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Madrid Application Receiving Office Established in Thailand

With Thailand's accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) in November 2017, the Thai government is moving forward in supporting international registration of trademarks in the nation.

In early January 2018, the Ministry of Commerce organized an opening ceremony for its new Madrid Application Receiving Office at the Department of Intellectual Property (DIP), with the event witnessed by the Deputy Minister of Commerce, Permanent Secretary of the Ministry of Commerce, Director General of the DIP, and other high-ranking government officials.

The office will be tasked with receiving and examining international applications using the Madrid system—inbound and outbound—and will also act as a center for disseminating knowledge about the Madrid system, including supporting brand owners in the international registrations of their trademarks.

Examination Guidelines

Pursuant to the Ministerial Regulation regarding the Madrid Protocol that was published in the *Government Gazette* on December 18, 2017, and came into force on November 7, 2017, once the DIP receives an international application from the World Intellectual Property Organization (WIPO) indicating Thailand as the designated country, the office will translate all the necessary information, such as the applicant's name and address, the list of goods and services, etc., from English into Thai. At that point, the office will issue a domestic application number, distinct from the international application number, and proceed with the examination process.

According to section 18 of the Ministerial Regulation, the rules and procedures for Thai trademark applications will be applied to Madrid international applications. Given this fact, all the examination rules and procedures, including the interpretation of distinctiveness, examination for similarity, prohibition of marks, clarification of the specifications of goods and services, etc., will be based on local laws and practices, the same as for Thai applications.

If, upon examination, the office finds any irregularities in the international application that would trigger any grounds for refusal (e.g., nondistinctiveness of the mark) the office

will issue a notification of provisional refusal to the applicant. To respond to the notification, the international applicant is required to appoint a local representative and provide a response within 60 days after receipt of the notification.

When the international application has been correctly amended and accepted, the office will publish the international application in the *Thai Trademark Journal*, the same as for applications filed via the national route. If a third party files an opposition against the registration of the international application, the office will not proceed with the registration of the opposed mark. At that stage, the international applicant must appoint a local representative and file a counterargument to the office within 60 days after receiving the opposition notice.

Timeline

As Thailand has adopted into law the declaration set out under Articles 5(2)(b) and (c) of the Madrid Protocol, the examination process for international applications using the Madrid system must be completed within 18 months; otherwise, the international application will automatically be deemed to be accepted for registration. However, in the case where an opposition action is raised by a third party, the office may still inform WIPO of a notification of

refusal after the expiry of the 18-month time limit. In comparison, registration under the national route takes approximately 12–15 months before an applicant receives the first notification or notice of publication.

It is important to note that, while the Madrid Protocol is an attractive option for foreign companies and trademark owners who seek trademark registration internationally due to the cross-border

convenience in filing, renewing, and transferring rights it provides, the examination rules and procedures for international applications designating Thailand will not be less stringent.

Conclusion

Since the Madrid Protocol entered into force in Thailand, the nation has been receiving much attention from applicants in other countries seeking to register their marks in Thailand. The office has received 166 international registrations/applications designating Thailand as of January 15, 2018. Additionally, there are currently 20 international applications filed with the Thai DIP seeking IP protection in other member countries under the Madrid Protocol.

These application figures are likely to increase in the near future with the removal of Thailand from the Office of the U.S. Trade Representative's Priority Watch List on December 15, 2017. Thailand is therefore likely to gain increased prominence among business owners and investors interested in expanding the protection of their brands, whether through the Madrid route or the national route. 🇹🇭

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