Legal Framework for the Application, Examination, Grant, Cancellation and Appeals in relation to Patents in Thailand

JITTIMA SRITHAPORN
Director of Legal Office
Department of Intellectual Property
7 Intellectual Property Laws

<table>
<thead>
<tr>
<th>Thailand’s IP laws</th>
<th>Status</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Copyright Act B.E. 2537 (1994) amended (No. 2, 3) B.E. 2558 (2015), (No. 4) B.E. 2561 (2018)</td>
<td></td>
</tr>
<tr>
<td>• Geographical Indication Protection Act B.E. 2546 (2003)</td>
<td></td>
</tr>
<tr>
<td>• Optical Disc Production Act B.E. 2548 (2005)</td>
<td>Will be revoked</td>
</tr>
</tbody>
</table>
## International Treaties

<table>
<thead>
<tr>
<th>WIPO</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>Berne Convention</td>
<td>Since July 1931</td>
</tr>
<tr>
<td>WIPO Convention</td>
<td>Since December 1989</td>
</tr>
<tr>
<td>Paris Convention</td>
<td>Since May 2008</td>
</tr>
<tr>
<td>Patent Cooperation Treaty</td>
<td>Since September 2009</td>
</tr>
<tr>
<td></td>
<td>(Member No. 142nd, DIP PCT Office was opened on December 2009)</td>
</tr>
<tr>
<td>Madrid Protocol</td>
<td>Since August 2017</td>
</tr>
<tr>
<td></td>
<td>(Member No. 99th, DIP Madrid Office was opened on November 2017)</td>
</tr>
<tr>
<td>Marrakesh Treaty</td>
<td></td>
</tr>
<tr>
<td></td>
<td>(Member No. 51st Since April 2019)</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>WTO</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>TRIPS Agreement</td>
<td>Since January 1995</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Next Step</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>WIPO Copyright Treaty (WCT)</td>
<td></td>
</tr>
<tr>
<td>WIPO Performances and Phonograms Treaty (WPPT)</td>
<td></td>
</tr>
<tr>
<td>Hague Agreement</td>
<td></td>
</tr>
</tbody>
</table>
Overview of The Patent Act
Development of the Patent Act


   - Enforced from 30 SEP 2535 (1992)
   - To comply with WTO obligations

   - Enforced from 27 SEP 2542 (1999)
   - To add the protection of Petty Patent

The Draft Patent Act (No..) B.E. ....
1. The draft regarding patent / petty patent
   - 29 JAN 2019 the Cabinet approved principles of the draft
   - Status: Has been sent to the Council of State for consideration

2. The draft regarding design patent and the accession to the Hague Agreement
   - Status: published the draft on the DIP website and www.lawamendment.go.th for public hearing on 18th September – 18th October 2019.

According to the Thai Patent Act B.E. 2522, there are 3 types of Protection

1. **Invention Patent**
   - Novelty + Inventive step + industrial applicability
   - Duration: 20 yrs

2. **Design Patent**
   - Novelty + industrial applicability
   - Duration: 10 yrs

3. **Petty Patent**
   - Novelty + industrial applicability
   - Duration: 6 yrs initial + 2 yrs + 2 yrs (maximum of 10 yrs)
The following inventions are not protected under Patent Act:

(1) naturally occurring microorganisms and their components, animals, plants or extracts from animals or plants;
(2) scientific or mathematical rules or theories;
(3) computer programs;
(4) methods of diagnosis, treatment or cure of human and animal diseases;
(5) inventions contrary to public order, morality, health or welfare.
Patent vs Design Patent

"invention" means any innovation or invention which creates a new product or process, or any improvement of a known product or process.

"design" means any form or composition of lines or colors which gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft.
Example of Product Patent

“Chaipattana Aerator”

Patent No.3127, Granted: Feb 1993
Example of Design Patent

Honda Motor Co., Ltd.
Application No. 1502004252
Registration No. 60306 Issued on 26 Jan 2018
Registration Process
Patent Application

- **Filing Application**
- **Preliminary Examination**
- **Publication**
- **Substantive Examination**
- **Certificate of Registration**

**Possible to convert to petty patent application at this stage**

- **Opposition within 90 days**
- **Appeal to PT Board within 60 days**

- **File A petition to cancel an invalid patent**

**The CIPIT Court**
Design Patent Application

1. Filing Application
   - Preliminary Examination
     - Publication
       - Substantive Examination
         - Certificate of Registration

   - Publication
     - Opposition within 90 days

   - Substantive Examination
     - Appeal to PT Board within 60 days

   - Certificate of Registration

   - File a petition to cancel an invalid patent
     - The CIPIT Court
Petty Patent Application

- Filing Application
- Preliminary Examination
  - Certificate of Registration
    - Within 1 year: Request for substantive Examination in Sec. 65 bis
      - DIP (Revocation Order by PT Board)
    - over 1 year: File a petition to cancel an invalid patent
      - The CIPIT Court

Possible to convert to patent application at this stage
Comparison of Paris and PCT Route

**Paris**
- File local application (0 months)
- File applications abroad (12 months)
- Requirements for entry into the national phase within 30 months from the first filing date

**PCT**
- File local application (0 months)
- File PCT application (12 months)
- International search report & written opinion (16 months)
- International publication (18 months)
- (optional) File demand for International preliminary examination (22 months)
- (optional) International preliminary report on patentability (28 months)
- Enter national phase (30 months)

- File separate patent applications within 12 months from the first filing date
The Appeal Process
The Patent Appeal Process

DG’s order or decision

- No appeal or No right of appeal
  - Final

- Notice of appeal
  - PT subcommittees in the related fields
  - Decision by the PT board
  - Notified of the decision
  - Appeal to the CIPIT court
The Board of patents shall be composed of:

- Chairman
- Permanent Secretary of the Ministry of Commerce
- Qualified Members (not more than twelve & at least six members shall be from the private sectors)

- science, engineering, industry, industrial design, agriculture, pharmacy, economics and law

- Approved by the Cabinet (2-year term)
The Board shall have the following authorities and duties:

(1) to give advice or consultation to the Minister in issuing the Royal Decrees and Ministerial Regulations under this Act;
(2) to decide any appeal made against any order or decision of the Director-General on patents or petty patents;
(3) to act on other matters as stipulated in this Act;
(4) to consider any other matter on patents or petty patents as assigned by the Minister.
Statistics of Patent Application

![Bar chart showing the number of patent applications for Thai, Foreigner, Total, and Granted from 2014 to 2018. The data is presented for each year with the number of applications for each category. The chart includes a legend for Thai, Foreigner, Total, and Granted. The chart is dated July 2019.](image)

<table>
<thead>
<tr>
<th>Year</th>
<th>Thai</th>
<th>Foreigner</th>
<th>Total</th>
<th>Granted</th>
</tr>
</thead>
<tbody>
<tr>
<td>2018</td>
<td>2596</td>
<td>366</td>
<td>2962</td>
<td>1372</td>
</tr>
<tr>
<td>2017</td>
<td>2335</td>
<td>182</td>
<td>2517</td>
<td>1155</td>
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<tr>
<td>2016</td>
<td>2391</td>
<td>230</td>
<td>2621</td>
<td>1288</td>
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<tr>
<td>2015</td>
<td>2003</td>
<td>161</td>
<td>2164</td>
<td>1560</td>
</tr>
<tr>
<td>2014</td>
<td>1618</td>
<td>128</td>
<td>1746</td>
<td>828</td>
</tr>
</tbody>
</table>

July 2019
Trend of Patent Protection in Thailand

Statistics of Patent Application via Paris and PCT
Government Officials 329 persons

- Patent Examiner (99) - 30%
- Design Examiner (21) - 10%
- Trademark Examiner (65) - 13%
- Legal Officer (44) - 7%
- Administrator (34) - 20%
- Other Staff (66) - 10%
Number of Patent / Design Examiners

- **Total Patent Examiners**: 99
  - Experienced examiners: 24
  - New recruited examiners: 75

- **Total Design Examiners**: 21
  - Experienced examiners: 11
  - New recruited examiners: 10

*Status as of Aug 2018*
Legislative Development
The Draft Amendment Act regarding Patent / Petty patent
Objectives of the Patent Act Amendment

to streamline registration and administration procedures for patent and petty patent

to amend the compulsory licensing chapter according to the Article 31 bis of the TRIPS Agreement to allow exportation of pharmaceutical product to countries with no capacity and waive double remuneration if the remuneration is already paid by exporting country

to include international principles of disclosure requirement, prior informed consent, and mutual agreed terms principles related to genetic resources and traditional knowledge

to include PCT Chapter in the Patent Act
Areas of the Draft Amendment in order to streamline patent registration and administration procedures
Formality Examination

- Rights to File (Art. 10, 11, 14)
- Definitions of Invention (Art. 3)
  - Minimum documentation & understandable claims and specifications (Art. 17)
  - Move the examination of Patentable subject Matter (Art. 9) to substantive examination

1st Publication at 18 months from filing date or priority date (if any)

Indicate source + submit document relating to PIC/MATS if the invention in an application includes utilization of GRs and/or TK

Definitions of Invention (Art. 3)
Shorten pending period in the examination procedure

Publication 1st

Request for examination

Opposition

 Opposition

3rd Party Observations (during 1st – 2nd publication)

Within 90 days from 2nd publication

Filing

Within 90 days from publication

18 months from filing date / priority date

Years from filing date

18

Years from publication

35

(18 months from from publication)
Substantive Examination

**Definition of Invention (Art.3)**
- Patenable subject matter (Art.9)

**Novelty/Inventive step/Industrial applicable (Art.5)**

**Right to file (Art. 10/11/14)**

**First to File (Art.16)**

**Clarity (Art.17)**

**Unity (Art. 18/26)**

**2nd Publication (Intention to grant)**

File a request for substantive examination within 3 years from filing date (Art.29)
Current Patent Filing Procedures

- Filing Applications
  - Rights to file (Art.10/11/14/15)
  - First to file (Art.16)
  - Definition of Invention / Patentable subject Matter (Art.3,9)
  - Clarity (Art.17)

- Formality Examination
  - Examiner orders a correction of defects within 90 days (extendable for 90 + 30 days)
  - Abandoned

- Publication (no time limit)
  - File a request for substantive examination within 5 years from the date of publication

- Substantive Examination (Art.30)
  - Novelty/Inventive step/Industrial applicable (Art.5)
  - Patentable subject Matter (Art.9)
  - Rights to file (Art.10/11/14)
  - Unity (Art.18, 26)

- Patent Granted

- Pre-Grant opposition (Grounds Art 5/9/10/11/14 in charge by 1 examiner)
  - Appeal to the Patent Committee
  - Appeal to the IPIT court

Examiner orders a correction within 90 days (extendable for 90 + 30 days) → Abandoned

Legal office
(as amended of March 20, 2019)

For reference purpose
Traditional knowledge

Knowledge, practices, representations, expressions, knowledge, skills – as well as the instruments, objects, artefacts and cultural spaces associated therewith – that communities, groups and, in some cases, individuals recognize as part of their cultural heritage. This intangible cultural heritage, transmitted from generation to generation, is constantly recreated by communities and groups in response to their environment, their interaction with nature and their history, and provides them with a sense of identity and continuity, thus promoting respect for cultural diversity and human creativity.
Defensive Protection of GRs/TK in the Draft Amendment

**Filing Application**
Where the invention in an application includes utilization of GRs and/or TK
- Indicate the source
- Submit document relating to PIC/MATS

**Formality Examination**

**Publication**

**Substantive Examination**

**Patent Grant**

**Non/Wrongful disclose/or false statement**

**Administrative penalty**
Other Important Amendments

- Amend prior art conditions to meet international standard such as including disclosure in documents outside the country.
- Use recording of the licensing procedure instead of registering with the DIP.
- Allow correction of the granted patent with minor irregularities.
- Amend petty patent registration procedure to enhance efficiency.
- Allow any person to request for substantive examination after the grant of the petty patent.
- Amend fees schedule; increases filing fees, reduces fees for SMEs / startup / e-filing, discontinues publication fee.
The Draft Amendment Act regarding Design Patent and the accession to the Hague Agreement
Objectives of the Patent Act Amendment

- to streamline registration and administration procedures for patents for designs.
- to prepare for the accession of Thailand to the Hague Agreement Concerning the International Registration of Industrial Designs.
Areas of the Draft Amendment in order to streamline Design Patent registration and administration procedures

1. Filing the Application
2. Formality Examination
3. Substantive Examination
4. Publication
5. Patent Grant
Hague Agreement is the system for international registration of industrial designs, established by WIPO. It offers the possibility of obtaining protection for industrial designs in several Contracting Parties by means of a single international application.

Two Acts of the Hague Agreement are currently in operation:
- the Geneva Act, which was adopted on July 2, 1999.
- the Hague Act, which was adopted on November 28, 1960.

There are 70 contracting parties (Status on October 7, 2019 From http://www.wipo.int/hague/en/)
Preparation for Accessing to Hague Agreement

- Process Analysis
- Legislative Change
- Procedural Change
- IT System Change
- Community Change
Other Important Amendments

- Allow Partial Designs protection
- Amend prior art conditions to meet international standard such as including a design which was widely known or used outside the country
- Allow an applicant to request for separation an application into a number of applications
- Extend the period of protection from 10 years to 15 years
- Add a provision for deferment of publication
- Amend fees schedule such as increases filing fees
For more information
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