



<< Left
Srila Thongklang
 Partner
 srila.t@tilleke.com

<< Right
Suebsiri Taweepon
 Attorney-at-Law
 suebsiri.t@tilleke.com

Patentability of “New Use” Patents in Thailand

Among international IP practitioners, there has long been a controversial issue regarding whether the new use of a known product can satisfy the novelty requirement to be patentable. So-called “new use” patents frequently concern subject matter such as chemical substances or medical use of known products.

In Thailand, this question has never been put to the test in the Supreme Court. However, the Supreme Court recently rendered a decision on an attempt to invalidate an invention patent, which concerned a new discovery of the use of a known, non-chemical product claiming to be novel and inventive. The Thai Supreme Court’s elucidation, in response to the “new use” patent in Thailand, is described below.



Thai Patent Law

Thai patent law generally provides protection for three different types of patents—invention patents, design patents, and petty patents. An invention patent protects innovations that result in a new product or process, or any improvement of a known product or process. Similar to most jurisdictions, in order to be patentable, an invention must be new, non-obviously inventive, and industrially applicable.

But if an applicant discovers a new way to use an existing product that provides an unexpected result, can this new use be patented under Thai patent law?

Thai Court Perspective

A Thai individual patented a new use for reed mats, to absorb humidity and thus protect cargo stored on ships, and enforced this patent against competitors. Among the competitors was Chidlom Marine Services & Supplies Ltd., which is a market leader in shipping-related and logistics services in Thailand.

Chidlom Marine thus filed a civil action against this Thai individual to invalidate his Patent No. 8871,

arguing that the issuance of this patent was unlawful.

Thailand’s Intellectual Property and International Trade (IP&IT) Court rendered its decision in favor of Chidlom Marine, as the plaintiff, and invalidated Patent No. 8871. Despite an appeal from the defendant, the Thai Supreme Court affirmed the IP&IT Court’s decision, by reasoning that the Thai Patent Act does not provide protection for “new use” patents.

New Use as Mere Discovery or New Process Patent

The Supreme Court ruled that the defendant’s patent lacked novelty as it only represented the mere use of a known product, by utilizing the reed (also known as narrow-leaved cattail) for mat weaving, which is actually a known process. In addition, the subject matter of this patent did not involve any new invention or any improvement of the traditional knowledge or new method for mat weaving.

Thus, the use of the reed mat to absorb humidity and protect cargo stored on ships could not be considered a process patent. Moreover, the patent’s claims did not involve a new process for making the reed mat, nor did they entail a new process for protecting and absorbing humidity. In summary, the invention was not new and there were no modifications or developments involved in respect of the mat-making process.

Reed mats are also a traditional local product that have been manufactured for an extensive period of time. The defendant’s patent primarily involved the mere discovery of a new use, by applying the reed mat with cargo on board ships. The Thai Supreme Court therefore decided that the subject matter of this invention lacked novelty. The qualification of the reed mat to absorb humidity and protection of cargo is an inherently natural qualification which was a mere discovery, not a new invention [Supreme Court Case No. 7119/2552].

Patentability of New Discoveries

The case described above clearly involves the mere discovery of a new method for using a known product (using a local reed mat to protect cargo), which has been long disclosed as traditional knowledge.

At this stage, it can be concluded that the new (non-medical) use of a known product is not novel, even though such use has never been known to the public at the time of the invention. However, the discovery of a new method of utilizing an existing product (or chemical substance) is still open to be patentable in Thailand. 🐼

