

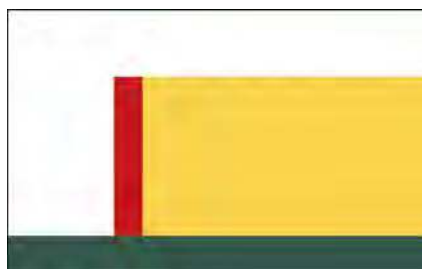
THAILAND

**Group of Colours Marks:
Standards for Determining
Distinctiveness**

A group of colours, the combination of two colours or more, form a kind of mark (group of colours mark) that can be registered under the Thai Trademark Act. Presently, there are few examples of group of colours marks registered in Thailand; few owners of such marks seek registration, and a number of applications have been rejected due to nondistinctiveness. Complicating matters is the lack of a standard by which a Registrar may consider the uniqueness of a group of colours mark. In addition, evidence showing that the same trademark has been accepted as sufficiently distinctive for registration in other countries is not persuasive evidence for Thai trademark authorities to reach the same conclusion. Thus, the distinctiveness issue is left solely to the discretion of the Registrar in charge of the application at hand.

A Distinctive Group of Colours

A recent Thailand Supreme Court decision could serve as a guide for determining the distinctiveness of a group of colours mark. In the case, Shell Brands International AG (Shell) applied for registration of a group of colours mark under Application No. 595727 for use with "grease; lubricants; engine oil; gasoline; diesel; industrial oil for the automobile industry; industrial oil for industrial manufacture" in International Class 4 in Thailand. The Registrar rejected the mark, citing nondistinctiveness. Shell appealed the Registrar's rejection to the Board of Trademarks, but the Board upheld the rejection, claiming that the applied group of colours mark was not represented in a special manner; the red, yellow, and gray strips were



**Shell Brands International AG's mark
in Application No. 595727**

displayed in a common combination, which is nondistinctive for registration.

Shell appealed the Board of Trademarks' decision to the Central Intellectual Property and International Trade Court (IP&IT Court). The IP&IT Court withdrew the Registrar's rejection and the Board of Trademarks' decision and instructed the Registrar to proceed with the registration. The Department of Intellectual Property, which has authority over the Registrar and the Board of Trademarks, did not agree and appealed the IP&IT Court's decision to the Supreme Court.

In Decision No. 2183-2184/2553, the Supreme Court considered the appeal and determined that the only issue before the Court was whether or not the applied group of colours mark was represented in a manner inherently distinctive for registration in that its appearance was unique enough to distinguish Shell's goods from others. The Supreme Court followed the IP&IT Court's prior reasoning that the applied group of colours mark is inherently distinctive for registration because the combination, in perspective, expressly shows the intention to place the longest, gray rectangular strip as a base and to place the shorter, red vertical rectangular strip on the gray rectangular strip base in a position left from the centre.

Visually, the length of the gray rectangular strip base from the leftmost side to the position of the red rectangular strip is shorter than the length of the gray rectangular strip base from the rightmost side to the position of the red rectangular strip. The yellow rectangle also abuts the vertical red rectangular strip, is equal in height to vertical red rectangular strip, and is equal in width to the length of the gray rectangular strip base from the red rectangular strip to the rightmost side. The applied group of colours mark is not merely a common, unrecognizable combination that the general public will understand as merely strips, lines, and geometrical frames that typically accompany pictures, are used as a frame for text, or are used as a part of picture or text in the packaging of products. On the contrary, the red and gray rectangular strips and the yellow rectangle are combined in a special manner. The use of the contrasting colours imbues a special characteristic in the applied mark and leads the general public to easily recognize and understand that this group of colours is a trademark functioning to distinguish Shell's goods



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from others. Consequently, the applied group of colours mark is inherently distinctive for registration according to the Thai Trademark Act.

**Lessons from the Supreme
Court of Thailand**

The Supreme Court's decision provides a sound process for determining the distinctiveness of a group of colours mark. Obviously, the combination of colours must be special and not commonly used in trade. Key determinants of indistinctiveness are arguably a common collection of colour strips, lines, and/or geometrical framing that the general public is accustomed to seeing in everyday combinations, such as with pictures, as a frame for text, or as a part of a picture or text in the packaging of products. Hopefully, this decision will create a standard for Registrars, to be used when considering the distinctiveness of a group of colours mark, and for applicants and trademark practitioners, to be used in drafting a description of a combination of colours.

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