

Thailand

Q214 Protection Against the Dilution of a Trademark

SUMMARY by **Nettaya Warncke**
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Dilution is an acknowledged theory in Thailand but it is not mentioned anywhere in the trademark law. The Thai Trademarks Act orders the Registrar to refuse a mark which is identical or confusingly similar to a prior registered mark. There are also other proscriptions but none include dilution. There is a general provision rejecting a mark which is found to be against the public policy. This general provision is periodically used to reject an application for a mark proven to belong to someone else who has no registration in Thailand to form a basis for rejection on the grounds of a prior registered mark. Hence, this general provision can be used by the authorities to adopt the theory of dilution but no such exercise has been seen so far even though the issue of dilution has been raised by some opposers. Decisions are still with reasons of similarity or non-similarity or public policy. The issue of dilution or lack thereof has never been mentioned in the authorities' decisions

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REPORT

The Thai Trademarks Act was last amended in 2000, decades after the doctrine of dilution has been incorporated into the trademark law of many countries. In the latest (2000) amendment, the recognition of well known marks and special protection thereto was added to the Trademarks Act. The theory of dilution was discussed among practitioners and academicians but the Thai Trademark Office, in charge of drafting the amendment to the 1991 Trademarks Act obviously did not see the issue warrants a specific inclusion in the Act. However, one can say that a proscription under Section 13(1) of the present Trademarks Act covers the issue of dilution because it proscribes marks identical to the prior registered marks regardless of the goods and classes, unlike Section 13(2) which sets the condition of high similarity to the degree of causing confusion.

“Section 13. Subject to Section 27, the Registrar shall not register a trademark applied for upon finding that:-

(1) it is the same as a trademark already registered by someone else or,

(2) it is so similar to another's registered trademark that the public might be confused or misled as to the proprietor or origin of the goods, provided the application is for

goods of the same class or for goods of a different class found by the Registrar to be of the same character.”

The Trademarks Act Section 13(1) however does not cover the situation where 1) the established mark is not registered in Thailand and 2) the established mark is not exactly copied but used as a part of a third party's mark which in its overall appearance is not “identical” to the established mark. Neither can such a situation be handled by Section 13(2) since it may not be the question of deception of the public which is a prerequisite of Section 13(2).

The situation under the present law is however not totally hopeless because there exists a general provision of “public policy” under Section 8(9). Use nevertheless depends largely on the sole discretion of the authorities and this can render totally different results as illustrated in the following decisions of the Examiner, Trademark Registrar (in charge of oppositions) and the Trademark Board.

LIFEFORD CHIC CHANEL as per specimen shown below passed the examination process of absolute and relative grounds despite existence of several registrations of CHANEL in the same class. Chanel SA opposed when the said mark was advertised for opposition.



The Registrar in charge of opposition rejected Chanel SA's opposition on the grounds that although the parties' goods overlap, the difference in appearance and pronunciation of the marks will prevent public confusion (Registrar's Decision No. 146/2550). The Registrar seems to adhere to the routine method of considering only the public deception to decide the case although the opposition raised the issue of the destruction of the value of the trademark CHANEL if the Trademark Office allowed registration of the opposed mark despite the disclaimer of exclusive right to CHIC CHANEL. (It was also unclear as to why CHIC CHANEL was disclaimed.)

When the appeal was filed with the Trademark Board, the issue of dissimilarity and absence of public deception was sustained but the Board commented on the issue of the disclaimer of CHANEL that it was not warranted, i.e. the examiner should not have requested it. The Trademark Board went on to rule that this was the same word as CHANEL of the opposer and since the applicant provided no explanation as to why and how this word was adopted, it was therefore believed that the adoption was with bad faith, it was thus against the public policy and the entire mark was refused registration (Trademark Board's Decision No. 825/2552).

Compare the above decision of the Trademark Board with the following decisions of the Trademark Board, albeit different set of Board members due to different period (members of the Trademark Board are appointed every four years and reappointment is possible), and one can see that without specific inclusion of the doctrine of dilution in the trademark law, the issue is very much dependent on the

authorities' opinion of the cases. In the various oppositions filed by Nike International Ltd. on the basis of its registered trademark Swoosh Design, the oppositions did not raise only the issue of similarity but the dilution that registrations of opposed marks would disperse the uniqueness of its Swoosh Design. The latter was not addressed by either the Registrar or the Trademark Board in any of their decisions.



The Trademark Board's Decision No. 891/2550

Issued: 8 October 2007

Nike International Ltd., Opposer
vs
Mr. Chatchawarn Metawisarn, Applicant
of I.C. 24 application which covers mosquito nets

The Trademark Board made a comparison between the applicant's trademark






and the opposer's registered trademarks,  and , and ruled that the said trademarks were different in both appearance and pronunciation. Although relatively similar to the opposer's Swoosh Device, the stylized letter "C" was deemed distinguishable as it was positioned in a different style. [The applicant of this mark endorsed it as C BABY mark.] The addition of other elements are found to also have rendered the marks distinguishable. The Board was of the view that each of the trademarks in dispute could be called or pronounced differently and since the goods for which the parties' marks were applied were in different classes and not of the same description, the applicant's trademark was considered so distinguishable from the opposer's marks that the public may not be confused or misled as to the proprietor or origin of the goods. The Board accordingly held the applicant's trademark registrable.

The Trademark Board's Decisions, Nos. 814/2550 and 815/2550

Issued: 13 September 2007

Nike International Ltd., Opposer
vs
Royal Crown Import Export Co., Ltd., Applicant
of I.C. 25 application which covers shoes and sports shoes

The Trademark Board adhere to the routine practice of making a comparison

between the applicant's trademark  and the opposer's registered trademarks, **SWOOSH**,  and , and came to the opinion that the said trademarks were so different in both appearance and pronunciation that the public may not be confused or misled as to the proprietor or origin of the goods. The Board

stated that although relatively similar to the opposer's Swoosh Device, the applicant's device was considered distinguishable as it was positioned differently from the opposer's mark. The addition of other elements as parts of the applicant's trademark also rendered the mark distinguishable. The Board went on to say that the parties' trademarks were phonetically different since each of the marks could be called or pronounced differently. The applicant's trademark was accordingly held not similar to those of the opposer and thus was held registrable.

The Trademark Board's Decision No. 1697/2549

Issued: 16 January 2007





Nike International Ltd., Opposer

vs

Co-Camp Trading Ltd. Part., Applicant

of I.C. 25 application which covers upper outer garments (except upper inner garments and sports upper garments), shoes (except sports shoes).

Again the Trademark Board only made a comparison between the applicant's

trademark  and the opposer's registered trademarks ,  and , and ruled that the said trademarks were so different in both overall appearance and pronunciation that the public may not be confused or misled as to the proprietor or origin of the goods. The Board found that the device in the applicant's mark was designed differently from Nike's Swoosh Device, and the addition of the words CAMP INN also rendered the mark visually distinguishable. For phonetic difference, the applicant's mark would be called CAMP INN brand, whereas each of the opposer's marks could be called NIKE brand, Swoosh brand or other names depending on whatever it was perceived by the public. Due to the differences mentioned, the applicant's mark was considered not similar to those of the opposer and thus was held registrable.

With the present level of local and international trade, a mark now functions more than just indicating the origin of the goods/services. Public deception should not be the only issue of consideration when determining an infringement case. While that remains an important issue of the trademark law and the public should be protected from making choices caused by deception, trademark owners should be given fair protection from commercial pirates who want to reap where they had not sown.

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