

## DECEMBER 2009 / JANUARY 2010 Thailand: IP Court allows trade mark coexistence

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Section 27 of the Thai Trade Mark Act allows for the possibility that confusingly similar trade marks may be registered if they have been honestly and concurrently used by their owners. This provision, however, has seldom been put into practice by the Thai Registrar and Board of Trade Marks when considering applications for potentially similar marks. Instead, the Registrar and the Board tend to flatly reject marks that may be deemed similar to existing registrations.

In contrast to this practice, the Central Intellectual Property and International Trade Court (IP&IT Court) has relied on Section 27 in multiple decisions to allow registration of trade mark applications that had initially been rejected on the basis of confusing similarity. As an example, in Decision no 162/2551, the plaintiff had applied for the trade mark Mango in 2002, but the application was rejected because both the Registrar and the Board considered it identical or similar to a prior registrant's trade mark, Mango Australia & Device, registered in 2002.

The plaintiff then filed a suit to cancel the registration of the earlier-registered trade mark. As the owner of the trade marks Mango and MNG, which were first registered in 1954 in Spain, the plaintiff argued that it had a better right in the trade mark Mango than the registrant. The plaintiff's trade mark has been registered in many countries, and its clothing products under the trade mark have been sold in Thailand since 1998, as well as being sold worldwide. In response, the defendant claimed to have been the owner of the Mango Australia trade mark for an extended period of time and to be the sole owner of the mark in Thailand.

In weighing this dispute, the Court determined that the plaintiff has been the proprietor of the mark in good faith for more than ten years, both in Thailand and abroad. Although the marks are similar and cover the same categories of goods, the Court deemed that the Registrar had the authority to allow coexisting registration of the trade marks under Section 27 of the Trade Mark Act. The Court therefore rendered the judgment dismissing both the Registrar's and Board's decisions as unlawful. An appeal is pending before the Supreme Court.

This decision illustrates a trend of the IP&IT Court and the Supreme Court in allowing the coexistence of similar trade marks in the same class of goods, such as Marni and Mani and Gas and Gas & Triangle Device, when both trade marks have been used and applied in good faith by their owners.



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