



1 Jul 2020 International trademark registration under the Madrid System in Thailand: practical points for brand owners

Thailand - [Tilleke & Gibbins](#)

- In 2018 and 2019 almost 60% of foreign marks filed in Thailand used the Madrid System
- The Madrid Application Receiving Office requires that the identification of the goods or services be clear and concise
- Brand owners should be aware of the high possibility of refusal in Thailand

As of 22 June 2020, Thailand has received 20,368 Madrid applications and, if considering only the years 2018 and 2019, almost 60% of foreign marks filed in Thailand utilised the Madrid System. With the system now in its third year, this update reflects on observations of the Madrid System and identifies the practical points for brand owners to consider when deciding which of the two channels - the Madrid System or the direct national route in Thailand - is the most efficient.

Madrid Application Receiving Office

The Madrid Application Receiving Office was set up to receive and examine international applications using the Madrid System. Once WIPO notifies the office of the designation, the latter will allocate a local application number and translate the applicant's name and the list of goods or services. The office will have to make decision within the 18-month time limit under Thailand's declaration of accession to Madrid Protocol.

If the office finds no grounds for refusal, it will publish the Madrid application in the *Thai Trademark Gazette* and, if no opposition is filed, issue a statement of total grant of protection. However, if grounds for refusal are found, the office will issue and send a provisional refusal to WIPO, which will then transmit it to the applicant. The applicant will have 90 days to appoint a local representative and file a response.

Provisional refusal

Statistics gathered by IP-based software revealed that more than 85% of Madrid applications designating Thailand during 2017-2018 received provisional refusals, usually citing vagueness of the description of goods or services. It is important to note that Thailand is not a member of the Nice Agreement, but has broadly adopted the Nice Classification in tailoring its version of the Manual of Goods and Services. The office requires that the identification of the goods or services be clear and concise, and it does not accept wording such as "namely" or "including". Long descriptions that include several goods or services must be split into separate descriptions on an item-by-item basis. Examples of accepted and rejected descriptions from the Manual of Goods and Services are provided below:

Rejected description	Acceptable description
Telecommunications devices (Too broad)	Smartphones
Retail services connected with the sale of perfumes, beauty products, toiletries, candles, tableware, cutlery, machines for household use, hand tools, lighting, jewellery, watches, goods in precious metals or coated therewith ... (Too long and includes too many items)	Retail services for clothing; Retail services for cosmetics; Retail services for computer software.

Once registered, the office will issue a Thai-language certificate of trademark registration - with the applicant's name in Roman alphabet letters and the list of goods or services in English - which is then sent to the appointed local representative.

Differences between the Madrid and national filing systems

Below are the major points of difference between the two systems:

	Madrid route	National route
Local representation (including notarised and translated power of attorney)	Not required for filing a Madrid application, but necessary for filing a response with the Trademark Office	Required at all stages but a power of attorney will be required only once
Average timeframe for issuance of the first provisional refusal	17-18 months	14-15 months
Time limit to respond to a provisional refusal	90 days from the date of provisional refusal	60 days from receipt of the provisional refusal

The Madrid System is beneficial to brand owners as it provides a low-cost and effective solution for obtaining and maintaining trademark protection in multiple jurisdictions. However, for Thailand, it is crucial that brand owners be aware of the high possibility of refusal, so that they can better plan their brand protection strategies in a more cost-effective way.

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