

**Supreme Court of the Kingdom of Thailand**  
**S.C. 5447/2011**  
**Yung Sung-ghew Kow. Ltd. v. Department of Intellectual Property**

**Court** : Supreme Court  
**Kind of Case** : Civil case  
**Date of Judgment** : 27/06/2011  
**Plaintiff** : Yung Sung-ghew Kow. Ltd.  
**Defendant** : Department of Intellectual Property  
**Area of Law** : Trademark  
**Statue** : Trademark Act B.E. 2534 (1991), Section 27

**Panel of Justice**

Maitree Sriarun - Aram Sanemontree - Somkwun Wichienwan

**Background**

Registration of the plaintiff's trademark, which composed with the word "GIANNI VALENTINO" and artificial picture of "GV" was refused by the Trademark Registrar on the grounds that the mark was like or alike to others Trademark that already been registered, according to section 13 of the Trademark Act B.E. 2534 (1991). On appeal therefrom, the Trademark Board passed its decision confirming the Trademark Registrar's discretion.

Against such discretion and decision, the plaintiff sued the defendant and requested the Central Intellectual Property and International Trade Court that the defendant instructed to refuse registration of such trademark on the grounds that it likes or alike to others registered trademark was unlawful. The plaintiff's trademark was different to others trademark and doesn't occurred confusion to the public. In addition the trademark fountain from Japan, while the other two registered trademarks fountain from Italy. The trademark had been using from the plaintiff with good faith for a long time. During the time that these trademarks had been using along together with good faith, it occurred no confusing to the public about the production or the owner of the trademark. As follow it should assume that each trademark had been using in a good faith manner from each owner. The Trademark Registrar's should register this trademark.

In response to the plaint, the defendant argued that the plaintiff had no right to file this case because the Trademark Board's decision had already been final under section 18 of the Trademark Act B.E. 2534 (1991).

**Issue**

1. Whether or not the plaintiff's trademark was like or alike others trademark that already registered, which can occur confusion to the public on the issues of the production owner or the production fountain.

2. Whether or not the principle about how to consider the request trademark was like or alike others trademark, should consider both trademark feature and the trademark concept.

3. Whether or not when the "VALENTINO" word had its own meaning pursuant to the general dictionary, and the plaintiff and the others registered trademark owner had declared to refuse to be the only user of such word, then the plaintiff can use the word as a component of its trademark. In addition, whilst the placing of plaintiff creation picture and alphabet was distinctive difference, which

could not cause any confusion to the public, so the trademark was able to be register by the Trademark Registrar's.

4. Whether or not the good faith user of the like or alike trademark from outside the Kingdom of Thailand can be claim to be register in the Kingdom of Thailand, according to section 27 of the Trademark Act B.E. 2534 (1991).

### **Procedure History**

The Central Intellectual Property and International Trade Court dismissed the case.

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. The plaintiff's trademark feature has an artificial picture of "GV" which got an artificial Roman alphabet V in the circle line and the cycle was uncompleted. This was similar to others trademark, which has an article Roman alphabet V in the oval line and the cycle was uncompleted too. Furthermore, the plaintiff's trademark has the "VALENTINO", Roman alphabet, as the significant part of its trademark, which was the same feature to others trademark. As follows, it could see that the plaintiff's trademark was alike others trademark that had already been registered. Therefore, when the plaintiff has applied to register such trademark in the same production category, as same as, the registered trademark, this could occur confusion to the public about who was the production owner or the production fountain.

2. In the case of plaintiff's trademark feature and the trademark concept, it came from Mr. Gianni Valentino name, who is the Italian famous designer and the owner of a well-known dressing room. The "GV" trademark feature had an artificial picture concept from Mr. Gianni Valentino initial name letter, and the trademark name "GIANNI VALENTINO" came from Mr. Gianni Valentino name. Even this plaintiff's trademark didn't copy from others thought, but when the plaintiff's trademark was like or alike others registered trademark, it still remain the prohibited feature for the Trademark Registrar's to register.

3. When consider the trademark was like or alike others registered trademark, it must not consider by counting the word "VALENTINO" as the main point because it had its meaning pursuant to the general dictionary, in addition with the facts that the plaintiff and the owner of the registered trademark declared not to be the only user of such word. As a result, the main point when consider the plaintiff's trademark, it should consider the feature of the plaintiff's trademark, instead the word "VALENTINO", but if the feature had no distinctive difference between each other trademark, the plaintiff's trademark was still prohibit for the Trademark Registrar's to register.

4. According to section 27 of the Trademark Act B.E. 2534 (1991) said the Trademark Registrar's has power to register for several trademarks, which are like or alike others trademark, if each trademark owner had use their trademark in a good faith manner or had the special circumstances that should be registered. This section aimed to enforce toward the good faith action, which occur in the Kingdom of Thailand only. From the plaintiff's trademark facts, it appeared that the trademark was registered, and used with good faith action for more than 20 years in Japan and others countries until now, which was not in the Kingdom of Thailand, so it didn't comply

with section 27 of the Trademark Act B.E. 2534 (1991). Moreover, even the plaintiff had permitted from Mr. Gianni Valentino, the creation and the owner of such trademark in Italy to be the only user in Japan and Asia pacific countries, it still can't counted as the special circumstances according to section 27 of the Trademark Act B.E. 2534 (1991). The plaintiff's trademark was still prohibit for the Trademark Registrar's to register.

**Keywords**

Trademark – Trademark Registrar's– Good faith– like or alike- Special circumstances-Initial name- Trademark feature-Artificial picture

**Other**

Summarized and Translated by Yanaphak Mantarat