



# AN EXAMINATION OF THE MADRID PROTOCOL: ADVANTAGES AND DISADVANTAGES



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In matters regarding Trademark Protection, the Trademark can be protected by way of two systems.

The first of these two systems consists of filing with the Paris Convention for the Protection of Industrial Property which means the trademark owner can file their trademark directly with the designated countries. Even with the proper filing through the Paris Convention, it does not automatically protect the trademark in all of the Paris Union countries once it is protected in the countries where the trademark has been filed with.

Another way to protect the trademark and the second of the two systems is filing with the Madrid Protocol. This means the trademark owner uses the Madrid system to protect the trademark in over the 130 countries that are members of the aforementioned system by filing a single international application and one-time payment of the set of fees.

In addition, Thailand has been a member of the Madrid Protocol since November 7, 2017, and is one amount the 130 countries who are members of the treaty. The Madrid Protocol is administered by the World Intellectual Property Organization (WIPO) which is convenient, cost-effective, although it may be viewed as time-consuming.

As this may sound like a contradiction, we will explain as to the advantages and disadvantages of the Madrid Protocol as detailed below.

#### *Advantages*

- An international application can get protection among the member countries through a single application.
- An international application can make a one-time payment of the set of fees.
- Cost-effective method.
- The process is less time-consuming.
- Any amendment in the details of the applicant can be amended by forwarding one single document to the International Bureau and no need to be made at each national office.
- The costs of filing and renewal of an international application are lower than direct application.

### *Disadvantages*

- International registration can extend only to Protocol territories.
- If a basic application filed in Thailand is canceled or limited in the first five years, then the international mark will similarly be cancelled or limited.
- If an international registration is designated in Thailand receiving the office action from Thai DIP, the applicant must appoint a Thai representative to proceed with the next action.

Therefore, as seen above, the two trademark systems present both advantages and disadvantages dependent upon the factors and details presented. As part of the Madrid Protocol, Thailand is part of a much larger trademark community which may offer additional advantages to the trademark applicant.

As always, it is best to contact a trademark professional who can guide you and provide additional insight into what may be the best choice and the most cost-effective solution to your needs.