



Basic search

By Keyword

Channels

- Registration
 - National procedures
 - International procedures
 - Examination/Opposition
- Cancellation
- Enforcement
- Infringement
- Ownership changes
- Related rights
- Internet issues
- Other issues

Information

- Contributors
- Testimonials
- About us
- Contact details
- Terms & conditions

Other World Law Report sites:

Copyright

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Yearbook 2007

April 24 2007 - Thailand

Tilleke & Gibbins International Ltd

Restaurant name dispute resolved by IP & IT Court

Print version

The Intellectual Property and International Trade Court (IP & IT Court) has issued a decision clarifying the ownership of a trade name following the plaintiffs' sale of a restaurant business to the defendants a company and its directors. After several years, however, the former owners attempted to reassert their rights to the Tawandang-Sard-Saeng-Deun trade name, claiming that the name of the restaurant had not been sold at the time the ownership was transferred.

Based on the Tawandang-Sard-Saeng-Deun name, the defendants had registered a RONG BEER GERMAN TAWANDANG device mark and were also using this sign as a trade name. The plaintiffs filed a cancellation action with the IP & IT Court against the trade name and device mark, claiming that they were the original owners of the name Tawandang (meaning 'red sun' in Thai).

The IP & IT Court accepted evidence that the plaintiffs have used the name Tawandang in conjunction with different words and devices for eight restaurants in the vicinity of Bangkok. The court noted that in 1997 the plaintiffs sold some of their restaurants to the defendants. During the sale of the restaurants there was no written statement about the assignment of the name of the restaurants.

For their part, the defendants claimed that they had the right to use the disputed name for their restaurant. In addition, the defendants pointed out that they had created a new device mark (RONG BEER GERMAN TAWANDANG) in 1999 to be used with a unique new restaurant featuring a micro-brewery. Since its inception, the defendants' new restaurant has achieved wide recognition among the Thai public as one of the most popular beer restaurants in Bangkok. Further, the evidence of record showed that three years after the plaintiffs sold their restaurants to the defendants, the plaintiffs filed various trademarks comprising the name Tawandang and a number of devices.

The court held that the plaintiffs obviously allowed the defendants to use the trade name Tawandang for three years. Although the plaintiffs registered various trademarks comprising this name, the registrations did not take place until three years after selling the restaurants. This, coupled with the other evidence of record, was not sufficient for the plaintiffs to have exclusive rights over the name Tawandang, and hence the defendants could not be prevented from using and registering the disputed mark. The defendants' trademark and service mark were considered to be different from the plaintiffs' various trademarks and service marks.

The court was of the opinion that both parties may, separately, exercise the rights to their marks. The plaintiffs have neither better rights over the disputed trade name, trademark and service mark, nor are they entitled to file a lawsuit to cancel the disputed trademark and service mark. Thus, the court dismissed the plaintiffs' case.

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