GLOBAL PATENT EXAMINATION STILL CONCEPTUALIZED

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The twenty-first century is an era of rapid change driven by human creativity in developing new technology. A patent is a means to protect the fruits of this technological revolution. A patent cannot claim an exclusive right for something that previously exists, nor can it claim something obvious. To determine these conditions, patent examination involves looking for *prior art:* earlier publications that show the technology is not new or is obvious. Prior art is interpreted differently in different jurisdictions. For example, in the United States, the first-to-invent system prevails. Consequently, there is a one-year grace period during which publications by the inventor will not undermine patentability. Of course, this principle has inevitable consequences in countries which do not apply the same principle, where prior art is determined from the filing date of the patent.

Since Thailand uses a first-to-file system, no matter which invention is firstly developed, a patent will only be granted to the party who files a patent application first. Therefore, the filing date of the patent is absolutely critical. If the applicant files a patent application in a foreign country, he is entitled to file the application in Thailand within twelve months from such first foreign filing date. Then, the date of the first application in the foreign country is treated as the filing date in Thailand based on a priority claim. Any publication disclosed between the filing date in the first country and in Thailand will not be counted as prior art of the application. However, if the applicant failed to claim the priority date in the first country or does not have a valid right to do so, the filing date would be deemed to be the date of the application filed in Thailand and any publication during such an interim period would immediately be treated as the prior art.

In general, an examination result obtained in one country should be deemed as valid in other countries for the same technology. Many countries have included this principle in their patent laws. In this regard, Section 25 of the Thai Patent Act states that, to facilitate the examination of a patent application, an examination done by any foreign or international patent office or organization may be treated as having been done by the competent officer. However, the same invention has to go through substantive examination separately on a country-by-country basis. Each country has a different approach to what the examination entails and whether or not the requirements of patentability have been met. Therefore, an application which has already been granted in another country may not necessarily be patentable in Thailand. The case described below provides an illustration of how country-by-country examination differences can impact a patent application.

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An application for an invention patent, designated as Application No. 031087, entitled "Pipe of polyethylene having improved mechanical properties" was filed in Thailand on April 26, 1996, without claiming priority to the first filing date, April 28, 1995, in Germany. According to this application, high-strength pipe of ethylene polymer can be obtained if the ethylene polymer material can be prepared according to the method disclosed in WO 91/18934. As a result of the lack of priority claim, any invention that was disclosed before April 26, 1996 would be considered as prior art of this application.

On May 27, 1998, three parties filed oppositions against this application based on different technical and legal grounds focusing on the argument that the claim and the detailed description are not consistent, as well as the contentions that the application lacks enablement of disclosure, novelty, and inventiveness.

The Director-General ruled that the relevant prior art did not disclose the preparation of polyethylene having a density and a melt flow index as specified in the application and/or the production of a pipe made from polyethylene having said properties. However, the relevant prior art showed that the improved mechanical properties of the pipe depend on the properties of polyethylene material, not on the preparation process thereof. The Director-General thus ruled that the invention was obvious to a person skilled in the art and has no inventiveness.

On April 5, 2006, the applicant filed an appeal petition with the Board of Patents against the Director-General's decision by explaining that the invention related not only to the polymer compositions, but also to "pipe" having the improved mechanical properties. The knowledge of combination between low molecular weight of homopolymer and high molecular weight of copolymer had never been disclosed. There was no prior art demonstrating the improvement of mechanical resistance, especially in terms of stress cracking stability. Additionally, since this invention had been examined and granted a patent in the U.S., the American application was deemed to have inventiveness.

The Board of Patents weighed these arguments and ultimately ruled on the same ground as the Director-General's decision that the invention was not widely known or used in Thailand, or not described in a document or printed publication in Thailand or a foreign country. Nevertheless, this invention was obvious to a person ordinarily skilled in the subject. As such, the Board of Patents held that the invention lacked inventiveness and was not patentable.

In filing an application in Thailand or any other countries, a patent owner should be aware that a patent which has been granted in the U.S., for example, does not provide absolute assurance that an equivalent application for the same patent will be granted in another country. Not only the rules regarding prior art, but also the examination system itself can differ and lead to discrepancies in the examination results. It is therefore necessary to analyze the patent application according to each country's patent examination system in order to avoid the possibility of rejection of a patent already granted in another country. ◆