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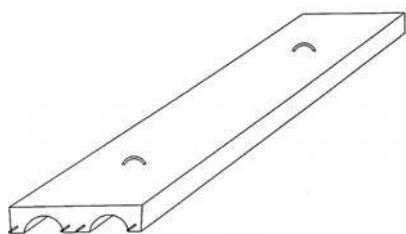
INVENTION VS DESIGN: SUPREME COURT RULES ON IMPROPER PATENT PROTECTION

Seeking suitable protection in Thailand over new products can become confusing at times, particularly for companies that successfully develop new and unique designs possessing innovative functionality. Under the Thai patent law, a new product involving both distinctive appearance and inventive utility may be patented separately as both an invention patent and a design patent.

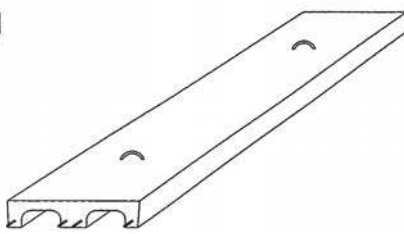
As a best practice, any industrial product with functional features should be first and foremost protected as an invention patent. Despite this, some companies may consider protecting their unique products by filing only a design patent, a simpler procedure which they expect will yield quicker results. However, as the case described below shows, patenting industrial products that possess technical functionality as design patents can have unexpected consequences.

Background

The plaintiff, a well-known Thai construction company, successfully developed a pre-stressed concrete plank with two different designs—one with a rounded bottom and one with a rounded-rectangle bottom. Designed for concrete flooring systems in building construction, the products are normally used by placing a number of them together side by side and ultimately topping them with concrete to form a finished concrete floor. The plank products with the two new designs were filed for protection as design patents in March 2001.



Plank with rounded bottom design



Plank with rounded-rectangle bottom design

In 2004, the Department of Intellectual Property (DIP) dismissed the plaintiff's two design patent applications, reasoning that the two designs lacked novelty and were considerably similar to prior art. The plaintiff appealed the DIP's decision to the Central Intellectual Property and International Trade Court (IP&IT Court). The IP&IT Court dismissed the plaintiff's case, ruling that the products in question were in fact primarily influenced by their technical function, which is not the true intention of design patent law. The plaintiff then appealed the IP&IT Court's decision to the Supreme Court.

Supreme Court Decision

In a 2009 ruling (Supreme Court Case 9733/2552), the Supreme Court affirmed the IP&IT Court decision to dismiss the plaintiff's two applications. The Court viewed that a product deserving to be protected as a design patent must have a distinctive visual appearance. A product whose innovative technical function cannot be seen once the product is in place in its intended setting is not eligible for protection as a design patent.

The plaintiff's products were found to be novel in that they provide a better result than the prior art in their concave design at the bottom of the concrete plank. The new rounded and rounded-rectangle bottom designs help improve the ability to absorb more weight and provide more strength to the plank compared to a common plank with a flat bottom. Nevertheless, when the products are topped with concrete to make a finished concrete floor, it is not possible to see the new concave designs which the plaintiff seeks to protect. The adaptation and improvement of the concrete plank is functional, not an ornamental aspect of the products as required by design patent law. In order to protect these products, the plaintiff should have sought protection as an invention patent, rather than as a design.

In making this decision, the Supreme Court essentially found that the plaintiff made the wrong decision when selecting the type of patent protection it would seek. The Court recognized that this issue was not raised by the parties to the case, but the Court held that it had the authority to consider this issue under Section 142 of the Civil Procedure Code. This section states that the Court can render judgment only on the claims made by the parties to a case, except in certain well-defined circumstances. Under Section 142 subsection 5, one such circumstance arises where a point of law involving public order could have been raised by the parties.

Invoking this public order stipulation, the Court held that if the plaintiff were granted the exclusive right over the products at issue, the plaintiff would be able to initiate criminal or civil actions against anyone who uses these designs. This would create the possibility that a third party could face criminal prosecution for violating the patent, despite the fact that the patent protection itself was improper as it should have been sought as an invention, not a design. As this potential outcome would be contrary to public order, the Court dismissed the plaintiff's case.

Consequences

Choosing the wrong type of patent when the application is submitted can jeopardize patent protection, regardless of the inherent patentability of the product. Although the two new plank products were not obvious to a person

having ordinary skill in business construction, their technical function features failed to be protected by the proper invention patent. Having made this initial error in filing, the plaintiff of the case is now barred from filing a separate application for an invention patent for these products, as they have already been disclosed to the public. This reinforces the need for companies to carefully consider the nature of the improvement provided by their product and the level of functionality that it involves. By weighing these factors at the filing stage, applicants can ensure that they are able to obtain exclusive rights over their products and prevent others from using them in the market. 🐼