

## Recent Board of Trademarks decisions on similarity encouraging for trademark applicants Thailand - Tilleke & Gibbins

## Examination/opposition National procedures

June 03 2015

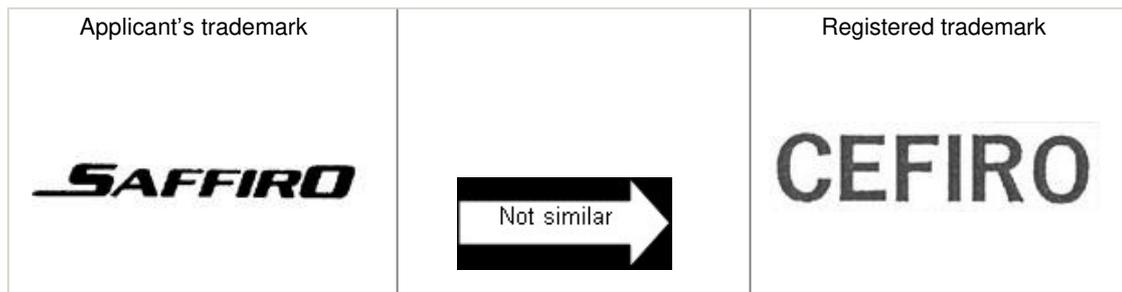
When determining whether trademarks are identical or similar, trademark registrars and the Board of Trademarks used to be very consistent in their decision-making. In most cases, if a registrar refused to register a trademark and the applicant appealed the decision to the Board of Trademarks, the board would typically confirm the registrar's order and refuse to register that trademark. Only in unusual circumstances would the board overturn an earlier decision by the registrar.

However, more recently, there has been a divergence between the decisions made by the registrars and the Board of Trademarks. In a number of cases, the registrar has reached a conservative decision, refusing applications on the basis of their similarity to registered marks. On appeal, however, the board has taken a broader view and found that the marks were not sufficiently similar to cause confusion among the public. Through the examination of two recent cases in which the board reversed an earlier decision of the registrar, this update will discuss this trend and consider what it means for trademark applicants.

In the first case, the applicant's SAFFIRO mark was refused by the registrar based on its similarity to the previously registered CEFIRO mark. The applicant appealed this decision to the Board of Trademarks.

In comparing the trademarks, the board opined that, although the trademarks each have three syllables and end in 'firo', the letters in the first syllable of each mark (ie, 'saf' and 'ce') created a visual difference between the trademarks.

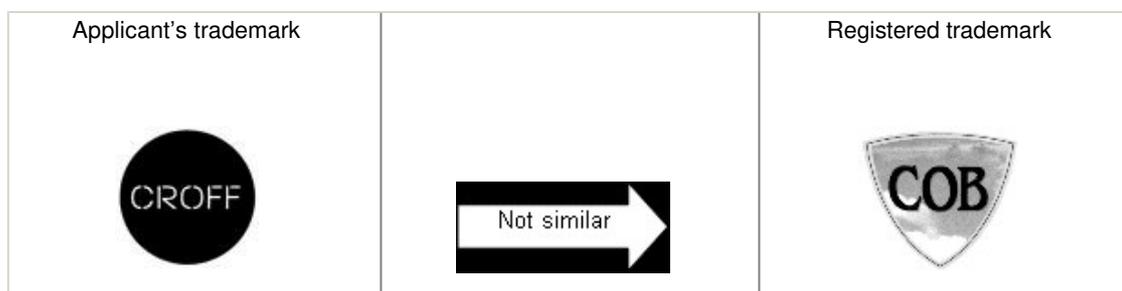
Regarding pronunciation, the board noted that the applicant's trademark can be pronounced 'saf-fi-ro', whereas the registered trademark can be pronounced 'ce-fi-ro'. Therefore, the pronunciations of the parties' marks were different, so that there would not be confusion among the public as to the ownership or origin of the goods. Hence, the applicant's trademark was not considered similar to the registered mark, and in Decision No 1149/2557, the Board of Trademarks declared that the mark was registrable.



A second case in which the board overturned a decision of the registrar involved the refusal of the mark CROFF (and circle device) based on its similarity to the mark COB (and shield device).

Disagreeing with the registrar's initial refusal of the applicant's mark, the board held that the word element 'croff' in the applicant's trademark was placed in a circle device, while the word element 'cob' in the registered trademark was placed within a shield device. Therefore, the trademarks were visually different.

Further, the board found that the applicant's trademark can be pronounced 'croff', whereas the registered mark can be pronounced 'cob'. These differences ensured that there would not be confusion among the public as to the ownership or origin of the goods. The board therefore decided (in Decision No 1152/2557) that the applicant's trademark was not similar to the registered mark and could proceed to registration.



These decisions are encouraging for trademark applicants. In the past, applicants were frequently disappointed when marks that were allowed to co-exist in other jurisdictions were refused by the Thai registrars on similarity grounds, and these decisions were then upheld by the board. The board's more recent decisions have shown a willingness to challenge the criteria used by the registrars and focus on the real possibility of public confusion, rather than on vague similarities in appearance or pronunciation.

*Sunisa Trakulwongveera, Tilleke & Gibbins International Ltd, Thailand*

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