

World Trademark Review Daily

Supreme Court clarifies when mark is suggestive, rather than descriptive Examination/opposition Thailand - Tilleke & Gibbins National procedures

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Brand owners and Thailand's Trademark Office frequently disagree as to how to distinguish between a suggestive mark and a descriptive mark.

According to Section 7(1) of the [Thai Trademark Act BE 2534 \(1991\)](#), as amended by the Trademark Act (No 2) BE 2543 (2000), a 'distinctive' trademark is sign which enables the general public, or the consumers, to distinguish the goods bearing the sign from other goods.

In addition, Section 7(2) clearly states that:

"a trademark containing, or consisting of, a word or clause that has no direct reference to the character or quality of the goods, and is not a geographical name as prescribed by the minister in the Ministerial Notifications (among others), shall be deemed to be distinctive."

Within the context of the legislation, disputes between brand owners and the Trademark Office - specifically, the registrar of trademarks and the Board of Trademarks - have frequently arisen over whether the marks applied for are distinctive.

A recent example, *Liebherr-International AG v Department of Intellectual Property* (Supreme Court Case 9466/2554), was published in April 2012.

In this case, [Liebherr-International AG](#) filed an application to register the mark BIOFRESH for "apparatus for refrigerating and freezing" in Class 11 of the [Nice Classification](#). The registrar of trademarks deemed that the mark was descriptive of the goods; after reviewing the appeal filed by Liebherr, the Board of Trademarks confirmed the registrar's decision that the mark was not registrable due to a lack of distinctiveness.

Liebherr filed a complaint with the Intellectual Property and International Trade Court (IP & IT Court), arguing that the board's decision was incorrect because 'biofresh' was an invented word; therefore, the BIOFRESH mark was not directly descriptive of the character or quality of the goods.

After reviewing the case and the arguments presented, the IP & IT Court found that the mark was distinctive, and ordered that the decisions of the registrar and the Board of Trademarks be withdrawn. The Department of Intellectual Property filed an appeal with the Supreme Court.

The Supreme Court held that BIOFRESH, when used with "apparatus for refrigerating and freezing" in Class 11, was a suggestive mark, which made consumers think, or imagine, that the goods can help maintain the freshness of fruits, vegetables or meat. Therefore, the term 'biofresh' had no meaning which directly described the character or quality of the goods. The Supreme Court thus found that the mark BIOFRESH was distinctive and registrable. Supreme Court clarifies when mark is suggestive, rather than descriptive

However, the Supreme Court noted that, if the registrar determines that a part of a mark includes a word that is commonly used in trade, he/she may order that the applicant disclaim this part. The Supreme Court concluded that the board's decision to reject the application for BIOFRESH was incorrect, and ordered that it be withdrawn.

There have been several other cases in which the IP & IT Court and the Supreme Court have disagreed with the registrar and the Board of Trademarks over the perceived distinctiveness of a mark. Brand owners should thus consider the possibility of raising an argument based on this issue, because, after review by the courts, their mark might be deemed to be suggestive, rather than descriptive.

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