

THAILAND

Distinctiveness of marks under current Thai practice



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One of the common reasons Thai authorities refuse to allow marks to register is because they are descriptive of the goods or services that fall under the mark, and thus lack distinctiveness. According to the current practice, the Thai Registrar checks for any possible linkage between the meaning of the mark and the goods or services to be registered; if one is found, the Registrar will reject the registration of such a mark. The trade mark applicant is then entitled to file an appeal petition with the Board of Trademarks. Nevertheless, the view and practice of the Trademark Registrar and the Board of Trademarks are usually the same. Consequently, trade mark applicants frequently face the need to file an appeal to the Central Intellectual Property and International Trade Court (IP&IT Court) and finally to the Supreme Court to obtain protection of their marks. This is true for both word marks and three-dimensional marks.

Word marks

The Supreme Court Judgment No 2040/2552 (2009) regarding the mark AQUAFEED offers helpful criteria for determining the descriptiveness of goods/services of marks:

1. Consideration must be made as to whether and how a mark is explicitly representative to the public of the goods/services for which registration is sought. If the public instantly or very quickly understands from the mark what kind(s) of goods/services the mark is used for, then the mark is considered descriptive of the goods/services.
2. If the public takes a considerable amount of time in understanding what kind of goods/services the mark is for, then such mark is not descriptive of the goods/services, but merely suggestive of them.

When the application for AQUAFEED was initially filed to cover the goods "animal feeds," the Trademark Registrar and the Board of Trademarks rejected the mark for registration. In their consideration, the mark was divided into two words, *aqua* and *feed*. The meaning of *aqua* is water, while the meaning of *feed* is giving food. As a result, they considered the mark AQUAFEED directly descriptive of the goods "animal feeds." However, by using the criteria above, the IP&IT Court and the Supreme Court disagreed with the decision of the Registrar and the Board and rendered their judgment that the mark AQUAFEED was not directly descriptive of the goods "animal feeds." The mark was thus allowed to register.

Three-dimensional marks

Descriptiveness rejections of trade mark applications are a problem not only for word marks, but also for three-dimensional marks. On June 30 2000, the Thai Trademark Act was amended to provide protection for three-dimensional objects as trade marks. Since that time, many applicants have filed to register the shape of their products as three-dimensional marks, but very few applicants have been successful in obtaining registration. Based on the local practice of the Department of Intellectual Property, the Trademark Registrar tends to reject most three-dimensional mark applications

consisting of the shape of the product itself on the ground that the proposed mark is directly descriptive of the goods for which registration is sought. Even if the three-dimensional trade mark application is a representation of the container of the product, this is still deemed to be descriptive of the product. Some examples of rejected applications are Application No 475755 for "Perfume Bottle Mark" by Carolina Herrera and Application No 539203 for "Juice Bottle Mark" by Australiana Group Holdings.

IF THE PUBLIC INSTANTLY OR VERY QUICKLY UNDERSTANDS
FROM THE MARK WHAT KIND(S) OF GOODS/SERVICES THE
MARK IS USED FOR, THEN THE MARK IS CONSIDERED
DESCRIPTIVE OF THE GOODS/SERVICES

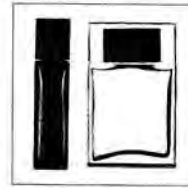
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Another application that was rejected belongs to The Coca-Cola Company. The Coca-Cola Company's application for registration of its famous "Coca-Cola Bottle" was rejected by both the Registrar and the Board of Trademarks on grounds of non-distinctiveness. The proposed bottle mark, filed under Application No 434308, was considered a generic picture not sufficiently distinctive for registration and was also considered a container directly descriptive of the applied goods, beverages, in Class 32. The Coca-Cola Company then filed a lawsuit with the IP&IT Court against the Board's rejection of its proposed mark. The Coca-Cola Company claimed that its proposed mark had been widely used not only as a container but also as a trade mark and, as such, had acquired distinctiveness through use; hence, it should be considered as having acquired secondary meaning.

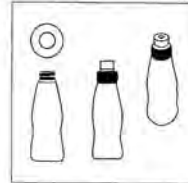
In June 2004, the IP&IT Court rendered its decision in the matter. The Court held that the proposed bottle mark was merely an invented picture presented in two dimensions, length and width, without the third dimension, depth. Thus, it should not be considered a container for the goods and hence was sufficiently distinctive for registration as a two-dimensional (not a three-dimensional) trade mark. The Supreme Court upheld this first-instance decision in its Judgment No 7024/2549 (2006) and allowed the mark "Coca-Cola Bottle" to be registered as a two-dimensional mark. A later decision, Supreme Court Judgment No 630/2551 (2008), similarly allowed The Coca-Cola Company to register its "Green Dimple Bottle" for the same reasons.

From these cases, we can draw the conclusion that when filing a three-dimensional mark application for either a container or the shape of a product, it is essential for the application to include adequate representations of the mark in three dimensions – length, width, and depth. Images of every side of the mark, including perspective view, are recommended. It is also recommended that the specimen of the mark be presented in a manner that is identical to its actual use, which has been well recognised by the public, to prove that the mark has gained secondary meaning.

Rejected



"Perfume Bottle Mark"
by Carolina Herrera



"Juice Bottle Mark"
by Australiana Group
Holdings

Accepted in 2D



"Coca-Cola Bottle"
(left) and "Green
Dimple Bottle"
by The Coca-Cola
Company

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Darani Vachanavuttivong is co-managing partner of Tilleke & Gibbins, the oldest and one of the largest independent law firms in Thailand, and managing director of the firm's large and active intellectual property department, which has won *Asialaw's* Thailand IP Firm of the Year Award from 2004 to 2007; *Managing Intellectual Property's* Thailand IP Firm of the Year Award in 2007, 2008 and 2009; and *Asian-Counsel's* IP Firm of 2007 and 2009 for Thailand. Ms Vachanavuttivong herself is consistently identified as a leading lawyer in the area of intellectual property.

Ms Vachanavuttivong graduated from Thammasat University in Thailand with a bachelor's degree in business administration (accounting) in 1985, a higher diploma in auditing in 1988, and a Master of Science in accounting in 1991. She later pursued law studies and obtained her law degree in 1999 from Ramkhamhaeng University. In 2002, she successfully completed the programme of instruction for lawyers and negotiation workshop at Harvard Law School. She passed the examination for a Thai lawyer's licence in 2004. In addition, she completed the patent agent training course conducted by the Department of Intellectual Property and is a certified patent agent. She also received a certificate for completing the SEAD course on drafting patent specifications conducted by the Federation Internationale des Conseils en Propriete Industrielle.

Since 1990, Ms Vachanavuttivong has been responsible for Tilleke & Gibbins' trade mark registration practice. In 2001, she became the managing director of the firm's intellectual property registration operations, assuming responsibility also for the firm's patent registration practice and the intellectual property registration operations for Vietnam, Cambodia, Laos and Myanmar. In 2005, she was given charge of the firm's entire intellectual property practice.

Ms Vachanavuttivong recently completed her second term as president of the Intellectual Property Association of Thailand and now serves as the secretary general and a director of the Association. In addition, she was elected by her peers to serve as country head for Thailand of the ASEAN Intellectual Property Association. She is a frequent speaker and has authored numerous articles on intellectual property topics.

