

UNUSUAL COMBINATION OF WORDS: DISTINCTIVE OR NOT?

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In Thailand, much like in other jurisdictions, one of the most important factors in determining the registrability of a trademark application is the requirement that the mark must be sufficiently distinctive.

According to Section 7 of the Thai Trademark Act, a distinctive trademark shall enable the public to distinguish the goods with which the trademark is used from other goods. In determining a trademark's distinctiveness, Section 7 (2) of the Thai Trademark Act requires a word(s) that has no direct reference to the character or quality of the goods, and is not a geographical name. Similarly, Article 15 of TRIPS provides that any sign/word, or any combination of signs/words, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.

The court case described below helps to elucidate the Thai Court's discretion in weighing whether an unusual combination of words which is used in an arbitrary manner can be considered sufficiently distinctive for registration.

In early 2004, Avermedia Technologies, Inc. ("Avermedia"), a Taiwanese corporation with business expertise in manufacturing and distributing products in the field of digital media, filed a word mark "AVerMedia" to protect its goods in Class 9 with electronics products, particularly TV tuners, PC-to-TV Scan Converters, and Document Cameras in Thailand.

AVerMedia

The Trademark Registrar rejected the application for the mark "AVerMedia" reasoning that the mark is



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non-distinctive, a decision that was later upheld by the Board of Trademarks. The Trademark Registrar asserted that the word "AVerMedia" can be interpreted as "a recording device which can accurately measure or improve information." When applied to goods in Class 9, the Registrar felt that the mark made a direct reference to the relevant goods.

Avermedia disagreed with the decisions made by the Trademark Registrar and the Board of Trademarks, as its mark had not been created with this reference in mind. In mid-2006, Avermedia lodged a case against the Department of Intellectual Property ("DIP") to the

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Intellectual Property and International Trade Court (“IP&IT Court”) seeking to overturn the DIP’s rejection.

In December 2007, the IP&IT Court pronounced its judgment in favor of Avermedia, holding that the plaintiff’s trademark “AVerMedia” does not directly refer to the character or quality of the applied goods in Class 9. The Court found that although the word “aver” means “affirmation/confirmation of fact” as the DIP claimed, most Thais would not immediately make this connection. Moreover, even if the mark as a whole could be separately interpreted

in the manner asserted by the DIP, this meaning is not directly descriptive in this case because it does not explain the exact characteristics of the plaintiff’s products to the public.

Thus, the IP&IT Court was of the opinion that the Registrar’s initial reasoning that the word “AVerMedia” means “*a recording device which can accurately measure or improve information*” was an overly broad interpretation. The Court reversed the decisions made by the Trademark Registrar and the Board of Trademarks and ordered that the mark “AVerMedia” proceed to registration in Class 9.

This decision reveals that, when compared to the perspective of the DIP, the Thai Court tends to be less conservative in considering a word mark that is applied for registration in Thailand. An unusual combination of words can often be interpreted in many different ways, depending on the discretion of the responsible authority. However, as long as the trademark owner can prove to the Court that registration was sought in good faith and can provide evidence of the history of the mark’s creation, the protection of the mark should be recognized and accepted under the Thai trademark law. ♦