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## Thailand's DIP Revives Proposed Amendments to the Patent Act

On September 30, 2020, Thailand's Department of Intellectual Property (DIP) published its latest draft of the proposed amendments to the Patent Act B.E. 2522 (1979). The amendment process, which is taking place in two phases and has been pending for several years, began to take a higher profile in February 2018 with the convening of public hearings on the proposed new legislation. After a series of committee meetings through November of that year, the cabinet approved a set of proposed amendments in January 2019.

The second phase in the amendment process then began, focusing on industrial design registration procedures and provisions to facilitate Thailand's accession to the Hague Agreement Concerning the International Registration of Industrial Designs. The Committee on Patent Act Reform held nine meetings from March to November 2018, and then further discussed these proposed amendments with the Committee on the Law for the Development of Patents over seven meetings from February to July 2019.

To get comments and recommendations on the proposed second-phase amendments, the DIP arranged public hearings from September to October 2019, before submitting the proposed amendments to the cabinet and Council of State for approval. On March 27, 2020, the Council of State requested that the proposed amendments from both phases be combined into a single Patent Act, thus shelving the initial idea of a separate Design Patent Act.

Accordingly, the DIP made plans to revise the proposed amendments, using comments obtained during public hearings, before sending them to be reviewed by the Ministry of Commerce, the cabinet, the Council of State, and finally the parliament. This process began with the publication of the proposed amendments on the DIP's website on September 30, 2020, and public hearings that were held through October 31, 2020.

### Patent-Related Amendments

While these proposed amendments are likely to undergo changes as this process progresses, the published draft law does give a good indication of what issues will be addressed, and how. Some of the major matters proposed for amendment are identified below.

**Genetic resources, genetic material, derivative works, and traditional knowledge.** Genetic resources (GRs), genetic materials, derivative works, and traditional knowledge (TK) are covered in Section 3, which also requires disclosure of the source of GRs and TK used for development of the claimed inventions. Documents and agreements relating to access and benefit-sharing must be submitted along with applications for patent registration.

**Worldwide novelty.** While inventions were already required to be "state of the art," now the phrase "outside the

country" has been added to this. This makes explicit that inventions widely known or used either within or outside the country will not be patentable.

**Avoidance of double patenting.** The draft law explicitly states that an application for a patent filed in Thailand, even if it is published on or after the date of a later-filed application in Thailand, will be considered state of the art. In contrast, the current Patent Act is not so clear on this point.

**Grace period for disclosure prior to filing.** There are two instances when disclosures of the subject matter of an invention no more than 12 months before the filing of a patent application will not be taken into account when considering the state of the art: a disclosure occasioned by the subject matter having been obtained unlawfully; and a disclosure made by the inventor, the applicant, or their authorized representative.

**Non-patentability of surgical methods.** Surgical methods considered methods of treatment are added to the list of non-patentable subject matter.

**Dual publication.** Patent applications will be published twice—first within 18 months of the application's filing date in Thailand, and again after substantive examination. The opposition period is 90 days from the second publication date, at the end of which the patent will be granted if there has been no opposition.

**Divisional applications.** Applicants may request separation of a patent application before the second publication of the patent. Under the current Patent Act, such a request is not allowed and separating a patent application can only be done at the discretion of the patent examiner.

**Period of examination requests.** The time allowed for requesting substantive examination is reduced to three years from the application's filing date in Thailand (down from the present five years from the publication date).

**License agreements.** Whereas the current law requires registration of a patent license agreement, the draft amendments change this requirement to recordation of a license agreement with the Patent Office. In addition only a formality examination will be conducted.

**Error correction in granted patents.** The draft law permits correction of trivial errors found in a patent after it has been granted, provided that the corrections do not expand the scope of the patent.

**Surcharge for extended annuity payments.** The director-general of the DIP may designate a patent abandoned if its annuity fee is not paid by the due date, but the Board of Patents may revoke the director-general's order. Upon receiving a revocation petition, the board may grant an extension to pay the annuity fee, subject to a 50% surcharge.

**Compulsory licenses.** The draft law authorizes ministries, sub-ministries, and government departments to issue a compulsory license to import patented medicines for public use, in line with Article 31 bis of the TRIPS Agreement. It also provides for the issuance of a compulsory license to export medicines to countries with insufficient or no pharmaceutical manufacturing capacity in pharmaceuticals.

**PCT rules.** The draft law adds a new chapter for international applications under the Patent Cooperation Treaty, covering issues such as applicant qualifications, filing procedures, priority claims, restoration of priority rights, and so on.

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### *Requesting substantive examination for a petty patent.*

The period for requesting substantive examination of a petty patent will be changed to six years (an increase from the current one year). A request for substantive examination can be filed at any time by any person, regardless of their interest in the petty patent.

### **Proposed Amendments on Design Patents**

The draft law also includes significant changes to industrial design registration procedures and introduces provisions that prepare for Thailand's accession to the Hague Agreement-Concerning the International Registration of Industrial Designs. The major proposed amendments on design patents can be grouped into three main categories, as laid out below with reference to specific sections in the draft law.

### **Procedures**

***Examination of design patent applications.*** The DIP has proposed moving the examination of designs prior to the publication of the design patent application in Thailand. After examination, the DIP will publish the design patent application and will accept oppositions for up to 90 days from the publication date.

***Deferral of design publications.*** Deferral of publication of a design patent application can be requested in compliance with rules and procedures specified in the DIP director-general's guidelines. Regardless of any deferral request, the DIP will still be able to proceed with examination or the issuance of office actions.

***Period for responding to office action.*** The deadline for responding to an office action will be shortened from the current 90 days from the date of receipt, to 60 days. Furthermore, the applicant can request a one-time extension for another 60 days.

### **Protection**

***Partial design patent applications.*** The draft law allows for the protection of partial designs, as the definition of "designs" in Section 3 includes "part of an article that is visible to the naked eye."

***Related design patent applications.*** The definition of "principal design" makes room for the protection of related designs. The related design patent application must have the same title, the same applicant, and subject matter that bears similarity to the principal design. It must be filed within six months from the filing date of the principal design, and the protection of the related design starts from the filing date of the principal design. An assignor can assign the related designs, together as a set, to one assignee for the same period of time.

***Duration of protection.*** Including all possible renewals, the proposed amendments allow 15 years of protection for a design patent—five years after the design patent is registered and granted, plus two renewals of five years each.

***Request for late renewal payment.*** For a renewal filed more than six months after the expiration date, the patent owner needs to request that the director-general allow late payment of the renewal fees, which would incur a surcharge of 50 percent.

***Patent design rights.*** The new draft elaborates on the patent design owner's rights, which are applicable only within the boundaries of the drawings, title, claims, and brief description of the design patent. Likewise, any materials, properties, utilization, or benefits from a feature not within the rights of a design patent are not allowed to be exploited. Examples of non-infringement include:

- ▶ Private use with no commercial interest or conflict with the owner's benefits;
- ▶ Research and experiments that do not conflict with the owner's benefits;
- ▶ Prior use with good faith;
- ▶ Temporary or emergency entry by equipment of ship vessels; and
- ▶ Use of the design after receiving consent from the owner.

### **Hague Agreement**

Upon Thailand's accession to the Hague Agreement, the DIP will begin to receive international applications for protection under the agreement. Applicants must have Thai nationality or be Thai-registered juristic persons with residence or real industrial or commercial activities in Thailand. International applications designating Thailand will be considered to have been filed in Thailand as well, with the WIPO registration date becoming the Thai filing date. As Thailand currently accepts only single-design patent applications, applications for multiple designs (which are accepted by WIPO) will be rejected by the DIP and will need to be filed as single-design applications. Applicants will be able to do this by amending or separating their multiple-class application, as described in the paragraph on single-design patent applications above. The designation fee for Thailand will be at the agreement's standard designation fee level three, which means the DIP will examine the novelty and other substantive grounds of the design.

### **Government Fees**

The government fee for filing a design patent application is increased significantly to THB 3,000 (approximately USD 100) from the previous THB 250 (about USD 8) per application. However, the government fee will now include filing fee, publication fee, and registration fee.

The government fee for requesting an extension of time will be THB 5,000 (approximately USD 660). Design renewal fees will be paid for a period of five years, replacing the current annual payment, and will be charged at THB 20,000 (approximately USD 660) for the first renewal, and THB 49,000 (approximately USD 1,620) for the second renewal.

### **Outlook**

The proposed amendments to the patent and design regimes mentioned above represent significant potential developments in Thailand's regulatory regime for patents and industrial designs. These draft amendments are likely to undergo additional changes in response to comments received during the public hearings and further revisions by the cabinet and the Council of State. Further updates on this subject are expected to become available around end of 2021. 🐞