

THAILAND

I.D.1. Similarity of Marks

In *Arcor S.A.I.C. v. Department of Intellectual Property* (Arcor), the Thai Supreme (Dika) Court affirmed the Intellectual Property and International Trade Court (IP&IT Court)'s ruling and withdrew the earlier decisions of the Trademark Registrar and the Board of Trademarks.¹

In 2004, Arcor filed an application for the trademark ROCKLETS THE COLORS OF CHOCOLATE & Device (see illustration below) for the goods chocolate, candy, and sweets in Class 30.² The Trademark Registrar rejected the trademark application on the basis that this mark was confusingly similar to the prior-registered trademark LOCKETS.³ Arcor filed an appeal with the Board of Trademarks, but the Board upheld the Registrar's decision. The Board reasoned that although the applied-for mark contained the phrase "The colors of chocolate," this phrase was disclaimed and thus was not a material part of the mark. Additionally, the pronunciation of the applied-for mark and the prior-registered trademark were similar and the evidence of use submitted by Arcor was insufficient to prove that the mark had been widely distributed in Thailand. Therefore, the mark was not acceptable for registration.



In an attempt to overcome the decisions by the Registrar and the Board, Arcor filed a complaint against Thailand's Department of Intellectual Property (DIP) with the IP&IT Court. In the complaint, Arcor contended that the decisions of the Registrar and the Board were incorrect and unlawful because its trademark was not similar to the prior-registered trademark. Furthermore, Arcor had used the mark in good faith for a substantial period of time to

1. Dika Case No. 3897/2552 (Supreme Court, Nov. 19, 2009).

2. Application No. 572255 (Class 30), filed Nov. 11, 2004.

3. Application/Registration No. 288745/TM32314 (Class 30), filed July 16, 1985.

the extent that it had gained wide recognition, and thus it deserved to be registered under Section 27 of the Thai Trademark Act.⁴ Arcor therefore requested that the IP&IT Court order that its trademark application be considered registrable and that the decisions of the Registrar and the Board be revoked.

In response, the DIP made the following arguments:

- The decisions of the Registrar and the Board were made in good faith under the law. As such, the decisions were correct and lawful.
- The Registrar instructed Arcor to disclaim the phrase “The colors of chocolate” and the image of the candies, and Arcor complied with this request. Based on this disclaimer, the applied-for trademark was similar to the prior-registered trademark LOCKETS. This similarity could cause public confusion as to the origin of the goods.
- Arcor’s evidence of the sale of products in Thailand in 2005 was not sufficient to demonstrate that Arcor’s trademark had been widely advertised or used.

After weighing the arguments presented, the IP&IT Court found that the applied-for mark was not similar to the prior-registered trademark. The IP&IT Court ordered the revocation of the decisions of the Registrar and the Board.

Dissatisfied with this decision, the DIP filed an appeal with the Dika Court. In rendering a judgment, the Dika Court first considered whether the applied-for mark was confusingly similar to the prior-registered trademark. The Dika Court held that the overall appearance of the applied-for mark was different from the prior-registered trademark. The Dika Court further ruled that Arcor’s disclaimer of the phrase “The colors of chocolate” and the picture of candies did not mean that the wording and image should be excluded from consideration when viewing the trademark. This undermined the DIP’s argument that, after the disclaimer, the word “ROCKLETS” was the only important element in the mark.

4. Trademark Act, B.E. 2534 (1991), as amended by Trademark Act (No. 2), B.E. 2543 (2000). Section 27 provides:

If the Registrar is of the opinion that there have been honest concurrent users or special circumstances which make it proper to do so, the Registrar may allow the registration by more than one owner of a trademark which is identical with or similar to a registered trademark under Section 13 or to trademarks applied for under pending applications under Section 20 in respect of goods of the same class or goods of a different class but found by the Registrar to be of the same character subject to such conditions and limitations as to the mode or place of user or such other conditions and limitations as the Registrar may think fit to impose. The Registrar shall without delay notify the applicants and registered trademark owner in writing giving the grounds thereof. The applicant or registered trademark owner may appeal an order of the Registrar under the first paragraph to the Board within ninety days from the date of receipt thereof. Decisions of the Board under paragraph two shall be final.

Although both parties' marks were used in the same class, the Dika Court ruled that the marks were sufficiently different so as not to cause public confusion as to the origin of the goods. The Dika Court therefore upheld the judgment of the IP&IT Court and dismissed the DIP's appeal.

This was a noteworthy decision because the Thai Dika Court confirmed that, when considering the similarity of two marks, the disclaimed element of a mark should be regarded as a substantial part of the mark and must be included in the comparison.