

**Supreme Court of the Kingdom of Thailand**

**S.C.9240/2011**

**Honda Motor Co., Ltd. v. Department of Intellectual Property**

**Court** : Supreme Court  
**Case** : Civil  
**Date of judgment** : October 18, 2011  
**Plaintiff** : Honda Motor Co., Ltd.  
**Defendant** : Department of Intellectual Property  
**Concepts** : Intellectual Property, Trademark  
**Statue** : Trademark Act B.E.2534 (1991) section 7

**Panel of Justices**

Dhajaphan Prabhudhanitisarn, Aram Senamontri, Prinya Deepadung

**Case Background**

The plaintiff claimed that it was the inventor of a multi-purpose engine “GX,” sold in many countries including Thailand. On June 14, 2006, the plaintiff submitted the application for registration of the shape or configuration of such multi-purpose engine as its trademark. The plaintiff’s multi-purpose engine had been registered as a trademark in form of a shape or configuration of an object in various countries worldwide. Nonetheless, the registration was refused by the Trademark Registrar on the grounds that the trademark had no distinctive character and it was a shape or configuration that indicated the characteristics of the goods. The plaintiff appealed against the Registrar’s order to the Trademark Board. The Board affirmed the Registrar’s order. The plaintiff then, against the Board’s decision, appealed to the Central Intellectual Property and International Trade Court that its trademark

had distinctive character and requested for a revocation of the Registrar's order and the Board's decision.

In response to the plaint, the defendant argued that the plaintiff did not apply for registration of a trademark as a shape or configuration of an object, therefore, the application should be considered as a request for registration of a picture trademark and that the Trademark Registrar's order and the Trademark Board's decision were lawful.

### **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**

Did the plaintiff's trademark, a shape or configuration of a multi-purpose engine "GX", have distinctive character and therefore registrable?

### **Rationale**

According to section 6 of the Trademark Act B.E. 2534 (1991); to be registrable, a trademark must be distinctive. The characteristics of a distinctive trademark are stipulated in section 7 paragraph one and two. This reflects that the Act aims to protect a distinctive trademark for it can distinguish the goods with which the trademark is used from other goods, and such trademark must not have direct reference to the character or quality of the goods. The characteristics of an engine may be protected under the Patent Act B.E. 2522 (1979) which grants an exclusive right to the inventor for a limited time, unlike the protection under the Trademark Act which grants an exclusive right to the trademark owner upon

registration. The trademark owner is entitled to such exclusive right as long as he has the registration renewed.

Although the plaintiff claimed that it had invented and designed the engine “GX” to be distinguishable from other similar engine, when the picture of the engine “GX” was compared with those of five other engines, it was evident that the characteristics of the engine “GX” and the others were apparently similar, for example, the main components were very much alike and installed into similar positions. Hence, the consumers were unlikely to be able to distinguish the engine “GX” from other engines at first glance. On the contrary, what distinguished the engine “GX” from other engines was the plaintiff’s mark “HONDA” and some minor differences in color setting. To conclude, the shape or configuration of the engine “GX” alone, without the trade name or color setting, was not distinctive enough to enable the consumers to recognize that the engine “GX” was the plaintiff’s product. Moreover, as it did not appear that the plaintiff ever sold the engine “GX” without the word “HONDA” attached, it implied that the plaintiff had applied for registration of the shape or configuration of the engine “GX” simply to prevent other manufacturers from producing similar engines, which would unduly limit the rights of another person. For all the above mentioned reasons, the mark of which the plaintiff applied for registration did not have distinctive character under section 7 of the Trademark Act B.E. 2534 (1991). The Trademark Registrar’s order and the Trademark Board’s decision were lawful. Whether or not a trademark is registrable in a particular country depends on social context and respective law, the fact that the plaintiff’s trademark had been registered in one country did not mean that it should be registrable in another.

**Keywords** Distinctive character, shape or configuration, trademark

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