

**Supreme Court of the Kingdom of Thailand**

**S.C. 5451/2011**

**McDonald's Corporation v. Department of Intellectual Property**

**Court** : Supreme Court  
**Case** : Civil  
**Date of Judgment** : June 27, 2011  
**Plaintiff** : McDonald's Corporation  
**Defendant** : Department of Intellectual Property  
**Concepts** : Intellectual Property, Trademark  
**Statue** : Trademarks Act B.E 2534 (1991) sections 6(1), 7, 8(10), 13

**Panel of Justices**

Tanasit Nilkamheang, Aram Senamontri, Somkuan Wichienwan

**Case Background**

The plaintiff is the owner of numerous trademarks and service marks that contain the word “Mc” as a substantial part, used extensively worldwide in connection with a variety of food products. On August 6, 2003, the Trademark Registrar published the application for the registration of a trademark “MacCandy,” proposed to be used in connection with specified goods, such as candy, dessert, peppermint and sugar candy. The plaintiff filed a notice of opposition with the Registrar requesting the suspension of such trademark’s registration. The Registrar dismissed the opposition. The plaintiff appealed against the Registrar’s order to the Trademark Board but the Board affirmed the Registrar’s order. The plaintiff subsequently appealed against the Board’s decision to the Central Intellectual Property and International Trade Court that its trademarks and the applicant’s both contained the Roman alphabet word “Mac” which might confuse or mislead the

public as to the owner or the origin of the goods because the goods used or proposed to be used with the respective trademarks were in the same class. The plaintiff also claimed that the applicant purposely imitated the plaintiff's trademark and that the applicant's trademark had no distinctive character because the word "Mac" was the plaintiff's trademark and "Candy" was a direct reference to the character or the quality of the goods. Accordingly, it appealed that the applicant's trademark was not registrable under section 7 paragraph two (2) of the Trademark Act B.E. 2534 (1991).

The defendant argued that the Trademark Registrar was of a view that the applicant's trademark was not similar to that of the plaintiff and therefore dismissed the plaintiff's notice of opposition. The Trademark Board, too, considered the trademarks of the applicant and the plaintiff to be distinctively different and would not confuse or mislead the public as to the owner or the origin of the goods. Hence, the applicant's trademark was registrable.

### **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 applicant's trademark identical with or so similar to the plaintiff's registered trademark that it may confuse or mislead the public as to the owner or the origin of the goods?

2. Does the applicant's trademark have distinctive character and therefore is registrable?

### **Rationales**

1. Although the first syllable of the Roman alphabet word in the applicant's trademark, "Mac," contains the Roman letters "M" and "c," as same as "Mc" in the plaintiff's trademarks and service marks, such word is an ordinary word used to refer to Scottish people or Scottish last names. The word "Mac" is therefore not an invented word and the applicant may use it as a part of its trademark. Moreover, the plaintiff's trademarks and service marks vary in pronunciation; i.e. Big Mac, Mcfish, McDonald's, McPizza, McBurger, Mac Tonight, et cetera. Those are different from the pronunciation of the applicant's trademark. Besides, the applicant's trademark contains a picture of an eagle, whereas the plaintiff's do not. No matter how long or how largely the plaintiff had been using its trademarks, the applicant's trademark is registrable because it is not identical with nor was it so similar to the plaintiff's trademark that it may confuse or mislead the public as to the owner or the origin of the goods under section 8(10) and section 13 of the Trademark Act B.E. 2534 (1991).

2. The word "Mac" is an ordinary word with no direct reference to the character or quality of the goods and therefore deemed to have distinctive character. Even though the plaintiff had been using the word "Mac" before, it does not thoroughly prohibit others to use such word in their trademarks as long as it is used in the manner that does not confuse the public as to the owner or the origin of the goods. The picture of an eagle in the applicant's trademark is even bigger than the Roman alphabet word's part. The eagle picture is therefore a substantial and distinctive part of the trademark. Even if the word "Candy" has direct reference to the character or the quality of the goods which would be deemed not registrable under section 7 paragraph two (2), the applicant has already

disclaimed an exclusive right to use such word. Taking into account the whole trademark, the applicant's trademark contains other substantial parts which have distinctive character. Accordingly, the applicant's trademark is registrable under section 6(1) of the Trademark Act B.E. 2534 (1991).

**Keywords** Identical or similar trademark, ordinary word, distinctive character

**Summarized and Translated by** Kamonchanok Katinasamit