

THAILAND

Inventive Step Requirement: Lessons from Recent Thai Cases

In seeking a patent, applicants not only have to define the novelty of an invention but also have to indicate that such invention possesses an inventive step. Further, the patent application must thoroughly document the inventive step in the disclosure and claims. Failure to meet these criteria will lead to the dismissal of the application. The cases described below provide some important insights on how to avoid rejection of a Thai patent application due to inadequate attention to the requirements for inventive step.

Lack of Inventive Step

A typical case in which an applicant encountered an inventive step rejection was Thai Application No. 0001005055 for an invention entitled "Metal Bar for Towing Vehicle." The invention comprised three metal tubes telescopically connected to one another in a manner that the tube with shorter diameter was movable inside the tube with longer diameter when it was not in use. When in use, the tubes were to be pulled out from one another to a satisfactory length, and bolts were used for attaching the tubes to one another at the connecting points, which could be taken off when finished using the invention.

The subject matters and structure of the invention in which the tubes were movable inside one another and were adjustable in length had already been disclosed in prior art. Specifically, US Patent No. 3,797,846 for an invention entitled "Tow Bar" disclosed a clamping bar including a front tube telescopically fitted at an adjustable position within a rear tube by means of a plurality of spaced apertures through the front end of the rear tube and the rear end of the front tube, with a bolt securely fitted between the tubes during use by a wing nut.

The difference between the prior art and the Thai application was the extent that the tubes of the applicant's invention were movable inside one another to facilitate its storage, whereas the tubes of the prior art were in a fixed position. However, both the Director-General of the Department of Intellectual Property and the Board of Trademarks found that the invention's subject matter and structure had been disclosed in

the prior art and were thus obvious to a person skilled in the art. The difference between the prior art and this application was not sufficient to signify that the invention involved an inventive step.

In brief, this case reveals that the application succeeded in defining that the invention was different from the prior art but failed in indicating that the invention possessed an inventive step. Describing only that an invention is different from others is not sufficient to show that the invention has an inventive step.

Inventive Step Not Fully Described

A different example is provided by Thai Application No. 0001002063 for an invention entitled "Amorphous silicon-type solar water heater and electric generator." The invention was described as a solar cell that could produce both hot water and electricity at the same time. It comprised a solar receiver, water pipeline system, and hot water container wherein the water pipeline system was located under the solar receiver and connected with the hot water container to form a continuous water circulation system. The special characteristic of the invention was that the solar receiver was an amorphous silicon-type solar cell coated upon an aluminum sheet or other heat-induced metals.

When compared with the relevant prior art related to solar water heaters – namely US Patent No. 4,240,405 and US Patent No. 4,084,578 – the subject matter of the Thai application had already been disclosed in the prior art only in regard to the positioning and features of the water circulation system. Thus, the special characteristic described above could be defined as an inventive step. However, since the applicant failed to indicate the special characteristic in the claims, the Director-General ruled that the invention had no inventive step.

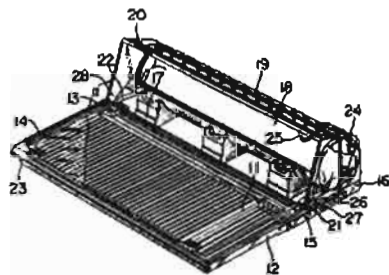
The applicant subsequently filed an appeal to the Board of Patents. The Board considered that the invention indeed involved an inventive step as it was indicated in the disclosure. The Board recommended that the applicant should revise the patent application by indicating the inventive step in the claims. This was accomplished by amending Claim 1 to include the fact that the solar receiver was an amorphous silicon-type solar cell coated upon an aluminum sheet or other heat-induced metals.

This second case reveals that the

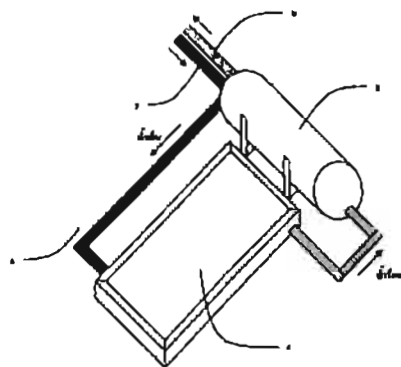


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inventive step should be clearly described and explained not only in one section of the application (e.g. the disclosure) but in all sections which require such description (e.g. objective, disclosure, claims, etc.). In other words, the inventive step must be consistently addressed throughout the application as a whole. All applicants for invention patents should be mindful of this important lesson.



US Patent No. 4,084,578



Thai Application No. 0001002063

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