

A Crucial Step of Thai Trademarks towards a New Era of Changes

The year 2015 is the year when Thailand is to fully become a part of the ASEAN Economic Community; or AEC, and one of several achievements by ASEAN Member States on the road to AEC is to be a party to the Madrid Protocol. Madrid Protocol is a treaty facilitating the application for trademark registration in over 90 countries around the world. Thailand's accession to the Madrid Protocol is going to bring massive changes to the trademark registration practices in Thailand, directly and indirectly affecting business planning of both SMEs and large corporations.

The Madrid Protocol is likely to have an impact on nearly every active player in the business because it will help Thai exporters cut costs of having their trademarks registered and legally protected in the international markets. The benefits of lower cost of trademark registration are even more magnified due to a perfect timing at which Thailand is to fully integrate into AEC and all trading gateways to neighboring countries are set to open.

Under the Madrid System, the applicant for trademark registration is able to specify, at the time of filing the application with the Department of Intellectual Property, a list of countries where the applicant wishes to have the trademark be legally protected, Business operators, or trademark owners, are no longer required to travel to each and every country in order to initiate the trademark application filing process nor appoint their representatives to do the registration for them, The Madrid Protocol offers Thai trademark owners the opportunity to have their trademarks protected in several countries by simply filing one application (in English language) for international registration directly with the Department of Intellectual Property. Moreover, the time generally taken for the overall process of trademark registration can be speculated, To explain it more clearly, the designated trademark office in each destination country to which the application for international trademark registration is sent has a period of 18 months to complete the examination of each trademark application and notify the applicant of the result whether to accept or refuse the application. If there is no response from the designated office in any destination country after 18 months, the trademark applied for protection is automatically deemed as being registered in that particular destination country. This time limit requirement certainly makes business planning and

management of risks much easier for business operators. Furthermore, in case of any change to the information earlier provided and maintained in the registration database, e.g. change of address or trademark, renewal, transfer of trademark rights, etc., the trademark owner is able to update such change via one written notice which will take effect in all destination countries where the trademark has already been registered. This is certainly a greater convenience for all trademark owners.

Filing an application for trademark registration via Madrid System is very easy. The applicant needs to fill out a specific application form in English (for more information, visit the Department of Intellectual Property website at www.inthailand.go.th) and manually deliver the form to the Department's international trademark application office currently located on the 7th floor. Before forwarding the application to the International Bureau, the Department of Intellectual Property is to conduct a preliminary examination by checking whether the applicant is of Thai nationality (or whether business activities are conducted in Thailand), whether the trademark in question has already been registered in Thailand (the trademark eligible for international application must be the same trademark as earlier registered domestically and the goods item(s) with which the applied-for trademark will be specifically used must match), and whether the information filled in the application form is correct (e.g. the applicant's name; all must be correctly translated into English). Then, the Department of intellectual Property will make sure that the application is forwarded to the International Bureau at the World Intellectual Property Organization (WIPO) in Geneva no later than 2 months for examination of good list associated with the applied-for trademark. Then, the application will be delivered to each designated trademark office in the destination country in which the trademark is applied for registration.

Once the designated trademark office completes the examination, in essence, of the application, the result will be communicated to the International Bureau who will subsequently forward the result to the applicant. If the result is refusal, the applicant may directly contact the designated trademark office in the destination country to challenge the result, provide additional explanations, or amend the application. In such process, the applicant needs to appoint a representative, whose presence in the destination country is required, to take actions on the applicant's behalf. But if the application is granted by the designated office in the first place, the application will be published for public inspection to give any third party an

opportunity to raise an objection in order to ensure transparency and fairness of the registration process. If no objection is raised, the designated office in the destination country will accept the registration (in some countries, the registration is accepted before publishing the application details for objection), and then notify the International Bureau of the acceptance of trademark registration, who will forward the result of acceptance to the applicant.

It is apparent that in a near future the procedures for registering trademark overseas will be considerably easier and cost saving, encouraging many business operators to export their products to markets across the world, and protecting these entrepreneurs from becoming victims of trademark counterfeiting or exploitation in bad faith. Once the Madrid System is in effect, the Department of Intellectual Property hopes to see Thai business operators are able to make maximum use of this system in order to fully serve their business purpose and to effectively protect their equitable rights associated with use of trademark.

At present, there are 93 countries and 1 international organization, namely the African Intellectual Property Organization, joining the Madrid Protocol, representing nearly all major markets from all corners of the world. For Thai business operators aiming to sell products to consumers across the globe, including such less accessible market as those countries in Africa, they can have their trademarks conveniently registered in foreign countries of the goods' destination through Madrid System, We have every reason to believe that the year 2015 will be the year of change to Thai trademarks towards the international framework and Thai business operators are meant to benefit most from such change.