

Supreme Court of the Kingdom of Thailand

S.C. 5448/2011

Burger King Corporation v. Department of Intellectual Property

Court	:	Supreme Court
Kind of Case	:	Civil Case
Date of Judgment	:	2011/06/27
Plaintiff	:	Burger King Corporation
Defendant	:	Department of Intellectual Property
Area of Law	:	Service Mark
Statue	:	The Trademark Act B.E. 2534 (1991)

Panel of Justices

Somkuan Wichienwan – Aram Senamontri – Thanasit Nilkumhang

Background

A plaintiff applied a service mark registration of words, “HAVE IT YOUR WAY”, in Classification 43, service and restaurant. A registrar denied the application because the service mark was not distinctive. The words mean “dine it on your choice or with your style” which had direct reference to the character or quality of the service. Furthermore, the evidence the plaintiff showed were not enough to consider that the service mark was used widely which was deemed a distinctive service mark in respect of the Ministerial Notifications. Hence, the plaintiff appealed the registrar’s order to the Trademark Board. The Trademark Board held that the words were not distinctive because they could be implied the meaning “there are everything you want” which narrated commonly. They were not distinctive in respect of Section 7 Paragraph one; therefore, they were prohibited to be registered in respect of Section 80 complied with Section 6 of the Trademark Act B.E. 2534 (1991). Moreover, the evidence the plaintiff showed were not enough to consider that the service mark was used widely which was deemed a distinctive service mark in respect of the Ministerial Notifications. The plaintiff, then, filed a law suit to seek for revocation of the orders of the registrar and the Trademark Board. The Central Intellectual Property and International Trade Court rendered a judgment which revoked the orders of the registrar and the Trademark Board and order the registrar precede the registration application of the plaintiff. The defendant, the Department of Intellectual Property, filed the appellant to the Supreme Court.

Issue

Whether or not the service mark of the plaintiff is the words which are common words in the sense of public or certain consumers who would not distinct between the service of the plaintiff and others; hence, it is not distinctive in respect of Section 7 Paragraph one.

Proceeding History

Although the service mark the plaintiff filed the application was commonly narrative, there were facts which were not argued by the defendant. Before the plaintiff applied the application, the plaintiff has registered and used such the service mark with the restaurant service which mainly sold hamburgers and beverages in restaurants with a plaintiff's service mark "BURGER KING" in many countries for more than twenty years. In Thailand, the plaintiff has used such the service mark with the restaurant service which mainly sold hamburgers and beverages in restaurants with a plaintiff's trademark and service mark "BURGER KING" in Bangkok and many provinces nearby. Furthermore, the plaintiff advertised the service mark in a magazine, published media and marketing with a credit card company, and billboards in many places of many provinces of Thailand, which the certain customers realized that such the service mark was belonged to the plaintiff. Moreover, such the service mark was appeared only in the restaurants with the trademark and service mark "BURGER KING" of the plaintiff, but not in other's restaurants which were the same business. Therefore, the service mark with such words had characteristic which made public realize that the service with the plaintiff's service mark was different from others. In addition, the words "HAVE IT YOUR WAY" had no direct reference to the character or quality of the plaintiff's service; i.e. they did not directly refer to the character or quality of the restaurant in accordance with the Trademark Act B.E. 2534, Section 80 complied with Section 7 Paragraph two (2). Consequently, such the service mark was distinctive and could be registered in accordance with Section 80 complied with Section 6 and 7 Paragraph one of the Act.

Keywords service mark, distinctive

Summarized and Translated by Akedanai Techajongjintana

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