

Supreme Court of the Kingdom of Thailand

S.C. 8726/2011

The Whitaker Corporation v. Department of Intellectual Property

Court : Supreme Court

Case : Civil

Date of Judgment : October 3, 2011

Plaintiff : The Whitaker Corporation

Defendant : Department of Intellectual Property

Concepts : Intellectual Property, Trademark, Service Mark

Statue : The Trademark Act B.E. 2534 (1991) sections 6, 7, 80

Panel of Justices

Prinya Deepadung, Aram Senamontri, Dhajaphan Prabhudhanitisarn

Case Background

The plaintiff is the owner of a mark composed of the words “AMP” and “NETCONNECT” written inside an oval mark  . On January 21, 2005, the plaintiff submitted application number 579420 for registration of the mark as a trademark to be used with the goods in Class 9 and submitted the applications number 579421, 579422, 579423 and 579424 for registration of the same mark as a service mark to be used with services in Class 37, 38, 42 and 35 respectively. The Trademark Registrar held that some parts of the service mark had no distinctive character according to

section 7 of the Trademark Act B.E.2534 (1991) and ordered the plaintiff to disclaim exclusive right to use the Roman letters “NETCONNECT.” As for the trademark registration, the Registrar was of a view that the trademark had no distinctive character because the term “AMP” was an abbreviation of the word “AMPERE” which referred to a unit of electrical current that flows through a one- ohm resistance. Such term, when used with the proposed goods, had direct reference to the character or quality of the goods and therefore was not registrable. The plaintiff appealed against the Registrar’s order to the Trademark Board. The Board affirmed the order of the Registrar. The plaintiff, subsequently, brought the case before the court requesting for nullification of the Registrar’s order and the Board’s decision, and requested the court to order the Registrar to proceed to process the applications.

Procedural History

The Central 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 reversed the lower court’s judgment; it revoked the order of the Trademark Registrar and the decision of the Trademark Board that refused the registration of the plaintiff’s trademark and service mark under the applications number 579420, 579421, 579422, 579423 and 579424 and ordered the Trademark Registrar to proceed to process such applications.

Issue

Was the decision of the Trademark Board, in relation to applications number 579420 to 579424, that the trademark and service mark in dispute had no distinctive character and therefore not registrable lawful?

Rationale

According to the section 7 paragraph two (2) and section 80 of the Trademark Act B.E. 2534 (1991), a word or words having reference to the character or quality of the goods or services, which would be deemed to have no distinctive character, are limited only to those having *direct* reference to the character or quality of the goods or services. A word or words having merely indirect reference to the character or quality of the goods or services would therefore be deemed to have distinctive character.

The trademark pertaining to the application number 579420 is composed of the words “AMP” and “NETCONNECT” written inside an oval mark. Although “AMP” is abbreviated from “AMPERE,” *a unit of electrical current*, and “AMPLIFIER,” *an electrical device that makes sounds louder*, the goods proposed to be used with the trademark are namely electrical switchboards, wall electrical circuit, temporary electric cords or boards, electric cables, electrical connectors, electrical cable connectors, and optic cables; they are neither an electricity meter nor a sound amplifier. Hence, “AMP” does not refer directly to the character or the quality of the goods. Even though the goods under the trademark are related to electricity, it is only indirect relation. Using “AMP” with such goods would not be a direct reference to their character or quality in the same manner as using it with an electricity meter or an amplifier. Accordingly, "AMP" does not have direct reference to the character or the quality of the goods and is therefore deemed to have distinctive character according to section 7 paragraph two (2) of the Trademark Act B.E. 2534 (1991).

The other part of the trademark, the word “NETCONNECT” which means *network connection*, also has no reference to the character or quality of the aforementioned goods, nor is it a description of them. That is to say, *network connection* has neither direct nor indirect reference to electrical switchboards, wall electrical circuit, temporary electric cords

or boards, electric cables, electrical connectors, electrical cable connectors, and optic cables. As a conclusion, the words “AMP” and “NETCONNECT” in the plaintiff’s application number 579420, when used in connection with the aforementioned goods, do not directly refer to the character or the quality of the goods. Thus, the plaintiff’s trademark is deemed to have distinctive character which enables the public or users to distinguish the goods with which the trademark is used from other goods, which is registrable under section 6 of the Trademark Act B.E. 2534 (1991).

As for the service mark registration pertaining to the applications number 579421 to 579424, the services proposed to be used with the mark are, *inter alia*; building wiring installation, maintenance of building wiring system, repairing building wiring system, telecommunication consulting, and computer network consulting. None of them is a service for measuring electric current in amperes, amplifier rental, or any service in relation to sound-amplifying. Hence, the word “AMP” in the mark does not refer directly to the character or the quality of the services. Even though some of the services are related to electricity, it is only indirect relation. Using “AMP” with such services would not be a direct reference to their character or quality in the same manner as using it with a service for measuring electric current in amperes, amplifier rental, or any service in relation to sound-amplifying. As for the other services, they are not even related to electricity or sound-amplifying. Accordingly, “AMP” does not have direct reference to the character or the quality of the services and is therefore deemed to have distinctive character according to section 7 paragraph two (2) and section 80 of the Trademark Act B.E. 2534 (1991).

The other part of the service mark, the word “NETCONNECT” which means *network connection*, also has no reference to the character or quality of the aforementioned services, nor is it a description of them. As a conclusion, the words “AMP” and “NETCONNECT” in the plaintiff’s applications number 579421 to 579424, when used in

connection with the aforementioned services, do not directly refer to the character or the quality of the services. Thus, the plaintiff's service mark is deemed to have distinctive character which enables the public or users to distinguish the services with which the mark is used from other services, which is registrable under section 6, section 7 paragraph one and paragraph two (2), and section 80 of the Trademark Act B.E. 2534 (1991). It is therefore held that the decision of the Trademark Board was unlawful. The judgment of the Central Intellectual Property and International Trade Court shall be reversed and the Trademark Registrar shall proceed to process the respective applications of the plaintiff.

Keywords service mark, distinctive character, direct reference to character or quality

Summarized and translated by Non Tuntapong

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