

## THAILAND

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## PART 1 PATENTS

### §1.01 SUMMARY

#### [A] Kinds of Patents

- Patents of invention

#### [B] Duration of Patents

- 20 years from the date of filing the application

#### [C] Patentable/Not Patentable

- Novelty, inventive step, susceptibility to industrial application.
- The exceptions of Rule 39 of the PCT apply.

**[D] Novelty**

- Not published anywhere in the world and not publicly used in Thailand.

**[E] Requirements and Procedure**

- Filing languages: any
- Language of translation: Thai
- Time limit for filing translation: 90 days
- A patent of invention is granted after substantive examination
- An opposition procedure is provided before registration.

**[F] Specific Aspects of Regional Patents**

- Not applicable in this jurisdiction.

**[G] Specific Aspects of International Patent Applications (PCT)**

- Time limit for entering National: 30 months from the priority date
- Time limit for filing translation: 30 months from the priority date.

**[H] Governmental Websites**

- [www.ipthailand.go.th](http://www.ipthailand.go.th)

## §1.02 DETAILED INFORMATION

### [A] Conventions and Legislation

#### [1] Conventions

- Convention Establishing the World Intellectual Property Organization (WIPO Convention), 1967, member since 25 December 1989;
- Paris Convention, since 2 August 2008; and
- Patent Cooperation Treaty, since 24 December 2009.

#### [2] Laws

- Patents Act B.E. 2522 of 1979, as amended by Patents Act (No. 2) B.E. 2535 of 1992, and by Patents Act (No. 3) B.E. 2542 of 1999, latest amendments effective since 27 September 1999;
- The Protection of New Plant Varieties Act B.E. 2544, which took effect on 26 November 1999; and
- Copyright Act B.E. 2537 (1994), which took effect on 21 March 1995.

### [B] Kinds of Patents

- Patents of invention.

### [C] Duration of Patents

The duration of patents of invention is twenty years from the date of filing the application, subject to the payment of annual fees. No extension may be granted.

#### [1] *Supplementary protection certificate*

Not applicable in this jurisdiction.

### [D] Requirements for Renewal

The first annual fee is due at the beginning of the fifth year (four years after the filing date). Annual fees may be paid sixty days before the anniversary of the filing date. Late payment is accepted without surcharge if paid within sixty days after the anniversary of the filing date. After sixty days, a 30% surcharge is applied. If not paid within 180 days after the anniversary of the filing date, the patent will be deemed abandoned and then cancelled. As to possibilities for restoration, see 'Restoration'.

If it takes more than five years for the patent to be granted, the annual fees for the fifth year and any additional years must be paid within sixty days after grant.

One may pay all annual fees in a lump sum when the fifth year annual fee is due. If the patent is surrendered or cancelled, there is no refund for fees paid in advance.

### [E] Patentable / Not Patentable

According to the Act, 'invention' means any development or invention which results in a new

product or process, or any improvement of a product or process. ‘Process’ means any process, art or method of producing, maintaining or improving the quality of a product, including the application of such process. In addition, new use of an existing product is eligible for patent protection. Patents concerning a process will also cover products obtained by application of such process.

To be patentable, an invention must be new, involve an inventive step and be capable of industrial application. An invention will be considered to involve an inventive step if it is not obvious to a person having ordinary skill in the art. An invention will be deemed to be capable of industrial application if it can be put into use in industry, including agriculture, handicraft and commerce.

Apart from inventions not complying with any of the general requirements of novelty, non-obviousness and applicability in industry, the following are unpatentable:

- (1) microorganisms existing in nature and their components;
- (2) animals, plants, and animal and plant extracts;
- (3) scientific and mathematical rules and theories;
- (4) computer programs;
- (5) methods of diagnosis, treatment and medical therapy applied to human or animal bodies; and
- (6) inventions being contrary to public order, morality, health or welfare.

Foods and beverages, machinery for direct use in agriculture, and all types of biotechnology including processes for the production of plants or animals are patentable.

The exceptions of Rule 39 of the PCT apply.

### *[1] Chemical compositions*

Chemical compositions are patentable.

### *[2] Pharmaceuticals*

Pharmaceuticals and pharmaceutical ingredients may all be patented.

### *[3] Second use*

Second use of an existing non-medical product is patentable. Second use of a non-medical substance already existing is not patentable with the exception of Swiss-type claims.

Pursuant to Section 9(4) of the Thai Patent Act, a method of diagnosis, treatment or therapy applied to human or animal bodies is prohibited from being patented.

For example, the following claims are deemed as the first indication of therapeutic use, which falls under the prohibition of Section 9(4):

- (i) (Substance X) for use in the treatment of (Medical condition Y)
- (ii) (Substance X) for use as a (Y-treating agent)
- (iii) (Substance X) for use in therapy (or for use as a medicament).

The following claim is considered a Swiss-type claim for the second medical use of an existing product, which could be protected under patents, provided that it meets the requirements of novelty, inventive step and industrial application.

‘The use of [known compound/substance X] for the manufacturing of a medicament for the treatment of [disease].’

Non-medical use claims are patentable if the use of the known compound has not been known to the public (e.g., a new use of a known cosmetic).

*[4] Treatment of the human body*

Methods of diagnosis, treatment and care of the human or animal body are not patentable.

*[5] Biological materials*

Biotechnological processes for the production of plants or animals may all be patented. Microbiological processes and man-made microorganisms are patentable; however, the law prohibits microorganisms existing in nature and their components, as well as animals, plants, and animal and plant extracts, from patentability. Genes and gene sequences may be patentable.

*[6] Plant varieties*

Plant varieties are not patentable. However, the protection of new plant varieties in the form of 'Plant Breeders' Rights' is available under the Protection of New Plant Varieties Act B.E. 2544, which took effect on 26 November 1999.

*[7] Software-related inventions*

Computer programs as such cannot be patented, but may be protected as a literary work (Copyright Act B.E. 2537 (1994)). Thailand is a party to the Berne Convention for the Protection of Literary and Artistic Works as revised in Paris in 1971. Computer program is defined as a command, set of commands, or other things to be used with a computer so as to make the computer operate or bring about a certain result in any computer language.

*[8] Business methods*

There is no specific prohibition on the grant of a patent for a business method. However, most applications are rejected on the ground that it is an abstract idea, not an invention.

*[9] Immoral inventions or inventions contrary to public order*

Inventions being contrary to public order, morality, health or welfare are not patentable.

*[10] Semiconductors*

Semiconductors are patentable.

**[F] Novelty**

An invention is new if it is:

- (1) not disclosed in a published document or in printed matter or by exhibition or public disclosure by any means anywhere in the world before the filing or priority date;

- (2) not widely known or used in Thailand before the filing or priority date;
- (3) not already patented by a patent of invention or a petty patent in Thailand or anywhere else;
- (4) not applied for in an application for a patent of invention or petty patent in another country more than eighteen months prior to filing the application in Thailand where the foreign patent or petty patent has not been issued; and
- (5) not been a subject matter of an earlier patent or petty patent application filed in Thailand or abroad which has been published.

*[1] Grace period*

The following are not a bar to novelty:

- (1) disclosure of the invention within twelve months before the filing date due to or in consequence of an unlawful act; and
- (2) disclosure of the invention within twelve months before the filing date by the inventor, including display of the inventor's work at an international or official public exhibition. A person who has exhibited his/her invention at a public exhibition held in Thailand and sponsored or authorized by a State organization and files a patent application relating to that invention within twelve months from the opening date of the exhibition may be considered to have filed the application on said opening date.

**[G] Applicant**

Applicant can be the inventor or his/her legal successor or assignee (individual, legal entity), or the joint inventors.

The following may apply for and obtain a patent of invention in Thailand:

- (1) nationals of Thailand and legal entities established in Thailand;
- (2) nationals of a country being a member of an international Convention or Treaty for patent protection to which Thailand is a party;
- (3) nationals of a country allowing nationals of Thailand and legal entities established in Thailand to apply for a patent in that country; and
- (4) persons having domicile or a real and effective industrial or commercial establishment in Thailand or in a country being a member of an international Convention or Treaty for patent protection to which Thailand is a party.

If two or more persons have made the same invention independently of each other, the first applicant shall be entitled to a patent. If in such case patent applications have been filed on the same date, the applicants must agree to whom the patent shall be granted. If no agreement can be reached within the prescribed term, the parties may bring the case to the competent court within ninety days, failing which they will be considered to have abandoned their applications.

In the case of an invention made by an employee in the performance of his/her task or under a contract of which the making of inventions is the object, the employer will be entitled to apply for a patent, unless provided otherwise in the contract. If the employer would benefit from the use of the invention, the employee shall be entitled to remuneration in addition to his/her normal salary. The employer shall also be entitled to apply for a patent with respect to inventions made by an employee where the employment contract does not require him/her to carry out inventive activities, if the invention was made using means, statistics or reports made available or at his/her disposal on account of the employment contract, except if agreed upon otherwise. In such case, the employee will always be entitled to remuneration in addition to his/her normal salary. The right of the employee to a remuneration as referred to may not

be excluded by contract. The Director-General of the Patent Office may upon request establish the amount of the remuneration for the employee, taking into account the salary of the employee, the importance of the invention, the benefits the employer has and may have from the invention and other relevant circumstances. The provisions relating to employees in principle apply also to civil servants.

If a patent is owned by two or more persons jointly, each co-owner may execute the exclusive rights under the patent without the consent of the other co-owner(s). However, a patent may be licensed or assigned (totally or partially) only with the consent of all co-owners. Likewise, a co-owned patent or any claim thereof may be surrendered only with the consent of all co-owners.

### **[H] Assignment**

If an assignee applies for a patent, a deed of assignment, signed by the assignor and the assignee, is to be filed.

A patent may be assigned. Assignments must be made in writing and must be registered in order to be effective.

The requirements for registration are as follows:

- (1) deed of assignment, signed by the assignor and the assignee, notarized (if executed abroad), in the Thai language or with a Thai translation;
- (2) power of attorney from the assignee, notarized (if executed abroad). For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate;
- (3) patent certificate for endorsement; and
- (4) payment of the required fee.

### **[I] Requirements for Filing**

#### *[1] Obligation to file first with national office*

Not applicable in this jurisdiction.

#### *[2] Minimum requirements for obtaining filing date / Provisional applications*

The minimum requirements for filing patent applications are as follows:

- (1) Request on prescribed form, signed by the applicant or his/her agent, and containing the following information:
  - (a) indication of full name, address and nationality of the applicant;
  - (b) full name, address and nationality of the inventor(s) (if not the same as the applicant);
  - (c) the title of the invention;
  - (d) indication of the nature and purpose of the invention;
  - (e) country, date and number of application whose priority is claimed (if applicable);  
and
  - (f) in case exhibition priority is to be claimed, details concerning exhibition concerned.
- (2) Details with regard to the corresponding applications/patents filed in the applicant's home country or in other countries (if any).

- (3) For filing under the PCT route, the translation of the parts of application text, including only the Thai translation of the title, all claims and abstract must be submitted to secure the thirty-month deadline.

Specification claims and the abstract can be in any language, provided that a Thai translation is filed within ninety days, and drawings, if applicable. The application must contain at least one claim.

### *[3] Request for grant*

The requirements for filing patent applications are as follows:

- (1) Request on prescribed form, signed by the applicant or his/her agent, and containing the following information:
  - (a) indication of full name, address and nationality of the applicant;
  - (b) full name, address and nationality of the inventor(s) (if not the same as the applicant);
  - (c) the title of the invention;
  - (d) indication of the nature and purpose of the invention;
  - (e) country, date and number of application whose priority is claimed (if applicable);  
and
  - (f) in case exhibition priority is to be claimed, details concerning exhibition concerned.
- (2) Details with regard to the corresponding applications filed in the applicant's home country and in other countries (if any).
- (3) If the applicant is not the inventor, a deed of assignment, signed by the assignor and the assignee. The deed of assignment may still be filed within ninety days from filing the application.
- (4) Specification claims, and abstract in any language, provided a Thai translation is filed within ninety days, and drawings if applicable.

### *[4] Appointment of Representative*

Applicants not domiciled in Thailand must appoint a local agent who is registered with the Patent Office of Thailand. The agent should remain appointed during the entire life of the patent. The address to which communications may be sent must be provided to the Patent Office.

### *[5] Power of Attorney / Designation of inventor / Other documents*

A power of attorney is required. The power of attorney must be signed by the applicant and notarized by a Notary Public (if executed abroad). For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate. The power of attorney may still be filed within ninety days from filing the application. This term may be extended by ninety days, and a further thirty days.

### *[6] Priority*

The Right of Priority provided under the Paris Convention may be claimed. From 27 September 1999, priority may be claimed based on an application filed in another country, provided that



the applicant is a national of a member country of the World Trade Organization (WTO) or a national of the country that provides, reciprocally, equal rights to a Thai national.

To claim priority, the Thai application must be filed within twelve months after the first corresponding application was filed. If there is a priority claim, a certified copy of the priority application must be filed within sixteen months after the priority date. A request for an extension to submit the priority documents is not available. An application with a priority claim will not be approved for publication until a certified copy of the priority application is submitted. An electronic copy will be accepted. The priority application does not need to be translated into Thai.

If an invention has been displayed at a public exhibition sponsored or authorized by a State organization and held in Thailand and a patent application relating to that invention has been filed within twelve months from the opening date of the exhibition, the application shall, upon request, be deemed to have been filed on said opening date. Exhibition priority shall be claimed on filing. The details in respect of the exhibition and an evidencing certificate are to be furnished together with the patent application.

*[7] Allowable language(s) upon filing / Language(s) of procedure*

The Thai language. Any document in a foreign language must be followed by a translation into the Thai language, within ninety days. The translation need not be certified. The Thai translation requirement for foreign search reports and grants of patent submitted for the purposes of substantive examination may be waived by the Examiner.

*[8] Description*

The specification with one or more claims must be filed in the Thai language. The specification may first be filed in any other language, provided that the Thai translation is filed within ninety days. Foreign applicants may send a description in English for translation into the Thai language by the agent in Thailand.

The specification must contain a complete, concise and clear description of the invention that will enable a person having an ordinary skill in the relevant art to execute the invention. The specification must contain a brief description of the drawings, if drawings are filed. The specification must set forth the best method known to the applicant to exploit the invention and the use of the invention in industry, agriculture, handicraft or commerce as appropriate is to be described.

In the case of an application relating to an invention in the microbiological field, a culture of the microorganism concerned must be deposited with an authorized depositary authority before or on the filing or priority date, and the certificate of deposit must be filed together with the application or within ninety days from filing. Deposits may be recognized which were made with an International Depositary Authority under the Budapest Treaty of 1977. For these Authorities, see Part II 'General Subject Matter', the Chapter 'Deposit of Microorganisms (Budapest Treaty-International Depositary Authorities)'.

*[9] Claims*

Claims must be filed in the Thai language. Foreign applicants may send claims in English for translation into the Thai language by the agent in Thailand. The application must contain at least one claim. Multiple dependency of claims is allowed. No additional claims fee is applicable.

*[10] Abstract*

An abstract must be filed in the Thai language. Foreign applicants may send abstract in English for translation into the Thai language by the agent in Thailand.

*[11] Drawings*

The drawings must be on sheets of strong, smooth, white, matt and durable paper of international size A4 (21 cm × 29.7 cm) and in three sets. The minimum margins to be observed are as follows: top 2.5 cm, left 2.5 cm, right 1.5 cm and bottom 1 cm. Note that any foreign characters in the drawings will have to be replaced by signs in Thai phonetics.

*[12] Payment of fees*

The official fee for filing a patent application must be paid on filing the application. The fee cannot be paid late.

**[J] Procedure***[1] Filing Authority*

Patent Office, Department of Intellectual Property, Ministry of Commerce.

*[2] Online filing*

Online filing is available, but a hard copy will also need to be submitted. The application is not considered filed until the hard copy is submitted.

*[3] Formal examination*

Applications for the grant of a patent will first be examined as to compliance with the formal requirements and whether the subject matter is excluded from patentability.

The applicant may submit supporting documents such as a power of attorney, Deed of Assignment or Statement of Applicant's Right and the Thai translation of the description and claims within ninety days after filing. The applicant may request a further ninety-day extension, except for the Thai translation. The applicant may request a final, thirty-day extension. Otherwise, the application will be considered abandoned.

If it is found that the formal requirements are not complied with, or if the invention is found to fall under any of the categories excluded from patentability, the application shall be rejected.

*[4] Search*

The Examiner will search for prior art after the applicant has requested substantive examination.

*[5] Obligation to submit corresponding foreign search results and/or application numbers*

The Examiner may request an applicant who has filed a corresponding application or corresponding applications in other countries to submit the search reports and examination

results from any of those other countries as he/she sees fit. The said reports and results may be filed by the applicant within ninety days from the receipt of such instruction. The applicant may request a further ninety-day extension and a final, thirty-day extension. If there are extenuating circumstances and documents are still not yet available, the applicant may request an extension, as needed.

*[6] Substantive examination*

Patent applications are examined as to novelty and substance. However, this examination is not taken up automatically, but only after an explicit request thereto has been made within the prescribed period (deferred examination system). The examination request must be made by the applicant upon payment of the examination fee within five years after the publication date.

If an opposition against the application has been filed and an appeal has been lodged against the decision on opposition, the examination request may still be made within one year after the final decision has been made, if that one-year period ends later than the period of five years from publication of the application.

If the examination request has not been made in due time, the application will be considered abandoned.

For the purpose of the examination, any governmental service, unit or organization or any foreign or international patent office or organization may be requested to carry out novelty searches or substantive examination and in such case, such searches and examinations will be treated as having been made by the Patent Office of Thailand.

The applicant must pay the costs of the examination within sixty days from the notification concerned, failing which the application will be considered abandoned.

Official actions are to be responded to within ninety days. A further ninety-day extension and a final, thirty-day extension may be requested.

If during examination it appears that the invention does not meet the requirements of novelty, inventive step and applicability in industry, or is not patentable per se, or that the applicant is not entitled to a patent, the application will be rejected and the applicant be notified thereof. If an opposition had been filed, the opposing party will also be notified of the decision of rejection.

*[7] Accelerated examination*

Not applicable in this jurisdiction

However, it is possible to request an accelerated examination by way of (1) PPH or (2) ASPEC.

*Patent Prosecution Highway (PPH)*

The Department of Intellectual Property (DIP) of Thailand and the Japanese Patent Office (JPO) has agreed to implement a two-year Patent Prosecution Highway Pilot Program (PPH Pilot Program), starting in January 2014. The Thai application that is eligible to enter into the PPH Pilot Program must claim priority to a corresponding Japanese application. In addition, a request to participate in the PPH must be filed at the DIP either at the same time as, or after, the filing of the 'request for a substantive examination'.

**Requirements:**

- (A) Copies of all office actions (relevant to the substantive examination for patentability in the JPO) issued for the corresponding Japanese application, and the English translation thereof.
- (B) Copies of all claims determined to be patentable/allowable by the JPO, and the English translation thereof.

- (C) Copies of references cited by the JPO examiner.
- (D) Claim correspondence table.

*ASEAN Patent Examination Co-operation (ASPEC) Programme*

ASPEC is a cooperation programme for the examination of patent applications which is now being implemented by ASEAN member countries.

The purpose of this programme is to share search and examination results between the participating offices to allow applicants in participating countries to obtain corresponding patents faster and more efficiently. The programme will potentially reduce duplication on the search and examination work done, thereby saving time and effort. Additionally, search and examination work done on a corresponding application serves as a useful reference in producing quality reports.

ASPEC has been implemented in Thailand since 1 January 2014. The applicant may at the time of requesting substantive examination file a petition to prosecute the application under ASPEC and submit a corresponding foreign patent granted by one of the ASEAN member countries which participates in the programme. It is anticipated that the examination will be shortened to only around six months in comparison to a normal substantive examination request which could take up to two years.

*[8] Amendments and corrections*

Amendments to a pending patent application may be made. However, no amendment is allowed that would broaden the scope of the application as originally filed or that would add to the essential elements of the invention.

*[9] Third party observations*

No relevant legislation/jurisprudence in this jurisdiction.

*[10] Grant*

The average processing time from filing to grant is four to five years. If during examination, the invention is found patentable and the applicant entitled to a patent, and no opposition was filed, or if, where an opposition was filed, it has been decided that the invention belongs to the applicant, the Director-General of the Patent Office shall order a patent to be registered and granted.

The applicant will then be invited to pay the granting fee within sixty days, failing which the application will be considered abandoned. When the granting fee has been duly paid, the patent shall be registered and shall be granted to the applicant within fifteen days from payment of the granting fee, but not before the expiration of the sixty-day period for lodging an appeal.

*[11] Re-examination*

Not applicable in this jurisdiction.

*[12] Opposition*

Within ninety days from the date of publication of the application, any interested party may file an opposition. The notice of opposition must contain the grounds upon which it is based and must be accompanied by supporting evidence.

The grounds for opposition are as follows:

- (1) the opposing party has a better right;
- (2) the invention does not meet the patentability requirements;
- (3) the invention is a subject matter that is explicitly prohibited from patent protection;
- (4) the applicant is not entitled to apply for a patent; and
- (5) the applicant is not eligible to file an application, such as an employee who develops an invention in the course of his/her employment.

A copy of the notice of opposition shall be sent to the applicant, who shall file a counter-statement within ninety days, failing which the application will be considered abandoned. The counter-statement must be accompanied by supporting evidence.

The parties may, during the opposition proceedings, file additional evidence or statements. The opposition is to be decided upon by the Director-General of the Patent Office. If it is decided that the opposing party's claim (1– 5) is vindicated, the patent application will be rejected. If the decision rejecting the application is not appealed, or if the rejection is upheld in the appellate proceedings by decision of the Patent Board or by judgment of the competent court (as applicable), the opposing party shall have the right within 180 days after the rejection or after the date that the decision or judgment on the appeal became final, to file an application in respect of the invention concerned, which will then retain the filing date of the original rejected application. In such case, the publication of the rejected application will be considered as the publication of the application of the opposing party. If an opposing party has filed an application as referred to in the foregoing sentence, no opposition against that application may be filed on the ground that the party filing that opposition has a better title. The opposing party who has filed a patent application in manner as referred to must file an examination request within the prescribed period.

#### *[13] Appeal*

Against rejection of an application, an appeal may be lodged with the Patent Board within sixty days. If an application is upheld in opposition proceedings, the opposing party may lodge an appeal with the Patent Board within sixty days. During the appeal proceedings, the Board may require the furnishing of evidence or additional statements. The decision on the appeal will be notified to the appellant and the other parties involved, as appropriate. Furthermore, an appeal against the decision of the Patent Board may be lodged within sixty days with the competent court.

#### *[14] Continuation applications*

Not applicable in this jurisdiction.

#### *[15] Unity of invention / Divisional applications*

An application may relate only to one invention or to a group of inventions so linked as to form a single inventive concept. If during examination it is found that the requirement of unity of invention is not met, the applicant will be notified and required to file divisional applications.

In such case, the applicant should file the required divisional applications within 120 days from the notification, which if so filed within the 120-day period shall retain the filing date of the parent application. The applicant may appeal against the requirement to divide the application to the Director-General of the Patent Office within 120 days. The decision of the Director-General on such appeal shall be final.

After the filing of the preliminary examination is completed, the notification for paying the

publication fee will be issued. The applicant can file a request for a substantive examination of the divisional applications within five years from the date of the publication in the official *Patent Gazette*.

#### *[16] Conversion*

It is possible during the procedure of a grant to convert an application for the grant of a patent of invention into an application for the grant of a petty patent, or to convert an application for the grant of a petty patent into an application for a patent of invention. Conversion of an application for a patent of an invention into an application for a petty patent is possible if the request for conversion is made prior to the publication of the patent application. An application for a petty patent may be converted into an application for a patent of an invention if the request is made prior to registration of the petty patent. In both cases, if conversion is duly made, the converted application will retain the filing date of the original application.

#### *[17] Publication / Public File Inspection*

If after the formal examination it is found that the formal requirements have been complied with and that the invention appears to be patentable, the publication of the patent application will be ordered.

Notice will be sent to the applicant to pay the publication fee, which fee must be paid within sixty days. If the publication fee is not paid, the applicant will once more be notified to pay the publication fee, and if that fee is still not paid within sixty days from that notice, the application will be considered abandoned.

With the publication of the application, a provisional protection starts. After grant of the patent, compensation may be claimed for infringement retroactive to the publication date, provided that the infringing party was aware of the patent application or had been informed thereof in writing. Before publication of the application, inspection and making copies thereof is possible only with the written authorization of the applicant.

There are secrecy provisions. The Director-General of the Patent Office may direct that the specification and the subject matter of a patent application be kept secret, if it appears to him/her that the invention concerned should be kept secret in the interest of national security. A person, including the applicant, who is aware that the Director-General has directed the application to be kept secret, may not disclose the subject matter or specification of the invention unless if authorized by law. Violation of this provision is punishable with imprisonment of not more than one year and/or a fine not more than THB (Thailand Baht) 50,000.

#### *[18] Withdrawal to prevent publication*

Publication is usually approved about eighteen months after the filing date, though it can be even longer. Before the publication is made, the applicant or agent in Thailand can request the withdrawal of the application. Another way to avoid publication of the application is by leaving the publication fee unpaid. If the applicant is notified to pay the publication fee but fails to do so within sixty days from the date of receipt of the notice, the competent officer will once again notify the applicant. If the applicant fails to pay the publication fee within sixty days from the date of receipt of such second notice, the applicant is deemed to have abandoned the application.

**[K] Nullity and Lapse**

Any interested person and the Public Prosecutor may apply to the competent court for the nullification of a patent of invention (or petty patent).

The grounds for nullification are as follows:

- (1) the invention was not novel;
- (2) the invention was unpatentable per se;
- (3) the patentee was not entitled to the patent;
- (4) the patentee is an employee and the employer was entitled to a patent.

A patent may be cancelled by the Patent Board upon request of the Director-General of the Patent Office in the following cases:

- (1) if a compulsory licence has been granted for the patent, and it appears that two years after its grant the patented product has not been manufactured or the patented process not been used in Thailand without legitimate reasons, or there has been no sale or importation for sale of that product within Thailand, and the Director-General of the Patent Office is of the opinion that there are reasonable grounds for the cancellation of the patent; or
- (2) if the patentee has granted a licence containing a prohibited clause. Before requesting cancellation, the Director-General will order an inquiry and give the patentee and the licensee(s) an opportunity to file their comments within sixty days. If after the inquiry it appears that there are reasonable grounds for the cancellation of the patent, the Director-General will submit his/her report to the Patent Board for the cancellation of the patent.

**[L] Use Requirement**

A patent must be sufficiently worked in Thailand within three years from grant or within four years from filing of the application, whichever period is longer. If the patentee, without sufficient legitimate reasons, does not utilize his/her patented invention within the specified time, anyone may apply for a compulsory licence to exploit the invention.

**[M] Marking**

Marking is not compulsory. Possible marking is 'Thai Patent No...'. It is essential that, when marking is applied, the number of the patent concerned is mentioned. In case of a pending application, as marking may be used 'Patent Pending'. False marking is a criminal offence punishable by imprisonment not more than one year and/or fine of not more than THB 200,000. Marked products have no implications for awarding compensation in case of past infringement.

**[N] Licenses**

Exclusive and non-exclusive voluntary licences under a patent may be granted. Licence agreements must be in writing and must be registered with the Patent Office. The agent must submit an original licence agreement or copy of the licence agreement, certified by a Notary Public as a true and correct copy of the original, a signed power of attorney from the licensor, a signed power of attorney from the licensee and a copy of the licensee's business registration certificate (if the licensee is a Thai company). Any power of attorney executed abroad must be notarized by a Notary Public. Any power of attorney executed in Thailand must be witnessed.

The following clauses may not be contained in a licence agreement:

- (1) clauses stipulating any condition, restriction or compensation which would have the effect of unfair competition; and
- (2) clauses which require the licensee to pay compensation for the use of the patented invention after the expiration of the term of the patent.

These prohibited clauses shall be void. If, when registration of a licence agreement is requested, the agreement contains any prohibited clause, it will be referred to the Patent Board. If the Board decides that the agreement contains one or more prohibited clauses, registration of the licence will be refused unless the parties intend that void provisions may be severable. In such case, registration of the valid part of the licence agreement may be allowed.

Compulsory licences may be granted in the following cases:

(1) Non-working cases

Any person may apply to the Director-General of the Patent Office for the grant of a compulsory licence under a patent if, after the expiration of three years from grant of the patent or of four years from the date of filing the application for the patent (whichever period is longer), without sufficient legitimate reasons:

- (a) the product protected by the patent is not being produced or the process protected by the patent is not being used in Thailand; or
- (b) the products protected by the patent or products produced by the process protected by the patent are not being sold in Thailand, or are sold there at unreasonably high prices or in a quantity being insufficient to meet domestic demand.

A person applying for the grant of a compulsory licence on any of these grounds must show that he/she has tried to obtain a licence from the owner of the patent with reasonable conditions and for a reasonable remuneration but could not succeed in obtaining such licence within a reasonable period. A compulsory licence granted on account of non-working may be terminated upon request if it appears that the reason for granting the licence has ceased to exist and is not likely to recur, provided that the termination does not affect the rights or interests of the grantee of the compulsory licence.

(2) Dependent patents

If the working of any claim in a patent would be likely to constitute an infringement upon a patent belonging to another party, the owner of the first-mentioned patent may apply to the Director-General of the Patent Office for the grant of a compulsory licence under the other patent, provided that:

- (a) the invention of the applicant for the licence involves an important technical advance of considerable economic significance in relation to the invention covered by the other patent;
- (b) the applicant for the licence will allow a cross-licence with reasonable conditions for the use of his/her invention to the owner of the other patent; and
- (c) the licence can be assigned only together with the dependent patent.

Also in this case, the party applying for the compulsory licence must show that he/she has tried to obtain a licence from the owner of the older patent with reasonable conditions and for a reasonable remuneration but could not succeed in obtaining such licence within a reasonable period. As follows from the above, a person applying for the grant of a licence in this case must allow a cross-licence for the use of his/her invention to the owner of the older patent.



### (3) Public interest cases

Ministries, public bodies and departments of the State may, either themselves or through others, work a patented invention in the interest of activities of public utility or essential for the national defence, or for the preservation or realization of natural resources or the environment, or for the purpose of relieving a severe shortage of food or pharmaceuticals, or for another public benefit. In such case, compensation shall be due to the owner of the patent or to the exclusive licensee. Furthermore, during a state of war or emergency the Prime Minister with the consent of the Cabinet may order the exercise of any patent right if necessary for the defence of the country and the security of the nation, provided that a reasonable compensation is paid to the owner of the patent.

The owner of the patent under which a compulsory licence is granted, or (where applicable) the exclusive licensee shall be entitled to compensation. In cases as meant under (1) and (2), the applicant for the grant of a compulsory licence must propose an amount of compensation, conditions for the exercise of the patent rights and restrictions of the rights of the owner of the patent and the licensee as referred to. The Director-General when deciding upon an application for the grant of a compulsory licence shall establish the compensation, the conditions for the exercise of the patent rights, and the restrictions of the rights of the owner of the patent and the licensee in accordance with the agreement between the owner of the patent and the applicant for the compulsory licence or, if no such agreement can be reached within the prescribed term, as he/she will deem appropriate and provided that:

- (1) the extent and term of the compulsory licence may not be more than required under the circumstances;
- (2) the owner of the patent will remain entitled to grant voluntary licences under the patent;
- (3) the licence will be aimed primarily to meet the domestic public demand;
- (4) the compulsory licence may be assigned only together with the business or the goodwill of the business concerned; and
- (5) the compensation must be adequate under the circumstances.

An appeal against the Director-General's decision may be lodged with the Patent Board within sixty days. In cases as meant under (3), except in case of war or emergency, a proposal for the compensation and the terms of the licence shall be submitted to the Director-General, and the compensation is to be agreed upon between the Ministry, public body or department in question and the owner of the patent.

The owner of a patent may apply for an entry to be made in the Register to the effect that licences under the patent are available as of right. After such entry has been made, a reduction will apply to the annual fees to be paid in respect of the patent. If such entry has been made, the Director-General of the Patent Office may grant to any person applying therefor a licence under the patent with such terms and conditions as may be agreed upon by that person and the owner of the patent. If the parties cannot agree within the prescribed period, the Director-General shall establish the terms and conditions as he/she would deem appropriate. An appeal against the decision of the Director-General may be lodged within thirty days with the Patent Board, whose decision is final.

### **[O] Pledge and Seizure**

No relevant legislation/jurisprudence in this jurisdiction.

**[P] Infringement***[1] Infringing acts / Non-infringing acts*

The scope of protection conferred by a patent is to be interpreted on the basis of the claims. The description and drawings may serve to interpret the scope of the claims. The protection may extend to characteristics of the invention which, although not specifically stated in the claims, in the eyes of a person of ordinary skill in the field to which the invention relates, have properties, utility and effect being similar to those stated in the claims (doctrine of equivalents).

The following acts done without the consent of the owner of a patent are deemed patent infringement:

- (1) in the case of a patent for a product, the production, use, sale, having available for the purpose of sale, offering for sale, and importation of the patented product; and
- (2) in the case of a patent for a process, use of the patented process, and the production, use, sale, having available for the purpose of sale, offering for sale, and importation of products made by the patented process.

As follows from the above, the protection conferred by a patent for a process extends to the products made by application of that process. Reversal of the burden of proof: if in case of an infringement action based on infringement of a process patent (or process petty patent) the plaintiff can prove that the product of the defendant has the same or similar characteristics as the product made by the patented process, that product will be presumed to have been made by application of the patented process until the defendant has proved otherwise.

The following acts are not considered infringement:

- (1) acts done for the purpose of education, research or experimentation only, provided that such acts do not unreasonably conflict with a normal exploitation of the patentee and do not unreasonably prejudice the legitimate interests of the patentee;
- (2) the preparation of medicines in individual cases according to a prescription of a physician made by a professional pharmacist or a medical practitioner, and acts done with regard to medicines so prepared;
- (3) any acts done in respect of applications for the registration of medicines, where the applicant intends to produce, sell or import the patented medicine when the patent expires. So, use of a patented pharmaceutical for the purpose of obtaining government approval in order to produce, sell or import the same after the expiration of the patent would not be deemed infringement (Bolar provision);
- (4) use of equipment being a patented invention on board of ships of a country being a member of an international Convention or Treaty on patent protection to which Thailand is a party, in the machinery or other accessories, when such ships temporarily or accidentally enter the waters of Thailand, and provided such equipment is used exclusively for the needs of the ships;
- (5) use of equipment being a patented invention in the construction or operation or other accessories of aircraft or land vehicles of a country member of an international Convention or Treaty on patent protection to which Thailand is a party, when those aircraft or land vehicles enter Thailand temporarily or accidentally; and
- (6) use, sale, possession for sale, offering for sale or importation of a patented product if the patentee has permitted or allowed the manufacture or sale of that product. Consequently, international exhaustion of patent rights applies now, and parallel importation of patent protected goods manufactured or sold abroad by or with the consent of the owner of the patent may be allowed.

*[2] Prior user rights*

The production of a patented product or the use of a patented process made without the consent of the owner of the patent shall not be deemed patent infringement if the party producing or using the invention has, in good faith, started the production or has acquired the equipment therefor prior to the date of filing the patent application in Thailand.

*[3] Remedies*

Infringement actions are to be brought before the competent court. Available remedies are injunction and award of damages. Preventive injunction may be obtained in case of imminent infringement. The issuance of an injunction will not curtail the patent owner's right to claim damages against the infringer. The amount of damages the infringer may be ordered to pay to the owner of the patent will be an amount as the court finds appropriate taking into account the severity of the injury and the lost benefits as well as the expenses necessary to enforce the right of the patent owner.

Upon publication of the application, certain forms of protection begin. In respect of any act of infringement, before the grant of patent but after publication, where the infringer is aware of the patent application or has been informed in writing thereof, damages may be claimed after the patent has been granted.

*[4] Penal provisions*

The law provides that infringing goods in possession of the infringer are to be confiscated. The court may order the destruction of those goods, as well as the taking of other measures to prevent further distribution of the goods.

Patent infringement is a criminal offence punishable by imprisonment of not more than two years and/or a fine of not more than THB 400,000.

*[5] Enforcement and Customs*

There are generally two possible means for a patent owner to enforce its patent rights against an alleged infringer: civil and criminal sanctions. If a patent owner wishes to enforce the rights through criminal proceedings, he/she may lodge a Criminal Complaint with the police to conduct search and/or seizure of evidence of infringement. In practice, the specialized police unit will undertake patent enforcement only when they are satisfied that there is evidence that infringement is taking place.

If a patent owner seeks damages by way of civil remedies, he/she may choose to first issue a warning notice to the infringer, before bringing a civil infringement case to court. Regardless of the type of remedy sought, gathering evidence of infringement before commencing an action is crucial, particularly due to the lack of a formal discovery process in Thailand. There is, however, a limited form of document disclosure available under the Civil Procedure Code which involves bringing a motion before the court seeking disclosure of an identified document by the other party. The court will issue an order for the other party to file the original evidence, and if the court agrees with such document disclosure orders, an admission by the other party will be deemed to be in accordance with the facts of the document. A civil proceeding is commenced against an alleged infringer by filing a Complaint with the IP&IT Court detailing the patent infringement claim.

With regard to border measures, although Customs Recordation is available, it provides measures only for copyright and trademark infringement. Section 5 of the Export and Import of Goods Act, B.E. 2522 (1979) provides authority to the Ministry of Commerce to issue Notifications on the matter of goods to be prohibited from export or import. However, currently

there are only Notifications on the matters of copyright and trademark infringement. Therefore, at present there is no specific Notification allowing Customs authorities to seize patent infringing goods at the border.

### **[Q] Restoration**

Restoration of priority right is not possible.

On the other hand, the PCT applicant may request restoration within two months after the date of the period to file an application has passed or within twelve months after the date the priority period of thirty months has expired, whichever expires first. The application must justify the request with reasons for failing to file the application within the priority period. If the competent officer views that the applicant has an appropriate reason for not filing an application in the priority period, the competent officer may approve the restoration of the priority right and proceed with the international application. However, restoration of failure to meet a time limit is not possible.

With regard to reinstatement of a lapsed patent due to non-payment of annuity fees, the patentee can submit a reasonable explanation to the Board as to why the annuity fee was not paid on time. If it is satisfied with the reason provided, the Board may restore the patent. There is no specific time limit for this action.

### **[R] Specific Aspects of Regional Patents**

Not applicable in this jurisdiction.

### **[S] Specific Aspects of International Patent Applications (PCT)**

#### *[1] Receiving Office*

Patent Office, Department of Intellectual Property, Ministry of Commerce.

#### *[2] International Searching Authority*

- (1) United States Patent and Trademark Office
- (2) European Patent Office
- (3) State Intellectual Property Office of the People's Republic of China
- (4) Japan Patent Office
- (5) Australian Patent Office
- (6) Korean Intellectual Property Office.

#### *[3] International Preliminary Examining Authority*

- (1) United States Patent and Trademark Office
- (2) European Patent Office
- (3) State Intellectual Property Office of the People's Republic of China
- (4) Japan Patent Office
- (5) Australian Patent Office
- (6) Korean Intellectual Property Office.

*[4] National phase / Regional phase*

A national phase application must be filed by thirty months from the priority date. A Thai translation of the application text must be submitted within thirty months of the first filing date of the application. If translation of the entire application cannot be completed, the title, claims and abstract must be translated and submitted with the application. Within ninety days of the Thai filing date, the translation of the entire application must be submitted.

The average processing time from entering the national phase to grant is five years.

*[5] Payment of fees*

Official fees in THB.

	THB
International fees (first thirty pages)	45,000
Each supplement page	500
Electronic filing with PCT-EASY	42,000
Electronic filing with PCT-SAFE in pdf, jpeg, tif format	39,000
Electronic filing with PCT-SAFE in xml format	36,000
Transmittal fees	3,000

As of July 1, 2015, an applicant who is a natural person, being a national of and residing in Thailand, is entitled to receive a 90% reduction in filing fees

The fees must be paid within one month from the date of receipt of the application by the Patent Office. If the applicant fails to pay the full fee amount, the Patent Office will notify the applicant to pay the outstanding amount, plus a late payment fee within one month after the date specified in the notification. If the applicant fails to do so, the application will be cancelled.

**[T] Fees***[1] Table of official fees*

	THB
On application for a patent.....	500
Fee for publication.....	250
On filing request for examination.....	250
On filing a notice of opposition.....	250
Granting fee.....	500
Conversion fee from patent of invention to petty patent.....	100

Annual fees:

For patents of invention, annuities are due each year starting with the fifth year from filing the application, according to the following schedule:

Year	5	6	7	8
Fees	1,000	1,200	1,600	2,200

9	10	11	12	13	14
3,000	4,000	5,200	6,600	8,200	10,000
15	16	17	18	19	20
12,000	14,200	16,600	19,200	22,000	25,000

	THB
On application to record an assignment of a patent or petty patent.....	250
On application to register a licence under a patent or petty patent.....	250
On application for a compulsory licence.....	500
A duplicate of a lost or damaged patent or petty patent.....	50
Appeal fee.....	500
Copies of documents, each.....	50
Certifying copies of documents:	
(a) of more than ten pages, each copy.....	50
(b) of not more than ten pages, each page.....	5
(c) on filing any application other than those mentioned above.....	50

#### [U] Transitional Provisions

Not applicable in this jurisdiction.

#### [V] Specific Patent Issues

Not applicable in this jurisdiction.

#### [W] Governmental Websites

– [www.ipthailand.go.th](http://www.ipthailand.go.th)

**PART 2 TRADEMARKS****§2.01 SUMMARY****[A] Duration of Registration**

- 10 years from the date of filing the application, indefinitely renewable for further 10-year periods.

**[B] Registrable / Not Registrable**

- Registrable is any mark used to distinguish goods and/or services in trade.
- A mark may be comprised of a photograph, drawing, device, brand, name, word, phrase, letter, numeral, signature, combinations of colours, figurative element or a combination thereof. Taste marks, fragrance marks and sound marks are not registrable.

**[C] Procedure**

- A mark is registered after formal examination and examination as to absolute grounds, and if no successful oppositions to the registration of the mark have been filed within ninety days as from the publication of the application.

**[D] Governmental Websites**

- [www.ipthailand.go.th](http://www.ipthailand.go.th)

## §2.02 DETAILED INFORMATION

### [A] Conventions and Legislation

#### [1] Conventions

- Convention Establishing the WIPO Convention, 1967, since 25 December 1989; and
- Paris Convention, since 2 August 2008.

#### [2] Laws

- The Trademarks Act B.E. 2534 (1991) was amended by the Trademarks Act (No. 2) B.E. 2543 (2000) and the amended Act took effect on 30 June 2000.

### [B] Duration of Registration

The duration of a mark registration is ten years from the date of filing the application and indefinitely renewable for further ten-year periods. Even if there is a valid priority claim, the ten-year term begins on the Thai filing date.

### [C] Requirements for Renewal

A renewal application may be filed within ninety days before the date of the expiration.

There is no grace period and a lapsed registration cannot be revived. However, if a proprietor inadvertently allows a registration to lapse, files a new application for exactly the same mark and for exactly the same goods or services and finds that the new application is in conflict with another mark, the Registrar may take into consideration the applicant's rights as evidenced by the lapsed registration.

The requirements for renewal are as follows:

- (1) request for renewal;
- (2) power of attorney, notarized by a Notary Public (if executed abroad). For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate. Unless otherwise provided in the power of attorney, a single power of attorney may be used to file multiple renewal applications. The agent may submit a valid, durable power of attorney, provided that the trademark owner's particulars therein are up to date;
- (3) the original certificate of registration (at present, this requirement is not strictly enforced); and
- (4) payment of the required fees.

The Trademark Office adopted (as a guideline) the Tenth Edition of the Nice Agreement on 1 March 2013. Therefore, in the case of an application for renewal of a trademark/service mark under the previous Edition, the goods/services may have to be re-classified for renewal. If an application for renewal is found not in accordance with the formal requirements, the Registrar will require the applicant for renewal to correct the renewal application within thirty days, failing which the Registrar will order the cancellation of the registration. If the owner of the mark because of legitimate reasons is not able to comply with the order of the Registrar within said period, the Registrar might extend that period as may be necessary under the circumstances.



**[D] Registrable / Not Registrable**

A trademark is defined in the law as a mark used or proposed to be used on or in connection with goods, to distinguish the goods with which the mark of the owner thereof is used from goods bearing a mark belonging to another person. A service mark is defined as a mark used or proposed to be used on or in connection with services, to distinguish the services using the service mark of the owner thereof from services under the service mark of another person.

To be registrable, a mark must be distinctive. A mark is defined as ‘a photograph, drawing, device, brand, name, word, phrase, letter, numeral, signature, combination of colours, figurative element or a combination thereof’. A mark may be considered distinctive if it enables the public or users to distinguish goods or services with which the mark is used from other goods or services.

A mark having one or more of the following essential particulars will be deemed distinctive:

- (1) a personal name, a surname not being a surname to its ordinary signification, the full name of a legal person under the law on legal persons, or a trade name represented in a special manner;
- (2) a word or words having no direct reference to the character or quality of the goods or services and not being a geographical name as designated by the Minister of Commerce;
- (3) a combination of colours represented in a special manner or a stylized letter, numeral or invented word;
- (4) the signature of the applicant for registration or of a predecessor in his/her business, or the signature of another person with his/her permission;
- (5) a representation of the applicant, or of another person with his/her permission, or of a deceased person with the permission of his/her ascendants, descendants and spouse (if any); and
- (6) an invented device.

An otherwise non-distinctive word, letter, numeral or name may nevertheless be deemed distinctive and registrable if it can be proven as prescribed by the rules of the Minister of Commerce that it has been used in Thailand continuously for a reasonably long period of time such that consumers to whom the goods or services are targeted would know that the goods or services are distinguished from those of others. The mark may be regarded only as distinctive for those goods or services of which such use is proven, and the evidence of use submitted to prove use of the mark must show exactly the same mark as shown in the trademark application.

The following are not registrable:

- (1) State arms or crests, royal seals, official seals, emblems of the Chakri Dynasty, emblems and insignia of royal orders and decorations, seals of office, ministerial, departmental or provincial emblems;
- (2) national flags of Thailand, royal standards or official flags;
- (3) royal names, royal monograms, royal initials or names of royal families;
- (4) representations of the King, the Queen, or of Royal descendants;
- (5) names, word, words or signs which represent the King, the Queen, royal descendants or royal families;
- (6) national flags or emblems of foreign States, flags or emblems of international organizations, seals of foreign heads of State, official emblems and seals of quality control and certification of goods belonging to foreign States or international organizations or names and initials of foreign States or international organizations, unless permission is given by the competent officer of the foreign State or international organization;
- (7) official signs and emblems of the Red Cross, or the names ‘Red Cross’ or ‘Geneva Cross’;
- (8) a mark identical or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Government of Thailand or a government department or State enterprise of Thailand or other agency of the Thai government, or by a foreign government or international organization, except where such medal, diploma,

certificate or mark has been actually awarded to the applicant for the goods and is used in combination with the trademark, provided that the calendar year in which the award was received is indicated;

- (9) a mark which is contrary to public order, morality or public policy;
- (10) a mark which is the same as a generally famous mark in accordance with the rules designated by the Minister of Commerce by notification or so similar thereto that the public may be confused as to the proprietor or origin of the goods, whether or not the mark is registered;
- (11) a mark similar to those under (1), (2), (3), (4), (5), (6) or (7); and
- (12) a geographical name as indicated by Ministerial Announcement effective 20 September 2004.

Colours may be claimed. A mark registered in black and white shall be deemed to be registered for all colours.

#### *[1] Colour marks*

Generally, a single colour cannot be registered. A combination of colours, if distinctive, is registrable.

A combination of more than two colours, which is not tied to any sign, can be registered as a trademark, as long as it is distinctive enough to allow the public to distinguish goods or services bearing such colour mark from the goods or services of another trader. However, in the case a combination of colours lacks distinctiveness, it is still registrable if it acquires distinctiveness through use. In addition to distinctiveness, a colour mark must not be identical or similar to previously registered marks. A registrable mark must also not be contrary to public order, morality or public policy.

#### *[2] Three-dimensional marks*

The words in the definition ‘Shape or configuration of an object’ are interpreted to include three-dimensional marks.

#### *[3] Collective marks*

The law provides for the registration of collective marks. A collective mark is considered as a trademark or service mark used or proposed to be used by companies or enterprises of the same group or by members of an association, cooperative, union, federation, group of persons or any other State or private organization. In principle, the provisions applicable to trademarks are applicable to collective marks *mutatis mutandis*. However, the provisions relating to licensing do not apply to collective marks, and it is not possible to license collective marks.

#### *[4] Certification marks*

The law provides for the registration of certification marks. A certification mark is considered as a mark used or proposed to be used by its owner on or in connection with goods or services of another person to certify the origin, composition, method of production, quality or other characteristics of such goods, or to certify as to the nature, quality, type or other characteristics of such services.

On application for the registration of a certification mark, the rules relating to the use of the mark must be filed. These rules must indicate the origin, composition, method of production, quality or other characteristics to be certified, and must include the rules, procedures and

conditions for authorizing use of the certification mark. When the application is published, the main points of the rules will be indicated. The applicant for registration must demonstrate an ability to certify the characteristics of the goods or services as provided in the rules. The Registrar may ask the applicant to amend the rules as he/she may think fit within sixty days. Registration of a certification mark will be refused if the Registrar is of the opinion that the applicant does not have sufficient ability to certify the characteristics of the goods or services as provided in the rules, or that registration of the mark would not be in the public interest. The rules on the use of a certification mark may be amended, provided that the public interest is not affected.

The owner of a registered certification mark may not use that mark on his/her own goods or services, and may not license other persons to act as certifier through use of the mark. A certification mark may be assigned only with special consent of the Registrar. To obtain such consent, the intended assignee must prove that he/she has sufficient ability to certify the characteristics of the goods or services as indicated in the rules.

#### *[5] Associated marks*

In the case that several marks being registered or applied for, belonging to the same owner and covering goods of the same class or covering goods of different classes but being of the same character, would so resemble each other that the public might be confused or deceived with regard to the owner or the origin of the goods if the marks were used by different persons, the Registrar shall require the marks to be registered as associated trademarks. Associated marks may only be assigned together.

#### *[6] Series of marks*

Not applicable in this jurisdiction.

#### *[7] Other marks*

Taste marks, fragrance marks and sound marks are not registrable.

### **[E] Applicant**

The owner of a mark using or proposing to use the same may apply for its registration.

If an application for registration is filed by more than one applicant for marks being in the Registrar's view the same or so similar that the public might be confused or deceived with regard to the owner or the origin of the goods or services, and the applications relate to goods or services in the same class, or to goods or services of different classes which in the Registrar's view have the same character, the first applicant shall be entitled to registration. The applicant(s) whose applications in such case is (are) rejected may lodge an appeal with the Trademark Board within ninety days.

### **[F] Assignment**

A pending or registered mark may be assigned with or without the business. Assignments must be registered with the Trademark Office to be effective.

The requirements for registration are as follows:

- (1) Deed of assignment, signed by the assignor and the assignee, both signatures notarized by a Notary Public (if executed abroad).
- (2) Power of attorney, signed by the assignee, notarized by a Notary Public (if executed abroad).
- (3) Original certificate of registration for endorsement.
- (4) Payment of the required fee.

Associated trademarks may only be assigned together. Certification marks may only be assigned with the special consent of the Registrar.

### **[G] Requirements for Filing**

#### *[1] Request for registration*

Multi-class and series of marks applications are not available. The applicant must file a separate application for each mark in each desired class of goods or services. Goods and services must be clearly and specifically described. Broad descriptions and the term ‘all goods (or services)’ are not allowed.

The requirements for registration are as follows:

- (1) Request on prescribed form, containing the full name, address and nationality of the applicant, the description of goods or services for which registration is desired (whereby each kind of goods or services must be clearly specified), and an indication of country, date and number of the application whose priority is claimed (if applicable).
- (2) Thirty-five prints of the mark. In the case of an application for a three-dimensional mark, the applicant must submit thirty-five prints of seven views: front, back, left side, right side, top, bottom and perspective.
- (3) In case of an application for the registration of a certification mark: the rules relating to the use of the mark.

Marks not in Thai language must be translated and documents not in the Thai language must be accompanied by a Thai translation.

#### *[2] Appointment of Representative*

Applicants not residing or established in Thailand must appoint an agent in Thailand and elect an address for service at the office of such agent. The address for service must be maintained during the entire lifetime of the registration of a mark, so that the owner of the mark can be contacted through that address by the Registrar. It is a ground for cancellation of the registration of a mark by the Registrar that its owner ceases to have an address for service in Thailand.

#### *[3] Power of Attorney*

The power of attorney must be signed by the applicant, notarized by a Notary Public (if executed abroad), in which the notary must certify that the signature is genuine. If the applicant is a legal entity, the notary must also certify that the person signing the power is authorized thereto and that the applicant entity is an existing legal entity. For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate. Unless otherwise provided in the power of attorney, a single power of attorney may be used to file multiple applications. The power of attorney should be filed with the request for registration.

*[4] Priority*

Paris Convention priority can be claimed. Additionally, a national of any WTO Member State or a national of any country which would allow a Thai applicant to claim priority may claim priority. The priority claim must be stated in the application, providing country, date and number of the priority application.

The applicant must also submit a certified copy of the priority application and a statement from an authorized person certifying that the priority application was in force as of the Thai filing date and has not been cancelled or abandoned. These may be filed with the application or ninety days after the Registrar requests the submission of these.

*[5] Graphical representations*

Graphical representations should be no larger than 5 cm × 5 cm. An official fee of THB 100 is charged for each additional centimetre.

**[H] Procedure***[1] Filing Authority*

Trademark Office, Department of Intellectual Property, Ministry of Commerce.

*[2] Online filing*

Online filing is available. However, a hard copy must be filed to actually secure the application number and filing date.

*[3] Classification*

The Trademark Office has adopted (as a guideline) the Tenth Edition of the Nice Agreement on 1 March 2013. The Examiners use this only as a guideline and are not bound to strictly adhere to the Agreement.

*[4] Search*

When examining an application, the Registrar will search for prior marks in the same class and in other classes, covering goods or services of the same character.

*[5] Examination*

Applications for the registration of a mark are examined as to compliance with the formal requirements, prior marks and as to registrability per se. In case of formal deficiencies, the applicant may amend the application within ninety days.

If a mark is found registrable but in the Registrar's view contains any parts being common to the trade for some types or classes of goods or services, the Registrar may order the applicant within ninety days to disclaim exclusive rights with regard to such part(s) of the mark and/or to make such other disclaimer(s) as may be considered necessary. An application after filing may be amended, but it is not allowed to include additional goods or services or to materially amend the representation of the mark.

If the mark or any essential part thereof is found not registrable per se, the registration shall be refused. The reasons for the refusal will be given.

#### *[6] Registration*

If no opposition is filed or, when an opposition is filed, if the application is approved, the Registrar will order the registration of the mark and inform the applicant of that order. The applicant must then within thirty days pay the registration fee, failing which the application shall be considered abandoned. After payment of the registration fee, the mark will be registered and a certificate of registration will be issued.

#### *[7] Opposition*

Within ninety days from publication of the application, any interested party may file an opposition. The notice of opposition must contain the grounds upon which it is based.

The grounds for opposition are as follows:

- (1) Opposing party has a better title to the mark than the applicant.
- (2) The mark is not registrable per se.
- (3) The application is not in conformity with the law.

A copy of the opposition notice will be sent to the applicant who must file a counter-statement within ninety days, failing which the application will be considered abandoned. After the counter-statement has been filed, the Registrar may require the parties to give additional statements or written explanations or to furnish evidence. The opposition will be decided by the Registrar.

#### *[8] Appeal*

An appeal against refusal, on the Registrar's decision on publication and on an opposition may be lodged with the Trademark Board within ninety days. Further appeal against refusal and on the decision of the Board may be lodged with the competent court within ninety days.

#### *[9] Alteration after Registration*

The owner of a registered mark may voluntarily restrict the list of goods or services by amendment. The representation of a registered mark cannot be altered.

#### *[10] Publication / Public File Inspection*

If the Registrar determines that the application is in compliance with the formal requirements and the mark found registrable per se, the Registrar shall order the application to be published. The Registrar may revoke the order for publication of the application if he/she finds an objection to registration.

Any person may inspect the register of marks and obtain copies and certified copies of documents upon payment of the required fee.

**[I] Nullity and Lapse****(A) Cancellation by Court**

Any interested party may, during five years from the date of the order of the Registrar to register a mark, apply to the competent court for the cancellation of the registration of the mark on grounds that he/she has better title to the mark than the owner of the registration. If the applicant for cancellation proves better title only for some of the goods or services for which the mark has been registered, the court will restrict the registration to the goods or services for which better title has not been proven. Furthermore, any interested person or the Registrar may apply to the competent court for the cancellation of the registration of a mark on grounds that the mark has become so common to the trade for certain kinds or classes of goods or services that the mark has lost its characteristics as a mark.

**(B) Cancellation by Trademark Board**

Any interested person or the Registrar may request the Trademark Board to cancel the registration of a mark on any of the following grounds:

- (1) The mark was at the time of registration not distinctive.
- (2) Mark was at the time of registration prohibited under the law.
- (3) The mark was identical to a mark of another holder and registered for goods or services in the same class or of another class but of the same character.
- (4) The mark so resembles the prior registered mark of another holder that it may cause the public to be confused as to the owner of the mark or the origin of goods.
- (5) The mark is against good moral or public order.
- (6) The owner of the mark had at the time of registration no bona fide intention to use the mark for the goods or services for which it was registered, and in fact there was no bona fide use whatsoever of the mark for such goods or services, or the mark has not been so used for those goods or services during three years immediately preceding the filing of the application for cancellation, except where the owner can prove that the non-use was due to special circumstances in the trade and not to an intention not to use or to abandon the mark for the goods or services for which it is registered.

An appeal against the decision of the Trademark Board may be lodged with the competent court within ninety days.

**(C) Cancellation by Registrar**

The Registrar may cancel the registration of a mark if the owner of the mark ceases to have an address for service in Thailand, or if the owner of the mark has not complied with the conditions and restrictions prescribed by the Registrar on registration. An appeal against the Registrar's decision may be lodged with the Trademark Board within ninety days. An appeal against the decision of the Trademark Board may be lodged with the competent court within ninety days.

The owner of the registration of a mark may request the Registrar for the cancellation thereof. However, if a licence has been granted under the registration, the consent of the licensee is required for such cancellation (except if stipulated otherwise in the licence agreement).

**[J] Use Requirement**

A mark may become vulnerable to cancellation if not used within three years after registration.

**[K] Marking**

Marking is not compulsory. A person who represents a mark as registered in Thailand which is in fact not so registered, or sells or has available for the purpose of sale goods bearing a mark which he/she knows is falsely represented as registered, or gives or offers a service under a mark which he/she knows is falsely represented as registered may be punished by imprisonment of not more than one year and/or a fine of not more than THB 20,000.

Marked products have no implications for awarding compensation in case of past infringement.

**[L] Licences and Registered Users**

Exclusive and non-exclusive licences under a registered mark may be granted for all or some of the goods or services for which the mark is registered. Licence agreements must always be in writing and must be registered with the Trademark Office to be effective. The agent must submit a copy of the licence agreement, certified by a Notary Public as a true and correct copy of the original, a signed and notarized power of attorney from the licensor (if executed abroad), a signed and witnessed power of attorney from the licensee (if executed in Thailand) and a copy of the licensee's business registration certificate (if the licensee is a Thai company).

Licence agreements must contain provisions ensuring the effective control by the owner of the mark over the quality of the goods or services of the licensee, and must specify the goods or services for which the mark is licensed. The Registrar will refuse registration of a licence agreement if he/she is of the opinion that the agreement will cause confusion or deceive the public or is contrary to public order, morality or public policy. The Registrar may impose conditions or restrictions. Use of a mark by a registered licensee in his/her business is deemed use by the owner of the mark. The owner of the mark and the licensee may together apply to the Registrar for the amendment of the registration of the licence agreement or for the cancellation of the registration thereof. Any interested person or the Registrar may request the Trademark Board to cancel the registration of a licence agreement on grounds that the use of the licensed mark by the licensee causes confusion or deceives the public or is contrary to public order, morality or public policy, or on the ground that the owner of the mark is no longer capable to exercise effective control over the goods or services concerned. An appeal against the decision of the Board may be lodged with the competent court within ninety days.

A licensee is not entitled to transfer the licence to any third party or to grant any sublicense, unless if provided otherwise in the licence agreement.

**[M] Pledge and Seizure**

No relevant legislation/jurisprudence in this jurisdiction.

**[N] Infringement***[1] Infringing acts / Non-infringing acts*

The trademark owner has the exclusive rights to use the mark in connection with the goods or services for which the mark is registered.

No registration of a mark shall interfere with any bona fide use by a person of his/her own name or surname or of the name of his/her place of business, or of the name or surname of or the name of the place of business of any of his/her predecessors in business, nor will registration of a mark interfere with the use by any person of any bona fide description of the character or quality of his/her goods.



*[2] Remedies*

The Trademarks Act does not provide for proceedings that can be instituted to prevent, or to recover damages for, infringement of an unregistered mark. However, the Act does not restrict the right of the owner of an unregistered mark to bring legal proceedings, as provided by the Penal Code and the Civil and Commercial Code, against any person passing off goods as those of the owner of the unregistered mark.

If there is clear evidence that a person is committing or is about to commit an act of infringement, an injunction or preventive injunction may be obtained.

*[3] Penal provisions*

A person who counterfeits a registered trademark, service mark, certification mark or collective mark may be punished by imprisonment of not more than four years and/or a fine of not more than THB 400,000. The same penalty applies to a person who imports, sells, offers for sale or has available for the purpose of sale goods bearing a counterfeit mark, or who gives or offers a service under a counterfeit mark. For imitation of a registered trademark, service mark, certification mark or collective mark of another, the penalty is imprisonment of not more than two years and/or a fine of not more than THB 200,000. The same sanctions apply for a person who imports, sells, offers for sale, or has available for the purpose of sale goods bearing an imitation mark, or gives or offers a service under an imitation mark. In case of recidivism within five years of discharge, the maximum penalties are doubled. If the infringing party is a legal entity, the managing director, manager or representative of such entity shall be liable, unless he/she proves that he/she had no knowledge of the infringing acts and had not consented thereto. The law provides that all goods imported, sold, offered for sale or having been available for the purpose of sale in infringement of the exclusive rights to a mark are to be confiscated, without regard to whether a person is convicted for the offence.

*[4] Enforcement and Customs*

When faced with infringement in Thailand, a rights holder may bring a criminal charge against an infringer. An action may be brought before the Central Intellectual Property and International Trade Court (IP&IT Court) or a Complaint can be filed with the police or the Department of Special Investigation (DSI). The IP&IT Court, which is the oldest specialized IP court in ASEAN, exclusively hears IP cases.

Rights holders may also pursue Civil Actions against infringers in the IP&IT Court. Passing-off actions are also possible, based on the tort provisions of the Civil and Commercial Code. Other trademark infringement actions may be taken under the Trademark Act, together with wrongful acts under the Code. In a civil suit, a rights holder can request a permanent injunction against the offender and may try to recover any actual proven damages.

Regarding border measures, the Notification of the Ministry of Commerce on Exports and Imports B.E. 2530 (1987) deals with the importation and exportation of goods with counterfeit trademarks. The Notification sets the procedure whereby trademark owners can request Customs officers to seize infringing goods. The proprietor or agent may complete a form at the Trademark Office. If by an agent, a valid power of attorney must be attached. The Trademark Office will send the completed form and supporting documents, including a certified copy of the mark, to the Customs Department. The written request for intervention by Customs is an essential document that allows Customs to suspend the release of imported/exported goods that infringe trademarks and copyrights. In addition, the request for intervention also provides Thai Customs with a sufficiently detailed description of the goods to which the intellectual property right applies and with the particulars needed to contact the right holder at any time. The right holder who submits a written request for intervention by

Customs is liable for all damages and expenses that may occur to importers, exporters and Thai Customs.

If Customs finds suspect goods, they will contact the proprietor or agent to confirm that the goods are counterfeit.

### **[O] Well-known and Reputed Marks**

The determination of generally well-known marks must consist of the following two criteria:

- (1) The goods or services with which the mark is used are widely distributed, published, advertised or used by any means, such as the mark of a football team, in good faith under normal practices, whether by the trademark owner, agent or licensee in Thailand or abroad, to such an extent that the mark is well known in Thailand among the general public or in the relevant sector of the public.
- (2) The mark must be recognized as well known by consumers.

The Trademark Office has issued a regulation which establishes a procedure for the recordation of well-known marks. A separate application, supported by evidence, is required. Evidence may be submitted on the filing date, and additional evidence may be submitted within sixty days. The regulation established a Board of Well-Known Marks. The Director of the Trademark Office serves as Chairman and Trademark Examiners serve as Members. If the Board agrees that the mark is well known, it will be registered as such. If the Board does not agree, the applicant may file a response within sixty days after receiving the Board's rejection. The Board will summarize the facts and submit the same to the Director-General of the Department of Intellectual Property for his/her consideration.

### **[P] Trademarks and Trade Names**

Dual protection is not prohibited. The owner of a trade name can file an opposition against a pending trademark application or seek cancellation of a registered trademark. If the dispute is not resolved at the Registrar or Trademark Board level, the dispute may be submitted to the Intellectual Property and International Trade Court. The owner of a registered mark may seek injunction against use of a trade name.

### **[Q] Trademarks and Domain Names**

Dual protection is not prohibited. The owner of a domain name can file an opposition against a pending trademark application or seek cancellation of a registered trademark. If the dispute is not resolved at the Registrar or Trademark Board level, the dispute may be submitted to the Intellectual Property and International Trade Court. The owner of a registered mark may seek cancellation of a domain name in court.

### **[R] Trademarks and Appellations of Origin / Trademarks and Geographical Indications**

The Geographical Indications Act took effect on 28 April 2004. The Act defines a geographical indication as 'a name, symbol or any other thing used to identify or used in lieu of a geographical origin, which indicates that the goods originating in said geographic location are of the quality, reputation or specific characteristic of said geographic origin'. Applications for registration may be filed with the Department of Intellectual Property and the application procedure, as well as an opposition against an application for a geographical indication, is similar to a trademark application.

The owner of a geographical indication can file an opposition against a pending trademark application or seek cancellation of a registered trademark. The owner of a trademark can file an opposition against a pending geographical indication application or seek cancellation of a registered geographical indication. If the dispute is not resolved at the Registrar or Trademark Board level, the dispute may be submitted to the Intellectual Property and International Trade Court.

### **[S] Restoration**

Not applicable in this jurisdiction.

A lapsed registration due to non-payment of the renewal fee cannot be revived. However, if a proprietor inadvertently allows a registration to lapse, files a new application for exactly the same mark and for exactly the same goods or services and finds that the new application is in conflict with another mark, the Registrar may take into consideration the applicant's rights as evidenced by the lapsed registration.

### **[T] Specific Aspects of Regional Trademark Registration**

Not applicable in this jurisdiction.

### **[U] Specific Aspects of International Trademark Registration**

Not applicable in this jurisdiction.

### **[V] Fees**

#### *[1] Table of official fees*

Fees in THB, since 7 October 1997.

	THB
On application for registration of a trade or service mark, for one class, for each kind of goods or services.....	500
On application for registration of a certification mark or a collective mark, for one class, for each kind of goods or services.....	500
On filing notice of opposition.....	1,000
Amendment of certification mark rules when application is pending.....	100
On application to register assignment of pending mark.....	1,000
Registration fee for a trademark or service mark, for one class, for each kind of goods or services.....	300
Registration fee for a certification mark or a collective mark, for one class, for each kind of goods or services.....	300
Renewal fee for a trademark or service mark, for one class, for each kind of goods or services.....	1,000
Renewal fee for a certification mark or a collective mark, for one class, for each kind of goods or services.....	1,000

Further fees:	
On application to register an assignment.....	1,000
On application to register a licence, per application.....	500
Registration of a licence agreement, for each agreement.....	1,000
On application for amendments of particulars of the registration of a licence agreement, or on application to cancel registration of a licence agreement.....	200
On application to Trademark Board for cancellation of a registration.....	500
Appeal fee:	
(a) against refusal of registration, or against decision on opposition, or against decision to register same or similar mark in case of honest concurrent use, or against order of disclaimer.....	2,000
(b) in other cases.....	1,000
On request for a certified extract from the Register.....	200
Obtaining certification concerning registration particulars.....	50
Obtaining duplicate of registration certificate.....	100

**[W] Transitional Provisions**

Not applicable in this jurisdiction.

**[X] Specific Trademark Issues**

Not applicable in this jurisdiction.

**[Y] Governmental Websites**

- [www.ipthailand.go.th](http://www.ipthailand.go.th)

**PART 3 UTILITY MODELS****§3.01 SUMMARY****[A] Duration of Registration**

- 6 years from the date of filing the application, twice renewable for 2-year periods with a total of 10 years.

**[B] Registrable / Not Registrable**

- Novelty, susceptibility to industrial application.
- The exceptions of Rule 39 of the PCT apply.
- Also, computer programs and animal and plant extracts are, *inter alia*, subject matters that are explicitly excluded from patentability under the Thai Patent Act, as already mentioned in the above Patent section.

**[C] Novelty**

- Not published anywhere in the world and not publicly used in Thailand.

**[D] Requirements and Procedure**

- Filing languages: any
- Language of translation: Thai
- Time limit for filing translation: 90 days
- A petty patent is registered after formal examination and examination as to registrability per se, but not as to novelty and inventive step.

**[E] Governmental Websites**

- [www.ipthailand.go.th](http://www.ipthailand.go.th)

## §3.02 DETAILED INFORMATION

### [A] Conventions and Legislation

#### [1] Conventions

- Convention Establishing the WIPO Convention, 1967, since 25 December 1989;
- Paris Convention, since 2 August 2008; and
- Patent Cooperation Treaty, since 24 December 2009.

#### [2] Laws

- Patents Act B.E. 2522 of 1979, as amended by Patents Act (No. 2) B.E. 2535 of 1992, and by Patents Act (No. 3) B.E. 2542 of 1999, latest amendments effective since 27 September 1999.

Thailand does not have legislation for utility models. However, petty patents offer similar protection.

### [B] Duration of Registration

The duration of a petty patent registration is six years from the date of filing the application, and can be renewed twice, for two years each time. The total term of protection is ten years from the date of filing the application.

### [C] Requirements for Renewal

The first annual fee is due at the beginning of the fifth year (four years after the filing date). The second annual fee is due at the beginning of the sixth year. The first renewal fee is due at the beginning of the seventh year and the second renewal fee is due the beginning of the ninth year. Annual fees for the fifth and sixth years may be paid sixty days before the anniversary of the filing date. Late payment is accepted without surcharge if paid within sixty days after the anniversary of the filing date. After sixty days, a 30% surcharge is applied. Late payment is not accepted for the seven- to eight-year renewal and nine- and ten-year renewal.

Renewal of the term of a petty patent for two years is to be applied for on payment of the required fee during the last ninety days of the initial six-year period or the last ninety days of the first two-year extension period, as applicable. If renewal has been duly and timely applied for, the petty patent will be deemed registered for the renewal period. No documents are required to pay an annuity or a renewal.

If it takes more than five years for the petty patent to be granted, the annual fees for the fifth year and any additional years must be paid within sixty days after grant.

One may pay all annual fees in a lump sum when the fifth year annual fee is due. If the petty patent is surrendered or cancelled, there is no refund for fees paid in advance.

### [D] Registrable / Not Registrable

To be registrable as a petty patent, an invention must be new and be capable of industrial application, but an inventive step is not required. Therefore, a petty patent may be an appropriate form of protection for inventions of lesser inventive level.

Foods and beverages, machinery for direct use in agriculture, and biotechnological processes for the production of plants or animals may all be protectable as petty patents.

The following are not protectable as petty patents:

- (1) microorganisms existing in nature and their components;
- (2) animals, plants, and animal and plant extracts;
- (3) scientific and mathematical rules and theories;
- (4) computer programs;
- (5) methods of diagnosis, treatment and medical therapy applicable to human or animal bodies; and
- (6) inventions being contrary to public order, morality, health or welfare.

### **[E] Novelty**

An invention is new if it is:

- (1) not disclosed in a published document or in printed matter or by exhibition or public disclosure by any means anywhere in the world before the filing or priority date;
- (2) not widely known or used in Thailand before the filing or priority date;
- (3) not already patented by a patent of invention or a petty patent in Thailand or anywhere else;
- (4) not applied for in an application for a patent of invention or petty patent in another country more than eighteen months prior to filing the application in Thailand where the foreign patent or petty patent has not been issued; and
- (5) not been a subject matter of an earlier patent or petty patent application filed in Thailand or abroad which has been published.

#### *[1] Grace period*

The following are not a bar to novelty:

- (1) disclosure of the invention within twelve months before the filing date due to or in consequence of an unlawful act; and
- (2) disclosure of the invention within twelve months before the filing date by the inventor, including display of the inventor's work at an international or official public exhibition. A person who has exhibited his/her invention at a public exhibition held in Thailand and sponsored or authorized by a State organization and files a patent application relating to that invention within twelve months from the opening date of the exhibition may be considered to have filed the application on said opening date.

### **[F] Applicant**

Applicant can be the inventor or his/her legal successor or assignee (individual, legal entity), or the joint inventors.

The following may apply for and obtain a utility model (known in Thailand as a petty patent):

- (1) Nationals of Thailand and legal entities established in Thailand.
- (2) Nationals of a country being a member of an international Convention or Treaty for patent protection to which Thailand is a party.
- (3) Nationals of a country allowing nationals of Thailand and legal entities established in Thailand to apply for a patent in that country.

- (4) Persons having domicile or a real and effective industrial or commercial establishment in Thailand or in a country being a member of an international Convention or Treaty for patent protection to which Thailand is a party.

If two or more persons have made the same invention independently of each other, the first applicant shall be entitled to a patent. If in such case patent applications have been filed on the same date, the applicants must agree to whom the patent shall be granted. If no agreement can be reached within the prescribed term, the parties may bring the case to the competent court within ninety days, failing which they will be considered to have abandoned their applications.

In the case of an invention made by an employee in the performance of his/her task or under a contract of which the making of inventions is the object, the employer will be entitled to apply for a patent, unless provided otherwise in the contract. If the employer would benefit from the use of the invention, the employee shall be entitled to remuneration in addition to his/her normal salary. The employer shall also be entitled to apply for a patent with respect to inventions made by an employee where the employment contract does not require him/her to carry out inventive activities, if the invention was made using means, statistics or reports made available or at his/her disposal on account of the employment contract, except if agreed upon otherwise. In such case, the employee will always be entitled to remuneration in addition to his/her normal salary. The right of the employee to remuneration as referred to may not be excluded by contract. The Director-General of the Patent Office may upon request establish the amount of the remuneration for the employee, taking into account the salary of the employee, the importance of the invention, the benefits the employer has and may have from the invention and other relevant circumstances. The provisions relating to employees in principle apply also to civil servants.

If a patent is owned by two or more persons jointly, each co-owner may execute the exclusive rights under the patent without the consent of the other co-owner(s). However, a patent may be licensed or assigned (totally or partially) only with the consent of all co-owners. Likewise, a co-owned patent or any claim thereof may be surrendered only with the consent of all co-owners.

### **[G] Assignment**

If an assignee applies for a patent, a deed of assignment, signed by the assignor and the assignee, is to be filed.

A patent may be assigned. Assignments must be made in writing and must be registered in order to be effective.

The requirements for registration are as follows:

- (1) Deed of assignment, signed by the assignor and the assignee, notarized (if executed abroad), in the Thai language or with a Thai translation.
- (2) Power of attorney from the assignee, notarized (if executed abroad). For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate.
- (3) Patent certificate for endorsement.
- (4) Payment of the required fee.

### **[H] Requirements for Filing**

*[1] Obligation to file first with national office*

Not applicable in this jurisdiction.



*[2] Minimum requirements for obtaining filing date*

The minimum requirements for filing petty patent applications are as follows:

- (1) Request on prescribed form, signed by the applicant or his/her agent, and containing the following information:
  - (a) indication of full name, address and nationality of the applicant;
  - (b) full name, address and nationality of the inventor(s) (if not the same as the applicant);
  - (c) the title of the invention;
  - (d) indication of the nature and purpose of the invention;
  - (e) country, date and number of application whose priority is claimed (if applicable);  
and
  - (f) in case exhibition priority is to be claimed, details concerning exhibition concerned.
- (2) Details with regard to the corresponding applications filed in the applicant's home country and in other countries (if any).
- (3) If the applicant is not the inventor, a deed of assignment, signed by the assignor and the assignee. The deed of assignment may still be filed within ninety days from filing the application.
- (4) For filing via the PCT route, the incomplete translation of the application text, which includes only the Thai translation of the title, all claims and abstracts, must be submitted to secure the thirty-month deadline.

The specification, claims and abstract, in any language, provided that a Thai translation is filed within ninety days, and drawings if applicable. The application must contain at least one claim.

*[3] Request for registration*

In principle, the provisions in respect of the application for a petty patent are, *mutatis mutandis*, the same as in the case of a patent of invention, unless otherwise stated.

The requirements for filing petty patent applications are as follows:

- (1) Request on prescribed form, signed by the applicant or his/her agent, and containing the following information:
  - (a) indication of full name, address and nationality of the applicant;
  - (b) full name, address and nationality of the inventor(s) (if not the same as the applicant);
  - (c) the title of the invention;
  - (d) indication of the nature and purpose of the invention;
  - (e) country, date and number of application whose priority is claimed (if applicable);  
and
  - (f) in case exhibition priority is to be claimed, details concerning exhibition concerned.
- (2) Details with regard to the corresponding applications filed in the applicant's home country and in other countries (if any).
- (3) If the applicant is not the inventor, a deed of assignment, signed by the assignor and the assignee. The deed of assignment may still be filed within ninety days from filing the application.
- (4) Specification, claims and abstract, in any language, provided a Thai translation is filed within ninety days, and drawings if applicable.

It is at present not possible to apply for both a patent of invention and a petty patent for the same invention.

*[4] Appointment of Representative*

Applicants not domiciled in Thailand must appoint a local agent who is registered with the Patent Office of Thailand. The agent should remain appointed during the entire life of the petty patent as the address for service to which communications may be sent.

*[5] Power of Attorney / Designation of creator / Other documents*

The power of attorney must be signed by the applicant and notarized by a Notary Public (if executed abroad). For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate. The power of attorney may still be filed within ninety days from filing the application, extendible with another ninety days and further extendible with thirty days.

*[6] Priority*

As of 2 August 2008, priority can be claimed based on the Paris Convention. Additionally, as of 27 September 1999, priority may be claimed from a priority application filed in another country by a national of a World Trade Organization (WTO) Member State or by a national whose country would grant reciprocal rights to a Thai applicant.

To claim priority, the Thai application must be filed within twelve months after the first corresponding application was filed. If there is a priority claim, a certified copy of the priority application must be filed within sixteen months after the priority date. An application with a priority claim will not be approved for publication until a certified copy of the priority application is submitted. An electronic copy will be accepted. No translation of the priority document is required.

If an invention has been displayed at a public exhibition sponsored or authorized by a State organization and held in Thailand, or at an international exhibition, and a petty patent application relating to that invention has been filed within twelve months from the opening date of the exhibition, the application shall, upon request, be deemed to have been filed on said opening date. Exhibition priority shall be claimed on filing. The details in respect of the exhibition and an evidencing certificate are to be furnished together with the patent application.

*[7] Allowable language(s) upon filing / Language(s) of procedure*

The Thai language. Any document in a foreign language must be followed by a translation into the Thai language, within ninety days. No certification of the translation is required. A Thai translation requirement for foreign search reports and grants of patent submitted for the purposes of substantive examination may be waived by the Examiner.

*[8] Description*

The specification with one or more claims must be filed in the Thai language. The specification may first be filed in any other language, provided that the Thai translation is filed within ninety days. Foreign applicants may send a description in English for translation into Thai by the agent in Thailand. The specification must contain a complete, concise and clear description

of the invention that will enable a person having an ordinary skill in the relevant art to execute the invention.

The specification must contain a brief description of the drawings, if drawings are filed. The specification must set forth the best method known to the applicant to exploit the invention and the use of the invention in industry, agriculture, handicraft or commerce as appropriate it is to be described.

In the case of an application relating to an invention in the microbiological field, a culture of the microorganism concerned must be deposited with an authorized depositary authority before or on the filing or priority date, and the certificate of deposit must be filed together with the application or within ninety days from filing. Deposits may be recognized which were made with an International Depositary Authority under the Budapest Treaty of 1977. For these Authorities, see Part II 'General Subject Matter', the Chapter 'Deposit of Microorganisms (Budapest Treaty-International Depositary Authorities)'.

#### *[9] Claims*

Claims must be written in Thai. Foreign applicants may submit claims in English to claim a Thai filing date. A Thai translation must be provided within ninety days of the filing date. The number of claims may not exceed ten. Multiple dependencies of claims are allowed. According to the Thai Patent Office regulation, Claim 1 must be in a two-part claim format in which the first part lists some prior features, followed by the words 'characterized in that,' and the second part clarifies *novel or improved aspects of the invention* that are to be claimed.

#### *[10] Abstract*

An abstract must be filed in the Thai language. Foreign applicants may send an abstract in English for translation into the Thai language by the agent in Thailand.

#### *[11] Drawings*

The drawings must be on sheets of strong, smooth, white, matt and durable paper of international size A4 (21 cm × 29.7 cm) and in three sets. The minimum margins to be observed: top 2.5 cm, left 2.5 cm, right 1.5 cm and bottom 1 cm. Note that any foreign characters in the drawings will have to be replaced by signs in Thai phonetics.

#### *[12] Payment of fees*

The official fee for filing a petty patent application must be paid on filing the application. The fee cannot be paid late.

### **[I] Procedure**

#### *[1] Filing Authority*

Patent Office, Department of Intellectual Property, Ministry of Commerce.

#### *[2] Online filing*

Online filing is available. However, a hard copy must also be submitted to obtain a filing date.

### *[3] Examination*

In principle, the provisions in respect of the grant of a petty patent are, *mutatis mutandis*, the same as in the case of a patent of invention, unless otherwise stated.

Applications for the grant of a petty patent are examined as to formal requirements and patentability per se, but not as to novelty and inventive step.

If it is found that the formal requirements have not been met or that the invention is not patentable per se, the application will be rejected.

Within one year from the date of publication of the registration and grant of a petty patent, the owner of the petty patent and any interested person may request an examination of the invention covered by the petty patent as to novelty and capability of industrial application. In such case, the invention will be so examined and an examination report be submitted to the Director-General of the Patent Office. If the Director-General finds that the requirements of novelty and industrial applicability are met, he/she will inform the owner of the petty patent and the party who requested the examination thereof. If the Director-General is of the opinion that the invention is not new or not capable of industrial application, he/she will order an investigation and notify the owner of the patent thereof, who may then file a statement with his/her reasons within sixty days from the date of receipt of the order. If on completion of the investigation it is found that the invention is not new or not capable of industrial application, an investigation report will be made and submitted to the Patent Board for the cancellation of the petty patent, and the owner of the petty patent and the party who requested the examination be notified thereof.

### *[4] Amendments and corrections*

Amendments to a pending petty patent application may be made. However, no amendment is allowed that would broaden the scope of the application as originally filed or that would add to the essential elements of the petty patent.

### *[5] Registration*

If it is found that a petty patent may be registered, the Director-General of the Patent Office will order a petty patent to be registered and granted to the applicant. The applicant will then be invited to pay the fee for registration and publication within sixty days, failing which the application will be considered abandoned. If the required fee is paid in time, the petty patent will be registered and issued to the applicant.

### *[6] Accelerated registration*

An accelerated examination is available only for applications originating from Japan. The applicant can file a request for the Patent Prosecution Highway (PPH) Pilot Program with the Department of Intellectual Property if the applicant meets the requirements based on the Japan Patent Office application.

### *[7] Opposition*

Because a petty patent is published and granted on the same day, there is no opposition process before grant.

*[8] Appeal*

Against rejection of an application, an appeal may be lodged with the Patent Board within sixty days. If an application is upheld in opposition proceedings, the opposing party may lodge an appeal with the Patent Board within sixty days. During the appeal proceedings, the Board may require the furnishing of evidence or additional statements. The decision on the appeal will be notified to the appellant and the other parties involved, as appropriate. Furthermore, an appeal against the decision of the Patent Board may be lodged within sixty days with the competent court.

*[9] Unity of creation / Divisional applications*

An application may relate only to one invention or to a group of inventions so linked as to form a single inventive concept. If during examination it is found that the requirement of unity of invention is not met, the applicant will be notified and required to file divisional applications.

In such case, the applicant should file the required divisional applications within 120 days from the notification, which if so filed within the 120-day period shall retain the filing date of the parent application. The applicant may appeal against the requirement to divide the application to the Director-General of the Patent Office within 120 days. The decision of the Director-General on such appeal shall be final.

*[10] Branched-off applications*

It is possible to file a petty patent application based on, and parallel to, a pending (PCT/national) patent application.

*[11] Conversion*

It is possible to convert an application for the grant of a petty patent into an application for the grant of a patent of invention and vice versa, provided that the conversion is prior to publication.

*[12] Publication / Public File Inspection*

The registration of the petty patent will be published.

*[13] Withdrawal to prevent publication*

A petty patent may be approved for simultaneous publication and registration about twelve to eighteen months after the filing date. The application will not be published and registered if the applicant does not pay the publication and registration fee. Therefore, an applicant can prevent publication by not paying the fee.

**[J] Nullity and Lapse**

Any interested person and the Public Prosecutor may apply to the competent court for the nullification of a petty patent.

The grounds for nullification are as follows:

- (1) The invention was not novel.
- (2) The invention was unpatentable per se.
- (3) The patentee was not entitled to the petty patent.
- (4) The patentee is an employee and the employer was entitled to a petty patent.

A petty patent may be cancelled by the Patent Board upon request of the Director-General of the Patent Office in the following cases:

- (1) If a compulsory licence has been granted for the petty patent, and it appears that two years after its grant, the patented product has not been manufactured or the patented process not been used in Thailand without legitimate reasons, or there has been no sale or importation for sale of that product within Thailand, and the Director-General of the Patent Office is of the opinion that there are reasonable grounds for the cancellation of the petty patent.
- (2) If the patentee has granted a licence containing a prohibited clause. Before requesting cancellation, the Director-General will order an inquiry and give the patentee and the licensee(s) an opportunity to file their comments within sixty days. If after the inquiry it appears that there are reasonable grounds for the cancellation of the petty patent, the Director-General will submit his/her report to the Patent Board for the cancellation of the patent.

### **[K] Use Requirement**

A petty patent must be sufficiently worked in Thailand within three years from grant or within four years from filing of the application, whichever period is longer. If a petty patent without sufficient legitimate reasons is not so worked, it will become subject to the grant of compulsory licences.

### **[L] Marking**

Marking is not compulsory. A possible marking is ‘Thai Petty Patent No...’, its abbreviation or any foreign word of the same meaning on the product, the container or package of the product, or in the advertisement of the product. It is essential that, when marking is applied, the number of the patent is included. In the case of a pending application, the marking ‘Petty Patent Pending’ may be used. Marking is meant to notify the public that these products are subject to patent protection. If a person infringes a patent despite being aware of its protection, he/she will be liable for a criminal offence and damages. False marking is a criminal offence punishable by imprisonment up to one year and/or a fine up to THB 200,000.

Marked products have no implications for awarding compensation in case of past infringement.

### **[M] Licences**

Exclusive and non-exclusive voluntary licences under a petty patent may be granted. Licence agreements must be in writing and must be registered with the Patent Office. The agent must submit an original licence agreement or copy of the licence agreement, certified by a Notary Public as a true and correct copy of the original, a signed power of attorney from the licensor, a signed power of attorney from the licensee and a copy of the licensee’s business registration certificate (if the licensee is a Thai company). Any power of attorney executed abroad must be notarized by a Notary Public. Any power of attorney executed in Thailand must be witnessed.

The following clauses may not be contained in a licence agreement:

- (1) clauses stipulating any condition, restriction or compensation which would have the effect of unfair competition; and
- (2) clauses which require the licensee to pay compensation for the use of the patented invention after the expiration of the term of the petty patent.

These prohibited clauses shall be void. If, when registration of a licence agreement is requested, the agreement contains any prohibited clause, it will be referred to the Patent Board. If the Board decides that the agreement contains one or more prohibited clauses, registration of the licence will be refused unless the parties intend that void provisions may be severable. In such case, registration of the valid part of the licence agreement may be allowed.

Compulsory licences may be granted in the following cases:

(1) Non-working cases

Any person may apply to the Director-General of the Patent Office for the grant of a compulsory licence under a petty patent if, after the expiration of three years from grant of the patent or of four years from the date of filing the application for the patent (whichever period is longer), that the patentee unjustifiably fails to utilize the patented invention in the following circumstances:

- (a) the product protected by the petty patent is not being produced or the process protected by the petty patent is not being used in Thailand; or
- (b) the products protected by the petty patent or products produced by the process protected by the petty patent are not being sold in Thailand, or are sold there at unreasonably high prices or in a quantity being insufficient to meet domestic demand.

A person applying for the grant of a compulsory licence on any of these grounds must show that he/she has tried to obtain a licence from the owner of the petty patent with reasonable conditions and for a reasonable remuneration but could not succeed in obtaining such licence within a reasonable period. A compulsory licence granted on account of non-working may be terminated upon request if it appears that the reason for granting the licence has ceased to exist and is not likely to recur, provided that the termination does not affect the rights or interests of the grantee of the compulsory licence.

(2) Dependent patents

If the working of any claim in a patent would be likely to constitute an infringement upon a patent belonging to another party, the owner of the first-mentioned patent may apply to the Director-General of the Patent Office for the grant of a compulsory licence under the other patent, provided that:

- (a) the invention of the applicant for the licence involves an important technical advance of considerable economic significance in relation to the invention covered by the other patent;
- (b) the applicant for the licence will allow a cross-licence with reasonable conditions for the use of his/her invention to the owner of the other patent; and
- (c) the licence can be assigned only together with the dependent patent.

Also in this case, the party applying for the compulsory licence must show that he/she has tried to obtain a licence from the owner of the older patent with reasonable conditions and for a reasonable remuneration but could not succeed in obtaining such licence within a reasonable period. As follows from the above, a person applying for the grant of a licence in this case must allow a cross-licence for the use of his/her invention to the owner of the older patent.

(3) Public interest cases

Ministries, public bodies and departments of the State may, either themselves or through others, work a patented invention in the interest of activities of public utility or essential for the national defence, or for the preservation or realization of natural resources or the

environment, or for the purpose of relieving a severe shortage of food or pharmaceuticals, or for another public benefit. In such case, compensation shall be due to the owner of the petty patent or to the exclusive licensee. Furthermore, during a state of war or emergency, the Prime Minister with the consent of the Cabinet may order the exercise of any patent right if necessary for the defence of the country and the security of the nation, provided that a reasonable compensation is paid to the owner of the petty patent.

The owner of the petty patent under which a compulsory licence is granted, or (where applicable) the exclusive licensee shall be entitled to compensation. In cases as meant under (1) and (2), the applicant for the grant of a compulsory licence must propose an amount of compensation, conditions for the exercise of the patent rights and restrictions of the rights of the owner of the patent and the licensee as referred to. The Director-General when deciding upon an application for the grant of a compulsory licence shall establish the compensation, the conditions for the exercise of the patent rights and the restrictions of the rights of the owner of the petty patent and the licensee in accordance with the agreement between the owner of the petty patent and the applicant for the compulsory licence or, if no such agreement can be reached within the prescribed term, as he/she will deem appropriate and provided that:

- (1) the extent and term of the compulsory licence may not be more than required under the circumstances;
- (2) the owner of the petty patent will remain entitled to grant voluntary licences under the petty patent;
- (3) the licence will be aimed primarily to meet the domestic public demand;
- (4) the compulsory licence may be assigned only together with the business or the goodwill of the business concerned; and
- (5) the compensation must be adequate under the circumstances.

An appeal against the Director-General's decision may be lodged with the Patent Board within sixty days. In cases as meant under (3), except in case of war or emergency, a proposal for the compensation and the terms of the licence shall be submitted to the Director-General, and the compensation is to be agreed upon between the Ministry, public body or department in question and the owner of the petty patent.

The owner of a petty patent may apply for an entry to be made in the Register to the effect that licences under the petty patent are available as of right. After such entry has been made, a reduction will apply to the annual fees to be paid in respect of the patent. If such entry has been made, the Director-General of the Patent Office may grant to any person applying therefor a licence under the patent with such terms and conditions as may be agreed upon by that person and the owner of the patent. If the parties cannot agree within the prescribed period, the Director-General shall establish the terms and conditions as he/she would deem appropriate. An appeal against the decision of the Director-General may be lodged within thirty days with the Patent Board, whose decision is final.

### **[N] Pledge and Seizure**

No relevant legislation/jurisprudence in this jurisdiction.

### **[O] Infringement**

#### *[1] Infringing acts / Non-infringing acts*

The scope of protection conferred by a petty patent is to be interpreted on the basis of the claims. The description and drawings may serve to interpret the scope of the claims. The protection may extend to characteristics of the invention which, although not specifically



stated in the claims, in the eyes of a person of ordinary skill in the field to which the invention relates, have properties, utility and effect being similar to those stated in the claims (doctrine of equivalents).

The following acts done without the consent of the owner of a petty patent are deemed infringement:

- (1) In the case of a petty patent for a product, the production, use, sale, having available for the purpose of sale, offering for sale and importation of the patented product.
- (2) In the case of a petty patent for a process, use of the patented process, and the production, use, sale, having available for the purpose of sale, offering for sale and importation of products made by the patented process.

As follows from the above, the protection conferred by a petty patent for a process extends to the products made by application of that process. Reversal of the burden of proof: if in case of an infringement action based on infringement of a process patent (or process petty patent) the plaintiff can prove that the product of the defendant has the same or similar characteristics as the product as made by the patented process, that product will be presumed to have been made by application of the patented process until the defendant has proved otherwise.

The following acts are not considered infringement:

- (1) Acts done for the purpose of education, research or experimentation only, provided that such acts do not unreasonably conflict with a normal exploitation of the patentee and do not unreasonably prejudice the legitimate interests of the patentee.
- (2) The preparation of medicines in individual cases according to a prescription of a physician made by a professional pharmacist or a medical practitioner, and acts done with regard to medicines so prepared.
- (3) Any acts done in respect of applications for the registration of medicines, where the applicant intends to produce, sell or import the patented medicine when the patent expires. So, use of a patented pharmaceutical for the purpose of obtaining government approval in order to produce, sell or import the same after the expiration of the patent would not be deemed infringement.
- (4) Use of equipment being a patented invention on board of ships of a country being a member of an international Convention or Treaty on patent protection to which Thailand is a party, in the machinery or other accessories, when such ships temporarily or accidentally enter the waters of Thailand and provided such equipment is used exclusively for the needs of the ships.
- (5) Use of equipment being a patented invention in the construction or operation or other accessories of aircraft or land vehicles of a country member of an international Convention or Treaty on patent protection to which Thailand is a party, when those aircraft or land vehicles enter Thailand temporarily or accidentally.
- (6) Use, sale, possession for sale, offering for sale or importation of a patented product if the patentee has permitted or allowed the manufacture or sale of that product. Consequently, international exhaustion of patent rights applies now, and parallel importation of patent protected goods manufactured or sold abroad by or with the consent of the owner of the petty patent may be allowed.

#### *[2] Prior user rights*

The production of a patented product or the use of a patented process made without the consent of the owner of the petty patent shall not be deemed patent infringement if the party producing or using the invention has, in good faith, started the production or has acquired the equipment therefor prior to the date of filing the patent application in Thailand.

*[3] Remedies*

Infringement actions are to be brought before the competent court. Available remedies are injunction and award of damages. Preventive injunction may be obtained in case of imminent infringement. The issuance of an injunction will not curtail the patent owner's right to claim damages against the infringer. The amount of damages the infringer may be ordered to pay to the owner of the petty patent will be an amount as the court finds appropriate taking into account the severity of the injury and the lost benefits as well as the expenses necessary to enforce the right of the patent owner.

*[4] Penal provisions*

The law provides that infringing goods in possession of the infringer are to be confiscated. The court may order the destruction of those goods, as well as the taking of other measures to prevent further distribution of the goods.

Petty patent infringement is a criminal offence punishable by imprisonment of not more than two years and/or a fine of not more than THB 400,000.

*[5] Enforcement and Customs*

There are generally two possible means for a patent owner to enforce its patent rights against an alleged infringer: civil and criminal sanctions. If a patent owner wishes to enforce its rights through criminal proceedings, he/she may lodge a Criminal Complaint with the police to conduct a search for and/or seizure of evidence of infringement. In practice, the specialized police unit will undertake patent enforcement only when they are satisfied with the evidence that infringement is taking place.

If a patent owner seeks damages by way of civil remedies, he/she may choose to first issue a warning notice to the infringer before bringing a civil infringement case to court. Regardless of the type of remedy sought, gathering evidence of infringement before commencing an action is crucial, particularly due to the lack of a formal discovery process in Thailand. There is, however, a limited form of document disclosure available under the Civil Procedure Code which involves bringing a motion before the court to seek the disclosure of an identified document by the other party. The court will issue an order for the other party to file the original evidence if the court agrees with such document disclosure orders, and an admission by the other party will be deemed to be in accordance with the facts of the document. A civil proceeding is commenced against an alleged infringer by filing a complaint with the IP&IT Court detailing the patent infringement claim.

With regard to border measures, even though Customs Recordation is available, it provides measures only for copyright and trademark infringement. Section 5 of the Export and Import of Goods Act B.E. 2522 (1979) provides authority to the Ministry of Commerce to issue Notifications on the matters of specifications of goods to be prohibited for export or import. However, currently there are Notifications on the matters of copyright and trademark infringement only. Therefore, at present, there is no specific Notification allowing Customs to seize patent infringing goods at the border.

**[P] Restoration**

Restoration of priority right is not possible.

On the other hand, the PCT applicant may request restoration within two months after the date by which to file an application has passed, or within twelve months from the date the priority period of thirty months has expired, whichever expires first. The application must justify the request with reasons for its failure to file the application within the priority period.

If the competent officer views that the applicant has an appropriate reason for not filing an application during the priority period, the competent officer may approve the restoration of the priority right and precede the international application. However, restoration of failure to meet a time limit is not possible.

With regard to reinstatement of a lapsed patent due to non-payment of annuity fees, the patentee can submit a reasonable explanation to the Board as to why the annuity fee was not paid on time. If satisfied with the reason provided, the Board may restore the patent. There is no specific time limit for this.

### **[Q] Utility Model Application Based on International Patent Application (PCT)**

Thailand joined the PCT effective on 24 December 2009. It is possible to apply for a petty patent in Thailand through filing a PCT international application. The time limit for entering the national phase is thirty months from the priority date. The time limit for filing the translation is thirty months from the priority date.

### **[R] Fees**

#### *[1] Table of official fees*

Official fees in THB, since 29 September 2004.

	THB
On application for a petty patent.....	250
Application for amendment.....	50
Conversion fee from petty patent to patent of invention.....	100
Fee for publication and grant.....	250
Application for examination.....	250

Petty patents have duration of six years from the filing date and may be renewed for two-year terms for a total duration of ten years protection, according to the following schedule:

Annual fees since 29 September 2004:

Year	5	6	7 and 8	9 and 10
Fees	750	1,500	6,000	9,000

### **[S] Transitional Provisions**

Not applicable in this jurisdiction.

### **[T] Specific Utility Model Issues**

Not applicable in this jurisdiction.

### **[U] Governmental Websites**

– [www.ipthailand.go.th](http://www.ipthailand.go.th)

## **PART 4 INDUSTRIAL DESIGNS AND MODELS**

### **§4.01 SUMMARY**

#### **[A] Duration of Registration**

- 10 years from the date of application, no extension.

#### **[B] Registrable / Not Registrable**

- Design patents may be granted for new industrial and handicraft designs.

#### **[C] Novelty**

- Absolute novelty is required.

#### **[D] Procedure**

- A design patent is granted after substantive examination.
- An opposition procedure is provided before registration.

#### **[E] Governmental Websites**

- [www.ipthailand.go.th](http://www.ipthailand.go.th)

## **§4.02 DETAILED INFORMATION**

### **[A] Conventions and Legislation**

#### *[1] Conventions*

- Convention Establishing the WIPO Convention, 1967, since 25 December 1989;
- Paris Convention, since 2 August 2008; and
- Berne Convention for the Protection of Literary and Artistic Works as revised at Paris in 1971.

#### *[2] Laws*

- Patents Act B.E. 2522 of 1979, as amended by Patents Act (No. 2) B.E. 2535 of 1992, and by Patents Act (No. 3) B.E. 2542 of 1999, latest amendments effective since 27 September 1999.

In Thailand, design registrations are known as design patents, and creators of designs are known as inventors or designers. Thus, a patentable design may be known as an invention.

### **[B] Duration of Registration**

The duration of an industrial design registration is ten years from the date of application, subject to the payment of annual fees. No extension may be granted.

### **[C] Requirements for Renewal**

Annual fees are due in advance, before or within sixty days after the anniversary of the filing date. So, the first annual fee is to be paid before or within sixty days after the fourth anniversary of the filing date. The grace period for paying annual fees is 120 days, with a 30% surcharge of the fee due.

All annual fees may be paid at once. There is no refund of prepaid fees if the patent is later cancelled or surrendered.

If an annual fee is not paid in due time nor, with the applicable fine, within the grace period, the patent shall be cancelled, but the Patent Board, on request made by patentee within sixty days and on showing that the patentee was not able for a legitimate reason to pay the annual fee and fine, may extend the period for making payment.

### **[D] Registrable / Not Registrable**

A design is defined in the law as any configuration of a product or composition of lines or colours that gives a special appearance to a product and may serve as a pattern for a product of industry or handicraft.

Protection for designs may be granted in the form of a design patent. Design patents may be granted for new industrial and handicraft designs.

The following are not registrable:

- (1) designs not falling under the definition of a design;
- (2) designs lacking the required novelty;
- (3) designs being contrary to public order or morality; and
- (4) designs prescribed to be unpatentable by Royal Decree.

**[E] Novelty**

Absolute novelty is required.

Not considered new are the following:

- (1) designs of which the representation, subject matter or specification has been disclosed in a published document or printed publication anywhere in the world before the application date;
- (2) designs being widely known or used by others in Thailand before the filing date of the application;
- (3) designs which have been the subject of an application for a patent of invention or for a design patent in Thailand, published before the application date; and
- (4) designs which are so similar to any designs as meant under (1), (2) or (3) that they could be considered to be an imitation.

*[1] Grace period*

Not applicable in this jurisdiction.

**[F] Applicant**

An applicant for a design patent can be the designer (also known as the inventor) or his/her legal successor or assignee (individual, legal entity), or the joint inventors.

The following may apply for and obtain a design patent in Thailand:

- (1) Nationals of Thailand and legal entities established in Thailand.
- (2) Nationals of a country being a member of an international Convention or Treaty for patent protection to which Thailand is a party.
- (3) Nationals of a country allowing nationals of Thailand and legal entities established in Thailand to apply for a patent in that country.
- (4) Persons having domicile or a real and effective industrial or commercial establishment in Thailand or in a country being a member of an international Convention or Treaty for patent protection to which Thailand is a party.

If two or more persons have made the same design independently of each other, the first applicant shall be entitled to a design patent. If in such case applications have been filed on the same date, the applicants must agree to whom the design patent shall be granted. If no agreement can be reached within the prescribed term, the parties may bring the case to the competent court within ninety days, failing which they will be considered to have abandoned their applications.

In the case of a design made by an employee in the performance of his/her task or under a contract of which the making of inventions is the object, the employer will be entitled to apply for the design, unless provided otherwise in the contract. If the employer would benefit from the use of the design, the employee shall be entitled to remuneration in addition to his/her normal salary. The employer shall also be entitled to apply for a design patent with respect to designs made by an employee where the employment contract does not require him/her to carry out inventive activities, if the design was made using means, statistics or reports made available or at his/her disposal on account of the employment contract, except if agreed upon otherwise. In such case, the employee will always be entitled to remuneration in addition to his/her normal salary. The right of the employee to a remuneration as referred to may not be excluded by contract. The Director-General of the Patent Office may upon request establish the amount of the remuneration for the employee, taking into account the salary of the employee, the importance of the design, the benefits the employer has and may have from

the invention and other relevant circumstances. The provisions relating to employees in principle apply also to civil servants.

If a design is owned by two or more persons jointly, each co-owner may execute the exclusive rights under the patent without the consent of the other co-owner(s). However, a design may be licensed or assigned (totally or partially) only with the consent of all co-owners. Likewise, a co-owned patent or any claim thereof may be surrendered only with the consent of all co-owners.

### **[G] Assignment**

If an assignee applies for a design patent, a deed of assignment, signed by the assignor and the assignee, is to be filed.

A design patent may be assigned. Assignments must be made in writing and must be registered in order to be effective.

The requirements for registration are as follows:

- (1) Deed of assignment, signed by the assignor and the assignee, then notarized and legalized in Thai or with a Thai translation.
- (2) Power of attorney from the assignee, notarized (if executed abroad). For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate.
- (3) Patent certificate for endorsement.
- (4) Payment of the required fee.
- (5) Graphical representations of the design.

### **[H] Requirements for Filing**

#### *[1] Request for registration*

Each application for a design patent must relate to a design for use with only one kind of product.

The requirements are as follows:

- (1) Request on prescribed form, stating the full name, address and nationality of the applicant, full name, address and nationality of the designer (if not the applicant), and indicating the number of pictures of the design, the product in relation to which it is to be used and its class according to the classification prescribed by the competent Minister (i.e., the International Classification for Industrial Designs under the Locarno Agreement of 1968).
- (2) One clear and concise claim (no more than one claim).
- (3) Details with regard to the corresponding applications filed in other countries.
- (4) Applicant is not the designer, a deed of assignment, signed by the assignor and the assignee.
- (5) Documents in foreign language must be accompanied by a certified translation in the Thai language.

#### *[2] Appointment of Representative*

Applicants not domiciled in Thailand must appoint a local agent who is registered with the Director-General of the Patent Office of Thailand. The agent should remain appointed during the entire life of the design patent as the address for service to which communications may be sent.

*[3] Power of Attorney*

A power of attorney is required. The power of attorney must be signed by the applicant and notarized by a Notary Public (if executed abroad). For Taiwanese applicants, the signed and notarized power of attorney must also be legalized by a Royal Thai Embassy or Consulate. The power of attorney may still be filed within ninety days from filing the application. This term is extendible with ninety days and further extendible by thirty days.

*[4] Priority*

Priority can be claimed if the application is filed within six months after the priority filing date. Thailand is a member of the Paris Convention. Additionally, a national of any WTO Member State or a national of any country which would allow a Thai applicant to claim priority may claim priority.

A certified copy of the priority application must be filed before the Thai application is approved for publication. An electronic copy will be accepted.

*[5] Description*

The description of the design (optional) must not exceed 100 words.

*[6] Graphical representations*

Four sets of pictures of the design, that is, photographs or drawings on sheets of international size A4 (21 cm × 29.7 cm), must be filed. If photographs or drawing of the product design are shown in a specific colour or colours, only the product design in that colour/colours are protected. However, if the design is in black and white, the protection will be granted for all colours.

The Patent Office requires seven views: front, back, left side, right side, top, bottom, and perspective.

*[7] Multiple deposits*

Each application for a design patent must relate to a design for use with only one kind of product.

**[I] Procedure**

In principle, the official procedure in respect of the application for and the grant of a design patent is, *mutatis mutandis*, the same as in the case of patents of invention including the publication of the application, opposition, examination of the application, amendment of the application, obligation to provide details and documents concerning the corresponding foreign filings, and appeals.

*[1] Filing Authority*

Patent Office, Department of Intellectual Property, Ministry of Commerce.



*[2] Online filing*

Online filing is available, but a hard copy will also need to be submitted to obtain a filing date.

*[3] Classification*

The classification prescribed by the competent Minister is the International Classification for Industrial Designs under the Locarno Agreement of 1968.

*[4] Search*

The Examiner will search for prior art and novelty at the same time, after publication has concluded.

*[5] Examination*

No request for examination is needed. The Examiner will proceed with the examination after the ninety-day publication period has concluded. The examination includes formal examination and examination as to similar previous designs.

*[6] Registration*

If during examination the design is found registrable and the applicant entitled to a registration, and no opposition was filed, or if, where an opposition was filed, it has been decided that the invention belongs to the applicant, the Director-General of the Patent Office shall order that the design be registered.

The applicant will then be invited to pay the granting fee within sixty days, failing which the application will be considered abandoned. When the granting fee has been duly paid, the design shall be registered and shall be granted to the applicant within fifteen days from payment of the granting fee, but not before the expiration of the sixty-day period for lodging an appeal.

*[7] Opposition*

Within ninety days from the date of publication of the application, any interested party may file an opposition. The notice of opposition must contain the grounds upon which it is based and must be accompanied by supporting evidence.

The grounds for opposition are as follows:

- (1) The opposing party has a better right.
- (2) The design is not novel.
- (3) Design is unregistrable per se.
- (4) Applicant is not entitled to apply for registration.
- (5) Applicant is an employee, and the employer is entitled to apply for registration.

A copy of the notice of opposition shall be sent to the applicant, who shall file a counter-statement within ninety days, failing which the application will be considered abandoned. The counter-statement must be accompanied by supporting evidence. The parties may during the opposition proceedings file additional evidence or statements. The opposition is to be decided upon by the Director-General of the Patent Office.

*[8] Appeal*

Against rejection of an application, an appeal may be lodged with the Patent Board within sixty days. If an application is upheld in opposition proceedings, the opposing party may lodge an appeal with the Patent Board within sixty days. During the appeal proceedings, the Board may require the furnishing of evidence or additional statements. The decision on the appeal will be notified to the appellant and the other parties involved, as appropriate. Furthermore, an appeal against the decision of the Patent Board may be lodged within sixty days with the competent court.

*[9] Publication / Deferred Publication / Public File Inspection*

If after the formal examination it is found that the formal requirements have been complied with and that the design appears to be registrable, the publication of the application will be ordered. A design may be approved for publication about twelve to eighteen months after the filing date. The application will not be published if the applicant does not pay the publication fee. Therefore, an applicant can prevent publication by not paying the fee.

Notice will be sent to the applicant to pay the publication fee, which fee must be paid within sixty days. If the publication fee is not paid, the applicant will once more be notified to pay the publication fee, and if that fee is still not paid within sixty days from that notice, the application will be considered abandoned.

With the publication of the application a provisional protection starts. After grant of the registration, compensation may be claimed for infringement retroactive to the publication date, provided that the infringing party was aware of the application or had been informed thereof in writing. Before publication of the application, inspection and making copies thereof is possible only with the written authorization of the applicant.

**[J] Nullity and Lapse**

Any interested person and the Public Prosecutor may apply to the competent court for the nullification of an industrial design or model.

The grounds for nullification are as follows:

- (1) The design was not novel.
- (2) The design was unregistrable *per se*.
- (3) The patentee was not entitled to the design patent.
- (4) The patentee is an employee and the employer was entitled to a design patent.

**[K] Use Requirement**

The Patent Act does not require patented designs to be worked, and the grant of compulsory licences under a patented design is not provided for.

**[L] Marking**

Marking is not compulsory. Possible marking is ‘Thai Patent No...’. It is essential that, when marking is applied, the number of the patent concerned is mentioned. In case of a pending application, this marking may be used: ‘Patent Pending’. False marking is a criminal offence punishable by imprisonment of not more than one year and/or fine of not more than THB 200,000.

Marked products have no implications for awarding compensation in case of past infringement.

### **[M] Licenses**

Exclusive and non-exclusive voluntary licences under a design patent may be granted. Licence agreements must be in writing and must be registered with the Patent Office. The agent must submit an original licence agreement or copy of the licence agreement, certified by a Notary Public as a true and correct copy of the original, a signed power of attorney from the licensor, a signed power of attorney from the licensee and a copy of the licensee's business registration certificate (if the licensee is a Thai company). Any power of attorney executed abroad must be notarized by a Notary Public. Any power of attorney executed in Thailand must be witnessed.

The following clauses may not be contained in a licence agreement:

- (1) Clauses stipulating any condition, restriction or compensation which would have the effect of unfair competition.
- (2) Clauses which require the licensee to pay compensation for the use of the patented invention after the expiration of the term of the patent.

These prohibited clauses shall be void. If, when registration of a licence agreement is requested, the agreement contains any prohibited clause, it will be referred to the Patent Board. If the Board decides that the agreement contains one or more prohibited clauses, registration of the licence will be refused unless the parties intend that void provisions may be severable. In such case, registration of the valid part of the licence agreement may be allowed.

### **[N] Pledge and Seizure**

Not applicable in this jurisdiction.

### **[O] Infringement**

#### *[1] Infringing acts / Non-infringing acts*

The following acts done without the consent of the owner of a design patent are considered infringement:

- (1) Use of the patented design for manufactured products.
- (2) Sale, having available for the purpose of sale, offering for sale and importation of products using the patented design.

Not considered as infringement is the use of a patented design for the purpose of education or research only.

#### *[2] Prior user rights*

Not applicable in this jurisdiction.

*[3] Remedies*

Infringement actions are to be brought before the competent court. Available remedies are injunction, award of damages. A preventive injunction may be obtained in case of imminent infringement. The issuance of an injunction will not curtail the patent owner's right to claim damages against the infringer. The amount of damages the infringer may be ordered to pay to the owner of the patented design will be an amount as the court finds appropriate taking into account the severity of the damage and the lost benefits as well as the expenses necessary to enforce the right of the owner.

In respect of any act of infringement done before grant of the design patent but after publication of the application, where the person doing the act is aware of the application for a design patent or has been informed in writing thereof, damages may be claimed after the design patent has been granted. In view hereof it may be important that, after an application has been published (potential) infringers are duly informed in writing of the application.

*[4] Penal provisions*

The law provides that infringing goods in possession of the infringer are to be confiscated. The court may order the destruction of those goods, as well as the taking of other measures to prevent further distribution of the goods.

Infringement is a criminal offence punishable with imprisonment of not more than two years and/or fine not to exceed THB 400,000.

*[5] Enforcement and Customs*

There are generally two possible means for a patent owner to enforce its patent rights against an alleged infringer: civil and criminal sanctions. If a patent owner wishes to enforce its rights through criminal proceedings, he/she may lodge a Criminal Complaint with the police to conduct a search for and/or seizure of evidence of infringement. In practice, the specialized police unit will undertake patent enforcement only when they are satisfied with the evidence that infringement is taking place.

If a patent owner seeks damages by way of civil remedies, he/she may choose to first issue a warning notice to the infringer before bringing a civil infringement case to court. Regardless of the type of remedy sought, gathering evidence of infringement before commencing an action is crucial, particularly due to the lack of a formal discovery process in Thailand. There is, however, a limited form of document disclosure available under the Civil Procedure Code which involves bringing a motion before the court to seek the disclosure of an identified document by the other party. The court will issue an order for the other party to file the original evidence if the court agrees with such document disclosure orders, and an admission by the other party will be deemed to be in accordance with the facts of the document. A civil proceeding is commenced against an alleged infringer by filing a complaint with the IP&IT Court detailing the patent infringement claim.

With regard to border measures, even though Customs Recordation is available, it provides measures only for copyright and trademark infringement. Section 5 of the Export and Import of Goods Act B.E. 2522 (1979) provides authority to the Ministry of Commerce to issue Notifications on the matters of specifications of goods to be prohibited for export or import. However, currently there are Notifications on the matters of copyright and trademark infringement only. Therefore, at present, there is no specific Notification allowing Customs to seize patent infringing goods at the border.

**[P] Restoration**

Restoration of priority right is not possible.

Also, restoration of failure to meet a time limit is not possible.

If an annual fee is not paid in due time nor within the grace period, the patent shall be cancelled, but the Patent Board, on request made by patentee within sixty days after receipt of the decision of cancellation, and on showing that the patentee was not able for a legitimate reason to pay the annual fee and fine, may extend the period for making payment.

With regard to reinstatement of a lapsed patent due to non-payment of annuity fees, the patentee can submit a reasonable explanation to the Board as to why the annuity fee was not paid on time. If it is satisfied with the reason provided, the Board may restore the patent. There is no specific time limit.

**[Q] Specific Aspects of Regional Design Registration**

Not applicable in this jurisdiction.

**[R] Specific Aspects of International Design Registration**

Not applicable in this jurisdiction.

**[S] Design and Copyright Protection**

Dual protection is not prohibited. The owner of a copyrighted work can file an opposition against a pending design application or seek cancellation of a granted design. If the dispute is not resolved at the Director-General or Patent Board level, the dispute may be submitted to the Intellectual Property and International Trade Court.

**[T] Fees**

*[1] Table of official fees*

Fees in THB, since 29 September 2004.

	THB
Application fee.....	250
Fee for publication of application.....	250
On request for examination.....	250
On filing notice of opposition.....	250
Granting fee.....	500

Annual fees:

Annual fees are due in respect of the fifth and following years from filing, according to the following schedule:

Year	5	6	7	8	9	10
Fees	500	650	950	1,400	2,000	2,750

Further fees:	THB
On application for recordal of an assignment (pending application).....	50
On application for recordal of an assignment (granted design patent).....	250
On application to register a licence.....	250
Duplicate of lost or damaged patent.....	50
Appeal fee.....	500
Copies of documents, not more than ten pages, per page.....	5
Copies of documents, more than ten pages, per page.....	50
Certifying copies of documents, per page.....	50
On filing any application other than those mentioned above.....	50

**[U] Transitional Provisions**

Not applicable in this jurisdiction.

**[V] Specific Industrial Design and Model Issues**

Not applicable in this jurisdiction.

**[W] Governmental Websites**

– [www.ipthailand.go.th](http://www.ipthailand.go.th)