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Thailand Aims to Clear Patent Backlog Through Modified Examination Process

On March 8, 2017, the key stakeholders from Thailand's public and private sectors were called together for a meeting at the office of the Secretary General to the Prime Minister to discuss issues relating to long-term patent pendency and the need to accelerate the patent application process.

The meeting was attended by a range of government departments, including the Department of Intellectual Property (DIP), the Food and Drug Administration (FDA), and the National Science and Technology Development Agency. Also in attendance were members of five private associations: AIDS Access Foundation, FTA Watch, the Intellectual Property Association of Thailand, the Pharmaceutical Research and Manufacturers Association, and the Thai Pharmaceutical Manufacturers Association.

The Deputy Prime Minister, Wissanu Krea-ngam, spoke about the possibility of relying on Section 44 of Thailand's Constitution to expedite patent examination. In encouraging news, he stated that the National Council for Peace and Order (NCPO) has agreed to announce an order to solve the delays and backlog of pending patent applications, which presently number about 12,000. The objective of the meeting was to hold a transparent and public hearing, according to the Constitution. The NCPO decided to temporarily suspend the Section 44 order while holding a public hearing for as many stakeholders as possible before the order takes effect.

Under Section 44, a solution will be announced to solve this long-time problem. There is a precedent case for this type of action that involved the FDA, which had implemented a similar solution in the past to clear its backlog of applications. The solution designed for the patent backlog problem has been proposed and prepared by the DIP and is referred to as "Modified Examination."

Modified Examination

Any patent applicant can seek Modified Examination of a patent application if it meets either of the following two conditions:

1. If the patent application was filed with the DIP more than five years ago but has not yet been published; and/or
2. If the patent application's request for a substantive examination was filed with the DIP more than five years before the date of the announcement of the Section 44 order and:
 - 2.1. The claims of the requested patent application must conform to (i.e., must be exactly the same as) those of the foreign corresponding patent granted in a foreign country/countries and must not overreach beyond the claims that were published in the Thai *Patent Gazette*.

- 2.2. A copy must be provided of the corresponding patent granted in a foreign country that was submitted at the time or after the request for a substantive examination was filed.

The conditions to request a Modified Examination may be subject to changes. The Thai DIP is continuing to review and consider the required conditions.

Under Modified Examination, the patent examiner will closely review the requirements listed above. Once the examination is completed, a patent will be granted immediately.

The DIP expects that the time needed for conducting Modified Examination of an application could be reduced by half from the normal examination period under the current practice.

Corresponding Granted Patents

The corresponding patent must have been granted in one of the following six jurisdictions: Europe, USA, Japan, China, Korea, or Australia.

This is the same list as that of the PCT International Searching Authority and the International Preliminary Examining Authority for Thailand.

Application Form

The DIP will issue a new application form for patent applicants who wish to make a request for Modified Examination. It is possible that, in the application form, the DIP will require that applicants requesting Modified Examination confirm the corresponding patent granted in a foreign country and identify the linkage of each claim that has been conformed to those of the selected foreign corresponding patent to the relevant information appearing in the Thai specification by indicating the page number and line number.

Timing of Request

The request for Modified Examination must be submitted to the DIP within three months from the date of the Announcement of the Section 44 order. After this three-month window has passed, the DIP will not accept any further requests for Modified Examination. As the time of publication of this article, the Section 44 order has not yet been announced.

Official Fee

There will be no official fees required in requesting Modified Examination.

Reexamination

All patents that are granted by the Modified Examination procedure are subject to reexamination requested by an interested person within one year from the granting date. In the case where a request for reexamination is filed, the patent examiner will conduct a substantive examination of the patent in accordance with the patent examination guidelines. A special Examination Committee may be formed for a specific field. For example, in the pharmaceutical field, a representative from the FDA may be one of the committee members. The timeframe to complete the reexamination may possibly be set at one year from the date of filing the initial request.

Outlook

Patent owners should be closely monitoring developments in Thailand for the issuance of this Section 44 order. After the order has been officially announced, patent owners will want to seize the opportunity to pursue Modified Examination for their eligible applications, in order to seek expedited protection for their patents. 🍀