

Supreme Court of the Kingdom of Thailand

S.C.9240/2011

Honda Motor Go, LTD v. Department of Intellectual Property

Court : Supreme Court
Kind of Case : Civil case
Date of judgment : 2011/10/18
Plaintiff : Honda Motor Go, LTD
Defendant : 1. Department of Intellectual Property
Area of Law : Intellectual Property Trademark
Statue : Trademark Act B.E.2534 (1991)

Panel of Justices

Thatchaphan Praphutnitisal- Aram Senamonti-Prarinya Dee-phadung

Background

Plaintiff filed to the plaintiff that Plaintiff, a Japanese company, invented the general purpose engine model GX and produced this engine to sell in many countries including Thailand. The defendant-the Department of Intellectual Property-is a Government agency attached to the Ministry of Commerce and is a juristic person.

Submitted to the defendant was the plaintiff's application for registration of its trademark ,the shape or figure of the general purpose engine as the shape or the shape of object or 3D engine, the usage of which was in respect of the particular goods in classification 7, i.e. engine not for land vehicles and water pump. This application was refused by the Trademark Registrar on the grounds that the mark was not distinctive character and when using as a trademark, the character of goods would be explained by its shape or figure. On appeal therefore, the Trademark Board passed its decision confirming the Trademark registrar's discretion.

Against such discretion and decision, the plaintiff brought the case before the court requesting the court to judge that its trademark was distinctive character and qualified as a rightful trademark and also withdrew the Trademark Registrar's discretion and the Trademark Board's decision.

In response to the plaintiff, the defendant argued that the plaintiff's application for registration did not asked the shape or figure to be his trademark, so in order to consider this

application; it must focus on photo as a trademark not on the shape or figure. Therefore, the Trademark Registrar's discretion and the Trademark Board's decision were statutory.

Issue

Whether or not the plaintiff's trademark the shape or figure of general purpose engine model GX was not of distinctive character to be registered.

Proceeding History

The Central Intellectual Property and International Trade Court held that the plaint be dismissed.

The Supreme Court confirmed the judgment of the Central Intellectual Property and International Trade Court.

Analysis

The Trademark Act of B.E. 2534, Section 7, paragraphs one and two refer to the essential characteristics of trademarks that have distinguishing characteristics that make them unique. This includes trademarks that make the public or consumers of the product realize and understand that that trademark is different from other products. Trademarks that have or include one of the essential substances named herein are to be considered to have distinguishing characteristics... (2) Words or messages that do not directly indicate the characteristics or properties of the product... As indicated by the law it can be inferred that the general intent of the Trademark Act of B.E.2534 is to protect the trademark rights that have been registered as a trademark used to distinguish that products' trademark from other products and it must not indicate the characteristics or properties of that product directly. Concerning the shape or figure of the plaintiff's general purpose engine model GX, the shape or figure of which engine the plaintiff submitted for registration: The plaintiff claimed and testified that he had designed it to have characteristics that significantly distinguished it from other engines of the same type. To wit: The gas tank sits on top of the engine, the air filter is on top next to the gas tank, the exhaust pipe is near the air filter system and the starter is connected to the fan cover in front of the engine. Each piece of equipment has a color that is unique to itself, distinguishing it from the color of other engines. The engine is red, the gas tank is white, the air filter system and exhausted are black. The plaintiff has been using this color since 1983 and has never changed it. This has made it recognizable by all who see it as belonging to the plaintiff, in contrast to others. Nevertheless, when the photographs are

compared against five other engines, as seen on page seven of the plaintiff's complaint, it is evident that the characteristics of the plaintiff's engine and the others are easily recognized characteristics and all are similar. In addition, the plaintiff's engine used the trademark HONDA which makes it credible that the plaintiff wishes to register the trademark of the shape or figure of the general purpose engine GX simply to use the trademark law to prevent production by other engine manufacturers whose products have similarities to the plaintiff's. This would unnecessarily limit the rights of others. It is evident that in regards to the plaintiff's afore mentioned request to register the trademark, the order of the registrar and the verdict of the Trademark Board stands and there is no grounds to revoke it. As for certain countries permitting the plaintiff to register this trademark, this is dependent upon the society of and details of the laws governing each country but is not a reason to register this trademark for the plaintiff.

Keywords Distinctive character – shape or figure- trademark

Summarized and translated Soemsit Sirijaroensuk

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