

Headline: **Revision of Thailand's Trademark Act to accede Madrid Protocol**

Revision of Thailand's Trademark Act to accede Madrid Protocol

Since 2005, the Thai Department of Intellectual Property (DIP) has appointed a working group for preparation to join as a member of Madrid Protocol. The DIP recently revealed updates to the Thailand's Trademark Act which is expected to bring major changes to the trademark registration system in Thailand, and in correspondent to the Madrid System.

Whereas the contracting states must implement their domestic laws to be in compliance with the Principles of Madrid Protocol, Thailand is also obliged to such implement with certain notable and interesting subjects planned in the revision of Thailand's Trademark Act as follows:

1. Multiple-class application available:

One trademark application may be applied for one or more than two classes

2. 18-months time limit to refuse an international application:

As a designated country of an international application, Thailand is entitled to declare in a notification of refusal* of an international application to the International Bureau of WIPO within a period of 18 months as from the filing date. Otherwise, the right of refusal by the Thai Trademark Office against the registration of an international application will be exhausted, whereas the Thai Trademark Office will be forced to grant a registration to an international application (Article 5 of Madrid Protocol).

*Based only on the grounds applicable, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited directly with the Office who notifies the refusal.

3. Registration date:

3.1.If the Thai Trademark Office transmits an international application to the International Bureau within two months as from the receiving date, the registration date of such international application will be deemed the date that the Thai Trademark Office receives the application.

3.2.If the Thai Trademark Office transmits an international application to the International Bureau later than two months as from the receiving date, the registration date of such international application will be deemed the date that the International Bureau receives the application. (Article 3 of Madrid Protocol)

4. One trademark in one class can be owned by different owners for different goods/services. (Article 9 of Madrid Protocol).

The current version of Thailand's Trademark Act strictly forbids one identical/similar mark with subject to same manner of goods/services to be owned by different owners.

The adaptation of this principle from Madrid Protocol resulted in the practices on trademark registration in Thailand become more resilient and more international.

5. Grace period of renewal:

There is currently no grace period of renewal in Thailand's trademark system. In case of failing to renew a national trademark registration within an expiry date would result in the registration be disposed from the Register without possible restoration.

In applying a Madrid Protocol, a registered international trademark application that failing to be renewed within an expiry date may be renewed within six months as from the expiry date subjected to the payment of a surcharge (Article 7 of Madrid Protocol).

In addition to the above subjects which are exclusively revised in preparation for the accession of Madrid Protocol, the DIP also aimed to further includes new matters to the trademark protection which have not been appeared in present version of the Thai Trademark Act i.e. scent and sound trademarks.

With consideration to the new version of Thailand's Trademark Act, this can be regarded as a sign of upcoming substantial developments for trademark protection in Thailand in the near future.

The proposed bill was previously aimed to be promulgated at the end of 2014. However, it currently appears that the enactment may be delayed due to legislative reasons and the process has been postponed. In the meantime, our firm will be monitoring any updates on this matter and will report further development soon.