

NOTE OF THE LEGISLATIVE ADVISER
concerning the appeal made by the American Coca-Cola Co. against
a decision of the Registrar of the Trade-Marks which refuses to register
the word "Coca-Cola" as trademark for goods of the said Company
(44th. category; natural and manufactured mineral of aerated waters)

The objections of the Registrar are:

1. That "Coca-Cola" is not an invented word and consequently is contrary to the Trade-Mark Act B.E. 2474 (Section 4 (3);
2. that the word "Coca-Cola" contains direct reference to the "character or quality of goods" and consequently is contrary to the said Act (Section 4 (4);
3. that eventually registration may be made under section 4 (5) only if the Company can prove by evidence that this mark has been widely used to the knowledge of the public knowing the the mark "Coca-Cola" means the goods of the Coca-Cola Co. specifically.

It is well known that the question, is a very difficult one (as shown by cases and commentaries in foreign countries) I fully acknowledge the difficulties encountered by the Registrar, and one has to pay homage to the conscientious work and interesting considerations which he has submitted. But, upon appeal, it is now practically to the Minister to decide, and the point of view is not exactly the same. It is essential to demonstrate that the registration of a Trade-Mark is unquestionably and without doubt contrary to the law; and also that it is likely that such registration might injure some interested in this country.

That is what I intend to examine in the following.

GENERAL REMARKS

I. Registration of a Trade-Mark in other country does not mean necessarily that it must be accepted for registration in Siam. But when it appears that the said Trade-Mark has been registered all over the world (e.g. in England, France, Germany, Burma, Butch East Indies, Egypt, Hongkong, Philippines, Stratis Settlements, India, Japan, Switzerland, etc.) 123 countries in all, one cannot fail to be stricken by that fact, and has the duty to examine carefully if the refusal of registration in this country would not appear an application of the principles governing registration of Trade-Marks everywhere surprisingly narrower than in the other countries.

II. It has been said in a previous Note dated 7th. October B.E. 2490 and concerning registration of "Coca-Cola" that the principles are laid down in the Trade-

Mark Act B.E. 2474, where they are similar to those of the English law. It is of interest to realize clearly that the purpose of those principles (and, in fact, of the legislation on Trade-Marks in general) is to immobilize a certain word for the benefit of a certain commercial concern duly entitled there to so that henceforth it cannot be used for commercial purposes by other persons. Then, one can only agree with the opinion expressed by Lord Herschell (House of Lords) in the famous case *Solio*, when he says¹ "If the use on every word in the language was to be permitted as a trade-mark, it was surely essential to prevent its use as a trade-mark where such use would deprive the rest of the community of the right which they possessed to employ that word for the purpose of describing the character or quality of goods.....". But "if a man has rightly invented a word to serve as his trade mark, what harm is done, what wrong is inflicted, if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor?" This idea² Kerly : On Trade Marks P. 160 comes to say that the words of a language are common property and should remain so in favour of everybody who, in his trade, offers his goods to the public.

III. It seems that in practice it is commendable to consider each case on its own merits. Many conditions (language, usages, nature of the goods, local market, etc). may be taken into consideration.

CONCERNING SECTION 4 (3) (invented word)

IV. As to the question of "invented word", the competent authority or the Courts should, in order to appreciate it:

- (a) to examine if it is really an "invented word" and
- (b) if the registration of that word is likely to deprive the rest of the community of the normal use of an usual expression in the exercise of their legitimate course of business.

V. Firstly, is Coca-Cola an "invented" word? It is well known that "Coca" and "Cola" are foreign words coming from the Quichua or African language and designate vegetal substances which are widely used. As to "Coca-Cola", it is a compound word. Coca is one thing designated by that name. Cola is another thing designated by that name. The invention of the Company has consisted of mixing Coca and Cola (probably according to such or such proportion which is their Secret, - and, it is said, with other ingredients not divulged): the result being a soft drink.

¹ 254, U.S.143

² โปรดดูเชิงอรรถที่ 1

The name "Coca-Cola" is the invented word for that invented thing. A proof of it is that "Coca-Cola" does not mean either Coca (an ordinary thing) nor Cocz (an ordinary thing); because it means something different from those ordinary things and which is no longer a natural product innocent of adulteration.

VI. There can be little doubt that a compound word may be, and in fact is in almost all cases, an invented word, even in the current language. When the words "railway", "chemin de fer", "Eisenbahn" have been created, they have become the specific appellation of something entirely new and which their component part did not suggest at all. Those words have been invented in the XIXe. century just to designate a new invention.

VII. Secondly, "Coca-Cola" is nothing else than a soft drink of current use. That drink is supposed to be a stimulant, but that does not suffice to make it a medicine. Alcohol also is a stimulant, and however wine, beer or brandy are not medicines, but current beverage. Of course objections in case of a soft drink of current use can be much less severe and the scrutinizing much less exacting than in the case of a medicine for which a Trade-Mark cannot be granted as soon as there is the risk to immobilize even indirectly, for the benefit of a firm only, some chemical substances generally used for therapeutics : in which last case, the Registrar is certainly justified to be very careful if the so-called invented word is merely an insufficient disguise of a chemical substance by use of a prefix, affix, etc.

VIII. As to the repercussion of the registration of the proposed word, it seems quite satisfactory that persons or firms proposing to trade in some soft drink called "Coca" or in some soft drink called "cola", shall not at all be deprived from their right or facilities if the compound word "Coco-Cola" is registered as trade-mark. And on the other side, the Company will have no more right to prevent them to do so, than they will have any right to trade in any mixtures of Coca and Cola as specified by the compound. In fact, if the Trade-Mark "Coca-Cola" were registered in Siam as in many other countries, one cannot foresee that any person or firm would oppose to such registration.

CONCERNING SECTION 4 (4) (direct reference to the character or quality of the goods)

IX. The Act says that the Trade-Mark may be "a word or words having no direct reference to the character or quality of the goods.....". Those two words need interpretation.

X. As to "character", according to the Oxford dictionary, character, in the figurative sense, means as far as things are concerned "the aggregate of the distinctive features of anything; essential particularity; nature, style, sort, kind,

description". One may wonder if the fact that Coca and Cola are mentioned as the component part of the beverage is not a description of its character? But I ask the permission to quote that there has been a very reliable case in U.S. America (1920)³ which did concern exactly that question, and which better still, did concern the Coca-Cola Company. Another Company (the Koke Company of America) did sue the first one, contending that the word "coca-cola" was descriptive and consequently should not be accepted for registration of a Trade-Mark. Then the U.S. Supreme Court has decided that "coca-cola" was not descriptive and that it was a valid trade-mark. And the judgment did mention especially: "we are dealing herewith a popular drink, not with a medicine

In other words, coca-cola probably means to most persons the plaintiff familiar product to be had everywhere, rather than a compound of particular substances".

I do not feel competent enough to discuss the decision above mentioned, and I confine myself to quote it as a most essential reference in our present case.

XI. As to the "quality" of the goods, there seems to be no explanation by the commentators because "quality" is a word of plain language; it is presumed that to say, for instance, that the "Coca-Cola" beverage is stimulant should be mention of a quality; I feel that nothing similar results for the mention of the two component parts of the beverage under consideration.

CONCERNING SECTION 4 (5) (distinctiveness)

XII. Curiously enough there are in fact not less than three versions of section 4 (5); in order not to interrupt the demonstration made in this Note, I quote them in an Annex.

In my opinion the Section 4 (5) excludes of its provisions by the word "but" any thing like a name, signature, word or words and its purpose is to confine to sign only.

In any case, whichever text is adopted, one must admit that in order that any mark be accepted for registration, there must be "evidence of its distinctiveness".

May I remind that this point is not unknown to us? In another recent request of the Coca-Cola Company, which has been dealt with by the Note of the Krisdika dated 7th. October 2490, one of the reason to reject the Trade-Mark proposed by the Company has been that the mark "Koke" as proposed had no

³ โปรดดูเชิงอรรถที่ 1

distinctiveness (I remind that it was in ordinary printed characters, which I have compared myself to those of a mere visiting card). The Krisdika has pointed out that distinctiveness must be more unquestionable, and has agreed that it is so in the Trade-Mark "Ford" where the letter F of that word was in fact a design which could not be imitated without forgery. I pray the reader to refer to the proposed mark "Coca-Cola", and I am of opinion that the objection made in the precedent case against the word "Koke" (printed letter) does not exist in our present case, whilst the adhesion given to the word "Ford" (as an example) applies quite satisfactorily to our present case as far as the aspect of the Trade Mark is in question.

XIII. This is for me the most essential point in order to know if the proposed Trade Mark has sufficient distinctiveness, and no other evidence is necessary. I know that in the English law they consider as evidence of distinctiveness the fact that the merchandise is well known as such in the local market, and the Registrar has mentioned that fact. I am rather inclined to wonder if the "proff by evidence" of distinctiveness extends as far as to popular knowledge ascertained in the local market? And to wonder besides if an argument of this kind, which may be fair for an American product in America or Europe, is equally fair for the same in Siam? But I need certainly not to examine that point if it is admitted that there is sufficient evidence of distinctiveness by the aspect of the Trade Mark itself.

CONCLUSION

Referring to the difficulty of the matter which I have reminded at the begining of this Note and to the great care which it requires, I would be satisfied to conclude that in my opinion, the case in favour of registration is stronger, I would say Much stronger, than the case to reject registration.

27th October 2490

บันทึกแย้ง

ข้าพเจ้าไม่เห็นด้วยกับบันทึกของกรรมการฝ่ายข้างมาก เฉพาะในกรณีเกี่ยวกับ มาตรา ๔ อนุมาตรา (๕) มาตรา ๔ อนุมาตรา (๕) นี้แยก "เครื่องหมาย" ธรรมดา กับ "คำ" ออกจากกัน กล่าวคือถ้าเป็นเครื่องหมายอื่น เช่น รูปสัตว์ รูปบ้าน เมื่อมีลักษณะบ่งเฉพาะในตัวของมันเองก็จดทะเบียนได้ แต่สำหรับ "คำ" นั้น ต้องมีหลักฐานมาแสดงว่ามีลักษณะบ่งเฉพาะมิฉะนั้นมิได้รับจดทะเบียนตามมาตรา ๔ อนุมาตรา (๕) เหตุผลที่ให้จดทะเบียนยากกว่ากันก็คือ ถ้าเป็นเครื่องหมายอื่น ๆ แล้วความจำเป็นที่บุคคลอื่นจะใช้เครื่องหมายอย่างเดียวกันนั้นไม่รู้จักมีแต่ "คำ" นั้น บุคคลใช้กันอยู่ทุกวันโดยเฉพาะอย่างยิ่ง คำว่า "Coca-Cola" แสดงถึงลักษณะของสินค้า ฉะนั้นจึงไม่ควรจะให้บุคคลใดบุคคลหนึ่งมาจดทะเบียนผูกขาดคำที่มีความหมายถึงลักษณะสินค้าเสียแต่ผู้เดียว ไม่ยอมให้บุคคลอื่นใช้คำนี้อีก เว้นแต่ผู้จดทะเบียนนั้นจะมีหลักฐานมาแสดงว่า "คำ" นั้นมีลักษณะบ่งเฉพาะแล้ว เพียงที่เขียนคำว่า "Coca-Cola" ได้มีลักษณะแปลกไปหน่อยยังไม่เพียงพอที่จะให้จดทะเบียนได้ ข้อที่ควรระลึกมีว่าในส่วนที่เกี่ยวกับการจดทะเบียน "คำ" เป็นเครื่องหมายการค้า นั้น มาตรา ๔ อนุมาตรา (๕) ยอมให้จดได้โดยถือเป็นข้อยกเว้นจากการจดทะเบียน "คำ" ตามอนุมาตรา (๑)-(๓) เท่านั้น จึงต้องตีความและนำอนุมาตรา (๕) นำมาใช้อย่างเคร่งครัด

ข้าพเจ้าเห็นว่าในกรณีนี้ไม่ปรากฏว่าผู้จดทะเบียนมีหลักฐานมาแสดงว่าคำว่า "Coca-Cola" มีลักษณะบ่งเฉพาะตามที่มาตรา ๔ อนุมาตรา (๕) ต้องการคำว่า "ลักษณะบ่งเฉพาะ" นี้ วรรคท้ายของมาตรา ๔ ให้ความหมายว่า "นำมาทำให้เหมาะ เพื่อจะชี้ให้เห็นว่าสินค้าของเจ้าของเครื่องหมายการค้า นั้น ผิดกับสินค้าของผู้อื่น" ซึ่ง "หลักฐาน" ที่จะนำมาแสดงนี้โดยที่เป็นหลักฐานในทางข้อเท็จจริง จึงต้องปรากฏว่าได้ใช้ "คำ" นั้นเป็นเวลานานพอที่เมื่อประชาชนเห็นสินค้าที่ใช้คำนั้น ประชาชนย่อมเข้าใจได้ทันทีว่าเป็นสินค้าของบริษัทโคคา-โคลา ซึ่งจะเป็นได้ต่อเมื่อนำสินค้าที่ใช้เครื่องหมายนั้นมาขายในประเทศไทยจนเป็นที่รู้จัก การที่สินค้านั้นเป็นที่รู้จักกันในต่างประเทศไม่เป็นการเพียงพอ (เทียบ Hallsbury Vol.X X X 11 No.854) ข้าพเจ้าเห็นว่า การจดทะเบียนเครื่องหมายนี้ควรจะรอให้เครื่องหมายคำว่า "Coca-Cola" นี้เป็นที่แพร่หลายในประเทศไทยว่า หมายถึงเครื่องหมายของสินค้าของผู้จดทะเบียนเสียก่อน ซึ่งนายทะเบียนมีหน้าที่ ๆ จะพิจารณาหลักฐานบ่งเฉพาะอย่างเดียวกับกรณีเครื่องหมาย "Coke" ซึ่งคณะกรรมการกฤษฎีกาได้วินิจฉัยไปแล้ว

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