

**Supreme Court of the Kingdom of Thailand**

**S.C. 9513/2011**

**Siam Safety Premier Co., Ltd. v Siam Safety Technology Co., Ltd.**

**Court** : Supreme Court  
**Kind of Case** : Civil Case  
**Date of Judgment** : 2011/11/08  
**Plaintiff** : Siam Safety Premier Co., Ltd.  
**Defendant** : Siam Safety Technology Co., Ltd.  
**Area of Law** : Right to use of trade name, Trade name  
**Statute** : Trademark Act B.E. 2534 (1991)  
**Panel of Justices** :

Dhajaphand Prabhudhanitisarn - Aram Senamontr - Prinya Deepadung

**Background**

Plaintiff filed the case against defendant on the ground that plaintiff had registered company limited since 1999 under the name Siam Safety Premier Company Limited and used trade name under “Siam Safety Premier” or “SSP”. Later on, plaintiff registered service name under “SSP” and invented image for goods in class 42 as for installation service of fire extinguisher system. Defendant applied for company established registration in 2003 under the name Siam Safety Technology Company Limited by bringing the words “Siam Safety” which was specific name and essential part of the plaintiff’s trade name which caused damages to plaintiff. Plaintiff requested the court to order defendant to pay 100,000,000 baht for the damages with interest and prohibited defendant to use the name “Siam Safety Technology Company Limited” or not to use the words “Siam Safety” as a part of defendant’s name and asked for the damages of 5,000,000 baht per moth from the defendant.

Defendant made counter - claim that the Bangkok Metropolitan Partner Company Registrar examined rules, regulations, laws and others and allowed defendant to register the company limited under the name Siam Safety Technology Company Limited. Plaintiff had known since the beginning but did not make an objection. Therefore, defendant might have the legally right to use the said name for business and might not confused and misled to the ordinary people that defendant was plaintiff’s agent or associated company. Filing false fact by plaintiff spoiled defendant’s reputation. Defendant requested the court for case dismissal and ordered

plaintiff to pay the defendant 20,000,000 baht and 1,000,000 baht per month for damages.

The Central Intellectual Property and International trade Court dismissed the counter – claim.

### **Issue**

Whether defendant infringed the right of trade name of plaintiff or not.

### **Procedural History**

The Central Intellectual Property and International Trade Court judged that defendant had to pay 300,000 baht with interest to plaintiff and prohibited defendant to use the name Siam Safety Technology Company Limited or with no words Siam Safety as part of defendant's company name. Dismissed others requests. As for defendant's counter – claim should be dismissed.

Defendant appealed to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court amended that the counter – claim dismissal by the Central Intellectual Property and International Trade Court judgment should be dismissed. Apart from the amendment was in line with the judgment of the Central Intellectual Property and International Trade Court.

### **Analysis**

The right to use of a name or person name, though other person might use similar name but it should not spoil interest of prior users illegally without consent. Otherwise, it should be deem as infringing to right to use of a name according to Civil and Commercial Code Section 18 and Section 420 or 421. In case of the right to use of trade name, it should be adapted the said provision to use for certification and protection the right of trade name. The fact in this case could be learnt that plaintiff registered as company limited under the name “Siam Safety Premier Company Limited” in 1999. Plaintiff run business about production and distribution of fire extinguishers especially fire ball. Plaintiff had patent both in Thailand and the United States of America. Plaintiff use the said name for such business and used as a part with invented image as registered service mark and trademark in Thailand. Therefore, it could be counted that the said name had been qualified as trade name of the plaintiff. The said business and goods of the plaintiff had publicized until it had reputation and got so many awards. As for defendant, it was registered as company limited after the plaintiff in 2003 under the name “Siam Safety Technology Company

Limited” which was not only being similar to plaintiff’s trade name but also being bring the word which was an essential part of the plaintiff ‘s trade name “Siam Safety” to use as essential part of defendant’s company name. The usage of essential part of plaintiff’s trade name like this might be confused or misled the buyer as to the same company. Though the plaintiff’s name had the word “premier” at the end of the name and defendant’s name had the word “technology” at the same place but those words had no dominant character which were important enough to notice or remember like the words “ Siam Safety”. Even though buyers noticed thoroughly, and saw the differences but they might be understood that defendant was associated company with plaintiff or having relationship to each other. Hence, it was counted that defendant used the words “Siam Safety” of plaintiff and still used such name for the same business as plaintiff. Therefore, the acts of defendant might be the usage of plaintiff’s trade name which had chance to spoil interest of plaintiff’s business. It was appeared that defendant produced and distributed fire ball as same as plaintiff whose the patent holder until there was dispute about the infringing patent of invention, If it was appeared that it caused damages to plaintiff’s business, it could be deemed that defendant’s acts spoiled the plaintiff’s interest. Plaintiff also had authorized director testified about damages that plaintiff estimated sales volume of fire balls for Thailand about 50,000,000 baht to 32,000,000 baht. Moreover, Marketing Manager of plaintiff testified that he has worked in the said position since 2007 until present. Sale system of plaintiff in Thailand used dealer to distribute goods all over the country including offered to sell to government agencies. The offering for sell fire balls directly to consumer or retail shop, customers always told that it used to be offering for sale for sale before whereas plaintiff had never offered for sell that customer before. When asking the detail from customer, it was appeared that fire balls which had been offered for sell before were defendant’s goods. And customers thought that it was the same company as plaintiff’s company. Defendant had witness testified that sales volume would be more or less depend on managing method of selling company as essential part. The court had an opinion that plaintiff had witness testified the detail of facts about obstacle of offering for sell to customer because of competition. Some customers misled that defendant’s goods was plaintiff’s goods and plaintiff’s sales volume was less than estimation. When considering together with prior reason that plaintiff produced and distributed fire balls under plaintiff’s patent before. Later on, defendant used the name with the words “Siam Safety” as same as plaintiff and run

business about the production and distribution for the same goods. Therefore, the competition shall be affected to the said goods selling of plaintiff. Though defendant made packaging with different colour to plaintiff's goods and had defendant's company name printing including advertising and publicizing goods and defendant's company name or office of defendant was far away from plaintiff. But, methods of goods selling were in the mean of distribution all over the country. When there were same name in essential part, it might be confused or misled the buyer. From aforesaid reason, it was believed that defendant used the said plaintiff's trade name for business might spoil interest in plaintiff trading which should be infringing to the right to use of trade name according to Civil and Criminal Code Section 18 appurtenant to Section 420 and 421. Plaintiff had the right to request the court issued prohibit order the defendant used the name by infringing to plaintiff and paid damages to plaintiff.

The Central Intellectual Property and International Trade Court dismissed the defendant's counter – claim even though the court rejected defendant's counter – claim and there was no issue to adjudicate as to counter – claim. Therefore, the judgment of the Central Intellectual Property and International Trade Court that after hearing, the defendant was the infringer to the right to use of trade name “Siam safety” of plaintiff. Defendant had no right to ask for the damages from plaintiff according to the request of the counter – claim. The Intellectual Property and International Trade Division of the Supreme Court make amendment in order to make it right.

**Keywords**

right to use of trade name, Trade name, confused or misled

**Summarized by**

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