

## Q&A: PATENTS IN THAILAND

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### **1. What are the procedures for filing patent applications in your jurisdiction?**

In the case of an invention application, direct filing of a new patent application in Thailand by the Paris Convention route allows all foreign applicants entitled to national treatment to be able to claim priority rights within 12 months of the first foreign filing date. If priority is not claimed, the application can be directly filed in Thailand, provided that no more than 18 months have passed from the first filing date and the application has not yet been published or laid open.

Applications that enter Thailand by the PCT route have a time limit of 30 months from the earliest priority date for entering the PCT national phase in Thailand. This term applies irrespective of whether the demand for an international preliminary examination, under Chapter II of the PCT was filed. For the national phase entry in Thailand, the official language is Thai. Furthermore, the Thai translation of the application text must be submitted within 30 months of the first filing date of the application. The 20-year patent term of protection in Thailand starts from the filing date of the PCT international application.

### **2. How long will it take to register a patent and what are the standard costs?**

The average length of time for a patent application to be granted ranges from five to seven years from the Thai filing date. However, very few patent applications related to the pharmaceutical field have been granted in Thailand, since inventions in the field of medicine are highly complex.

The estimated cost for the entire process of filing a patent application to the granting of the patent is \$2,000. This does not include any advice given before the filing, drafting, revision, translation, or certification of any document, or any amendments to official documents.

### **3. What is the scope of patent protection in your jurisdiction?**

In order for the invention to be patentable, the requirements specified in the Thai Patent Act BE 2522 (1979), as amended by Patent Act (No 2) BE 2535 (1992) and Patent Act (No 3) BE 2542 (1999), are that the invention must be novel, inventive, and applicable in industry. Patent protection will be granted to claims that cover new products and processes.

In the case of product patents, Section 36 of the Patent Act states that the patent owner shall have sole rights to produce, use, sell, possess for sale, offer for sale, or import the patented products into Thailand.

In the case of process patents, the patent holder has the sole right to use the process stated in the patent and to produce, use, sell, possess for sale, offer for sale, or import into Thailand, products that are made by the application of the patented process.

### **4. Is there substantive examination and if so what is typically the nature and extent of correspondence with the patent examiner?**

A request for a substantive examination of a patent application is obligatory for all applicants, regardless of their nationality, and such a request must be filed within five years of the date of publication.

In the substantive examination stage, the examination of the Thai case is actually based on a patent which is granted in a corresponding application that was filed in an examining country. The entire copy of the patent and any office action(s) that have been issued for the corresponding application must be submitted to the Thai Patent Office, as the examination of the Thai case will actually be started upon submission of these documents.

Furthermore, it is necessary to amend the claims in the Thai application to follow those granted in a corresponding patent. Since the granted claims have already been deemed to be novel and inventive, the Thai examiner will be more willing to grant a patent for the Thai application, provided the claims are not contrary to Thai patent law.

### **5. What are the requirements on obviousness and inventive step?**

Section 7 of Thailand's Patent Act broadly prescribes that an invention shall be deemed to involve an inventive step if it is not obvious to a person ordinarily skilled in the art. According to the Examiner's Handbook on Examinations of Patent and Petty Patent Applications (2006), examiners should consult the search report that was issued in a corresponding application, if available, when considering whether an invention possesses an inventive step. Other criteria include, among others, considering whether the invention gives surprising results, leads to a reduction in costs, or possesses advantages over the prior art.

### **6. What types of inventions or ideas can be patented? Are there any notable or unusual exceptions?**

Thailand's Patent Act provides the definition of an invention as any discovery, or invention, resulting in a new product or process, or any improvement of a product or process. According to Section 5 of the Patent Act, a patent may be granted for an invention that is new, involves an inventive step, and is capable of industrial application.

However, certain inventions, as prescribed under Section 9, are not capable of being protected by a patent, such as: microorganisms, which naturally exist and their components; animals, plants, or extracts from animals or plants; scientific and mathematical rules and theories; computer programs; methods for diagnosing, treating, or curing human or animal diseases; and inventions which are contrary to public order or morality, public health, or welfare.

### **7. How can you appeal a denied application? Are there any time limits on making an appeal?**

In accordance with the Thai Patent Act, an appeal for a denied application is permitted. Such an appeal must be filed with the Board of Patents within 60 days upon receipt of a notification rejecting the application. If the Board affirms the rejection decision, an appeal of the denied application can be filed with Thailand's Central Intellectual Property and International Trade Court (IP&IT Court) within 60 days of receiving notification of the Board's decision.

### **8. Is it possible to file pre-grant or post-grant oppositions and if so how do these work?**

Only a pre-grant opposition is available under the Patent Act, and it must be filed within 90 days of the date that the application has been published in the Official Patent Gazette. However, after a patent has been granted, a cancellation of the patent can be filed with the IP&IT Court.

### **9. What is the process for modifying patents?**

A voluntary amendment to the patent application can be filed at any time before the publication of the application, provided it does not enlarge the scope of the invention as originally filed. After the application has been published and a request for a substantive examination has been filed, the Thai application is normally revised to follow the corresponding granted patent, as prescribed by Thai patent law. However, once the Thai patent has been granted, no amendment can be made, unless permitted by the director-general of Thailand's Department of Intellectual Property.

### **10. Is there anything else about the filing system in your jurisdiction that patentees should be aware of?**

The following key features should be taken into account by the patent owner at the time of filing:

An applicant for a petty patent, which is similar to a utility model in some jurisdictions, or a patent, is entitled to change the type of right applied for in the following cases:

- For a petty patent application, the type of right can be changed from a petty patent to a patent, before the registration of an invention and the issuance of a petty patent.
- For a patent application, the type of right can be changed from a patent to a petty patent, before the publication of any opposition that has been filed against a patent application.

A petty patent application can seek patent protection for no more than 10 claims.

A voluntary divisional application cannot be filed. Filing a divisional application is only possible when the examiner rejects the unity of the invention and instructs the applicant to file a divisional application. Such rejections and instructions will occur in the substantive examination stage.

Thailand has recently become a member of the PCT. In order to comply with Thai patent law, a national phase application, along with the Thai translation of the application text, must be submitted within the 30-month deadline, starting from the earliest filing date.

### **11. How can patents be enforced in your jurisdiction? What options do patent owners have?**

Both civil and criminal action may be taken against an infringer of a Thai registered patent, and preliminary relief is also available.

#### *Civil action*

In a civil action, the patent owner can request a permanent injunction against the infringer, forcing them to cease manufacturing and selling the infringing product. The patent owner can also request that the court award compensation, based on actual proven damages.

#### *Criminal action*

Criminal action is begun either by filing a criminal complaint with the police or by filing a private criminal suit with the IP&IT Court. Under the Patent Act, any person who produces, uses, sells, possesses for sale, offers for sale, or imports the patented product into the Kingdom of Thailand, shall be punishable with imprisonment of up to one year and/or a fine of not more than Bt200,000 (\$6,670).

#### *Public criminal action*

A public criminal action can be begun by filing a complaint to the police inquiry officer. After the filing of the complaint, and once the inquiry officer has been presented with substantial evidence of the infringement, the police will conduct a raid action whereby the product infringing the patent will be seized. After the raid action, the police inquiry officer has to conclude the case by providing an opinion on whether the case should be prosecuted further. This report will be presented to the public prosecutor, who will determine whether to prosecute the case based on the evidence provided by the police inquiry officer.

#### *Private criminal action*

Separate from the public criminal action, the criminal law system of Thailand allows the injured person – the patent owner – to start criminal action, without relying on the state's resources. A private criminal action is started by filing a direct complaint to the IP&IT Court. However, due to the absence of an investigation and consideration by a state agency and the prosecutor, the criminal procedure law requires that the injured party, who begins such private criminal action, prove that it has a *prima facie* case before the court accepts the case. If the injured person fails to prove a *prima facie* case, the case would be dismissed.

#### *Preliminary relief*

When faced with an infringement, the patent owner may pursue civil preliminary relief to immediately stop the infringing activity. This includes an *ex parte* preliminary injunction and an Anton Piller order for the search and seizure of evidence relating to the infringement.

#### *Preliminary injunction*

A preliminary injunction can be applied for before filing a lawsuit against the infringer. The patent owner must be able to provide the court with proof of ownership of the patent, evidence of infringement, and sufficient reasons or justifications for the preliminary injunction. Such reasons include irreparable harm which cannot be addressed by monetary compensation or any other form of indemnity. The court's decision on the issuance of a preliminary injunction will take into account the nature and extent of damages that both parties may incur if the injunction is granted, and vice versa, and the difficulty of enforcing the judgment against the alleged infringer.

#### *Anton Piller order*

In addition to a preliminary injunction, the patent owner may also seek an Anton Piller order to seize evidence relating to the infringement, if an emergency situation exists. The Anton Piller order is designed to preserve infringement evidence for use at a later date when a lawsuit is launched by the patent owner. To support a motion for an Anton Piller order, the patent owner must be able to show that an emergency situation exists in which, if the other party or a third party involved is notified beforehand, the evidence of such infringement would be damaged, lost, destroyed, or otherwise become difficult to adduce at a later stage.

### **12. Are there some types of patents that are harder to enforce than others?**

Generally, it is more difficult to enforce a process patent than a product patent.

### **13. Where does the burden of proof lie for infringement allegations?**

The burden of proof involving an alleged IP infringement normally lies with the plaintiff, who will have to discharge the burden of proof for claims set out in the complaint. In a criminal case, the plaintiff will have to prove beyond reasonable doubt that the defendant has committed the offence, as claimed. In a civil case, the court will decide the matter in accordance with the balance of probabilities, and the party that presents the most convincing evidence will win.

In cases involving claims relating to an infringement of a process patent, the burden of proof is generally reversed. In such cases, the patent owner is merely required to prove that there are similar or identical end products, and the defendant will then be forced to prove that it used a different process from the patented process.

#### **14. What are the typical remedy options for infringement? How are damages awards calculated?**

Permanent injunction and damages are available remedies in a civil case, while criminal liability is available in a criminal case. According to the Patent Act, the right of a patent owner to receive compensation in a civil action for losses suffered as a result of infringement would be considered based on the seriousness of the damages, the loss of benefits, and the necessary expenses incurred in enforcing the rights of the patent owner. Interim relief in the form of a preventive injunction and evidence preservation orders or Anton Piller are available.

#### **15. How can you appeal an enforcement decision? How long and how costly is the process?**

An IP&IT Court decision can be appealed to the Supreme Court (Dika Court) within 30 days of the date the judgment is rendered. Appeals do not need be confined to issues of law, and it is quite common for the Dika Court to reexamine the entire case. Appeals are conducted in the form of a written submission, and no hearings take place, with the exception of the judgment hearing. A judgment by the Dika Court can take up to two years.

The court fees for filing an appeal to the Dika Court depend on the total amount of damages claimed. For damages totalling less than Bt50 million (\$1.667 million), the fee will be 0.2% of the damages, but will not exceed Bt200,000 (\$6,667). For any amount of damages exceeding Bt50 million, the fee will be 0.1% of the amount.

#### **16. Who holds the burden of proof for patent invalidity claims?**

Generally, the burden of proof in civil cases involving alleged IP infringement lies with the plaintiff. If the plaintiff claims for patent invalidation of the defendant's patent, the plaintiff will bear the burden of proof for this issue.

In a patent infringement case where the defendant also files a counterclaim to invalidate the plaintiff's patent, each party shall bear the burden of proof for the issue that it raised. That is, the plaintiff shall bear the burden of proof for the infringement allegation, while the defendant shall bear the burden of proof for the invalidity challenge.

As such, theoretically, the trial will begin with the defendant presenting witnesses and evidence relating to the invalidity issue to the court. This would be followed by the plaintiff presenting its witnesses and evidence to rebut to the invalidity issue, followed by its witnesses and evidence to prove the infringement. The trial will conclude with the defendant presenting its witnesses and evidence to rebut the infringement issue.

#### **17. What kind of expertise does your patent court system hold?**

The IP&IT Court is a specialised court that adjudicates disputes involving IP rights in Thailand. A quorum of the IP&IT Court must consist of two professional judges and one associate judge. Those who are selected as IP&IT Court associate judges have expertise in IP or technical skills in order to assist the judges with technical aspects.

#### **18. Who can act in a litigation case in court?**

Authorised attorneys or the parties themselves can appear before the court. However, due to the complexity of patent cases, it is recommended that the owner of the patent be represented in court by a lawyer who has expertise in patent law.

#### **19. What are the alternatives to litigation in courts?**

In addition to civil litigation, negotiation through the Mediation Center is another alternative. Negotiation is becoming popular in Thailand, as it is more cost efficient and less time consuming than trial proceedings. There are two government agencies that facilitate mediation of IP disputes in Thailand: the Department of IP and the IP&IT Court. This is a free service provided by the government. The case will be mediated by a mediator who has a business or IP background. Unlike arbitration, no decision is made by the mediator, as their responsibility is merely to facilitate and encourage both parties to settle the case, before going to trial.

#### **20. Are there any other issues relevant to your jurisdiction?**

The number of patent litigation cases in Thailand has increased significantly in recent years, and cases have become more complicated and involve more technical aspects. However, securing a positive result in such cases remains difficult, and the results usually remain clouded in doubt.

In addition, as there are few precedent cases for patent litigation in Thailand, it is difficult for litigators to determine the appropriate amount of information and evidence that should be presented to the court. For example, when the conflict is related to an infringement relating to the doctrine of equivalents, litigators need a deep and comprehensive understanding of the particular technology or invention. This is problematic for many Thai lawyers because the majority have no technical background.

Although scientists or expert witnesses can be presented during a case to facilitate a better understanding among the team members, these witnesses are extremely expensive. Even if there is a strong understanding of the case, the next question that arises is how the case can best be presented to the court to prove the facts and to meet the burden of proof. Also, since punitive damages are not available in Thailand, the patent owner needs to decide whether it is worthwhile to continue investing in the patent litigation case, or whether other measures should be sought to manage or resolve the dispute.

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