

## Supreme Court of the Kingdom of Thailand

S.C. 5448/2011

### Burger King Corporation v. Department of Intellectual Property

**Court** : Supreme Court

**Case** : Civil

**Date of Judgment** : June 27, 2011

**Plaintiff** : Burger King Corporation

**Defendant** : Department of Intellectual Property

**Concepts** : Intellectual Property, Service Mark

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

#### Panel of Justices

SomkuanWichienwan, Aram Senamontri, TanasitNilkamhaeng

#### Case Background

The plaintiff applied for a service mark registration of the phrase, “HAVE IT YOUR WAY”, to be used with restaurant services. The Trademark Registrar refused the registration on the grounds that the service mark had no distinctive character and the proposed phrase meaning “dine on your choice or with your style,” had direct reference to the character or quality of the service. The evidence submitted by the plaintiff were insufficient to prove that the service mark had been widely used and should be deemed distinctive according to the rules

prescribed by the Minister of Commerce. 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. The plaintiff requested for a revocation of the Registrar's order and the Board's decision.

### **Procedural History**

The Central Intellectual Property and International Trade Court revoked the Trademark Registrar's order and the Trademark Board's decision. It ordered the defendant to proceed to process the plaintiff's application to register the service mark.

The defendant appealed to the Supreme Court.

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

### **Issue**

Is the plaintiff's service mark "HAVE IT YOUR WAY" a general phrase that did not enable the public or consumers to distinguish the plaintiff's service from others and therefore should be deemed to have no distinctive character under section 7 paragraph one of the Trademark Act B.E. 2534 (1991)?

### **Rationale**

Although the plaintiff's service mark "HAVE IT YOUR WAY" is a general description, the service mark had already been registered and used in connection with fast food restaurant services that mainly offer hamburgers and beverages under the plaintiff's trademark and service mark "BURGER KING" in various countries for more than 20 years. As for in

Thailand, the plaintiff has been using and advertising the service mark in dispute in magazines, printing media, and billboards in both Bangkok and other provinces. As a result, it has been widely recognized by a large number of customers that such service mark belongs to the plaintiff. In addition, such service mark appears only in the restaurants that bear the plaintiff's trademark and service mark "BURGER KING," not in other restaurants that offer the same food products. Thus, the service mark "HAVE IT YOUR WAY" is deemed to enable the public or customers to distinguish the service under the plaintiff's service mark from others. Furthermore, the phrase "HAVE IT YOUR WAY" meaning "have it your style" or "eat it as you want," does not portray any character or quality of the respective service. Hence, it is held that the service mark has no direct reference to the character or quality of the plaintiff's service and shall be deemed to have distinctive character and registrable according to section 6, section 7 paragraph one, and section 80 of the Trademark Act B.E. 2534 (1991).

**Keywords** service mark, distinctive character

**Summarized and Translated by** Akedanai Techajongjintana

**Edited by** Kamonchanok Katinasamit