

Supreme Court of the Kingdom of Thailand

S.C. 5822/2011

Lacoste v. Mr.Thanakarn Po-on and Others

Court	:	Supreme Court
Kind of Case	:	Civil Case
Date of Judgment	:	2011/07/06
Plaintiff	:	Lacoste
Defendants	:	Mr.Thanakarn Po-on (1 st) Pada Alligator Co.,Ltd (2 nd) Miss Jaruwan Bunjusuwan (3 rd)
Area of Law	:	Trademark
Statue	:	The Trademark Act B.E. 2534 (1991)

Panel of Justices

Maitri Sri-arun - Aram Senamontri – Parinya Deepadung

Background

A plaintiff is an owner of a trademark, an artificial crocodile drawing and “LACOSTE” letters, in Classifications 28. The plaintiff has registered the trademark in France since 1933 and in Thailand since 1974. The plaintiff has used such trademark in Thailand and over 190 countries for a long time. The plaintiff registered, in Thailand, the drawing as a trademark for clothes and costumes which are in Classifications 25. The three defendants possessed shirts which had trademarks, an artificial crocodile drawing and a word “ALLIGATOR”, parts of shirts with such trademarks, and other properties. The first defendant applied such trademark applications. The plaintiff challenged the applications and appealed. The plaintiff filed a lawsuit to ask the Central Intellectual Property and International Trade Court for withdrawing the applications of the defendants, desistance of using or registration of the trademarks identical with or similar to the plaintiff’s trademarks, and compensation of 500,000 Baht. Therefore, the Central Intellectual Property and international Trade Court dismissed the complaint. The plaintiff appealed to the Supreme Court.

Issues

1. Whether or not the trademarks of the first defendant are identical with or similar to the registered trademarks of the plaintiff, and that the public might be confused or misled as to the owner or origin of the goods?

2. Whether or not the filing of trademark applications of the first defendant is bona fide?

Proceeding History

Although the plaintiff had witnesses testifying that the first defendant's trademark and the plaintiff's trademark are similar, which the plaintiff claimed that it is sufficient to prove that it was so similar thereto that the public might be confused as to the owner or origin of the goods. It was mere personal opinion of that witness which was not completely accepted as sense of reasonable person. The feeling of reasonable person must be considered by the trademark itself. Hence, it was necessary to consider both of the trademarks as a whole and the pronunciation of them. In re, using worldwide the trademarks, artificial crocodile drawings, by the plaintiff does not mean that the plaintiff owns the exclusive right to use them. Because crocodiles are natural creatures, others also are able to use them as their trademarks up until they are not identical with or similar to the plaintiff's trademarks that the public might be confused as to the owner or origin of the goods.

The first defendant's trademarks were artificial crocodile drawing with long body, up-wide-opened mouth of approximately 90 degrees, and turn-down tail while the plaintiff's trademarks, the artificial crocodile drawings, were with thick body, horizontal-placed head, a bit opened the mouth, and turn-up tail. Furthermore, the first defendant's trademarks had the word "ALLIGATOR" on the drawings, some were beneath the drawings. And some had the word "Monitor" on the drawings, some were over the drawings. Although the word "ALLIGATOR" also means crocodile in Thai, the pronunciation is totally different from the word "LACOSTE" which is belonged to the plaintiff. Therefore, it deemed not to confuse the public as to the plaintiff's trademarks. According to the rationales above, the first defendant's trademarks had many different characteristics from the plaintiff's; therefore, the first defendant's trademarks were not identical with the plaintiff's trademarks or so similar thereto that the public might be confused as to the owner or origin of the goods. As for the issue the plaintiff claimed that the first defendant was not bona fide in filing the trademark registration application because the public could not distinct the first defendant's trademarks and the plaintiff's, where the court has already justified that the first defendant's trademarks were not identical with the plaintiff's trademarks or so similar thereto that the public might be confused as to the owner or origin of the goods, it was not concluded the first defendant was not bona fide. The Supreme Court affirmed the judgment of the Central Intellectual Property and International Trade Court.

Keywords trademark, confused or misled

Summarized and Translated by Akedanai Techajongjintana

Edited