

Supreme Court of the Kingdom of Thailand
S.C. 5451/2011
McDonald's Corporation v. Department of Intellectual Property

Court : Supreme Court of Thailand
Kind of Case : Civil Case
Date of Judgment : 2011/06/27
Plaintiff : McDonald's Corporation
Defendant : Department of Intellectual Property
Area of Law : Trademark
Statue : Trademarks Act B.E 2534

Panel of Justice

Tanasit Nilkumheang - Aram Saenamontree - Somkwun Wichienwan

Background

Plaintiff is the owner of numerous trademarks and service marks that contain a word "Mc" to food products in several formats. Trademark Registrar announced the applicant's trademark "MacCandy" in specified goods such as; candy, dessert, peppermint mint, sugar candy. The previous mentioned goods trademarks with a Roman word "Mac" is the primary component and essence including the same first syllable pronunciation and consumer groups. Therefore, it is likely that the public will be confused, mistakenly in ownership because of the plaintiff's trademark "Mac" has been well-known in Thailand and around the world for over 50 years. The applicant's trademark registration is intended to imitate the plaintiff's trademark because the word "Mac" is the plaintiff's trademark and the word "Candy" has directly refer to the character or quality of the specified goods, thus prohibited registration under section 7, paragraph two (2) of the Trademarks Act B.E. 2534 (1991). The plaintiff is the owner of a famous trademark under section 8 (10) of the Trademark Act B.E. 2534 (1991), requested the Trademark Registrar to refuse the trademark's registration. The defendant testified that the applicant's trademark is identical or dissimilar to a well-known mark which caused to the public confusion in ownership or source of products, and distinctive character but not directly refer to the character or quality of the specified goods, thus the Trademark Registrar shall be grant the registration and requested to dismiss.

Issues

1. The applicant's trademark is identical or similar to the plaintiff's trademark which had been registered, whether or not caused to the public confusion in ownership or source of products.
2. Whether or not the applicant's trademark "Candy" is distinctive character, but does not directly refer to the character or quality of the specified goods.

Procedural History

The Central Intellectual Property and International Trade Court dismissed the case
The Plaintiff appealed to the Supreme Court
The Intellectual Property and International Trade Division of the Supreme Court confirmed the judgment of the Central Intellectual Property and International Trade Court

Analysis

1. Even the applicant's trademark, the first syllable is Roman word "Mac" and the Roman alphabet, M, and c same as "MC", of the plaintiff's trademark and service mark which have been registered but such words are words that have meanings that are commonly used that refers to the Scottish or the foreword surname of the Scottish. The applicant is entitled to use the word "Mac" which generally used in common. In addition, the plaintiff's trademarks and service marks may have different such as; BigMc, McFish, McPizza, McBurger, and McTonight and so on, that are different from the applicant's trademarks. Furthermore, the applicant's trademark "MacCandy" is consist of eagles appearance, which is different from the plaintiff's trademark, which without any animal symbolic. Therefore, the applicant's trademarks is not the same as or similar to the plaintiff's trademark which have been registered, and lead to the public confusion in ownership or origin of the goods. Registration is not prohibited under the Trademark Act. MF 2534, Section 8 (10) and Section 13.

2. The word "Mac" is generally used in common, neither the inventor nor a word that directly refer to the character or quality of the specified goods which has distinctive characteristic. Though, the plaintiff brought such words as a trademark, it does not prejudice other parties not to take such words to use is strictly prohibited. Just only make the different from the former when use those that will be used as a marker of the later mark would have to be different from others who have used it before, enough to not cause public confusion go astray in the ownership of or origin. As follow, the applicant's trademark is different from the plaintiff's trademark and servicemark as judged. Moreover, the eagle appearance of the trademarks of the applicant is large and above the Roman word "MacCandy" and the word is larger than the Roman alphabet as well. The Eagle is the distinctive character, but had not directly referred to the character or quality of the specified goods, and is the essence of the mark of the applicant, such as Vegas. Eagle invention has such a distinctive and the trademark of the applicants may call Eagle MacCandy or MacCandy. Although the word "Candy" is not distinctive and the applicant refused to show their credentials, but when decided through the trademark, the applicant's trademark is distinctively and should have been registered under the Trademarks Act B.E 2534, Section 6 (1).

Keywords

Trademark – The applicant's trademarks– Department of Intellectual Property – same as or similar - confusion in ownership- commonly used

Other

Summarized and Translated by Yanaphak Mantarat