

World Trademark Review Daily

Marks that are similar to INNs cannot be registered
Thailand - Tilleke & Gibbins

Cancellation
National procedures

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Generic drug manufacturers in Thailand tend to use names for their products that are similar to the generic name of the drug (also known as international non-proprietary name or INN), despite the fact that the trademark legislation prohibits the registration of a mark that is identical, or similar, to an INN designated by the [World Health Organisation](#).

The Thai Intellectual Property and International Trade Court (IP & IT Court), a court of first instance with specialised jurisdiction over IP-related cases, has recently confirmed that the registration of such marks was forbidden.

The case arose from a petition requesting that the Board of Trademarks cancel a trademark registration owned by a generic drug company, which covered goods in Class 5 of the [Nice Classification](#) - namely, drugs for the treatment of hypertension. The petition was based on the grounds that the mark was similar to the INN of the drug, as stated in the Notification of the Ministry of Commerce No 5 (2000).

The Board of Trademarks cancelled the registration, which prompted the generic drug company to file an appeal to the IP & IT Court.

In addition to analysing the similarity between the mark and the INN, the court also provided an interesting reasoning on whether the petitioner had the right to file a petition for the cancellation of the mark at issue. The court took into consideration the fact that the pharmaceutical products of the petitioner (at the Board of Trademarks level) and the plaintiff (at the IP & IT Court level) were the same, since both products contained the same active ingredient. The court also recognised that both companies were engaged in the same business field, and, therefore, were competitors. As a result, sales of the plaintiff's product directly affected sales of the petitioner's products.

The plaintiff argued that the petitioner did not have any legal standing from the outset to file the petition, since the petitioner's mark (for the same product) was not similar to the plaintiff's mark. Therefore, there was no likelihood of confusion among the public.

However, the court ruled that the differences between the parties' trademarks were irrelevant, and stated that the key issue in this case was the similarity between the plaintiff's trademark and the INN. In this respect, the court considered that the similarity between the plaintiff's mark and the INN was likely to cause confusion. The court further stated that use of a trademark which is similar to an INN creates an unjust advantage and leads to unfair competition.

Turning to the issue of the similarity between the plaintiff's mark and the INN, the court noted that both consisted of three syllables, and that the beginning and end syllables were identical. After considering the appearance and pronunciation of the mark and the INN, the court concluded that they were similar and, therefore, the plaintiff's mark was prohibited from registration. Consequently, the court dismissed the case.

Although Notification No 5 of the Ministry of Commerce, which prohibits the registration of a mark that is identical, or similar, to an INN, has been implemented since 2000, very few cases involving this issue have been brought before the court. In this instance, the court correctly applied the law and issued a sensible decision.

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