

Informed Counsel

Analysis of Recent Legal Developments in Southeast Asia



c o n t e n t s

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Thailand has introduced important changes regarding timelines of patents, design patents, petty patents, and trademark registration procedures.
- 3 **Increased Funding for SMEs**
The National Legislative Assembly of Thailand recently passed a new law to improve financial stability for small and medium enterprises by increasing access to funds from financial institutions.
- 3 **Update on Well-Known Marks**
The Department of Intellectual Property has abolished Thailand's recordation system for well-known trademarks.
- 4 **Oppositions Based on Unregistered Marks in Indonesia**
We examine a recent case in which an applicant's trademark published in Indonesia was successfully opposed on the basis of an unregistered mark.
- 5 **Myanmar's Franchising Potential**
In this article, we look at franchising in Myanmar as well as issues relating to trade, intellectual property, and emerging markets.
- 6 **Bringing Brands to Vietnam**
This article provides an overview of company establishment, franchising, and using an agent or distributor in Vietnam.
- 7 **Alcoholic Beverage Restrictions**
The Thai government has introduced controversial labeling and message restrictions for alcoholic beverages that could result in major losses for the alcohol industry.
- 8 **Customs Audits**
Understanding customs audits is important because violations of the Customs Act can have severe legal ramifications.
- 9 **Cyber Security Preparedness**
Companies should continually evaluate their cyber security preparedness and develop and implement defense and mitigation strategies to prevent and limit damage due to cyber attacks.
- 10 **Government Promotes Railway PPPs**
The Private Investment in State Undertaking Act introduces streamlined project approval procedures for railway public-private partnerships.
- 11 **Solar Power Generation Program**
A program that establishes solar farms, funded and operated by public partners in partnership with project supporters, is underway.
- 12 **Tilleke & Gibbins Updates**
Our firm has received top rankings and awards from The Legal 500 Asia Pacific and Asialaw Profiles, and we have hired a new Japanese patent specialist.

Licensing Facilitation Act: Enhancing Patent and Trademark Registration Procedures

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The Licensing Facilitation Act B.E. 2558 (2015) (LFA), implemented on July 21, 2015, requires government authorities that register and/or grant licenses—such as the Department of Intellectual Property (DIP)—to publish public manuals disclosing the rules, procedures, requirements, costs, and periods of time that relate to granting the licenses. The rationale behind the LFA is to expedite registration procedures with government authorities across Thailand.

Under the LFA, the DIP has published 33 public manuals to date, issued by five offices, including public manuals related to patent registration, international applications under the Patent Cooperation Treaty, patent design registration, and trademark registration. The public manuals specify the relevant laws, list all of the required steps, and estimate timelines and workflow, which the laws do not provide.

This article presents an overview of the important changes introduced by the LFA regarding timelines of patents, design patents, petty patents, and trademark registration procedures.

Patents

The total time to process a patent registration from filing to grant is within 55 months, which includes 12.5 months from the patent application to publication, 38.5 months for substantive examination, and 20 days to grant and issue a patent letter.

One significant change introduced by the LFA relates to the DIP's patent registration procedure, and specifically, the deadline to submit formal documents. Prior to July 21, 2015, a patent application had to be filed with certain formal documents, including a power of attorney, and if applicable, a deed of assignment and a statement of the applicant's right to apply for a patent.

If these formal documents were not submitted with the patent application, then a request for a 90-day extension, counted from the Thai filing date, was required to file the patent application. In addition, two further extension requests were previously available—90 days and then 30 days—meaning that 210 days were provided to file the requisite documents.

From July 21, 2015, onward, if the formal documents are not filed at the same time as the patent application, they must be submitted within the non-extendable deadline of 90 days from the date of filing the application with the DIP. Failure to comply will result in the application being deemed abandoned.

There are exceptions in which the submission deadlines remain unchanged—they apply to the submission deadline of the priority document, if applicable, which is still 16 months from the first filing date of the base application, as well as the deadline to submit a complete Thai translation of the specification, which is still 90 days from the Thai filing date. All of these deadlines are non-extendable.

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A summary of changes to the deadlines is set out below.

Document Type	Deadline Under Previous Regulation	Deadline Under New Regulation (Effective July 21, 2015)
Power of Attorney	90 days + 90 days + 30 days	90 days (non-extendable)
Deed of Assignment	90 days + 90 days + 30 days	90 days (non-extendable)
Statement of Applicant's Right to Apply for a Patent	90 days + 90 days + 30 days	90 days (non-extendable)
Complete Thai-Language Specification	90 days	90 days (unchanged)
Priority Document	16 months from the first filing date	16 months from the first filing date (unchanged)
Response to Office Action	90 days + 90 days + 30 days	90 days + 90 days + 30 days (unchanged)

Patent Design

The total time to process a patent design registration from filing to grant is within 15 months, which includes 8 months and 2 days from the patent design application to publication, 6 months to conduct a substantive examination, and 2 days to grant and issue a patent design letter.

Petty Patent

The total time to process a petty patent registration from filing to grant is within three months, which excludes the publication period of 12 months after grant for an interested person to file a request for substantive examination of the petty patent.

Trademark Registration

The total time to register a trademark is 16 months, which includes 11 months to examine the registrability of an applied-for mark, 3 months to publish a mark, and 30 days to grant and issue a registration certificate.

Others

The LFA has also amended and established other timelines that relate to trademark and patent registration information, assignment of trademark and patent rights, patent and trademark license registration, renewal of trademark registration, and annuity payment, among others.

A summary of the important timelines to register intellectual property rights is shown below.

Procedures	Total Period of Time
Trademark Registration	16 months
Amendment of Trademark Registration Information	68 days
Assignment or Inheritance of Trademark Rights	68 days
Trademark License Registration	105 days
Renewing Trademark Registration	68 days
Patent Registration	55 months
Design Patent Registration	15 months
Petty Patent Registration	3 months
Assignment of Patent Registration	7 days
Patent License Registration	35 days
Annuity Payment	9 days
Amendment of Patent Registration Information	2 days

Under Section 10 of the LFA, the relevant government authority must complete the registration of these intellectual property rights within the timelines stated in the public manuals. If the authority cannot complete the registration within the timelines, it must notify each applicant in writing every seven days of the reason for the delay in granting the registration. A copy of this written notification must be submitted to the Public Section Development Committee.

The LFA's new public manuals, procedures, and timelines should provide impetus for government authorities that register and/or grant licenses to hasten Thailand's patent and trademark registration procedures. If they are able to closely observe and meet the timelines, Thailand will bolster its competitiveness, and strengthen its image as a reliable and transparent jurisdiction for intellectual property registration.