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Case Study: The Supreme Court's Interpretation on Descriptive Trademarks

Lack of distinctive character is one of the most common reasons raised by the Trademark Registrar and the Board of Trademarks in Thailand to reject a trademark for registration. Given that many brand owners face strict examination regarding the distinctiveness of their trademarks, several cases have been brought before the Central Intellectual Property and International Trade Court (IP&IT Court) in an attempt to reverse decisions by the Registrar and the Board. Recently, the Supreme Court rendered an interesting judgment on descriptive trademarks that may allow brand owners' trademarks to be more smoothly registered in Thailand.

In this case, the applicant filed a trademark application for **Superdry** in Class 25 covering certain clothing goods (belts, beach shoes, beach clothing, caps, hats, baseball caps, sun hats, casual clothing, hooded sweatshirts, jeans, printed t-shirts, lined and unlined jackets, etc.). The Trademark Registrar rejected this trademark for registration on the grounds of nondistinctiveness because the Registrar took the view that the applicant's mark, SUPERDRY, was descriptive of the characteristics of the goods.

The applicant appealed the Registrar's decision to the Board of Trademarks. The Board, however, relied on the Registrar's reasoning and added that the term "Superdry" and the Japanese characters that accompany the name SUPERDRY mean "very dry or extremely dry." Therefore, it may be understood by consumers that the goods under this trademark have a quick-drying texture that makes users feel dry and comfortable, thereby demonstrating to the consumer that the qualities of SUPERDRY's clothing are better in this regard than clothing under other trademarks.

In a challenge to the Board's decision, the applicant appealed this case to the IP&IT Court by arguing that the trademark SUPERDRY should not be deemed descriptive of the characteristics of the goods for which protection was sought and therefore ought to be a registrable trademark. On the plain meaning of the term, "Superdry," the IP&IT Court agreed with the Board's reasoning that the word "Superdry" can be interpreted to mean very dry or extremely dry. On the issue of distinctiveness, however, the IP&IT Court determined that these meanings would not influence the general public's immediate understanding or recognition of the type(s) of goods under this trademark. Therefore, the Court held that the trademark was distinctive.

Strictly speaking, we at Tilleke & Gibbins are of the opinion that the judgment of the IP&IT Court is not completely correct since the issue of this case was whether the word "Superdry" was descriptive of the *nature or the characteristics of the goods* (not whether the word was descriptive of the *type* of goods).

Eventually, the case was appealed to the Supreme Court, which initially ruled that, "To determine whether a word is directly descriptive of the nature or characteristics of the goods, it should consider whether the word enables the public to immediately know or understand the characteristics of the goods. If the word is a generic term that is closely related to the nature or characteristics of the goods, or the general public can use only limited judgment to know the nature or characteristics of the goods bearing the trademark, that word shall be deemed directly descriptive of the nature or characteristics of the goods." Moreover, the Court further ruled that if a trademark is a word for which consumers need to use significant consideration or imagination to understand the nature or characteristics of goods under such a trademark, that word would not be regarded as being directly descriptive of the nature or characteristics of the goods.

In this case, even though the Supreme Court found that the word "Superdry" does not have any meaning in a standard English language dictionary, the applicant did not deny that the word "Superdry" is a combination of the words "super" and "dry," which, when taken together, could be interpreted to mean *extremely dry*. If this trademark were used with goods that claim "dryness" as a special feature, such a word would be descriptive of the characteristics of goods. In any case, the Supreme Court determined that the goods, as filed for trademark registration, comprised belts, shoes, hats, shirts, pants, casual clothing, scarves, gloves, and underwear, which are articles of apparel and accessories for which a quick-drying feature is not a particularly special feature that consumers need. The word "Superdry," therefore, does not directly refer to the nature or characteristics of the goods.

In addition, the Supreme Court opined that the trademark, SUPERDRY, is comprised of the words "super" and "dry" only. Therefore, it is quite difficult for the general public to understand that the goods under this trademark are quick-drying, as was determined by the Board of Trademarks. Moreover, the Court found that even if the word "Superdry" could be interpreted to mean "quick-drying," it does not refer to the nature or the characteristics of the goods. Ultimately, the SUPERDRY trademark was adjudged to be distinctive for registration.

From our review of the Supreme Court's decision, the Court's ruling is aligned with the interpretation of distinctiveness of trademarks in international practice. The Supreme Court highlighted that, in order to be deemed nondistinctive, a word must be capable of making the general public immediately understand, or use only limited consideration or imagination to understand, the nature or characteristic of goods for which protection is sought. On the contrary, if the general public needs to apply at least reasonable consideration or imagination to understand the connection between the word and the goods for which it is used, then such a word cannot be interpreted to be a directly descriptive word.

This Supreme Court decision serves as a good guideline for brand owners who may face similar problems when registering their trademarks in Thailand. Moreover, if the Trademark Registrar and the Board of Trademarks strictly rely on the guidelines provided by the Supreme Court, it would standardize trademark registration practice in Thailand to be identical to and consistent with international trademark practice. 🏆