

THAILAND

PATENTS, INDUSTRIAL DESIGNS, AND PETTY PATENTS

GENERAL NOTES

Thailand is not yet a member of the Patent Cooperation Treaty (PCT). However, on August 2, 2008, Thailand became a party to the Paris Convention. Thailand is carrying out the necessary legal procedures for accession to obtain membership in the PCT. It is generally expected that adhesion to the PCT will occur in the near future.

The right to apply for patent protection is not restricted to Thai nationals and nationals of countries that have reciprocal patent agreements with Thailand. The right to apply for patent protection will also be extended to nationals of countries which are parties to international patent treaties or conventions to which Thailand is also a party.

Since Thailand is a member of the Paris Convention, the World Trade Organization (WTO) and thus the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), nationals of the Paris Convention and WTO member countries will receive the same protection accorded to Thai nationals. All foreign applicants entitled to national treatment will be able to claim priority right within 12 months of the first foreign filing date in case of an invention application, and within 6 months of the first foreign filing date in case of a design application.

If priority is not claimed, it is possible to file a non-convention application within 18 months from the first filing date provided that the application has not been made available to the public by any means prior to the date of filing the Thai application. However, an invention for which a patent application was first filed more than 18 months before is no longer patentable in Thailand. Also, a design that has been made available to the public by any means prior to filing in Thailand is not patentable.

NOVELTY

Section 6 of the Thai Patent Act describes an invention as “new” or qualified for worldwide novelty if it does not form part of the state of the art, which includes one of the following inventions:

- (1) An invention which was widely known or used by others in the country before the date of the application for patent.
- (2) An invention the subject matter of which was described in a document or printed publication, displayed or otherwise disclosed to the public, in this or a foreign country before the date of the application for patent.
- (3) An invention already patented or petty patented within or outside the Kingdom prior to the date of application for patent.
- (4) An invention for which an application for a patent or a petty patent has already been filed outside the Kingdom for over 18 months prior to the date of application for patent, but the patent or petty patent has not been granted.
- (5) An invention for which an application for a patent or a petty patent has already been filed within or outside the Kingdom and the application has been published before the date of filing the application in the Kingdom.

According to Section 9 of the Thai Patent Act, the following inventions are not patentable under the Act:

- (1) Microorganisms which naturally exist and their components, animals, plants, or extracts from animals or plants.
- (2) Scientific and mathematical rules and theories.
- (3) Computer programs.

- (4) Methods for diagnosing, treating, or curing human or animal diseases.
- (5) Inventions which are contrary to public order or morality, public health, or welfare.

INSTRUCTION NOTES

1. APPLICATION FOR PATENT

Section 5 of the Thai Patent Act states that a patent may be granted only for an invention in respect of which the following conditions are satisfied:

- (1) The invention is new.
- (2) It involves an inventive step.
- (3) It is capable of industrial application.

It is not possible to file a voluntary divisional application in Thailand. Filing a divisional application is possible only when the Examiner rejects the unity of invention and instructs the applicant to file a divisional application based on Section 26 of the Thai Patent Act. Instructions for filing a divisional application will occur in the substantive examination stage.

For a convention filing, the date of a first patent application outside the Kingdom may be claimed by the applicant for a subsequent corresponding application filed in the Kingdom within a period of 12 months from such date.

For a non-convention filing, if a corresponding foreign application has been filed outside of Thailand, provided that no more than 18 months have passed from such date and the application has not been published or disclosed, then with the priority application number and filing date information the English specification can immediately be filed to obtain the earliest Thai filing date. The priority document need not be submitted.

If no priority application has ever been filed anywhere outside of or in Thailand, then the English specification, abstract, and claims must first be translated into Thai for submission to the Thai Patent Office.

Filing Information and Documents

The following information and documents are required to file an application for a patent in Thailand:

- (1) The name(s) and address(es) of the applicant(s) and inventor(s).
- (2) The serial number(s) and filing date(s) of the priority document(s).
- (3) Instruction if priority is to be claimed.
- (4) A new notarized Power of Attorney for each application or a notarized general Power of Attorney (legalization is not required unless the applicant is Taiwanese). Sample formats are shown on pages 10 and 11. The effective date of authorization must be on or prior to the Thai filing date. The document and its Thai translation should be filed together with the application. If this is not possible, both documents can be filed within 90 days from the Thai filing date of the application. This deadline can be extended for another 90 days and again for another 30 days. In order to avoid submitting a notarized Power of Attorney for each case, the applicant can provide a notarized general Power of Attorney which can be used for patent applications filed by the same applicant and it may become specific by filling in the title of the invention or design.
- (5) An original executed Deed of Assignment bearing the signatures of the inventor(s) as the Assignor(s) and the applicant(s) as the Assignee(s). All date fields must be dated on or prior to the Thai filing date. Neither notarization nor legalization is required. The document and its Thai translation should be filed together with the application. If this is not possible, both documents can be filed within 90 days from the Thai filing date of the application. This deadline can be extended for another 90 days

and again for another 30 days. A certified copy of the first-filed Assignment with an original executed Deed of Acceptance of Assignment can be filed in lieu of the Deed of Assignment.

- (6) If the applicant is the inventor, then an original executed Statement of Applicant's Right to Apply for a Patent must be filed in lieu of the Deed of Assignment.
- (7) Certified copy(ies) of the priority document(s) if claiming priority. This document must be submitted to the Thai Patent Office within 16 months from its first filing date but before publication of the Thai application. A request for an extension to submit the priority documents is not available.
- (8) An English specification of the invention, including claims, abstract, drawings (if any), and sequence listing (if any). This document must be provided with the filing instructions or at least 2 days before the filing deadline of the application. The English specification can be filed to secure the filing deadline of the application. Its Thai translation must be filed within 90 days from the Thai filing date of the application with no chance of obtaining an extension of time.

Preliminary Examination

Once the application is filed and the formal requirements have been fulfilled, the application will proceed to the preliminary examination stage which usually takes 1 to 1.5 years to complete. The Examiner conducts the preliminary examination to check the validity of the formal documents and determines the patentability of the invention as described in the specification, claims, drawings, and abstract.

Publication

Once the preliminary examination is completed, the notification for paying the publication fee will be issued. The average length of time for a patent application to be published may range from 2 to 3 years from the Thai filing date. The publication payment must be paid within 60 days from the day of receipt of the notification.

After the publication fee is paid, it would take approximately 2-4 months for the application to be published for opposition in the Thai Patent Journal for a period of 90 days. The opposition can only be filed within this 90-day period. A petition for rejection of a patent can be filed at any time after the patent is granted, but before the expiry date of the patent.

Substantive Examination

Filing a request for substantive examination of the application is possible once the application has been published. The deadline to file the request is within 5 years from the publication date. Copies of the examination and search reports, office actions and patent granted in the corresponding application filed in other examining countries, e.g., the U.S.A., the U.K., and E.P., must be submitted to the Thai Patent Office as the examination of the Thai application will be initiated upon submission of the document(s) to the Patent Office.

The examination of the Thai application will be based on the patent(s) and Office Action(s), as the Examiner will verify whether the specification and claims of the Thai case conform to those of the documents. If there is no conformity, the Examiner will issue an Office Action instructing the applicant to amend the specification and claims of the Thai application to conform to the corresponding patent, and file the amendment as a response to the Office Action within 90 days from the date of receipt of the Office Action. The deadline to file a response to the Office Action can be extended twice for 90 days and 30 days, respectively, without incurring any expenses. Therefore, it is always recommended that the applicant amend the claims when a request for substantive examination is filed. However, if the applicant prefers to wait for the notification from the Thai Examiner, then the cost relating to amendment of claims will not be incurred at this stage.

Registration

If no further amendment is required in the application, the notification to pay the registration fee will be issued which takes approximately 2 years from when the request for substantive examination is filed. The

payment of the registration fee must be made within 60 days from the date of receipt of the notification. After the registration fee is paid, the application will be granted a patent and then annuities can be paid.

A patentee of a granted invention patent has the sole rights to produce, use, sell, possess for sale, offer for sale, or import the patented products into Thailand. For a process patent, a patentee has the rights to use the process stated in the patent, produce, use, sell, possess for sale, offer for sale, or import into Thailand products made by the application of the patented process.

Annuity

Annuity payments must be made to maintain the patent. The first annuity (the so-called "fifth annuity") is due on the beginning of the fifth year from the Thai filing date and additional fees shall be payable annually thereafter. The payment of the fees shall be made within 60 days after the beginning of the fifth year of the term of the patent and of every year thereafter. However, if a patent is granted after the beginning of the fifth year of the term of the patent, the first annual fee shall be paid within 60 days after the grant of the patent. If any annual fee is not paid within the prescribed period, the patentee shall pay the fee together with a surcharge of 30% of the unpaid fee within 120 days.

2. APPLICATION FOR INDUSTRIAL DESIGN

To be eligible for a design patent, a design must be new. The term of a design patent is 10 years from the date that the application is filed in Thailand. This term cannot be extended. The design system in Thailand is a substantive examination system. A design that has been disclosed to the public and/or patented or registered elsewhere prior to filing a Thai application is not patentable in Thailand.

Under Section 60 *bis* of the Thai Patent Act, if a person files a design patent application in the Kingdom within 6 months from the date of filing of the corresponding patent application outside the Kingdom for the first time, that applicant shall be entitled to claim priority from the first application filed outside the Kingdom.

The patentee shall have the sole rights to use the patented design with a product, or to sell, possess for sale, offer for sale, or import into Thailand products which utilize the patented design, except for use of the product design in the interest of education or research.

Under Section 57 of the Thai Patent Act, the following designs are not new and will be rejected by the Thai Patent Office:

- (1) A design widely known or used by others in this country before the filing of the application for a patent.
- (2) A design which was disclosed or described in this or foreign country before the filing of the application for a patent.
- (3) A design which was published before the filing of the application for a patent.
- (4) Any design so nearly resembling any of the designs prescribed in (1), (2), or (3) as to be an imitation.

Filing Information and Documents

Information and documents required for filing a new design patent application in Thailand are the same as those for a patent application (Items 1-7, pages 2-3). In addition, drawings or black-and-white photographs in A-4 size (8.5" X 12") showing the front, back, left, right, top, bottom, and perspective views of the product (three copies per view) must be submitted with the application.

If photographs or drawings of the product design are shown in specific colors, only the product design designated in those colors will be protected under Thai laws. However, if they are in black and white, the protection will be granted for all colors.

A design patent application can consist of only **one** design. If the drawings contain different designs or embodiments, then each embodiment must be filed separately in its own application in order to receive the broadest range of protection.

A description of the design may be included but must not exceed 100 words.

The registration time for a Thai design patent application in a best-case scenario is from 2.5 to 3 years from the Thai filing date.

Preliminary Examination

After the application is filed, the Examiner will conduct a preliminary examination to check the validity of the formal documents and patentability of the design.

Publication

Once the preliminary examination is completed, the notification for paying the publication fee will be issued. The publication period for the Thai Patent Office may range from 1 to 3 years from the Thai filing date. The publication fee must be paid within 60 days from the day the notification is received. This deadline cannot be extended.

After the publication fee has been paid, it will take approximately 2-4 months for the application to be published for opposition in the Thai Patent Journal for a period of 90 days. The Examiner will automatically conduct the examination.

Registration

After the examination is completed, the notification to pay the registration fee will be issued. The payment of the registration fee must be made within 60 days from the date of receipt of the notification. After the registration fee is paid, the application will be granted a design patent and then annuities can be paid. The licensing agreement and compulsory license can be initiated after a design patent has been granted.

Annuity

After a design patent is granted, annuities must be paid in order to keep it in force. The first annuity (the so-called "fifth annuity") is due at the beginning of the fifth year from the filing date and additional fees shall be payable annually thereafter. The payment of the fees must be made within 60 days calculated from the beginning of the fifth year of the term of the design patent and of every year thereafter. However, if a design patent is granted after the beginning of the fifth year of the term of the design patent, the first annual fee must be paid within 60 days calculated from the grant of the design patent. If any annual fee is not paid within the prescribed period, the patentee must pay the fee together with a surcharge of 30% of the unpaid fee within 120 days.

3. APPLICATION FOR PETTY PATENT

To be eligible for a petty patent, an invention must be new and industrially applicable. It does not have to possess an inventive step. Provided the Examiner deems that the invention is new and industrially applicable, the invention under a petty patent application will be accepted for registration. A request for substantive examination is not required. Within 1 year from the date of publication and the registration of an invention and the issuance of a petty patent, an interested person may request for an inspection to determine whether the invention to which the petty patent is granted is new and capable of industrial application.

Owners of petty patents, like owners of ordinary patents, will have the exclusive rights to exploit their inventions as well as grant licenses to others.

An applicant may not apply for both a patent and a petty patent for the same invention. However, applicants in either case can change the type of right applied for, from petty patent to patent and vice versa. This must be done prior to registration of the invention and issuance of the petty patent, or before publication of the patent application.

Filing Information and Documents

Information and documents required for filing a new petty patent application in Thailand are the same as those for a patent application (Items 1-7, pages 2-3). In addition, an English specification of the invention, including claim(s), abstract, drawings (if any), and sequence listing (if any), is required. According to Clause 25 of the Ministerial Regulations No. 21, an application for a petty patent shall specify no more than 10 claims. In compliance with the Thai Patent Office's official requirements, claim 1 of the petty patent application must be a two-part claim. The first part lists prior features/functions/processes followed by the words "characterized in that"; the second part states the novel or improved aspects of the invention that are to be claimed.

Publication and Registration

When the application is accepted for registration, the notification to pay the publication and registration fees will be issued. The payment must be made within 60 days from the date of receipt of the notification. After the publication and registration fees are paid, the application will be granted a petty patent and then annuities can be paid. The licensing agreement and compulsory license can be initiated after a petty patent has been granted.

Annuity

Annuity payments must be made to maintain the petty patent. The payment of the fees shall be made within 60 days after the beginning of the fifth and sixth years of the term of the petty patent. However, if a petty patent is granted after the beginning of the fifth year of the term of the petty patent, the first annual fee shall be paid within 60 days after the grant of the petty patent. If any annual fee is not paid within the prescribed period, the patentee shall pay the fee together with a surcharge of 30% of the unpaid fee within 120 days.

The term of a petty patent will be 6 years from the date the application is filed in Thailand. The term may be extended twice, for a period of 2 years each, but an application for any such extension must be submitted within 90 days prior to the expiration of the petty patent. Although the term of protection for petty patents will be shorter than that for ordinary patents, the term will be equivalent to that for design patents (i.e. 10 years from the date the application is filed) if the petty patent term is calculated to include the two allowable extensions. Therefore, the full term of protection for a petty patent which includes the two allowable extensions is 10 years.

4. APPLICATION RELATING TO MICROORGANISMS

Copy of Certificate of Deposit of microorganism with an internationally accepted depository body must be submitted within 90 days from filing date of application in Thailand.

5. LICENSE REGISTRATION

Patent licensing agreements must be registered and approved by the Thai Patent Office. Failure to do so may result in cancellation of the patent.

6. ABANDONMENT

It is provided that an application shall be deemed abandoned under the following circumstances: non-response to the outstanding office action, non-submission of the required documents, and non-payment of fees due.

7. ASSIGNMENT

A notarized Power of Attorney from assignee and a deed of assignment bearing the signatures of both assignor and assignee are required.

8. CHANGE OF NAME

A certified copy of certificate of change of name and a notarized Power of Attorney from the company in its new name are required.

9. SEARCH

A search with regard to a patent application is permitted only after the application has been published in the Thai Patent Journal.

10. OPPOSITION

A duly completed Patent Office opposition form must be submitted within 90 days of publication.

11. APPEAL

An appeal must be made to the Thai Patent Board of Appeals within 60 days after receipt of notification from the Director-General of his refusal to grant a patent.

12. WORKING

If a patent has not been worked for 3 years after being granted or 4 years after filing of application, whichever is longer, a compulsory license may be issued.

POWER OF ATTORNEY

PATENTS

KNOW ALL MEN BY THESE PRESENTS that we _____
 (Name of Applicant)

_____ of _____
 (Address of Applicant)

do hereby nominate and appoint **MRS. DARANI VACHANAVUTTIVONG and/or MS. SONTHAYA SUNKAPONGSE and/or MR. NUTTAPHOL ARAMMUANG** of **Tilleke & Gibbins International Ltd., No. 1011, Supalai Grand Tower, 20th-26th Floors, Rama 3 Road, Chongnonsi Sub-District, Yannawa District, Bangkok 10120, Thailand**, to be our true and lawful attorney or attorneys for us and in our name:

To apply for and obtain in Thailand patents and/or petty patents for our inventions/designs.

To accept the assignment of inventions, designs, patents and/or petty patents and patent and/or petty patent applications; to register any change of name; to defend our applications and patents and/or petty patents from objection, opposition, or attack; to file notices of opposition and appeals; to pay all fees; to withdraw applications; to apply for cancellation of any patent and/or petty patent; to enter into consent and compromise; and to prosecute and defend our patents and/or petty patents before the Board of Patents.

To defend our patents and/or petty patents from infringement, imitation, or attack whether by way of civil court or criminal proceedings or otherwise; to file criminal charges or complaints with the Police Authorities and/or Administrative Officials; to file, prosecute, defend, and carry to completion in the Courts and administrative tribunals of Thailand, all our claims or legal proceedings, both civil and criminal, including bankruptcy against any natural or juristic person; enforce any judgment or order obtained therein, including defending any counter claim or separate suit or claim; to compromise, refer to arbitration, or settle any such proceedings or take such other steps as may be necessary in the premises, including the power to receive money or other property due or to become due in the premises from any Court, administrative tribunal, person or persons, or from any juristic entity.

For the aforesaid purposes in our name to sign and lodge all papers and writing which they or any of them in their aforesaid capacity may deem necessary or desirable; to alter and amend such documents and applications; to attend and appear on our behalf at Thailand Government Offices or elsewhere, or before any Court or judicial officer in Thailand; to appoint a substitute or substitutes under him or them for the performance of any or all of the aforesaid acts, and the same at pleasure to remove, and generally to do all such acts, deeds and things as they or any of them may in their discretion think fit for the carrying out of these presents.

AND we hereby confirm and ratify whatsoever our said attorney and attorneys, substitute or substitutes may lawfully do by virtue of these presents.

The above referenced authorization will be effective from _____.
 (Date the applicant authorizes the agents)

IN WITNESS WHEREOF we have hereunto set our hands this _____ day of _____, _____
 in _____.

(To be notarized) _____ (Grantor)
 (Signed by the authorized person of the applicant)

Note: The date when the applicant signs must be before the filing date.

NOTARIAL ACKNOWLEDGMENT

(Suggested Contents)

Before me, the undersigned Notary Public, on this _____ day of _____, _____,
appeared Mr. _____, well known to me to be the person whose name
is subscribed on the foregoing Power of Attorney, as being the _____
(Title)

of _____
(Name of Corporation/Limited Company)

which is likewise known to me to be incorporated (registered) under the laws of _____
(Place of Incorporation)

and to be actually in existence at this date.

(Signature of Notary Public) (Notarial Seal)