

Supreme Court of the Kingdom of Thailand

S.C. 5822/2011

Lacoste v. Thanakarn Po-on, et al.

Court : Supreme Court

Case : Civil

Date of Judgment : July 6, 2011

Plaintiff : Lacoste

Defendants : Thanakarn Po-on (1st)
Pada Alligator Company Limited (2nd)
Jaruwan Bunjusuwan (3rd)

Concepts : Intellectual Property, Trademark

Statue : The Trademark Act B.E. 2534 (1991) sections 7, 8

Panel of Justices

Maitree Sriarun, Aram Senamontri, Prinya Deepadung

Case Background

The plaintiff is the owner of a trademark , an invented crocodile picture, used with the word “LACOSTE,” which has been registered in France since 1933 and in Thailand since 1974 to be used with clothing products. The plaintiff has been using the

trademark in more than 190 countries, including Thailand, for a long time. The first and third defendants are the authorized directors of the second defendant. The three defendants jointly produced shirts and other clothing products bearing a trademark  composed of an invented crocodile picture and the word “ALLIGATOR.” The first defendant submitted a number of applications for registration of such trademark to which the plaintiff has submitted notices of opposition and appeals. The plaintiff claimed that the defendants infringed on its trademark and demanded the compensation thereof. It also requested the court to prohibit the defendants from using the disputed trademark and to revoke the defendants’ trademark registration applications.

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 upheld the lower court’s judgment.

Issues

1. Is the first defendant’s trademark identical with or so similar to the registered trademark of the plaintiff that the public might be confused or misled as to the owner or origin of the goods?
2. Did the first defendant legitimately apply for trademark registration?

Rationales

Although the plaintiff has been using the invented crocodile picture as its trademark worldwide, it does not mean that it has the exclusive right to the crocodile picture. As crocodiles are natural creatures, another person may use crocodile picture as a part of his trademark insofar as it is not identical with or so similar to the registered trademarks that the public might be confused or misled as to the owner or origin of the goods.

The invented crocodile picture in the first defendant's trademark is the one that has a long body, 90-degree wide-opened mouth, and its tail is pointing downward; whereas the one in the plaintiff's trademark has thicker body, horizontally-oriented head, its mouth slightly opens, and its tail is pointing upward. Although an "ALLIGATOR" is a similar animal to a crocodile, the pronunciation is totally different from the word "LACOSTE." Thus, it cannot be deemed that the first defendant used the word "ALLIGATOR" to mislead the public that its trademark is the plaintiff's. As a conclusion, the first defendant's and the plaintiff's trademark have many different characteristics, therefore, it cannot be held that the first defendant's trademark is identical with or so similar to the plaintiff's that the public might be confused or misled as to the owner or origin of the goods.

Even though the plaintiff's witnesses have testified that the first defendant's and the plaintiff's trademarks were similar and the plaintiff claimed that those testimonies were a sufficient proof that the two trademarks were so similar that the public might be confused as to the owner or origin of the goods, they were merely personal opinions of the witnesses. Whether or not the perception of the person of ordinary prudence would be in accordance with those opinions shall be determined objectively from the trademark characteristics.

The plaintiff further appealed that the first defendant did not legitimately applied for trademark registration as the public could not distinguish the first defendant's trademark from that of the plaintiff. In this regard, as it is already held that the first defendant' trademark is not identical with or so similar to the plaintiff's that the public might be confused or misled as to the owner or origin of the goods, it therefore cannot be held that the first defendant's applications for registration of its trademark was an illegitimate act. The appeal shall be dismissed.

Keywords trademark, identical with or similar to, confused or misled

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