



International Litigation—Asia

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Trademark Similarity Consideration in Thailand

In considering the similarity of trademarks in both the registration process and during litigation, courts in many jurisdictions forbid dividing the elements of each mark to compare them separately and insist that the trademarks must be compared by considering all elements of the trademarks as a whole. The reason underlying this legal principle is that consumers are not likely to recognize all of a trademark's separate details or elements. Scholars in the field of trademark law refer to this principle as the "Anti-Dissection Rule."

Apart from the application of this principle, from the observations of writers on the legal principles and practices of the courts and trademark offices of other countries, determining the similarity of a trademark applied for registration with prior registered trademarks should not involve the trademarks themselves solely but also should take into account the following factors.

1. *The goods for which the trademark is applied*—If a trademark applied for registration is identical to a registered trademark and the goods for which the trademark is applied are the same or related, the courts and trademark offices in many countries would consider that such a trademark cannot be registered. Similarly, a trademark cannot be registered if it is closely similar to a registered trademark and used for the

same goods as those of the registered trademark, as it could cause confusion among the public. However, the question remains regarding whether a trademark can be registered if it is only similar to a registered trademark and the goods for which it is applied are simply related to, not exactly the same as, those of the registered trademark. The subsequent factors shall provide an answer to this question.

2. *Distribution channels*—Distribution channels are another factor as they could differ between goods under the same class. For instance, food for livestock and for aquatic animals may fall under the same class of goods; however, as these products are distributed differently, public confusion about their origin is less likely to occur.
3. *Price of the product*—As consumers use greater care in selecting highly priced products, consumer confusion about such products under an applied or registered trademark, or both, would be reduced.
4. *Consumer awareness*—Consumer awareness shall be brought into consideration if the goods for which the trademark is applied are intended for use by a specific demographic. For example, if the item of goods for which the trademark is applied is a medical product and only medical doctors use this product, the chance that doctors will be confused as to the owner or origin of the product is low as doctors are specialists with specific

knowledge about a variety of similar products.

5. *Intention of the applicant*—Whether the applicant has applied for registration of a trademark similar to a registered trademark in bad faith is another factor commonly considered by courts and trademark offices. If the application is filed in bad faith, the intention of the applicant typically is regarded as creating a high possibility that the public will be confused as to origin and ownership.
6. *Reputation of the trademark*—If a registered trademark is considered well known, its scope of protection widens. Even when a trademark that has applied for registration is not identical to a well-known trademark, the possibility that the public could be confused remains high. On the contrary, if the registered trademark has never been used or is not recognized as a well-known trademark, the scope of protection of such trademark shall be limited to a narrower extent than the well-known trademark because the chance that the consumers will be confused as to the origin of the products bearing the trademarks is rather low.
7. *The actual use of the trademark*—The use of the trademark in commerce also is taken into account by courts and trademark offices. For example, if the trademark attached to the product is displayed in a small size, it would be difficult for the consumers to distinguish the products under the mark from other products; therefore, the chance that the consumers will be confused as to the origin of the products is high.
8. *Acquiescence in enforcing trademark right*—If a trademark that is sought for registration is similar to a registered trademark but the owner of the registered

trademark ignores or consents to the use of the similar trademark by its owner for an extended period of time without enforcing his rights to prevent the use of the similar trademark, courts in many countries deem that the owner of the registered trademark has been lax in exercising his rights. Therefore, under the "Doctrine of Acquiescence," the owner of the registered trademark cannot impede the use or registration of the similar trademark.

It is important to note that the consideration of similarity as described above is limited to the consideration of a trademark that is identical or similar to a registered trademark and that is used or intended for use with the same or related goods. Although these factors may still be considered when evaluating trademark applications that are identical or similar to a well-known trademark, it must be noted that protection of the well-known trademark shall not be limited only to the goods for which it is registered or related goods. Therefore, a trademark identical or similar to a well-known trademark may not be registrable regardless of the goods covered by the application.

In Thailand, the lack of a clear Anti-Dissection Rule in the Trademark Act 1991 hampers the consideration of trademark similarity. Only a brief reference in Section 17 of the Act indicates that, in considering the ability to register a trademark, the trademark must be considered as a whole. However, Thai Trademark Registrars and other officials on the Board of Trademarks seem to be of the opinion that this wording does not explicitly prohibit considering each element of a trademark separately. In practice, the Thai Trademark Registrar and the Board of Trademarks always have divided the elements of the trademark applied

for registration and have compared each part separately with the registered trademarks. Consequently, a considerable number of cases filed to the Central Intellectual Property and International Trade Court each year seek to overturn the Registrar's and the Board's decisions.

Unlike the Trademark Registrar and the Board of Trademarks, the Supreme Court accepts and applies the Anti-Dissection Rule to the consideration of trademark similarity. For instance, in the case *Cement Michelin LC v. Siamese Tire Co., Ltd.* [Supreme Court Judgment No. 10657/2546] the Supreme Court held:

In considering whether a trademark is similar to another trademark in order to determine the trademark infringement issue or registrability issue, we must look at the trademark as a whole, the essential elements, pronunciation, as well the use of the mark with the product. These factors must be considered so as to determine the main issue of whether there is any cause that could lead to confusion among the public as to the owner of the trademark.

Apart from the application of the Anti-Dissection Rule, the Thai Court also considers the similarity of trademarks by looking at the other factors discussed above. In *Parfums Christian Dior v. Department of Intellectual Property et. al.*, [Supreme Court Judgment No. 1793/2549] the Court also considered the punctiliousness of consumers in selecting a product and the price of the product. In this case, the plaintiff's registered trademark HIGHER and the defendant's applied trademark HI-ER (consisting of HI-ER in its Thai transliteration, followed by HI-ER in Roman letters) were identical in pronunciation and were used for the same class of goods. Nevertheless, when

considering other factors such as the distribution channels, product quality, and price of the plaintiff's product, the defendant's product was deemed different from the plaintiff's product. Therefore, the Court ruled that it was unlikely that the public would be confused as to the owner or origin of the product and permitted registration of the mark HI-ER.

Another example of the factors considered by the Court is provided in *Ho Pa Corporation Limited v. Sataporn Marketing Co., Ltd.* [Supreme Court Judgment No. 3203/2549]. In this case, the main product of the plaintiff was balsam and the product of the defendant was mosquito repellent. Despite this difference, the Court held that the defendant's applied word mark TIGER in its Thai transliteration betrayed the defendant's bad-faith intent to copy the plaintiff's trademark, which consisted of a tiger device, the word TIGER in its Thai transliteration, and the word TIGER in Roman letters. The Court found the marks sufficiently similar that they could cause confusion among the public as to the origin of the product or the owner of the mark, and the Court thus refused to register the defendant's mark.

In general, while it is certain that the Supreme Court of Thailand applies the Anti-dissection Rule, the Thai trademark regime lacks consistency in applying this principle. While the Court upholds the rule and looks at other factors in considering the similarity of trademarks as well as the chance that the public will be confused as to the owner or origin of the product, the Trademark Registrars and the Board of Trademarks have as yet failed to set up a standard or guideline for considering trademark similarity that reflects the widely shared acceptance of the Anti-Dissection Rule. Unnecessary litigation and lost opportunities for trademark owners to protect their trademark rights have been the unfortunate consequences.

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