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The Distinctiveness of Thai Language Marks Using Foreign Language Pronunciation

Trademark lawyers and brand owners generally agree that the process of filing a new application for trademark registration in Thailand is not always as straightforward as hoped. One of the greatest challenges for a trademark owner in this process is the discretion granted to the registrar and the Board of Trademarks when assessing the distinctiveness factor of a mark. The registrar and the Board of Trademarks usually take a deliberate approach, using their sole discretion, when examining the distinctiveness of a mark, which can lead to several interpretations of a mark's meaning, sometimes resulting in the unexpected rejection of a mark on grounds of nondistinctiveness.

INTOUCH Case Study

In a recent case handled by Tilleke & Gibbins, the applicant filed an application for the **อินทัช** mark, a Thai word mark using the English pronunciation of "INTOUCH," in international class 9, covering digital mobile phones, batteries, earphones, chargers and other related goods. The registrar first rejected the mark, finding that the Thai mark contained the English pronunciation of "INTOUCH," which was comprised of the word "in," which can mean "inner or inside," and the word "touch," which can mean "to touch, rhyme, or connect." When considering the words together, the registrar reasoned that the mark "INTOUCH" has the meaning "to touch inside, to be connected, or to be contacted," which was found to be directly descriptive of the characteristics of the proposed goods. Although the applicant argued in its appeal to the Board of Trademarks that the mark "INTOUCH" was a single coined word and could not be interpreted as separate elements, as is normally the case, the board relied on the registrar's discretion.

With the intention to reverse the registrar's and board's discretion on the nondistinctiveness issue, the applicant appealed to the Intellectual Property and International Trade Court (IP&IT Court), arguing that the mark was sufficiently distinctive, as it was an invented word with no meaning in any dictionaries. The applicant also argued that the mark had been used with its goods and services and thus had become well known to the public. As a result, the IP&IT Court ruled in favor of the applicant, holding that the mark was distinctive and ordered that the board's decision be reversed. The Board of Trademarks, as the defendant, appealed to the Court of Appeal for Specialized Cases, which then reversed the judgment of the IP&IT Court.

Ultimately, this long legal battle was brought before the Supreme Court on the issue of whether the applicant's mark was directly descriptive of the characteristics of the goods. The court ruled that, to determine whether the pronunciation of the mark was directly descriptive in accordance with

Thai Trademark Act, it should consider the following elements:

1. The meaning of the term in the Thai language;
2. The common usage of the term in Thailand; and
3. The relationship between the term and the characteristics of the goods or services.

When considering these three elements together, the mark must be sufficiently descriptive for the public to understand immediately, in a straightforward way, that the mark directly describes the goods without having to use much consideration or imagination to make the connection. If the public needs to expend much thought, imagination, or consideration in order to understand the characteristics of the goods, then the mark might not be considered a directly descriptive mark. In this case, the applicant was able to prove that the mark was the homophone of the English words "in touch"—that is, a combination of the words "in" and "touch." This mark could not be interpreted by the meaning "to touch inside, to be connected, or to be contacted," as claimed by the Board of Trademarks. Additionally, the court ruled that the board did not employ the most direct interpretation but instead indicated an interpretation for which there was no clear evidence as to why it was the most appropriate interpretation.

Accordingly, the court opined that even though there was a definition for "be in touch," meaning "to contact," in the Oxford English Dictionary (as referred to by the registrar and the Board of Trademarks), the mark "INTOUCH" was formed by combining two words, neither of which was directly interpretive or directly descriptive of the characteristics of the goods. The term "be in touch" can be defined using several meanings, and thus the general public in Thailand would not understand the meaning in a straightforward manner without using much consideration. As such, this mark was deemed to be sufficiently distinctive for registration.

Provisions from the Case

In this case, the court laid out three main considerations for determining whether a mark using foreign wording is descriptive (and thus not registrable as a distinctive trademark):

1. In order to determine the distinctiveness of a mark created using the Thai alphabet or words, but containing pronunciations in a foreign language, the true meaning of the foreign-language pronunciations must be taken into consideration.
2. The true meaning of such pronunciations must be directly descriptive of the nature or characteristics of the goods, unless the mark cannot be considered a nondistinctive mark.
3. The terms contained in a mark indicating one or more of the true meanings of these terms cannot be deemed as directly descriptive of the nature or characteristics of the goods.

These are new guidelines for determining the distinctiveness of a mark using foreign language pronunciation. This case was the first on record where the court reasoned in this particular way, especially with regard to the direct interpretation of the true meaning of a mark.

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Implications for Brand Owners

From this case study, as well as from many other court cases deliberating the distinctiveness of certain marks, it can be noted that the conservative examination and discretion of the registrar and the Board of Trademarks are often more strictly applied than the judgment of the court. Nevertheless, the current practice of the registrar and Board of Trademarks is likely to continue in the near future. Thus, to secure successful registration, applicants must be certain of the qualifications of their proposed marks in terms of distinctiveness. Carefully undertaking trademark searches at the Department of Intellectual Property for each international class for which an applicant would like to file an

application can increase the chances for successful registration and help avoid possible opposition raised by third parties.

However, ultimately the decision as to whether or not to move a mark toward registration is still reliant on the registrar's sole discretion.

As the court has now set out these new tests for consideration of the distinctiveness of a mark, brand owners can feel reassured that the court takes a broader view than the registrar or Board of Trademarks when passing judgment or rendering its opinion on a trademark's registrability .

Furthermore, it is hoped that the tests for distinctiveness set out by the Supreme Court in several prior decisions regarding the examination criteria for the distinctiveness of marks might be used as guidelines to standardize the practice of the registrar and the Board of Trademarks in the near future. 🙏