

Supreme Court of the Kingdom of Thailand

S.C. 4861/2011

Devarana Spa Company Limited v. UthaiVichit Company Limited

Court : Supreme Court

Case : Civil

Date of Judgment : June 13, 2011

Plaintiff : Devarana Spa Company Limited

Defendant : UthaiVichit Company Limited

Concepts : Intellectual Property, Trademark, Service Mark, Trade Name

Statue : The Trademark Act B.E. 2534 (1991)sections 44, 67, 80

Panel of Justices

Dhajaphan Prabhudhanitisarn , Aram Senamontri, MaitreeSriarun

Case Background

The plaintiff is a limited company established in 2000. Its main objective is to provide healthcare services in form of spa treatment. Between 2000 and 2003, the plaintiff registered a number of trademarks and service marks which consisted of the word “Devarana” as

a significant part to be used with various goods and services. The defendant is a real estate development company that owns a housing estate under the name “Bann Dhewaran,” which has the same pronunciation as “Devarana.” The plaintiff claimed that the public was likely to be misled that the defendant’s housing estate was operated by the plaintiff or related to the plaintiff. The plaintiff therefore requested the defendant to stop using the word “Dhewaran” both in Thai and Roman letters, remove all materials, equipment, advertisement, printing media and other items bearing such word from the market, and compensate the plaintiff for the damages caused.

In response to the complaint, the defendant argued that it had been operating real estate development business and using “Bann Dhewaran” as its trademark since 1999, whereas the plaintiff, established in 2000, did not engage in any real estate business. The defendant also counter-claimed that it was the rightful owner of its trademark “Bann Dhewaran” since it had created this trademark prior to the plaintiff’s use of “Devarana.” The defendant therefore requested the court to dismiss the case, revoke the plaintiff’s service mark registrations, order the plaintiff to stop using the word “Devarana” both in Thai and Roman letters, and prohibit the plaintiff from opposing to the defendant’s trademark and service mark registrations.

Procedural History

The Central Intellectual Property and International Trade Court held that the claims and counter-claims be dismissed.

Both parties appealed to the Supreme Court.

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

Issues

1. Did the defendant infringe on the plaintiff's trademarks, service marks, and trade name?
2. Does the defendant have better right in the service mark registration, with respect to the plaintiff's application submitted after the defendant had used such name?

Rationales

“Dhewaran” or “Devarana” is defined in a dictionary as paradise or heaven. It is therefore a general word that another person may still use insofar as it does not confuse the public or cause damage to those who have registered such word as their trademarks, service marks or trade names. The defendant has been using the word “Bann Dhewaran” as a trade name in connection with real estate development and housing estate which are large-scale projects. It has first advertised such name to the public on January 17, 2004, through leaflets and newspaper. Even though the plaintiff has registered its trademarks and service marks composing of “Devarana” since 2000, it appeared that those marks were registered to be used with different goods or services, i.e. letter paper and envelopes; restaurants, hotel, and healthcare services. In this regard, pursuant to section 44 and section 80 of the Trademark Act B.E. 2534 (1991), the plaintiff has exclusive rights to use its marks only in connection with the designated categories of goods and services. The plaintiff therefore has no right to prohibit the defendant from using the word “Dhewaran” both in Thai and Roman letters in connection with real estate development and housing estate. Moreover, the plaintiff has been using the word “Devarana” with the word “Spa”,

whereas the defendant has been using the word “Dhewaran” with the word “Bann,” which refers to the real estate and housing estate business. Hence, it cannot be concluded that the public would be confused as to whether the defendant’s business belongs or relates to the plaintiff. The business of the defendant requires high amount of investment capital while there was no evidence to prove that the plaintiff’s business is of the similar scale. Accordingly, it is unlikely that the defendant has intentionally operated its business under its trade name by exploiting the plaintiff’s reputation, be it the trade name, trademarks, or service marks. The use of the trade name by the defendant therefore does not infringe on the plaintiff’s rights to its trademarks and service marks and does not cause any damage to the plaintiff’s reputation.

As it is held that the use of trade name or service mark by both parties did not confuse the public as to the respective service owner or provider, the defendant does not have better right than the plaintiff with respect to the plaintiff’s registered trademarks and service marks. Consequently, the defendant has no right to request the court to revoke the registration of the plaintiff’s trademarks and service marks according to section 67 and section 80 of the Trademark Act B.E. 2534 (1991).

Keywords service mark, revocation, trade name

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