

## Supreme Court of the Kingdom of Thailand

S.C. 5447/2011

### Yung Sung-ghew Kow. Ltd. v. Department of Intellectual Property

<b>Court</b>	:	Supreme Court
<b>Case</b>	:	Civil
<b>Date of Judgment</b>	:	June 27, 2011
<b>Plaintiff</b>	:	Yung Sung-ghew Kow. Ltd.
<b>Defendant</b>	:	Department of Intellectual Property
<b>Concepts</b>	:	Intellectual Property, Trademark
<b>Statue</b>	:	Trademark Act B.E. 2534 (1991) sections 13, 27

#### Panel of Justices

Maitree Sriarun, Aram Senamontri, Somkuan Wichienwan

#### Case Background

The registration of the plaintiff's trademark, which consisted of the word "GIANNI VALENTINO" and the invented device of "GV," was refused by the Trademark Registrar on the grounds that the trademark was identical with or similar to two registered trademarks of another person according to section 13 of the Trademark Act B.E. 2534 (1991). The plaintiff appealed against the Registrar's order to the Trademark Board but the Board affirmed the Registrar's order. Subsequently, the plaintiff appealed against such order and decision to the court that the refusal of registration was unlawful because its trademark was not identical with or similar to any registered trademark of another person and did not confuse the public. The plaintiff claimed that its trademark was originated from Japan, whereas the other two registered trademarks were originated from Italy. The plaintiff's trademark and the

other two registered trademarks have been used concurrently, in good faith, for a long time and never caused any confusion to the public concerning neither the trademark nor the respective goods. Hence, the plaintiff's trademark was registrable.

In response to the plaint, the defendant argued that the plaintiff lacked standing because the Trademark Board's decision was final under section 18 of the Trademark Act B.E. 2534 (1991).

### **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 upheld the judgment of the lower court.

### **Issues**

1. Is the plaintiff's trademark identical with or so similar to the registered trademark of another person (Registration Number Khor.56298) that the public may be confused or misled as to the owner or origin of the goods?

2. Had there been a particular circumstance that the Registrar might allow the registration of the plaintiff's trademark under section 27 of the Trademark Act B.E. 2534 (1991)?

### **Rationales**

1. The plaintiff's trademark has an invented Roman letter "V" inside an incomplete circle line which is similar to a registered trademark of another person that has an invented Roman letter "V" inside an incomplete oval line. The plaintiff's trademark also bears the Roman alphabet word "VALENTINO" as a significant part, in the same manner as the registered trademark of another person. Accordingly, the

plaintiff's trademark is deemed to be similar to the registered trademark of another person. Therefore, the use of the plaintiff's trademark in connection with the same class of goods as the said registered trademark is likely to confuse or mislead the public as to the owner or origin of the goods. Although the plaintiff's trademark had been derived from the plaintiff's own concept, the initials of a famous Italian designer, and is not a copy of another person's idea, given the fact that the plaintiff's trademark is similar to the registered trademark of another person, the trademark is therefore not registrable.

2. Under section 27 of the Trademark Act B.E. 2534 (1991), the Trademark Registrar may allow the registration by more than one owner of a trademark which is identical with or similar to a registered trademark if there have been honest concurrent users or special circumstances which make it proper to do so. However, this provision refers only to the case where several owners of trademarks have been concurrently using their trademarks in good faith in the Kingdom of Thailand. Even though the plaintiff had registered the trademark overseas and had been using the trademark in connection with the particular goods extensively in various Asian countries, it was not an honest concurrent user of the trademark under section 27 by whom the Registrar might allow the registration.

**Keywords** Registrable, identical with, similar to, concurrent, special circumstance

**Summarized and Translated by** Kamonchanok Katinasamit