

Supreme Court of the Kingdom of Thailand

S.C. 10926/2011

Retail Royalty Company v. Department of Intellectual Property, et al.

Court : Supreme Court

Case : Civil

Date of Judgment : December 21, 2011

Plaintiff : Retail Royalty Company

Defendants : Department of Intellectual Property (1st)
Banyong Limprayunwong (2nd)
Kiat Rhurungroj (3rd)
Panumard Sittivaekin (4th)
Somyod Churthai (5th)
Radwit Saenthawesuk (6th)
Charnwit Suwannabun (7th)
Suwan Sukprasert (8th)
Por Anawin (9th)
Jakkaphong Na Bangchang (10th)

Concepts : Intellectual Property, Trademark

Statue : Trademarks Act B.E. 2534 (1991) section 7

Panel of Justices

Maitree Sriarun, Aram Senamontri, Somkuan Wichienwan

Case Background

The registration of the plaintiff's trademark, the Roman alphabet word "AE", was refused by the Trademark Registrar on the grounds that the trademark was

identical with or similar to a registered trademark of another person. The plaintiff appealed against the Registrar's order to the Trademark Board. The Board passed a decision that the plaintiff's trademark was not identical with or similar to a registered trademark of another person, but the plaintiff's trademark, pursuant to Dr. Wit Teangburanathum's dictionary, had the meaning of *one*, which meant that the trademark was a general word that had no distinctive character under section 7 of the Trademark Act B.E. 2534 (1991) and therefore was not registrable.

The plaintiff appealed against the Trademark Board's decision to the court, requesting for the revocation of the Trademark Board's decision. The plaintiff claimed that its trademark was registrable for it had distinctive character under section 7 of the Trademark Act B.E. 2534 (1991). The word "AE" was not a general word that had a meaning or translation specified by a dictionary. Only Dr. Wit Teangburanathum's dictionary was not a sufficient source to hold that "AE" was a dictionary word. According to Webster's Third New International Dictionary, "AE" was a word used by the Scottish, not by general people. The word "AE" was Roman letter-compounded and could be pronounced without meaning. Therefore, it was an invented word which had distinctive character. Even if it was not an invented word, it was still registrable as an ordinary word because it had a meaning of "one" without direct reference to the character or quality of the goods, therefore, the trademark was deemed to have distinctive character according to section 7 paragraph two (2) of the Trademark Act B.E. 2534 (1991).

In response to the plaint, the defendants argued that the Trademark Board had the authority to review the Trademark Registrar's order both in factual and legal issues. The Board also had the authority to make extensive decision concerning issues other than those appeared in the Registrar's order. As a conclusion, the

Trademark Board's decision was lawful. The defendants therefore requested the court to dismiss the plaintiff.

Procedural History

The Central Intellectual Property and International Trade Court revoked the Trademark Board's decision. It ordered the first defendant to proceed to process the plaintiff's respective application.

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

Does the plaintiff's trademark have a distinctive character which is registrable under the Trademark Act B.E. 2534 (1991)?

Rationale

There are only two dictionaries wherein the word "AE" appears; the Dr. Wit Teangburanathum's dictionary and the Webster's Third New International Dictionary. The former stipulates that "AE" means *one*, whereas the latter stipulates that "AE" is a word used by the Scottish which is likely to mean *one*. However, the word "AE" does not appear in the other dictionaries that the plaintiff had submitted to the court and the defendants failed to prove the credibility of the Dr. Wit Teangburanathum's dictionary. The evidences presented by the defendants are therefore insufficient to hold in favor of them that "AE" is a general or ordinary word. Accordingly, if the plaintiff uses "AE" as its trademark, the public can certainly distinguish the goods under the trademark from other goods. The plaintiff's trademark therefore has distinctive character under section 7 paragraph one of the Trademark

Act B.E. 2534 (1991). In addition, for the trademark has no direct reference to the character or quality of the goods, it is deemed to have a distinctive character according to section 7 paragraph two (2) of the Trademark Act B.E. 2534 (1991). The Supreme Court affirms the lower court's judgment to revoke the decision of the Trademark Board and the first defendant shall proceed to process the plaintiff's respective application.

Keywords Registrable, ordinary word, distinctive character

Summarized and Translated by Yanaphak Mantarat, Kamonchanok Katinasamit