

# Informed Counsel

Analysis of Recent Legal Developments in Southeast Asia



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## Updates on Proposed Amendments to the Thai Patent Act

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Thailand's Patent Act was last amended in 1999. Since then, the Department of Intellectual Property (DIP) has gone through numerous rounds of review of potential revisions to the law, with the latest draft of proposed amendments to the Patent Act being published on the DIP website on January 31, 2018. The DIP then arranged for public hearings during February 1-28, 2018, to obtain comments and recommendations on the proposed provisions.

Based on the comments obtained from the public hearing, the DIP plans to complete revisions to the draft amendments and submit them for review by the Ministry of Commerce by August 2018. Following that ministerial review, the draft will need to be further reviewed and approved by the Cabinet, the Council of State, and the National Legislative Assembly. If the legislative process unfolds smoothly, an amended Patent Act is expected to enter into force in early 2019.

Based on the latest published draft, some of the major proposed amendments are as follows:

### Genetic Resources, Genetic Material, Derivative, and Traditional Knowledge

Definitions of genetic resources (GRs), genetic material, derivative, and traditional knowledge (TK) will be added to Section 3, and disclosure of GRs or TK source, access, and benefit-sharing will be required for relevant inventions in patent applications.

### Worldwide Novelty

Section 6 (1) will be revised to consider the state of the art of an invention which was widely known or used by others outside, as well as within, the country before the date of the patent application.

### Double Patenting Avoidance

A patent application that has been filed in Thailand will be considered the state of the art even though it may have been published on or after the date of application in Thailand.

### Grace Period

Disclosure of the subject matter of an invention within 12 months before the date of patent application will not be deemed to be a valid disclosure in considering the state of the art of the invention in the following circumstances:

- ▶ A disclosure which was made or due to be made in consequence of subject matter that has been obtained unlawfully;
- ▶ A disclosure of the subject matter by the inventor; or
- ▶ The invention has been displayed at an international exhibition in Thailand or in a country which is a contracting state of an international convention or agreement of which Thailand is a member, if the exhibition is organized by the Thai government or the government of the relevant contracting-state country.

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## Updates on Thai Patent Act (from page 1)

A patent applicant can claim the date of the disclosure under these conditions to be the priority date of the patent application in Thailand.

### Surgery Method

Items that cannot be protected with a patent will be subject to the surgery method.

### Introduction of Two Rounds of Publications

Patent applications will be published twice. The first publication will be made within 18 months from the filing date in Thailand or the first priority date. The second publication will be made after the substantive examination is completed and the patent has been granted, and it will be open to patent invalidation. Therefore, the opposition period after the first publication will be eliminated and replaced by the invalidation action, which must be filed within 90 days from the second publication date. There is only one official publication fee—the fee for the second publication.

### Divisional Application

An applicant will be able to request the separation of a patent application before the second patent publication date. In the current patent law, this type of request is not allowed, and separating a patent application will be at the discretion and instructions of the patent examiner only.

### Substantive Examination

The time to file a request for substantive examination will be reduced from five years from the publication date to three years from the filing date in Thailand.

### Trial Committee

A committee of three to five members will be appointed to consider oppositions and counterstatements. This committee will prepare a report of their decision for the consideration of the Director-General of the DIP.

### License Agreement

The requirement to register a patent license agreement will be changed to be a recordation of license agreement with the Patent Office.

### Increment Deadline for Annuity Payment

The extended deadline to pay annuity will be increased from 120 days with a 30% surcharge to be 180 days with a 30% surcharge. In addition, the deadline to file a revocation petition with the Board of Patents will be increased from 60 days to 180 days. The Board of Patents may grant a further extension of time to pay annuity fees with a 50% surcharge.

### Patent Compulsory License Committee

A committee of three to five members will be assigned by the Director-General of the DIP to consider and approve any application for a compulsory license filed by an interested person on the condition that the patent has not been used after three years from its date of grant, or four years from its date of application, whichever is later, under Section 46. The committee will also have the authority to consider and approve a compulsory license for dependent patents. That is, when the working of a patent is likely to constitute

infringement of a patent of any other person, then the patentee who wishes to exploit his/her own patent may apply to the Director-General for a license of the other person's patent under Section 47 and 47 *bis*.

### Grant of Compulsory License

A compulsory license may be granted in the case that the Trade Competition Commission has issued an order that a patentee has violated any clause of the Trade Competition Act, resulting in an obstacle to public access to healthcare services.

### New Section 51/1 for Compulsory License

A ministry may use compulsory licenses to produce and export patented medicines to least-developed countries or WTO member countries that do not have pharmaceutical manufacturing capacity or sufficient manufacturing capacity and have submitted a request to import patented medicine to the WTO.

### New PCT Chapter

The draft amendments add a new Chapter of International Application under the Patent Corporation Treaty (PCT), including new sections for applicant qualifications, filing procedures, priority claims, restoration of the right of priority, and more.

### Conversion of Patent

The draft provides a deadline for the conversion of a patent application (before grant) into a petty patent application to be within three years from the filing date of the application. The same process applies for conversion of a petty patent application into a patent application.

### Substantive Examination of a Petty Patent

The period of one year to request that a petty patent be examined substantively will be canceled, and a request for substantive examination can be filed at any time by any person (not only an interested person).

Draft amendments to the Patent Act pose significant implications for patents in Thailand, including in applications, examinations, publications, oppositions, compulsory licensing, conversions, official fees, and other areas

### Changing the Party that Bears the Burden of Proof in the Case of Process Patent Infringement

Section 77 is amended, changing the “infringer” who the patentee of a process patent can sue to be the “manufacturer.”

Although likely to be subject to further changes, the draft amendments to the Patent Act pose significant implications for patents in Thailand, including in applications, examinations, publications, oppositions, compulsory licensing, conversions, official fees, and other areas. It is expected that further updates on the subject will be available after August 2018. 📅