



**Darani Vachanavuttivong**  
Co-Managing Partner  
Managing Director, IP  
darani.v@tilleke.com

## Updates to Trademark and Patent Legal Framework in Thailand

The intellectual property (IP) legal framework in Thailand is constantly evolving to enhance IP registration and protection in the nation, and to account for important changes in the global IP landscape. In the second half of 2017, Thailand will likely see a few legal developments in IP, which could have important implications for brand owners.

### Implementation of Madrid Protocol

Thailand’s amended Trademark Act, which came into force on July 28, 2016, introduces a new chapter on trademark registration of international trademarks, providing the legal foundation for the country to become a member of the Madrid Protocol.

Building on this legal groundwork, the Thai Ministry of Foreign Affairs submitted its instrument of accession to the Madrid Protocol with the World Intellectual Property Organization (WIPO) on August 7, 2017, making Thailand the 99th contracting state under the Madrid System. The protocol will take effect in Thailand on November 7, 2017, 90 days after the submission date, and will enable brand owners in the country to file a single international application and pay one set of fees to protect their marks in 114 territories of 98 other contracting states.

“ Thailand’s amended Trademark Act introduces a new chapter on trademark registration of international trademarks, providing the legal foundation for the country to become a member of the Madrid Protocol ”

### Proposed Amendments to the Patent Act

Various proposed amendments to the Patent Act in Thailand have been the subject of numerous discussions since 2009 and are still in the process of being studied and debated in 2017.

The patent amendments aim to solve and prevent backlogs and long delays in granting patents in Thailand, reduce the periods of pendency for patent registration, and ensure that the duration to grant a patent complies with the time frame of 55 months set by the Licensing Facilitation Act.

According to the latest draft of the patent bill, a number of interesting amendments are being considered, as follows:

1. Introducing a two-step publication process in the patent system:
  - 1.1 The first publication of a patent application will be made within 18 months of the filing date (no opposition can be filed at this stage).
  - 1.2 A second publication will be ordered after the substantive examination, allowing the public to file an opposition against a patent application.
  - 1.3 An official publication fee will be collected at the time that the application is first filed, well before the first publication date. No official fee is required for the second publication.
2. Reducing the time frame for filing a request for substantive examination from five years to three years.
3. Setting the opposition period to be 90 days from the second publication date of the application.
4. Introducing a Trial Committee for Oppositions.
5. Allowing Third-Party Observations to ongoing proceed-

“ The protocol will take effect in Thailand on November 7, 2017, and will enable brand owners in the country to file a single international application to protect their marks in 98 other contracting states ”

- ings before the Department of Intellectual Property’s Patent Office.
6. Changing from compulsory registration of a patent license agreement to a system of recordation of patent license agreements.
7. Increasing the time frame for extension requests for annuity payments from 120 days with a 30% surcharge to 180 days with a 30% surcharge.
8. Extending the deadline to file a revocation petition with the Board of Patents from 60 days to 180 days.
9. Authorizing the Board of Patents to grant an extension for annuity payments, with a 50% surcharge.
10. Increasing the number of patent examiners tasked with approving the recordation of license agreements from one person to three to five persons.
11. Revising procedures for recordation of patent license agreements and introducing new procedures for issuing compulsory licenses in line with the World Trade Organization’s Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).

Trademark owners, especially those with international portfolios, are encouraged to remain updated on the changes that will be brought about when the Madrid Protocol takes effect in Thailand. Meanwhile, patent owners should study the latest draft amendments of the Patent Act to be ready to comply with requirements in the near future, when the bill becomes law. 🚀