

Supreme Court of the Kingdom of Thailand

S.C. 2239/2011

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

Court : Supreme Court

Case : Civil

Date of Judgment : March 29, 2011

Plaintiff : Von Dutch Originals, LLC.

Defendants : Department of Intellectual Property (1st)
Director-general of Department of Intellectual Property (2nd)
Kiat Rhurungroj (3rd)
Panumas Sitthivekin (4th)
Rattawit Saentaweesuk (5th)
Sanguan Lewmanomont (6th)
Chanwit Suwannaboon (7th)
Suwan Sukprasert (8th)
Por Anawin (9th)
Rujira Bunnag (10th)

Concepts : Intellectual Property, Trademark

Statute : The Trademarks Act B.E. 2534 (1991) sections 6, 7, 8

Panel of Justices

Somkuan Wichienwan, Aram Senamontri, Tanasit Nilkamhaeng

Case Background

The plaintiff is a limited company under the laws of the United States and the owner of the trademark . The plaintiff submitted a trademark registration application number 551883 to the first defendant, but the registration was refused by the Trademark Registrar on the grounds that the word “Von Dutch” means *from the Netherlands or of the Netherlands* which was a geographical name and a description of the character of the goods, and therefore had no distinctive character under section 7 paragraph two of the Trademark Act B.E. 2534 (1991). The plaintiff appealed against the Registrar’s order to the Trademark Board. The second to the tenth defendants who were the members of the Board rendered a decision that the word “Von” means *from or of or to come from* and the word “Dutch” means *relating to the Netherlands or people of the Netherlands*, therefore, “Von Dutch” was a general term which had no distinctive character under section 7 paragraph one of the Trademark Act B.E. 2534 (1991). The Board further held that the trademark, when used with the proposed goods, would mislead the public that the goods were produced in the Netherlands, while the plaintiff was an American company. The Board, therefore, ordered for a suspension of the trademark registration.

Procedural History

The Central Intellectual Property and International Trade Court revoked the Trademark Registrar’s order and the Trademark Board’s decision, ordered the first defendant to proceed to process the trademark registration application, and dismissed the plaint against the second to the tenth defendants.

The first defendant appealed to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court partly reversed the lower court's judgment where it dismissed the case against the second to the tenth defendants. Apart from the said part, the lower court's judgment was upheld.

Issue

Is the plaintiff's trademark  not registrable under section 8(13) of the Trademark Act B.E. 2534 (1991) and is the word "Von Dutch" a general term which has no distinctive character under section 7 paragraph one of the Trademark Act B.E. 2534 (1991)?

Rationale

According to the Notification of the Ministry of Commerce (Number 5) B.E. 2543 (2000); a trademark which is a mark or a description that might confuse or mislead the public as to the class, the origin, or the owner of the goods, is not registrable. The Notification was issued by virtue of section 8(13) of the Trademark Act B.E. 2534 (1991) which strictly prohibits the registration of a trademark containing particular characteristics, therefore, section 8 of the Act and the Notification should be interpreted narrowly that a mark or description that might confuse or mislead the public as to "the origin" of the goods refers only to the one that directly denotes the place of the origin of the goods. It should not be interpreted too broadly that the restriction is also applied to a mark or description that denotes the people relating to such place. Otherwise, a word denoting the people of any country could never be included in a registrable trademark, which is not even expressly prohibited by law.

The plaintiff's trademark  contains "Von", a German word means *from or of or to come from*, and "Dutch", an English word means *relating to the Netherlands* or

people of the Netherlands. Accordingly, "Von Dutch" should mean *from the people of the Netherlands*, therefore, it refers to the people of the Netherlands, not the country which is under the definition of "origin" of the goods pursuant to Clause 2(2) of the Notification of the Ministry of Commerce (Number 5). The plaintiff's trademark , therefore, is not a mark or description that might confuse or mislead the public as to the origin of goods. Moreover, the trademark would not confuse or mislead the public as to the owner of the goods either; because when "Von Dutch" is used with the proposed goods, it only conveys the message that the goods are of or from the people of the Netherlands, not that the goods belong to a particular owner.

As "Von Dutch" means *from the people of the Netherlands*, if the trademark in question is used, according to the plaintiff's registration application, with clothing products, it would not be a direct reference to the character or the quality of the goods, nor is it a geographic name as prescribed by the Minister of Commerce. The plaintiff's trademark is therefore deemed to have distinctive character and registrable under section 6(1) and (2) and section 7 paragraph two (2) of the Trademark Act B.E. 2534(1991). The judgment of the Central Intellectual Property and International Trade Court shall be affirmed for this part.

The Central Intellectual Property and International Trade Court held that the second to the tenth defendants were not personally liable on the grounds that they had acted on behalf of the Trademark Board and it did not appear that they acted out of negligence or intentional dishonest. Consequently, the lower court dismissed the case against them. However, according to the plaint, the plaintiff merely requested the court to revoke the Trademark Registrar's order and the Trademark Board's decision. The plaintiff had brought the case before the court against the second to the tenth defendants due to the fact that they were the members of the Board and had collectively rendered the decision by virtue of

section 96(1) of the Trademark Act B.E. 2534(1991). The plaintiff did not allege that the second to the tenth defendants had acted out of negligence or intentional dishonest by which the plaintiff was damaged. It is therefore unlawful to dismiss the plaintiff's case against the second to the tenth defendants as it was a judgment rendered in excess of or not included in the plaint. The judgment of the Central Intellectual Property and International Trade Court for this part shall be nullified.

Keywords trademark, confused or misled as to the owner or the origin of the goods,
distinctive character

Summarized by Non Tuntapong

Translated and edited by Kamonchanok Katinasamit