

THAILAND

Case Studies Reveal Pitfalls in Patent Filings

When an applicant lacks a true understanding of the intended purpose of the patent system, has little or no experience in drafting a specification, and is not knowledgeable in patent laws and regulations, the chances his applications may be rejected based on avoidable grounds are high. The following applications demonstrate the dangers inherent in a weak grasp of applicable patent laws and deadlines.

Poorly Drafted Claims

- Selected claims of Thai Patent Application No. 081472 filed in April 2003 for an invention entitled "Heat Energy from Direct Current Electric Coil for a Multi-Purpose World"

Claim 1. I hereby request protection in the rights to ownership and possession of the title of the invention.

Claim 2. The detailed description of the invention in its entirety in accordance with what is specified under trademark law and patent law in the amended Thai Patent Act B.E. 2522, particularly the description that explains the technical aspect of the work that is new according to Section 5 (2) combined with Section 7.

- A portion of the first claim of Thai Patent Application No. 085060 filed in September 2003 for an invention entitled "Energy Saving System"

Claim 1 [as excerpted]. Components for building a mechanical energy generating machine and an electricity consuming machine system that can generate its own electricity which makes up the "Energy Saving System" that can help save energy. This will improve the economy, reduce costs by solving the technical work so that it is improved over work that has long been in existence according to Section 5(2) and combined with Section 7. Components include the following . . .

The Director-General of the Department of Intellectual Property (DIP) rejected both applications on the grounds that they were not in accordance with Section 17 of the Thai Patent Act and Ministerial Regulation 21, clauses 3 and 4, which lay out the parts that must be contained in a patent specification and the requirements that these parts must

meet. In the first application, the specification described only the use of batteries to generate heat from a direct current electric coil, which heat was then blown by a fan to create pressure that would push the piston in a cylinder to generate power for use in various kinds of work. In the second application, the applicants described the use of power from different sources in various ways. The characteristics and structure of the inventions were not clearly explained in the applications.

The applicants appealed to the Board of Patents, asserting that the applications were in accordance with Section 17 and that the grounds on which the applications were rejected only called for the issuance of an Official Action so that appropriate amendments to the specifications could be filed. The Board affirmed the decisions of the Director-General in both cases, citing that the disclosures were not enabling as they described ideas that had not yet been reduced to practice, and the claims failed to specify what the applicants wanted to prevent others from infringing. Therefore, provided that there really is a patentable invention, it is in the applicant's best interests to prepare a specification that follows good drafting practices.

Miscalculating Deadlines

Miscalculating deadlines is another mistake that can prove disastrous for uninformed applicants, as the case of Design Patent Application No. 0302003090 for "Electric Wire Support Rail" shows. In an order issued on November 9, 2006, the Director-General of the DIP rejected the application on the grounds that the design was similar to an existing work featured in US Patent No. 289,633 patented on May 5, 1987. The decision was based on Section 57(4) of the Patent Act, which states that a design is not new if it nearly resembles a design that was widely known or used by others in Thailand before the filing of the application, or it has been disclosed in this or a foreign country, or it has already been published.

Under Section 72 of the Act, applicants have a right to file an appeal within 60 days from the date the rejection notice is received; otherwise, the rejection order stands. As the applicant received the rejection notice on November 18, 2006, the deadline to submit an appeal was thus January 17, 2007. Unfortunately, the applicant submitted



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the appeal on January 18, 2007, one day past the deadline, so the appeal was considered void and the Board left the rejection order stand. The applicant thereby lost the chance of knowing whether his arguments would have been sufficiently convincing to overturn the Director-General's rejection. This case serves to highlight the fact that the deadline for filing an appeal is not extendable in Thailand.

The Board of Patents decided on 37 appeal cases between 2007 and 2008. Of these, two cases involved Section 17 and another two were deemed void because the appeal was not submitted prior to the deadline.

To avoid the scenarios described herein, it would be a prudent move on the part of the applicants to familiarize themselves with the patent laws of the jurisdictions in which they seek patent protection. They can learn from the many available resources and from those with experience in the field in order to steer clear of avoidable pitfalls.

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