

**Supreme Court of the Kingdom of Thailand**

**S.C. 3760/2554**

**Marriott Worldwide Corporation v. Department of Intellectual Property, et al.**

**Court** : Supreme Court  
**Case** : Civil  
**Date of Judgment** : May 19, 2011  
**Plaintiff** : Marriott Worldwide Corporation  
**Defendants** : Department of Intellectual Property (1<sup>st</sup>)  
Director-General of the Department of Intellectual  
Property (2<sup>nd</sup>)  
**Concepts** : Intellectual Property, Service Mark  
**Statute** : Trademark Act B.E.2534 (1991) sections 16,18, 80

**Panel of Justices**

Chaleaw Phonwiset, Aram Senamontri, Tanasit Nilkamhaeng

**Case Background**

The plaintiff is the owner of a service mark, an invented picture composed of the words “COURTYARD,” “Marriot” and a picture. On July 24, 2003, the plaintiff submitted the application for registration of its service mark to be used in connection with certain services, namely hotels, resorts, camps, restaurants, event and exhibition management, and hotel reservation. The registration, however, was refused by the Trademark Registrar on the grounds that the word “COURTYARD,” a part of the service mark, had direct reference to the character or the quality of the respective services. The plaintiff appealed to the Trademark Board but the Board affirmed the Registrar’s order. Against the Board’s decision, the plaintiff appealed to the court that

its service mark had distinctive character and therefore registrable. It requested for a revocation of the Trademark Registrar's order and the Trademark Board's decision.

The defendants argued that the Plaintiff's service mark was not widely known in Thailand and that the plaintiff lacked standing.

### **Issues**

1. Does the plaintiff have standing to sue?
2. Does the word "COURTYARD" directly refer to the character or the quality of the respective services?

### **Procedural History**

The Central Intellectual Property and International Trade Court held that the service mark had distinctive character and registrable. The court revoked the Trademark Registrar's order and the Trademark Board's decision.

The defendants appealed to the Supreme Court.

The Intellectual Property and International Trade Division of the Supreme Court upheld the judgment of the lower court.

### **Rationale**

1. Section 18 paragraph one of the Trademark Act B.E. 2534 (1991), which stipulates that the decision of the Trademark Board shall be final, only means that the appellant (of the Trademark Registrar's order) cannot further appeal against the Board's decision to any administrative officer. This provision does not prevent the appellant from bringing his or her case before the court. The plaintiff, therefore, has standing to sue.

2. Although the word "COURTYARD" means *an open space within a house*, when used in connection with the proposed services, it only seemed to be an

attempt to draw attention from the interested customers. It did not indicate or imply that the respective services offered more spacious areas than those of other rival companies because *an open space within a house* could also be used in several other activities. Accordingly, the part "COURTYARD" in the plaintiff's service mark does not directly refer to the character or quality of the services, yet the whole mark is an invented picture with distinctive character and therefore registrable under section 80 and section 16 of the Trademark Act B.E. 2534 (1991).

As it is already held that the plaintiff's service mark has distinctive character, it is unnecessary to consider whether or not the plaintiff had widely used or advertised the service mark pursuant to the rules prescribed by the Minister of Commerce, because it would not change the outcome of the case.

**Key Words:** Service mark, standing to sue

**Translated and summarized by** Tavinwong Jitviwat

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