

Supreme Court of the Kingdom of Thailand

S.C. 7201/2554

Live Nation Worldwide, Inc. v. Department of Intellectual Property

Court : Supreme Court
Case : Civil
Date of Judgment : August 16, 2011
Plaintiff : Live Nation Worldwide, Inc.
Defendant : Department of Intellectual Property
Concepts : Intellectual Property, Trademark
Statute : Trademark Act B.E. 2534 (1991) Sections 6, 13

Panel of Justices

Tanasit Nilkamhaeng, Aram Senamontri, Somkuan Wichienwan

Case Background

The plaintiff, a juristic person under the laws of the United States of America, is the owner of the trademark and service mark "ARTIST NATION". The plaintiff is a leading company in organizing musical live performances, concerts, and other entertainment live programs. It has established the Artist Nation Division to handle artist management, marketing strategies, broadcasting rights, ticket sales, and fan meetings. On May 30, 2007, the plaintiff submitted a number of applications to register the trademark and service mark "ARTIST NATION" to be used with various classes of goods. Only the registration under application number 662529 to use the mark with shirts; excluding undershirts, sports shirts, tee shirts, and rugby shirts; was refused by the Trademark Registrar on the grounds that the trademark was identical with or similar to the registered trademark of another person, namely "ARTLIST INTERNATIONAL." The plaintiff appealed to the Trademark

Board but the Board affirmed the Registrar's order. The plaintiff appealed to the court that its trademark was registrable because it was different from the registered trademark in terms of meaning, translation, spelling, pronunciation, and number of syllables. The plaintiff requested the court to revoke the Registrar's order and the Board's decision and to order the Registrar to proceed to process the respective application.

The defendant argued that the plaintiff's trademark was so similar to the registered trademark in terms of pronunciation that it might mislead the public as to the owner or the origin of the goods.

Procedural History

The Central and Intellectual Property and International Trade Court dismissed the case.

The Plaintiff appealed to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court upheld the judgment of the Central and Intellectual Property and International Trade Court.

Issue

Is there a reasonable cause to revoke the Trademark Registrar's order and Trademark Board's decision?

Rationale

Although the plaintiff's trademark "ARTIST NATION" and the registered trademark "ARTLIST INTERNATIONAL" are different in number of syllables, the meanings are yet similar. That is to say, "ARTIST," meaning *someone who creates things with great skill and imagination*, and "ARTLIST," referring to a

list of arts, are both from the root word “Art.” Likewise, “NATION,” meaning *a country*, and “INTERNATIONAL,” meaning *involving more than one country*, are both from the root word “Nation.” Even though the plaintiff’s trademark “ARTIST NATION” is written in a single line, whereas the registered trademark “ARTLIST INTERNATIONAL” is separately written in two lines, the significant part of the registered trademark is apparently “ARTLIST,” as the letters are in much bigger size than “INTERNATIONAL.” Upon comparing “ARTIST” to “ARTLIST,” the plaintiff’s trademark is similar to the registered trademark in both spelling and pronunciation, especially when taking into account the fact that both trademarks are written in capital letters, not in invented letters that would display obvious difference. Furthermore, the class of goods with which the plaintiff had proposed to use the trademark is likely to be targeted at customers of various age groups and preferences, including individuals with limited English capability that might be unable to distinguish between the two trademarks in dispute. The similarity is therefore likely to confuse or mislead the public as to the owner or the origin of the goods. The plaintiff’s trademark, proposed to be used with certain clothing products, is therefore not registrable. The Trademark Registrar’s order and the Trademark Board’s decision were lawful and shall not be revoked.

Keywords: service mark, confuse or mislead

Translated and summarized by Tavinwong Jitviwat

Edited by Kamonchanok Katinasamit