

Multi-Class Application Revisited

With the effect as from July 28, 2016, the Thai Trademarks Act was amended to allow a multi-class application. This made it more convenient and cost-efficient for an applicant, especially that with a wide range of goods and services, to apply for protection here. At that time, however, it was unclear how the multi-class application would be handled by the Department of Intellectual Property. As more than a year has passed, some multi-class applications have been examined and some issues have become clearer as follows:

- **Rejection**

When rejecting a multi-class application on the grounds of either non-distinctiveness or similarity, the examiner usually does not indicate to which classes the rejection applies. This suggests that the rejection applies to all classes. Unless the applicant responds to such rejection, the entire application will be deemed abandoned. Likewise, if the examiner rejects descriptions of goods and services in some classes and the applicant fails to amend the rejected descriptions, the application will be rejected for all classes even though the descriptions in other classes are acceptable.

In some cases, the applicant may discuss with the examiner for clarification as to which classes are rejected. It may also be possible to overcome the rejection by deleting the rejected classes and have the applications proceeded with the remaining classes. This nonetheless would subject largely to each examiner's discretion.

- **Appeal**

If the mark is rejected in some classes and the applicant appeals, the whole application will be held in abeyance for the appeal decision. It is not possible to divide the application in order to appeal in the rejected classes and have the other classes progress further. This would inevitably and unnecessarily delay the registration process for the non-rejected classes. The applicant will have to choose either to delete the rejected classes to have other classes proceed or to file an appeal, which will delay the registration process for all classes.

- **Advertisement**

If found registrable in relation to all classes, the application will be advertised. Each class will be separately published on a different page of the Trade Mark Journal. Under this practice, it would be necessary for an opposer to ensure that the opposition is sufficiently filed against all relevant classes. In case of an opposition, the entire application will be held in abeyance for the opposition result even when the opposition does not apply to all classes.

Though being more efficient to file, a multi-class application may result in less flexibility for the applicant in dealing with rejection. In case of foreseeable rejection, it may be a better option to file single class applications.