FEBRUARY 2010 Thailand: Colourful trade mark decision overturned

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Colorplus Fashions, an Indian corporation, applied for registration of the mark ColorPlus (stylized) in Thailand in Class 25 for apparel products. In examining the application, the Trade Mark Registrar determined that the word "colorplus" signifies colourful or high-quality colours, which is directly descriptive of the properties and/or characteristics of the goods applied for. The mark was therefore refused for registration on the grounds of nondistinctiveness. Colorplus filed an appeal to the Board of Trade Marks, but the Board agreed with the Registrar's refusal on the same grounds. Facing rejection of the mark, Colorplus filed a civil suit before the Central Intellectual Property and International Trade Court in an attempt to overturn these decisions.

The Court considered the case and stated that "a word or clause that has direct reference to the character or quality of the goods" – as prescribed in Section 7(2) of the Thai Trade Mark Act – shall be a word or clause which, when used in connection with a product, can lead consumers to know the character or quality of that product directly: the type of product, objective of use, or its quality. The Court stated that although "colorplus" signifies colourful or high-quality colours, this word, when used in this manner, merely attracts the interest of consumers of that product. That is, the word "colorplus" does not directly refer to the character or quality of the goods, and as such the Court held that the mark is distinctive and registrable.

The usual practice of the Trade Mark Registrar is to reject marks comprising either descriptive or suggestive meanings, based on the reasoning that such meanings make direct reference to the character or quality of the goods. This practice, however, overlooks the important differences between descriptive and suggestive meanings. A suggestive mark tends to indicate the nature, quality, or characteristic of the goods or services in relation to which it is used, but does not describe the characteristics; instead, it requires imagination on the part of the consumer to identify the product or service.

In the Colorplus decision, it appears that the Court separated the descriptive and suggestive meanings from each other. Based on the Court's judgment, the phrase "direct reference" – as stipulated in the Trade Mark Act – would only apply to descriptive meanings, not suggestive meanings.

As a final consideration, trade mark applicants need to account for the fact that the Thai language is complicated. As such, when considering the Thai meaning of a word, it is sometimes difficult to distinguish between descriptive and suggestive meanings. Fortunately, the Court's judgment in this case provides more certainty on the interpretation of descriptiveness.

Rungroj Kobkitwattanakul

Tilleke & Gibbins International Ltd
Supalai Grand Tower, 26th Floor
1011 Rama 3 Road, Chongnonsi, Yannawa
Bangkok 10120, Thailand
Tel: +66 2653 5555
Fax: +66 2653 5678
bangkok@tillekeandgibbins.com
www.tillekeandgibbins.com