

THAILAND

Emoticon Trademarks: Challenging Distinctiveness Criteria

:) :P :( :D :-O

As you certainly know, these symbols are not a basic series of punctuation marks and letters. They are emoticons, a portmanteau word composed of emotion and icon, signifying those iconic typographical manifestations of various emotions. Prevalently used for a decade in e-mails and text messages due to their expressive brevity, emoticons are now employed by businesses seeking to capture the attention of Gen Y, or the Net Generation, and to trademark them for commercial purposes.

In December 2008, the Russian Patent Office (Rospatent) allowed Superfone, a mobile advertising company, registrations for a wink emoticon ;-)) with advertising, communication, and broadcasting services. Reportedly, the registrant confirmed that he would not take any legal actions against general users but also cautioned that local companies using his registered emoticon and/or similar ones with his designated services for brand identification would face the risk of being sued unless they obtained licenses from him. Rospatent's approval of this generic emoticon has generated a great deal of public criticism.

Prior to the registration of the wink emoticon in Russia, the United States Patent and Trademark Office (USPTO) allowed a number of registrations of pure emoticon trademarks, the very first of which has been registered since 1998. Some examples:

:-) for printed matter, clothing, and online ordering services

:D for computer peripherals, calendars, wallets, cup holders, table linen, clothing, stuffed animals, etc

: ) for computer peripherals, postcards, backpacks, cup holders, table linen, stuffed animals, etc.

:-) for clothing

:) for alcoholic beverages, except beer

Recently, the USPTO granted the rights for the most basic emoticons :) and ;) to T-Mobile USA, a well-known mobile telephone provider. The applications for these marks covering cellular phones were unopposed during the publication period and Notices of Allowance were issued in February 2010.

Similarly, in Finland, the emoticons :-), :) , =), =(, and :( were trademarked in 2006 for different products and services.

In Thailand, there has been a continual increase among businesses in the use of emoticons as part of their customer base expansion strategy. For instance, a fast food business well known for its chicken has been using various emoticons [ 😊 ☺ ☹ ☹ ] collectively with its logo and individually on its menus and products. The set of emoticons + iconic Uncle/catchphrase as well as the emoticons + the iconic Uncle + 4-digit telephone number have successfully been trademarked for food and related services without any restrictions to surrender the rights to use such common signs.

The expansion of searches for marks containing emoticons divulges more than a few applicants gaining protection of their marks containing the basic emoticons :-), :) , and :P without any disclaimers, including the case of a Thai applicant registering a trademark comprising a phrase and the smiley emoticon :). Bearing his sole rights to the part :) in mind, he decided to have the pure :) trademarked for the sales of furniture, and it was successfully registered in 2006.

Many observers have questioned whether an emoticon in fact fulfills the function of a trademark. As the trademark offices in various countries, including Thailand, continuously allow such registrations, they seem to have concluded that emoticons are not a simple representation of a single sign or symbol in general but rather the combination of two or more characters to make up a device that serves to distinguish the origin of the goods and services.

Paradoxically, in online discussion forums and web boards, many internet users have balked at the monopoly of emoticons among businesses. For them, emoticons should be treated as generic and untrademarkable symbols, as they stem from the mingling of punctuation and alphabetical letters to form facial expressions. Having been in public use for over two decades, these symbols are restricted in their ability to indicate the commercial origin of goods in the mind of consumers and distinguish the goods from those of other companies. These internet users are concerned about legitimate proprietors of pure emoticon marks who may obstruct other persons from using them in



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their daily lives and even sue other applicants who seek to use them as parts of their marks.

As use of the internet, smart phones, and social networking continues to grow, it is no wonder the number of applicants interested in gaining protection of emoticon trademarks has proliferated. IP practitioners and trademark lawyers worldwide should relish the opportunity to witness and participate in future developments regarding emoticon trademarks.

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