

DIFFERENT APPROACHES IN EVALUATING CONFUSING SIMILARITY

by Srila Thongklang and Parichart Monaiyakul



Left: Srila Thongklang, Partner

Right: Parichart Monaiyakul, Attorney-at-Law
Intellectual Property

When evaluating two possibly similar marks, the Registrar and the Board of Trademarks have a tendency to focus on specific elements of the marks that may be deemed similar. Usually, this means focusing primarily on certain aspects of appearance and pronunciation, while deemphasizing other important issues such as actual use of the mark in trade or the intent of the parties in seeking registration. This approach can be contrasted with the method employed by Thai courts, which consider a wide variety of factors in rendering their judgments. This contrast is particularly apparent in the following case study.

On August 29, 2002, S.A. Corman submitted Application No. 496464 to the Department of Intellectual Property (DIP) for registration of its trademark "CORMAN" to cover *"anhydrous milk fat and butter ghee including butter and dry spreads being mixes of vegetables and milk grease"* in Class 29.

CORMAN

The Trademark Registrar rejected the application, citing it for confusing similarity to the prior registered trademark "Colman's & Goat Device" under Registration No. TM60631, which had been filed on June 12, 1987 for the goods *"meat, fish (dead), poultry (dead), game (dead), meat extracts, preserved fruits, dried fruits, cooked fruits, preserved vegetables, dried vegetables, cooked vegetables, jellies, jam, butter, cheese, eggs, drinking yogurts, milk, milk-based food products, edible oils, edible fats, butter-based food products used as bread spread, fermented fruits, and fermented foods"* in Class 29.



S.A. Corman filed an appeal with the Board of Trademarks and the Board upheld the Registrar's decision by finding that S.A. Corman's trademark was similar to the prior trademark Registration No. TM60631. The Board further held that registration of the "CORMAN" trademark would cause confusion among the public as to the proprietor or the origin of the goods. Therefore, according to Section 13 of the Thai Trademark Act, the trademark "CORMAN" could not be accepted for registration.

In response to this rejection, S.A. Corman filed a complaint against the DIP with the Central Intellectual Property and International Trade Court (IP&IT Court). The complaint was filed on the basis that the mark "CORMAN" was not similar to the prior registered trademark in terms of appearance and pronunciation and that the mark "CORMAN" had been used before the prior registered mark "Colman's & Goat Device" was filed for registration in 1987.

Ruling in favor of the plaintiff, the IP&IT Court ordered the cancellation of the decisions that had been made by the Trademark Registrar and the Board of Trademarks for the mark "CORMAN". The DIP appealed this decision to the Thai Supreme (Dika) Court.

In considering whether the mark is similar and could cause confusion among the public, the Dika Court ruled that the entire mark should be considered, not only some elements thereof. After comparing the appearance of the disputed trademarks, the Dika Court found that S.A. Corman's trademark consisted of all uppercase letters with no stylization, while the prior registered mark consisted primarily of lower case letters which were designed to be curved above the face of a goat in a wreath. It is clear that the goat face design and wreath were not included in S.A. Corman's mark, which should distinguish the marks. Further, even though the marks shared five letters in common, there were two different letters and the prior registered mark contained the apostrophe and letter "s" at the end of

the word. The overall aspects of the marks were therefore different.

In addition, S.A. Corman's mark has been used with the goods "butter", while the prior mark was registered for the goods "mustard". The relevant group of consumers should be familiar with the Roman letters and the goods involved. As a result, the similar pronunciation of the mark was not a sufficient element to cause the marks to be considered confusingly similar, nor should it prevent the registration of the mark. Furthermore, the owner of the prior registered mark also consented to S.A. Corman's registration of its mark in Thailand. Finally, S.A. Corman's mark was derived from part of its company name.

Based on the foregoing, the Dika Court, under Case No. 977/2551, found that there was no bad faith intention to benefit from the prior registered mark. Therefore, there was no reason to refuse the Application No. 496464. The Dika Court affirmed the IP&IT Court's ruling and withdrew the decisions of the Trademark Registrar and the Board of Trademarks rejecting the trademark application for "CORMAN".

This decision demonstrates the wide range of criteria used by the Dika Court in making its decision to accept registration of the mark. Whereas the Registrar and the Board seemed to focus largely on the similarity of the pronunciation of the marks, the Court considered all aspects of the marks' appearance, the goods involved, and the intent of the applicant in seeking registration. Since the courts frequently reverse this type of decision by the Registrar and the Board, applicants whose marks have been rejected based on confusing similarity may therefore consider the option of challenging such refusals. ♦