

World Trademark Review *Daily*

Supreme Court: generic or common words may be distinctive
Thailand - Tilleke & Gibbins

Examination/opposition
National procedures

July 25 2014

The [Thai Trademark Act](#) provides no restriction on the registration of marks that consist of Roman letters, Arabic numerals, mathematical symbols, scientific symbols or abbreviations. However, in practice trademark registrars order that such elements be disclaimed or reject applications for marks consisting of such elements in their entirety on the ground that these elements are common or generic terms, or have general meanings. Therefore, many applicants simply decide to disclaim such elements in their marks in order to allow the registration process to continue. However, there is still a risk that marks consisting of such generic elements will be considered unregistrable. Some trademark owners challenge refusals by the registrar by initiating a lawsuit before the Central Intellectual Property & International Trade Court (IP & IT Court).

In 2007 [Club 21 Private Limited](#) filed three applications to register the trademark/service mark CLUB 21, depicted below, for goods and services in Class 16 (magazines), Class 25 (shirts and sports shirts) and Class 35 (market research, sales promotion, opinion surveys, providing business information and business management consultancy services) of the [Nice Classification](#):



The registrar opined that Club 21's trademark was not distinctive, as the word 'club' is a common word meaning an organisation for people who have a common interest in a particular activity, and does not enable the public or customers to distinguish goods or services bearing that mark from the goods or services of others. In addition, the registrar stated that the number 21 in Arabic numerals does not have any special characteristics. Hence, the three applications were rejected.

Club 21 filed appeal petitions with the Board of Trademarks, which confirmed the rejection orders. Club 21 (as plaintiff) then appealed to the IP & IT Court through a civil suit against the Department of Intellectual Property (as defendant).

The IP & IT Court found that the plaintiff's trademark was registrable, as the mark made no direct reference to the character or quality of the goods and services at issue. The Department of Intellectual Property disagreed with the IP & IT Court's judgment and filed an appeal petition with the Supreme Court.

On May 27 2014 the Supreme Court pronounced its judgment. The Supreme Court ruled that the plaintiff's trademark was distinctive under Section 7 of the Trademark Act, and further elaborated that "a distinctive trademark" is one which enables the public or users to distinguish the goods bearing that mark from the goods of others. The provisions of the Trademark Act do not stipulate that a generic word or a word with a general meaning cannot be distinctive.

Although the plaintiff's trademark was composed of the word 'club' and the number 21, which are both common, the combination of these two elements made no direct reference to the character or quality of the goods and services specified in the applications. Moreover, the plaintiff's trademark consisted of an invented device, in which the number 21 was written in larger letters above the word 'club' within a square shape.

Therefore, the plaintiff's trademark enabled the public or users to distinguish the goods or services on which

World Trademark Review *Daily*

the trademark was used from the goods or services of others, and was thus distinctive. Consequently, the Supreme Court revoked the registrar's orders and the board's decisions, and ordered the defendant to proceed with the registration of the plaintiff's trademark for the goods and services at issue.

This judgment shows that the Supreme Court takes a broad view when considering the distinctiveness of trademarks. Roman letters, Arabic numerals, mathematical symbols, scientific symbols, abbreviations or any combination of these elements should be accepted for registration and considered distinctive, as long as they make no direct reference to the character or quality of the goods or services specified in the application.

Nuttaphol Arammuang, Tilleke & Gibbins International Ltd, Bangkok

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.