

§22.04 Cancellation

Thailand

In *Plasco, Inc. v. Thantri Meethikulchanun*,¹⁰⁷⁵ the Dika Court considered the IP&IT Court's dismissal of the plaintiff's complaint, which had been based on the reasoning that the complaint was filed after the expiration of the prescribed five-year period for filing a cancellation action based on "better right" grounds under Section 67 of the Thai Trademark Act.¹⁰⁷⁶ The Dika Court reversed the IP&IT Court's decision on how the period was to be calculated. In addition, it insisted that when a claim was based on passing-off grounds the claimant's mark be required to have a reputation as a well-known mark.

The first issue under consideration was whether the plaintiff filed its cancellation action against the defendant's trademark MDI, for medical devices, within five years from the date of the Registrar's order for registration of the mark. The defendant claimed that the plaintiff filed the complaint after the five-year period had expired. The Court was of the opinion that the written statement notifying the defendant of the Registrar's order to register the trademark and requesting that the defendant pay the registration fee was merely a written statement of notification about the Registrar's order. The trademark registration procedure would be complete only when the defendant paid the registration fee and the Registrar issued a trademark registration with a verifiable registration number. As the facts of the case revealed that the Registrar issued the registration number for the disputed trademark on October 17, 1996, the period for cancellation on the grounds of better right under Section 67 would expire on October 17, 2001. Therefore, because the plaintiff filed its complaint for cancellation on October 16, 2001, the Court held that the complaint was filed within the period provided by law. The defendant's claim that the plaintiff's cancellation action was filed after the five-year period had expired was, therefore, inadmissible.

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The second issue was whether the plaintiff had a better right to the disputed trademark MDI than the defendant. The Court found that the defendant imported medical devices bearing the trademark MDI for distribution in Thailand. The defendant further claimed, without supporting evidence, that he had invented the term “MDI,” explaining that it stood for “Medical Disposable International.” The plaintiff countered that it was the manufacturer of the products bearing the trademark MDI and that MDI was the abbreviation for “Medical Device International,” the name of one of the plaintiff’s subsidiaries that produced MDI products. The Court found that the plaintiff’s evidence carried more weight. Accordingly, it ruled that the plaintiff had a better right to the trademark MDI.

The third issue was whether the defendant’s use of the same mark was considered to be passing off its goods as those of the plaintiff. The Court was of the opinion that “passing off” refers to one person’s selling or distributing a product by using a trademark of another person without any right or using a counterfeit trademark so as to lure the public in believing that the product belongs to the true owner of the trademark. In this case, the plaintiff could not prove that its products under the trademark MDI were well known in Thailand. Therefore, the use of the plaintiff’s trademark by the defendant in importing products from manufacturers in other countries could not be considered to be passing off. The Court ruled that the defendant’s action was not passing off its goods as those of the plaintiff and that the plaintiff did not prove that the defendant’s act caused any damages to its products under the trademark MDI. Thus, the Court was unable to set damages for the defendant to pay to the plaintiff.

Endnotes

¹⁰³³ For a discussion of the facts and liability issues, see § 6.00 Famous and Well-Known Marks. Other aspects of the Federal