

World Trademark Report

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Tilleke & Gibbins International Ltd

Application enters [COMFORT ZONE] following opposition

In *Davines SpA v Department of Intellectual Property* (Red Case IP 56/2550, June 28 2007), the Intellectual Property and International Trade Court (IP & IT Court) has overturned an earlier decision and has allowed the registration of the trademark [COMFORT ZONE].

In 2001 *Davines SpA*, an Italian company, filed a trademark application for registration of the mark [COMFORT ZONE] for goods in Class 3 of the *Nice Classification*, covering, among other things, skin care creams, oils for the face, lotions, hair gels, make-up removing preparations, make-up powder, perfumes, shampoos, soaps and shaving gels.

Unilever NV, a Dutch company, filed an opposition stating that the trademark [COMFORT ZONE] is confusingly similar to its registered trademark COMFORT, which is also registered for various goods in Class 3, as well as other registered trademarks that include the word 'COMFORT'. The registrar dismissed Unilever's opposition. Unilever then filed an appeal with the Board of Trademarks, arguing the same grounds. The board agreed with Unilever's allegation and refused Davines's application. It stated that the trademark [COMFORT ZONE] is confusingly similar to the registered trademark COMFORT both in appearance and pronunciation.

Davines filed a civil suit with the IP & IT Court in an attempt to overturn the board's decision. It claimed that the trademark [COMFORT ZONE] is distinctive and, thus, not confusingly similar to the registered trademark COMFORT. Davines provided the court with certificates of registration for the mark [COMFORT ZONE] from other countries and samples of the two parties' products bearing the marks to demonstrate the actual use of the trademarks in the market.

The IP & IT Court ruled that although both marks consist of the word 'COMFORT', Davines's mark is not confusingly similar to Unilever's registered mark for the following reasons:

- Davines's trademark includes the word 'ZONE' and '[]' device.
- The letters used in both marks are different because Davines uses all lower case letters, while Unilever uses all upper case letters.
- The pronunciation of each mark differs.

The court also ruled that the trademark [COMFORT ZONE] is an arbitrary and fanciful word, which is inherently distinctive under the Thai Trademark Act. As a consequence, the IP & IT Court cancelled the board's decision and allowed registration.

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