The difference between the two is that the inherent distinctiveness is *prima facie* registrable while the distinctive acquired through use is the opposite, but it maybe allowed to be registered if the trademark owner can demonstrate, typically by reference to evidence of use, that consumers in the marketplace exclusively associate the mark, as used on the identified goods or in connection with the identified services, with a particular commercial origin or source.¹³

Noticeable, there is some interesting in the Thai trademark law whether it require of trademarks' actual use as a condition or not. Due to the article 15(3) of TRIPS that sets the actual use of trademarks as one condition for trademark's registration. The concept of actual use comes from the Common law system which will talk in the next chapter.

Not being Prohibited by this Trademark Act

Subject to section 8,¹⁴ this section said about trademarks having or consisting of any characteristics according to subsection (1)-(13), shall not be registrable as trademarks under the Trademark Act B.E. 2534 (A.D. 1991). For

5. The photograph of the applicant or that of another with his or her permission or with the consent of his or her ascendants, decendants and spouse, in the case of a deceased person.

6. An invented picture.

In case a name, word or phrase contrary to the descriptions in(1) and (2) above is used as trademark on goods which are widely distributed or extensively advertised under the rules and regulations prescribe br the Minister and there is proof that the rules and regulations have been complied with, the trademark shall be deemed distinctive.

¹³ Siam Legal, The requirement of distinctiveness, available at http://www.siam-legal.com/legal_services/intellectual-property-thailand.php?page=3. (last visited 5 August 2008).

¹⁴ Section 8 Trademark Act B.E. 2534 (A.D. 1991) as amended by Trademark Act (No.2) B.E. 2543 (A.D. 2000).

examples; state crests, national flag of Thailand or the international, and any concerned to royal marks, these marks are prohibited to apply for trademark registration.

Not being Identical or Similar to those Registered by Others

Marks those are identical or similar to registered trademarks being prohibit for registration. This essential element is under section 13¹⁵ of the Trademark Act B.E. 2534 (A.D. 1991). This condition is to prevent the overlap of trademarks which cause confusion on the part of the public.

As we know the basically knowledge of registrable marks then we are now ready to learn and consider about the definition and characteristics of moving image marks.

D. Moving Image Marks

In today's digital age, just as technology and marketing techniques have developed the manner in which businesses interact with the consumers, the types of signs used to promote and identify goods and services have evolved beyond 'traditional' trademarks categories. Today's businesses are not simply protecting

¹⁵ Trademark Act B.E. 2534 as amended by Trademark Act (No.2) B.E. 2543, section 13:

Subject to the provisions of Section 27, if in the opinion of the Registrar, a trademark for which registration is sought is:

1. a trademark which is identical to another trademark already registered by another proprietor, or
2. a trademark which is so similar to another trademark already registered by another proprietor that it confuses or deceives the public as to the proprietor or the origin of the goods, the trademark shall not be accepted for registration.

In the event that registration is sought for a trademark which is to be used on goods of the same or different classes but are considered by the Registrar to be of the same character, the trademark shall not be accepted for registration.

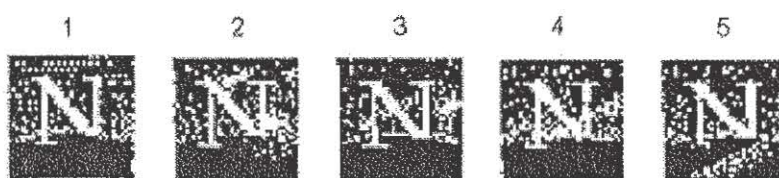
brand names and logos, they are also registering less conventional devices, such as sound mark, shape, a combination of colors, three-dimension mark, hologram mark, and including moving image marks. Moving-image marks are good signs that attract consumers' attention more readily than two-dimensional trademarks because moving image marks are precisely and easy accessible. They can pass directly the proprietors' information to their consumers.

1. Characteristics of Moving Image Marks

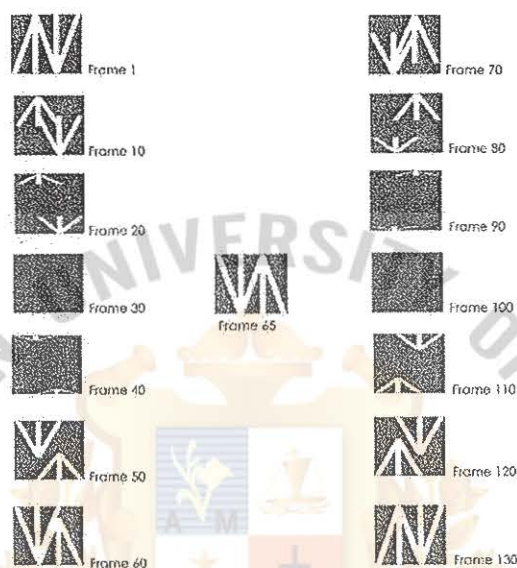
Moving image marks are one type of Non-Conventional Trademarks, or also known as Non-Traditional Trademarks are any new type of trademarks which does not belong to pre-existing, conventional category of trade marks, and which are often difficult to register, nevertheless they are innovative trademarks that are good tools of their proprietors.

Generally, **Moving image marks** per se cannot form the basis of the representation, as this would not constitute graphical representation. They may consist of or contain elements of motion. The moving image may be a film-clip, video, or moving logo for TV-shows. Two main ways of representing motion or multimedia signs have been now identified in countries where they are accepted for registration as trademarks. The first method would be to provide a series of still images that clearly depict the motion, together with a detailed written description of the marks.

There may be an addition requirement to specify the chronological order of the images, by numbering the series of frames or including that sequence in the written description. In some systems, there may be a limitation as to the number of frames to be provided. Other elements of the description may include the duration, the direction and the frequency of the motion. A statement or indication of the type of marks would normally be required.



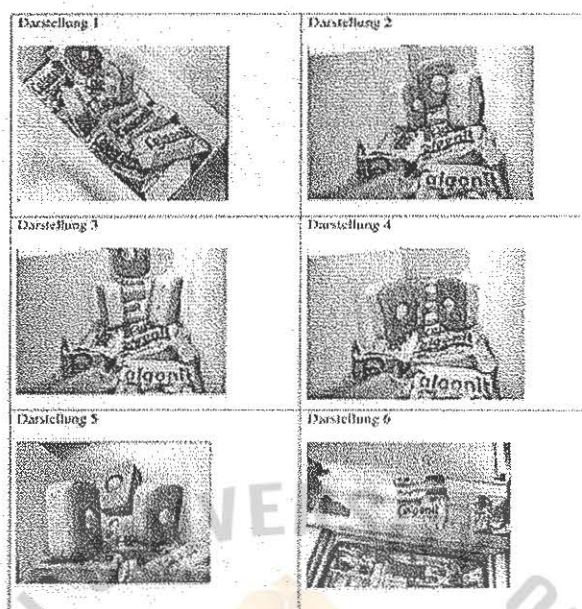
The above mark belongs to Netscape Communications Corporation that registered for goods in class 9. The mark consists of an animated sequence of images depicting the silhouette of a portion of a planet and a series of meteorites passing through the scene, all encompassed within a square frame. The animated sequence is displayed during operation of the software.



The above mark is submitted to the Community trade mark (CTM). The mark represented in a constantly-running sequence of images blending one into the next as shown by the representative frames in the sequence shown in the accompanying drawing, starting with frame 1 and finishing at frame 130, repeating indefinitely.

The second method of representation may consist of a short movie that will be filed together with the application and a written description outlining the nature of the marks and describing the movement. In this case, a recording of the motion in analog or digital format will be required. If applications can be filed electronically, an electronic file of the motion may be submitted.¹⁶

¹⁶ WIPO, Representation and description of non-traditional marks possible areas of convergence, available at <http://www.wipo.int/edocs/mdocs/sct/en/sct19/sct192.pdf>. (last visited 28 July 2008).



The above mark is registered under the German Patent and Trade Mark Office. The mark is represented in the form of a short movie for products in class 1, 2 and 3.

2. Development of Moving Image Marks

As aforesaid that moving image marks are one type of Non-conventional trademarks in which are broadly inclusive as they encompass marks which do not fall into the conventional set of marks (e.g. those consisting of letters, numerals, words, logos, pictures, symbols, or combinations of one or more of these elements), and therefore includes marks based on appearance, shape, sound, smell, taste and texture. The non-conventional trademarks may therefore be *visible* signs (e.g. colors, shapes, moving images, holograms, positions), or *non-visible* signs (e.g. sounds, scents, tastes, textures).¹⁷

Non-conventional trademarks including moving image marks are perhaps used as trademarks or brands as long as Conventional trademarks. For the reason, that proprietors unaware used moving image connecting with their goods or services.

¹⁷ Global Oneness, Non-conventional trademark, (Google Ads.), available at http://www.experiencefestival.com/trademark_-_non-conventional_trademarks.(last visited 30 July 2008).

However, consumers immediately recognized the owners of goods or services whenever they had seen such moving image marks. For Example, there was one Film Corporation that used lion's picture or called "Leo the Lion" as logo to open before showing their movie. That Film Corporation is MGM Picture Corporation. The "Leo the Lion" has been used as trademark of Metro-Goldwyn-Mayer for decades. For over 80 years, movie audiences have counted on seeing the roaring lion at the beginning of all MGM films.¹⁸ This logo has been familiar to the movie audiences for a long time. Although there is uncertainty regarding this lion's name or any other personal information, we do know that this lion has been in use the longest. It has been first featured in the Tom & Jerry cartoons starting in 1957, has kept roaring ever since, and can now be seen and heard at the beginning of all MGM films.



Furthermore, moving image mark is often as memorable as a company's name or logo, helping that company gained a significant advantage over its competitors. Their use is particularly prevalent on the Internet and in the entertainment industries such as Paramount Corporation, Walt Disney Pictures Universal Pictures and Warner Home Video. Many web browsers also feature animated devices in the top right-hand corner of the browser screen, and moving-image marks could often be seen at the openings of films.¹⁹

¹⁸ Metro Goldwyn Mayer, *History and Timeline*, available at <http://mgm.media room.com/index.php?s=40&cat=7>. (last visited 26 November 2008).

¹⁹ Review, *Poetry in Motion*, available at <http://USPTO.go.th/trade mark/poetryon motion/html>. (last visited 12 August 2008).



It has been pointed out that with the Internet, it has become technically possible to display moving logos and that such signs are becoming more and more common use. The choice of acceptable means to represent such marks would have to be made and could include a series of still pictures, the moving image represented electronically, and a description of the mark in words or a combination of those elements.

3. Background of Moving Image Marks Protection

Moving Image marks have become more widely accepted in recent times as a result of legislative changes which expands the definition of 'trademark'. Such developments are the result of international treaties dealing with intellectual property, such as the Agreement on Trade-Related Aspects of Intellectual Property Rights, which sets down a standardized, inclusive legal definition. Due to "the goal being to the user's attention without disturbing him or her", said by Russell Pangborn, Microsoft associate general counsel.²⁰ Therefore, it is one reason for using moving image marks. Nevertheless, there are no general rules concerning these marks. In some countries, they do not constitute separate category of marks. It would seem that the decision as to whether a mark of this kind is registrable could only be made on a case-by-case basis. Anyway, in order to register moving image marks, such marks shall be distinctiveness and can be graphical representation. These conditions are general concept for non-conventional trademarks registration that are applied in countries where accept for non-conventional trademarks. As a result, we shall consider on the definition and characteristics of moving image marks whether they having character under the conditions of those countries to be register as trademarks

²⁰ Catherine Saez, Some see rise in Non-Traditional Trademarks; National Registries not yet, available at <http://www.ip-watch.org/weblog/index.php?p=1108>. (last visited 20 June 2008).

or not and whether they are marks according to section 4 of the Trademark Act B.E. 2534 (A.D. 1991) or not.

As Thailand is undergoing a transition into the knowledge-based economy, the ability to obtain knowledge and utilize such knowledge to the greatest extent possible, especially through creating innovations. To foster innovations, promote research and development, stimulate value creation, and expedite the full utilization of knowledge, it is necessary to develop the basic infrastructure in intellectual property to facilitate these activities. The Royal Thai Government has thus developed a clear policy to promote effective protection of intellectual property rights. This intention can be inferred from both in the new Constitution of the Kingdom of Thailand B.E. 2550 (A.D. 2007), which gives special emphasis on providing protection on intellectual property in line with international accepted standard.²¹

Protection of trademarks in Thailand started since B.E. 2452 (A.D. 1909). After that, the first Trademark Act was enacted in B.E. 2457. This act sets the conditions for registering trademarks along with the right of registered trademarks. Until in B.E. 2534 (A.D. 1991), Thailand issued a new Trademark Act B.E. 2534 (A.D. 1991) which has been enforce till now. Nevertheless, Trademark Act is amended in B.E. 2543 (A.D. 2000) by issuing the Trademark Act (No. 2) B.E. 2543 (A.D. 2000).²² This act is issued to improve the Trademark Act B.E. 2534 due to the cause that Thailand became a member of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) in B.E. 2538 (A.D. 1995). TRIPS established

²¹ Department of Intellectual Property, Ministry of Commerce Thailand, Thailand's Implementation on Intellectual Property Rights, available at http://www.ipthailand.org/ipthailand/index.php?option=com_content&task=view&id=315&Itemid=197. (last visited 1 September 2008).

²² Pinita Ansusinha, "Protection of Single Color Trademark," (Master of Law, Business Law, Graduate School of Laws, Assumption University, 2007), p.15.

legal compatibility between member jurisdictions by requiring the harmonization of applicable laws.

As a result, Thailand was obligated to improve our law for being the same standard of TRIPS. This improvement is to amend section 4 of the Trademark Act B.E. 2534 (A.D. 1991) by extending the definition for registrable mark. However, the Act still not covers to moving image marks. In practice, moving image marks have been used to identify the source of their goods, they maintain function of trademark, however they are not permitted to register as trademarks under the Trademark Act B.E. 2534 (A.D. 1991). Such moving image marks are NOKIA, 20th Century Fox Film Cooperation and Columbia Pictures.

At the same time, moving image marks are protected under trademark laws of European Union, United Kingdom, the United States, Singapore, Germany, Denmark and Finland. Even if, there is no precisely provision of trademark laws stated that moving image marks are protected as trademarks under their laws, however they expand their laws by giving more interpretation to cover moving image marks and started to register first moving image mark in 2002. That first moving image mark's applicant in United Kingdom was submitted on August 2001 for the goods of chocolate. After that, European Union by the Office for Harmonisation in the Internal Market (OHIM) also registered one moving image mark and many other countries also accepted to registered moving image marks such as Germany, the United States and Singapore.

In summary, moving image marks are apt for use in promoting and advertising a wide range of goods and services in which innovation and technological advancement is employed. As a result, moving image marks are sought to be registered in respect of various household apparatus and electric appliances. Mostly, consumers of these products are likely to be the general public who generally welcome new products using innovative design or advanced technology. Researcher considers that when the moving image marks are used in relation to these products, they are likely to be perceived by the average consumers more than any other trademarks. Due to moving image marks are remarkable trademarks so they are easy to be recognized in consumers' mind.

Chapter 3

Protection of Moving Image at International and Local Levels

Accordingly, moving image marks tend to have an effect to the innovative world therefore certain countries have recently begun to accept for registering trademarks application for moving image marks. For example, the Office for Harmonisation in the Internal Market (OHIM) has accepted number of applications for registration of “moving image design marks”, being published in the form of stills showing the different various stages in the progression of the moving image, and accompanied by the description in words of the progression of that sequence. Besides, United Kingdom, Germany, the United States and Singapore are sample countries that accept moving image marks to be registered as trademarks under their trademark laws. Thus, in this chapter will study trademark laws by separately into the international and local levels.

A. International Levels

Before the existence of any international agreement in the field of intellectual property, it was difficult to obtain unitary protection for intellectual property rights in various countries, since each nation had their own laws based on their own particular legal doctrines and practice⁵. However, during the second half of the last century, international trade increased rapidly and internationally oriented flow of technology developed significantly.²³ As a sequence, this circumstance brought for legislation on intellectual property rights in many countries to be unified and harmonised. The Paris Convention was the earliest international effort in the field of intellectual property rights. It has been followed by the series of multilateral and bilateral agreements.

²³ Nguyen Nhu Quynh, “Special Trade Marks – Legislation and the Situation in the European Community,” (Master of European Affair Program, Faculty of Law, Lund University, 2002), p.11.

1. Paris Convention

Paris Convention for the protection of Industrial Property was one of the first intellectual property treaties. The convention established in 1883 to protect trademark, patents, and product's design. The main content about trademark registration under the Paris Convention is to be considered under the conditions of each Country of the Union according to Article 6²⁴ that imposes such countries to use their domestic laws. Moreover, the Convention also imposes trademarks being accessible to the nationals of other Countries of the Union according to Article 6quinquies (A) of the Convention.²⁵ Subject to this article, trademark registered in the

²⁴The Paris convention, article 6

Marks: Conditions of Registration; Independence of Protection of Same Mark in Different Countries;

(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.

(2) However, an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been affected in the country of origin.

(3) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.

²⁵The Paris Convention, article 6

Quinquies Marks: Protection of Marks Registered in One Country of the Union in the Other Countries of the Union.

(1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

(2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he

country of its source shall be accepted and protected in other member state parties. This principle is called “telle-quelle”. At a result, the Paris Convention only sets up the basic principle of trademarks protection, besides; the definition and standard of protection freely depend upon the domestic laws of each State Parties.²⁶ Thus, the provisions relate to moving image marks have not yet imposed under the Paris Convention. Anyway, the researcher thinks that there has no possibility to add more content of moving image marks in the future because the Paris Convention was a treaty that generally sets the principle of Industrial Property’s protection. Hence, any details of trademarks protection are duty of each State Parties that shall impose it by them.

2. Trade Related Aspects of Intellectual Property Rights: TRIPS

TRIPS is an International Agreement that lays down minimum standards for the protection of all intellectual property rights including trademarks, copyright and related rights, geographical indications, industrial designs, patents, integrated circuits and confidential information. TRIPS imposes an obligation on its participant States to apply the Paris Convention standards relating to trademarks. Thus in adopting a broad definition of the signs capable of being marks, it requires trademark registration to extend to marks for services. It strikes out on its own in defining the right in a registered mark: this is the exclusive right to prevent unauthorized third parties from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the mark is registered and there is a likelihood of confusion. Additionally, TRIPS extends the Paris Convention provision on the protection of well-known marks to service marks

has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.

²⁶ Pinita Anusinha, “Protection of Single Color Trademark,” (Master of Business Law, Graduate School of Laws, Assumption University, 2007), p.50.

and to cases of dilution by use for different goods and services where that use is damaging.²⁷

TRIPS is only one international agreement that precisely provides a definition of trademark according to Article 15.1²⁸ that can be separated into 2 main points; firstly, trademark's registration and secondly, conditions of registrable marks. TRIPS gives sample of registrable marks such as word including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs. Anyhow, TRIPS is also stated nothing deeply about moving image mark or even non-conventional trademark. Notwithstanding, other marks including moving image mark may be registered as trademark if they can distinguish the goods or services of one undertaking from those of other undertakings. In addition, TRIPS is the basic principle of trademark law in many countries which lead into a registrable mark's development.

B. Local Levels

As a result of social development that extremely influence to trademark's advancement therefore, many countries are likely to accept of Non-conventional trademarks that do not belong to the Conventional trademark. This response leads such countries into an improvement of their trademark laws. For part of the local

²⁷ Cornish and Llewelyn, International Intellectual Property (Great Britain :United Kingdom Publishing Co.,Ltd.) 581 (3rd ed. 1997).

²⁸ Trade Related Aspects of Intellectual Property Rights: TRIPS Article 15.1:

“Any sign, or any combination of signs, capable of distinguish the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration of trademarks. Where signs are not inherently capable of distinguish the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may, require as a condition of registration, that signs be visually perception.”

levels, researcher will classify countries into three sub-heading that are European Union system in which included United Kingdom and Germany as the EU' member states then, United States and Singapore.

1. European Union System

a. Development of Trademark Law

For reason that the European Union (EU) is included in local level because the treaty of the EU enforces only its member states that consist of the combined territories of 27 states.²⁹ The EU is a political and economic union of such member states. It was established by the Treaty of Maastricht in 1993 upon the foundations of the pre-existing European Economic Community. For the legal system, the EU is based on a series of treaties. These first established the European Community and the EU, and then made amendments to those founding treaties. In 1998, EU established the First Council Directive that approximates the laws of the member states. These are power giving treaties which set broad policy goals and establish institutions with the necessary legal powers to implement those goals. These legal powers include the ability to enact legislation which can directly affect all member states and their inhabitants.

b. Characteristics of Registered Trademarks

For trademarks' protection, EU has an Office for Harmonisation in the Internal Market (OHIM) that is an official authority carrying out the trademark's procedures. The Community Trade Mark (CTM) and Registered Community Design (RCD) are the gateway to the European single market – providing protection for

²⁹ Europa, Member States of the European Union, available at http://europa.eu/abc/european_countries/index_en.htm. (last visited 4 December 2008).

Intellectual Property Rights throughout the European Union, which covers 27 countries.³⁰

The ways to obtain protection for a trademark in the whole EU are:

1. A Community trade mark: an exclusive right that protects distinctive signs, valid across the EU, registered directly with OHIM in Alicante in accordance with the conditions specified in the Community Trade Mark Regulations (CTMR). The CTMR is based on a 'basic Regulation' of the Council of the European Union (Council Regulation (EC) No 40/94

2. An international trade mark designating the European Community: likewise an exclusive right but administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva according to the Madrid Protocol. WIPO processes the application and then sends it to OHIM for examination according to the conditions specified in the CTM Regulations. This has the same effect as applying directly for a Community trade mark.³¹

Trademark under the EU is a sign which serves to distinguish the goods and services of one organisation from those of another. Trademarks are words, logos, devices or other distinctive features which can be represented graphically. They can consist of, for example, the shape of goods, their packaging, sounds and smells.³² Under European Union's trademarks law, trademarks such as words or figurative marks are an essential part of the "identity" of goods and services. They help deliver brand recognition, in logos for example, and play an important role in marketing and communication. In conclusion, there are three essential functions of trademark that

³⁰ Office for Harmonisation in the Internal Market (OHIM), About OHIM, available at <http://oami.europa.eu/ows/rw/pages/OHIM/index.en.do>. (last visited 16 August 2008).

³¹ Office for Harmonisation in the Internal Market (OHIM), How to obtain protection for the whole of the European Union (EU), available at <http://oami.europa.eu/ows/rw/pages/CTM/protection/protection.en.do>. (last visited 16 August 2008).

³² Office for Harmonisation in the Internal Market (OHIM), What is a trademark?, available at <http://oami.europa.eu/ows/rw/pages/CTM/trademark.en.do>. (last visited 16 August 2008).

are to identify the origin of goods and services, to guarantee consistent quality by showing an organisation's commitment to its users and consumers, and being a form of communication, a basis for publicity and advertising.

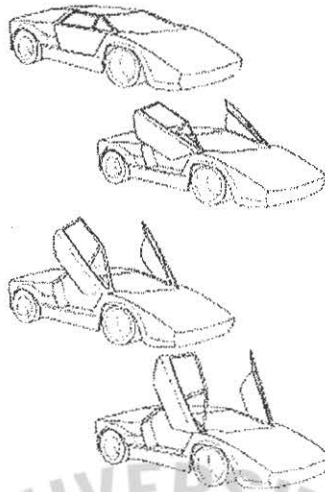
c. Registration of Moving Image Marks

According to the definition of a Community Trade Marks Article 4³³, it is possible to register a variety of trademarks under the European Union trademarks law including words, other graphical representations, and even sounds. Therefore, moving image mark is considered to be a registrable mark under the definition of the European Union's trademarks law, if moving image mark can comply with its conditions that are able to distinguish the goods and services of one proprietor from another and being graphical representation. Due to the trademark laws of EU do not impose strictly for the definition of registrable marks. This is an advantage for variety marks in which having opportunity to be considered for trademark's registration under the European Union's trademarks law.

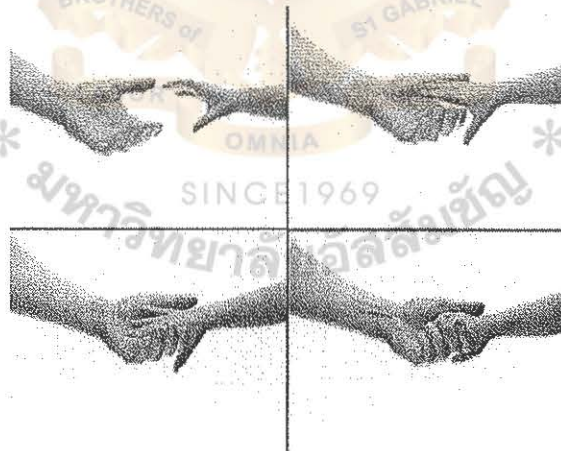
The following trademarks are samples of moving image marks that are registered by the OHIM, the official authority of the EU.

³³ COUNCIL REGULATION (EC) No 40/94, article 4

“A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”



The above mark registered for the doors of the Lamborghini (CTM 1400092), with a description: "The trademark refers to a typical and characteristic arrangement of the doors of a vehicle, for opening the doors are "turned upwardly", namely around a swivelling axis which is essentially arranged horizontal and transverse to the driving direction". The registration is for goods in the classes 12 and 28 (cars and toy cars).³⁴



³⁴ Debbie Ronning, Taste, Smell and Sound-Future Trademarks?, Moving Image Mark (The Norwegian Patent Office), (March 17, 2004), available at <http://Patentstyret - Taste, smell and sound – Future Trademarks.htm>. (last visited 25 July 2008).

The upper mark consists of an image of a man's hand and a child's hand which appear in sequence, whereby the man's hand and the child's hand converge in the positions illustrated in the top left and right figures, and the man's hand and child's hand touch and clasp in the position illustrated in the bottom left and right figures respectively. The mark (Reg. No. 3429909) is for goods in the classes 9, 28, 38, and 41. This mark is registered under European Union's trademark law and is also registered in the United State of America.



The mark comprises six still pictures representing a moving image. Picture number 1 is the starting point with a stylized green colored bird starting to open its wings. In the subsequent pictures the bird's wing/s is/are opening progressively to the highest position which is shown in the final picture number 6. The numerical indications do not belong to the mark because an applicant represents the mark by numbering the series of still images. The mark registered for goods in classes 35, 41 and 42 that relate to consultancy services for business management, education and intellectual property consultancy and agency.



The above moving mark is represented by six chronological, two-dimensional illustrations that indicate the procedure for the simultaneous sinking of a "small ship" made of sugar, within a time frame of approximately 12 seconds. The mark registered for goods and services in class 30, 35 and 43 that are relating to beverage, advertising and services. An owner's country is Germany that applied in 2004 and registered in 2006.

In order to register trademark under the CTM, the applicants shall represent marks in graphically together with the description of such marks and for what goods or services. After the date of submitting the application, this is an examination's period. Between this period, the registrar will consider whether it has any priority or an opposition submitting for this mark or not. If there has no any priority or opposition, such mark will be registered as trademark. However, there are two ways that the mark is not registered as trademark; firstly, the applicant withdraws for registration or secondly, such mark is rejected because it is unqualified according to the registration's conditions of CTM. Nevertheless, the applicant can appeal the decision of CTM for reconsideration. Duration of registered mark is for 10 years from a filing date and such mark may be renewed indefinitely for further 10 years period.

In conclusion, a mark which it's characteristic can comply with the European Union's trade marks law represented by the Community Trade Marks that shall be distinctive feature and can be represented graphically, hence, such mark could be considered to register as trademark under the EU. At this time, there are many moving image marks submitting for registration and they are still under the examination.

Moreover, there are two member states of the EU that researcher take to be the samples for easier understanding to reader. That two member states are United Kingdom and Germany.

2. United Kingdom

a. Development of Trademark Law

As modern capitalism has grown the drive to sell products and services using some mark, brand or name has invaded more and more fields. Some foods and a few other staples are still sold to the consumer without branding, but the tendency is consistently towards some form of labeling to indicate source. Before

industrialization, there were, of course, instance of traders or trader groups who deployed marks of various kind to distinguish their products. The hallmarks of goldsmiths and silversmiths and the mark of Sheffield cutlers are English examples which have survived as distinct systems.³⁵ Then trademark developed becoming as a modern advertisement. Most advertising teaches consumer to buy by product mark or house name and keeps reiterating it message in the hope of persuading buyer not to defect to rivals.³⁶

By the 1850s, the trademark law was adopted a system of registering trademarks for instance, of French law of 1857.³⁷ Later on, there was issuing a law concerned trade mark in many times. Anyway, those laws were not clear enough whether the registrable types of mark could be protected only after registration. Until the time of international business has grown, the extensive changes were introduced into United Kingdom law by the Trade Marks Act 1994 which has been use now.

b. Characteristics of Registered Trademarks

The Trade Marks Act 1994 gives a basic definition of trademark in section 1(1) which states that a 'trademark' is:

"any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another"³⁸

As the above definition, it can imply that certain marks are definite broadly; anyhow, such marks may be refused in accordance with section 3, 4 and 5. On its own, section 1(1) consists of three elements:

- (1) any sign;
- (2) graphically representation and
- (3) distinctiveness

'Any sign' mean anything which can convey information.

³⁵ Cornish and Llewelyn, International Intellectual Property (Great Britain: Cavendish Publishing Co.) 573 (3rd ed. 1997).

³⁶ Ibid., p.574.

³⁷ French Trade Mark Law, see Beier (1975), P.294-298.

³⁸ Trade Marks Act 1994, section 1(1).

‘Capable of being represented graphically’

The requirement of capability of graphical representation was introduced by a certain case. Swizzels Matlow’s trade mark application for a chewy sweet on a stick. This application was rejected because it was not possible to understand the mark precisely without reference to sample of the goods which meant that the mark was not capable of being represented graphically.

Furthermore, the words that sign can be represented graphically; particular by means of images, lines or characters, and that the representation shall clear, precise, self-contained, easily accessible, intelligible, durable and objective.³⁹

‘Distinctiveness’

A registrable mark required capable of distinctiveness. The distinctiveness requirement means that the main purpose of the trademark is to convey a message about the source of and responsibility for quality of the goods or services that are labeled with the mark.⁴⁰

As mentioned, a registrable mark under the 1994 Act is required for distinctiveness. A mark that failed to be distinctive mark according to the Act, however, such mark may obtain by a distinctive though use. In order to acquire distinctive character through use the mark must be perceived by the relevant category of persons to designate a product or service as originating from a given company. The following items may be taken into consideration for distinctive though use: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.⁴¹

³⁹ Ibid., p. 371.

⁴⁰ Ibid., p.374.

⁴¹ The judgment of the Court of Justice in Case C-353/03.

c. Registration of Moving Image Marks

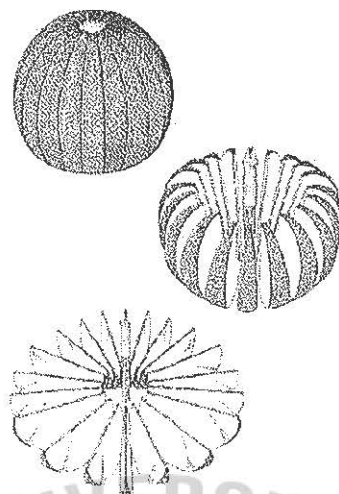
Subject to the 1994 Act, the definition of registrable marks is widely therefore, any sign and including a moving image marks which can comply with its rule, shall be deem a registrable marks. Therefore, in order to register a moving image as trademarks, they shall meets with the substantial elements in section 1(1). The substantial elements consist of any sign, graphical representation and the distinctiveness. Moreover, such moving image marks shall not be unregistrable marks in accordance with section 3, 4 and 5. For duration of registered mark under the 1994 Act, the initial period of registration is for 10 years from the date of registration and the registration may be renewed for further 10 years.⁴²

Nevertheless, a moving image per se cannot form the basis of the representation, as this would not constitute graphical representation. Moving images can be represented by a sequence of still pictures and a written description describing the nature of the mark represented by the still pictures and the correct sequence that corresponds to the mark in use.⁴³

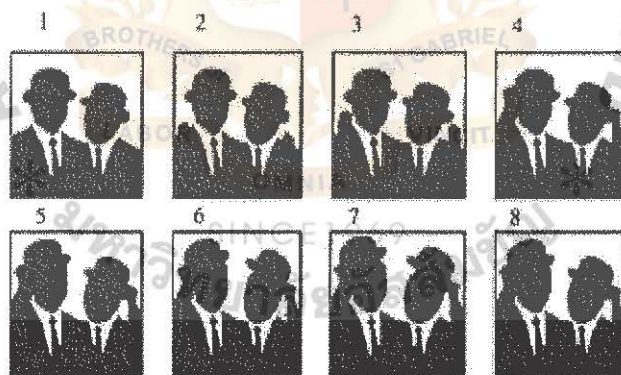
The following examples of moving image marks were successfully registered in the UK. The first one is a mark for Kraft Foods UK Ltd. (UK No. 2280003). The mark consists of the three dimensional shape breaking apart, as shown in the sequence of still pictures attached to the form of application. The mark registered for chocolate, chocolates and confectionery in class 30. This mark is not further detail.

⁴² Amanda Michael, A Practical Guide to Trademark Law, (Britain: Sweet & Maxwell Publishing) 59 (3rd ed. 2002).

⁴³ Jane MUTIMEAR, Kathrin VOWINCKEL, Richard ABNETT, Conditions for registration and scope of protection of non-conventional trademarks, available at www.aippi.org.uk/docs/Q181.UK%20Group.Response.pdf (last visited 21 August 2008).



The following mark consists of a representation of the two characters illustrated in the first frame of the illustrations' sequence attached slowly raising their hats as illustrated in frames two through eight of the said sequence and then replacing their hats as illustrated in frames eight through two of the sequence. At the conclusion of the sequence, returns to the representation as shown in the first frame.⁴⁴



The another one belonged to Derbyshire Building Society's registration of a gesture made by a person by tapping one side of his/her nose with an extended finger

⁴⁴ Auszug aus/ Extract from DEMAS, OAMI-online, UK Trade Mark, available at http://oami.europa.eu/CTMOnline/RequestManager/en_SearchBasic? (last visited 21 August 2008).

on the side of the nose being tapped.⁴⁵ This mark has also a characteristic of gesture mark.



Furthermore, there are many moving image marks that are applied for registration as trademark. The following marks are samples of moving image marks that are submitted in this year (2008).



⁴⁵ Jane MUTIMEAR, Kathrin VOWINCKEL, Richard ABNETT, Conditions for registration and scope of protection of non-conventional trademarks, available at www.aiippi.org.uk/docs/Q181.UK%20Group.Response.pdf. (last visited 21 August 2008).

This moving image mark applied for a series of eight marks as products and services of: alcoholic beverages (except beer) in class 33, Retail services connected with the sale of food and drink (including alcoholic beverages), glassware, corkscrews, wine stoppers, wine corks, wine closures, wine cellar thermometers, wine coolers, wine chillers, wine warmers in class 35, and Retail services connected with the sale of food and drink (including alcoholic beverages), glassware, corkscrews, wine stoppers, wine corks, wine closures, wine cellar thermometers, wine coolers, wine chillers, wine warmers in class 41



This moving image mark applied for a series of three marks as products of copying paper, envelopes, pads (paper), paper, paper sheets, wood pulp paper, and writing paper.



The above mark applied for a series of eight marks as products of Printed matter, paper, cardboard, and goods from these materials, not included in other classes; printed pages downloaded from the Internet; printed publications; books; annuals; publications; comics; magazines; newsletters; newspapers; albums;

periodicals; journals; catalogues; manuals; pamphlets; leaflets; posters; stationery; labels; address books; instructional and teaching materials (except apparatus); instructional and teaching materials in the form of games, apparatus and instruments; drawings; paintings; photographs; prints; pictures; calendars; pens; pencils; pencil top ornaments; tags; gift wrap cards; wrapping paper; note pads; decorative paper items; paper party goods; greetings cards; stickers and sticker albums; plastic materials for packaging; beer mats; parts and fittings for all the aforesaid goods. Continuously, moving image marks tend to be applied as trademark more and more in UK due to an unusual style that make such marks for more accessible and precisely.

3. Germany

a. Development of Trademark Law

The first German trademark law was the Trademark Protection Law (Gesetz der Markenschutz), enacted on November 30, 1874. It put into place a non-substantive trademark registration and examination system. After that, German trademark law was amended in many times until January 1, 1995, the Trademark Act was enacted in which was a major amendment to the law by increasing the number of articles to 164. The present German trademark law solidified certain concepts, such as: permitting the assignment of trademarks; the expansion of the subject matter available for trademark registration; and a post-registration opposition system.⁴⁶ This new Act governs not only trademarks, service marks and collective marks, but also trade designations, company names and geographical indications.

⁴⁶ The History and Development of Trademark Law, (Japanese Translation), available at <http://www.iip.or.jp/translation/ono/ch2.pdf>. (last visited 29 November 2008).

b. Characteristics of Moving Image Marks

According to the Trademark Act 1995, the important changes effected by this new Act are summarized below.⁴⁷

(1) The definition of registrable marks has been expanded to include any signs that are capable of being represented graphically and that are capable of distinguishing the goods or services of one undertaking from others. Under this definition colors and color combinations, names, letters, numerals, sound marks, three-dimensional marks, shape or packaging of a product and including moving image marks should be registrable. In view of this more relaxed definition of registrability (under the old law, for example, only word and device marks which could be represented two-dimensionally were registrable), applicants, whose marks have previously encountered insurmountable inherent registrability objections, could be filed new application for such marks.

(2) Rights in a mark under the new Act derive, not only from registration of the mark, but also from the following:

(a) Use of a mark in the course of trade whereby the mark has acquired prominence as a trade mark among the trade circles concerned;

(b) Where a mark is well-known within the meaning of Article 6bis of the Paris Convention.

(3) Objections to the registrability of marks that are considered non-distinctive, descriptive or generic may be overcome by establishing that the marks have acquired secondary meaning among the relevant trade circles prior to the date on which a decision is rendered with regard to the registrability of the mark.

(4) The term of a registration will run from the date of filing and expire 10 years after the end of the month in which the filing date falls. Registrations will continue to be renewable for further periods of 10 years.

⁴⁷ LADAS & PARRY, German - New Marks Act, (LADAS & PARRY LLP.), available at <http://www.internetmarken.de/guide/tmlawe.htm> (last visited 29 November 2008).

(5) Under the old law, the user requirement was strictly applied and marks had to be used in the form in which they were registered. Under the new law, use of the mark in a form which differs from the form in which it was registered will satisfy the user requirement, provided such variation does not alter the distinctive character of the registered mark. Use of the mark applied to goods in Germany but intended solely for export constitutes use of the mark in Germany.

(6) A registration is subject to cancellation if the application was filed in bad faith or if the mark was barred from registration on absolute grounds, such as lack of distinctiveness. However, such registration will only be held invalid if the cancellation action was instituted ex officio within 2 years or by a third party within 10 years following registration.

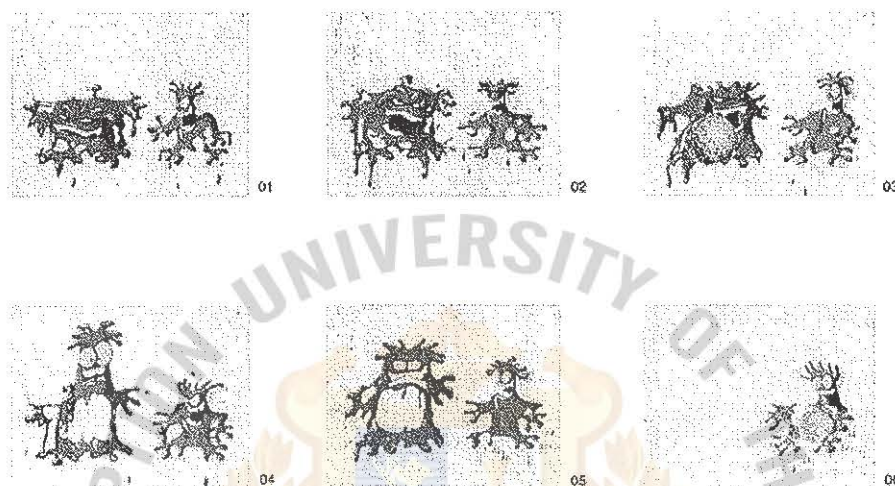
c. Registration of Registered Trademarks

As mentions, the new German trademark law mostly facilitates the applicants for trademarks registration and gives trademarks' owners more rights. This new Act expands the definition of registrable marks according to the German Trademark Act section 3⁴⁸ therefore, moving image marks shall be deemed to register as trademarks in the case that they fulfill the other conditions of the German trademark law. Noticeably, Germany is a country that use civil system however, the German trademark law has the basic principle of trademark law as same as the countries that use common system. Noticeably, in the German Trademark Act does not impose that graphical representation is one condition to register trademark under the German trademark law. However, a graphic representation of the mark is required to be attached together with its application according to section 8 (1) of the Trade Mark Ordinance.

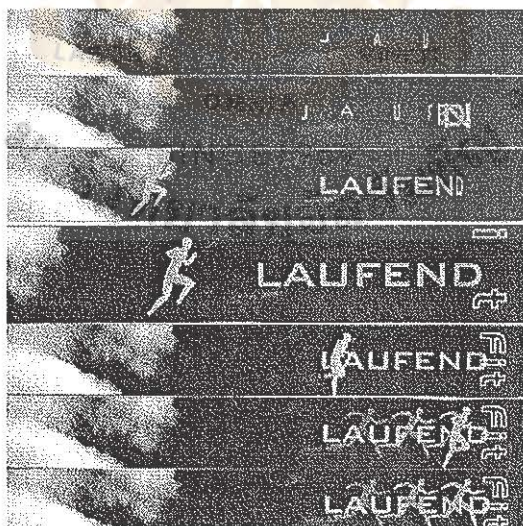
⁴⁸ German Trademark Act, section 3.

“(1) Any signs, particularly words, including personal names, designs, letters, numerals, sound marks, three-dimension configurations, including the shape of goods or their wrapping as well as other packaging, including colors, and combination of colors, which are capable of distinguish the goods or services of one undertaking from those of other undertakings may be protected as trademark.”

In the past, the German trademark law represented by the German Patent and Trade Mark Office had registered for many moving image marks. The following marks were samples of moving image marks that were registered as trademarks by the German Patent and Trade Mark Office.⁴⁹

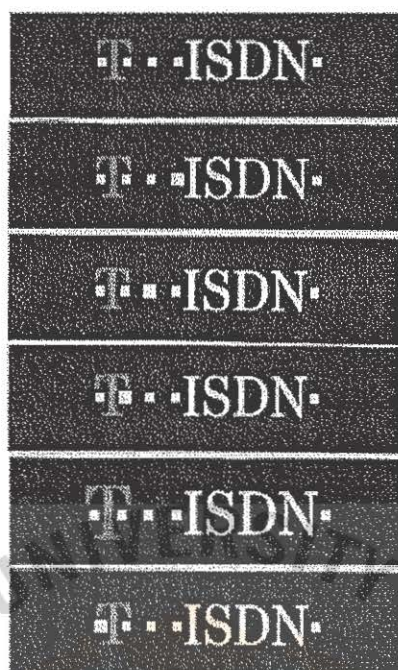


This mark registered for goods and services in classes 3, 16 and 21 in year 2002. The mark represented still images and together with the chronological number.

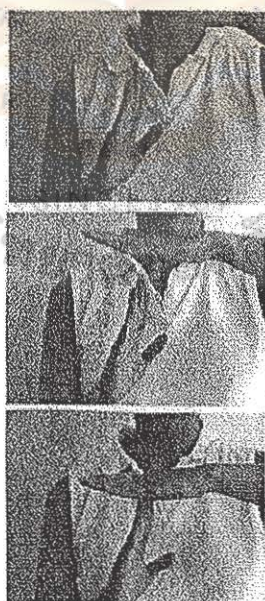


A representation of the above mark consisted of a short movie showing such mark. The mark registered for goods and services in classes 41 and 42 in year 2002.

⁴⁹ German Patent and Trade Mark Office, available at <http://www.dpma.de/>. (last visited 27 November 2008).



The mark provided a series of still images together with trademark's text "-T--ISDN". This mark registered in 2004 for goods and services in classes 9, 16, 38 and 42.



The above mark registered in 2004 for goods and services in classes 9, 16, 38 and 42. The mark represented by 3 frames of still images.



01



02



03



04

The upper mark showed a series of four still images together with numbering of each image. The mark registered in 2003 for goods and services in classes 1, 3 and 5.

In summary, as aforesaid that moving image marks are now interesting marks for the proprietors even though they are less familiar types of trademarks. Nevertheless, there is nothing to show in the trademark laws of said countries thereof to treat moving image marks and including other non-conventional trademarks different from conventional trademarks. Therefore, many countries tend to allow for non-conventional trademarks that are capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of undertaking. For convincing this change, many countries mostly use flexible method by expanding the definition of registrable marks. This method is the easiest for protection of non-conventional trademarks including moving image marks.

4. The United States System

a. Development of Trademark Law

In the past, trademarks were used on goods to indicate source. Merchants and artisans have used trademarks for centuries; the medieval trademark not only allowed artisans to take credit for their work but also permitted guilds to control quality.⁵⁰ English common law protected trademarks beginning in the seventeenth century. The colonists brought this law with them from England. The purpose of trademark law was to prevent consumer misunderstanding as to source. This meant that trademarks were local and goods-specific that was most trade at the time.

Through the nineteenth century, trade became less local, and a system of federal registration was created in 1870. This system, held unconstitutional in 1879 in a series of Supreme Court decisions collectively known as the Trademark Cases, was replaced in 1881, and then in 1905 with a federal trademark registration statute restricted to marks used in interstate commerce, thus rendering it constitutionally valid. Presently, trademark law in the United States is governed by the Trademark Act of 1946 and amended in 1988, also known as the Lanham Act.

b. Characteristics of Registered Trademarks

The Lanham Act section §1127 defines trademark as including words, names, symbols, or combinations thereof⁵¹ that a person uses or intends to use in commerce to distinguish his or her goods from those made or sold by another.⁵²

⁵⁰ US History Encyclopedia, Trademarks, available at <http://www.amswer.com>. (last visited 16 August 2008).

⁵¹ US Trademark Law, What can be protected as a trademark?, available at <http://www.chillingeffects.org/trademark/faq.cgi#Toc>. (last visited 16 August 2008).

⁵² The Lanham Act, section §1127, the term “trade mark” includes any word, name, symbol, or device, 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 to register on the principal register established by this chapter, to identify and distinguish

Within trademark law are several specialized terms used to categorize marks that may be subject to protection. The categories are form, mode of use, and, most commonly, strength. The four subcategories of strength are generic, descriptive, suggestive, and arbitrary or fanciful as aforesaid.⁵³

These considerations force a producer to select or create a symbol or name for its product that is suitable for trademark protection. A mark will not be allowed to use a trademark that another entity already uses. A consideration to trademark owner is uniqueness. The less unique characteristics a mark possesses, the less legal protection it receives. However, such mark shall be used in conjunction with goods in order to complete. Contrarily, a unique mark bears little relationship to the product is preferred over a mark that is more generic.

For trademark registration under the Lanham Act 1946 as amended in 1988, a trademark's owner shall intent to use the mark in commerce and must intend to do so in order to sell a product, not merely to reserve his rights for use. In addition, duration of each registration remains in force for 10 years according to section §1058 and may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration according to section §1059.

c. Registration of Moving Image Marks

As considered section §1127 of the Lanham Act, marks can be anything even though they are not defined in section §1127 because the provision of US's trademark law just gives the samples of registrable marks. Therefore, it implies that moving image marks could be registered as trademarks, if such moving image marks fall into other conditions of trademark registration. Besides, the basic principle of registration as trademarks, moving image marks' applications shall be furnished by their owners as following:

his or her goods, including a unique product, from those manufactured, or sold by others and to indicate the source of the goods, even if that source is unknown.

⁵³US History Encyclopedia, Trademarks, available at <http://www.answer.com> (last visited 16 August 2008).

(1) A drawing of the mark- it may depict a single point in the movement, or up to 5 freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark.

(2) A description of the mark.

Due to the Rules of Practice and Federal Statutes under the US trademark law⁵⁴, in the case that a mark is consisted of both visual and non-visual matter, the applicant must submit a drawing depicting the visual matter, and include a description of non-visual matter.⁵⁵ Furthermore, the mark's applicant is required to provide samples of how the mark is used in commerce, unless the application is based on intent-to-use, or on a foreign filing.

The moving image marks or animation marks below are samples of trademarks that are registered subject to the Lanham Act 1946.



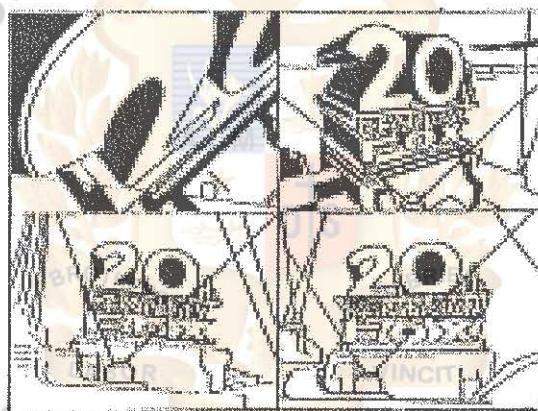
⁵⁴ US Trademark Law, Rules of Practice and Federal Statutes, Application for Registration:

§ 2.22 (a) (12) “A clear drawing of the mark. If the applicant does not claim standard characters, the applicant must attach a digitized image of the mark in .jpg format. If the mark includes color, the drawing must show the mark in color.”

⁵⁵ Report for APEC Survey on Non-Traditional Trade Marks, available at www.apec.org/apec/publications/free_downloads/2008.MedialibDownload.v1.html?url=/etc/medialib/apec_media.../cti/. (last visited 30 July 2008).

The mark consists of a moving image of a flash of light from which rays of 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 appear in the sky encircling the lady.⁵⁶ The mark belongs to Columbia Pictures Industries which were approved by USPTO in the mid-1990s.

Another well-known trademark belongs to Twentieth Century Fox Film Corporation. The mark represents a computer generated sequence showing the central element from several angles as though a camera is moving around the structure. The drawing represents four “stills” from the sequence. The mark was registered in 1995 and renewed in 2006.



Presently, there are many moving image marks or motion marks that are approved by the United States Patent and Trademark Office (USPTO) that is a commissioner for patents and trademarks' registration and continuously being registered in the future.

⁵⁶Auszug aus/ Extract from DEMAS, OAMI-online, available at http://oami.europa.eu/CTMOnline/RequestManager/en_SearchBasic?(last visited 21 August 2008).

5. Singapore System

a. Development of Trademark Law

Singapore has a dual system of trade mark law: protection for trade marks may be available both under the Trade Marks Act 1998 (Cap 332, 1999 Rev ed) ('TMA') and at common law. These two systems are independent of each other. Protection under the TMA is conditional upon registration of the trade mark with the Registry of Trade Marks within Intellectual Property Office of Singapore ('IPOS').⁵⁷

b. Characteristics of Registered Trademarks

In order to register trademarks in Singapore may be obtained in two ways: through (i) a domestic application filed with the Registry of Trade Marks; or (ii) an international application filed under the Madrid Protocol, designating Singapore as a country where protection is sought. Besides, there is one exception for well known trademarks that are granted under the TMA, regardless of whether they are registered.

Under the 1998 Act section 2⁵⁸, 'mark can be letters, words, names, signatures, numerals, devices, brands, labels, tickets, shapes, colors, and aspects of packaging or any combination of these'. For a trade mark to be registered⁵⁹, it must be distinctive and capable of distinguishing the goods and/or services of the owner from

⁵⁷ Singapore Academy of Law, Intellectual Property Law, available at <http://www.singaporelaw.sg/content/iplaw2.html>. (last visited 30 August 2008).

⁵⁸ The Trademark Act 1998, section 2

'sign' includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, color, aspect of packaging or any combination thereof.

⁵⁹ The Trademark Act 1998, section 2

'trade mark' means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided by any other person."

similar goods and/or services of other traders.⁶⁰ Moreover, such mark shall being represented graphically. Typically, there are two types of trade marks:

(1) Common law trade mark occur where the trade mark has been used either as a brand name or in advertising relation with goods and/or services to such an extent that it has developed a reputation such that any unauthorized use by another trader would make a misrepresentation or be misleading or deceptive to consumers.

(2) Registered trade mark is a trade mark registered under the Trade Marks Act.⁶¹

In addition, the applicant needs to furnish the following information to obtain a filing date because a trade mark registration will take effect from the date of filing: (1) a statement that a request for registration is sought, (2) name and address of the applicant, (3) a clear graphical representation of the mark, (4) a list of goods and services sought for registration, classified according to the International Classification of Goods and Services, (5) a declaration of use/intent to use the trade mark, and (6) the prescribed fee. From 2nd July 2007, the applicant may file for registration in one application in respect of several classes of goods or services. When several classes of goods or services are filed in one application, the application leads to only one registration.

The application will be processed when the above particulars are furnished in the prescribed form. Besides, marks comprising of a three-dimensional shape of the goods or packaging, the representation may be represented by line drawings. If a single-view line drawing is insufficient, multiple aspect views but up to a maximum of six views should be provided.

c. Registration of Moving Image Marks

As considered the Singapore trade mark law, it shows that moving image marks may also be registered in Singapore, if such marks can be represented

⁶⁰ Intellectual Property Office of Singapore, About Trade Mark, available at <http://www.ipos.gov.sg/leftNav/tra/>. (last visited 30 August 2008).

⁶¹ Loh Eben Ong & Partners, Singapore Trade Marks Centre (Non-Contentious), Singapore registration, available at <http://www.law.com.sg/trademark.htm>. (last visited 30 August 2008).

graphically and capable of distinguishing the goods and/or services of their owners from another. For the reason that the Singapore Trademark Act 1998 defines a registrable mark as any sign being capable of represented graphically and which is capable of distinguishing goods or services dealt with or provided by any other person. The basic principle of trademark in Singapore is as same as United Kingdom unless Singapore gives some samples of registrable marks. Consequently, moving image marks can also be registered as trademarks if they fall within the requirement of Singapore trademark law.



Chapter 4

Problems of Moving Image Marks Protection in Thailand

The process of trademark registration in Thailand is governed by the Trademark Act B.E. 2534 (A.D.1991) and its subsequent amendment, which came into the Trademark Act B.E. 2543 (A.D. 2000) that is enacted to amend the Act B.E. 2534. The scope of the protection under this amendment extends to combinations of colors and three-dimensional marks. However, other types of non-conventional trademarks such as smells, sounds, tastes and moving image marks are not yet recognized for registration in Thailand. Hence, this chapter will discuss on the problem of moving image marks' protection under Thai law, its registration's procedure and uses of moving image marks.

A. Should Thailand Protect Moving Image Marks?

Moving image marks are one popular tactic of the proprietors that use to persuade consumers for choosing their products or services. This is because moving image marks are easily to understand and being accessible to the consumers' mind. As a result, moving image marks tend to be used by the proprietors more than in the past. As good trademarks shall be accessible to the consumer, the famous mark may usually be targeted for copying and the moving image mark is not the exception. The competitors may deceive consumers between the products of moving trademarks' owners with their products. Thus, if the owners of moving image mark needs to protect their exclusive right, he must register such trademark in accordance with the law. The registration is to prevent their competitors for using the mark which is identical or similar to their registered marks for a purpose of consumers' misunderstanding.

However, the Thai Trademark Act B.E. 2543 does not have any specific provision regarding moving image marks and the section 4 also does not clearly express that the mark included moving image marks. This leads to an interpretation's problem of section 4 and this may cause trouble to owners of moving image marks to use or protect the mark. Therefore, the Thai trademark law should be amended to

cover moving image marks and other marks that can absolutely hold function of trademark. This amendment will enhance the Thai trademark law being in line with the international rules and reach the modern using of trademarks.

Moreover, in addition to protect and maintain exclusive right of the moving image marks' owners, the registration of trademark can maintain the utilitarian of both trademarks' owners and consumers in accordance with the theory of intellectual property protection.

In addition, there are results in the case that Thai trademark law gives protection covered moving image marks as following:

1. Result of Giving Moving Image Marks Protection

a. The Advantages of Giving Moving Image Marks Protection

There are five main advantages in the case that Thailand grants a protection to moving image marks, as follows:

(1) As Thailand is facing a transition into basic knowledge of economy, if we accede the protection of moving image marks, the Thai trademark law will be in the same standard of internationalization. Thereafter, the Thai trademark law will be accepted to other countries.

(2) A protection of moving image marks will support both internal and external of Thailand investment. The investors will assure that their trademarks will be protected under Thai trademark law.

(3) The form of trademark will continuously grow and develop to an innovation. This will inspire an idea of the proprietor to create the new form of trademark.

(4) To preserve the rights of moving image marks' owners. The owners of moving image marks will be confident that their marks will be protected subject to the Thai trademark law. The owners of moving image marks will have the legal right to prevent the others from unauthorized uses of their trademarks. In addition, they will have absolutely power to sue in order to stop the unfair business practices of other undertakings. The owners of such moving trademarks can keep their benefit from an infringement of unauthorized persons because trademarks are likely to be the assets of their owners.

(5) An innovation of trademarks will facilitate and maintain a benefit of the consumers because the good trademarks shall be accessible to the consumers. Furthermore, the consumers will not be misled and deceived by the origins of goods and services.

b. Disadvantage of Giving Moving Image Marks Protection

In the case that moving image marks are accepted for registration in Thailand, it may have some problems because of moving image marks are very new for both applicants and the registrars. Therefore, applicants may file uncompleted or incorrect documents of moving image marks and a few errors may cause a delay up to 3-6 months. While, the registrars may confuse which applications should be considered as moving trademarks under the new amendment.

B. Can Moving Image Marks be Protected under the Trademark Act B.E. 2534 (A.D. 1991)?

As considered the definition of mark according to section 4 under the Trademark Act B.E. 2534 (A.D. 1991) as amended by Trademark Act (No. 2) B.E. 2543 (A.D. 2000) that “a ‘mark’ means a photograph, drawing, invented, ..., or any combination of these items.” As a result, it shall be considered that the Thai trademark law defines only the marks provided in section 4 can be registered as trademark under the Trademark Act B.E. 2534 (A.D. 1991).

Therefore, it can suppose that other marks including moving image marks which are not defined under section 4, shall not be considered as a mark in accordance with the section 4, thus, they cannot be registered as trademarks under the Trademark Act B.E. 2534 (A.D. 1991). However, it is worth to consider the section 6 regarding conditions of a registrable trademark which provided that the mark which can be registered must be distinctiveness, not being prohibit by the Act and not being identical or similar to others registered marks. Therefore, if moving image marks fulfill all conditions provided therein, the moving image marks should be considered as registrable marks.

Moreover, moving image marks can hold the main function of trademarks that are to differentiate goods or services of their owners from others. For reason that moving image marks have the outstanding characteristic unlike the other marks

because they are easy to communicate information completely of their owners to consumers.

Meanwhile, moving image marks can be registered in many countries such as United Kingdom, Germany, the United States and Singapore; furthermore, they can be also registered under the European Union. This is because to the definition of a registrable mark under the trademark laws of these countries are defined and interpreted broadly. For example, under the EU represented by Community Trade Mark, regulates mark as “any signs capable of being represented graphically, particularly words, including personal names, ..., provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”. For United Kingdom, it provided in the Trade Marks Act 1994 that trademark is “any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another”. Whereas, the Lanham Act of the United States used the word “includes” defining a term of trademark. In consequence, any mark including moving image marks can be registered under the trademark laws of these countries even though there are no precisely written provisions in their trademark laws. According to their trademark laws, other marks may be considered to register as trademarks even though such other marks are not defined in their trademark laws. Meanwhile, the Thai Trademark Act B.E. 2534 (A.D. 1991) uses the word “means” to define a registrable mark, therefore, other marks including moving image marks shall not be defined as mark under section 4 and it will be the ground for registrar to reject the registration. This is an important point that Thai trademark law is different from trademark laws of these countries. Consequently, moving image marks shall not be deemed a registrable marks under the Trademark Act B.E. 2534 (A.D. 1991), even though such moving image marks may fall into the other conditions of registrable trademarks under section 6. As a result, it can be concluded that the statuses of moving image marks are not accepted under the Trademark Act B.E. 2534 (A.D. 1991).

C. The Problem of Moving Image Marks Registration under the Trademark Act B.E. 2534 (A.D. 1991)

The Trademark Act B.E. 2534 (A.D. 1991) had been enforced as trademark law in Thailand in 1991. After that, it was amended by Trademark Act (No. 2) B.E. 2543 (A.D. 2000). In order to register the trademark in Thailand, the registrar shall consider the characteristics of marks complying with the section 4 and section 6 of the Act. In the case of moving image marks, the registrar shall firstly consider whether moving images are marks according to the definition of section 4 or not. As considered, moving image marks are not marks according to section 4; however, moving image marks hold all functions of trademark, so that they should be considered as registrable marks. Suppose that they are marks according to section 4, we should then consider their characteristics in relating to section 6 whether they are distinctive characters, not being prohibited by the Act and not being identical or similar to the other registered marks or not. In order to register the trademark, section 4 is an important element that is imposed by the law nevertheless, regarding to the purpose of trademark that is to distinguish the goods or services of its owner from others. As a result, moving image marks can greatly hold such function of trademark. So as to consider whether a mark can distinguish the goods or services of a proprietor from others or not, an important factor is a distinctive character of such mark that have to consider its characteristic according to section 7.

In the case that moving image marks are considered to be registrable marks then, we shall think about moving image marks registration. As a result of their characteristics that are different from other marks because moving image marks do not have still images, they are movable signs. Consequently, there may be a problem of registration that how can moving image marks' owners show their characteristics to apply for registration. In Thailand, there is no provision or regulation to support this issue because moving image marks are still not be accepted as registrable marks under the Trademark Act B.E. 2534 (A.D. 1991). Presently, the Thai trademark law has regulation for trademark registration that is used for immovable marks. On the other hand, the said countries that accepted moving image as trademarks, they solve this problem by the European Union, United Kingdom and Singapore set a condition for

trademark registration that mark shall be graphical representation. Whereas, the United States and Germany impose in their trademarks' regulations for a condition of represented graphically.

D. The Problem of Applying Moving Image Marks as Trademarks

In order to register trademark under the Trademark Act B.E. 2534 (A.D. 1991) as amended by Trademark Act (No. 2) B.E. 2543 (A.D. 2000), the applicant shall generally show that 'a mark used or proposed to be used in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trademark which are different from goods bearing the trademark of others'. As the mentioned provision, the applicants must show that they used or propose to use with their goods. The applicants are obligated to use trademarks connection with their products or services. This concept comes from the Common law system that wants to avoid some dishonest applicants who register trademarks in order to maintain the right in such trademarks. In fact, there is no use of trademarks. Thus, the Common law system sets a concept that the right in trademark arises from use, not from registration. As a result, the United States, United Kingdom and Germany follow this concept and set as a condition for trademark registration. Therefore, this maybe problem whether use of mark is a condition for registration under the Trademark Act B.E. 2534 (A.D. 1991) or not⁶² Besides, concerning to the characteristics of moving image marks that do not still images, so how moving image marks are used connecting with goods or service. For this case, it is no problem in the countries where accept to register moving image as trademark because they concern to the actual purpose of trademark that is to identify and distinguish the goods or services of its manufacturer from other manufacturers. Also, trademark is now used as an advertising tool of its owner. Consequently, trademark does not hold only the functions formerly but it holds additional function of trademark that is to advertise its goods or services. For this

⁶² Jakrisna Kaunpojna, The International Law Related to Copyright, Patent and Trademar (Bangkok: Nititham Publishing.) 288 (1998).

reason, moving image marks are good samples of the new function of trademark. As aforesaid that moving image mark absolutely acts as trademark due to its using connecting to its goods or services, so the problem of using moving image as trademark might not be worried for considering trademark registration.

In conclusion, moving image marks are the innovation design of trademarks. They are now interested by many proprietors using for persuade consumers' attention due to their different characteristics. According to the Trademark Act B.E. 2534 (A.D. 1991), moving image marks are not protected under the Thai trademark law. As compared between advantages and disadvantage, the Thai trademark law should give protection to moving image marks as trademarks. Concerned to section 4, moving image marks cannot be registered under the Thai trademark law because moving image marks are not included in the definition of 'mark' according to section 4 so that they are implied for prohibited register as trademarks. Suppose that moving image marks can be registered under section 4, anyway, there is a problem for moving image marks registration. Due to the characteristics of moving image marks that are movable signs, therefore, how moving image marks be represented for registration. Moreover, there maybe problem of applying moving image marks as trademarks due to the purpose of trademark that is uses to identify its origin and also to differentiate its proprietor from others. Hence, trademark shall be connected with its products or services, whilst moving image marks are movable signs so how moving image marks be connected to their products or services. As aforesaid, the Trademark Act B.E. 2534 (A.D. 1991) should protect cover to moving image marks, eve though, there are many problems in order to register moving image marks under the Thai trademark law. In order to register moving image marks in Thailand, we have to consider by comparing with the countries that moving image marks are registered and take the most effective method to adapt with Thai trademark law.

Chapter 5

Conclusion and Recommendations

A. Conclusion

Noticeably, trademark has been developed to be satisfying to consumers. It begins with conventional trademarks and then move toward to non-conventional trademarks in which do not fall into the definition of conventional trademarks. In consequent, non-conventional trademarks are now more established. The new creation of marks involves an enhancement of trademark. The proprietors or owners of goods and services absolutely want their products and services to be well-known to consumers so they invented new design of marks to be recognized and different from another in the market place. As a result, consumers are likely to welcome new products and services using innovative design or advanced technology. Ultimately, non-conventional trademarks become more affect to trademark's evolution due to the characteristics of non-conventional trademarks that are remarkable and having different form of the pre-existing conventional trademarks. Consequently, many countries and international organisation have amended their trademark laws to support the new form of trademarks.

At present, Thailand has been used Trademark Act B.E. 2534 (A.D.1991) as amended by Trademark Act (No.2) B.E. 2543 (A.D.2000). Thailand became a member of TRIPS in A.D.1995 so that Thailand revised the trademark law for up to the TRIPS' standard because of TRIPS imposes a minimum standard for its Contracting States. However, TRIPS sets up the definition of trademark as broadly. For moving image marks are not stated in the TRIPS nevertheless, moving image marks can register as trademarks under the TRIPS if such moving image marks are eligible to the standard.

Meanwhile, Thailand's Trademark Act B.E. 2534 (A.D.1991) dose not cover to moving image marks even though the Act was revised by extending the definition cover to phrases, color combinations and shape or configuration of goods. Therefore, moving image marks are still not being protected under the Trademark Act B.E. 2534 (A.D.1991). This problem may cause of moving image marks protection that they

cannot register in Thailand whilst many countries such as United Kingdom, Germany, the United States and Singapore including the European Union already accepted to register moving image as trademarks. This response of the said countries can prove that moving image marks are more affect to the development of trademark because the characteristics of moving image marks that are motion marks. Hence, the said countries permit for moving image marks registration to protect the right of their owners and to be with a social's enlargement. As a result that the Thai trademark law does not cover to moving image marks likely to other counties therefore, the Thai trademark law will lower to an international standard and it may affect to our international commerce.

In the case that Thailand gives a protection for moving image as trademark consequently, there are some problems that are said in the former chapter. In this chapter, the researcher will recommend methods to solve the problems by comparing with trademark laws of European Union, United Kingdom, Germany, the United States and Singapore. Then, we will take the most effective method that is suitable for adapting with the Thai trademark law.

B. Recommendations

As if Thailand amended the provision of Trademark Act A.D.1991 as amended by the Trademark Act No.2 B.E. 2543 (A.D. 2000) by extending the protection to moving image marks. There may be some problems as the researcher said in the previous chapter. For this chapter, there are some recommendations to express the researcher's opinion about these problems.

1. To Find a Solution on the Problem of Moving Image as Trademarks under the Trademark Act B.E. 2534 (A.D. 1991)

As considered the definition of mark according to section 4 under the Trademark Act B.E. 2534 (A.D. 1991) that gives the meaning of a registrable mark merely defined in section 4. Subject to section 4, mark is limited only a photograph, drawing, invented picture, brand, name, word text, letter, numeral, signature, group of colors, shape or three-dimensional object, or any combination of these items. Consequently, moving image marks are not included in the meaning under section 4

therefore, they are not mark according to the meaning of a mark under the Trademark Act B.E. 2534 (A.D. 1991). As a result, statuses of moving image marks are not accepted as trademarks under the Thai trademark law. At the same time, the countries that accept for moving image marks registration, they generally enact their trademark laws as broadly by just giving the samples of the registrable marks. In consequent, other marks can be registered under their trademark laws if such other marks are eligible for trademark registration. As we considered the characteristics of moving image marks concerning to section 6, moving image mark are also eligible as trademarks because they easily catch up character of distinctiveness in which is the main element of trademark. Besides, moving image marks shall approach to the other elements subject to section 6 likely a general consideration of trademark registration. Thus, Thailand should give moving image marks the protection as trademarks if they are qualified as trademark. In order to register moving image marks, the Thai trademark law should define widely for a registrable mark. In this case, Thai trademark law may adapt the United Kingdom trademark law by using the word “any sign” instead of “means” due to the UK Trade Mark 1994 Act is the clearest provision that should be adapted to Thai trademark law. This amendment of Thai trademark law will expand endlessly the definition of a registrable mark.

As compared between advantages and disadvantages of giving moving image marks protection, the reader can see that there are more benefits if moving image marks are accepted for registration. Therefore, the researcher thinks that the Thai trademark law shall accept moving image marks to be registered in Thailand.

2. To Find a Solution on the Problem of Moving Image Marks Registration under the Trademark Act B.E. 2534 (A.D. 1991)

As considered the Trademark Act B.E. 2534 (A.D. 1991), moving image marks are not belong to registrable marks according to section 4. Consequently, moving image marks cannot register as trademarks under the Trademark Act B.E. 2534 (A.D. 1991). Suppose that moving image mark are registrable marks according to section 4 and section 6, as we considered their characteristics and function, then we shall consider the registration of moving image marks. As considered section 11 of the Trademark Act B.E. 2534 (A.D. 1991) that imposes a process for trademark application. Subject to section 11, an applicant of a trademark shall be processes

according to the regulations prescribed by the Ministerial Regulations. Anyway, the regulations are now used for marks that are immovable marks; therefore, they might be not suitable for moving image marks. In this case, United Kingdom and Singapore impose condition for trademark application that mark shall represent graphically. Meanwhile, Germany and the United States set a condition of represented graphically in the regulations for trademark registration. Nevertheless, the Thai Trademark Act B.E. 2534 (A.D. 1991) should impose clearly a condition of represented graphically in the Act alike with the Act of United Kingdom and Singapore.

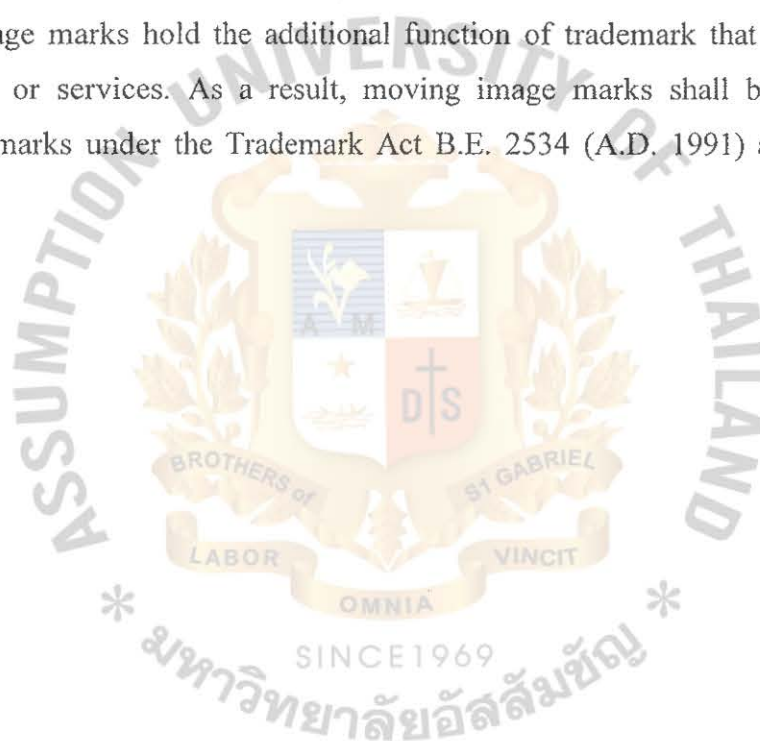
As to the aforesaid recommendation, the problems of giving moving image marks protection can simply solve by adding of mark's definition in section 4 to cover moving image marks as registrable marks. For example, a "mark" means a photograph, drawing..., or any combination of these items and also includes a movable or immovable mark. Otherwise, we may revise section 4 by using the word 'may consist of' instead the word 'means' in the term mark's definition. This amendment can expand the definition of a registrable mark therefore, it is not even moving image marks that can register as trademarks, and the other non-conventional marks may be considered for trademark registration. However, to amend the definition of mark under section 4 of the Trademark Act B.E. 2534 (A.D. 1991) to include moving image as a registrable mark is the best method that shall be used for solving the problems of moving image marks registration.

Furthermore, the researcher recommends the Thai trademark law to adapt the United Kingdom trademark law because the Trade Marks Act 1994 of the United Kingdom is the most precisely and it also supports any mark to be considered for trademark registration.

3. To Recommend the Means to Solve the Problem of Applying Moving Image Marks as Trademarks

According to the purpose of trademark law, the researcher think that Thai trademark law need to set the use of trademark as a condition of trademark registration. This is to maintain benefit of bona fide applicants who intend to use trademarks connection with their products or services, additionally, to prevent some applicants with bad faith of keeping the right in trademarks; in fact, there is no use in such trademarks. After that, the researcher considers on the problem of using moving

image as trademark. Due to moving image marks are marks that are movable signs, so that, how can use moving image marks in connection with their products or services. Related to the definition of 'trademark' according to section 4 of the Trademark Act B.E. 2534 (A.D. 1991), trademark means mark used, or purpose to be used on or in connection with goods of the proprietor of such trademark. Anyway, this problem shall resolve by concerning with the actual function of trademark that is used to indicate source of its product or service. Thus, whenever moving image marks can hold the function of trademark that is to differentiate the products or services of their owners from others and being recognized in the consumers' mind. Furthermore, moving image marks hold the additional function of trademark that is to advertise their goods or services. As a result, moving image marks shall be deemed the registrable marks under the Trademark Act B.E. 2534 (A.D. 1991) as amended by No.2.



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