

THE LEGAL PROBLEM OF 'TRADE DRESS' UNDER TRADEMARK ACT

Thai courts have yet to determine whether “trade dress”, or the look and feel of a product’s packaging or presentation, should be legally protected under the Thai Trademark Act of 1991. In fact, despite its importance for consumers the subject rarely arises.

This stands in contrast to the ongoing legal debate surrounding conventional trademark issues such as trademark similarity or the registrability of three-dimensional trademarks, sounds or smells. (The latter two have not yet been authorised for registration.)

To understand the complexity of the issue, let us briefly examine it from an intellectual property (IP) standpoint. “Trade dress” is a legal term describing the distinctive characteristics of a product’s packaging or presentation, allowing the public to recognise goods as belonging to a particular owner. Trade dress protection should generally be considered separately from protection of traditional trademarks, which involve certain symbols, marks, logos, trade names and service and other marks already protected by the Trademark Act.

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The crucial distinction between a trademark and trade dress is the latter offers more expansive protection, covering a combination of elements such as the total packaging design.

Legal protection for trade dress helps to prevent consumers from accidentally buying an imitator’s product due its appearance being confusingly similar. Pharmaceuticals in derivative packaging containing dissimilar or substandard ingredients are of particular concern. Christopher Raymond of the Kenan Institute Asia observed that poor-quality medicines in misleading packaging can exacerbate infectious diseases with consequences for rich and poor alike, especially in the face of a global pandemic.

Countries like the US, the UK and

India have proper legislation in place to protect the trade dress, design or appearance of products. The dark brown rectangle and silver lettering of the Hershey’s chocolate bar and the yellow and red packaging of Kodak film products are two notable examples of trade dress protected by the Lanham Act, a US federal statute regulating trade dress and ordinary trademarks. A trade dress owner is protected by law even without registering its trade dress with the US Patent and Trademark Office.

In the UK, trade dress protection cases typically find support in case law and the Trademark Act of 1994, which prohibits “passing off” to protect trademarks, whether registered or not, against imitation.

As Thai lawmakers have yet to provide specific protection in this area, trade dress owners are left with the passing-off provision of Section 46 of the Trademark Act, which allows the proprietor of an unregistered trademark “to institute a Court case against any person for passing off goods as those of the proprietor”. However, because

Thailand is a civil law country, Thai judges do not look to the substantial body of case law available to their common law colleagues. This limits the scope of how passing off is interpreted, weakening Section 46. Furthermore, the bad faith of trade dress imitators is not even a factor as long as there is no clear violation of trademark law.

It is very difficult for owners to win a trade dress case in Thailand, and even less likely to recoup lost profits or damages. Stakeholders must work together to prevent this country from becoming a haven for those wishing to profit from imitative products that tarnish the originator’s reputation and increase enforcement challenges. Specific trade dress legislation must be introduced, while interpretations of “passing off” must be broadened.

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