

**Supreme Court of the Kingdom of Thailand**

**S.C. 4049/2012**

**Caltex Oil (Thailand) Company Limited v. Pittikorn Charoenkit Limited**

**Partnership, et al.**

**Court** : Supreme Court

**Case** : Civil

**Date of Judgment** : April 10, 2012

**Plaintiff** : Caltex Oil (Thailand) Company Limited

**Defendants** : Pittikorn Charoenkit Limited Partnership (1<sup>st</sup>)  
Pittikorn Laklam (2<sup>nd</sup>)

**Concepts** : Trademark, Licensing Agreement

**Statute** : Trademark Act B.E. 2534 (1991) section 68  
The Act on the Establishment of and Procedure for  
Intellectual Property and International Trade Court B.E.  
2539 (1996) section 26

**Panel of Justices**

Prinya Deepadung, Aram Senamontri, Dhajaphan Prabhudhanitisarn

**Case Background**

The plaintiff has been operating oil business in Thailand under the name CALTEX and under the trademark composed of the word “CALTEX” and an invented star picture for more than 50 years. The plaintiff granted the rights to operate a gas station at the plaintiff’s premises to the defendants. Later, both defendants stopped buying gasoline products from the plaintiff and did not pay for gasoline prices and royalty fees, which constituted a breach of agreement. The plaintiff

requested the Court to order the defendants to leave the plaintiff's premises and to settle the overdue payments.

### **Procedural History**

The Central Intellectual Property and International Trade Court held in favor of the plaintiff.

Both defendants appealed to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court upheld the lower court's judgment.

### **Issue**

Is the licensing agreement in dispute considered to be invalid?

### **Rationale**

According to the licensing agreement, the plaintiff agreed to license the first defendant to operate the plaintiff's gas station under trade name and trademark "CALTEX". The petroleum products which the first defendant was bound to buy from the plaintiff for sale at the gas station were the products of the plaintiff. The user of the trademark "CALTEX" on such products was therefore the plaintiff. It was not the case that the first defendant was the provider of the products and was allowed by the plaintiff to use the trademark "CALTEX" onto those products, which would otherwise be considered as a trademark licensing agreement that should be conducted in writing and registered under section 68 paragraph two of the Trademark Act B.E. 2534 (1991). Hence, the licensing agreement is valid even though it was not registered with the Trademark Registrar.

Both defendants further appealed that they did not pass off their goods as the plaintiff's goods. However, it appeared that such argument has not been legally raised before in the lower court, therefore, the appeal of the defendants for this part is

unlawful and therefore can not be taken into consideration according to section 26 of the Act on the Establishment of and Procedure for Intellectual Property and International Trade Court B.E. 2539 (1996) appurtenant to section 225 paragraph one of the Civil Procedure Code.

**Keywords** trade name, licensing agreement, pass off

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