

Supreme Court of the Kingdom of Thailand

S.C. 11315/2010

Tang Toh Kang Limited Partnership, et al. v. Toh Kang Yaowarat the Old Siam

Goldsmith Company Limited

Court : Supreme Court

Case : Civil

Date of Judgment : November 26, 2010

Plaintiffs : Tang Toh Kang Limited Partnership (1st)
Second Lieutenant Attasarn Tantikarn (2nd)

Defendant : Toh Kang Yaowarat the Old Siam Goldsmith Company
Limited

Concepts : Intellectual Property, Right to the Use of a Name,
Trade Name, Trademark, Tort

Statutes : Civil and Commercial Code sections 18, 67

Panel of Justices

What Tingsamitr, Aram Senamontri, Somkuan Wichienwan

Case Background

The first plaintiff was established in 1940 and named “Tang Toh Kang” after its founder who was the second plaintiff’s grandfather. The second plaintiff is currently the managing partner of the first plaintiff. The defendant was established in 1992 under the name “Toh Kang Yaowarat the Old Siam Goldsmith Company Limited.” The first plaintiff and the defendant both operate for the same objective; to trade gold and other jewels. The plaintiffs claimed that the defendant violated the plaintiffs’ right to the use of a name and trademark. The plaintiffs therefore requested the court to order the defendant to stop using the company name

composed of the word “Toh Kang” and demanded compensation from the defendant amounting 5,000,000 Baht.

Procedural History

The Central Intellectual Property and International Trade Court held in favor of the plaintiff and ordered the defendant to compensate the plaintiffs amounting 3,000,000 Baht with interest.

The defendant appealed to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court only amended the lower court’s judgment as regards the compensation amount. It ordered the defendant to compensate the plaintiffs amounting 500,000 Baht with interest. Apart from that, the lower court’s judgment was upheld.

Issue

1. Did the plaintiffs submit the complaint within the period of prescription?
2. Do the plaintiffs have standing to sue?

Rationales

1. The defendant had derived the word “Toh Kang” from the first plaintiff’s entity name and trademark and registered such word as a part of its entity name since February 25, 1992. The defendant has been using that name, which is a continuous wrongful act against the plaintiffs, until the complaint submission date. The plaintiffs therefore are deemed to have submitted the complaint within the period of prescription.

2. The plaintiffs have been using the words “Toh Kang” and “Tang Toh Kang”, which were derived from the second plaintiff’s grandfather’s name, as the

entity name and trademark in connection with gold trade for more than 50 years. Those names had become well-known before the establishment of the defendant on February 25, 1992. Although the first plaintiff is a juristic person, it is entitled to the right to the use of the names “Toh Kang” and “Tang Toh Kang” under section 67 and section 18 of the Civil and Commercial Code. The defendant operates a gold business under the name “Toh Kang Yaowarat the Old Siam Goldsmith Company Limited” bearing the word “Toh Kang” as a substantial part of its entity name. Thus, it might confuse and mislead the public that the defendant’s business was related to that of the plaintiffs, which would cause damage to the plaintiffs. Even though the defendant’s name also contains other words apart from “Toh Kang” and the first plaintiff and the defendant are of different types of juristic persons, it does not entitle the defendant to the right to the use of the name “Toh Kang” as a substantial part of its name. Although the Registrar has accepted to register the defendant under such name, it was merely the Registrar’s discretion. The registration does not always entitle the defendant to the right to the use of the registered name. If the use of the defendant’s name results in a dispute concerning another person’s right to the use of a name under section 18 and section 67 of the Civil and Commercial Code, it shall be deliberated according to the provisions of the Code, especially section 18 and section 67. In this light, the plaintiffs may submit the complaint and request the court to order the defendant to cease committing the wrongful act and to prohibit the defendant from using the word “Toh Kang” as a part of its name. The plaintiffs therefore have standing to sue.

Keywords Confuse and mislead, trademark, juristic person, the right to use of a name

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