

Thailand prepares for the Madrid Protocol

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As part of the Asean Economic Community's harmonisation plan, member states have agreed to accede to the Protocol on the Madrid Agreement Concerning the International Registration of Marks, an existing system for registering trademarks.

The Madrid Protocol is administered by the World Intellectual Property Organization (WIPO). It provides a cost-effective and efficient means for trademark owners to obtain protection in multiple countries by filing a single "international application", at a single trademark office, in one language, and with one set of fees. This eliminates the high filing costs associated with filing separate national applications. Renewals and changes can all be made centrally through WIPO.

Thailand's Trademark Act was recently amended to allow the country to accede to the Madrid Protocol, and entered into force on July 28, 2016. The Department of Intellectual Property (DIP) is now drafting the relevant ministerial regulations and preparing a new team of trademark registrars who will oversee filing of international applications and examining international registrations from WIPO that designate Thailand.

An international application proceeds through the following three main stages:

Stage 1: Application through the office of origin: For a Thai applicant, a pending Thai trademark application or registration is a prerequisite for filing an international application under the Madrid Protocol. After the international application is submitted, the DIP certifies the information, such as the mark, goods or services, and so on, and forwards the application to WIPO.

The applicant may extend protection by requesting to designate jurisdictions that are part of the Madrid Protocol or subsequently after receiving the international registration.

Stage 2: Formal examination: WIPO checks whether the application complies with the requirements of the Madrid Protocol. Any irregularities need to be remedied within three months; otherwise, the application will be treated as abandoned, the process will end and the trademark will not be registered. In this situation, the filing fees will not be refunded.

If everything is in order, the application is recorded in the International Register and published in the WIPO Gazette of International Marks. WIPO will then send the applicant a certificate of international registration and notify the other trademark offices in the jurisdictions where the applicant has sought protection. This does not mean the trademark has been registered in each jurisdiction. Each office determines whether the mark can be registered in its country, usually through examination of the application and publication to allow third parties to oppose the application.

The application passes through substantive examination in the trademark offices of the jurisdictions that the applicant designated, in the same way as an application filed directly in each country. If the application is refused, the office must notify WIPO, and explain the reasons, within 12 or 18 months, depending on the jurisdiction.

If there are any procedures after the refusal, such as a response to an opposition, an appeal or a hearing, they will be handled between trademark offices and the applicant directly. WIPO will not get involved. If the application is accepted, a statement that protection of the mark has been granted will be sent to WIPO, which publishes it in the Gazette. The international registration is valid for 10 years, with the possibility of renewal.

However, if the international registration is based on a Thai application that has not been granted registration, or if it is based on a Thai registration that is cancelled in the first five years after registration, the rights granted under the international registration will be extinguished -- a process called a "central attack". If this occurs, the international registration will be cancelled.

It is possible to transform an international registration into national applications in each designated country, but this could involve re-examination by each jurisdiction's trademark office.

There are other hurdles in using this system as well. For example, the Madrid Protocol does not allow applicants to reclassify goods or services in a designated country once the application is accepted by WIPO. In some countries, such as the United States and the Philippines, the applicant would need to file a Declaration of Use and Evidence of Use within a certain period -- otherwise the registration would be invalid, which is different from Thai practice.

Given the challenges involved, before filing an application through the Madrid Protocol, trademark owners should consult an intellectual property lawyer to review applications and take precautionary measures to fully utilise the system. Thai IP lawyers who have experience filing trademark applications in foreign countries understand the nuances involved. Consulting an experienced IP lawyer will help identify any potential risks and avoid unnecessary expenses.

Despite its challenges, the Madrid Protocol is a good alternative trademark system for businesses of all sizes to protect their trademarks in foreign markets through a centralised, cost-effective means. It also promotes foreign investment, as it gives businesses confidence that their valuable trademarks will be protected. This will, in turn, enhance competitiveness in Asean and international markets.

About the author

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