

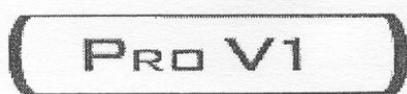
## Case Summary

### Thailand: Acushnet vs. Trademark Board: A Case of World's Most Popular Golf Ball Supreme Court Decision No.1447/2560 (dated 9 March 2017)

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*This is a case which showcases how a trademark owner can have unlawful rulings of the Thai Trademark Registrar and the Trademark Board overturned. Both deemed "PRO V1", the trademark of the world's most popular golf ball belonging to Acushnet Company, to be both descriptive and lacking distinctiveness, rejecting applications covering golf balls in Class 28 filed by Acushnet. Acushnet took them to court and both the Intellectual Property and International Trade Court (IP & IT Court, a court of first instance) and the Supreme Court (the court of last resort) overturned the rulings.*

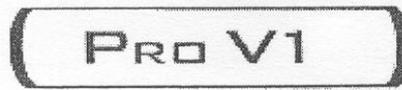
Acushnet owns the trademark PRO V1, which it uses both alone and in combination with the house trademark TITLEIST, in respect of its popular TITLEIST PRO V1 golf ball. It had also registered the trademark in various countries throughout the world. In 2008 and 2009, it applied for registration of the trademark



and the trademark



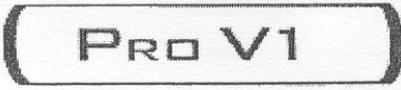
respectively. Both applications covered golf balls in Class 28. The Trademark



Registrar rejected the trademark in its entirety, saying that the word "PRO" was laudatory because it stood for "professional", which conveyed the idea that the goods bearing it was manufactured by experts, whereas the letter V and the numeral 1 appeared without any stylization and therefore must be deemed lacking distinctiveness. As far as the trademark



was concerned, the Registrar did not reject it entirely by required that Acushnet disclaim PRO V1 for the same reason that he rejected the

trademark 

Acushnet appealed to the Trademark Board, only to be disappointed again because the Board sided with the Registrar. In deeming the word "PRO" descriptive, the Board went even farther than the Registrar, saying that the word conveyed the idea that the subject golf ball was meant to be used by professional golfers.

Acushnet had no choice but to file a lawsuit against the Registrar and the Trademark Board in the IP & IT Court for giving unlawful rulings. To support its case, Acushnet

submitted voluminous evidence of long and extensive use of the subject trademarks and their worldwide popularity. Affidavits from professional golfers recognizing them as famous trademarks were part of the evidence.

The IP & IT Court decided in Acushnet's favor, saying that the trademarks were inherently distinctive, that the word "PRO" did not necessarily mean "professional" and that consumers might not always associate the word with golf-related products. As for the letter V and the numeral 1, the Court said that they were parts of the entire trademarks which the Court found to be distinctive and it would be wrong to view them individually as non-distinctive elements. The Court ordered that the rulings of the Registrar and the Trademark Board be cancelled.

The defendants then appealed to the Supreme Court, insisting that they were right in deeming the trademarks descriptive and lacking distinctiveness. **In March 2017** the Supreme Court dismissed the appeal and affirmed the decision of the lower court. In doing so, the Supreme Court said as follows.

It was not right to dissect PRO V1 in the way done by the Registrar and the Trademark Board. The trademarks should have been viewed in their entirety, not partially. The combination of various elements could give rise to a new thing that was distinctive. Moreover, the assumption that the word "PRO" could lead consumers to think that the goods covered were for professional golfers did not make any sense because the word "professional" was not limited to be used with golfers only. Therefore, it found the trademarks inherently distinctive.

The Supreme Court decision is final.