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## Booking.com: An Example of Domain Name Marks Acquiring Distinctiveness in Thailand

T rademarks that consist of a combination of a generic word and a top-level domain name, such as “.com,” are usually regarded as not registrable by trademark registrars. However, recent cases in the United States and in Thailand have proved that this premise is not always valid. In some instances, the combination of a generic word and a domain name only make the mark descriptive, but such a mark may still be registrable if the applicant can prove that it has achieved secondary meaning in that jurisdiction.

In late June 2020, in *Patent and Trademark Office v. Booking.com B. V.*, 591 U.S. (2020), the Supreme Court of the United States decided in favor of Booking.com, one of the world’s leading digital travel companies, and rejected the United States Patent and Trademark Office’s argument regarding the generic nature of the mark. In the judgment, Justice Ginsburg determined that consumers do not in fact perceive the term “Booking.com” as a generic name and that the mark could act as a source identifier for its services. As a result, the U.S. Supreme Court affirmed that “Booking.com,” as a descriptive mark, had acquired distinctiveness and was eligible for trademark protection.

It is less widely known that before this ruling—in March 2020—Thailand’s Court of Appeal for Specialized Cases announced its own judgment regarding the Booking.com key service marks BOOKING.COM, **Booking.com**, and **Booking.com**, reaching similar conclusions. This judgment was rendered following an appeal by Thailand’s Department of Intellectual Property (DIP) against the judgment of the Central Intellectual Property and International Trade Court (IP&IT Court) in *Booking.com B.V. v. Department of Intellectual Property* [2019].

### Background

The history of this case dates back to 2012, when Booking.com applied for trademark registration protection for its iconic “Booking.com” marks. The marks were examined and rejected by the Thai Trademark Registrar, and then by the Board of Trademarks on appeal, due to their lack of distinctiveness. The Thai Trademark Registrar and the Board of Trademarks found the marks to be descriptive when applied to the relevant services, and decided that the marks had not yet acquired distinctiveness through use in Thailand.

Booking.com then appealed to the IP&IT Court, which ruled in favor of the company on May 13, 2019, affirming that the Booking.com marks are distinctive and registrable under Thai trademark law, and overruling the Board of Trademarks’ decision to reject the trademark applications for several of Booking.com’s marks. On September 5, 2019, the DIP filed an appeal petition with the Court of Appeal for Specialized Cases, which ruled on January 21, 2020 (published March 19, 2020) to uphold the decision of the IP&IT

Court. The DIP requested that the court extend the deadline to request permission to appeal to the Thai Supreme Court, but later decided not to proceed further with the case. As a result, the judgment of the Court of Appeal for Specialized Cases became final.

### Decision of the IP&IT Court

At the IP&IT Court stage, Booking.com argued that their marks are inherently distinctive and had acquired secondary meaning through wide and long-term use in Thailand. In order to support this argument, Booking.com submitted evidence of use—such as publicity and advertising—and brought several witnesses to testify before the court. Booking.com presented its publicly conducted survey to the court, demonstrating that the relevant segment of the general public in Thailand recognizes the Booking.com marks as service marks. The IP&IT Court was convinced by these arguments, and decided that the Booking.com marks were either inherently distinctive or distinctive through use. For the inherent distinctiveness issue, the IP&IT Court concluded that an ordinary Thai person with a general understanding of English might not view the Booking.com marks as descriptive terms. In addition, the court considered the Booking.com marks to have clearly acquired distinctiveness through use.

### Decision of the Court of Appeal for Specialized Cases

Although the Court of Appeal for Specialized Cases affirmed the IP&IT Court’s decision that the Booking.com marks are distinctive and legally registrable, their rulings differed on the reasoning. The appellate court considered the Booking.com marks to be descriptive marks that had acquired distinctiveness through use, but not inherently distinctive marks. Particularly, the court considered that particular components, such as the internet domain name suffix “.com,” could not be regarded as invented words, which are presumably distinctive. Thus, the court decided that the term “Booking.com” is descriptive when used with the applied services. Nevertheless, once the court deliberated over the evidence submitted, including Booking.com’s witnesses, evidence, and public survey, it firmly resolved that the Booking.com marks have been widely used and advertised continuously for at least 10 years, which is considered an adequate length of time, until the general public or relevant sector of the public were able to recognize without confusion that the services under the subject marks are different from others’ services. Interestingly, in support of its decision the court quoted several witness testimonies from the cross-examination session, which indicated that even the defendant’s witnesses actually recognized the Booking.com marks as service marks without any confusion.

### Conclusion

The determination and reasoning in the Thai judgment of the Court of Appeal for Specialized Cases differs from the key issues addressed in the US Supreme Court’s judgment. The case in Thailand was not about whether the marks were generic, but rather concentrated first on whether the Booking.com marks were indeed descriptive, and then—if found to be descriptive—on whether the marks had acquired distinctiveness through use. However, both the US and Thai cases resulted in the conclusion that the Booking.com marks were descriptive, but were widely recognized and had achieved secondary meaning in each court’s respective jurisdiction.

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## Booking.com (from page 6)

Another notable similarity between the two cases was the submission of public consumer surveys as evidence of consumer perceptions about the distinctiveness of Booking.com's marks. Conducting the surveys proved to yield valuable supporting evidence germane to the courts' determinations in both jurisdictions. In Thailand, the use of consumer surveys as evidence in cases regarding non-distinctiveness of a trademark is extremely rare. However,



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## Cancelling a Thai Trademark Registered in Bad Faith

It is not unusual for brand owners to take a closer look at the Thai market for their products only to find that a third party has already applied for registration of their trademark. Brand owners who face this situation usually become aware of it when they consider entering the Thai market after their brand has already become famous and successful elsewhere. Well-known marks are often usurped when a bad-faith applicant intentionally registers a trademark to benefit from the goodwill and reputation associated with that trademark. As Thailand is a first-to-file system for trademark registration, supplying proof of intention to use is not a requirement for registration. Thus, if a legitimate brand owner has never registered their trademark in Thailand, a bad-faith applicant might take advantage of this opening to file another person's trademark in his or her own name.

Overlooking the early securing of trademark rights in Thailand can lead to complex problems, even when brand owners have a relationship with a distributor in Thailand. The problem usually comes to light when a brand owner seeks to end their relationship with one distributor and start a business relationship with a new partner. In some cases, brand owners are blindsided when they learn that the previous distributor had surreptitiously filed for registration of the trademark in the distributor's own name without alerting them—meaning that the former distributor now holds exclusive rights over the use of the trademark in Thailand.

After finding out about a bad-faith trademark registration, many brand owners seek to cancel the Thai registration of the trademark to which they have better rights than the registrant. The Trademark Act provides several mechanisms that brand owners can rely on to pursue cancellation of trademark's registration; however, none of the law's provisions clearly state the possibility of cancelling a trademark registered in bad faith. Below, we explore two possible methods for cancellation of a bad-faith registration, depending on which authority considers the matter.

### Cancellation with Board of Trademarks

A cancellation petition may be filed with the Board of Trademarks through one of two routes—one for “interested parties” (that is, affected parties, such as a legitimate brand owner) and one for anyone. While neither route is based on legal provisions clearly stating how to cancel a registration

according to the judgment of the Court of Appeal for Specialized Cases, a survey can supplement the evidence adduced and can help prove whether a mark can convey a source-identifying meaning in the view of the public consumer.

These similarities are encouraging both for their confirmation that brand owners with well-known descriptive marks still have avenues available for protecting their intellectual property, and for their indication of consistency in the treatment of trademarks in two varying jurisdictions (i.e., Thailand and the U.S.).

based on a bad-faith argument, they are viable possibilities for those seeking cancellation, with different criteria and requirements pertaining to each route.

If an interested party files a cancellation petition with the Board of Trademarks to challenge the mark's general registrability, the board will re-examine the distinctiveness, similarity, and legality grounds under section 61 of the Trademark Act. As a legitimate brand owner usually qualifies as an interested party, that owner can file a petition to cancel the mark on grounds that it is identical or confusingly similar to the legitimate owner's trademark, which was already registered outside of Thailand, and should therefore not have been filed.

A person not claiming interested-party status who wishes to file a cancellation petition must be of the opinion that the registered trademark is contrary to public order, morality, or public policy (Trademark Act, Section 62). As a bad-faith filing may be interpreted as contrary to these things, it should qualify for cancellation.

However, proving the bad faith of the registrant to the Board of Trademarks can be difficult, since there are no witness hearings. The Board of Trademarks considers only documentary evidence, which usually does not clearly reveal the registrant's intention, whether the registrant possessed knowledge of the original brand, or whether they intentionally copied the original brand to be registered as their own.

### Cancellation with the IP&IT Court

Better right grounds—that is, assertions that the genuine brand owner has a more legitimate right to use their own trademark than the registrant in Thailand does—are typically the most relevant legal grounds for cancellation of a trademark registered in bad faith. Section 67 of the Trademark Act provides that a legitimate owner may file a lawsuit for cancellation of a bad-faith trademark registration on better right grounds in the Central Intellectual Property and International Trade Court (IP&IT Court), provided that it has been registered for less than five years.

If a trademark has been registered for more than five years, it cannot be cancelled. This has already been challenged in court, with at least one brand owner arguing that the five-year limitation should only apply if the trademark in question was filed in good faith, and that brand owners should be able to cancel trademarks registered in bad faith even after the five-year period has expired. However, the Supreme Court rejected the argument and ruled that, as the five-year time period had expired, the trademark registration in that case could not be cancelled despite the brand owner having a better right to it.

Proving the bad faith of the registrant can be easier and have higher chances of success in the IP&IT Court, so most legitimate brand owners opt to do this rather than file a cancellation against a bad-faith registration through the Board of Trademarks. Again, however, if the trademark registration has been active for longer than five years, the IP&IT Court will reject the request.

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