

Thailand

The Thai Supreme (Dika) Court affirmed the Central Intellectual Property and International Trade Court's (IP&IT Court's) ruling and withdrew the decisions of the Trademark Registrar and the Board of Trademarks rejecting the trademark application for ZYSTAR filed by the plaintiff, Glaxo Group Limited (Glaxo).

In 2001, Glaxo filed with the Department of Intellectual Property (DIP) an application for registration of its ZYSTAR trademark, to cover "pharmaceutical preparations and substances for the treatment/prevention of alopecia" in Class 5.⁴⁶⁴ The Trademark Registrar rejected the application, finding that the mark was confusingly similar to the prior-registered trademark ZYTAR, covering "anti-bacterial substances for veterinary use," owned by Dimminaco AG.⁴⁶⁵ On Glaxo's appeal, the Board of Trademarks confirmed the Registrar's decision, reasoning that the appearance and pronunciation of the trademarks ZYSTAR and ZYTAR were closely similar and that registration of ZYSTAR would confuse or deceive the public as to the proprietor or the origin of the goods. Therefore, according to Section 13 of the Thai Trademark Act,⁴⁶⁶ the trademark ZYSTAR could not be accepted for registration.

Glaxo then filed a complaint against the DIP with the IP&IT Court. It argued that the applied-for mark ZYSTAR was not similar to the trademark ZYTAR in terms of both appearance and pronunciation, and that its registration would not confuse or deceive consumers as to the proprietor or the origin of the goods.

The IP&IT Court found in favor of the plaintiff. It overturned the decisions of the Registrar and the Board of Trademarks and ordered that the Registrar proceed with the registration of the trademark ZYSTAR by limiting the specification of goods to "pharmaceutical preparations and substances for the treatment/prevention of alopecia" in Class 5. The DIP appealed to the Dika Court.

After comparing the letters and pronunciation of the marks, the Dika Court held that the marks at issue were

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similar. However, it found that even though the goods to be covered by Glaxo's mark ZYSTAR were in Class 5, similar to those covered by the prior-registered trademark ZYTAR, and that both products were drugs, the categories of the products were different: The goods to be covered by the applied-for mark were pharmaceutical preparations and substances for the treatment or prevention of alopecia (baldness), while those covered under the prior-registered trademark were antibacterial substances for veterinary use. Also, according to Glaxo's witness testimony, the two categories of drugs are purchased from different places: drugs for humans are bought from hospitals or pharmacies and must be prescribed by physicians, whereas drugs for animals are bought from animal hospitals or animal clinics and are prescribed by veterinarians. The same witness further testified that Glaxo's drugs were not household remedies and consumers would not be able to purchase those specific products without a prescription or a pharmacist's recommendation.

The Dika Court found that Glaxo's witness was more convincing than the DIP's witnesses, among them being the Trademark Registrar, a member of the Board of Trademarks, and a legal officer. It ruled that the applied-for mark ZYSTAR would not cause confusion among the public as to the proprietor or the origin of the goods. Glaxo's mark was, therefore, registrable.⁴⁶⁷