

Supreme Court considers continued and honest concurrent use of trademarks

Thailand - Tilleke & Gibbins

Examination/opposition National procedures

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When registering a trademark in Thailand, applicants often face obstacles both in proving the distinctiveness of their marks and in avoiding citations for similarity to pre-existing marks. Although the [Thai Trademark Act](#) allows trademark owners to prove distinctiveness through continued and honest concurrent use, this approach rarely succeeds.

In February 2015, however, the Supreme Court confirmed that [Jaspal Co Ltd](#), a clothing company in Thailand, had successfully proved continued and honest concurrent use of its trademarks.

In 2005 Jaspal filed three trademark applications for marks containing the word 'chaps' for clothing products in Class 25:



The registrar and the Board of Trademarks concluded that the word 'chaps' means "coats made of leather" and "leather pants for cowboys", which directly describes the quality and/or appearance of clothing products in Class 25. Thus, the trademarks were deemed to lack distinctiveness. In addition, the trademarks were deemed by the registrar to be confusingly similar to the earlier registered trademark depicted below in Class 25:



Due to the lack of distinctiveness of the marks and their similarity to an earlier registration, the registrar and the board rejected Jaspal's trademark applications. Although the applicant had submitted evidence of use of these trademarks in Thailand, the evidence was deemed insufficient to prove acquired distinctiveness through use.

The case was brought before the Intellectual Property and International Trade Court (IP & IT Court) in 2009. Jaspal argued that its trademarks:

- did not directly describe the qualities and appearance of clothing products in Class 25;
- were not confusingly similar to the earlier registered trademark; and
- had acquired distinctiveness through use and had been used in an honest manner.

The arguments were supported by evidence of use of the trademarks in Thailand since 1983. The IP & IT Court overturned the registrar's and the Board of Trademarks' decisions and instructed the registrar to proceed with registration of the trademarks.

The Department of Intellectual Property disagreed with the IP & IT Court's judgment and filed an appeal with the Supreme Court in 2011. After reviewing the arguments and supporting evidence, the Supreme Court rendered its final judgment, deciding as follows:

1. The word 'chaps' directly described the qualities and appearance of clothing products in Class 25, and therefore, lacked inherent distinctiveness.
2. The evidence of use of these trademarks since 1983 was sufficient to prove that these trademarks

had been continually used, distributed and advertised in Thailand so that they had acquired distinctiveness through use.

3. Jaspal's trademarks and the earlier registered trademark shared the word 'chaps', and the surrounding elements were in similar positions. Jaspal's trademarks were thus confusingly similar to the earlier registered trademark.
4. The evidence of use since 1983 proved that the trademarks had been continually and honestly used both before and after 1995, which was the year when the cited trademark was registered. Additionally, Jaspal had spent a great amount of money distributing and advertising products under these trademarks in Thailand over a long period of time. Therefore, although Jaspal's trademarks were confusingly similar to the registered trademark, Jaspal and the owner of the registered mark had used their trademarks concurrently and honestly. This special circumstance fell under Section 27 of the Trademark Act, and so the registrar should allow the registration of these trademarks.

The Supreme Court's judgment illustrates that evidence showing continued and honest use of a trademark in Thailand, such as yearly product sales and advertising expenditures since first use, lists of shops or distributors, advertisement channels, and market research in connection with trademark awareness, are very important and useful to trademark owners if their marks lack inherent distinctiveness and/or are similar to an earlier registered trademark.

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