

IP NEWSLETTER

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MADRID PROTOCOL

The Government of Thailand recently deposited the instrument of accession to the Madrid Protocol for the International Registration of Marks with the Director-General of the World Intellectual Property Organization (WIPO) on August 7, 2017 with an effective date in Thailand on November 7, 2017.

The Madrid Protocol will simplify the filing process of international application for registration of marks by allowing brand owners in Thailand to seek protection of their marks in the 114 territories of the Madrid System's other 98 member countries, by filing a single international application with the Thai Department of Intellectual Property (DIP), as well as paying a single set of government fees. The system also enables other member country's trademark owners to designate Thailand and obtain legal protection in the country. Please, however, note that the registrability of the applied marks will still be based on the current Thai Trademark Act and local practice of the Trademark Registrar.

Outgoing International Application

An applicant must have the pending Thai trademark application or Thai trademark registration as a basis for filing international trademark application in one or more member countries under the Madrid Protocol. In this regard, the applicant also needs to ensure that the mark, list of goods/services and owner's name for outgoing international application are identical with those indicated in the basic application or registration. Once the DIP certifies the information in the international application, it will forward the application to the International Bureau (IB) of the WIPO for further formal examination before it is later submitted to the designated country under the Madrid Protocol.

It should be noted that, if the basic application is refused or the basic registration is cancelled during the five years from the date of the international registration, the international registration will become invalid accordingly. This is referred to as a "Central Attack". After the international registration has existed for five years, it becomes independent of the basic registration/application, in other word; it stays unaffected and valid in spite of subsequent refusal of the basic application or cancellation of basic registration.

Incoming International Application

The timeframe for Thai Trademark Registrar to issue a notification of refusal of the international registration to the IB is 18 months or more in case that there is an opposition raised by a third party. If the notification of refusal is not issued within the prescribed period and no opposition is filed, the international registration receives the same protection in Thailand as a national registration, subject to the possibility of central attack as described above.

For additional information regarding the Madrid Protocol and other trademark matters, please contact us at ipgroup@ilct.co.th or ratinuchk@ilct.co.th.