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Thailand's Progress Toward Joining the Hague Agreement

As ASEAN works toward greater unification, a number of action plans have been devised to accelerate integration. One such plan is the ASEAN Intellectual Property Rights Action Plan 2011-2015 (ASEAN IPR Action Plan), which has formulated strategic goals to increase the competitiveness of the ASEAN Economic Community with respect to the use of intellectual property.

A core tenet of the ASEAN IPR Action Plan is for ASEAN member countries to become contracting parties to the Hague Agreement, in order to implement a system for industrial design registration that is common to the region. The system would allow applicants to file a singular, international industrial design application and registration covering one or more member states directly with the World Intellectual Property Organization (WIPO) or through a receiving office. Once an application has been filed, WIPO examines the application to ensure that it complies with the formal requirements, and then it publishes the international regis-

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tration. All designated member countries are then notified of the registration and must provide a decision to register the industrial design or deny registration within 6 months of the publication of the international registration or, alternatively, within 12 months of the publication where that member country has an opposition system.

As part of Thailand's accession to the Hague Agreement, the country's Department of Intellectual Property (DIP) commissioned an independent study on managing design applications under the Hague Agreement. The study gathered information, such as the design community's opinions regarding the current design system and the opinions of interested parties including government personnel and the private sector, and reviewed how other Hague Agreement member countries manage Hague Agreement applications. Finally, the study compared the information that was gathered to the current Thai design registration system.

Section 3 of the Thai Patent Act defines a design as “any form or composition of the lines or colors which gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft.” Thus, a design includes product packaging and product design. Because Thailand does not allow registration of trade dress, a design patent application is an alternative form of protection.

Presently, Thai patent law does not allow applications that contain multiple designs. According to Section 60 of the Thai Patent Act, an application for a patent must relate to a design to be used with only one product. The patent application must contain seven views of the design, and drawings or photographs should be in black and white unless a particular color is sought for protection. If protection is sought for a particular color, the drawings should be submitted in color and the claim should include a claim for color. Partial designs are not allowed.

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Once an applicant submits an application, an examiner will conduct a formality examination to determine whether it meets the formal requirements. After the formality examination is completed, the application is published, and there is an opposition period of 90 days. After 90 days, the application proceeds to the substantive examination stage.

Substantive examination involves checking that a design is new, not contrary to public order or morality, and is not a design prescribed by a Royal Decree, as found in Sections 56 to 58 of the Patent Act. Once substantive examination is successfully completed, the application proceeds to grant. The period of protection is ten years from the filing date, and annuities are payable from the fifth to tenth years.

The DIP-commissioned study revealed a number of challenges in Thailand's current design system. One challenge is that the system is limited by the small number of examiners, meaning that examination proceeds at a sluggish pace. The existing backlog contributes to the predicament. Furthermore, applications are not filed electronically and there is no database of applications.

To overcome these challenges and prepare Thailand for accession to the Hague Agreement, the DIP will discuss the following possible changes:

1. pay government fees relating to the entire process up front;
2. allow multiple design applications;
3. no novelty examination during substantive examinations;
4. increase the term of protection to 15 years; and
5. no direct acceptance of international applications.

Though many hurdles remain, the DIP has endeavored to hasten the design patent examination process. The study's proposed changes, combined with the DIP's efforts to advance the prosecution of design registrations, will assist Thailand in its aim to become a contracting party to the Hague Agreement. ⚖️