

LASERJET DEEMED DISTINCTIVE IN THAILAND

by Nuttaphol Arammuang



Nuttaphol Arammuang, Attorney-at-Law
Intellectual Property

A recent Supreme Court decision, *Hewlett-Packard Company v. The Department of Intellectual Property*, provides important insight into the concept of “distinctiveness through use” or “secondary meaning” under the Thai trademark practice. This case, which focuses on the distinctiveness of Hewlett-Packard’s LASERJET trademark, is illustrative of the different perspectives used by the Department of Intellectual Property (DIP), the Central Intellectual Property and International Trade Court (IP&IT Court), and the Supreme Court in interpreting the notion of distinctiveness under Section 7 of the Thai Trademark Act.

Section 7 of the Act stipulates a fundamental condition for trademark registration. It holds that a “distinctive” trademark must allow the general public or consumers to understand that the goods bearing the mark are different from the goods of other parties (which can be referred to as inherent distinctiveness). The second paragraph of this provision then lists a number of essential elements that constitute distinctiveness, including the requirement that the mark must not directly refer to the character or quality of the goods. In the third paragraph of Section 7, an exception is made under which a mark that would normally be viewed as non-distinctive (and thus unregistrable) can nevertheless be deemed to be distinctive if it has been widely distributed or extensively used. Further to claiming that their trademarks themselves are inherently distinctive (e.g., a fanciful and unusual combination) under paragraphs 1 and 2 of Section 7, trademark owners generally submit evidence of use to the authorities to prove the distinctiveness through use under paragraph 3 at the same time. The following case study offers different perspectives on both the concept of inherent distinctiveness and the evidence required to demonstrate distinctiveness through use.

In 2001, Hewlett-Packard filed Trademark Application No. 464131 for registration of the mark LASERJET with the DIP for the goods “toner cartridges for photocopiers and printers” in Class 2. The Registrar rejected the application by reasoning that the trademark LASERJET means “to spout liquid,” which makes direct reference to the character and quality of the goods. Thus, the mark was determined to be non-distinctive and non-registrable. Hewlett-Packard filed an appeal petition against the Registrar’s order with the Board of Trademarks. The Board, however, affirmed the Registrar’s order and dismissed the disputed application.

Hewlett-Packard then filed a civil suit against the DIP with the IP&IT Court in an attempt to overturn the Board’s decision. Hewlett-Packard insisted that the trademark LASERJET is an inherently distinctive trademark because the mark is a fanciful and unusual combination with no meaning. In addition, Hewlett-Packard believed that the mark had been used widely in Thailand and other countries for a long time, and thus, had achieved distinctiveness through use. More than 30 boxes of documentary evidence were presented to the Court during the trial to support this fact, including the following key documents and evidence:

1. Samples, pictures, and packaging of the toner cartridges bearing the trademark LASERJET;
2. Advertising materials, news articles, Web sites, online discussion forums, and several IT magazines providing information regarding the plaintiff’s products bearing the trademark LASERJET in Thailand (initiated by Hewlett-Packard and the public);
3. Invoices and other sales documents demonstrating the sales figures and prices of the plaintiff’s products (more than 20 boxes);
4. Certificates of trademark registration of the plaintiff’s trademark in other countries;
5. Affidavit or written statement of the authorized person of the plaintiff providing the history of the company and trademark; and
6. Four computer dictionaries providing definitions of the word LASERJET.

On August 31, 2004, the IP&IT Court rendered its judgment dismissing the Registrar’s order and the Board’s decision. The IP&IT Court viewed that the trademark LASERJET itself was sufficiently distinctive to be registered for the goods in Class 2. The Court considered that although the trademark LASERJET could imply the definition “to spout liquid” and liquid is the form of the ink, such meaning is not “an exclusive meaning” of the mark. In addition, there are several forms and types of ink, including powder. In conclusion, the IP&IT Court ruled that the mark LASERJET did not directly refer to the quality and character of the goods sought for registration and, thus, was an inherently distinctive mark. The DIP, as the defendant, disagreed with the IP&IT Court’s decision and filed an appeal petition with the Supreme Court.

On November 17, 2008, the Supreme Court rendered its judgment affirming that the trademark LASERJET was registrable. The Supreme Court, however, exercised a

different view in considering the case. Instead of agreeing with the IP&IT Court’s finding that the disputed trademark was inherently distinctive under Section 7 paragraph 1, the Supreme Court relied on the same reasoning as the Registrar and the Board in determining that the trademark LASERJET itself was non-distinctive based on its consideration that the trademark LASERJET means “to spout liquid.” Thus, the Court concluded that the trademark LASERJET was not an inherently distinctive trademark under Section 7 paragraph 1 and paragraph 2 of the Trademark Act. In light of this, the Court also considered the issue of whether the plaintiff’s trademark had obtained distinctiveness through use under Section 7 paragraph 3.

The Court found that the plaintiff adduced evidence and witness testimony including the testimony of the plaintiff’s subsidiary that the printers and toner cartridges incorporating the trademark LASERJET had been widely known in Thailand for an extended period of time (more than 10 years). Moreover, these products were widely distributed from the plaintiff’s subsidiary to various wholesalers and retailers. The products incorporating the trademark LASERJET generated income for the plaintiff’s subsidiary in the amount of several million baht each year and such products achieved market share of more than 50 percent. The plaintiff’s annual budget was approximately THB 50 million for advertisement and promotion, through many channels, of its products relating to printer ink. Furthermore, in the market, no other business operators use the trademark LASERJET with printers and printer ink.

Several computer dictionaries as submitted by the plaintiff were important in the Supreme Court’s decision. The dictionaries recognized and defined that LASERJET is a trademark used by the plaintiff with printers. For example, *Prentice Hall’s Illustrated Dictionary of Computing*, Second Edition, states that “HP LaserJet” means “a trademark of Hewlett-Packard, assigned to its range of laser printers, first introduced in 1984 with one built-in font (Courier) offering a resolution of 300 dots per inch.”

Hence, the Supreme Court found that the plaintiff had widely used the trademark LASERJET with its products, including printers and toner cartridges, and widely sold these products for a substantial period of time to the extent that the Thai public can

Continued on page 3

LASERJET *(from page 2)*

differentiate the plaintiff's printer ink from the printer ink of other manufacturers. The trademark LASERJET had achieved distinctiveness through use in accordance with the Trademark Act 1991 Section 7 paragraph 3. The Supreme Court therefore overturned the Registrar's order and the Board of Trademarks' decision and ordered the DIP to proceed with registration of Hewlett-Packard's trademark LASERJET.

This judgment demonstrates the

Supreme Court's view in interpreting the meaning of a trademark. When compared to the IP&IT Court, the Supreme Court employs a more conservative approach in considering this issue. In this case, the Supreme Court applied the same opinion in analyzing the meaning of the mark as earlier used by the Registrar and the Board of Trademarks. However, the Supreme Court provided more emphasis on the criteria in considering whether the trademark had achieved distinctiveness through use under Section 7 paragraph 3. Hewlett-Packard

presented a large volume of evidence of use to the Court in this case. From this, it can be concluded that when a trademark owner is interested in registering a trademark that may potentially be rejected based on lack of distinctiveness under Section 7 paragraph 1, it is important to have a substantial amount of evidence of use to prove that the mark has gained distinctiveness through its wide distribution and extensive use. The Hewlett-Packard case provides significant guidelines regarding how to achieve this goal. ♦