



Piyawat Kayasit
Attorney-at-Law
piyawat.k@tilleke.com

A Novel Approach to Evaluating the Similarity of Trademarks in Thailand




The Court of Appeal for Specialized Cases (Specialized Appeal Court) was established in October 2016 to review all appeals against the judgments of the five specialized first instance courts in Thailand, including the Central Intellectual Property and International Trade Court (IP&IT Court). Most, if not all, judges of the Specialized Appeal Court, who are responsible for reviewing IP-related appeals, have had experience working as judges at the IP&IT Court and can be expected to be well versed in IP law and practices. They are capable of providing fair, practical, and sometimes novel judgments, as illustrated in a recent case involving how similarity of trademarks should be evaluated.

Opposition of Similar Trademarks

In June 2009, a Thai company filed an application for registration of the trademark MOBIL-AG & Device, Application No. 734360, for use with goods in Class 1, namely chemical fertilizers. This application was subsequently published in a trade gazette in September 2012. As the applicant's mark is closely similar to the well-known registered trademarks of Exxon Mobil Corporation ("ExxonMobil"), ExxonMobil filed an opposition petition against this application with the Trademark Office in December 2012 under Section 13 of the Trademark Act, among others. The opposition was based on several prior registered trademarks of ExxonMobil, particularly:

1. Trademark Registration No. Kor. 63198, registered for use with goods in Class 4, including lubricant oil, kerosene, gasoline, diesel; and
2. Trademark Registration No. Kor. 99756, registered for use with goods in Class 5, including antiseptics in plants and pesticides.

The marks are shown in the table below.

ExxonMobil's Trademarks	Applicant's Trademark
	
Trademark Reg. No. Kor. 63198	Trademark Appl. No. 734360
	
Trademark Reg. No. Kor. 99756	

Even though the Trademark Office Registrar found that

the applicant's trademark and ExxonMobil's trademark MOBIL, Reg. No. Kor. 63198, are similar, the registrar unfortunately dismissed the opposition because it found that both marks are for use with goods in different classes and that the lists of goods were not of the same character.

ExxonMobil then appealed the decision to the Board of Trademarks, which dismissed the appeal based on the same reasons. ExxonMobil therefore further appealed the decision by filing a lawsuit with the IP&IT Court.

IP&IT Court's Judgment

In January 2017, after reviewing the evidence and statements of witnesses produced by both parties, the IP&IT Court rendered judgment dismissing the lawsuit. The IP&IT Court found that (1) the appearances and pronunciations of both parties' marks were different; (2) the classifications of the goods of both parties' marks were different; and (3) the lists of goods of both parties' marks were not related. The court therefore ruled that the applicant's mark was not prohibited from registration under Section 13 of the Trademark Act. Disappointed with the judgment, ExxonMobil instructed Tilleke & Gibbins to appeal the IP&IT Court judgment to the Specialized Appeal Court.

Specialized Appeal Court's Judgment

On October 11, 2017, the Specialized Appeal Court rendered judgment finding that the applicant's Trademark Application No. 734360 is similar enough to ExxonMobil's Trademark Registration Nos. Kor. 99756 and Kor. 63198 so as to cause confusion among the public.

Even though both parties' marks are for use with goods of different classes, the lists of goods were found to have the same character. Accordingly, the applicant's Trademark Application No. 734360 is not registrable under Section 13 of the Trademark Act. The Specialized Appeal Court therefore reversed the judgment of the IP&IT Court and ordered that the prior decisions of the Trademark Registrar and the Board of Trademarks be withdrawn.

It is interesting to note that the Specialized Appeal Court not only addressed the similarity of both parties' marks, element by element, but also discussed the origin of the word "MOBIL." Particularly, it stated that this word is not Thai, but foreign. If this foreign word has not been used until it has a comparative meaning in Thai, there would be limitations for general consumers to recognize and remember it. Most importantly, "MOBIL" does not have a meaning in the dictionary and ExxonMobil's witness confirmed that the word has been used as a trademark since 1906 and has been registered worldwide. It can therefore be concluded that the applicant used the same word as that of ExxonMobil as a part of its trademark.

Moreover, in the appeal, in addition to the similarity issue, ExxonMobil argued that its registered trademarks are well known, and the applicant, who was well aware of ExxonMobil's well-known mark, applied for registration of a similar mark in bad faith. Even though the Specialized Appeal Court did not discuss or rule on the well-known and bad faith issues, it is obvious that these arguments were taken into consideration when evaluating the similarity between both parties' marks.

The ruling has positive implications for future similar cases in Thailand as it implies that, in deciding whether an applicant's trademark is prohibited from registration under Section 13 of the Trademark Act, the Specialized Appeal Court will take into consideration the fame of the prior registered trademark and the bad faith of the applicant. This approach should help in deterring any bad faith applicant from imitating other parties' well-known trademarks or applying for registration of such imitation trademarks. 🐉