

Patent litigation in Thailand: overview

Nandana Indananda, Piyawat Kayasit and Siraprapha Rungpry
Tilleke & Gibbins

global.practicallaw.com/6-620-8048

SOURCES OF LAW

1. What are the principal sources of law and regulation relating to patents and patent litigation?

The principal sources of law and regulation relating to patents and patent litigation in Thailand are:

- The Patent Act B.E. 2522 (1979), which is the principal source of law relating to patents. It has been amended twice, by the Patent Act B.E. 2535 (1992) and the Patent Act B.E. 2542 (1999). The Patent Act provides the framework for patent protection, including registration and prosecution procedures, licences and renewals, cancellation, burden of proof and penalties. The Patent Act covers not only invention patents, but also petty patents and design patents.
- Subsidiary legislation, in the form of various Ministerial Regulations and Notifications of the Department of Intellectual Property.
- The Act for the Establishment of and Procedures for the Intellectual Property and International Trade Court B.E. 2539 (1996).
- Rules for Intellectual Property and International Trade Cases B.E. 2540 (1997).

If the principal sources are silent on a specific issue, the following will apply:

- Civil Procedure Code.
- Criminal Procedure Code.
- Act for the Establishment of Kwaeng Court (District Court) and its Criminal Procedures.

Additionally, Thailand joined the World Trade Organization (WTO) in 1995 and automatically became a party to the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (TRIPS). It also joined the WIPO Paris Convention for the Protection of Industrial Property 1883 and the Patent Cooperation Treaty 1970 in 2009.

In the event of a conflict, the Patent Act and other applicable local laws will take precedence over international treaties.

COURT SYSTEM

2. In which courts/government bodies are patents enforced?

The Central Intellectual Property and International Trade Court is a specialised court that adjudicates disputes involving IP rights in Thailand, including patent disputes (for example, patent invalidity and patent infringement).

The Thai Patent Office, which is under the Department of Intellectual Property, Ministry of Commerce, does not have

jurisdiction or authority over patent litigation. The Court, not the Patent Office, adjudicates patent invalidation matters.

3. Do the courts/government bodies deal with infringement and invalidity simultaneously or must invalidity actions be brought in separate proceedings?

The Central Intellectual Property and International Trade Court hears infringement and invalidity issues simultaneously. However, the nature of the litigation process depends on whether invalidity is pleaded as a defence or a counterclaim in an action for patent infringement, or whether it is filed by an alleged infringer as a separate action.

If invalidity is filed as a separate action, the court can combine the invalidity action and the main action for infringement, and deal with both issues as part of the same trial. If there is no joinder, the two cases will run before the court in parallel. The court has no obligation to stay the main action for infringement while the invalidity proceeding is ongoing.

4. Who can represent parties before the court and/or government body?

Authorised attorneys or the parties themselves can appear before the court. However, due to the complexity of patent litigation, the owner of the patent should be represented in court by a lawyer with expertise in patent law.

5. What is the language of the proceedings? Is there a choice of language?

All litigation in Thailand is conducted in Thai. Typically, a choice of language is not allowed. A foreign witness who testifies before a Thai court will be required to have an interpreter to translate his/her testimony into Thai.

However, the Central Intellectual Property and International Trade Court allows for proceedings according to agreed terms, so it is possible for the parties to request the court to conduct proceedings in a different language. However, this request is extremely rare.

6. To what extent are courts willing to consider, or are bound by, the opinions of other national or foreign courts, or other national or international bodies, that have handed down decisions in similar cases?

Foreign judgments cannot be directly enforced in Thailand.

However, a foreign judgment can be recognised as proof of a claim adjudicated abroad. In these circumstances, the winning party must

file a court action against the losing party in Thailand and submit the foreign court's judgment as part of the evidence.

To be admitted as part of the evidence, the Supreme Court has ruled that a foreign judgment must be final and conclusive. Therefore, a foreign judgment in default cannot be considered final because it may be revoked at any time, unless the procedural rules of the forum rendering this judgment provide otherwise.

SUBSTANTIVE LAW

7. How is patent infringement assessed?

Thai patent law recognises both literal infringement and infringement by equivalents.

In accordance with the Patent Act B.E. 2522 (1979) (as amended), the scope of a patent will be determined by its claims, which can vary depending on the characteristics of the invention contained in the specifications and drawings. The doctrine of equivalents is recognised by the Patent Act, which permits a patent owner to argue patent infringement even if the claims are not literally infringed. Therefore, the scope of claims can extend protection to characteristics of an invention that an ordinarily skilled person in the field concerned is likely to find similar in property, utility, and effect to those stated in the claims.

There are two methods of enforcing a patent against an alleged infringer, that is, the patent owner can seek civil and/or criminal remedies. In the case of criminal proceedings, the claimant must also prove that the alleged infringer had the requisite intent to commit the infringement.

8. What defences are available to an alleged infringer?

The defendant(s) can raise a defence of non-infringement and/or patent invalidity.

In addition, section 36 of the Patent Act B.E. 2522 (1979) (as amended) contains seven statutory exemptions from patent infringement, including:

- An act for the purpose of study, research, experimentation or analysis, provided that it does not unreasonably conflict with a normal exploitation of the patent and does not unreasonably prejudice the legitimate interests of the patent owner.
- Any act concerning an application for drug registration where the applicant intends to produce, distribute or import the patented pharmaceutical product after the expiration of the patent term.

9. On what grounds can a patent be invalidated?

In accordance with sections 5 to 14 of the Patent Act B.E. 2522 (1979) (as amended), a patent can be invalidated on any of the following grounds:

- A patented invention is not new.
- A patented invention does not have an inventive step (that is, the invention is obvious to a person ordinarily skilled in the field concerned).
- A patented invention is incapable of industrial application.
- A patented invention encompasses non-patentable subject matter, for example:
 - naturally occurring microorganisms and their components, plants or animals;

- extracts of plants or animals;
 - scientific or mathematical principles or theories;
 - computer programs;
 - methods of diagnosing, treating or curing animal or human disease; or
 - anything contrary to public order, morals, health or safety.
- The patent owner is not the true inventor or has no right to file an application.
 - The patent applicant does not comply with section 14 of the Patent Act, which requires the patent applicant to meet at least one of the following conditions:
 - be a Thai national or a juristic person with its principal office in Thailand;
 - be a national of a country that is party to an international convention or treaty for patent protection to which Thailand is also a party;
 - be a national of a country that allows Thai nationals or juristic persons with their principal offices in Thailand to apply for patents; or
 - have a domicile or an actual and earnest ongoing functioning industrial or commercial enterprise in Thailand or a country that is party to an international convention or treaty for patent protection to which Thailand is also a party.

10. Can a court only partially invalidate a patent or transform it into a utility model?

In theory, partial invalidation of a patent should be possible. However, there is no direct precedent on this point to date and the Patent Act B.E. 2522 (1979) (as amended) does not contain an express provision that allows the court to invalidate individual patent claims. Therefore, it remains unclear whether partial invalidation is allowed in Thailand.

The transformation of a granted patent into a utility model is not permitted.

11. Is it possible to amend patent claims during proceedings?

It is not possible to amend patent claims after the patent is granted.

However, it is possible to cancel and surrender patent claims in accordance with the relevant Ministerial Regulations. Clause 4 of Ministerial Regulation No. 27 (B.E. 2522) prohibits the cancellation of patent claims where an invalidation action/defence has already been filed against the patent.

Therefore, once a patent is subject to a lawsuit, it is not possible to amend or cancel the patent claims.

12. Are there any grounds on which an otherwise valid patent can be deemed unenforceable?

Other than the issue of a compulsory licence against a patent, there are no grounds on which an otherwise valid patent can be deemed unenforceable against an infringer.

PARTIES TO LITIGATION

13. Who can sue for patent infringement?

Patent holder

Only a patent owner, or a transferee of a patent from the patent owner, can bring an infringement action in the Thai courts.

Exclusive licensee

There is no legal basis or precedent case in Thailand that expressly permits an exclusive licensee to sue for patent infringement.

Non-exclusive licensee

There is no legal basis or precedent case in Thailand that expressly permits a non-exclusive licensee to sue for patent infringement.

Distributor

There is no legal basis or precedent case in Thailand that expressly permits a distributor to sue for patent infringement.

Other

There is no legal basis or precedent case in Thailand that expressly permits a third party who was injured or sustained damage (as a result of patent infringement) to sue for patent infringement.

14. Under what conditions, if any, can an alleged infringer bring proceedings to obtain a declaratory judgment on non-infringement?

There are no declaratory proceedings in Thailand. Therefore, it is not possible for an alleged infringer to obtain a declaratory judgment on non-infringement.

15. Who can be sued for patent infringement?

A direct infringer can be sued for patent infringement. If a punishable offender is a juristic person (for example, a company), all the persons in charge or representatives of the juristic person will be liable to the penalties prescribed by law for the offence, except those who can prove that the offence was committed without their knowledge or consent.

The Patent Act B.E. 2522 (1979) (as amended) and precedent cases in Thailand are silent on inducement or contributory infringement. However, in cases where patent infringement is a criminal offence, a person who causes another person to commit any offence is an instigator, whether by (*section 84, Thai Penal Code*):

- Employment.
- Compulsion.
- Threat.
- Hire.
- Asking as a favour.
- Instigation.

16. Is it possible to add or remove parties during litigation?

It is possible to add parties during litigation by filing a motion (petition) with the court. Any third person can become a party by:

- Way of an interpleading of his/her own motion, when it is necessary for the acknowledgement protection, or enforcement of a right enjoyed by him/her.
- Way of an interpleading of his/her own motion, when he/she has a legal interest in the result of a case.
- Being summoned to appear in the case:
 - on the application of any party by a motion showing that he/she may sue, or be sued by, such party by virtue of a right of recourse or of a right to compensation, if the judgment is given against such party; or
 - by an order of the court when it thinks fit, or on the application of any party, in the case where the appearance of the third person is required by law, or is deemed necessary by the court in the interests of justice.

It is also possible for claimants to remove defendants by filing a motion withdrawing their claim against the relevant parties.

ENFORCEMENT OPTIONS

17. What options are open to a patent holder when seeking to enforce its rights in your jurisdiction?

There are generally two enforcement options open to a patent owner when seeking to enforce its rights in Thailand, depending on whether the patent owner seeks civil or criminal remedies.

Civil proceedings

If a patent owner seeks damages by way of civil remedies, it can first issue warning notices of infringement to the infringer, before proceeding to launch a civil patent infringement action.

To commence civil proceedings, the patent owner must file a written complaint with the Central Intellectual Property and International Trade Court (Court) and serve a copy of the complaint, along with a summons issued by the Court, on the defendant(s). The complaint must state which patent, and which of the patent claims are allegedly being infringed. In response, the defendant(s) can reply with a defence of non-infringement by filing an answer to the complaint with the Court and serve the defence on the patent owner. A counterclaim for patent invalidity can also be filed with the defence. If a counterclaim is filed, the patent owner can reply by filing an answer to the counterclaim and serving the answer to the counterclaim on the defendant(s).

The court will set a hearing date for the parties to determine if both parties are committed to litigation. If this is the case, the Court will set out the issues to be tried in a settlement of issues hearing. The Court will also determine the:

- Number of witnesses allowed by each party.
- Witness testimony dates.
- Deadlines for pre-trial procedures, including the:
 - conduct of experiments to prove infringement;
 - submission of each party's evidence lists; and
 - submission of evidence particulars.

With regard to gathering evidence, a formal discovery process is not available in Thailand. There is, however, a limited form of document disclosure available under the Civil Procedure Code, which involves bringing a motion (petition) before the court, seeking disclosure of an identified document by the other party. If the court determines that the evidence is relevant to the case, it will issue an order for the other party to file the original evidence. Thai courts will make their decision on a case-by-case basis.

Criminal proceedings

If a patent owner wants to enforce patent infringement through criminal proceedings, the patent owner can choose to pursue a public criminal action with the law enforcement authorities or a private criminal action independently.

For a public criminal action, the patent owner must instruct the police to conduct searches and seizures of evidence of infringement. The police will submit a request for a search and seizure order from the Court. If the police find evidence of infringement, the alleged infringer will be charged and asked to submit a plea. If the alleged infringer pleads not guilty, the designated investigation officer(s) will take evidence from both parties and submit an opinion to the public prosecutor to determine whether or not to prosecute. The criminal case will proceed to the Court if the public prosecutor agrees with the investigation officer's findings and a prima facie case against the alleged infringer can be established and demonstrated. The Court will then determine trial dates.

The police, and particularly the specialised police enforcement teams, will usually only involve themselves in patent enforcement if they obtain strong evidence of infringement.

Alternatively, the patent owner can choose to pursue a private criminal action by filing a criminal complaint with the Court directly. However, this approach is rarely used because it is often difficult for the patent owner to prove the alleged infringer's criminal intent.

Border measures

In practice, border control measures are not available with regard to patent infringement. Border control measures only exist for copyright and trade mark enforcement.

18. Is it compulsory to send a cease and desist letter to an alleged infringer before commencing patent proceedings?

Sending a cease and desist letter to an alleged infringer before commencing patent proceedings is permitted, but is not compulsory.

19. To what extent are courts willing to grant cross-border or extra-territorial injunctions (preliminary or permanent)?

The Thai courts will not grant cross-border or extra-territorial injunctions.

20. To what extent do courts recognise the blocking effect of "torpedo" actions abroad?

The Thai courts will not recognise the blocking effect of "torpedo" actions abroad.

21. To what extent are arbitration, and alternative dispute resolution (ADR) methods (such as mediation), available to resolve patent disputes?

Arbitration

Arbitration is recognised in Thailand under the Arbitration Act B.E. 2545 (2002). Thai arbitration law generally follows the UNCITRAL Model Law on International Commercial Arbitration 1985.

Parties can agree to submit existing or future civil disputes to arbitration, but the agreement must be a written document or mentioned in written correspondence between the parties to be

enforceable. The parties can agree on the choice of arbitrator(s) and the arbitral procedure. In an action involving a contract that contains an arbitration clause, the litigation can be stayed if one of the parties to the contract wants to arbitrate. If neither party mentions arbitration, the case will be litigated.

There are two arbitration institutions in Thailand, the Thai Arbitration Institute of the Ministry of Justice and the Thai Commercial Arbitration Institute of the Board of Trade. Both institutions:

- Are well respected and administered.
- Are supervised by a diverse advisory board.
- Have standard arbitration rules.
- Maintain a list of qualified available arbitrators.

Parties can also choose other qualified professionals and any language to conduct the arbitration, although Thai and English are most commonly used. Foreign attorneys can participate in the arbitration as either arbitrators or legal advisers. For contracts that specify a foreign arbitration institution, the most commonly institutions used are the International Chamber of Commerce (ICC), and Singapore, Hong Kong and London institutions.

If a party refuses to comply with an arbitral award, the award can only be enforced after a court judgment ordering enforcement is obtained. A petition for enforcement of an award must be filed with the court within three years from the date of enforcement of the award. The court can refuse enforcement on limited grounds, such as:

- Lack of capacity by one of the parties.
- Lack of notice given to one of the parties.
- The arbitral award is beyond the scope of the arbitration agreement.
- The arbitral tribunal or arbitration procedure was inconsistent with the arbitration agreement.

There is no distinction between the enforcement of arbitration awards rendered in Thailand and those rendered in foreign countries, provided that an award rendered in a foreign country is governed by a treaty, convention or international agreement to which Thailand is a party. Foreign arbitral awards rendered in member countries of the UN Convention on the Recognition and Enforcement of Foreign Arbitral Awards 1958 (New York Convention) and of the Geneva Protocol on Arbitration Clauses 1923 are recognised and enforced in Thailand, as Thailand is a party to both conventions.

ADR

The Central Intellectual Property and International Trade Court and the Department of Intellectual Property (under the Ministry of Commerce) have each established their own mediation centres for dealing with intellectual property disputes. It is an option for parties to submit their existing or future civil disputes to the mediation centres. If the case is negotiable, its conclusion will be made in the form of a settlement agreement.

COMPETITION AND ANTI-TRUST

22. Can a patent holder bring proceedings claiming both patent infringement and unfair competition for the same set of facts?

There is no provision that prohibits bringing more than one legal claim in a single lawsuit. However, as Thailand does not have unfair competition legislation, a patent holder cannot bring proceedings for unfair competition. It may be possible to bring other types of tort

claims or criminal claims that are similar in nature to an unfair competition claim.

23. To what extent can enforcement of a patent expose the patent holder to liability for an anti-trust violation?

It is highly unlikely that enforcement of a patent will expose the patent owner to liability for an anti-trust violation.

PROCEDURE IN CIVIL COURTS

24. What is the format of patent infringement proceedings?

Patent infringement proceedings in Thailand will be decided by a panel of three judges, which normally consists of two career judges and one associate judge (a qualified external expert appointed by the court). Jury trial is not available in Thailand.

25. What are the rules and practice concerning evidence in patent infringement proceedings in your jurisdiction?

To be admissible, evidence must relate to the facts to be proved by a party to the case and must be included in the list of evidence filed with the court. The list must be filed at least seven days before the date fixed for taking evidence, together with a sufficient number of copies for the other parties to collect from the court. Either of the parties can introduce new evidence after the deadline for filing the list of evidence, if they can show reasonable grounds and the new evidence has bearing on a material point in issue.

Each party can submit technical evidence (documentary evidence, physical evidence and expert witness reports), if documented in their list of evidence. Technical evidence can be challenged by the other parties.

Documents

Subject to limited exceptions, if another party objects to the originality or validity of a document, only the original is admissible. Microfilm, photostat, and facsimile copies are not considered to be the best evidence, although they can be admissible in limited circumstances.

All foreign documents submitted must be originals or certified true copies. Some must be notarised and then legalised by a Thai consulate or embassy. If a document submitted to the court is in English and the parties agree that all or any part of such document need not be translated into Thai, the court can permit the parties to submit the document as evidence in the case without a translation. Other foreign documents must be translated into Thai.

Witness evidence

Witnesses are required to appear before the court to authenticate documentary evidence. As a matter of procedure, the examination of a witness solely at court has been replaced with a requirement for the submission of an affidavit by the witness before the trial. The deadline for affidavit submissions varies depending on the case and the judge. Witness testimonies in the Central Intellectual Property and International Trade Court (Court) will commence with a witness examination (if any), a cross-examination by the opposing party's litigator, followed by a re-examination by the same party's litigator. Proceedings are conducted strictly in the Thai language.

At the request of one or both parties, the court can permit the submission of a written statement of a witness residing in a foreign country to confirm certain facts or opinions, instead of him/her appearing in person. Foreign witnesses who appear in court can use an interpreter during their testimonies.

Expert evidence

The appointment of expert witnesses by the parties and the court is permitted in the Court. The evidential value of expert witnesses' opinions submitted by the parties is lower than those of court-appointed experts. If experts are appointed by each party, the experts can be cross-examined by the opposing parties' lawyers.

26. Is evidence obtained in criminal proceedings admissible in civil proceedings and vice versa?

The evidence obtained in criminal proceedings is admissible in civil proceedings and vice versa.

27. Is evidence obtained in civil proceedings admissible in other civil proceedings?

The evidence obtained in civil proceedings is admissible in other civil proceedings.

28. To what extent is pre-trial disclosure permitted and what other mechanisms are available for obtaining evidence from an adverse party or third parties?

Pre-trial discovery

Discovery is not available in Thailand.

Other mechanisms

Evidence of infringement can be obtained in a number of ways, but frequently parties will rely on investigation teams and other service providers capable of identifying the:

- Location of the infringement.
- Extent of the infringement.
- Identity of the parties involved.

A more appropriate evaluation of the legal options can only be made when evidence has been compiled.

29. What level of proof is required for establishing infringement or invalidity?

The burden of proof in civil cases lies with the claimant, who must discharge the burden of proof in respect of the claims set out in the complaint. The claimant must also prove the damages it is seeking and the method of calculation of such damages. In recent years, the Central Intellectual Property and International Trade Court has started to address the standard of proof and often requires "clear and convincing" evidence for establishing patent invalidity. For patent infringement, the "preponderance of the evidence" standard is applied.

In criminal trials, the burden of proof is "beyond a reasonable doubt" and rests with the prosecution.

For claims regarding the infringement of a process patent, the patent owner must prove that there are similar or identical end products. To escape liability, the defendant must then prove that he/she used a different process from the patented process.

30. How long do patent infringement proceedings typically last?

Patent infringement proceedings from the submission of the pleadings to the first-instance judgment by the Central Intellectual Property and International Trade Court (Court) generally last between 18 and 36 months.

Fast-track procedures

Fast-track procedures are not available in Thailand due to the volume of cases pending before the Court.

Timetable

The timetable of the proceedings depends on the court's and the parties' availability. After the pleadings have been filed by the parties, the court will typically schedule a settlement of issues hearing. The hearing dates and deadlines for the submission of documents and evidence are typically scheduled at the end of the hearing, after the court has determined the issues in dispute. The trial generally commences within 12 months of the settlement of issues hearing. Witness testimonies for both parties may take from two to six months. Closing statements must generally be filed at court within one to two months of the last trial date. Judgment is typically rendered about three to six months after the last trial date.

Delay

The defendant will sometimes tactically attempt to delay proceedings by changing their solicitors or by delaying due to illness. A party can also delay the proceedings by asking the court to postpone the case during settlement discussions, but at the same time fail to negotiate seriously. However, any requests to postpone the hearing can be opposed by the claimant. In these circumstances, the court will consider whether the defendant's request is reasonable and maintains a very strict approach.

PRELIMINARY RELIEF

31. Is preliminary relief available, and if so what measures are available and under what conditions?

Search and preservation orders

In the event of an emergency, the patent owner can seek an Anton Piller order to seize evidence of infringement. The Anton Piller order is designed to preserve evidence of infringement for when a lawsuit is later launched by the patent owner. To apply for an Anton Piller order, the patent owner must show the court that:

- The situation is urgent.
- If the other party or third party involved is notified of the application beforehand, the evidence of infringement will be:
 - damaged;
 - lost;
 - destroyed; or
 - otherwise become difficult to adduce at a later stage.

Injunctions

A patent owner can apply for a preliminary injunction before filing a lawsuit against the infringer. The patent owner must provide the court with:

- Proof of ownership of the patent.
- Evidence of infringement.
- Sufficient reasons/justifications for the preliminary injunction to be requested, such as irreparable harm that cannot be

addressed by monetary compensation or any other form of indemnity.

The patent owner's application for a preliminary injunction is normally conducted as a without notice proceeding. In making its decision, the court will take into account the nature and extent of damages that both parties may incur if the injunction is granted and the difficulty of enforcing the judgment against the alleged infringer.

If a preliminary injunction is granted, the applicant must file an action relating to the preliminary injunction application within 15 days from the date on which the preliminary injunction is granted, or within the period prescribed by the court. If the patent owner fails to do so, the provisional measures will be withdrawn on expiry of that period.

32. Can a protective writ be filed at the court at which an ex parte application may be filed against that defendant?

This mechanism does not exist in Thailand.

33. What is the format/procedure of preliminary injunction proceedings?

General

Preliminary injunction proceedings can be conducted as:

- **Without notice proceedings.** The application is filed with the court before the patent owner files a complaint against the alleged infringer.
- **Adversarial proceedings between the parties.** The application is filed during litigation.

Level of proof

In preliminary injunction proceedings, the applicant must be able to establish a prima facie case of infringement and sufficient reasons for the court to conclude that granting a preliminary injunction is appropriate.

Evidence

The use of documents, affidavits, witnesses and court-appointed or private experts in preliminary proceedings is similar to that in civil proceedings (see *Question 25*). However, as preliminary injunction proceedings are designed to be brief and speedy, the scope of issues to be argued and the evidence and witnesses allowed by the court may be limited.

Patent validity

In the case of an *inter partes* preliminary injunction proceeding, which usually occurs after the patent owner has filed a complaint at court against the infringer, the defendant can present its defence to the court, such as a patent invalidity issue.

Length of proceedings

Preliminary injunction proceedings are intended as an avenue for an injured party to seek interim relief prior to judgment. Therefore, the court will normally conduct these proceedings in an expedited manner. A without notice preliminary injunction proceeding is usually completed within one to seven days from filing the application. However, proceedings may take longer in a sophisticated case involving complex technical issues and/or complicated proof of infringement.

In non-urgent cases, it can take between six and 12 months to obtain an *inter partes* preliminary injunction. This is because the court has no obligation to consider the application on an urgent basis. The court will schedule hearing dates according to its availability, which could be several months after the application is filed. In general, the

time frame depends largely on the scope of issues argued and the number of witness hearings scheduled by the court.

An appeal of a preliminary injunction application that is filed and ruled on during trial can be submitted to the Supreme Court within one month after the issuance of the court order. The main proceedings are not interrupted. For an appeal of a court order during trial concerning a preliminary injunction, the Supreme Court often issues a decision within eight to 12 months.

34. If a preliminary injunction is granted and the main infringement action is finally lost, can the defendant claim damages for the unjustified preliminary injunction?

If a preliminary injunction is granted but the main infringement action is finally lost, the defendant can claim compensation for damage suffered as a result of the preliminary injunction.

In cases where the court issues a preliminary injunction before proceedings have commenced, the court will demand that the applicant posts a bond for an amount determined by the court, taking into account any damage that may be incurred by the prospective defendant. Once the preliminary injunction application is granted, the applicant must deposit the bond with the court within the time frame provided. Otherwise, the injunction order will not be granted.

FINAL REMEDIES

35. What remedies are available against a patent infringer?

Criminal and civil remedies are available for patent infringement, and different methods of enforcement can be followed either simultaneously or consecutively.

If a patent owner pursues a civil action against an infringer, its relief will depend on the remedies claimed in its pleadings.

Permanent injunction

Under section 77 *bis* of the Patent Act B.E. 2522 (1979) (as amended), the court has discretion to define and grant a permanent injunction to the patent owner as the court may deem appropriate, provided that it is within the scope of remedies claimed by the patent owner in the pleadings. Therefore, the scope of the court order for a permanent injunction is limited to the types and extent of injunctive relief requested by the patent owner in the case. If the scope of the injunctive relief requested in the pleadings is broad, the injunction order awarded by the court can also be broad.

The grant of a permanent injunction is not automatic, although in most cases (if not all) a permanent injunction is awarded if the court finds patent infringement. It is possible for the court to deny or limit the grant of a permanent injunction, notwithstanding a finding of patent infringement, if there is a special circumstance or appropriate reason to do so. However, in practice, the Thai courts almost always grants a permanent injunction following a finding of patent infringement.

There are no specific rules for particular subject matters, such as pharmaceutical patents, or for particular types of claimants.

Monetary remedies

The patent owner can seek damages for losses suffered as a result of the infringement. If the patent owner's right has been violated, the court has the power to order the violator to pay compensation for damages to the patent owner in such amount as the court considers appropriate, taking into consideration the:

- Seriousness of the damages.
- Loss of benefits.

- Necessary expenses incurred in enforcing the rights of the patent owner.

However, in practice, the amount of compensation awarded by the court tends to be small and often not sufficient for the patent owner to recoup the economic loss caused by the infringement and the litigation costs. This is due to the fact that the court generally awards only actual proven damages, that is, the actual amount of damages suffered as a direct result of the infringing activities. Punitive damages or exemplary damages are not available in patent litigation in Thailand.

Delivery up or destruction of infringing goods

In addition to damages and injunctive relief, the court can order the destruction of goods that are found to infringe a patent.

Publication of the decision

The patent owner can seek publication of the decision, which is within the court's discretion to grant.

Recall order

The patent owner can also seek a recall order, which is within the court's discretion to grant.

Declaration of infringement and validity

Declarations of infringement and/or validity are not available in Thailand.

Others

If a criminal action is brought against the infringer instead of, or in addition to, a civil action, criminal penalties will also be applicable. Under section 85 of the Patent Act, this may include fines of up to THB400,000 and/or imprisonment of up to two years.

APPEAL PROCEDURE

36. What avenues of appeal are available for a defeated party and under what conditions?

An appeal against the first instance decision of the Central Intellectual Property and International Trade Court can be submitted to the Court of Appeal for Specialised Cases, which was recently established and officially opened for operation on 1 October 2016. The second instance decision of the Court of Appeal for Specialised Cases can be appealed to the Supreme Court if the Supreme Court accepts the appeal. The ruling of the Supreme Court is final.

A motion for permission to appeal must be filed with the court of first instance together with the appeal within one month from the date of the first instance judgment. However, it is possible to obtain an extension of the deadline, which can be done by way of a motion to the court. After receiving the motion and appeal, the court of first instance will immediately send a copy of these documents to the other party, who are entitled to oppose the motion, and then forward the motion and the appeal to the Court of Appeal for decision, without having to wait for the opposition.

If the motion is granted, the other party will have the right to file their response to the appeal with the first instance court within 15 days. This deadline is also extendable. After receiving the response to appeal, the first instance court will forward the appeal and the response to the Supreme Court for consideration.

The Supreme Court may grant permission if it finds that there is any issue in the appeal that sets out a significant matter worthy of clarification. An example of a significant matter would be if the Court of Appeal determined in its judgment a significant question of law in a manner that is inconsistent or contrary to a Supreme Court precedent.

Filing an appeal does not automatically stay enforcement of the judgment of the court of first instance. However, the appellant can apply to the Court of Appeal for a temporary suspension of such judgment by filing an application either together with the appeal or at any time after filing the appeal (but before the Court of Appeal renders its judgment). The Court of Appeal can grant the application if it is based on reasonable grounds. The Court of Appeal can impose any conditions it deems fit on the applicant (for example, ordering the applicant not to dispose of its assets during the appeal).

LITIGATION COSTS

37. What level of cost should a party expect to incur to take a case through to a first instance decision, preliminary injunction proceedings and appeal proceedings?

The costs of patent infringement and validity proceedings vary considerably, depending on the complexity, legal issues, and duration of the case.

The cost of civil patent litigation in the first instance ranges from EUR35,000 to EUR70,000 for an average case. For a highly technical patent infringement action involving a large amount of evidence and many witnesses, it could cost over EUR70,000 at first instance.

For a criminal action, provided that the public prosecutor has decided to proceed with the prosecution, the cost is often lower than a civil action. Generally, the cost of a criminal trial will depend on the extent to which the patent owner and its licensee must assist the public prosecutor in the case. The cost at first instance is normally over EUR15,000 for an average case.

Preliminary injunctions and Anton Piller orders cost between EUR15,000 and EUR35,000 on average. An appeal may cost in excess of EUR15,000, depending on the scope of the issues to be appealed.

In a civil action, the court has discretion to award costs and attorneys' fees against the losing party. However, the losing party may not always be required to pay the attorneys' fees and costs for the prevailing party. In most cases, attorneys' fees and costs awarded by the court are often small and generally not sufficient to allow the prevailing party to recoup its actual litigation costs.

REFORM

38. What are the important developing and emerging trends in your country's patent law?

The Patent Act B.E. 2522 (1979) (as amended) is likely to be amended in the near future. Proposed changes by the Thai Department of Intellectual Property include the following:

- Procedural changes aimed at increasing efficiency and reducing the long periods of pendency for patent registration.
- Post-grant opposition.
- Further clarification of non-patentable subject matters.
- Availability of, and procedures regarding, compulsory licences.
- Provisions on genetic resources and traditional knowledge.
- Provisions on applications under the Patent Cooperation Treaty 1970.

ONLINE RESOURCES

Intellectual Property and International Trade Court

W www.ipitc.coj.go.th

Description. This is the official website of Thailand's Central Intellectual Property and International Trade Court.

Department of Intellectual Property

W www.ipthailand.go.th

Description. This is the official website of Thailand's Department of Intellectual Property.

Practical Law Contributor profiles



Nandana Indananda, Partner

Tilleke & Gibbins

T +66 2056 5879
F +66 2056 5678
E nandana.i@tilleke.com
W www.tilleke.com

Professional qualifications. Former judge, Central Intellectual Property and International Trade Court; Barrister-at-Law, Institute of Legal Education, Thai Bar Association

Areas of practice. Intellectual property; technology; media and telecommunications; dispute resolution and litigation; anti-trust and competition; tax.

Non-professional qualifications. Master of Law and Technology, University of Stockholm; LLM, University of Leicester; LLM, University of Hong Kong; LLM, Ramkhamhaeng University; LLB, Ramkhamhaeng University



Piyawat Kayasit

Tilleke & Gibbins

T +66 2056 5878
F +66 2056 5678
E piyawat.k@tilleke.com
W www.tilleke.com

Professional qualifications. Attorney-at-Law, Thailand

Areas of practice. Intellectual property; dispute resolution and litigation.

Non-professional qualifications. LLM, University of Washington; LLB, Ramkhamhaeng University



Siraprapha Rungpry, Consultant

Tilleke & Gibbins

T +66 2056 5874
F +66 2056 5678
E siraprapha.r@tilleke.com
W www.tilleke.com

Professional qualifications. Intellectual property; regulatory affairs; technology; media and telecommunications.

Non-professional qualifications. LLM, New York University School of Law; JD, Boston College Law School; BA, University of Chicago