

Supreme Court of the Kingdom of Thailand

S.C. 6270/2554

Société BIC v. Big Trading Limited Partnership, et al.

Court : Supreme Court
Case : Civil
Date of Judgment : July 20, 2011
Plaintiff : Société BIC
Defendants : Big Trading Limited Partnership (1st)
Siripong Premrattanachai (2nd)
Concepts : Intellectual Property, Copyright, Trademark
Statutes : Copyright Act B.E. 2537 (1994)
Trademark Act B.E. 2534 (1991)

Panel of Justices

Prajuab Patchaneerattanakorn , Aram Senamontri, Thanapot Arayaluck

Case Background

The plaintiff, a juristic person under the laws of the Republic of France, is the author of an artistic work; a picture of a big head boy, which was first published in France. The plaintiff is also the owner of a registered trademark, the big head boy picture used with the word “BIC”. The trademark is used with razors for barbers and other products, such as stationery. The plaintiff claimed that the defendants jointly infringed copyright and trademark of the plaintiff by adapting the picture of a big head boy and creating a new similar mark with the word “RAZOR KING” used in connection with razors for barbers, which is the same class of goods as the plaintiff’s trademark. The plaintiff claimed that the defendants intended to mislead the public that the goods under their trademark were those of the plaintiff.

The plaintiff therefore demanded the compensation for the damages caused by the defendants.

The defendants argued that their trademark, a picture of a man carrying a razor behind his back with the word “RAZOR KING”, was not identical with or similar to the plaintiff’s trademark. The defendants were the inventors of their trademark and have been using such trademark in good faith since before 1996. As for the claim of copyright infringement, the defendants argued that the pictures in the trademarks of both parties were created by different authors. They were different and could not confuse the public.

Procedural History

The Central and 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. Did the defendants infringe the copyright of the plaintiff?
2. Did the defendants infringe the trademark of the plaintiff?

Rationales

1. The Copyright Act B.E. 2537 (1994) and the Trademark Act B.E. 2534 (1991) aim to protect owners of copyright and trademark separately. As for copyright, a copyright work is a work of authorship in forms prescribed by section 6 and section 8 of the Copyright Act, created by an author with the aim to have such work protected as a copyright work under the Act. In this case, it appeared that the

plaintiff was a manufacturer of ballpoint pens and had hired Raymond Savignac to create an invented picture of a big head boy to be used with the ballpoint pens and other products which later became well-known. This indicates that the plaintiff intended to hire Raymond Savignac to create such invented picture to be used as a trademark. Hence, the big head boy picture is not a work of authorship purposely created as an artistic work which would be entitled to copyright protection. The plaintiff is not a copyright owner of the invented picture of a big head boy who would enjoy protection under the Copyright Act B.E. 2537 (1994).

2. The plaintiff uses the big head boy picture as its trademark along with the word “BIC” in connection with stationery, razors, and lighters and had registered the trademark in Thailand, whereas the defendants' trademark is a picture of a man carrying a razor behind his back with the phrase “Razor King Sensitive Skin Shaver”, with a crown picture above Z. The two trademarks only bear similarities regarding the invented pictures of a boy and a man, apart from that they are totally different. Besides, the invented pictures of a boy and a man were both derived from the characteristics of human body, in which nobody should have an exclusive right. The only condition in using such picture should be that the new user must use such picture in a manner that it is distinguishable from other existing trademarks and does not confuse the public. On the whole, the two trademarks are considered to be different. When the products under the two trademarks were displayed together, the public was not confused or misled as to the owner or the origin of the goods. Hence, it cannot be held that the defendants infringed the trademark of the plaintiff.

Keywords juristic person, artistic work, existing trademark

Summarized and translated by Tavinwong Jitviwat

Edited by Kamonchanok Katinasamit