



The Importance of Patent Protection for EU Businesses in Thailand

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Speaker's bio

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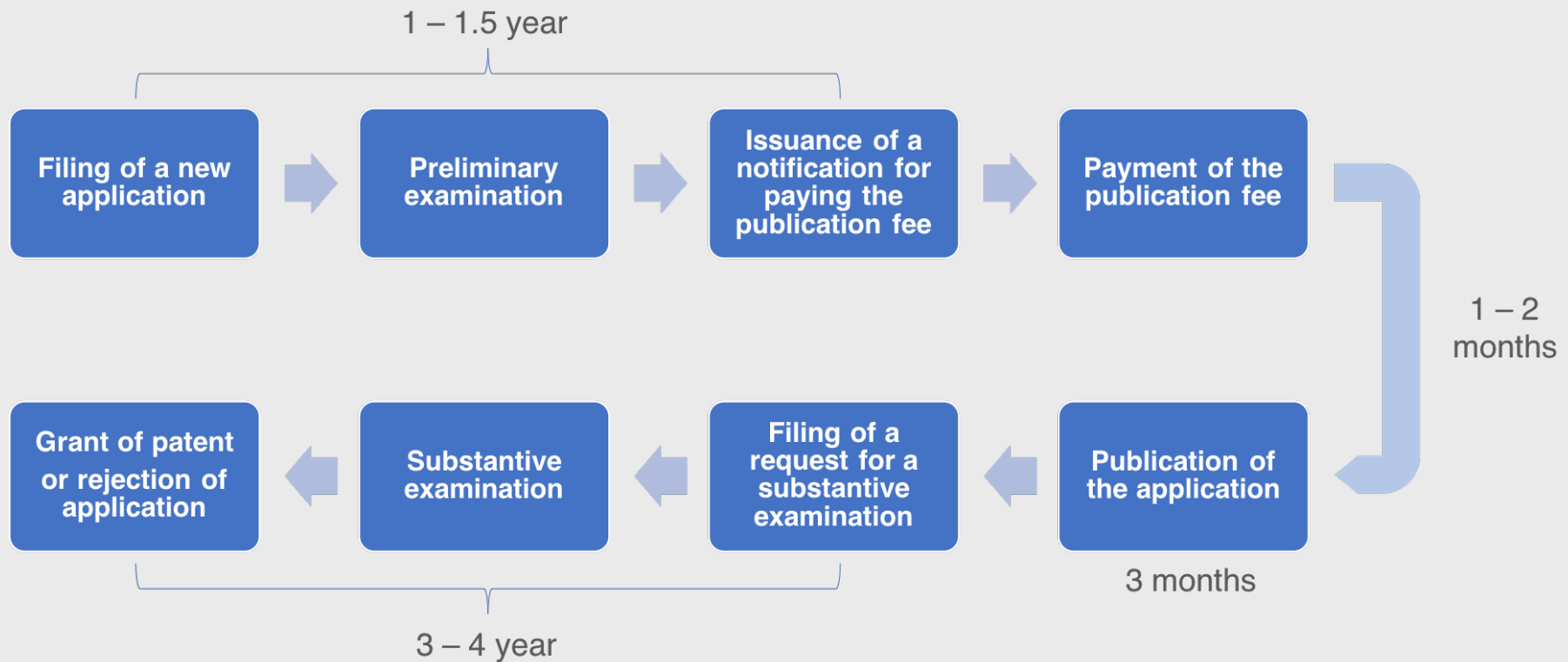
Benjapol is the head of Ananda IP's Patent Department. A registered Thai patent agent with close to 10 years of patent/design patent prosecution experience, Benjapol has represented a broad range of clients both domestically and abroad, from individual business owners to publicly traded companies.

Prior to joining Ananda IP, Benjapol worked as a patent agent at a large law firm in Thailand where he acquired valuable experience on patent prosecution, patent litigation, and valuation. At Ananda IP, Benjapol is responsible for managing the firm's patent practice and overseeing the development of patent, design patent, and petty patent work in the firm. Benjapol's practice focuses preliminarily in the areas of patent procurement, opinions, due diligence, valuation and litigation.

Types of Patent Protection

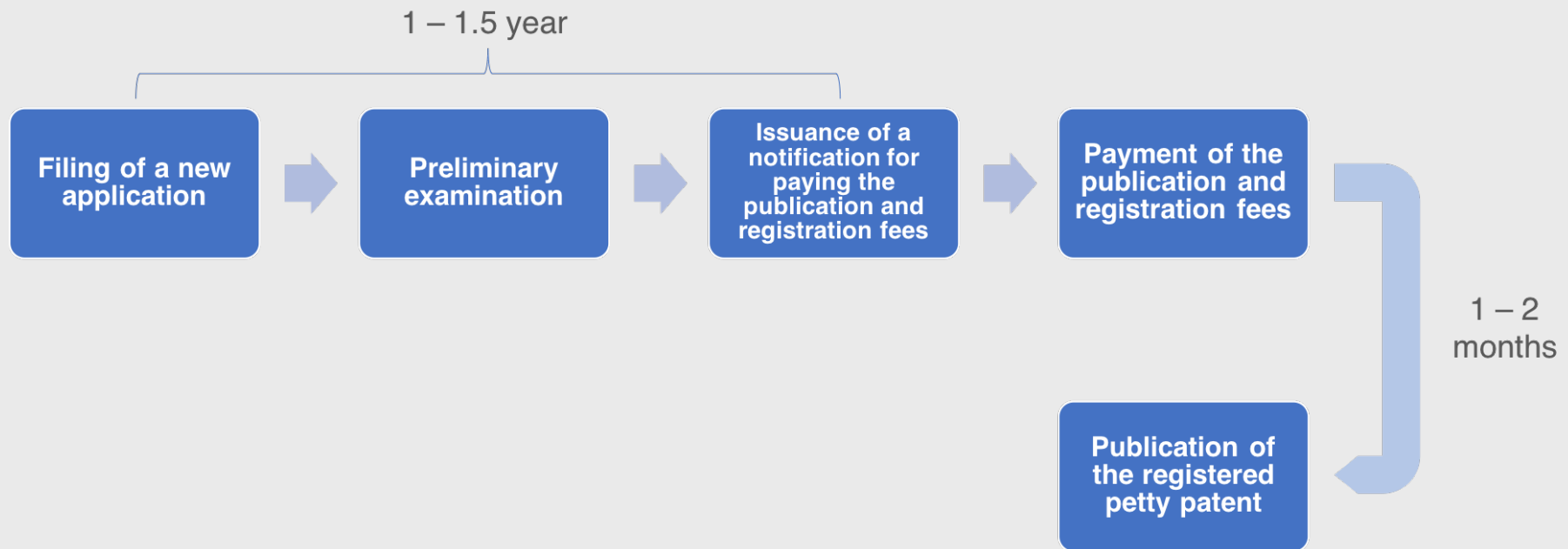
- Invention patent
 - a novel, non-obvious and industrially application invention
 - 20-year period of protection
- Petty patent
 - a novel and industrially applicable invention
 - 10-year maximum period of protection
- Design patent
 - a novel and industrially applicable ornamental aspect or aesthetic of a product
 - 10-year period of protection

Registration Process of Invention Patent Application

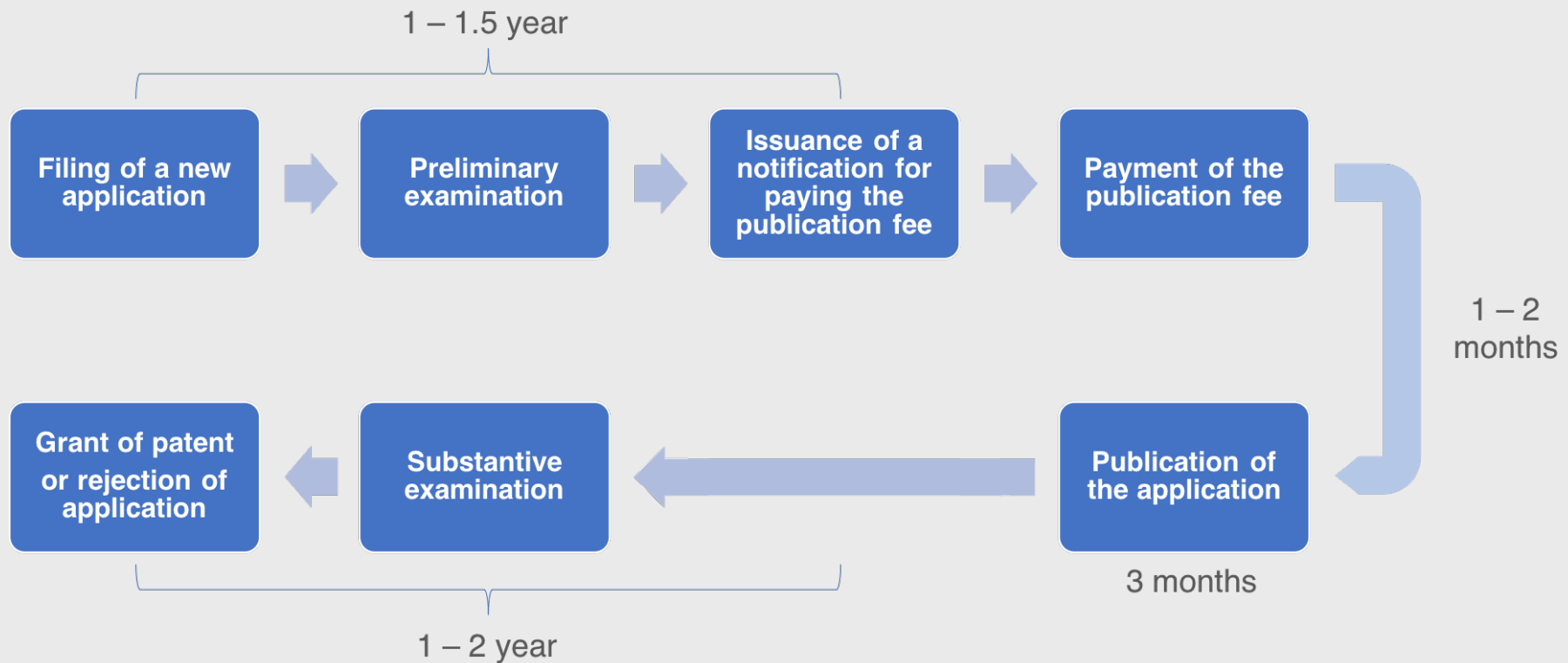


- * PPH Pilot Program: 6 months – 1 year
- * ASPEC Program: 6 months – 1 year

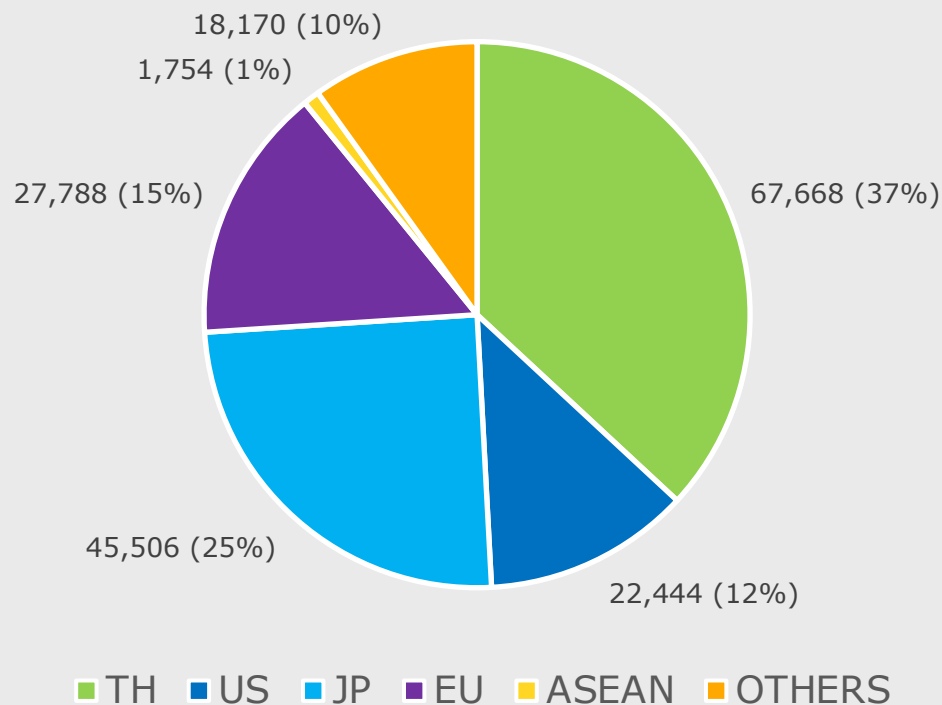
Registration Process of Petty Patent Application



Registration Process of Design Patent Application



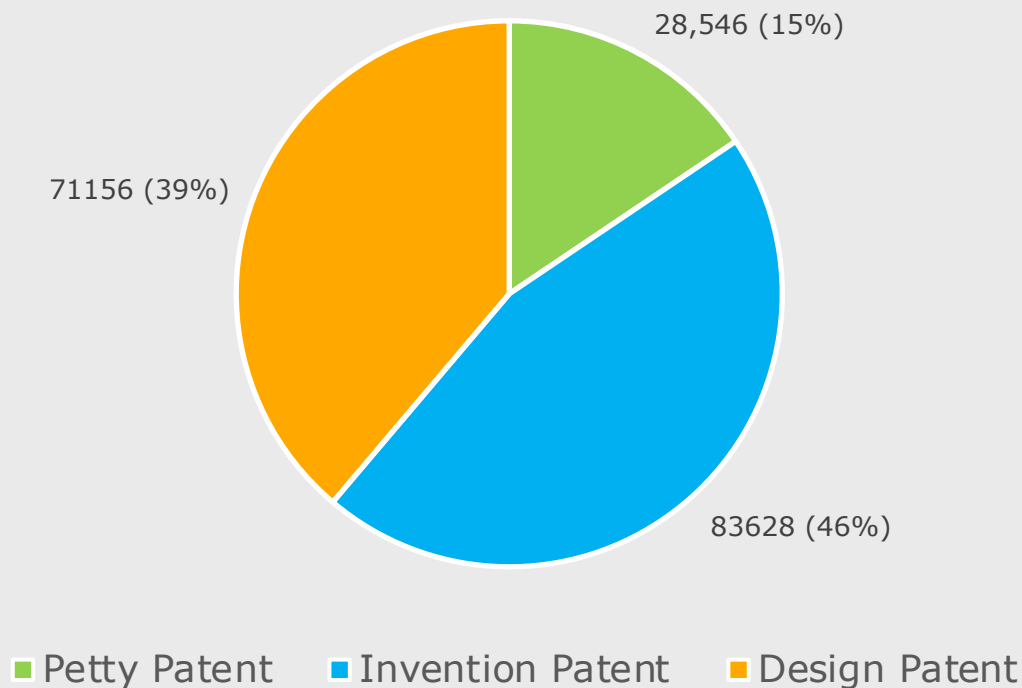
Statistics



Patent applications filed during 2001 – 2018 (By nationality of applicant)

* Source: Department of Intellectual Property of Thailand

Statistics (cont'd)

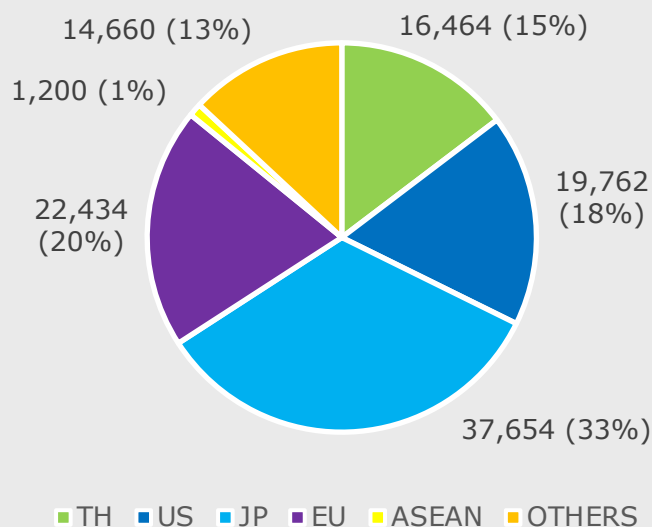


Patent applications filed during 2001 – 2018
(By type of patent)

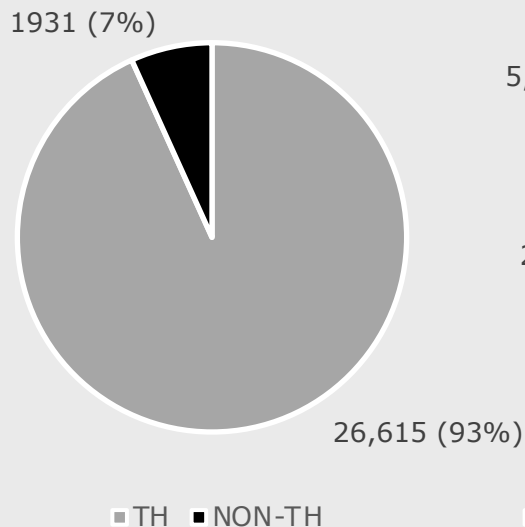
* Source: Department of Intellectual Property of Thailand

Statistics (cont'd)

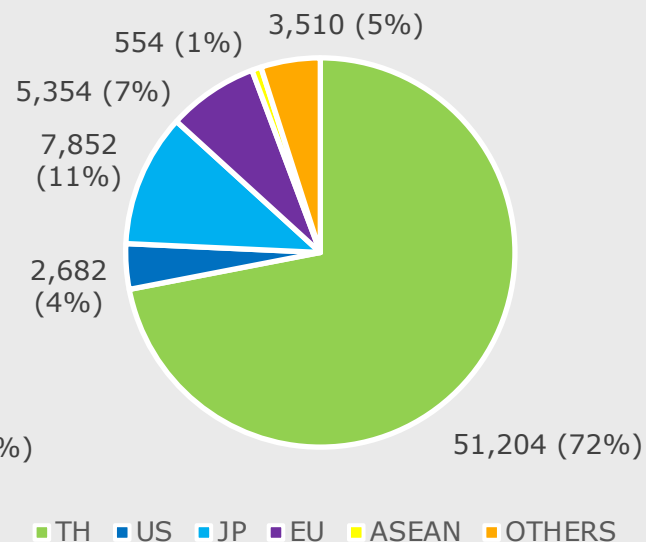
**INVENTION
(PATENT + PETTY PATENT)**



**INVENTION
(PETTY PATENT)**



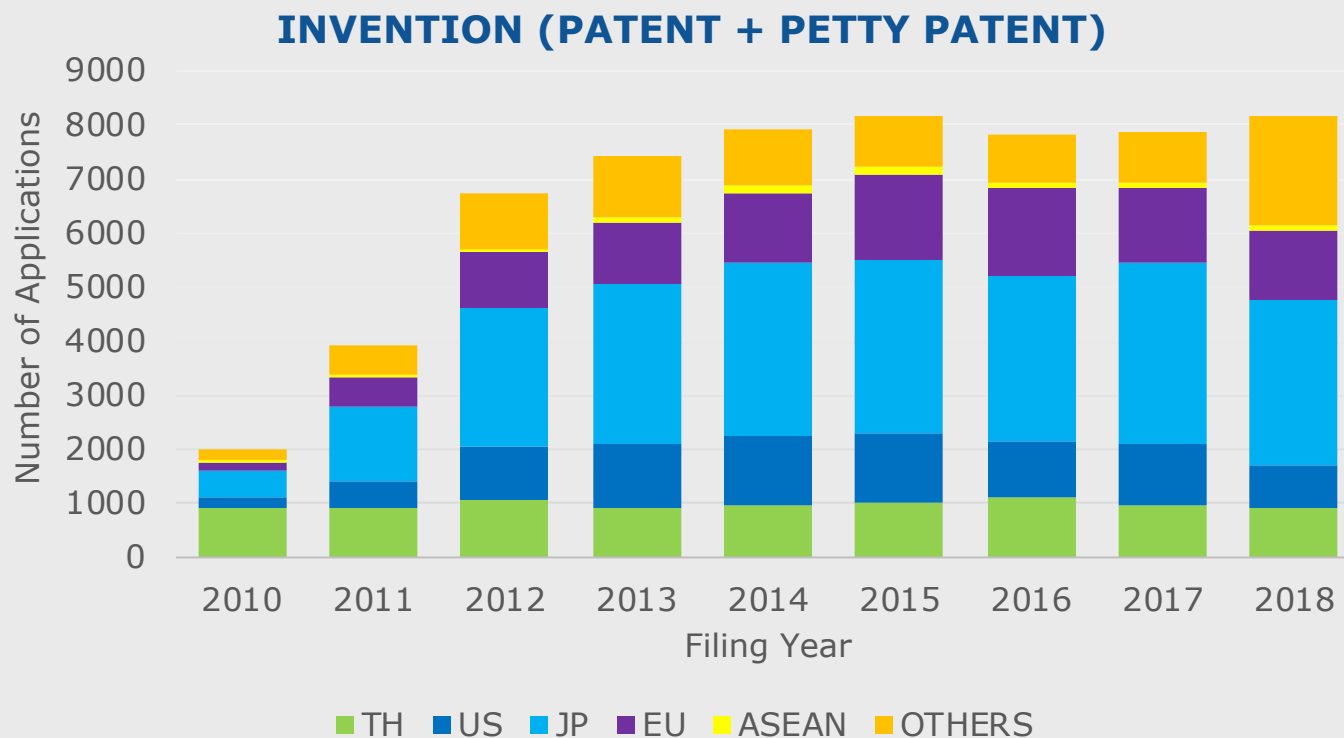
DESIGN PATENT



**Patent applications filed during 2001 – 2018
(By nationality of applicant)**

* Source: Department of Intellectual Property of Thailand

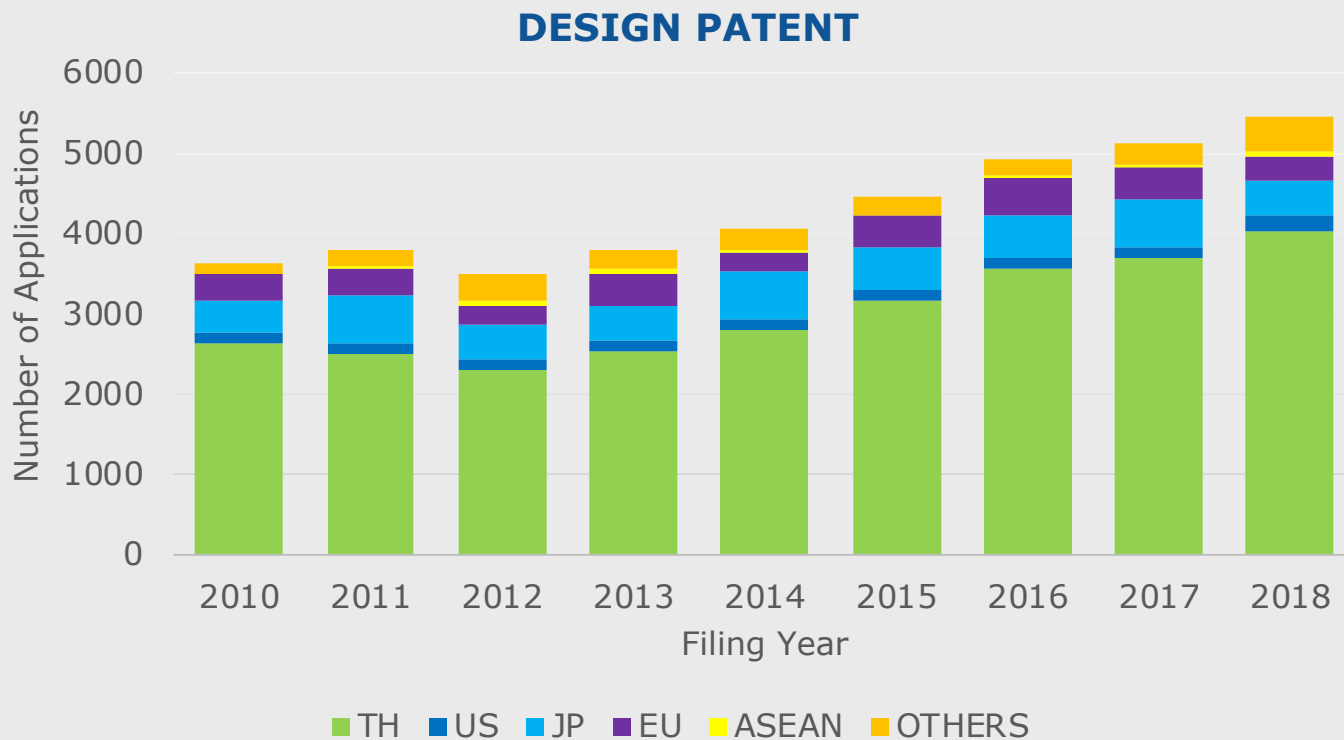
Statistics (cont'd)



Patent applications filed during 2010 – 2018
(By filing year)

* Source: Department of Intellectual Property of Thailand

Statistics (cont'd)

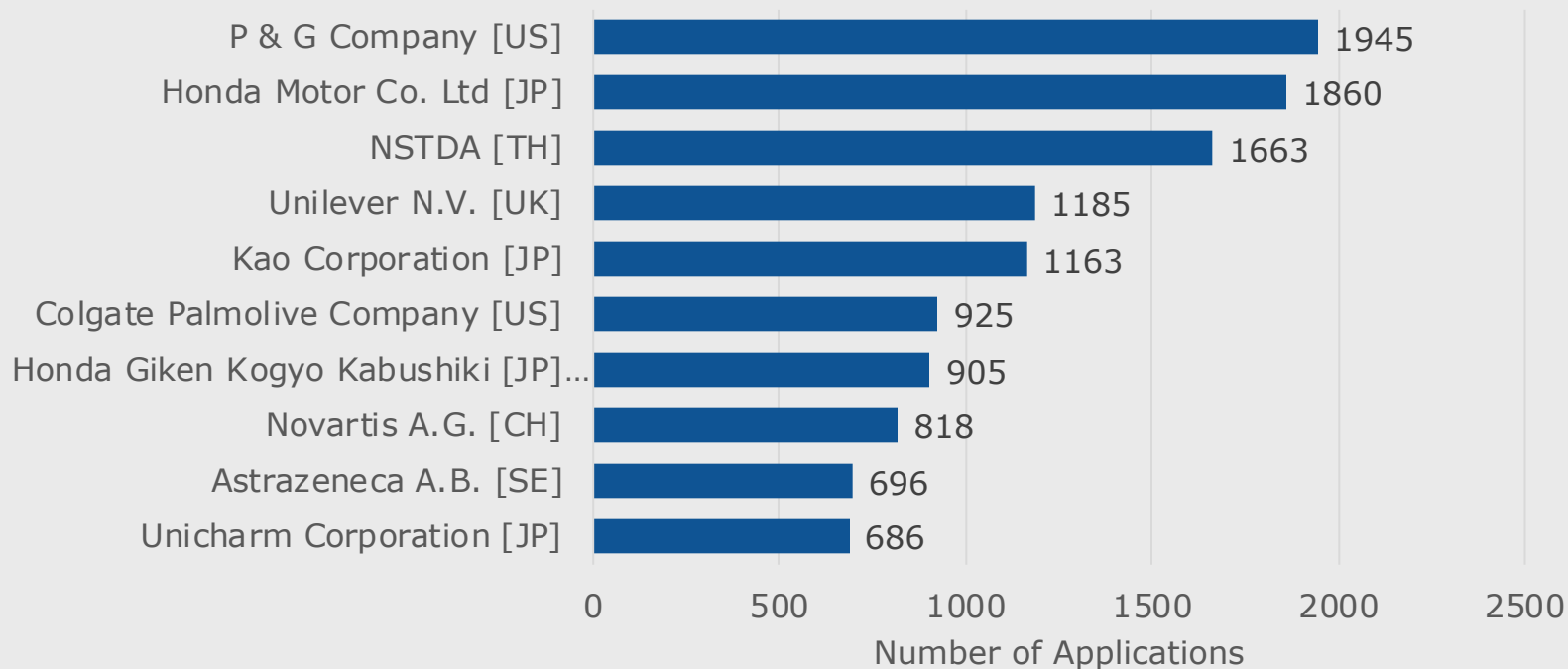


Patent applications filed during 2010 – 2018
(By filing year)

* Source: Department of Intellectual Property of Thailand

Statistics (cont'd)

TOP 10 APPLICANTS FOR INVENTION PATENTS & PETTY PATENTS



Patent applications filed during 1979 – 2018
(By applicant)

* Source: Department of Intellectual Property of Thailand

Major Issues

- Foreign domination
 - Technology is largely imported from abroad
 - Over 80 percent of patents granted to foreigners
- Inefficient patent examination
 - No adequate competent patent examiners
 - Dependent upon foreign patent offices
- Language and translation problems
 - Thai translation of patent specification is required
 - Translations are often poor, making the applications unclear and difficult to examine

Infringement

There are two types of infringement claims:

- Direct infringement (literal/non-literal infringement) – Recognized under the Thai Patent Act
- Indirect infringement – No express provision under the Thai Patent Act

Infringing acts:

- the production, use, sale, having available for the purpose of sale, offering for sale, and importation of a patented product
- use of a patented process, and the production, use, sale, having available for the purpose of sale, offering for sale, and importation of products made by the patented process

Infringement (cont'd)

Non-infringing acts:

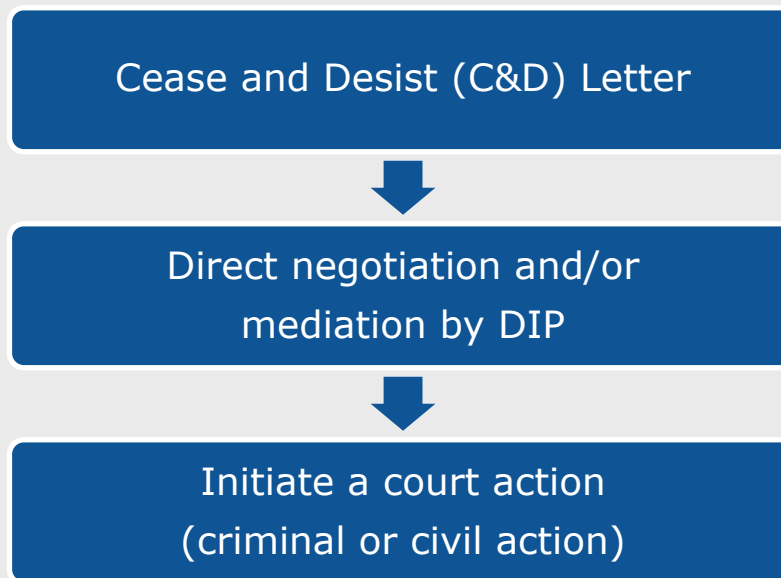
- acts done for the purpose of education, research or experimentation only
- the preparation of medicines in individual cases by a pharmacist/medical practitioner
- acts done in respect of applications for the registration of medicines
- use of equipment being a patented invention on board of ships of a country being a member of Paris Convention or PCT, when such ships temporarily or accidentally enter the waters of Thailand, and provided such equipment is used exclusively for the needs of the ships

Infringement (cont'd)

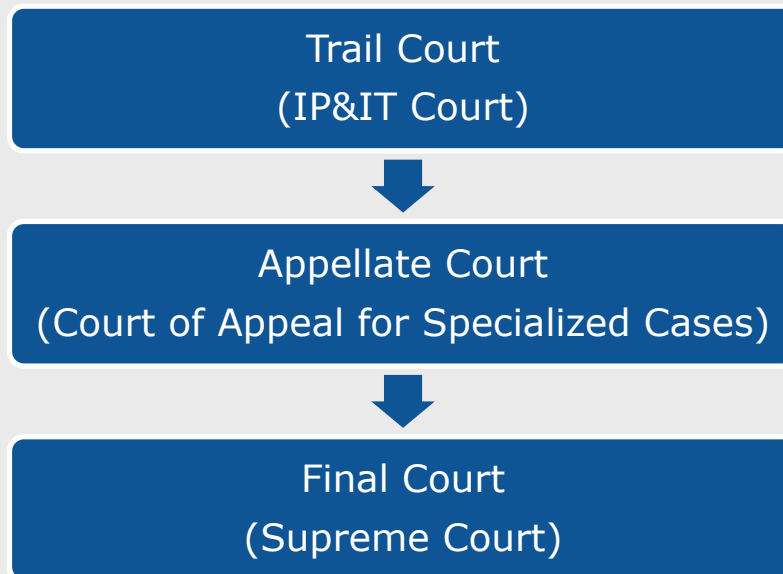
Non-infringing acts (cont'd):

- use of equipment being a patented invention in the construction or operation of aircraft or land vehicles of a country being a member of Paris Convention or PCT when those aircraft or land vehicles enter Thailand temporarily or accidentally
- use, sale, possession for sale, offering for sale or importation of a patented product if the patentee has permitted the manufacture or sale of that product
- the production of a patented product or the use of a patented process if the party producing or using the invention has, in good faith, started the production or has acquired the equipment therefor prior to the date of filing the patent application in Thailand

Pre-Litigation

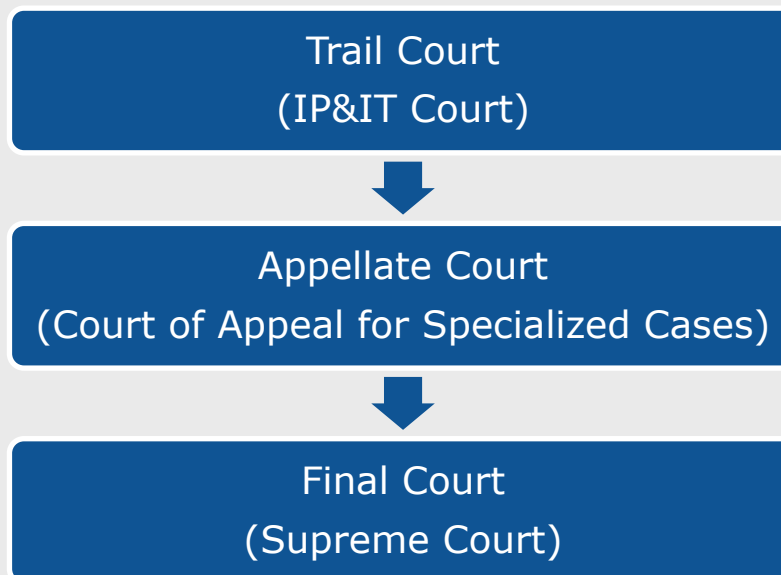


Criminal Action



- Must file a complaint within 3 months after learning of the infringement and learning the identity of the infringer
- Penalties: No more than 2 years imprisonment and/or fine not more than 400,000 Baht

Civil Action



- Civil Remedies: Permanent injunction, compensation (e.g. actual damages, attorney's fees), destruction of infringing goods, and other requests (if any)

Standing

- Who has standing to file a patent infringement action?
 - only the patent owner or the transferee of a patent
 - no express provision in the Thai Patent Act for standing of licensee
- Who has standing to challenge patent validity?
 - Any interested person or the public prosecutor
 - Must demonstrate that the claimant is an “interested party”

Case Example 1 – INVE

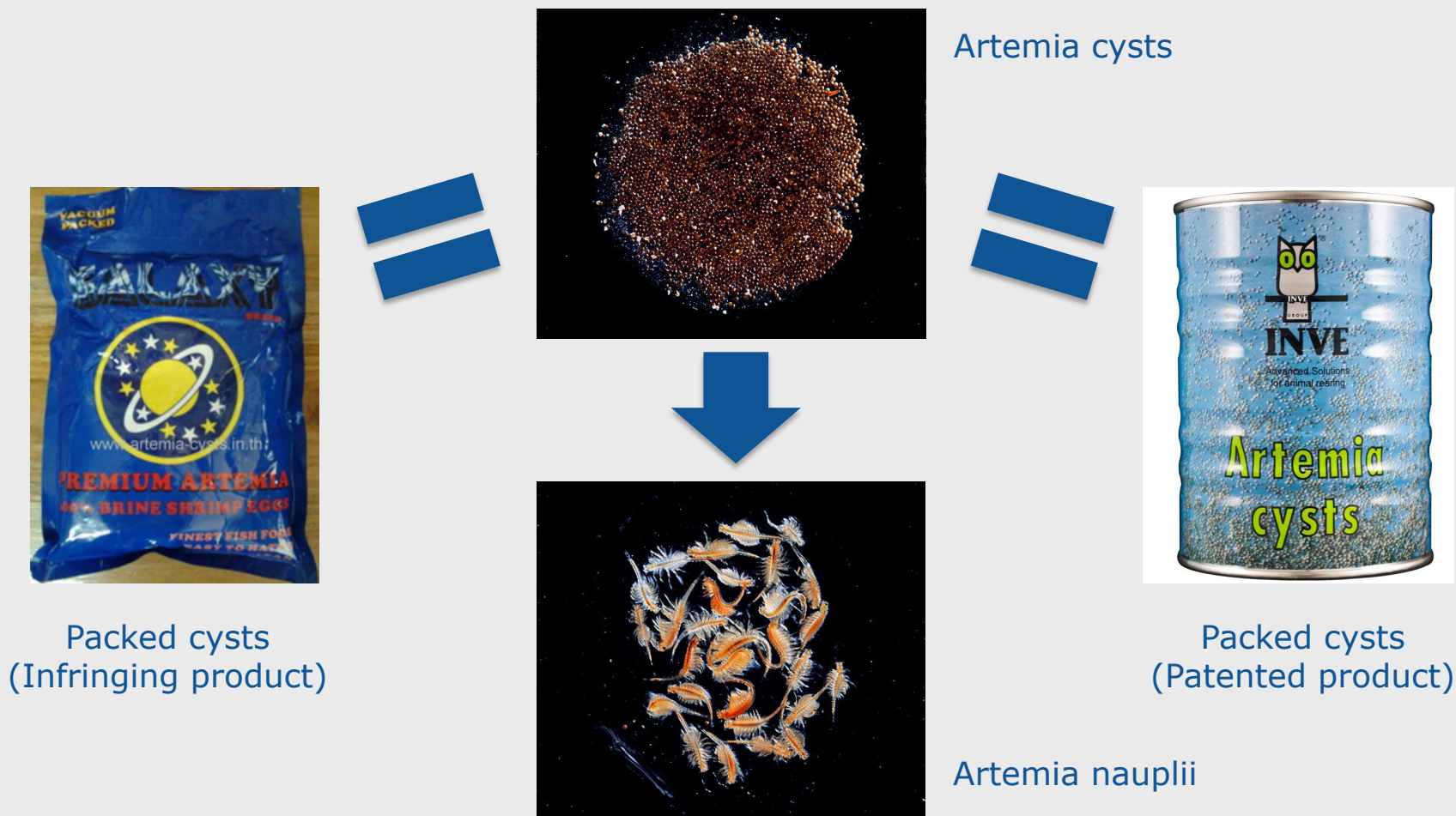
*INVE Technologies NV [BE] v. Marine-Tech International Co., Ltd. [TH]**

Background

- INVE filed 2 invention patent applications for “Method for producing Artemia nauplii and packaged cysts for use in that method” in Thailand in 2001, and were granted patents in 2014 and 2016
- In 2012, INVE found that Marine-Tech was infringing its patents by selling packaged cysts for increasing the hatching percentage of artemia nauplii (brine shrimp, which can be used to feed fish or shrimp), and competing unfairly in Thailand

*Source: www.tilleke.com, thefishsite.com, fishstockexchange.com

Case Example 1 – INVE



*Source: www.artemia-cysts.in.th, www.aquasonic.com.au, <https://pixels.com>

Case Example 1 – INVE

INVE Technologies NV [BE] v. Marine-Tech International Co., Ltd. [TH]*

Civil Suit

- In 2017, INVE filed a civil suit with the IP&IT Court for patent infringement against Marine-Tech
- In 2018, the IP&IT Court ruled that Marine-Tech had infringed INVE's patents, and granted a permanent injunction and Thailand's highest-ever award for damages in an IP case—over THB 106 million (approximately USD 3.5 million), plus interest from the date the complaint was filed

*Source: www.tilleke.com, thefishsite.com, fishstockexchange.com

Case Example 2 – INVE

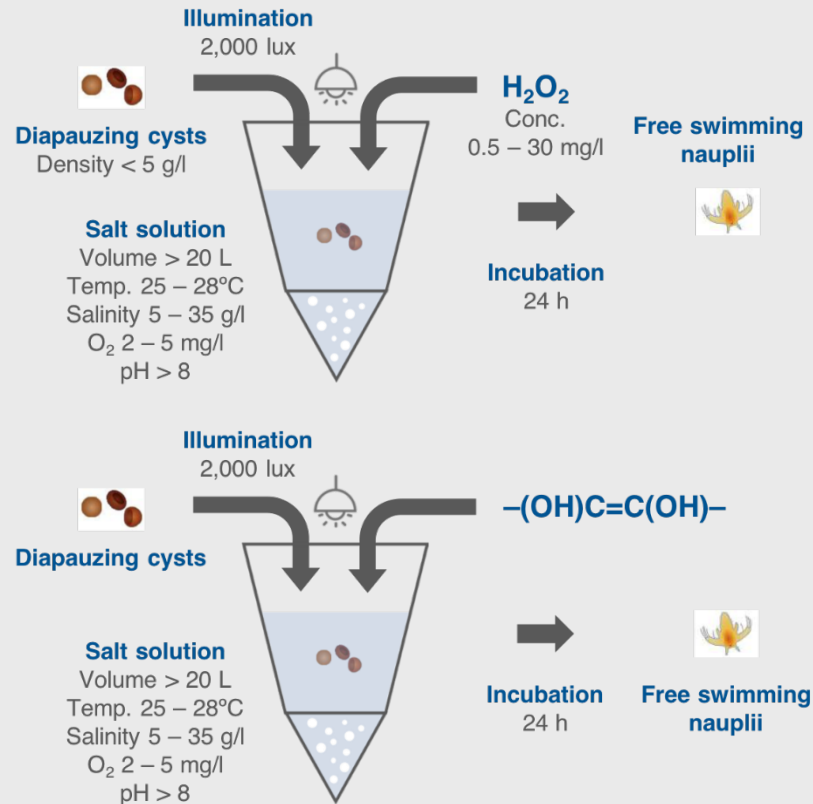
*INVE Technologies NV [BE] v. I&V Bio Co., Ltd. [TH]**

Background

- INVE filed 3 invention patent applications for “Method for producing Artemia nauplii and packaged cysts for use in that method” in Thailand in 2001 and 2006, and were granted patents in 2014 and 2016
- In 2017, INVE found that I&V Bio might be infringing its patents by using methods for producing Artemia nauplii (brine shrimp, which can be used to feed fish or shrimp) in Thailand

*Source: Ananda IP, I&V Bio

Case Example 2 – INVE



Patented methods



Allegedly infringing methods

*Source: Ananda IP, I&V Bio

Case Example 2 – INVE

INVE Technologies NV [BE] v. I&V Bio Co., Ltd. [TH]*

Civil Action

- In 2018, INVE submitted a petition for an Anton Piller Order for the search and seizure of evidence prior to the filing of a complaint
- The IP&IT Court accepted the petition, and INVE's lawyers along with execution officers served the court orders on I&V Bio to inspect the evidence at I&V Bio's hatchery

*Source: Ananda IP, I&V Bio

Case Example 2 – INVE

*INVE Technologies NV [BE] v. I&V Bio Co., Ltd. [TH]**

Civil Suit

- INVE then filed a civil suit with the IP&IT Court for patent infringement against I&V Bio
- In 2019, a settlement negotiation was conducted, and finally, both parties successfully entered into the Compromise Agreement

*Source: Ananda IP, I&V Bio

Case Example 3 – Honda

*Honda Motors Co., Ltd. [JP] v. Chinese Motorcycle Company**

Background

- Honda filed 5 patent applications for the designs of its Honda Wave 100S motorcycle in Thailand in 2005 and 2006, and were granted design patents in 2012
- In 2014, Honda found that a leading Chinese motorcycle company was manufacturing and selling two suspected infringing motorcycle models in Thailand under its own brand, and came to the conclusion that these two models were infringing all 5 of Honda's design patents

*Source: www.tilleke.com

Case Example 3 – Honda



Motorcycle
(Copied designs)



Motorcycle
(Copied designs)



Honda Wave 100s
(Patented designs)

*Source: www.tilleke.com, www.checkraka.com

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of the



Case Example 3 – Honda

*Honda Motors Co., Ltd. [JP] v. Chinese Motorcycle Company**

Civil Suit

- Honda then filed a civil suit with the IP&IT Court for patent infringement against the Chinese company
- In 2017, the IP&IT Court ruled that the Chinese company had infringed Honda's design patents and awarded Honda damages of more than THB 16 million (about USD 500,000), which is one of the highest ever awarded in a patent infringement lawsuit in Thailand

*Source: www.tilleke.com

Recent Developments

- Draft Amendment to Patent Act of Thailand
 - to improve especially application procedures in order to speed up the application process
- New E-Filing System of Thailand's DIP
 - for registering patents/petty patents/design patents, trademarks and also for recording copyrights
- New Patent Examination Guidelines
 - to update the examination of patent applications
 - to enhance communications between applicants/examiners
 - to provide an additional clarification on non-patentable subject matters

Recent Developments (cont'd)

- Increase in number of patent examiners
 - from 39 in 2015 to 143 in 2017
- Advancement in patent protection by the Court
 - highly effective court orders available under civil procedural rules, including preliminary injunctions and Anton Piller orders
 - substantial increases in compensation to cover damages sustained and legal fees

TIPS

- The applicant needs to retain a patent agent if he does not have a domicile/real business operations in Thailand.
- It is recommended to hire a patent agent due to complexity of patent applications
- A patent is necessary and has a value only when a product or process covered by the patent currently exists or will exist in the market
- Patent is territorial in nature. Businesses need to protect their invention through patent in the countries where they wish to operate

TIPS (cont'd)

- In some situations, maintaining your product/process as a trade secret is more appropriate than filing a patent application
- Applying for a petty patent is more appropriate than a patent for inventions that minor improvements are made to existing products or process
 - cheaper
 - simpler and faster
 - less invalidity grounds

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