

Record Damages Award a Positive Sign for Trade Dress Protection in Thailand

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The Central Intellectual Property and International Trade Court
Black Case No. Tor Por 184/2563
Red Case No. Tor Por 170/2564

Trade dress has always been one of the most challenging forms of protection under the IP regime in Thailand. Particularly, trade dress in the “store layout” form regularly presents challenges for IP protection and enforcement, given the lack of explicit laws and precedence. In December 2021, however, Tilleke & Gibbins secured a precedent judgment on this form of trade dress from Thailand’s Intellectual Property and International Trade Court (IP&IT Court).

The Thai bubble-tea chain Fire Tiger is a successful business of Ruay Sabai Sabai Co., Ltd., and an industry pioneer in the use of eye-catching trade dress. Fire Tiger’s store design, which resembles a tiger cage, features a gold-colored sculpture of a tiger’s head with an open mouth as a product-serving channel. Ruai Sabai Sabai also developed distinctive logos, menu designs, and other creative marketing ideas for Fire Tiger, and the chain quickly gained consumer recognition and media attention.

Ruay Sabai Sabai operates over 16 Fire Tiger stores in Thailand and has expanded their franchise business in Southeast Asia. Fire Tiger’s various marks have been registered in Thailand and overseas, and their tiger-head sculpture has also been recorded with the Copyright Office.

In 2019, Ruay Sabai Sabai became aware of a competing chain of bubble-tea stores using a similar trade name and trademark containing the word “fire” plus the name of another animal. Moreover, the competitor’s stores were using a similar gold-colored sculpture of an animal head with an open mouth in a golden cage for their product-serving channel, and the menu designs and marketing ideas also showed similarities to those of Fire Tiger. The competitor expanded rapidly, amassing over 200 franchise licensees throughout Thailand within a short period.

Ruay Sabai Sabai’s attempts to contact the competitor to resolve the dispute amicably all went ignored, so in view of the damage they sustained, Ruay Sabai Sabai filed a civil lawsuit against the competitor with the IP&IT Court on November 30, 2020.



On December 23, 2021, the IP&IT Court announced its judgment, concluding that the competitor's use of the word "fire" along with an animal name as its store name and in naming its bubble-tea products (in Thai and English languages), beverage cups bearing an animal head in the same position as on Fire Tiger's cups, and an animal-head sculpture with an open mouth as a serving channel could cause the general public to understand that the competitor's bubble-tea stores originated from Fire Tiger, or that the competing bubble-tea products are derived from the same source.

Since the competitor was the same type of business as Fire Tiger, the court believed that the actions noted above would deceive the public into believing that the competitor's goods or business, including the franchise businesses, are associated with Fire Tiger. This constitutes infringement as passing off under the Trademark Act, and the court agreed that the infringement caused damage to Ruay Sabai Sabai.

The IP&IT Court awarded damages of THB 10 million (approximately USD 303,000) with interest to Ruay Sabai Sabai, together with monthly damages of THB 100,000 (approximately USD 3,030) from the filing date of the complaint until the competitor ceases its passing-off actions. The amounts awarded by the IP&IT Court in this case are the highest handed down for a trademark case in Thailand.

This judgment proves that store layout trade dress can indeed be protected in Thailand. Even without explicit provisions in the Trademark Act, the IP&IT Court recognizes IP owners' efforts and financial investment, and is open to interpreting the law in line with international standards. It is hoped that this success will lead to more comprehensive protection of trade dress in Thailand.

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