

**Supreme Court of the Kingdom of Thailand**

**S.C. 7202/2011**

**Perusahaan Otomobil Nasional SDN BHD v. T – Tiger Part Company Limited**

**Court** : Supreme Court  
**Case** : Civil  
**Date of Judgment** : February 16, 2011  
**Plaintiff** : Perusahaan Otomobil Nasional SDN BHD  
**Defendant** : T – Tiger Part Company Limited  
**Concepts** : Intellectual Property, Trademark  
**Statute** : Trademark Act B.E. 2534 (1991) sections 6, 8,13  
**Panel of Justices** :

Prinya Deepadung, Aram Senamontri, Dhajaphan Prabhudhanitisarn

**Case Background**

The plaintiff is the owner of the registered trademark “PROTON” used in connection with automobiles. On May 15, 2006, the defendant submitted an application for registration of its trademark “proto” to be used with motorcycle accessories and replacement parts, namely, brake pads, clutch disks, automatic clutches, hubs, brake shoes, chains, mag wheels, wire wheels and sprockets. The plaintiff filed a notice of opposition against the proposed registration on the grounds that the defendant’s trademark was similar to that of the plaintiff. The notice of opposition, however, was dismissed by the Trademark Registrar. The plaintiff appealed against the Registrar’s order to the Trademark Board but the appeal was dismissed by the Board. Subsequently, the plaintiff appealed to the Central Intellectual Property and International Trade Court that the defendant’s trademark was so similar to the plaintiff’s registered and well-known trademark that the public might be confused or misled

as to the owner or the origin of goods and requested the court to order the defendant to withdraw the application.

The defendant argued that its trademark was not similar to the plaintiff's and that the two trademarks were different in various aspects such as the pronunciation and the goods with which they were respectively used, therefore, the public could not be confused or misled as to the owner or the origin of the goods.

### **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 judgment of the lower court.

### **Issue**

Is the defendant's trademark "proto" so similar to the plaintiff's trademark "PROTON" that it might confuse or mislead the public as to the owner or the origin of the goods?

### **Rationale**

In determining whether or not two trademarks are so similar that the public may be confused or misled as to the owner or the origin of the goods, not only the form or the visible elements of the trademarks should be considered, but all relevant aspects of the trademarks should also be taken into account, including the associated goods, the targeted customers and the intent of the applicant. The core issue is whether or not the similarity in dispute is likely to confuse or mislead the public as to the owner or the origin of the goods.

Upon comparing the defendant's trademark "proto" to the plaintiff's registered trademark "PROTON"; the trademark "proto" comprises five Roman letters which are

exactly the same as the first five Roman letters of the trademark “PROTON”. Nonetheless, there are many points of difference as regards the two trademarks; the trademarks “proto” and “PROTON” are both invented characters in different styles and pronounced differently. The trademark “proto” is proposed to be used with motorcycle accessories, whereas the trademark “PROTON” has been used with automobiles. Even though the goods under “proto” and those under “PROTON” are both associated with motor vehicles, the goods specified in the defendant’s application were motorcycle accessories and replacement parts of which the users are mostly mechanics or motorcyclists with specific interest in motorcycle maintenance or special design. The potential buyers of the goods under the trademark “proto” are therefore those who are considerably familiar with and possess competent knowledge regarding motorcycles and the replacement parts. Accordingly, they can certainly distinguish that the motorcycle accessories and replacement parts under the defendant’s trademark “proto” are not of the same owner or origin as the automobiles under the plaintiff’s trademark “PROTON,” which are much more well-known and higher in price than the goods associated with motorcycles. Thus, it cannot be held that the defendant’s trademark “proto” is so similar to the plaintiff’s trademark “PROTON” that the public might be confused or misled as to the owner or the origin of goods which would render the trademark unregistrable pursuant to sections 6(2) and (3), 8(10) and 13 of the Trademark Act B.E. 2534 as claimed by the plaintiff. The appeal, therefore, shall be dismissed.

**Keywords** Similar trademark, registrable, confused or misled

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