



Somboon Earterasaron
Partner
somboon.e@tilleke.com

Provisional Refusals of Madrid System Trademark Registrations in Thailand

WIPO's Madrid System, which provides an alternative to filing trademark applications through the traditional national route, has been an option for global brand owners seeking trademark protection in Thailand since November 7, 2017. As of October 2019, more than 15,000 international registrations (IRs) designating Thailand have been filed and processed at the International Bureau, which suggests a positive reception of the system by brand owners. Against this background, and now over 18 months from the date of joining Madrid (18 months being the statutory period within which the national trademark office needs to issue its provisional refusal), the Thai Department of Intellectual Property (DIP) has recently started to issue provisional refusals for IR applications designating Thailand. It is now a good time to point out several practical points that trademark owners should be aware of before deciding whether to seek protection in Thailand through the traditional national route or the Madrid route.

Incongruent Schedules and Conflicting Priority Rights

Every IR designating Thailand is to be allotted a local Thai application number, in addition to its IR number, after the DIP receives the application from WIPO and translates the name of the applicant. This local application number would follow with a 9-digit number, as with a national route application, that will act as a reference number when corresponding with the DIP, regardless of whether a provisional refusal is issued for the application. Brand owners therefore need to make sure to docket the local application and registration number in their portfolio management, maintenance, and enforcement.

It typically takes three to four months from the date of filing at the office of origin before an IR is published in the WIPO Gazette, making it disclosable via an online database, as well as various designated Trademark Office databases. In the case of Thailand, an IR designating Thailand will become searchable after the local application number is allotted. Although the DIP will try to allocate a corresponding local application number as soon as possible, this may take them several weeks, if not a few months. Thus, there could be a legal complication if two identical or confusingly similar marks are filed under different systems but with a close filing or priority date, whereby the one filed through the Madrid System has the prior right. There is a clear risk that by the time an examination is conducted against a national route application, which generally progresses faster than an IR, information on a particular IR may not be readily available. The registrar might then allow the national route application to go through and will only later find out that

the IR actually has the prior right (even though the IR becomes available in the local database later). Such a risk is not hypothetical, and we have already seen at least one case involving this unfortunate situation.

This type of occurrence signals to brand owners and their counsel that extreme caution should also be exercised to include the databases from both routes when conducting pre-filing availability searches.

List of Goods and Certificate of Registration

As with a few other jurisdictions, the DIP will translate the goods and services under an application from English into the local language (in this case, Thai) for examination purposes. The registrar conducts a formal examination focusing on the clarity of the list of goods and services based on the Thai translation. If a provisional refusal is issued, it would provide an opportunity for the brand owner to, through its Thai counsel, review the descriptions again and make sure that the descriptions correspond to the applicant's intention.

It is important for brand owners to ascertain whether the Thai translation corresponds to its expected scope of protection, as the translations will be docketed in the Trademark Office database. To date, no Certificate of Registration for an IR designating Thailand has been issued. Based on our discussion with the DIP, the Certificate of Registration for IR designating Thailand is to be issued in English, but in the event of an enforcement procedure, a corresponding Thai translation of the list of goods or services certified by the DIP is likely to be required by the relevant authorities. Thus, even a slight discrepancy in a Thai translation could negatively impair the trademark owner's rights to enforce its registered trademark in Thailand.

Multiple-Class Applications

While there is no difference in the examination of multiple-class applications made through either the Madrid or national route, a majority of IRs designating Thailand include several classes in one application. This leads to a very important practical perspective in that the DIP considers the whole application in its entirety, and a divisional application is not available in Thailand.

Under the current practice, the examiner does not indicate a specific class when they issue a refusal or impose a certain limitation, such as a disclaimer. Thus, in the case of refusal, the applicant needs to file an appeal covering all of the classes and, if a disclaimer is imposed, it would similarly be applicable to all classes. In addition, based on the latest regulations of the Board of Trademarks issued in March 2019, if one or more classes under a multiple-class application is appealed and is not successful, the whole application will be rejected, because a divisional application is not available under the current system.

Global System, Local Implementation

It appears evident from the above discussion that the Madrid System is a very attractive alternative for brand owners seeking trademark protection in Thailand. However, as with other jurisdictions, the system itself allows for local rules and regulations to be applied. This requires careful navigation by local counsel to optimize a brand owner's legal protection and to maximize efficient portfolio management. 🇹🇭