

Informed Counsel

Analysis of Recent Legal Developments in Thailand and Vietnam



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Tilleke & Gibbins has been named IP Firm of the Year by Managing IP and has achieved impressive firmwide rankings in the latest edition of Chambers Asia-Pacific.

Supreme Court Judgments Offer Insight into Concurrent-Use Trademark Registration



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Disputes about the registrability of similar marks are on the rise in Thailand. When a brand owner's attempts at trademark registration are thwarted by a prior-registered similar mark, one option is to seek registration under the theory of "concurrent use." Concurrent-use registrations are allowed under Section 27 of the Thai Trademark Act, which provides room for two similar marks to be registered if a trademark has been honestly and concurrently used by the trademark applicant or if there are other special circumstances. But to obtain a successful registration under this provision, the party claiming to be the rightful owner of the mark needs to meet a specific burden of proof.

Two recent Supreme Court judgments provide new insight into how brand owners can achieve registration under Section 27. In one matter, the Court allowed the concurrent-use registration; in the other, the trademark was rejected. Both cases can help brand owners decide whether their trademark may be eligible for registration under this provision.

Anna Sui Corp. v. Department of Intellectual Property (Supreme Court Case 11439/2554)

In this first case, Anna Sui Corp. applied for registration of the word mark ANNA SUI for products in several classifications of goods. After reviewing these applications, both the Registrar and the Board of Trademarks held that the trademark applications for ANNA SUI in Classes 20 and 24 were confusingly similar to the trademark ANNA in Designed Square, which had been previously registered for goods in Class 20. The authorities further decided that the application for ANNA SUI in Class 25 was confusingly similar to the prior-registered mark ANNA IS, which had been previously registered in the same Class 25.

Anna Sui Corp., as the plaintiff, 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 disagreed with these arguments and confirmed the earlier decisions by the Registrar and the Board that the mark ANNA SUI was not registrable.

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Supreme Court Judgments (from page 1)

Anna Sui Corp. appealed the first-instance court's judgment to the Supreme Court. After reviewing the appeal, case background, and all evidence, the Supreme Court first found that the trademark applications for ANNA SUI were confusingly similar to the prior-registered trademarks ANNA IS and ANNA in Designed Square because these marks contained the substantial part "ANNA" and the applications were filed for the same types of goods.

Nevertheless, the Supreme Court recognized that the mark ANNA SUI was registered in the United States in 1983, and that products under the mark ANNA SUI had been widely distributed and promoted in many countries, including Thailand, for a long period of time. In addition, "Anna Sui" is the name of an American fashion designer. The Supreme Court was therefore convinced that the mark ANNA SUI was created without copying the marks of any other party, and that the mark was used in good faith before the prior trademark application was filed in Thailand.

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

ANNA SUI

Plaintiff's Trademark

Anna Is



Prior-Registered Trademarks

Matsuda & Co. v. Department of Intellectual Property and Valentino S.P.A.

(Supreme Court Case 7158-7159/2555)

In the second case, on March 7, 1997, Matsuda & Co. (Matsuda), the plaintiff, filed a trademark application for VALENTINO RUDY & V Device for goods in Class 21. After reviewing the application, the Registrar approved the mark for publication. Valentino S.P.A. (Valentino) believed that this trademark was confusingly similar to its mark VALENTINO & V Device registered since 1986 in the same class of goods.

Valentino lodged an opposition against the mark VALENTINO RUDY & V Device, but the Registrar dismissed the opposition. Valentino filed an appeal with the Board of Trade-

marks, which then overturned the Registrar's earlier decision and rejected Matsuda's trademark application.

In response, Matsuda filed a complaint with the IP&IT Court against the Department of Intellectual Property (DIP), which oversees the work of both the Registrar and the Board, alleging that the DIP's decision was unlawful. Valentino, as an interested party, was granted a motion to join the DIP as a co-defendant in order to protect its interest.

In the complaint, Matsuda raised the following key arguments:

- ◆ The prior-registered mark belonging to Valentino contained only one word, "Valentino." This word was nondistinctive and was disclaimed in the registered mark, and thus Valentino had no exclusive right to the word.
- ◆ Matsuda's mark, on the contrary, contained two words, "Valentino" and "Rudy," and these two words were not disclaimed.
- ◆ Both parties' marks were different and so were the goods covered under each mark, despite falling in the same classification. Matsuda's goods included drinking glasses, spoons, forks, and knives, while Valentino's goods included soap dishes and towel racks made of metal and boxes of metal for dispensing paper towels.
- ◆ Matsuda filed its trademark application in good faith, as Valentino is a name and the letter "V" refers to Valentino, and its mark had been widely used for a long period of time.

In response, Valentino argued that the marks were confusingly similar and that the evidence submitted by Matsuda showed no use of the mark with the goods in Class 21. Thus, Valentino contended that Matsuda's mark VALENTINO RUDY & V Device was unregistrable.

The IP&IT Court agreed with Matsuda and decided that the mark VALENTINO RUDY & V Device was eligible for registration, with or without conditions, depending upon the Registrar's discretion. The DIP and Valentino filed an appeal with the Supreme Court.

The Supreme Court first held that both parties' marks were similar in appearance and pronunciation because they contained the same word "Valentino" and letter "V" and the position of the letter "V" was similar, although the stylization of the word and the letter were somewhat different. Also, the goods of both parties were in the same class and were related. These factors may cause confusion to the

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Trademark Act, Section 27, Paragraph 1

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 to each other under Section 20 in respect of goods of the same or different classes, but in the Registrar's opinion are of the same character, and the Registrar deems that the trademark has 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 ones for more than one proprietor, subject to such 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 trademarks who have been granted registration of his decision and reasons therefor.

public as to the source of the goods. The Supreme Court further mentioned that the word “Valentino” comprised part of Valentino’s mark, even though it had been disclaimed. Therefore, the whole trademark must be taken into consideration for the similarity issue.

For the next step in its reasoning, the Supreme Court further considered whether these two similar marks could be allowed for registration under Section 27. The Supreme Court elaborated that in granting a registration based on concurrent use in good faith or special circumstances under Section 27, the applicant must prove their use of the mark with the applied-for goods in Thailand before the application for the mark had been filed in Thailand. The Supreme Court found that “Valentino Rudy” was the name of an Italian designer, and Matsuda submitted evidence of use of the mark with clothing. There was no evidence showing the use of the mark with the goods covered by the trademark application in Class 21 before March 7, 1997.

Based on this, it could not be proven that the mark VALENTINO RUDY & V Device had been honestly and concurrently used with the goods in Class 21 or that special circumstances existed. The Supreme Court disagreed with the IP&IT Court’s ruling and held that the Board’s decision to reject the mark was correct (although the Court relied on different reasoning than the Board).

Therefore, Matsuda’s mark was deemed unregistrable and was rejected.



Lessons for Brand Owners

Based on these Supreme Court decisions, it is clear that use of a trademark in Thailand is very important when seeking registration under the concurrent use or special circumstances provisions of Section 27. The Matsuda case, in particular, shows that the applicant must present clear evidence of use not just for the mark in general, but also for the specific goods covered by the application. And this use must be shown in Thailand prior to the application date of the mark. Of course, it is also necessary for the applicant to demonstrate its good faith in applying for the mark. Taken together, this evidentiary burden would be difficult to overcome for some applicants.

Yet the Supreme Court’s decision to allow registration in the Anna Sui case should be viewed as an important development for brand owners who have struggled to register their marks in Thailand due to a confusingly similar prior registration. This decision shows that, with the right evidence in hand, it is indeed possible to overturn a rejection by the Registrar, the Board, and the IP&IT Court. 🏆