

## APRIL 2009 Thailand: Court rules on associated trade marks

01 Apr 2009

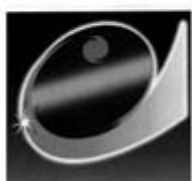
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In accordance with Section 14 of the Thai Trade Mark Act, the registrar will require that similar trade marks filed by the same owner be registered as associated trade marks if they are deemed to be identical or similar to each other. Although applicants are entitled to appeal this decision, the Board of Trade Marks (Board) and the Intellectual Property & International Trade Court (IP&IT Court) are likely to uphold the association requirement, as it is a widely accepted practice within Thai law.

Unilever NV owned two registered device marks for goods in Classes 3 and 5:



1) Application no 407200



2) Application no 499884

In 2003, Unilever filed three new trade mark applications in Classes 3 and 5:



1) Application no 532035



2) Application no 532036



3) Application no 532039

The registrar ordered Unilever to register application 532035 in association with applications 407200 and 499884 and to register applications 532036 and 532039 in association with application 499884. Unilever appealed this requirement to the Board, but the appeal was unsuccessful. Unilever then filed a complaint with the IP&IT Court in an attempt to achieve registration of the pending applications without associating them with its earlier registrations.

The IP&IT Court determined that the essential basis of each of the pending applications, when compared with the earlier registrations, was the oval-shaped device. This showed that the plaintiff aimed to use such images as the essential part of its trade marks. The extra elements that were included in each mark, such as the horizontal banner, the word Sunlight or the star, were regarded as minor details or components, whereas the oval was the principal element. These slight modifications were not sufficient to differentiate the pending applications from the earlier registrations. The Court held that if the plaintiff wished to use trade marks that were totally different from the registered trade marks, the designs of the latter applications should have been

substantially altered. Since the plaintiff still used the oval element, the Court decided that the pending applications were intended to fall within the same group as the earlier registrations. The Court also determined that the pending applications were identical or similar such that they could deceive or cause confusion among the public as to the proprietorship or the origin of the goods if they were being used by another proprietor.

Thus, the Court dismissed the plaintiff's complaint by reasoning that the decisions of the registrar and the Board were lawful according to Section 14 of the Thai Trade Mark Act.



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