

Supreme Court of the Kingdom of Thailand

S.C. 3759/2011

Marriott Worldwide Corporation v. Department of Intellectual Property

Court : Supreme Court

Kind of Case : Civil Case

Date of Judgment : 2011/05/19

Plaintiff : Marriott Worldwide Corporation

Defendant : 1. Department of Intellectual Property
2. Director-General of the Department of Intellectual Property

Area of Law : Intellectual Property, Service mark

Statue : Trademark Act B.E.2534 (1991)

Panel of Justices:

Chaleaw Phonwiset-Aram Senamonti-Thanasit NilKhamhaeng

Background

The Plaintiff filed with the court that the Plaintiff, an American company which operates hotels and accommodations, owns the service mark bearing the word "COURTYARD".

The first defendant, the Department of Intellectual Property, is a government agency attached to the Ministry of Commerce and is a juristic person.

The second defendant is the Director-General of the Department of Intellectual Property. With respect to registration of trademarks, one of the government officials serving in the defendant's office was appointed to be the Trademark Registrar, while its Director-General was appointed to be a member of the Trademark Board.

Submitted to the first defendant was the plaintiff's application for registration of its trademark, the word "COURTYARD" below in respect of the goods in class 43, i.e. service, hotel, resort, camp, restaurant, service facilities for general meeting discussion or exhibition and service facilities generally for special occasions and hotel booking. However, registration thereof was refused by the Trademark Registrar on the grounds that the mark was not distinctive in character under section 7 of the Trademark Act B.E.2534 (1991) and that it had direct reference to the character or quality of the specified services. On appeal, therefore, the Trademark Board passed its decision confirming the Trademark Registrar's discretionary decision.

Against this discretionary decision, the plaintiff brought the case before the court requesting the court to rule that its service mark was a distinctive character and qualified as a rightful trademark and also to withdraw the Trademark Registrar's discretionary decision and the Trademark Board's decision.

In response to the complaint, both defendants argued that the plaintiff's service mark was not distinctive character and requested that the complaint be dismissed.

Issues

Whether or not the plaintiff's service mark bearing the word "COURTYARD" was of distinctive character to be registered under the Trademark Act B.E. 2534 section 80 and section 6(1) because it had direct reference to the character of the plaintiff's service.

Procedure History

The Central Intellectual Property and International Trade Court held that the service mark "COURTYARD" was of distinctive character and could be registered and overturned the Trademark Registrar's discretionary decision and the Trademark Board's decision. The Supreme Court confirmed the judgment of the Central Intellectual Property and International Trade Court.

Analysis

Both defendants appealed that the plaintiff's service mark bearing the word "COURTYARD" means *yard*. The plaintiff's application for registration of this word for service, hotel, resort, camp, restaurant, service facilities for general meeting discussion or exhibition and service facilities generally for special occasions and hotel booking reflected the nature of the plaintiff's service that was the resort or the hotel or the room with the character of spacious than the other due to the fact that yard, the significant part inside area home outside roof but inside the area of the fence, was an open space area home where many events such as party that required a wide area or on the patio always occurred. So, the word "COURTYARD" has direct reference to the character of service and was not of distinctive in character. The Supreme Court ruled that even though the meaning of the word "COURTYARD" was *yard*, however, when applied to the service class 43, i.e. service, hotel, resort, camp, restaurant, service facilities for general meeting discussion or exhibition and service facilities generally for special occasions and hotel booking, it seemed to be convincing only to people who had already decided. It did not mean to indicate or illustrate that the nature of the service was more spacious than any other because *yard* might be used in several other situations. As a result, the plaintiff's service mark, the word "COURTYARD," did not refer directly to the character or qualification of the service but it was a word that could be of distinctive character to be registered under the Trademark Act B.E. 2534 section 80 and section 6(1). The Trademark Registrar's discretion and the Trademark Board's decision that refused to register the plaintiff's service mark, therefore, were unlawful.

Keywords Distinctive character – service mark

Summarized and translated by Soemsit Sirijaroensuk

Edited