

# World Trademark Review Daily

## Supreme Court considers issues surrounding concurrent use registrations Examination/opposition Thailand - Tilleke & Gibbins National procedures

September 27 2012

Trademark owners, even when they are acting in good faith, may face difficulties in obtaining a trademark registration if the mark they seek to register is confusingly similar, or identical, to an earlier registration. Section 27 of the [Thai Trademark Act](#) provides the opportunity to overcome this objection by allowing 'concurrent use' registrations if the trademark at issue has been honestly and concurrently used by the applicant or if there are other special circumstances.

In particular, Paragraph 1 of Section 27 provides as follows:

*"When there is an application for registration of a trademark that is identical, or similar, to one already registered by a different owner in accordance with Section 13, or when there are applications for registration of trademarks that are identical or similar under Section 20 in respect of goods of the same or different classes, but, in the registrar's opinion, of the same character, and the registrar deems that the trademarks have been honestly and concurrently used by each proprietor, or there are other special circumstances which are deemed proper by the registrar to allow registration, the registrar may permit the registration of the same trademark or of nearly identical trademarks by more than one proprietor, subject to conditions and limitations as to the method and place of use, or other conditions and limitations as the registrar may deem proper to impose. The registrar shall, without delay, notify in writing the applicants or the proprietors of the trademarks who have been granted registration of his decision and reasons therefor."*

The recent decision of the Supreme Court in *Anna Sui Corp v Department of Intellectual Property* (11439/2554) is a good example of the issues involved in concurrent use registrations in Thailand. In this case, plaintiff [Anna Sui Corp](#) filed three applications for the registration of the word mark ANNA SUI for goods in Class 25 of the [Nice Classification](#). After reviewing the applications, the trademark registrar decided that the mark ANNA SUI in Class 25 was confusingly similar to the earlier registered mark ANNA IS, which also covered goods in Class 25.

The plaintiff filed an appeal with the Board of Trademarks, but the registrar's decision was upheld. The plaintiff then filed a complaint with the Central Intellectual Property and International Trade (IP & IT) Court, claiming that the ANNA SUI mark had been widely used for a long period of time and was well known. In addition, the plaintiff stated that it had applied for registration of the mark in good faith. The IP & IT Court agreed with the registrar and the Board of Trademarks, and confirmed that the mark ANNA SUI was not registrable.

Anna Sui appealed to the Supreme Court. The court first found that the trademark applications for ANNA SUI were confusingly similar to the earlier registered trademark ANNA IS because the marks contained the substantial element 'Anna' and covered the same type of goods.

Nevertheless, after considering the evidence submitted by the plaintiff, the Supreme Court noted that the mark ANNA SUI had been registered in the United States since 1983, and that the products sold under the ANNA SUI mark had been widely distributed and promoted in many countries, including Thailand, over a long period of time. In addition, Anna Sui is the name of an American fashion designer. The Supreme Court was thus convinced that the mark ANNA SUI had been created without copying the marks of any other parties, and that it had been used in good faith before the earlier trademark had been filed in Thailand.

The Supreme Court thus concluded that the three trademark applications for ANNA SUI were registrable; however, registration would be subject to any conditions and limitations that the registrar might deem proper to impose.

The Supreme Court's decision shows that, in order to obtain registration of a mark under Section 27, it is necessary to prove the good faith of the applicant. Convincing evidence of the applicant's good faith includes evidence of use of the mark in Thailand and overseas, as well as evidence of registration of the mark in other countries. In addition, evidence of the origin of the mark, as shown in this case, could be very helpful to demonstrate the good faith of the applicant.

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