

World Trademark Law Report

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Tilleke & Gibbins International Ltd

VALENTINO COUTURE is well known, court rules

The Supreme Court of Thailand released last month its ruling in *Valentino Globe BV v JMS Corporation* (Dika Case 9041/2547, December 20 2004).

Section 8(11) of the Thai Trademark Act prohibits the registration of marks that are identical or very similar to well-known marks. However, what amounts to a well-known mark remains unclear, despite the Ministry of Commerce's attempt to clarify the issue with its Notification 2 of September 2004. Deciding whether a mark is well known is inherently subjective and, thus, uncertain. Accordingly, many mark owners prefer to oppose any unauthorized application for marks that are close variants or imitations of their famous marks.

In the case at hand, fashion designer Valentino Globe BV brought an opposition against two applications filed by JMS Corporation to register the word and design mark VALENTINO COUPEAU for bags and clothing in Classes 18 and 25 of the Nice Classification. Valentino based its opposition on its registered mark VALENTINO COUTURE. The trademark registrar rejected the opposition, holding that the VALENTINO COUPEAU mark was not confusingly similar to Valentino's mark. Valentino appealed to the Board of Trademarks, which affirmed the registrar's decision.

On further appeal, the Intellectual Property and International Trade (IP&IT) Court reversed the decision. The court considered the extensive evidence of use and renown of Valentino's mark and held that not only were the marks at issue confusingly similar, but Valentino had (i) the exclusive right to use its device mark VALENTINO COUTURE for the designated registered goods, and (ii) a better right to the name Valentino than JMS. Accordingly, the court ordered that the Department of Intellectual Property (DIP) refuse the registration of the VALENTINO COUPEAU mark.

The DIP appealed to the Supreme Court, which affirmed the IP&IT Court's ruling.

The Supreme Court stated that even though both parties had disclaimed rights in the name Valentino, JMS's mark imitated Valentino's mark and was intended to ride on its reputation. The court analyzed the layout of the marks and found that:

- both are on three lines;
- the device element is on the first line in both marks;
- the word 'Valentino' is on the second line in both marks; and
- the words on the last line of each mark are of similar appearance and sound.

The court concluded that this may cause confusion among the public and, accordingly, it ordered that the mark VALENTINO COUPEAU be denied registration.

The case demonstrates the differences in analysis used by the courts as compared with the DIP. The Supreme Court's decision is welcome in so far as it clearly demonstrates the willingness of Thai courts to protect well-known marks in Thailand.

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