**REGISTRATION OF GEOGRAPHICAL NAMES**

by Pannapa Rittinaphakorn

Trademark owners frequently choose to include a geographical name in their marks because it effectively draws public attention and is easy to remember. Under the current Thai practice, however, the Registrar will strictly enforce the legal provisions prohibiting registration of a geographical name as a trademark. The restrictions on geographical names are extremely onerous, and the successful registration of such names is therefore quite difficult. For trademark owners, only two exceptions to this practice remain.

In proscribing the registration of geographical names, Section 7(2) of the Trademark Act B.E. 2534 (1991), amended by the Trademark Act (No. 2) B.E. 2543 (2000), defines a distinctive trademark as “a word or phrase that has no direct reference to the character or quality of the goods and is not a geographical name according to the prescription of the Minister” (emphasis added). The Notification of the Ministry of Commerce B.E. 2535 (1992) regarding the Prescription of Geographic Names adds that “The following geographic names shall be regarded as geographic names under Section 7(2) of the Trademark Act:

1) Name of country, name of group of countries, name of region, or self-governing dominion which is of the same description of a country;
2) Name of county, state, or precinct;
3) Name of capital city, port, province, or special form of local administrative area;
4) Name of continent;
5) Name of ocean, sea, gulf, peninsula, cape, island, archipelago, or lake;
6) Other geographic names widely known by the public, for example,

mountain, river, district, sub-district, village, road, etc.

The above geographic names shall mean to include abbreviations, former names, or names called generally, without limitation to the names used in the regulation.”

This regulation clearly casts a rather wide net in defining geographical names, as everything from continents to roads is included. For example, the Registrar required the disclaimer of the word “Macquarie” in the service mark “MACQUARIE & Device,” on the basis that

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**WELL-KNOWN MARKS** *(from page 1)*

Clearly, a great deal of information and documents are required for submission along with the application for well-known mark. This is a time-consuming process. It is important that the trademark owner prepare the affidavit and supporting documents before filing the application. Otherwise, it may not be possible to collect sufficient supporting evidence by the required deadline for submission, which is 60 days from the filing date. This might result in dismissal of the application because of insufficient supporting evidence.

**Recordation Process**

The Board of Well-Known Marks is the responsible body for the recordation of well-known marks. This Board consists of ten Trademark Registrars, and the Director of the Trademark Office acts as its Chairman.

In considering the possibility of recordation, the Board will examine the application and supporting evidence. If the Board considers that the supporting evidence is insufficient to prove that the applied mark is well known, as required by the regulation, the Board will reject the application. The applicant will then be entitled to file an appeal petition to the Director General of the DIP within 60 days. If an unfavorable decision is rendered by the Director General, the application will be deemed abandoned.

If, on the other hand, the Board considers that the applied mark has successfully been proven to be well known among Thai consumers, the applied mark will be recorded as a well-known mark.

There is no government fee for filing the application. It will take about 6 months to complete the recordation of the well-known mark.

**Benefits of Recordation**

There are two primary benefits resulting from the recordation of well-known marks. First, the Registrar will rely upon the Register of Well-Known Marks when considering new trademark applications. This should ensure that the Registrar will not allow the publication of marks that are confusingly similar to a well-known mark in any class. Second, the owner of a recorded well-known mark does not need to prove that the mark is a well-known mark when the mark is:

- Used as the basis of a cancellation action according to Section 61 of the Trademark Act 2000;
- Used as a reference in an opposition filed against a third party’s mark;
- Used as a reference to support an appeal petition to the Board of Trademarks against the Registrar’s refusal decision in relation to (a) non-distinctiveness of similar marks owned by the same owner or (b) similarity to another owner’s registered mark.

In other words, well-known trademark recordation provides irrefutable evidence of the fame of the mark, which can provide an extremely valuable basis for a large number of actions that prevent the dilution of a mark.

In sum, the recordation system that was created in 2005 has led to a significantly improved process for establishing the well-known status of a mark. This presents numerous benefits for the owner of a well-known mark, as the recordation with the Board of Well-Known Marks can be relied upon in defending and expanding a famous brand. The key to successfully pursuing this type of recordation is the trademark owner’s ability to present significant evidence demonstrating the fame of the mark. To this end, Tilleke & Gibbins has carefully crafted a specific affidavit that is tailored to the requirements and expectations of the Board of Well-Known Marks. This affidavit, accompanied by the requisite supporting evidence, has proven to be very successful in ensuring a smooth recordation process. Clients who wish to obtain the suggested form of the affidavit may contact Darani Vachanavuttivong at darani.v@tillekeandgibbins.com.


**CARABAO** and **RED BULL** Unlock Horns

by Somboon Earterasarun

Frederick W. Mostert and Lawrence E. Apolzon, the authors of *From Edison to iPod: Protect Your Ideas and Make Money*, quote the following words of wisdom from Frederick’s father:

“When your client is looking for blood, settlement seems tame. But always, always try to settle first. Only if you’ve tried everything reasonable to settle out of court and failed, do you take off the gloves. And then: to battle.”

This philosophy is illustrative of the approach employed by Carabao Tawandang Company Limited in its cases against Red Bull Gmbh on the use and registration of the marks “Carabao & Device” and “Red Carabao & Device” with respect to “energy drinks products.”

Carabao Tawandang Company Limited (hereinafter referred to as “Carabao”) was established in Thailand in 2001, and it has rapidly become one of the top three energy drink beverages manufacturers locally, where the industry’s volume is well over Baht 15 billion (approx. US$470 million) a year. Carabao launched a range of energy drink products in Thailand in 2002 under the brand “Carabao Daeng” or “Red Carabao” with a figurative element made up of a horned buffalo skull on a predominantly red circular background. This buffalo design was originated by a famous Thai rock band, which has been in existence for more than 25 years. The band members also hold 50% stake in the company. The products were later distributed on a global basis.

After an enormous welcome in the local market, Carabao applied for registration of both the marks “Red Carabao & Device” as well as “Carabao & Device” as shown above in more than 100 countries worldwide, including the major European, American, and Asian energy drinks markets.

Most of the trademark applications were approved by the Examiners in each country, but these applications encountered oppositions/cancellations by

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**Geographical Names (from page 3)**

“Macquarie” is the name of a river in Australia. A disclaimer was similarly required for the word “Soria,” which is the name of a city and a province in Spain, in order to permit the registration of the trademark “Santagostino Baglio Soria.” These examples demonstrate the strictness with which the Thai Registrar is inclined to apply the prohibition on geographical names.

When applicants have challenged these disclaimer requirements, the Board of Trademarks has ruled that in order for a geographical name to be registrable, it must not be a well-known geographical name, especially among the Thai public. Decision Nos. 1493/2549 and 1494/2549 for the trademark “FORTH&TOWNE” effectively illustrate this practice. Forth & Towne (ITM) INC., an American company, filed two slightly different applications for the trademark “FORTH&TOWNE,”

Application Nos. 590655 and 593618, in Class 25. The Trademark Registrar ordered the applicant to dismiss the right to use the word “FORTH” because it is the name of a river located in southern Scotland. The applicant filed an appeal petition with

the Board of Trademarks seeking to overturn the Trademark Registrar’s order, based on the argument that the word “FORTH” is inherently distinctive. After examination of the appeal and evidence, the Board of Trademarks decided that despite the fact that the New English-Thai Dictionary written by Dr. Vith Thienbooranthum defines “FORTH” as the name of a river in southern Scotland, this geographical name is not well-known in Thailand. Consequently, the word “FORTH” cannot be considered a geographical name and the trademark “FORTH&TOWNE” was accepted as an inherently distinctive mark.

Trademark owners, however, may not wish to be limited to the registration of largely unknown geographical names. The second exception which permits the registration of geographical names is provided in Section 7 Paragraph 3 of the Trademark Act. This section provides that an otherwise non-distinctive trademark may be deemed to be distinctive if it can be proven that the mark has gained recognition among the public through extensive use. If applicants can prove that they have widely distributed and/or advertised the goods under their marks for a long time, to the extent that Thai consumers are familiar with them and can distinguish them from those of others, their marks may be registrable. This provides an alternative avenue through which a mark that employs a geographical name may achieve registration as a trademark in Thailand. Evidence which can be submitted in order to prove the use of a trademark includes invoices, brochures, leaflets, sales expenditures, advertising expenditures, annual reports, advertisements in various media, etc. Examples of marks comprising a geographical name that have successfully achieved registration based on wide use include “The New York Times” in Class 16 and “WHITTARD OF CHELSEA” in Class 30.

In sum, the registration of geographical names as trademarks is generally not permissible in Thailand, and the Registrar tends to be rather strict in enforcing this policy. Nevertheless, trademark owners have some degree of flexibility in seeking possible options for registration of marks that include geographical names. •

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