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## Thailand's DIP Revives Proposed Amendments to the Patent Act

Five years ago, Thailand's Department of Intellectual Property (DIP) was in the process of considering proposed amendments to the Patent Act. These discussions were put on hold, and the process has remained suspended until now.

On January 27, 2016, the DIP announced that it will be revisiting the proposed amendments with a focus on the following objectives:

- ▶ Reduce the long periods of pendency for patent registration and improve the patentability and enforceability of petty patents.
- ▶ Accept the Protocol Amending the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) regarding Thailand's public health.
- ▶ Facilitate Thailand's accession to the Hague Agreement regarding design protection.

This article will discuss these amendments.

### Patents

The patent amendments aim to address the long periods of pendency for patent registration, and to ensure that the time to grant a patent complies with the time frame set by the Licensing Facilitation Act, which is 55 months. The following amendments have been proposed.

**Reduction of time to request substantive examination.** The time period to request substantive examination will be reduced from five years to three years from the publication date.

**Post-grant opposition and specialized Board of Revocation/Invalidation.** Patent applications will be published twice. The first publication will be made after the formality examination is completed, following usual practice. The second publication will be made after the substantive examination is completed and the patent has been granted, and it will be open to patent invalidation. Therefore, the opposition period after the first publication will be eliminated and replaced by the invalidation action, which must be filed within a stipulated period of time (to be determined) from the granting date.

In addition, a specialized Board of Revocation/Invalidation will be established to consider patent invalidation. This board will be composed of at least three members but not more than five members. It must consist of the Examiner and a person qualified in law, and the other persons must be qualified persons in other fields. This should improve the examination process and hasten the granting of patents.

### Petty Patents

In order to qualify as a petty patent, an additional crite-

riion of patentability must be fulfilled. An applicant must demonstrate that the applied-for petty patent provides a solution to a technical problem.

Other proposed amendments include the application of post-grant opposition and invalidation to petty patents, and substantive examination will be conducted for petty patents before the petty patent holder exercises its patent right against a third party, including taking legal action against an infringer.

### Protocol Amending the TRIPS Agreement

The TRIPS Agreement established minimum standards for many IP regulations. The Protocol Amending the TRIPS Agreement allows WTO member states to use compulsory licenses to export patented medicines to countries which do not have manufacturing capacity in pharmaceuticals, in the interest of public health. Thailand's Cabinet recently approved certain aspects of the Protocol based on proposals made by the Ministry of Commerce. In particular, Thailand's Patent Act would be amended to:

- ▶ Accept the Protocol amending the Agreement on TRIPS with regard to Thailand's public health, and submit this decision to the National Legislative Assembly for approval; and
- ▶ Authorize the Ministry of Foreign Affairs to issue an Instrument of Acceptance after approval is obtained from the Cabinet and the National Legislative Assembly. The Ministry of Commerce will notify the World Trade Organization (WTO) of the acceptance.

Thus far, four categories of compulsory licenses have been proposed in Thailand, as follows:

- ▶ License to a third party to import pharmaceutical products under drug patents into Thailand;
- ▶ License to a third party to manufacture and export pharmaceutical products under drug patents to foreign countries;
- ▶ License to government ministries, bureaus, and departments to import pharmaceutical products under drug patents into Thailand; and
- ▶ License to government ministries, bureaus, and departments to manufacture and export pharmaceutical products to foreign countries.

More categories of compulsory licenses for drug patents and drug process patents will be proposed and discussed. In addition, Thailand's Patent Office recently stated that the Patent Act should be amended to accommodate the Doha Declaration on the TRIPS Agreement and Public Health, which reaffirms the flexibility of TRIPS member states to provide more access to essential medicines by circumventing patent rights.

### Thailand's Accession to the Hague Agreement

As part of Thailand's accession to the Hague Agreement, the DIP commissioned an independent study on managing design applications under the Hague Agreement. The DIP identified a number of challenges in Thailand's current design system, and it continues to make improvements. For example, an e-filing system has been implemented and will be refined in the near future, and there are plans to increase the number of examiners this year.

As the amendments progress, we will update readers on important developments in future issues of *Informed Counsel*. 