

REGISTRATION OF GEOGRAPHICAL NAMES

by Pannapa Rittinaphakorn

Trademark owners frequently choose to include a geographical name in their marks because it effectively draws public attention and is easy to remember. Under the current Thai practice, however, the Registrar will strictly enforce the legal provisions prohibiting registration of a geographical name as a trademark. The restrictions on geographical names are extremely onerous, and the successful registration of such names is therefore quite difficult. For trademark owners, only two exceptions to this practice remain.

In proscribing the registration of geographical names, Section 7(2) of the Trademark Act B.E. 2534 (1991), amended by the Trademark Act (No. 2) B.E. 2543 (2000), defines a distinctive trademark as “a word or clause that has no direct reference to the character or quality of the goods **and is not a**

geographical name according to the prescription of the Minister” (emphasis added). The Notification of the Ministry of Commerce B.E. 2535 (1992) regarding the Prescription of Geographic Names adds that “The following geographic names **shall be regarded as geographic names** under Section 7(2) of the Trademark Act:

- 1) Name of country, name of group of countries, name of region, or self-governing dominion which is of the same description of a country;
- 2) Name of county, state, or precinct;
- 3) Name of capital city, port, province, or special form of local administration area;
- 4) Name of continent;
- 5) Name of ocean, sea, gulf, peninsula, cape, island, archipelago, or lake;
- 6) Other geographic names widely known by the public, for example,

mountain, river, district, sub-district, village, road, etc.

The above geographic names shall mean to include abbreviations, former names, or names called generally, without limitation to the names used in the regulation.”

This regulation clearly casts a rather wide net in defining geographical names, as everything from continents to roads is included. For example, the Registrar required the disclaimer of the word “Macquarie” in the service mark “MACQUARIE & Device,” on the basis that



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“Macquarie” is the name of a river in Australia. A disclaimer was similarly required for the word “Soria,” which is the name of a city and a province in Spain, in order to permit the registration of the trademark “Santagostino Baglio Soria.” These examples demonstrate the strictness with which the Thai Registrar is inclined to apply the prohibition on geographical names.

When applicants have challenged these disclaimer requirements, the Board of Trademarks has ruled that in order for a geographical name to be registrable, it must not be a well-known geographical name, especially among the Thai public. Decision Nos. 1493/2549 and 1494/2549 for the trademark “FORTH&TOWNE” effectively illustrate this practice. Forth & Towne (ITM) INC., an American company, filed two slightly different applications for the trademark “FORTH&TOWNE,” Application Nos. 590655 and 593618, in Class 25. The Trademark Registrar ordered the applicant to disclaim the right to use the word “FORTH” because it is the name of a river located in southern Scotland. The applicant filed an appeal petition with

the Board of Trademarks seeking to overturn the Trademark Registrar’s order, based on the argument that the word “FORTH” is inherently distinctive. After examination of the appeal and evidence, the Board of Trademarks decided that despite the fact that the *New English-Thai Dictionary* written by Dr. Vith Thiengbooranathum defines “FORTH” as the name of a river in southern Scotland, this geographical name is not well-known in Thailand. Consequently, the word “FORTH” cannot be considered a geographical name and the trademark “FORTH&TOWNE” was accepted as an inherently distinctive mark.

Trademark owners, however, may not wish to be limited to the registration of largely unknown geographical names. The second exception which permits the registration of geographical names is provided in Section 7 Paragraph 3 of the Trademark Act. This section provides that an otherwise non-distinctive trademark may be deemed to be distinctive if it can be proven that the mark has gained recognition among the public through extensive use. If applicants can prove that they have widely distributed and/or

advertised the goods under their marks for a long time, to the extent that Thai consumers are familiar with them and can distinguish them from those of others, their marks may be registrable. This provides an alternative avenue through which a mark that employs a geographical name may achieve registration as a trademark in Thailand. Evidence which can be submitted in order to prove the use of a trademark includes invoices, brochures, leaflets, sales expenditures, advertising expenditures, annual reports, advertisements in various media, etc. Examples of marks comprising a geographical name that have successfully achieved registration based on wide use include “The New York Times” in Class 16 and “WHITTARD OF CHELSEA” in Class 30.

In sum, the registration of geographical names as trademarks is generally not permissible in Thailand, and the Registrar tends to be rather strict in enforcing this policy. Nevertheless, trademark owners have some degree of flexibility in seeking possible options for registration of marks that include geographical names. ♦