

Supreme Court of the Kingdom of Thailand

S.C. 4861/2011

Devarana Spa Co., Ltd. v. Uthaiwijit Co., Ltd.

Court : Supreme Court
Kind of Case : Civil Case
Date of Judgment : 2011/06/13
Plaintiff : Devarana Spa Co., Ltd.
Defendant : Uthaiwijit Co., Ltd
Area of Law : Trademark, Service Mark
Statue : The Trademark Act B.E. 2534 (1991)

Panel of Justices

Tatchapan Praputnitisarn - Aram Senamontri - Maitri Sri-arun

Background

The plaintiff is a limited company registered as Devarana Spa Co., Ltd. Its primary line of business is providing healthcare services by natural or herbal treatment, which is also referred to as spa treatment, in hotels within the Dusit Thani chain. The plaintiff registered its trademark and its service mark, which was comprised of both drawings and the following words, “Devarana Spa”, both in Thai and in Roman letters, under 1 trademark and 4 service mark categories. Its service mark under healthcare facility category was granted registration on November 23, 2000.

The defendant is a Thai company that owns a housing estate named “Baan Dhewaran”, which has the same pronunciation as “Devarana”. The plaintiff claimed that there was the likelihood of confusion to the public as to whether the housing estate was one of the businesses operated by the plaintiff or related to the plaintiff. Hence, the plaintiff requested that the defendant (1) discontinue using the word “Dhewaran” both in Thai and in Roman letters, (2) remove all materials, equipments, advertisement, printing materials and other similar items that affix such word from the market, (3) refrain from using or involving the words “Dhewaran” both in Thai and in Roman letters in the Defendant’s business, and (4) provide monetary compensation to the plaintiff.

In response to the complaint, the defendant argued that (1) it conducted housing estate business using “Baan Dhewaran” as its trademark since 1999 while the plaintiff, established in 2000, did not conduct any real estate business, (2) the plaintiff did not use its trademarks “Devarana Spa” both in Thai and in Roman letters with real estate business; hence the defendant’s trademark is different from the one of the plaintiff. The defendant counter-claimed that it was the lawful owner of its trademark “Baan Dhewaran” since it had created this trademark prior to the plaintiff’s use of “Devarana” marks. The defendant then requested that (1) the case be dismissed, (2) the plaintiff discontinue using the word “Devarana” both in Thai and in Roman letters, (3) the registration of the plaintiff’s service mark under 4 applications be revoked, and (5) the plaintiff be refrained from objecting to the registration of the defendant’s trademark and service mark.

Issues

Whether or not the defendant’s trademarks “Baan Dhewaran” both in Thai and in Roman letters infringed the plaintiff’s trademark, service mark and trade name.

Whether or not the defendant enjoyed a better right in the registration of “Baan Dhewaran” than the plaintiff did.

Proceeding History

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

The Supreme Court affirmed the lower court’s judgment.

Analysis

“Dhewaran” or “Devarana” is defined in a dictionary as being paradise or heaven. This word therefore was a general name which other people may still use providing that they act in good faith, i.e. not causing confusion to the public or damage to those who registered these words as their trademarks, service marks or trade names. The defendant used the word “Baan Dhewaran” when referring to its real estate and housing estate programs, which, based on the high selling price, are projects of significant size. Although the plaintiff applied for trademark and service mark registration in 2000, it only commenced its construction business of a commercial building in Dubai in 2007 and started to advertise a construction project of a service apartment building in Thailand in 2008. On the other hand, the defendant has used “Baan Dhewaran” both in Thai and in Roman letters as its trade names since 2003. Although the defendant’s trademark was registered after the registration of trademarks and service mark “Devarana” by the plaintiff, the plaintiff registered its marks in different categories from the one the defendant did. Pursuant to Trademark Act B.E. 2534 section 44, and section 80 together with 44, the plaintiff has exclusive rights over the use of its marks only in the indicated goods and services. The plaintiff therefore has no right to prohibit the defendant from using “Dhewaran” both in Thai and in Roman letters in the defendant’s real estate and housing

estate businesses. More so, the plaintiff used “Devarana” with the word “spa”, while the defendant used “Dhewaran” with the word “Baan”, which referred to its real estate and housing estate business. Hence, it is not reasonable to conclude that the public would be confused as to whether the defendant’s business belongs to the plaintiff or relates to the plaintiff in any way. 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 similar scale. Based on that fact, it is not a convincing that the defendant conducted its own business with the intention to exploit the reputation of the plaintiff. The use of the trade name by the defendant therefore does not infringe trademark and service mark of the plaintiff and does not damage the business reputation of the plaintiff. Since the use of marks by both parties did not cause the likelihood of confusion to the public, the defendant did not have better rights than the plaintiff. Hence, it cannot revoke the registration of trademark and service mark of the plaintiff according to Trademark Act B.E. 2534 section 80 together with 67.

Keywords Trademark – Distinctiveness – Revocation – Company name – Trade name

Summarized and Translated by Akedanai Techajongjintana

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