



The Legal 500 & The In-House Lawyer  
Comparative Legal Guide  
Thailand: Patent Litigation

This country-specific Q&A provides an overview of the legal framework and key issues surrounding patent litigation law in Thailand.

This Q&A is part of the global guide to Patent Litigation.

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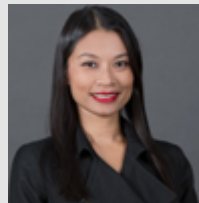
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## 1. **What is the forum for the conduct of patent litigation?**

The Central Intellectual Property and International Trade (IP&IT) Court, which is located in Bangkok, is a specialized court that has exclusive jurisdiction over civil and criminal proceedings in relation to intellectual property and international trade disputes, including patent litigation, in Thailand.

Thailand does not have a jury system, and judges preside over the courts. Further, different numbers of judges and levels of specialized judicial expertise are required, depending on the level and type of court. The IP&IT Court has two types of judges: (a) career judges, who are judicial officials with special training in intellectual property or international trade, and (b) lay judges, called “associate judges,” who are qualified external experts appointed by the court. An IP&IT Court trial is adjudicated by at least two career judges and one lay judge.

## **2. What is the typical timeline and form of first instance patent litigation proceedings?**

Typically, it could take between 18–36 months to obtain the IP&IT Court's first instance decision.

The IP&IT Court normally considers all disputed issues (e.g., patent invalidity, patent infringement, damages) in the same trial proceedings; and there is no separate pre-trial hearing to consider issues of claim construction.

The IP&IT Court often hears invalidity and infringement issues simultaneously. However, the nature of the trial proceedings largely depends on whether patent invalidity is pleaded as a defense or a counterclaim in an action for patent infringement, or whether it is filed by an alleged infringer as a separate civil action. If patent invalidity is challenged in a separate action, the IP&IT Court may combine the invalidity action and the main action for infringement, and deal with both issues as part of the same trial proceedings. If there is no joinder, then the two actions can run before the court in parallel. Although the IP&IT Court has no obligation to stay the main infringement trial while the invalidity proceeding is ongoing, the court often chooses to do so for efficiency.

Further, the IP&IT Court will also consider and rule on damages in the same trial proceedings.

## **3. Can interim and final decisions in patent cases be appealed?**

The final decisions of the first instance in a patent infringement lawsuit made by one judge at the IP Court can be appealed unconditionally to a panel of three judges of the same court. The appellate decision made by this panel of judges can in turn be appealed to the Supreme Court, provided that the value of the claim exceeds NT\$ 1.5 million. It usually takes approximately one to one and half year to conclude the proceeding at the second instance and six months to one year to conclude the proceeding at the third instance.

The IP Court in some cases will render interim decisions on specific issues, such as invalidity or infringement. Those interim decisions could not be appealed until the IP Court renders its final decisions on a patent litigation.

#### **4. Which acts constitute direct patent infringement?**

The exclusive rights of a patentee are set out in Section 36 of the Patent Act, B.E. 2522 (1979), as amended ("Patent Act"), which include:

(a) in the case of product patents, the exclusive rights to produce, use, sell, possess for sale, offer for sale, or import into Thailand the patented products;

(b) in the case of process patents, the exclusive rights to use the patented process, produce, use, sell, possess for sale, offer for sale, or import into Thailand products made by the application of the patented process.

The conduct of any of the foregoing actions without the consent of the patentee constitutes direct patent infringement. Both criminal and civil remedies are available for patent infringement and different enforcement tracks may be followed.

#### **5. Do the concepts of indirect patent infringement or contributory infringement exist? If, so what are the elements of such forms of infringement?**

The Patent Act and precedent cases in Thailand are silent on indirect or contributory infringement.

However, in the case of criminal proceedings of patent infringement wherein patent infringement is a criminal offence, the Penal Code, B.E. 2499 (1956) ("Penal Code") is expected to assist.

Specifically, Section 84 of the Penal Code defines an instigator as "whoever, whether by instigation, compulsion, threat, employment, encouragement or otherwise, causes another person to commit any offence." A patentee (plaintiff) in a criminal proceeding must prove that the alleged infringer possessed the requisite intent to commit the criminal offence of patent infringement.

#### **6. How is the scope of protection of patent claims construed?**

The scope of a patent will be determined by its claims, pursuant to the Patent Act, Section 36 bis, first paragraph, which states that "the right of the patentee to the patented invention under Section 36 shall be delimited by the claims. In deciding what the delimitations of the claims are, the characteristics of the invention as set forth in the specification and drawings shall be considered."

In addition, Thai law recognizes the doctrine of equivalents under the second paragraph of Section 36 bis.

## 7. What are the key defences to patent infringement?

- Patent invalidity;
- Non-infringement;
- Statutory exemptions from patent infringement, which include:
  - the Bolar provision;
  - the experimental/educational use exception;
  - exhaustion;
  - prior use;
  - compounding of medicines by a physician's prescription; and
  - use of patented device on a ship, aircraft or other vehicle when the ship, aircraft or other vehicle enters Thailand either temporarily or by accident, provided that such ship, aircraft or other vehicle is registered in a country that is party to a treaty for patent protection to which Thailand is also a member.

## 8. What are the key grounds of patent invalidity?

A patent can be invalidated based on one of the following grounds:

- the patented invention is not new;
- the patented invention does not have an inventive step (i.e., is obvious to a person ordinarily skilled in the art);
- the patented invention is incapable of industrial application;
- the patented invention constitutes a non-patentable subject matter, such as 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; and anything contrary to public order, morals, public health or welfare;
- The patentee is not the true inventor or has no right to file the patent application;
- The patent is held by an unqualified person (i.e., a non-WTO national/resident).

## 9. **How is prior art considered in the context of an invalidity action?**

Prior art under Thai patent law includes:

- 1) an invention that was widely known or used by others in Thailand before the patent application date;
- 2) an invention for which the details were described in a document or printed publication or otherwise disclosed to the public in Thailand or overseas before the patent application date;
- 3) an invention that was already been patented in Thailand or overseas before the patent application date;
- 4) an invention for which a patent application has been filed overseas and 18 months have elapsed since the patent application date; and
- 5) an invention for which a patent application has been filed in Thailand or overseas and the patent application has been published before the patent application date in Thailand.

In the context of an invalidity action, prior art references cannot be combined for the purposes of assessing novelty, but they can be combined for purposes of assessing an inventive step (obviousness).

## 10. **Can a patentee seek to amend a patent that is in the midst of patent litigation?**

A patent cannot be amended after grant, except for cancellation of the patent or patent claim(s). If an invalidation action has already been filed against the patent, cancellation of patent claims is also prohibited.

## 11. **Is some form of patent term extension available?**

Patent term extension is not available in Thailand.

## 12. **How are technical matters considered in patent litigation proceedings?**

In most cases, the IP Court judges will consider technical matters by themselves, with the help of technical

examination officers. IP Court judges will not refer a technical issue to an independent institute unless said technical issue is extremely complicated and requires expertise of an independent institute. Both parties in some cases are allowed to present expert witness testimony to establish technical facts.

**13. Are there procedures available which would assist a patentee to determine infringement of a process patent?**

It is rather difficult under Thai law for a patentee to obtain direct evidence of process patent infringement; however, the Patent Act provides for reversal of the burden of proof in respect of a process patent. That is, if the patentee can prove that the product produced by the alleged infringer has the same or similar characteristics as the product made using the patented process, then the alleged infringer must prove that he or she used a different process than the patented process.

**14. Are there established mechanisms to protect confidential information required to be disclosed/exchanged in the course of patent litigation (e.g. confidentiality clubs)?**

A party may submit a petition requesting the court to impose a mechanism to protect confidentiality of information or to seal certain evidence or records.

**15. Is there a system of post-grant opposition proceedings? If so, how does this system interact with the patent litigation system?**

As of 2019, there is no post-grant opposition proceedings. However, note that the Patent Act may be amended in the near future.

**16. To what extent are decisions from other fora/jurisdictions relevant or influential, and if so, are there any particularly influential fora/jurisdictions?**

Thai courts are not bound by and do not have to follow decisions from other national or foreign courts.

Also, foreign judgments cannot be directly enforced in Thailand.

However, Thai courts may take foreign decisions into account (if they are final and conclusive decisions) as part of evidence in the case if the decisions are directly relevant to the disputed issues (e.g., decisions in respect of foreign equivalents of a patent in suit) or if they provide persuasive authorities on a legal principle that is unclear under Thai law, and for which there is no precedent in Thailand.

**17. How does a court determine whether it has jurisdiction to hear a patent action?**

The IP&IT Court has exclusive jurisdiction over civil and criminal proceedings in relation to patent disputes (and all other intellectual property matters), including patent invalidity and patent infringement disputes, that occur within Thailand.

**18. What are the options for alternative dispute resolution (ADR) in patent cases? Are they commonly used? Are there any mandatory ADR provisions in patent cases?**

The IP&IT Court and the Department of Intellectual Property (under the Ministry of Commerce) each provide mediation services for dealing with intellectual property disputes. However, ADR is not commonly used in the context of patent disputes in Thailand.

**19. What are the key procedural steps that must be satisfied before a patent action can be commenced? Are there any limitation periods for commencing an action?**

A patent action is commenced by filing a written complaint with the IP&IT Court that clearly states standing, the disputed patent, the cause of action, and the remedies requested. The complaint, along with a summons issued by the Court, is then served on the defendant(s).

The Patent Act itself does not specify the limitation period. However, based on the Civil and Commercial Code, the right of claim for damages arising from a wrongful act shall be barred by prescription after the lapse of one year from the day of the wrongful act and the person bound to make compensation having become known to the injured person or ten years from the day the wrongful act was committed. This

section also applies to patent infringement, which is a form of wrongful act. Therefore, a civil patent infringement action should be filed with the court within one year from the date that the patentee becomes aware of the infringing act and the identity of the infringer, or within ten years of the date of the infringing act, whichever occurs first. If the infringing act continues, then the limitation period is extended accordingly.

20. **Which parties have standing to bring a patent infringement action? Under which circumstances will a patent licensee have standing to bring an action?**

Only a patentee, or a transferee of a patent from the patentee, can file a patent infringement action in the Thai court. There is no legal basis or precedent which expressly allows a patent licensee (exclusive/non-exclusive) to bring an action.

21. **Who has standing to bring an invalidity action against a patent? Is any particular connection to the patentee or patent required?**

In Thailand, patent validity can only be challenged in court. Pursuant to Section 54 of the Patent Act, any “interested party” can file a patent invalidation action to challenge the validity of a Thai patent any time after the patent is granted and before it expires.

The party challenging the patent must be able to demonstrate that it is an “interested party,” though this hurdle is easy to overcome. For example, a plaintiff could assert that it is injured in some way by incorrect restrictions to the market by virtue of the existence of the patent.

22. **Are interim injunctions available in patent litigation proceedings?**

Interim injunctions are available but difficult to obtain in Thailand. These include an *ex parte* preliminary injunction, sought prior to filing an action, and an *inter parte* interim injunction, sought during an action.

In general, the patentee (plaintiff) must provide the court with (a) proof of ownership in the patent, (b) evidence of infringement, and (c) sufficient reasons or justifications for the preliminary/interim injunction to be granted, such as (urgent) irreparable harm which cannot be addressed by monetary compensation or



any other form of indemnity.

The patentee's application for a preliminary injunction (prior to the filing of the lawsuit) is typically conducted as an *ex parte* proceeding. The IP&IT Court will take into account the nature and extent of damages that both parties may incur if the preliminary 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 provided by the court. If the applicant fails to do so, the provisional measures will be withdrawn on expiry of that period. On the other hand, an application for an interim injunction (after the patent action has commenced) is normally conducted as an *inter parte* proceeding.

**23. What final remedies, both monetary and non-monetary, are available for patent infringement? Of these, which are most commonly sought and which are typically ordered?**

Both criminal and civil remedies are available depending on the methods of enforcement (i.e., criminal or civil actions) pursued by the patentee. Available final remedies are as follows:

- Permanent injunction
- Damages
- Destruction of infringing products
- Criminal penalties (if a criminal action is brought instead of or in addition to a civil action) of fines of up to THB 400,000, imprisonment of up to two years, or both.
- Other relief sought by the patentee, such as publication of the decision, recall order, etc.

Among these, permanent injunctions and damages are most commonly sought and awarded by the court if patent infringement is found. Punitive damages or exemplary damages are not available in patent litigation in Thailand.

**24. On what basis are damages for patent infringement calculated? Is it possible to obtain additional or exemplary damages?**

The court generally awards only actual damages, which is the proven amount of damages that the plaintiff actually suffered as a direct result of the defendant's infringement. Punitive damages or exemplary

damages are not available in patent litigation in Thailand.

25. **How readily are final injunctions granted in patent litigation proceedings?**

The IP&IT Court has discretion to define and grant a permanent injunction as the court may deem appropriate, provided that it is within the scope of remedies requested by the plaintiff in the complaint. Consequently, if the scope of the injunctive relief requested in the complaint is broad, then the permanent injunction awarded by the court can also be broad. However, the court may deny or limit the permanent injunction, if there is an appropriate reason to do so.

26. **Are there provisions for obtaining declaratory relief, and if so, what are the legal and procedural requirements for obtaining such relief?**

Declaration of infringement or validity is not available in Thailand.

27. **What are the costs typically incurred by each party to patent litigation proceedings at first instance? What are the typical costs of an appeal at each appellate level?**

- First instance level: USD 50,000 to USD 100,000 for a moderate case. A highly technical case involving a large amount of evidence and a number of expert witnesses could cost over USD 100,000.
- Appellate level: USD 20,000 to USD 50,000. (Appeals are normally conducted by written submissions only.)

28. **Can the successful party to a patent litigation action recover its costs?**

In a civil patent litigation action, the court has discretion to award costs and attorney's fees against the

losing party, although the amount awarded is generally lower than the actual litigation costs incurred by the prevailing party. Also, the court does not always award the attorneys' fees and costs for the prevailing party in every case.

29. **What are the biggest patent litigation growth areas in your jurisdiction in terms of industry sector?**

Pharmaceutical industry.

30. **What do you predict will be the most contentious patent litigation issues in your jurisdiction over the next twelve months?**

Pharmaceutical patents.

31. **Which aspects of patent litigation, either substantive or procedural, are most in need of reform in your jurisdiction?**

Both substantive and procedural aspects of Thai patent litigation are in need of reform. The Patent Act is ambiguous and silent on many issues, which makes assessment of patent validity and infringement challenging and subject to discretion and different levels of understanding of the individual judge adjudicating each case. Also, the procedural aspect of patent litigation needs to be modernized and streamlined for fairness and efficiency.

32. **What are the biggest challenges and opportunities confronting the international patent system?**

Consistent interpretation and effective enforcement of the patent law.