

# THE NEED FOR AN ALTERNATIVE TO THE PATENT ACT

**I**n a short span of four years from 2004-08, the number of mobile phone users in Thailand rose from about 16.5 million to 31.8 million. In 2009 it was estimated that there were 33 million users. Interestingly, there were 65.8 million numbers sold. This means that people had more than one phone. In 2010 total users are expected to rise to 35 million (50% of the total population) with 72 million numbers sold.” — Pichai Chuensuksawadi, editor-in-chief of Post Publishing Plc, in a speech at the fourth Asean-China Media Co-operation Seminar in Beijing in March.

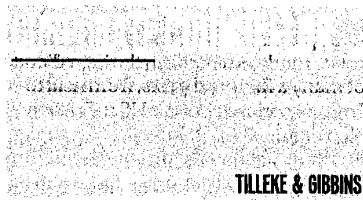
The rapid proliferation of mobile phones across the kingdom demonstrates the vital importance of technology in the lives of Thais — from metropolitan Bangkok to the rural provinces. With mobile companies launching new designs every month, it is crucial to have a speedy means of protecting new designs. Currently, there is no form of design protection in sync with the accelerated time frames for production and launch demanded by trendy, tech-savvy consumers.

A design patent allows a creator to protect non-functional, ornamental aspects of a device or machine, such as the notable way the lines of a phone’s body are tapered. The Patent Act of 1979, as amended in 1992 and 1999, explicitly provides rules and procedures to protect patents. Exercising that protection, however, has proved difficult or impossible for certain products, given the backlog of patent applications. While it takes about a month for a design patent to be registered in the European Community, at present a creator must wait three or four years to register one in Thailand.

Even though Thailand recently became a member of the Patent Cooperation Treaty (PCT), this does not ensure the patent registration procedure will be more expeditious. The PCT only makes it possible to seek patent protection for an invention simultaneously in many countries by filing an “international” application and provides a unified procedure for filing applications. It does not make Thailand process applications more quickly.

Efforts to expedite the patent application process must be complemented by other means of protecting design patents. Thailand should consider amending its Trade Competition Act (TCA) or passing other legislation to create a cause of action against infringement independent from patent ownership. Thailand might learn from studying the enforcement options in the unfair competition laws implemented by its Asian neighbours.

**China:** In his study entitled “The Evolution of Competition Law in East Asia, Dr Ping Lin, head of the economics department at Lingnan University in Hong Kong”, wrote that the 1993 Unfair Competition Act, China’s first competition law, was an important move



toward preventing anti-competitive practices and establishing a competition policy. The law’s purpose, as stated in its Article 1, is to “safeguard the healthy development of the socialist market economy, encourage and protect fair competition, stop acts of unfair competition and defend the lawful rights and interests of operators and consumers”. Article 5 offers protection against trademark infringement and forbids the copying of trademarks and certificates of quality and origin as well as the use of similar brand identification such as brand names, packaging or designs that might confuse consumers.

**Japan:** Article 2 (1) (iii) of the Unfair Competition Prevention Act prohibits selling, distributing, displaying for the purpose of selling or distributing, exporting or importing goods that imitate the configuration of another person’s goods — unless the configuration is essential in guaranteeing the function of authorised goods. This article allows the creators of external and internal shapes of goods and the pattern, colour, gloss and texture combined with such shapes to file a civil suit against an infringer of the design even without having registered a design patent. The statute of limitations for such protection runs three years from the date that the owner first sells the products in Japan.

**Thailand:** Thailand has no separate unfair competition law, and the TCA, enacted in 1999 to replace the 1979 Anti-Monopoly Act, offers an enhancement to business competition and attempts to improve enforcement mechanisms but does not cover intellectual property matters. If Thailand’s TCA were amended to allow a cause of action as in Japan, technology- and trend-driven companies that must constantly evolve to preserve their market position could more easily protect design innovations.

An independent cause of action against design infringement would provide a term of protection in Thailand against the replication of designs that are pending patent, such as mobile phone designs. In addition, patent owners would enjoy another enforcement option, allowing modern design patents more protection against imitators. While drafting and enacting such a law would pose a difficult challenge, the need for a practical enforcement alternative to the Patent Act should provide the motivation to succeed.

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