

# World Trademark Review *Daily*

**Supreme Court prohibits use of copycat packaging  
Thailand - Tilleke & Gibbins International Ltd**

**Passing off**

February 18 2011

In *Schneider Electric Industries SAS v Thai Bumroong Electric Co Ltd* (Case 2335/2553, January 24 2011), the Supreme Court of Thailand has affirmed a decision of the Central Intellectual Property and International Trade Court (IP & IT Court) and ordered the defendant to refrain from passing off its product as that of the plaintiff.

French company [Schneider Electric Industries SAS](#) brought an action against Thai Bumroong Electric Co Ltd (TBE), a local company, before the IP & IT Court. Schneider alleged infringement of its rights in:

- the packaging and product design of a circuit breaker incorporating the trademark EASYPACT and an orange-themed design; and
- the slogan "It's so easy and simple!".

The IP & IT Court ordered TBE to stop using packaging and product descriptions that were similar to those used by Schneider. The court found that TBE sought to pass off its product as that of Schneider based on the following facts and elements:

- TBE's packaging was similar to that of Schneider - that is, TBE's packaging had a similar shape, colour, layout, content (EASYPACT v EASYSET), slogan ("It's so easy and simple!") and pictures;
- TBE used similar labels (ie, similar description of the product quantity, voltage current, models, amount of poles, product ID, product descriptions and product certificates); and
- TBE's product was similar to Schneider's (ie, similar size, design, colours, words and content).

Based on these facts, the IP & IT Court concluded that TBE intended to imitate Schneider's product. Therefore, the court ordered TBE to:

- stop passing off its product as that of Schneider; and
- pay compensation in the amount of Bt100,000 per month (from the date on which the complaint was filed to the date on which TBE stopped using the product at issue).

TBE appealed to the Supreme Court.

The Supreme Court agreed with the IP & IT Court that:

- TBE's mark EASYSET was similar to Schneider's EASYPACT mark; and
- TBE's packaging was confusingly similar to Schneider's, which could mislead the public into believing that TBE's product originated from Schneider.

However, the Supreme Court opined that the motto "It's so easy and simple" was, in itself, a common phrase and, therefore, could not be protected as a trademark. The Supreme Court thus revised the part of the IP & IT Court's judgment that ordered TBE to stop using the words "It's so easy and simple" in a way which could mislead the public.

The Supreme Court's decision is significant in that it acknowledges that one may rely on a claim for passing off to protect an unregistered packaging design.

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