

LOGO CAN BE PROTECTED AS A TRADEMARK AND A COPYRIGHT IN THAILAND

Trademarks and copyrights can happen to be overlapping. A logo trademark usually comprises an artistic work. Where copyright protection subsists, this provides rights that are valuable and additional to but quite different from those arising under the trademark law. In Thailand, enforcement of a logo trademark can legally be litigated in one or several proceedings under either the trademark law alone or under both of the trademark law and the copyright law or other applicable laws. However, it should be noted that Thai courts sometimes do not recognize a trademark as a copyright and vice versa because the courts apply a notion that a subject matter entitled to protection under several laws should not be given overlapping protection.

1. Requirements for Protection as a Trademark

Under the Trademark Act B.E. 2534 (A.D. 1991) as amended by the Trademark Act (No. 2) B.E. 2543 (A.D. 2000) and the Trademark Act (No. 3) B.E. 2559 (A.D. 2016) (“TMA”), to be registrable, a trademark must be distinctive, not prohibited, and not identical with or confusingly similar to other registered trademarks. A trademark contrary to the public order, morality or public policy or identical to a well-known mark is not registrable (Section 8, TMA).

A trademark under the TMA can be a photograph, drawing, device, brand, name, word, letter, manual, signature, combination of colors, shape or configuration of an object or sound, or any one or combination thereof (Section 4, TMA). Three dimensional marks and shape marks can be registered if they are not a natural shape of the applied goods or functionally necessary, and do not add value to the goods (Section 7(10), TMA).

Registration of a trademark is not a condition precedent for its enforcement. Both registered and unregistered trademarks are given protection and can be enforced under the law. But there are significant benefits generated by trademark registration.

Unregistered trademarks are protected through various provisions of the Penal Code and the Civil and Commercial Code but its owner cannot file a legal proceeding against a trademark infringement under the TMA. Only a passing-off action is allowed for an unregistered trademark (Section 46, TMA).

2. Requirement for Protection as a Copyright

Under the Copyright Act B.E. 2537 (A.D. 1994) as amended by the Copyright Act (No. 2) B.E. 2558 (A.D. 2015) and the Copyright Act (No. 3) B.E. 2558 (A.D. 2015) (“CA”), a work of an author is protected as a copyright work if it is a creative expression of an idea which contains originality of the author.

A copyright work does not need distinctiveness required for a trademark but it must be a creative expression of an original idea of its author. The required level of originality or creativity is minimal.

A copyright subsists in a copyright work upon its creation. Registration is not required. But it is possible and optional to deposit a copyright work with the Copyright Office of the Department of Intellectual Property (“DIP”). A copyright deposit with the DIP is not a condition precedent for its protection and enforcement. A copyright deposit is, however, advisable as a copyright deposit certificate constitutes an important evidence document on ownership of the work.

3. Protection as Both Trademark and Copyright

Trademarks and copyrights, while distinct and separate, can happen to be overlapping. Copyrights protect creative works such as drawings, writings, visual art, music and audio recordings. Trademarks, on the other hand, protect phrases, words and symbols used to identify a product and signify its origin.

A logo trademark usually comprises an artistic work. Where copyright protection subsists in a logo trademark, this provides rights that are valuable and additional to but quite different from those arising under the trademark law. Thus, there has been a controversial issue regarding the overlapping protection between copyright and trademark for logo trademarks.

In Thailand, the CA and the TMA do not have a provision on the overlap of trademarks and copyrights. However, the CA and the TMA do not exclude protection of an artistic work which can also be protected or used as a trademark. A copyright work in the category of an artistic work can be registered as a logo trademark and used as such if it meets the legal requirements for a trademark under the TMA.

Here are some logo trademarks which are also protected as copyright works in the category of an artistic work under the CA:



SHARK Logo Trademark

Reg. No. Kor51995, Class 32



SHARK Logo Copyright "Artistic Work"

Deposit No. Sor1.9709



ANISA Logo Trademark

Reg. No. Kor358360, Class 28



SALADDIN Logo Trademark

Reg. No. 368089, Class 9

As the matter of practice, most of well-known characters from films and comic books already protected as copyright works under the CA by operation of law are also registered as trademarks for such goods as toys, cups, t-shirts, hats, hand bags, etc.

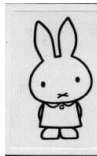
However, it should be noted that Thai courts sometimes do not recognize a trademark as a copyright and vice versa because the courts apply a notion that a subject matter entitled to protection under several laws should not be given overlapping protection (Supreme Court Judgment No. 15082/2556 (A.D. 2013)).

Enforcement of a logo trademark is litigated under either the TMA alone or under both of the TMA and the CA or other applicable laws. A claim for enforcement of a logo trademark and its copyright (in case it is also qualified as a copyright work) can be filed at one court proceeding under both the TMA and the CA.

4. Some Court Judgments

In Thailand, enforcement of a logo trademark can legally be litigated under either the TMA alone or under both of the TMA and the CA or other applicable laws. Although Thai courts usually feel it prudent to apply the legal notion that the laws providing protection to a subject matter should not overlap, if a third party uses a copyright work of other person as his own trademark or vice versa or free rides other person's rights, the courts may give protection under both the TMA and the CA to the genuine author/owner of the work and rule against a bad faith party or a free rider for being contrary to the public policy and the good morals of the Thai people. Here are some interesting examples:

(1) Supreme Court Judgment No. 4588/2552 (A.D. 2009)



MIFFY Logo Trademark



MIFFY Logo Copyright



OJOSUN Logo Trademark

The defendant took the rabbit fictional character from the plaintiff's MIFFY Logo Trademark and used it as one of the elements in the defendant's OJOSUN Logo Trademark. The defendant also filed an application for registration of the said trademark with the Trademark Office ("TMO"). The plaintiff filed an opposition with the TMO against the defendant's trademark application but the opposition failed. The plaintiff then filed an appeal with the Trademark Board ("TMB"). The TMB ruled that the defendant's trademark was not confusingly similar to the plaintiff's trademark. The plaintiff filed a lawsuit based on a copyright infringement against the plaintiff's MIFFY Logo Copyright (artistic work) in addition to the claim that the defendant's trademark was confusingly similar to the plaintiff's trademark. The Supreme Court ruled that, although overall the defendant's trademark was not confusingly similar to the MIFFY Logo Trademark of the plaintiff, the defendant's trademark contained a reproduction of the copyrighted artistic work of the plaintiff. **The Court reasoned that the legislative intent in the TMA was to protect persons acting in good faith and, therefore, reproducing or modifying the copyright work of another person in bad faith and using the reproduced or modified copyright work as a trademark is**

against the legislative intent of the TMA. The Court concluded that the defendant's trademark was unregistrable for **being contrary to the public policy and the good morals of the Thai people.**

(2) Supreme Court Judgment No. 6270/2554 (A.D. 2011)



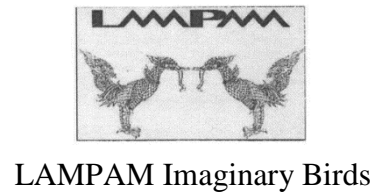
BIC and Big Head Boy Logo Trademark



KING Trademark

The plaintiff filed this case under both the TMA and the CA on the ground of trademark and copyright infringement by the defendants in relation to the use of the KING Trademark which was claimed by the plaintiff as confusingly similar to the plaintiff's BIC and Big Head Boy Logo Trademark. The plaintiff is a French company. It hired Mr. R to design the Big Head Boy Logo for using as a trademark. Mr. R designed the said logo based on the nature of the goods (ball-point pens) with which the trademark would be used. The plaintiff registered the said logo as a trademark in Thailand. The defendants filed an application to register their KING Trademark as a trademark for razors. The plaintiff filed this case to prevent the KING Trademark from registration for infringing the plaintiff's copyright in the Big Head Boy Logo and the BIC and Big Head Boy Logo Trademark. **The Court ruled that the concepts of trademark protection and copyright protection are totally different.** A work that is capable of being copyrighted must be a creative expression of an idea expressed as a recognized work that contains originality of its author. The Court found that the Big Head Boy Logo **was not a result of Mr. R's creative effort and therefore it could not get protection as a copyright work under the CA.** For the trademark infringement claim, the defendants' trademark contained the Boy Logo plus other distinctive elements. Although the Boy Logo of the defendants was somewhat similar to the Big Head Boy Logo of the plaintiff, the defendants' trademark as a whole was sufficiently different from the Big Head Boy Logo of the plaintiff and thus the defendants did not infringe the Big Head Boy Logo Trademark of the plaintiff.

(3) Supreme Court Judgment No. 16559/2557 (A.D. 2014)



The plaintiff filed this case under both of the TMA and the CA. The trademark of the plaintiff was a logo of two fighting cocks plus the word LAMPAM Stylized and was a well-known trademark in Thailand but it was not registered as a trademark before the defendant filed an application to register his trademark. The trademark of the defendant was a logo of two imaginary birds (each with an elephant tusk) plus the word LAMPAM Stylized confusingly similar to the plaintiff's trademark. The plaintiff sued the defendant on the grounds of trademark and copyright infringements and trademark passing-off. The Court ruled that the defendant's trademark **was confusingly similar to the plaintiff's trademark** both in pronunciations and appearances and thus the defendant's trademark was not registrable under the TMA. The Court also ruled that the act of the defendant was not a passing-off since the defendant clearly indicated that his goods were of his own origin and that he had no intent to misrepresent his goods as the goods of the plaintiff and that **the act of the defendant did not constitute a copyright infringement because the imaginary bird logo of the defendant was made from his creative effort and despite the fact that it was so similar to the plaintiff's trademark**, the defendant did not reproduce the plaintiff's two fighting-cock logo and therefore he did not infringe the plaintiff's copyright under the CA.

5. Our Suggestions

In conclusion, trademark and copyright protection, while distinct and separate, can happen to be overlapping, especially for a logo trademark as it comprises an artistic work. In Thailand, neither the TMA nor the CA expressly addresses this issue. However, the CA does not exclude protection of an artistic work which can also be protected or used as a trademark and the TMA does not prohibit an artistic work from being registered as a trademark either. A copyright work in the category of an artistic work can be registered as a logo trademark and used as such if it meets the legal requirements for a trademark under the TMA. By the same

token, an artistic work in a logo trademark can also be protected as a copyright work if it meets the legal requirements under the CA.

Enforcement of a logo trademark can legally be litigated under either the TMA alone or under both of the TMA and the CA. However, it should be noted that Thai courts sometimes do not recognize a trademark as a copyright and vice versa because the courts apply a notion that a subject matter entitled to protection under several laws should not be given overlapping protection.

An owner of a logo trademark should register his mark with the TMO of the DIP and also file a deposition of the work as a copyright work with the Copyright Office of the DIP. It is also advisable to compile and keep the evidence of use of a logo trademark in Thailand as it will be useful in a legal action against a competitor on the grounds of infringement. Trademark watching and market checking are also important since monitoring and detecting an infringement at an early stage can make enforcement of rights easier.

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