

Supreme Court of the Kingdom of Thailand

S.C. 8151 – 8152/2011

Sanofi Pasteur v. Department of Intellectual Property

Court : Supreme Court
Case : Civil
Date of Judgment : September 13, 2011
Plaintiff : Sanofi Pasteur
Defendant : Department of Intellectual Property
Concepts : Intellectual Property, Trademark
Statute : Trademark Act B.E. 2534 (1991)
Panel of Justices :

Rattana Kongkaew, Aram Senamontri, Maitree Sriarun

Case Background

The plaintiff is the owner of the trademark “HEXAXIM” in foreign countries and applied for registration of the trademark to use with vaccines. The registration, however, was refused by the Trademark Registrar on the grounds that the trademark was identical with or similar to the registered trademark of Cavid Tech AB, namely “EXAZYM.” The Trademark Board also affirmed the Registrar’s order. The plaintiff subsequently appealed to the Central Intellectual Property and International Trade Court that the trademark was registrable because it was not identical with or so similar to the registered trademark “EXAZYM” that the public might be confused or misled as to the owner or origin of the goods. The plaintiff therefore requested the court to revoke the Registrar’s order and Board’s decision and order the Registrar to proceed to process the registration application.

The defendant argued that the plaintiff's trademark was so similar to the registered trademark "EXAZYM" that the public might be confused or misled as to the owner or origin of the goods. The Trademark Registrar's order and the Trademark Board's decision were lawful.

Procedural History

The Central Intellectual Property and International Trade Court revoked the Trademark Registrar's order and the Trademark Board's decision and ordered the Registrar to proceed with the registration of the plaintiff's trademark.

The defendant appealed to the Supreme Court.

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

Issue

Is the plaintiff's trademark "HEXAXIM" so similar to the registered trademark of another person "EXAZYM" that the public might be confused or misled as to the owner or origin of the goods?

Rationale

The plaintiff's trademark "HEXAXIM" is proposed to be used with vaccines, whereas Cavid Tech AB's trademark "EXAZYM" is registered to be used with diagnostic preparations for medical use in the field of virology. Even though the goods in connection with both trademarks are in the same class, i.e. medicine, but the applications are different. The plaintiff's vaccines are to be given to children to prevent diphtheria, pertussis, tetanus, encephalitis, poliomyelitis and hepatitis B. They are not sold at general shops or drugstores but only to an exclusive dealer, Zuellig Pharma, who would later distribute the vaccines to hospitals or holders of medical

licenses. The vaccines must be stored in refrigerator and the cautions are well-written on the package that they are dangerous medical products to be used only by doctors, pharmacists or nurses. While in contrast, the goods under the registered trademark “EXAZYM”, the pharmaceutical products for diagnostic preparations for medical use, are generally used by medical technicians and medical scientists who work in medical laboratories to diagnose a particular disease from specimens such as blood, urine, feces, cerebrospinal fluid and bone marrow. Such products are not available at drugstores or general shops. They can be purchased only from the dealer of the manufacturing company. Accordingly, it is clear that the users of the goods in connection with the trademark “HEXAXIM” and the registered trademark “EXAZYM” are of different groups. Both are professional specialists with respective expertise who can certainly distinguish the difference between the goods under each trademark without being confused or misled. Moreover, the goods are not available at general shops or drugstores but distributed through different channels.

Although the defendant appealed that Jumpol Wattanakongton, whom the plaintiff summoned as a witness, had testified that some licensed drugstores were permitted to sell the plaintiff’s vaccines which meant that they were available to the general public and might lead to confusion, he had also testified that those vaccines could be sold only upon a doctor’s prescription and the buyers mostly would not apply the vaccines by themselves, but with assistance of a doctor or nurse. Thus, even though both trademarks are similar in pronunciation, it is not to the extent that it might confuse or mislead the public that the goods under the plaintiff’s trademark “HEXAXIM” were the diagnostic preparations for medical use in the field of virology with which Cavid Tech AB’s trademark “EXAZYM” is used or that the goods were

originated from Cavid Tech AB. The plaintiff's trademark is therefore registrable according to section 6(3) and section 13 of the Trademark Act B.E. 2534 (1991).

The fact that the plaintiff did not submit the agreement between itself and Cavid Tech AB to the Trademark Board could not be applied to justify the Board's decision. It shall be upheld that the Registrar's order and the Board's decision were unlawful. The appeal shall be dismissed.

Keywords confused or misled as to the owner or origin of goods, similar, registrable

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