

World Trademark Review *Daily*

Ferrari's 'prancing horse' device registered under 'concurrent use' provision
Thailand - Tilleke & Gibbins

Examination/opposition
National procedures

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Registration of a trademark worldwide is often fraught with difficulty, especially when the mark is confusingly similar, or identical, to an earlier local registration. However, Section 27 of the [Thai Trademark Act](#) provides for 'concurrent use' registrations if the registrar deems that the trademarks have been used honestly and concurrently by their owners, or if there are other special circumstances.

Section 27(1) provides as follows:

“When there is an application for registration of a trademark that is identical, or similar, to a trademark 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 to each other 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 their proprietors, 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 almost identical marks, 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 trademark proprietors of his decision and reasons therefor.”

A recent case between [Ferrari SpA](#) (plaintiff) and the Department of Intellectual Property (defendant) is a good example of 'concurrent use' registration in Thailand (Supreme Court, Case 5156/2556). The dispute arose when the plaintiff applied for the registration of its well-known 'prancing horse' device mark for goods in Class 25 of the [Nice Classification](#) (Application 489282):



The registrar rejected the application on the grounds that it was confusingly similar to the mark MOCCASIN (and 'prancing horse' device) which was registered in 1987 for goods in Class 25 by a Thai individual named Itti Kijpanich:



The plaintiff filed an appeal with the Board of Trademarks, which upheld the registrar’s decision, holding that the marks were confusingly similar both in appearance and pronunciation.

The plaintiff filed a complaint with the Central Intellectual Property and International Trade (IP & IT) Court, claiming that the marks were different. The plaintiff also added that its mark has been widely used for a long period of time and is well known, and that it had applied for registration of the mark in good faith. During the hearing, the plaintiff submitted additional evidence proving that its mark was invented and was first used with its goods in 1929. The plaintiff also submitted documents showing use and registration of its 'prancing horse' device mark in several countries.

The IP & IT Court believed that the plaintiff had filed for registration of its mark in good faith and accepted the

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registration of its mark. However, the court ordered that the plaintiff add the word 'Ferrari' in Roman characters or other distinguishing elements to the mark, in order to differentiate it from the mark owned by Kijpanich.

The plaintiff disagreed with the decision of the IP & IT Court and appealed to the Supreme Court, arguing that the mark should be accepted for registration without any conditions. After reviewing the case and the plaintiff's appeal, the Supreme Court first found that, although the plaintiff's 'prancing horse' device is similar to the trademark MOCCASIN (and 'prancing horse' device), which had been registered in the same class since 1987, the plaintiff had provided the court with sufficient evidence and documents to prove that it was the inventor and owner of the 'prancing horse' device. The Supreme Court concluded that the marks had been used honestly and concurrently by both parties under Section 27 of the Trademark Act. Hence, the plaintiff's application was a registrable trademark.

The Supreme Court also considered the plaintiff's appeal against the IP & IT Court's order to add the word 'Ferrari' in Roman characters or other distinguishing elements in order to differentiate the two marks. As the Supreme Court had determined that the plaintiff was the owner of the 'prancing horse' device, it found that it was not necessary to add any limitations on the use and registration of its mark. The Supreme Court thus overturned the order of the IP & IT Court in this respect.

Based on the Supreme Court judgment, Ferrari's application for goods in Class 25 was accepted for registration without any conditions. The decision is another example of how the Thai courts determine the degree of honest and concurrent use of similar marks, as well as the special circumstances under which registration might be allowed under Section 27 of the act.

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