

Supreme Court of the Kingdom of Thailand

S.C. 8726/2011


Whittaker Corporation v. Department of Intellectual Property


Court : Supreme Court
Case : Civil Case
Date of Judgment : 2012/02/27
Plaintiff : Whittaker Corporation
Defendant : Department of Intellectual Property
Area of Law : Trademark
Statue : The Trademark Act B.E. 2534 (1991) Section 6, Section 7 paragraph one, two (2), Section 8 (13), Section 80 [Hereinafter "The Trademark Act"]

Panel of Justice:

Prinya Deepadung - Aram Sena-montri - Dhajaphan Prabhudhanitisarn

Background:

The plaintiff filed the trademark registration application No. 579420 for the term "AMP" and "NETCONNECT" which are in an oval mark  to apply to the products in Class 9 and submitted the service mark registration application

No. 579421, 579422, 579423, 579424 for the mark  to apply to the services in Class 37, 38, 42, 35 respectively. The Trademark Registrar reasoned that the service mark is not distinctive character by the Trademark Act, Section 7, and asked the plaintiff submitting a letter of intent that it shall not be considered the sole right to use the Roman term "NETCONNECT". For the trademark registration application No. 579420, the Trademark Registrar ordered that the plaintiff's trademark is not distinctive character by the Trademark Act. The term "AMP" is an abbreviation of the word "AMPERE" means a power unit equal to the electric current flowing through the one ohm resistance. When it is applied to the goods by the trademark registration application, it is aimed to character or properties of the goods directly. The plaintiff filed an appeal against the Trademark Registrar to the Trademark Board. The Trademark Board confirmed the order of the Trademark Registrar. Plaintiff, then, filed the complaint to revoke the order of the Trademark Registrar, and the decision of the Trademark Board refusing the trademark and service mark registration mentioned above, to

request the Trademark Registrar register the trademarks and service mark by the plaintiff's applications.

Procedural History:

The Central Intellectual Property and International Trade Court dismissed the case. The plaintiff lodged the appeal to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court granted the revocation of the order of the Trademark Registrar, and the decision of the Trademark Board which rejected the trademark registration application No. 579420 and the service mark application No. 579421, 579422, 579423, 579424, and ordered the Trademark Registrar registering the trademark and service mark register applications.

Issue:

Whether the decision of the Trademark Board related to the trademark registration application No. 579420 and the service mark registration applications No. 579421 to 579424 are lawful or not?

Analysis:

According to the Trademark Act, Section 7, paragraph two (2) and Section 80 together with Section 7 paragraph two (2), a word or term aimed to the character which is not the distinctive character in itself, is limited to a word or term which is aimed at the characteristics or properties of the product or service directly. If the word or term is indirectly aimed at the characteristics or properties of a product or service, then the word or term is distinctive character. For the trademark registration application No. 579420, the word "AMP" is an acronym derived from the word "AMPERE" and "AMPLIFIER", which the word "AMPERE" means an unit of electric current measurement, and the word "AMPLIFIER" means an amplifier. However, the products, which are used the trademark, are the electric switch circuit, wall electric circuit, temporary electric cords or panel, electric cables, electric fitting circuits, electric fitting lighting circuit, and optic cable. They are not the electric current measurement unit or amplifier, so the word "AMP" and the term "AMPLIFIER" are not directly aimed at the characteristics or properties of the products by the trademark registration application No. 579420. Although the products are associated with electricity, they are related it indirectly. They are not relevant in the sense that they are aimed at the characteristics or properties of the electric current measurement unit in ampere or amplifier. When the word "AMP" is applied to the products by the application No. 579420, the word "AMP" is not aimed directly at the characteristics or properties of the products. The word "AMP" is regarded as a distinctive character by the Trademark Act, Section 7, paragraph two (2).

The term "NETCONNECT" means the linked network. It is not a word or term aimed directly at characteristics or properties of the 7 products listed above, and it is not the descriptions of the 7 products as well. The linked network is not associated directly or indirectly with the electric switch circuit, electric wall circuit, temporary electric cords or

panel, electric cables, electric fitting circuits, electric fitting lighting circuit, and optic cables. When the term "AMP" and "NETCONNECT" are applied to the 7 products, they are not directly aimed at characteristics or properties of the 7 products. They are a distinctive character which let the people or consumers know and understand that the products, which are used the trademark by the trademark registration application, are different from other products. They are the trademarks which shall be registered under the Trademark Act, Section 6.

For the service mark registration application No. 579421 to 579424 with the word "AMP" and "NETCONNECT" in an oval . The services by the application used with the mark are the building wiring installation system, maintenance of the wiring system in building, repairing the wiring system in the building, consulting on installation - maintenance - repairing of wiring system in a building, etc, including 10 items. They are not the service of measuring the Ampere electric current unit or the service of an amplifier rental or any other services on the amplifier. The word "AMP" is not aimed directly at the characteristics or properties of the services by the application No. 579421 to 579424. Although those services are related to electricity, but it is indirectly involved, not relevant in the sense that it is aimed directly at the characteristics or properties of the services. When the word "AMP" is applied to the services of 10 items, the word is not aimed directly at the characteristics or properties of the services by the registration No. 579421 to 579424. So It is the distinctive character under the Trademark Act, Section 80 together with Section 7 paragraph two (2). The term "NETCONNECT" is not a word or a term which is not aimed directly at the characteristics and properties of the 10 services, and not the description of such services. Because the linked network is not directly related to 10 services or not the description of the 10 services. So the word "AMP" and the word "NETCONNECT" by the service mark registration applications No.579421 to 579424 when are applied to the 10 services, they are not aimed directly to the characteristics or properties of the 10 services. They are the distinctive characters which let the people or consumers know and understand that the services which are applied the service mark are different from other services under the Trademark Act, Section 80 and Section 7 paragraph one and paragraph two (2). This service mark shall be registered by the Trademark Act, Section 80 and Section 6. Therefore, the decision of the Trademark Board refusing to register a trademark by the trademark application No. 579420 and a service mark by the service mark registration application No. 579421 to 579424, is not favorable by the Trademark Act, Section 7, paragraph two (2) and Section 80 together with Section 7 paragraph two (2).

Keyword: service mark, distinctive character

Summarized: Non Tuntapong

Edited: