

MAY 2009 Thailand: How to prove distinctiveness in court

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In *Hewlett-Packard Company v The Department of Intellectual Property* [Supreme Court Case no 3685/2551 (2008)], the Supreme Court affirmed the judgment of the Central Intellectual Property and International Trade Court (IP&IT Court) by using the concept of distinctiveness through use or secondary meaning.

In 2001, Hewlett-Packard filed trade mark application no 464131 for registration of the mark LASERJET with the Department of Intellectual Property (DIP) for toner cartridges for photocopiers and printers in Class 2. The registrar and the Board of Trademarks rejected the application by reasoning that the trade mark LASERJET means to spout liquid, which makes direct reference to the character and quality of the goods.

Hewlett-Packard then filed a civil suit against the DIP with the IP&IT Court. The company insisted that the trade mark LASERJET is inherently distinctive because the mark is a fanciful and unusual combination with no meaning. In addition, Hewlett-Packard submitted evidence proving that the mark had been used widely in Thailand and achieved distinctiveness through use. The IP&IT Court ruled that the mark LASERJET was inherently distinctive. The DIP appealed to the Supreme Court.

On November 17, 2008, the Supreme Court rendered its judgment affirming that the trade mark LASERJET could be registered. The Supreme Court, however, exercised a different view in considering the case. Instead of agreeing with the IP&IT Court's finding that the disputed trade mark was inherently distinctive, the Supreme Court considered that the trade mark LASERJET itself was non-distinctive based on its consideration that the trade mark LASERJET means to spout liquid.

The Court, however, considered the issue of whether the plaintiff's trade mark had obtained distinctiveness through use. The Supreme Court found that Hewlett-Packard had widely used the trade mark LASERJET with printers and toner cartridges, and widely sold these products for a substantial period of time. The trade mark LASERJET had achieved distinctiveness through use in accordance with Section 7 paragraph 3 of the Trademark Act. The Supreme Court therefore ordered the DIP to proceed with registration of Hewlett-Packard's LASERJET trade mark.



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