

RECENT SUPREME COURT SUCCESSES

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Intellectual Property

Among other successful litigation cases for Tilleke & Gibbins, the summer of 2009 is notable for three decisions announced by the Dika Court (Supreme Court) that not only have allowed our client's valuable trademarks to register but also serve as a guideline for brand owners who may face issues of descriptiveness and similarity. Although the Supreme Court's decisions are not considered precedents to follow under the Thai legal system, lower Courts do in practice consider the merits and principles of prior Supreme Court rulings as guidelines when reviewing similar cases. In observing how the Supreme Court ruled on the issues of distinctiveness and similarity in the following judgments, we can better assess how the Court determines descriptiveness and the possibility of allowing concurrent-use registrations in Thailand.

Descriptiveness

In the first favorable Supreme Court decision, No. 11044/2551, the Registrar and the Board of Trademarks (Board) initially denied the mark COOLAIR, which had been filed for registration for confectionery and gum in International Class 30, as they found the word COOLAIR directly descriptive of the characteristics of the goods and thus prohibited for registration. Evidence submitted by the applicant did not convince the Board that the mark had gained secondary meaning through wide use and advertising in Thailand. The case was then brought before the Central Intellectual Property and International Trade Court (IP&IT Court) for consideration. The IP&IT Court disagreed with the Registrar and the Board and found that the word COOLAIR itself is not directly descriptive of the mark's goods. The Department of Intellectual Property then appealed the IP&IT Court's decision with the Supreme Court. The Supreme Court upheld the IP&IT Court's decision, finding that the meaning of the word COOLAIR is not directly descriptive of the character of the goods and would not cause the public to think so. The trademark COOLAIR was ruled distinctive and thus permitted to register.

Concurrent registration

Supreme Court Case No. 1147/2552, the second favorable case, is indicative of a recent trend in which the Supreme

Court confirms the similarity of marks and the likelihood of confusion, and yet allows registration of the marks in question. In this case, the Registrar, the Board, and the IP&IT Court all found the mark MARNI confusingly similar to the prior-registered mark MANI on the basis of visual and aural appearance and identical classes of goods, and thus denied it registration. (The mark MARNI was filed for goods in International Classes 18 and 25 in 2003, while MANI had been registered since 1988 in the same classes.)

The applicant then appealed the IP&IT Court's judgment to the Supreme Court. In making its decision, the Supreme Court relied on a number of key facts. First, the mark MARNI was initially created in 1988 for use with high-end coats and later distributed widely with several goods in many countries including Thailand. Second, designers commonly use materials and designs for many goods—particularly clothing and accessories such as shoes, bags, and watches—that add a value to the products. This distinguishes the products from others and increases their popularity amongst high-end customers. Third, the owner of the mark MARNI presented evidence of both its advertisements for the products and its registrations of the mark in many countries. Fourth, the styles of products under the MARNI and MANI marks were quite different, and through its products and advertising the mark MARNI had become recognized by the relevant group of consumers. Finally, the owner of the mark MANI had provided a letter of consent for the plaintiff's use. Even though the letter of consent did not lessen the degree of similarity between the marks, it presented an acknowledgement by MANI's owner that the marks could coexist.

For the above reasons, the Supreme Court deemed that the plaintiff had used its mark in good faith and permitted MARNI to register.

Registrability of the same word by different applicants

In the third favorable Supreme Court case, No. 3203/2552, the Registrar and the Board rejected the service mark GULLIVERS TRAVEL ASSOCIATES—filed for hospitality-related services including computer software design relating to holidays and travel in International Class

42—because of its confusing similarity to the trademark GULLIVER, earlier registered with computer-related goods in International Class 9. The Board held that even though the applicant's mark also contained "TRAVEL" and "ASSOCIATES," these two words are directly descriptive of the goods and must be disclaimed. In essence, both parties marks are thus pronounced the same. The IP&IT Court agreed with the Registrar and the Board on the similarity of the marks and affirmed the Board's decision.

The applicant filed an Appeal with the Supreme Court. The Supreme Court disagreed with the IP&IT Court and opined that the applicant's disclaimer of the words "TRAVEL ASSOCIATES" indicates that the applicant has no exclusive right to use these words, but does not constitute their deletion from the mark. In considering the similarity of the mark, the Court judged it necessary to consider all three words together, along with the services covered under the mark, which directly relate to holiday travel, unlike the goods under the prior-registered trademark. Further, the Court found that the applicant filed the mark in good faith because "GULLIVER" is the name of a well-known literary character and the applicant has used the mark since 1975. Therefore, the Supreme Court found that the mark was registrable and it was not necessary to delete computer software design from the list of services.

Summary

When evaluating trademark applications, the Registrar and the Board often focus their attention quite narrowly on the basic properties of the mark, such as the appearance, pronunciation, and goods covered, while discarding additional evidence. In contrast, judges are frequently more open to considering other factors that might support registration of the mark, such as extensive good-faith use of the mark. Therefore, when difficulties are encountered in registering a mark at the Trademark Office, appeal to the court seems to be a valuable means to secure the registration. ❖