

Supreme Court of the Kingdom of Thailand

S.C. 2239/2011

Von Dutch Originals, LLC. v. Department of Intellectual Property

Court : Supreme Court

Case : Civil Case

Date of Judgment : 2011/10/03

Plaintiff : Von Dutch Originals, LLC.

Defendant : Department of Intellectual Property and others

Area of Law : Trademarks

Statute : The Trademarks Act B.E. 2534 (1991), Section 6 (1) (2), 7 paragraph two (2), Section 8 (13), The Announcement of Ministry of Commerce, No. 5 (B.E. 2543 (2000))

Panel of Justices

Somkoun Wichienwan - Aram Senamontri - Tanasit Nilkamhang

Background :

The plaintiff is a corporation under the laws of the United States, and the owner of the trademark . The plaintiff filed a trademark registration application No. 551883 to the first defendant, but the Trademark Registrar was not granted the trademark registration on the grounds that the word "Von Dutch" means "from the Netherlands or of the Netherlands" which is a geographical name and a description of the features of goods. Therefore it is not distinctive character under Section 7, paragraph two of the Trademark Act B.E. 2534 (1991). The plaintiff appealed the order of the Trademark Registrar to the Trademark Board of Committees. The second to tenth defendants as the Trademark Committee ordered that the word "Von" means "from/of/come from", and the word "Dutch" means "about the Netherlands/the Netherlands". So "Von Dutch" is a generic term, not distinctiveness under

Section 7, paragraph 1 of the Trademark Act B.E. 2534 (1991). Such mark leads to understand that the goods is produced from the Netherlands. But the plaintiff is an US corporation, this mark may make the public be confused or misled about the origin of the goods .

Issues:

Whether the trademark  by the plaintiff's trademark registration application No. 551883 has been prohibited for registration under the Trademarks Act B.E. 2534 (1991), Section 8 (13), and the Announcement of Ministry of Commerce, No. 5 (B.E. 2543 (2000)) related to the trademark prohibited for registration, dated 25 October B.E. 2543 (2000) , Rule 2 (2) (hereinafter "the Announcement of Ministry of Commerce) and the word "Von Dutch" is a generic term, and is not distinctive character under Section 7, Paragraph one of the Trademark Act B.E. 2534 (1991) or not?

Procedural History:

The Central Intellectual Property and International Trade Court (hereinafter: CIPITC) held that

- revoke the order of the Trademark Registrar, No. PN 0704/9341 and the decision of the Trademark Board, No. 1812/2549.

- order the first defendant to register the trademark according to the plaintiff's trademark registration application No. 551833.

The first defendant appealed to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court held against the judgment of the CIPITC.

Analysis:

The Announcement of the Ministry of Commerce has determined that the trademark which is a mark or a description leading to public confusion or misled about the type of product, origin of the goods, or the ownership of goods, is prohibited to registration. The Announcement of the Ministry of Commerce was issued by virtue of Section 8 (13) of the Trademark Act B.E. 2534 (1991). It shall be strictly forbidden to register any mark or description containing one of the aforementioned characteristics. Therefore, the interpretation of section 8 of the Act, including the Announcement of the Ministry of Commerce shall be interpreted strictly that the marker or description leading to public confusion or misled about "the origin of the goods" means the mark or description that convey meaning or to understand that a country or place of origin or the source of goods which is featured such mark or description directly. It shall not be construed the mark or description extend to the meaning of the country or person who lives in that place. If it is interpreted as the extension, the word which means a citizen of any country or a person who lives in that place will not be registered as a trademark, even it is expressly prohibited by law.

Trademark  by the plaintiff's application No. 551833 contains the word "Von" which is a German word that means "from/of/come from", the word "Dutch" which are English word that means "the Netherlands". So the word "Von Dutch" should have the meaning of "come from / the Netherlands". This term is convey directly to the Netherlands as a person, not the meaning of the Netherlands as a place which is under the definition of "Origin of goods" by Rule 2 (2) of the Announcement of the Ministry of Commerce. The trademark  by the plaintiff's application is not the mark or description that can lead the public might be confused or misled about the origin of goods. Therefore such trademark is prohibited to trademark registration. The word "Von Dutch" when applied to the goods is only mean the goods came from or is of the people of the Netherlands. It may not understand

that the goods under this trademark belongs to a specific person that would cause confusion or mislead the public as to the owner of such goods, according to the Trademark Act B.E. 2534 (1991), Section 6 (1) (2) , 7 paragraph two (2).

Keywords: trademark, confusion and being mislead

Summarized: Non Tuntapong

Edited: