



Final Step to Madrid: The DIP's Preparation for the Madrid Protocol

November 1, 2017

For years, the Thai Department of Intellectual Property has gradually taken various steps to prepare for accession to the Madrid Protocol. As the effective date (November 7, 2017) is fast approaching, significant progress is being made as follows.

- **Organization**

The Madrid Division currently with 8 staff has been established within the Trademark Office. This Division will be responsible for preliminary examination of the international applications filed through the Thai Trademark Office as an office of origin as well as preparation of Thai translations and substantive examination of international applications designating Thailand.

However, the relevant officer has insisted that both Madrid and local applications be examined under a consistent standard suggesting that marks held non-distinctive as well as terms of goods/services held too broad under the current practice will still face the same rejections even when filed through the Madrid system. To avoid such rejections, applicants may have to specifically customize their international applications in accordance with the Thai practice or file local applications instead.

Moreover, it would be prudent to ensure that the terms of goods/services in the international applications are accurately translated into Thai. Otherwise, they may be rejected or even worse the scopes of protection may be jeopardized or unreasonably narrowed.

- **Computer system**

The Department of Intellectual Property has implemented an on-line filing system, under which certain details of Thai basic applications/registrations can be automatically converted into international applications. Before using this system, applicants and agents have to register and verify their identities by presenting original official documents to the Trademark Office in person. Paper applications may not be allowed.

This on-line system should facilitate filing processes of international applications, but there may be some difficulties if applicants wish to file basic applications and international applications simultaneously because the Trademark Office will have to promptly input details of basic applications into the system in order that they can be used for filing international applications. Currently, it takes approximately 5 working days for the Trademark Office to update such details of new applications.

- **Relevant regulation**

The draft regulation specifying details of the Madrid procedure has been approved by the Council of State and should be promulgated soon. According to this draft, international applications submitted through the Thai Office will be examined in 25 days after filed, and the applicants will have to rectify incorrectness or incompleteness (if any) in 15 days upon receipt of the official notices. In case that the applications are in good order, the applicants will have to pay official fees to the International Bureau within 3 days upon receipt of requests from the Trademark Office. In view of these tight deadlines, the applicants should closely and consistently monitor status of their applications in order to ensure timely responses to official notices.

For incoming applications, the applicants will have to deal with provisional refusals issued by the Thai Trademark Office through local agents within 60 days upon receipt of the relevant notices.

It is a universal truth that there is no one-size-fit-all system. There is no exception for the Madrid Protocol, which may not perfectly function in all member states. The authorities, including the Thai Trademark Office, will have to finely tune the system in accordance with their specific circumstances. For trademark owners, it would be beneficial to familiarize themselves to not only the Protocol but also characteristics of relevant jurisdictions in order that they can effectively employ the Protocol in those jurisdictions.