

Supreme Court of the Kingdom of Thailand

S.C. 7201/2554

Life Nation Worldwide, Inc. v. Department of Intellectual Property

Court : Supreme Court
Case : Civil Case
Date of Judgment : 2011/08/16
Plaintiff : Life Nation Worldwide, Inc.
Defendant : Department of Intellectual Property
Area of Law : Intellectual Property, Trademarks,
Statute : Trademark Act. B.E. 2534 Sections 6 and 13

Panel of Justices

Thanasit Nilkhamhaeng – Aram Senamonti – Somkhuan Wichienwan

Background

The Plaintiff, a juristic person according to the laws of the United States of America, claims to own the trademark and service mark "ARTIST NATION." It protects the rights of its member artists, including marketing, promotion, broadcasting rights, concert tickets and merchandise. The plaintiff applied to register the trademark and service mark "ARTIST NATION" to use with one its line of shirts, not including undershirts, sports shirts, tee shirts and rugby shirts. The Registrar refused to register it, reasoning that it was similar to or resembled another trademark that had been previously registered, namely "ARTLIST." The Trademark Board ruled in favor of the refusal of the Registrar.

The Plaintiff held that the word "ARTIST" means *one who is an artist*; and "NATION" means *the populace*. It was a way to introduce their commerce or business that serviced the management of the rights and benefits of world famous musicians.

As for the trademark "ARTLIST INTERNATIONAL," the word "ARTLIST" meant *a list of artists*; and "INTERNATIONAL" meant *universal*. Their meanings were different and pronounced differently because the letters and syllables were different. The Plaintiff's trademark contained the necessary elements to be registered

and petitioned to have the Registrar's refusal and the Trademark Board's ruling overturned and the Plaintiff's trademark registered as applied for.

The Defendant testified that the Plaintiff's trademark had two syllables, an additional "L" that was pronounced similarly with another previously registered trademark and had the potential to confuse and mislead the public. It petitioned that the court dismiss the case.

Issues

1. Was there or was there not reasonable cause to overturn the refusal of the Registrar and the ruling of the Trademark Board, who stood by the refusal of the Registrar?

Procedural History

The Central and Intellectual Property and International Trade Court dismissed the case.

The Plaintiff appealed to the Supreme Court.

The Supreme Court for Intellectual Property and International Trade upheld the lower court's ruling.

Analysis

1. The Supreme Court reasoned that the Plaintiff's trademark in question was spelled "ARTIST," which was composed of two syllables. The other previously registered trademark was spelled "ARTLIST," also composed of two syllables. The meanings were very close, along the same line of meaning. The last word in the Plaintiff's trademark was "NATION," which means *a country*. The previously registered trademark had the word "INTERNATIONAL," *many nations*. Even though they are pronounced differently, the meanings are very similar and they come from the same root words. They both changed the noun "art" into "ARTIST" and "ARTLIST," respectively. And they changed the noun "nation" into an adjective, "INTERNATIONAL." Even though the Plaintiff's trademark read "ARTIST NATION" on a single line while the previously registered trademark had it on two lines, the "ARTLIST" part was the most prominent. The important part of the trademark was, therefore, the prominent word "ARTLIST." It was spelled and pronounced similarly, and spelled in all capital letters. The line of clothing for which the Plaintiff was applying for registration could potentially have customers from all

different age groups and tastes, or individuals with limited English language experience who could not tell the difference between the trademarks in question, which could easily lead to confusion and being misled. The Plaintiff's trademark, to be used on clothing, did not contain the necessary elements that would allow it to be registered.

Keywords: service mark, confusion and being misled

Summarized: Tavinwong Jitviwat

Edited: