

**Supreme Court of the Kingdom of Thailand**

**S.C. 3759/2011**

**Marriott Worldwide Corporation v. Department of Intellectual Property, et al.**

**Court** : Supreme Court

**Case** : Civil

**Date of Judgment** : May 19, 2011

**Plaintiff** : Marriott Worldwide Corporation

**Defendants** : Department of Intellectual Property (1<sup>st</sup>)  
Director-General of the Department of Intellectual Property  
(2<sup>nd</sup>)

**Concepts** : Intellectual Property, Service Mark

**Statue** : Trademark Act B.E.2534 (1991) sections 6(1), 7, 80

**Panel of Justices:**

Chaleaw Phonwiset, Aram Senamontri, Tanasit Nilkamhaeng

**Case Background**

The plaintiff is the owner of the service mark "COURTYARD." The plaintiff's service mark had been registered in many countries and used extensively in connection with certain services i.e. hotels, resorts, camping sites, restaurants, meeting and event management and hotel reservation. The service mark has been used in such manner for a long time and well-known in various countries including Thailand. On July 24, 2003, the plaintiff submitted the application for registration of the service mark "COURTYARD" to be used with the

aforementioned services. However, the registration was refused by the Trademark Registrar on the grounds that the service mark had no distinctive character according to section 7 of the Trademark Act B.E. 2534 (1991) and that it had direct reference to the character or quality of the specified services. The plaintiff appealed against the Registrar's order to the Trademark Board but the Board affirmed the Registrar's order. Against the Board's decision, the plaintiff appealed to the court that its service mark had distinctive character and therefore registrable. It requested for a revocation of the Trademark Registrar's order and the Trademark Board's decision.

The defendants argued that the Trademark Board had duly rendered its decision and the evidences submitted by the plaintiff were insufficient to prove that the service mark had been widely used or advertised in Thailand pursuant to the rules prescribed by the Minister of Commerce, therefore, the service mark could not be deemed distinctive.

### **Procedural History**

The Central Intellectual Property and International Trade Court held that the service mark "COURTYARD" had distinctive character and registrable. The court revoked the Trademark Registrar's order and the Trademark Board's decision.

The defendants 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 service mark "COURTYARD" not deemed to have distinctive character and therefore not registrable under the Trademark Act B.E. 2534 section 80 and section 6(1) because it has direct reference to the character of the plaintiff's services?

### **Rationale**

Although the word "COURTYARD" means *an open space within a house*, when used in connection with the proposed services, it only seemed to be an attempt to draw attention from the interested customers. It did not indicate or imply that the respective services offered more spacious areas than those of other rival companies because *an open space within a house* could also be used in several other activities. Accordingly, the plaintiff's service mark "COURTYARD" does not refer directly to the character or quality of the services, yet it is a word with distinctive character which is registrable under the Trademark Act B.E. 2534 (1991) section 80 and section 6(1). The Trademark Registrar's order and the Trademark Board's decision to refuse the registration of the plaintiff's service mark, therefore, were unlawful. As it is already held that the plaintiff's service mark has distinctive character, it is unnecessary to consider whether or not the plaintiff had widely used or advertised the service mark "COURTYARD" pursuant to the rules prescribed by the Minister of Commerce, because it would not change the outcome of the case.

**Keywords** Distinctive character, service mark, direct reference to the character

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