

Corporate Counsellor

TILLEKE & GIBBINS

Trademark litigation

In Thailand, the Trademark Registrar and Board of Trademarks, both governed by the Intellectual Property Department under the Commerce Ministry, generally use stringent criteria in deciding trademark issues. Section 13 of the Thai Trademark Act B.E. 2534 (1991) states:

"If in the opinion of the Registrar, a trademark for which registration is sought is: (1) a trademark that is identical to another trademark already registered by another proprietor, or (2) a trademark that is so similar to another trademark already registered by another proprietor that it confuses or deceives the public as to the proprietor or the origin of the goods, the trademark shall not be accepted for registration.

"In the event that registration is sought for a trademark that is to be used on goods of the same or different classes but is considered by the registrar to be of the same character, the trademark shall not be accepted for registration."

Not only are marks that are identical or similar in appearance to a registered trademark rejected, the registrar and the board also routinely reject marks that are identical or similar in pronunciation to any registered trademarks.

In a recent case, Perfume Christian Dior filed an application to register the mark "Higher" in International Class 3 for perfumery products, perfumes, essential oils, cosmetics, skin lotion, etc. The registrar rejected the application on the ground that the mark was identical or similar to the registered trademark "HI-ER & HI-ER in Thai characters" in International Class 3 covering skin lotion and owned by Niwat Sitarakm.

Dior filed an appeal but the Board of Trademarks affirmed the registrar's decision and opined that because the goods covered by both marks were in the same class and the marks' pronunciation was similar, there would be a likelihood of public confusion.

Dior then filed a civil action with the Central Intellectual Property and International Trade Court (IP&IT Court) seeking reversal of the board's decision.

Dior argued that its mark had been registered in good faith in more than 50

countries and submitted copies of several registrations, along with substantial evidence of use such as sales invoices and advertisements. It said the mark "Higher" was first introduced to the Thai market in 2000 by Perfume Christian Dior's authorised distributor, LVMH Perfumes & Cosmetics (Thailand) Co Ltd.

Dior also claimed that its mark "Higher" was clearly different from "HI-ER & HI-ER in Thai characters" in pronunciation and appearance. Both marks' overall appearances were markedly different in that "HI-ER" is in capital letters with a hyphen in between "HI" and "ER" followed by Thai characters, while "Higher" has only one capital letter. In addition, "HI-ER & HI-ER in Thai characters" has no meaning, whereas the plaintiff's mark does have a meaning.

Dior argued that although its goods and Mr Niwat's goods fell in the same class, their origins, packaging and targeted consumers were totally different. Furthermore, Dior's products were already on sale in leading shopping malls, but Mr Niwat's goods were not available for sale at the time of the litigation.

The IP&IT Court held that albeit the similarities in pronunciation, both marks were different. It reasoned that the essential component of the word of each mark was different in appearance and that the pronunciation of a mark was not in itself within the meaning of "Trademark" as defined by Section 4 of the Trademark Act.

The court ruled that there would not be any public confusion or deception as to the proprietor or origin of the goods under Section 13 (1) and (2), if the marks are different in appearance. However, it added that the pronunciation of a mark must still be considered, when it is identical or similar to a registered trademark in appearance.

Thus it appears that similarity in pronunciation will only become relevant when and if the two marks are substantially similar in appearance.

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