

Provision refusals in Thailand (Madrid applications)

If you filed an international trademark application via the Madrid system designating Thailand, in a great majority of cases, you will face a provisional refusal issued by the Thai Department of Intellectual Property (DIP) before your trademark is allowed for registration in Thailand.

Most commonly, this provisional refusal is based on one or more of the following grounds:

- (1) The **goods or services** listed in the application are deemed to be too “**broad or vague**” (*Section 9 Trademark Act*).
- (2) Part of the trademark (a word or a device element) is deemed common to the trade and should be **disclaimed** by the applicant (*Section 17 Trademark Act*).
- (3) The trademark is deemed to be **similar to a prior trademark** (pending or registered) used with the same kind of goods or services, which might confuse or mislead the public as to the ownership or origin of the goods or services (*Section 17(2) Trademark Act*).
- (4) The mark is deemed **not distinctive**, either because the registrar considered that the words used are too generic, that the words or the device elements are descriptive of the characteristics or quality of the goods and services; or because the mark consists only of an acronym and/or numerals without any stylization (*Sections 6 and 7 of the Trademark Act*).

The first ground of refusal is almost systematic, since the list of goods and services used by the DIP deviates largely from the Nice Classification. It is however easy to overcome, simply by filing an amendment of the specification in line with the requirements of the DIP, which means that the items should be especially specific and listed one by one.

The second ground of refusal is also easy to resolve by disclaiming the element(s) cited by the registrar as “common to the trade”. The disclaimer will prevent the owner of the trademark from claiming exclusive rights over the element(s) disclaimed, but her/his trademark will still be protected as a whole. In comparison to other South-East Asian countries, the Thai DIP strictly enforces the disclaimer requirement. Naturally, the applicant always has the option to challenge the registrar’s disclaimer request by filing an appeal before the Trademark Board, but the appeal procedure is rather lengthy and more costly.

The second and third grounds of refusal can only be overcome by filing an appeal against the registrar’s decision before the Trademark Board. The success rate of such a course of action should be determined on a case-by-case basis.

Currently, it takes around one year for the DIP to process an amendment of the specification or to record a disclaimer for incoming Madrid applications (for 3 to 6 months for standard applications filed in Thailand). The appeal procedure before the Trademark Board lasts 2 to 3 years.

These numerous obstacles encountered by foreign applicants using the Madrid Protocol should be carefully considered prior to choosing this path to register a trademark in Thailand. In many instances, filing a trademark application via a local representative would be more time and cost-effective. A minima, a local representative would (1) ensure that the list of goods and services complies with the requirements of the DIP; (2) advise on the necessity to include disclaimers in the application; and (3) conduct a trademark search to identify any existing similar prior marks.