

THAILAND

Registration of Bottle Shapes in Thailand

In seeking to develop a comprehensive portfolio of trademark rights, many companies have begun to look beyond their product names and logos. For at least the past decade, these businesses have been seeking trademark registration of other aspects of their overall branding strategies, including the packages they use for their products. One such forward-thinking business is The Coca-Cola Company, which has implemented a worldwide strategy to pursue three-dimensional registrations of its famous bottle designs. In Japan, for example, Coca-Cola was successful in winning a landmark decision from the High Court, which allowed the registration of its contour bottle as a three-dimensional trademark. In Thailand, two prominent Supreme Court decisions

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held that Coca-Cola was entitled to register two-dimensional images of its bottles as invented pictures under the Thai Trademark Act, but questions remain as to why three-dimensional trademark registration was not granted.

On October 3, 2000, Coca-Cola filed two applications for trademarks consisting of the shapes of its Coca-Cola bottle and its Sprite bottle in International Class 32 covering various non-alcoholic beverages. Importantly, neither of the bottles contained any wording; they were simply the images of the bottles themselves. The Department of Intellectual Property (DIP) rejected Coca-Cola's applications on the basis that when Coca-Cola's marks (shapes of bottles) were used with the goods for which registration was sought (drinks), the marks appeared to be the shape of a container for the goods. Both applications were therefore rejected on the grounds that they were common

general objects and not distinctive to be registrable. On appeal, the Board of Trademarks upheld these decisions, in response to which Coca-Cola filed two separate civil suits before the Central Intellectual Property and International Trade Court (IP&IT Court).

The rulings of the IP&IT Court differed for the two marks. With respect to the Coca-Cola bottle, the Court viewed that the subject mark was merely an invented picture of a bottle, not a three-dimensional mark; thus, the mark was sufficiently distinctive to function as a trademark. The Court therefore ruled in favor of Coca-Cola that the subject mark was registrable as a two-dimensional mark. This ruling contrasted with the decision in the Sprite bottle case, in which the IP&IT Court agreed with the DIP's contention that Coca-Cola's bottle was merely a picture of a container, which is a common, nondistinctive object. The Court therefore ruled that the Sprite bottle was not registrable. Each of these decisions was appealed to the Supreme Court by the losing party.

In separate decisions in 2006 (Judgment No. 7024/2549 for the Coca-Cola bottle) and 2008 (Judgment No. 630/2551 for the Sprite bottle), the Supreme Court determined that Coca-Cola's subject marks were invented pictures that had sufficient characteristics to allow consumers

to differentiate Coca-Cola's products from the products of other proprietors. Therefore, they were sufficiently distinctive for registration as two-dimensional marks. Under the law, the picture of the bottle in each of Coca-Cola's applications constituted an invented picture. Section 7(6) of the Thai Trademark Act stipulates that an invented picture shall be distinctive for registration. The Court therefore ordered the DIP to proceed with the registration of both marks as two-dimensional marks.

While the words Coca-Cola and Coke are famous brand names, the shape of the Coca-Cola bottle is also a well-known and registered trademark in many countries around the world. The Thai Registrar overlooked the applicant's intentions to register the shapes of the bottles as three-dimensional marks and rejected Coca-Cola's trademark applications. The decisions in these cases, from the Registrar through



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the Supreme Court, raise questions as to why the marks were initially rejected by the Registrar and why the Supreme Court determined that the marks were just invented pictures, rather than qualified to be three-dimensional marks. The history in these two cases teaches that when the protection of a three-dimensional mark is sought, it is necessary to submit to the Registrar photographs of the shape of the product in all different angles together with specimens of the product. Otherwise, the Registrar may consider the mark to be merely two-dimensional.



Coca-Cola Bottle



Sprite Bottle

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