

Overview patent system in Thailand

“2019 Seminar on the IP Landscape in New Southbound Countries”



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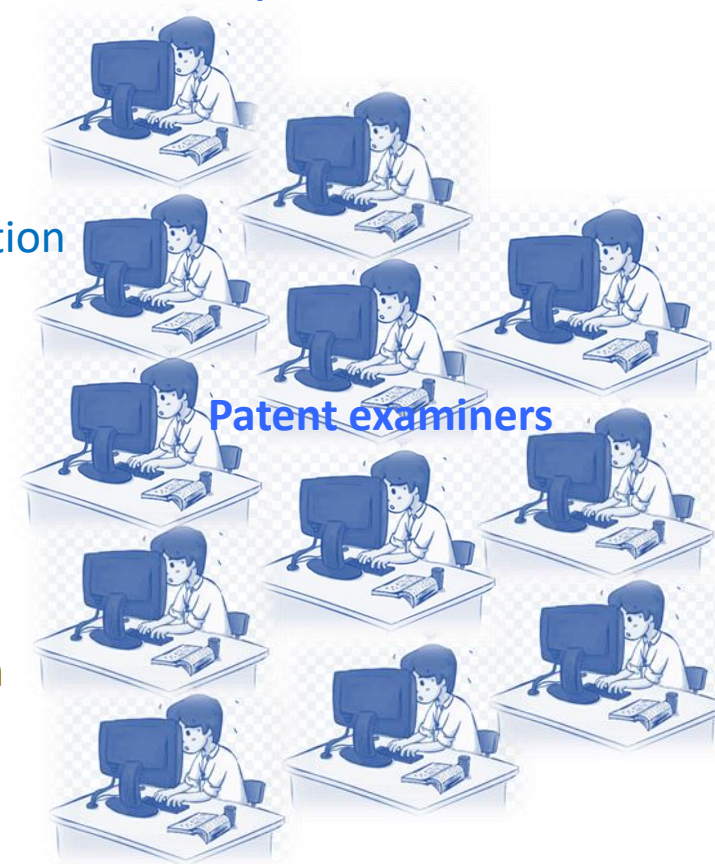


Creative inventions concept into patents and petty patents

DIP-Thailand

Patent Division

e-patent (TH-DB.)





Thailand Patent system

Law , Examination Procedure and Guideline

Legal Basis

1. Patent Act **No. 1**, B.E. 2522 (1979) and Patent Act **No. 2**, B.E. 2535 (1992) as amended by Patent Act **No.3**, B.E. 2542 (1999), the latter effective 27 September 1999
2. Relevant Ministerial Regulations
3. Relevant Notifications of DIP-Thailand

Major international treaties signed

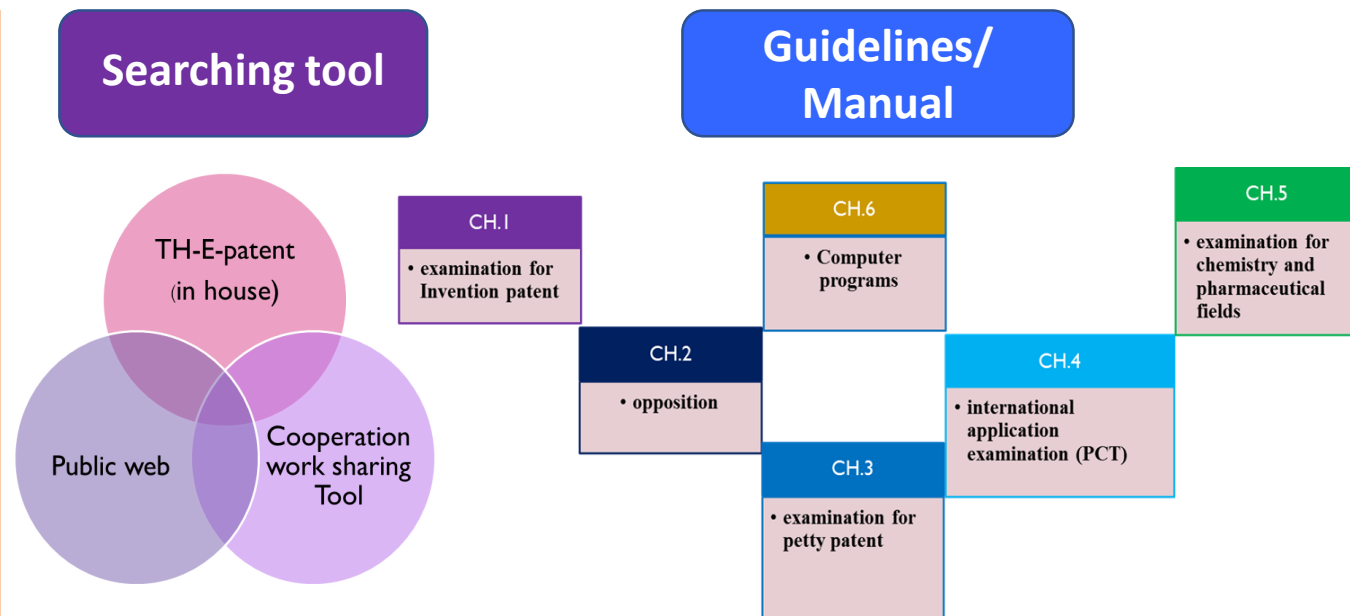
In 1995 – Thailand joined the World Trade Organization (WTO) at its inception, and hence also became a party to the Agreement on Trade-Related Aspects of Intellectual Property (**TRIPs Agreement**)

In January 2008 – The National Legislative Assembly of Thailand passed the interim cabinet's proposals regarding Thailand's accession to the Paris Convention for the Protection of Industrial Property and the Patent Cooperation Treaty (PCT). Thus, Thailand has been of the Paris Convention effective 2 August 2008

PCT Information

Thailand has deposited their instruments of accession with WIPO on 24 September 2009, **thus became the 142nd contracting state** of the Patent Cooperation Treaty. The treaty became effective **in Thailand from 24 December 2009**.

Accordingly, foreign applicant seeking to extend patent protection to Thailand may file a patent application either locally or through the PCT system. Including the applicant's nationality Thailand as well



***Guidelines for Examination of patent applications and petty patent B.E. 2019**



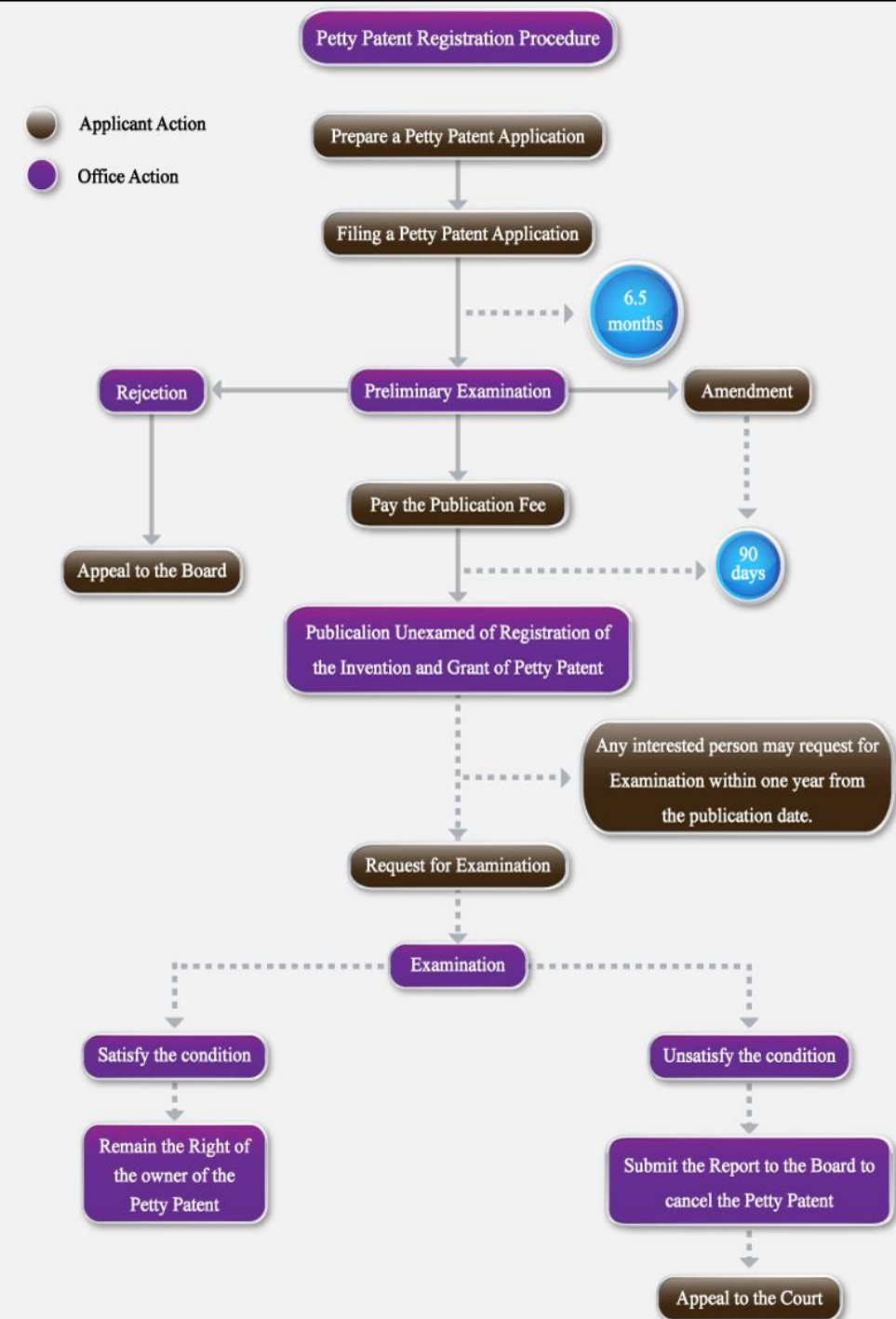
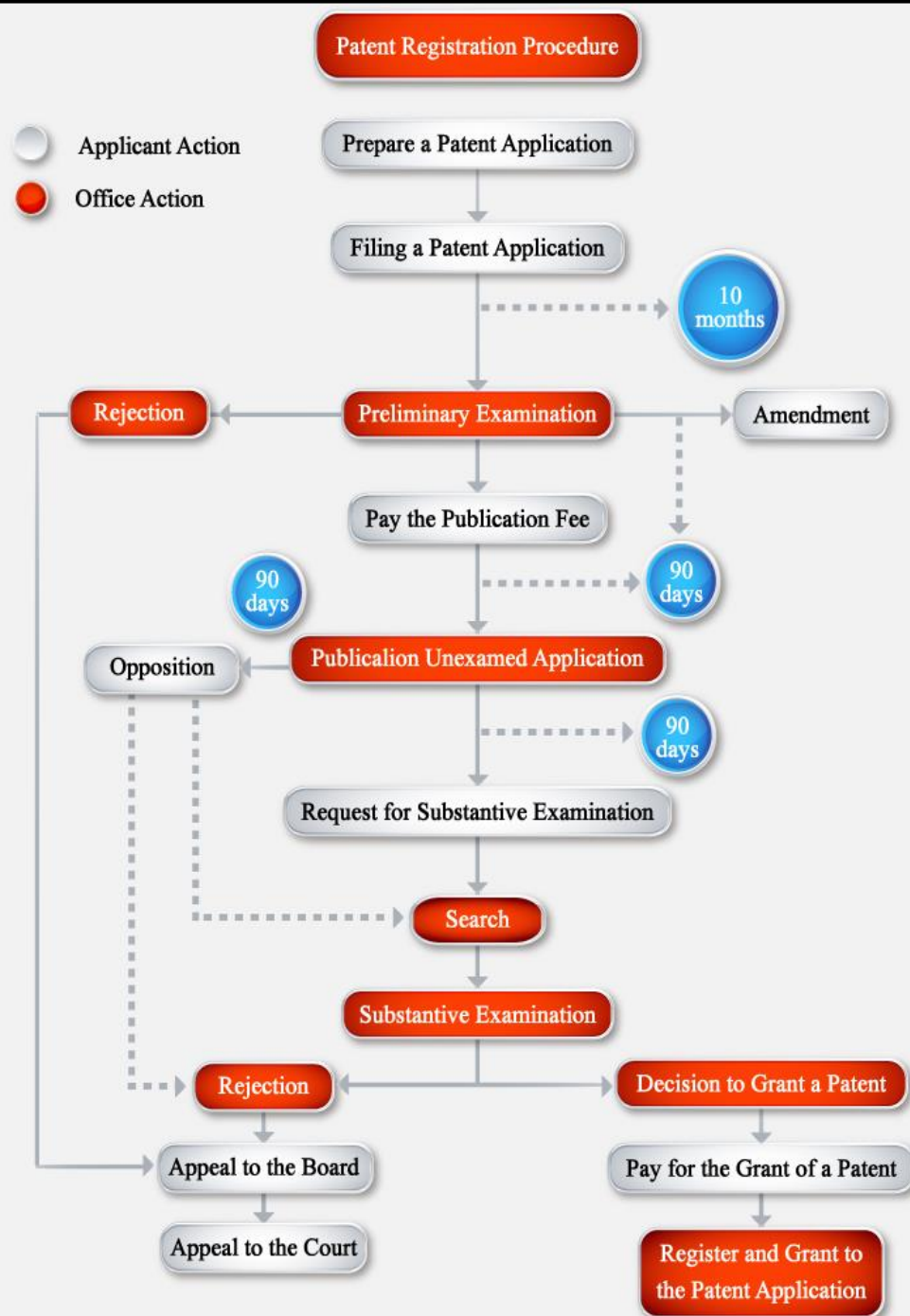
Overview patent in DIP-Thailand

	Inventions	Petty Patents	Design Patents
Conditions	<ul style="list-style-type: none">❖ Products❖ Processes❖ Improvement of a product or process		<ul style="list-style-type: none">❖ Forms/ Product shape❖ Composition of lines❖ Colors
Requirements	<ul style="list-style-type: none">❖ Novelty❖ Involves an inventive step❖ Capable of industrial application	<ul style="list-style-type: none">❖ Novelty❖ Capable of industrial application	<ul style="list-style-type: none">❖ Novelty❖ For industrial application / handicrafts
Exclusion	No person shall apply for both patent and petty patent for the same invention		
System	Formality Examination and Preliminary Examination		
	<ul style="list-style-type: none">❖ Publication (Un-examination)❖ within 5 year form Pub. date must be request <u>Substantive examination</u> (by Applicant)	<ul style="list-style-type: none">❖ Registration and publication❖ within 1 year form Pub. date may be request <u>examination</u> (by stakeholder)	<ul style="list-style-type: none">❖ Publication (Un-examination)❖ <u>Substantive Examination</u> (automatically conducted after Pub.)
	Grant and Renewal/Annuity		
Opposition	<ul style="list-style-type: none">❖ within 90 days after publication date (Pre-grant)❖ by any person	-	<ul style="list-style-type: none">❖ within 90 days after publication date (Pre-grant)❖ by any person
Patent valid (Max)	20 years	10 years	10 years
All annual fee	140 000 THB / 4 510 USD	17 000 THB / 550 USD	7 500 THB / 240 USD



The Granting Procedure of DIP

1. Filing Application
2. Preliminary Examination
3. Publication Unexamined
4. Opposition (if any)
5. Request for Substantive Examination (within 5 years from the publication date)
6. Searching and make a Search Reports
7. Substantive Examination
8. Registration or Rejection
9. Appeal





PROCESS FLOW FOR PCT APPLICATIONS

Major prosecution events for Patent in DIP-Thailand

Paris Convention	: 12 months
National Phase Entry	: 30 months (non-extendible)
Request for Examination	: 60 months (from publication date)

If an applicant cannot file the documents mentioned in 2, 3, and 4 together with the application to register a patent, it is often possible to request an extension of **time up to 90 days. (non-extendible)**

If such documents are not submitted within the deadline, the application will **be deemed withdraw** (licensing Facilitation Act B.E. 2015 Section 8).

When a priority right is claimed, the **priority documents** must be submitted **within 16 months from the priority date.**

If patent Application. Already submitted to NPE. DIP-TH, **No need** to file the priority documents

If Priority document (where priority is claimed and has not been transmitted to the national office by WIPO) , **must be submitted**

Preparation of Patent Application filed to DIP-TH

1. Detailed specification of the invention. The patent specification is acceptable in any language when filing an application but the Thai translation must follow within 90 days of the application. Importantly, the full specification must be filed on the application date.

2. A notarized power of attorney.

3. A Deed of Assignment signed by both the assignor (who is the inventor) and the assignee (the applicant). Legalization and notarization of the power of attorney are not required for the application process.

4. A statement of applicant's right to apply for a patent (only in the case that the applicant is also the inventor).

5. Where the applicant is claiming priority from an overseas application, the priority documents must also be submitted.

1. In the case that the applicant is a natural person (foreigner)

- The Application Form
- The Description, Claims, Abstract, and Drawings (in Thai).
On the very first filing, it is possible to the applicant to file the Description, Claims, Abstract, and Drawing in foreign languages, and file the Description, Claims, Abstract, and Drawing in Thai within 90 days later.
- Application form for the right to claim the date of the first filing in a foreign country or Claiming Priority Document (if any)
- **The original document or the copy of power of attorney certified by Notary Public with Thai translation**
- **Statement of applicant's right to apply for a patent / petty patent** (The document will be requested in the case that the inventor is also the applicant.)
- Other documents that the applicant has referred to in the request, and is useful for considering the request in order to grant the patent

2. In the case that the applicant is a legal person (foreigner)

- The Application Form
- The Description, Claims, Abstract, and Drawings (in Thai).
On the very first filing, it is possible to the applicant to file the Description, Claims, Abstract, and Drawing in foreign languages, and file the Description, Claims, Abstract, and Drawing in Thai within 90 days later.
- Application form for the right to claim the date of the first filing in a foreign country or Claiming Priority Document (if any)
- **The original document or the copy of power of attorney certified by Notary Public with Thai translation**
- **Deed of assignment certified by Notary Public with Thai translation**
- Other documents that the applicant has referred to in the request, and is useful for considering the request in order to grant the patent

1. In the case that the applicant is a natural person (foreigner)

- The Application Form
- PCT Request (PCT/RO/101) with Thai translation
- The Description, Claims, Abstract, and Drawings (in Thai).
On the very first filing, it is possible to the applicant to file the Description, Claims, Abstract, and Drawing in foreign languages, and file the Description, Claims, Abstract, and Drawing in Thai within 90 days later.
- **The original document or the copy of power of attorney certified by Notary Public with Thai translation**
- Other documents that the applicant has referred to in the request, and is useful for considering the request in order to grant the patent

Required documents

(To be submitted)

1. International Publication
2. International Search Report
3. Written Opinion of the International Search Authority
4. International Preliminary Examination Report (IPRP Chapter II) (If any)
5. Declaration VIII (i) : Identity of the Inventor (If any)
6. **Statement of Applicant's Right to Apply For a Patent) with Thai translation**
7. IB/306 Form with Thai translation (If any)
8. Sequence Listing with Thai translation (If any)



Documents to be submitted for patent application according to the PCT Route.

2. In the case that the applicant is a legal person (foreigner)

- The Application Form
- PCT Request (PCT/RO/101) with Thai translation
- The Description, Claims, Abstract, and Drawings (in Thai).
On the very first filing, it is possible to the applicant to file the Description, Claims, Abstract, and Drawing in foreign languages, and file the Description, Claims, Abstract, and Drawing in Thai within 90 days later.
- **The original document or the copy of power of attorney certified by Notary Public with Thai translation**
- Other documents that the applicant has referred to in the request, and is useful for considering the request in order to grant the patent

Required documents (to be submitted)

1. International Publication
2. International Search Report
3. Written Opinion of the International Search Authority
4. International Preliminary Examination Report (IPRP Chapter II) (If any)
5. Declaration VIII (i) : Identity of the Inventor (If any)
6. **Deed of assignment certified by Notary Public with Thai translation (No need to submitted)**
7. IB/306 Form with Thai translation (If any)
8. Sequence Listing with Thai translation (If any)



กรมทรัพย์สินทางปัญญา
DEPARTMENT OF INTELLECTUAL PROPERTY

Registration fees	Fees
Invention Patent Application	500
Design Patent Application	250
Invention Petty Patent Application	250
Change/Correction Request	50
Announcement of Patent Application	250
Petty Patent Registration Acceptance and Announcement	500
Invention Inspection Request (in case of invention)	250
Patent Registration Acceptance and Issuance	500
Objection	250
Appeal	500
Request for change of protection category	100



Invention	Royalty
5 th Year	1,000
6 th Year	1,200
7 th Year	1,600
8 th Year	2,200
9 th Year	3,000
10 th Year	4,000
11 th Year	5,200
12 th Year	6,600
13 th Year	8,200
14 th Year	10,000
15 th Year	12,000
16 th Year	14,200
17 th Year	16,600
18 th Year	19,200
19 th Year	22,000
20 th Year	25,000
Or pay the total amount upon the first yearly royalty payment	140 ,000



Petty Patent	Royalty
5 th Year	750
6 th Year	1,500
Or pay the total amount upon the first yearly royalty payment	2,000



Petty Patent Renewal Fees	Fees
First time	6,000
Second time	9,000

Can be find more information at
<https://www.ipthailand.go.th/en/patent-006.html>

1. Basic requirements for the patent examination of DIP-Thailand

“invention” means any innovation or invention which creates a new product or process, or any improvement of a known product or process (Section 3 and must not be prohibited by section 9)

Section 17 The application for a patent shall contain:

- 1. The title of the invention.**
- 2. Brief statement of its nature and purposes.**
- 3. A detailed description of the invention in such full, concise and clear as to enable any person ordinarily skilled in the art to make and use the invention**
- 4. Clear and concise claims supported by description.**
- 5. Drawing (if any)**
- 6. Abstract**

**Conflicting rights that affecting the invention
Sec.16 or Sec.65 ter or Sec.77 sexies**

**Unity of the invention
Section 18**

**Novelty
Section 5(1) with Section 6**

**Inventive step
Section 5(2) with Section 7**

**Capable of industrial
application
Section 5(3) with Section 8**

Patent



Applicant: Search for prior art to evaluate a patent or petty patent application (request for protection)
Examiner: Search for prior art to evaluate a patent or petty patent application (check, examine, grant/reject)

2. Basic requirements for the petty patent examination DIP-TH

Section 65 quinquies Before the registration of an invention and grant of a petty patent, the competent officer shall examine the application for a petty patent as to its conformity with Section 65 decies and 17 and examine that the claimed invention is protectible under Section 65 decies and Section 9

Unity of the invention
Sec. 65 decies with Sec. 18

Conflicting rights that affecting the invention
Sec.65 decies with Sec. 16 or Sec. 65 ter or Sec.77 sexies

(Sec. 65 decies with Sec. 17) The application for a patent shall contain:

1. The title of the invention.
2. Brief statement of its nature and purposes.
3. A detailed description of the invention in such full, concise and clear as to enable any person ordinarily skilled in the art to make and use the invention
4. Clear and concise claims supported by description.
5. Drawing (if any)
6. Abstract

Petty Patent



Section 65 sexies Within one year from the publication of the registration of the invention and the grant of a petty patent, any stakeholder may request to examine under Section 65 bis.

1. Authentication stakeholder
(Sec. 65 sexies)

2. Novelty (Sec. 65 bis (1))

3. Capable of industrial application (Sec. 65 bis (2))

the competent officer/Examiner

Examination report:

1. Does the request to examine within one year from the publication date?
2. Does that person request to be an exam as a stakeholder?
3. Does the application novelty and capable of industrial application?

Report to the Director-General to keep the petty patent

Submit report to the Board to cancel the petty patent

the decision is made by the Director-General and/or Board of Patent

Section 5

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; and**
- (3) it is capable of industrial application.”**

The under section 9 Prohibited Patent Subject Matter

Certain inventions are not eligible for protection under the Thai Patent Act. These exceptions restrict patent protection on public policy grounds as opposed to the lack of any intrinsic characteristics of a patentable invention inherent in the application. For instance the following inventions are not capable of being protected by a patent for invention



Section 7

States that “An invention shall be taken to be inventive step if is not obvious to a person ordinary skill in the art”

Section 8

States that “ An invention Shall be taken to be Capable of industrial application if can be made or use or any kind of industry , including handicrafts , agriculture and Commerce

- 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. method for diagnosing, treating or curing human or animal diseases;***
- 5. inventions which are contrary to public order of morality, public health or welfare***



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

In practice, when the Thai Patent Office determines whether the subject matter of a patent application is already known to the public, does the Thai Patent Office consider prior disclosures made only in Thailand, or does the Thai Patent Office consider prior disclosures made anywhere in the world?

- **(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**

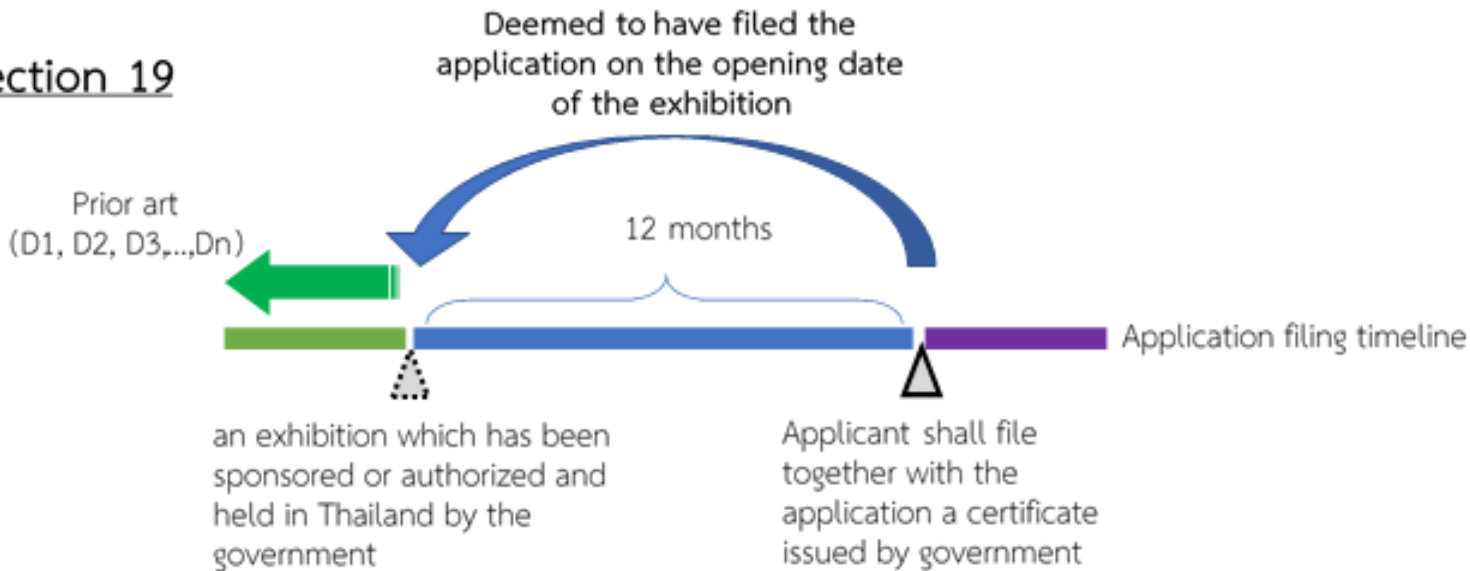
Section 6 (2) of the Thai Patent Act, the Thai Patent Office will consider prior disclosures made in Thailand or a foreign country or anywhere in the world

Prior disclosures -----> anywhere in the world

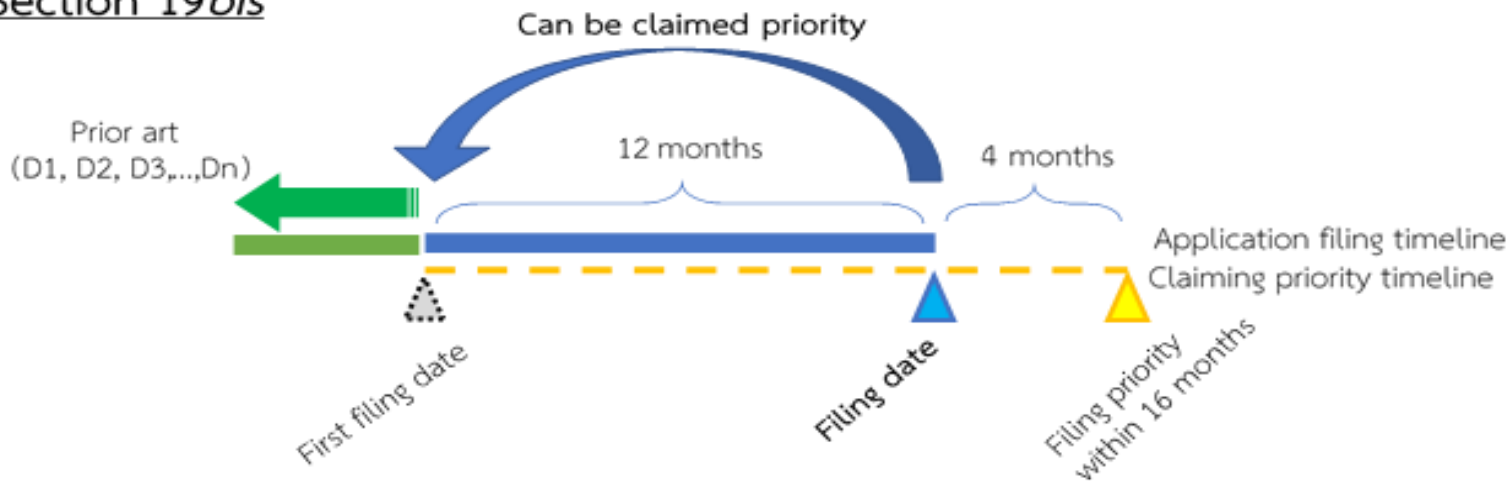
Section 6 (1) of the Thai Patent Act, the Thai Patent Office will consider prior use which has occurred in Thailand only

Prior use -----> Thailand only

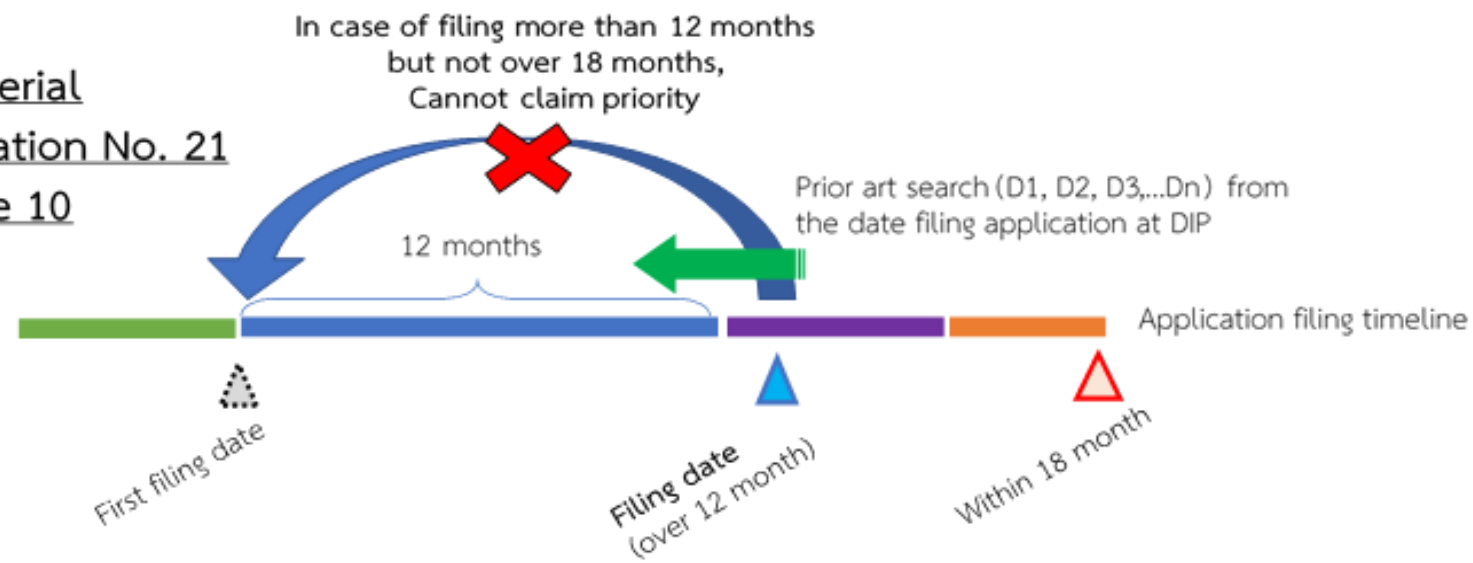
Section 19



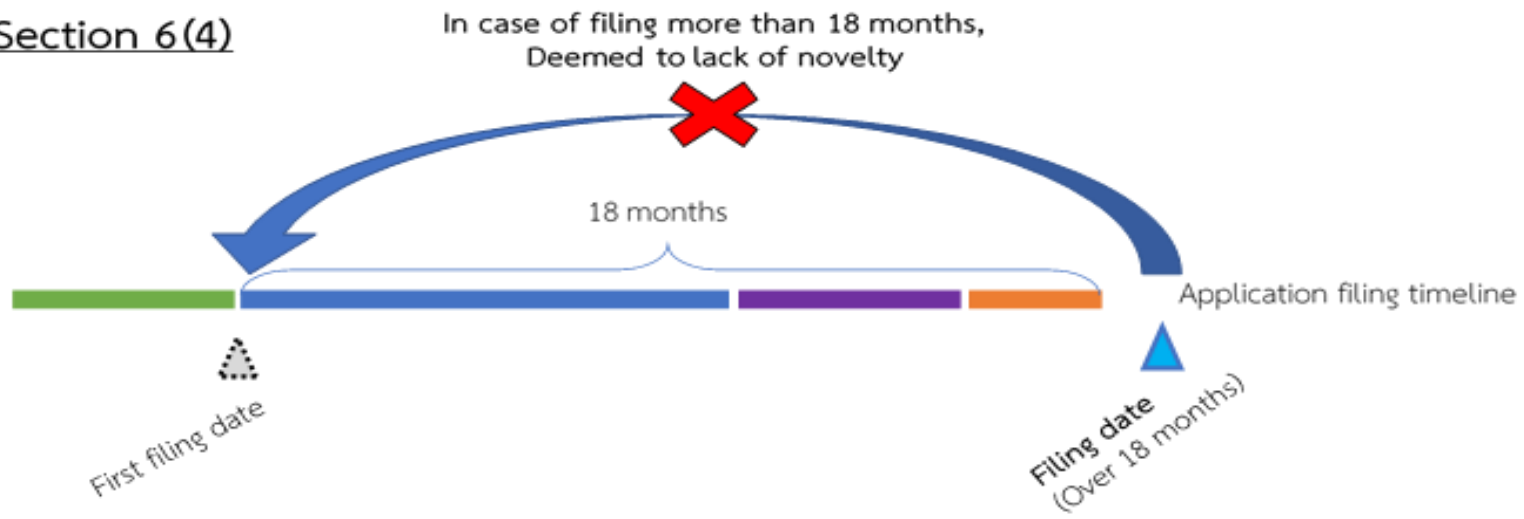
Section 19bis



Ministerial
Regulation No. 21
Clause 10

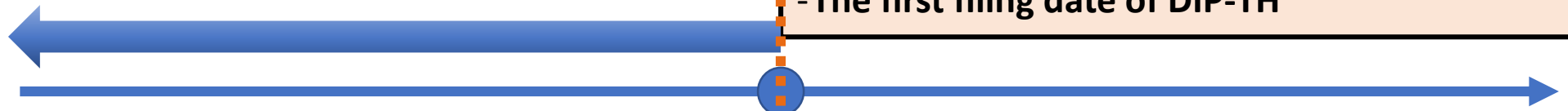


Section 6(4)



Great Period in Patent Act.

12 months



Filing date, To patent DIP-TH
which is one of the following dates.

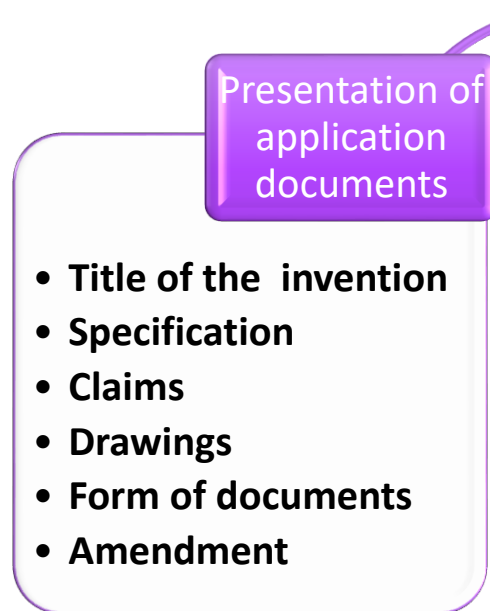
- The first foreign filing date. (Section 19bis)
- The opening date of an exhibition. (Section. 19)
- The first filing date of DIP-TH

Exception ;

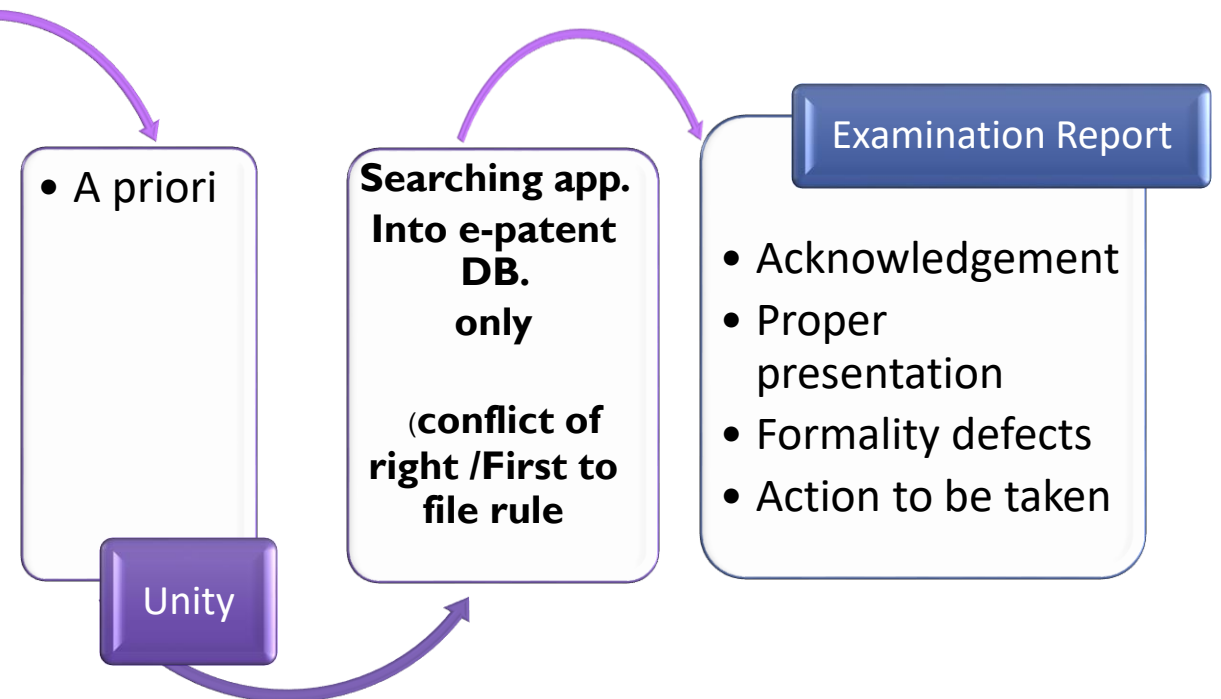
A disclosure which was due to, or made in consequence of, the subject matter having been obtained unlawfully, or a disclosure which was made by the inventor, or made in consequence of, the inventor displaying the invention at an international exhibition or an official exhibition if such disclosure was done within twelve months before the filing of an application for the patent, shall not be deemed to be a disclosure under Section. 6(2).

Formality and Preliminary Examination

Formality Exam.



Preliminary Exam.



Procedure of Examination

(1) Consider the subject matter of claimed invention

(2) Consider (elements/compositions/process/procedures) of claimed invention and the closest prior art

(3) Comparing and identifying the claimed invention and the closest prior art cited for determining novelty and inventive step if it any different

**Consideration process
(New invention)**

Identical

(Lacks novelty)

Non-identical – Novelty

4. Determine if the claimed invention involve an inventive step

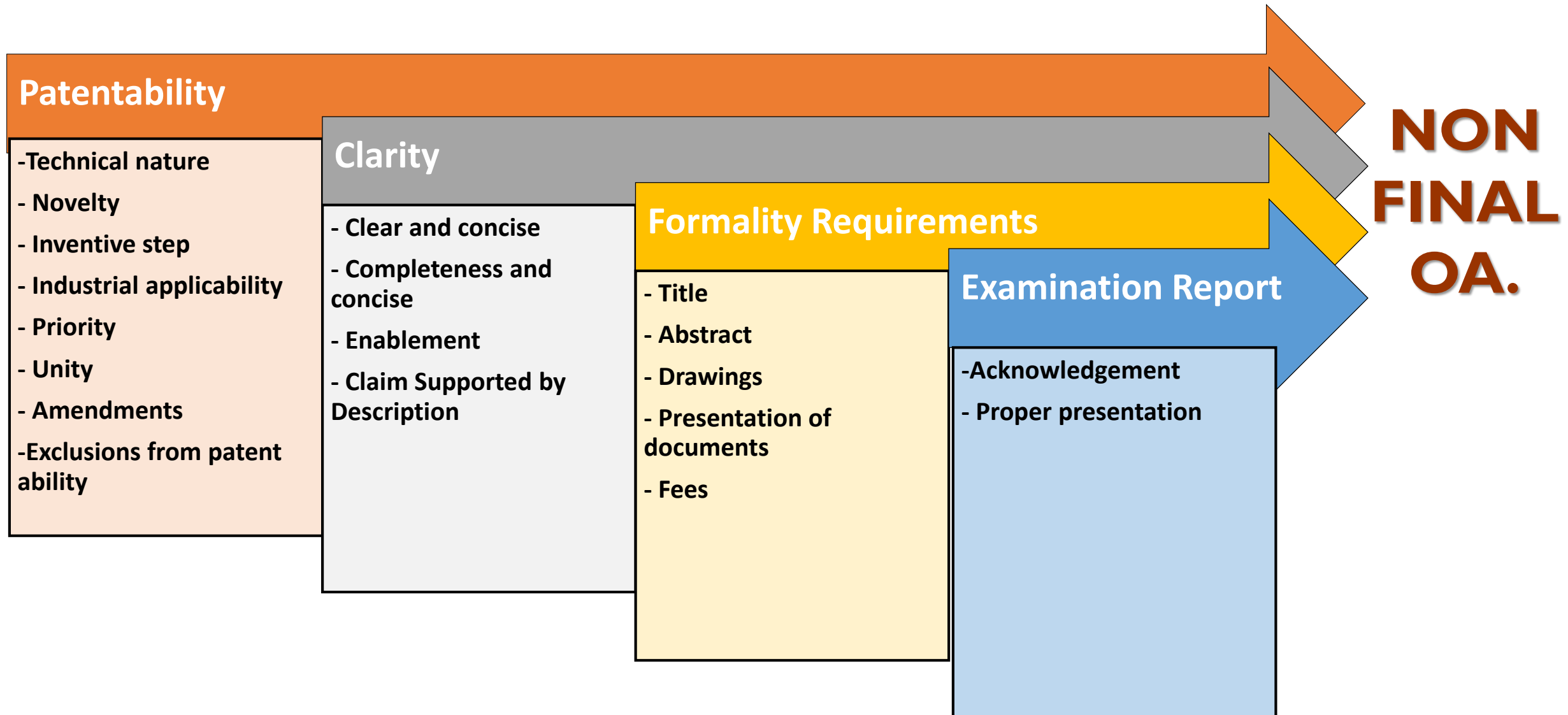
obvious

**If it obvious to a person
ordinary skilled in the art.
(Lacks an inventive step)**

Non- obvious

**if it non obvious to a person
ordinary skilled in the art.
(inventive step)**

Major issues for Substantive Examination



After applicant request for examination within 5 years from publication date (Sec.29)
examiner may proceed from the following case:

Case	Actions
1. Absence of examination report	Examiner conduct full substantive examination (Search report, examination report, and office action) by themselves
2. Presence of examination report	
2.1 Presence of search report only (authorized search organization)	Examiner conduct examination report by using search product and office action
2.2 Presence of examination report with search report in international database (DOSSIER) Utilizing work product	Examiner conduct examination report with office action
2.3 Presence of examination report with search report (Submit by applicant) Utilizing work product	Examiner conduct examination report with office action

Example :

- Search report TH
- Office action TH



Basic Procedure for Amendment of Patent /Petty patent

The application has been filed with the Patent Office , DIP-TH patent examiner will carry out a **preliminary examination stage** or **Substantive Examination stage** to check whether the formally required documents or subject matter of the in are in order and whether the claims are in compliance with Thai patent laws.

If there is a defect in the application documents,

The Patent Office will **issue Laws related to notification of orders** the applicant to amend the documents within the deadline, e.g. 90 days. (amendments)

If the applicant fails to amend the documents by the deadline, The patent application will be **deemed abandoned**.
The application cannot be restored.

Under the section 27 of the Patent Act empowers the examiner to instruct the applicant to appear before him in order to answer any question, or to hand to him any document or item.

Section 27. In the course of examination of an application, the competent officer may instruct the applicant to appear before him in order to answer any question, or to hand over to him any document or item.

If the applicant has filed on application for a patent in any foreign country, he shall submit a report of the examination of the application in accordance with the rules and procedures prescribed by the Ministerial Regulations.

If any document to be filed is in a foreign language, the applicant shall file such document accompanied by translation in Thai.

If the applicant fails to comply with the instruction of the competent officer under the preceding paragraph, or fails to submit the examination report within ninety days in accordance with the second paragraph of this Section, he shall be deemed to have abandoned his application. In case necessity, the Director-General may **extend such period as he deems appropriate.**



The laws related to Notification of Office Action

Section, Patent Act.	Office Action	Schedule the operation form receipt of the letter
Sec. 26 + Sec. 18 (Ministerial Regulation No. 22 clause 8,12)	Notice to the applicant requiring to separate the application	<u>Within 120 day form receipt of the letter</u> If files correctly - deemed to have that application on the filing date of first application If does not agree- shall appeal to the Director-General (Within 120 day) ,The decision of the Director-General shall be final
Sec. 27 (Ministerial Regulation No. 21 clause 16) (Ministerial Regulation No. 22 clause 7)	Notice to the applicant to amendment / clarify of reason /submit additional documents	<u>Within 90 day form receipt of the letter.</u> Applicant can be submit a <u>request to extend the time before the first time of dealine.</u> Patent Office will extend the time another 90 day (extend the 1st time) In addition, the applicant can also <u>request an extension of time. before extend the 1st time.</u> Patent Office will extend the time another 30 day (90 +90 +30 = 210 day)
Sec. 28	Notify to the applicant pay the publication fee	Within 60 day (the 1st time) form receipt of the letter Within 60 day (the 2 nd time) : <u>Patent Office will notify to the applicant again</u>
Sec. 30	Notify to the applicant that refuse the grant of a patent (In this case. Patent Office published refuse application)	The applicant can appeal the order <u>to the Board of Patents within 60 day form receipt of the letter</u>
Sec. 33	Notify the applicant that the fee must be paid for the grant of a patent	Within 60 day form receipt of the letter
Sec. 65quinquies	Notify the applicant to pay for the fees for registration of a petty patent and publication	Within 60 day (the 1st time) form receipt of the letter Within 60 day (the 2 nd time) : <u>Patent Office will notify to the applicant again</u>
Sec. 72 appeal to the Board of patent	under Sections 12,15, 28, 30, 34, 49, 50 or Section 61, or Section 65 and Section 12, 15, 28, 33, or 34 and Section 65quinquies or 65sexies or 65decies and Section 12, 15, 49 or 50,	within 60 days following the receipt of such order or decision. If he fails to do so within such period, the order or decision <u>of the Director-General shall be final.</u>



กรมทรัพย์สินทางปัญญา
DEPARTMENT OF INTELLECTUAL PROPERTY

Basic Procedure for Unity of the invention

Section 18 The application for patent shall relate to only one invention or to a group of inventions which are so linked as to form a single inventive concept.

Clause 5 Ministerial Regulations No. 21

An application containing claims as described below shall be construed as relating to a single invention:

(1) in addition to an independent claim for a product for which protection is sought, other independent claims setting forth the process a manufacture and use of the product.

(2) In addition to an independent claim for a process for which protection is sought, claims for the means and/or apparatus for carrying out process

Article 26 In the examination of an application if it appears that the application relates to several distinct inventions which are *not so linked as to form a single inventive concept*, the competent officer shall give a notice to the applicant requiring him to separate the application into a number of applications, each of which relates to a single invention.

If the applicant files any of the separated applications within one hundred and eighty days following the receipt of such notice under the preceding paragraph, he shall be deemed to have filed that application on the filing date of his first application.

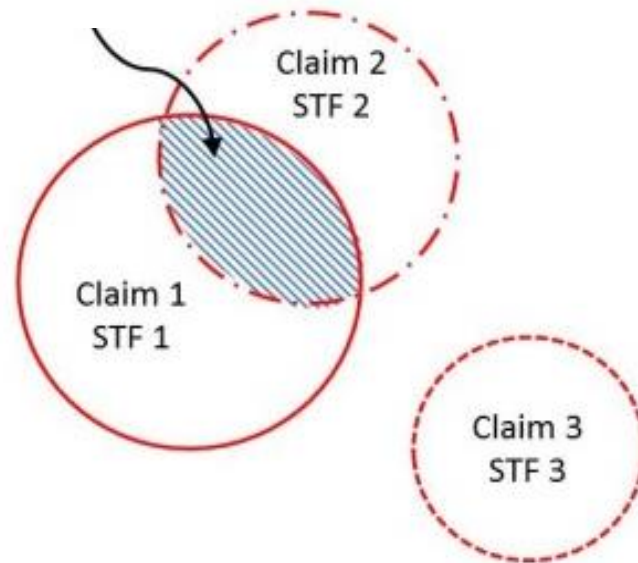
The application shall be separated in accordance with the rules and procedures provided by the Ministerial Regulations.

If the applicant does not agree with the requirement to separate the application, he shall appeal to the Director-General within one hundred and twenty days. The decision of the Director-General shall be final.

Rationale

- 1) Economic reasons : in order to prevent the applicant from submitting for several distinct inventions by paying only one request fee.
- 2) Technical reasons : in order to simplify the patent classification of invention, patents search, and examine the invention, for the invention that is going to happen in the patent application or any petty patent application.

Basic conceptual framework
Link



In the picture, it can be seen that within the square frame is the general technical field (TF) and each claim will have special technical feature (STF). If the special technical features are the same or correspond, there are having special technical feature together or between each other. Therefore, claim 1 and claim 2 are the same invention.

The concept is different from claim 3, therefore, claim 3 must be separated as another patent application. If it meet the criteria of the Ministerial Regulation No. 21 Clause 5, it couldn't be considered as the same invention.

General principles : "The inventions that included in a single patent application. If there is a connection or link in the claims, this means those inventions have a single general inventive concept (SGIC).
"Therefore, each invention that appears in any patent application must be reflected in each set of claims which have special technical feature that can be linked to each other."

Consider the claims without relying upon a prior art
A priori = before considering the claims to the prior art

Consider the claims by relying upon a prior art
A posteriori = after taking into consideration the prior art

A patentee shall pay annual fees prescribed in Ministerial Regulations, beginning the fifth year of the term of the patent. The payment shall be made within sixty days from the first day of the fifth year of the term of the patent and of every year thereafter. In case where a patent is granted after the first day of the fifth year of the term of the patent, the annual fees in respect of the fifth year to the year of grant shall be paid within sixty days from the date of grant.

If an annual fee is not paid within the said period, the patentee shall pay a ***surcharge of thirty percent of the unpaid fee.***

Then, if the annual fee and the surcharge are not paid within one hundred and twenty days from the expiration of the said period, the patent ***shall lapse pursuant to section 43 of Patent Act***

Moreover, pursuant to ***section 44 of the said Act*** the patentee may ***pay all the annual fees in advance concurrently, replacing payment for each year.***

65septies A petty patent shall have a term of six years from the date of filing of the application in the country. ***The term shall not include the period during which the court proceedings are taken under Sections 65decies and 16, 74 or 77sexies.***

The owner of a petty patent may request that the term of his petty patent be extended for two periods, each period shall be valid for two years, ***by submitting a request to the competent officer within ninety days before the expiry date.***

If the request is submitted within the said period, the petty patent shall be regarded as validly registered until it is otherwise ordered by the competent officer.

The request for extension of the term of a petty patent shall be in accordance with the rules and procedures prescribed by the Director-General.



Allowance & Patent/Petty patent Maintenance

Pay annual fees (Patent granted before year 5)

If patent granted before the first day of the fifth year of the term of the patent

Patent Office

- Notice of patent or petty patent registration

The applicant shall pay the registration fee within 60 days from receipt of notification And issued a certificate

- * Issued a notification of annual fee payment notification
(3 months in advance before the next year)

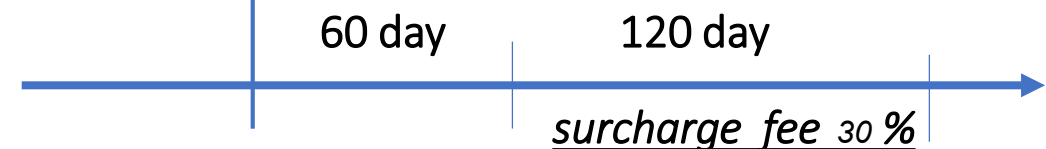
Example

Royalty Free (Year 5) = 1,000 Baht
surcharge fee 30% = ??????????????????

Example

End of year 4 | Starting year 5
Pay annual fees

*



Patentee shall pay annual fees within sixty days from the first day of the fifth year of the term of the patent and of every year thereafter

If an annual fee is not paid within the said period, the patentee shall pay a surcharge of thirty percent of the unpaid fee.

Patentee may pay all the annual fees in advance concurrently, replacing payment for each year. (Starting at the 5th year only) , will receive a discount from 152,000 baht to 140,000 baht

Then, if the annual fee and the surcharge are not paid within one hundred and twenty days from the expiration of the said period, the patent shall lapse pursuant



Allowance & Patent/Petty patent Maintenance

Pay annual fees (Patent granted after year 5)

If Patent granted after the first day of the fifth year of the term of the patent

Patent Office

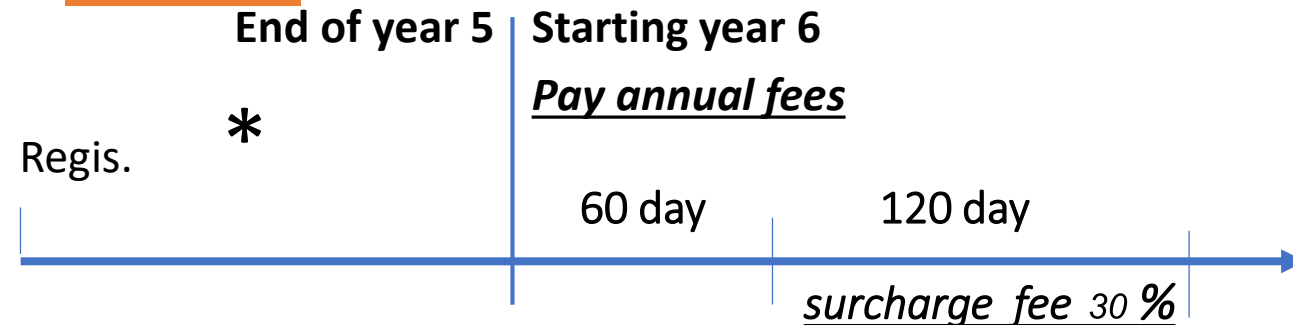
- Notice of patent registration with pay annual fees year 5 to the year of registration

The applicant shall pay the registration fee within 60 days from receipt of notification and issued a certificate

In this case, the applicant must pay an annual fee comes with.

- * Issued a notification of annual fee payment notification
(3 months in advance before the next year)

Example



Patentee shall pay annual fees within sixty days from the first day of the fifth year of the term of the patent and of every year thereafter *If an annual fee is not paid within the said period, the patentee shall pay a surcharge of thirty percent of the unpaid fee. As described in the previous slide*

Example

Royalty Free (Year 7) = 1,600 Baht
surcharge fee 30% = ????????????????????



Allowance & Patent/Petty patent Maintenance

Pay annual fees (Petty patent granted before year 5)

If petty patent granted before the first day of the fifth year of the term of the patent

Patent Office

- Notice of patent or petty patent registration

The applicant shall pay the registration fee within 60 days from receipt of notification And issued a certificate

- * Issued a notification of annual fee payment notification in year 5 or year 6 (3 months in advance before In those years)

Example

Royalty Free (Year 5) = 750 Baht

surcharge fee 30% = ??????????????????

Example

End of year 4 Starting year 5

*

Pay annual fees

60 day

120 day

surcharge fee 30 %

Patentee shall pay annual fees within sixty days from the first day of the fifth year of the term of the petty patent and of every year thereafter

If an annual fee is not paid within the said period, the patentee shall pay a surcharge of thirty percent of the unpaid fee.

Patentee may pay all the annual fees (year 5-6) in advance concurrently , replacing payment for each year.

Then, if the annual fee and the surcharge are not paid within one hundred and twenty days from the expiration of the said period, the petty patent shall lapse pursuant



Allowance & Patent/Petty patent Maintenance

Pay annual fees (Petty patent granted after year 5)

If petty patent granted after the first day of the fifth year of the term of the patent

Patent Office

- Notice of patent registration with pay annual fees year 5 to the year of registration

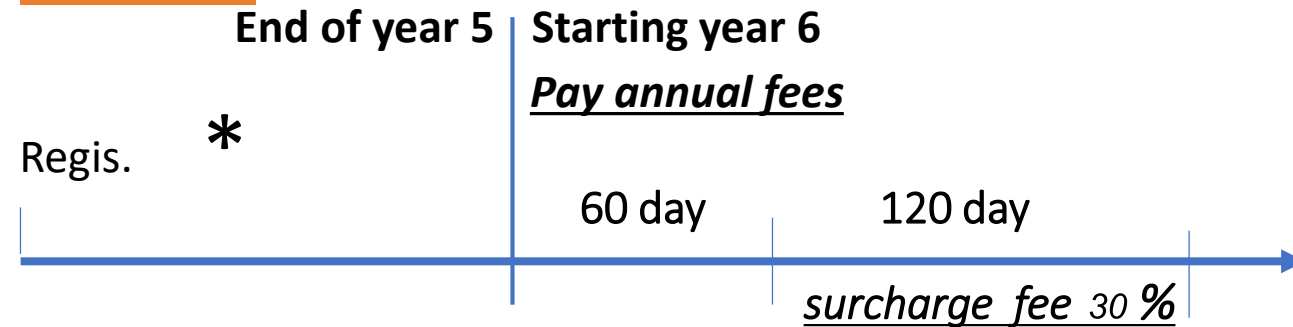
The applicant shall pay the registration fee within 60 days from receipt of notification and issued a certificate In this case, the applicant must pay an annual fee comes with.

- * Issued a notification of annual fee payment notification in year 5 or year 6
(3 months in advance before In those years)

Example

Royalty Free (Year 5) = 750 Baht
surcharge fee 30% = ??????????????????

Example



Patentee shall pay annual fees within sixty days from the first day of the fifth year of the term of the patent and of every year thereafter *If an annual fee is not paid within the said period, the patentee shall pay a surcharge of thirty percent of the unpaid fee. As described in the previous slide*



Allowance & Patent/Petty patent Maintenance

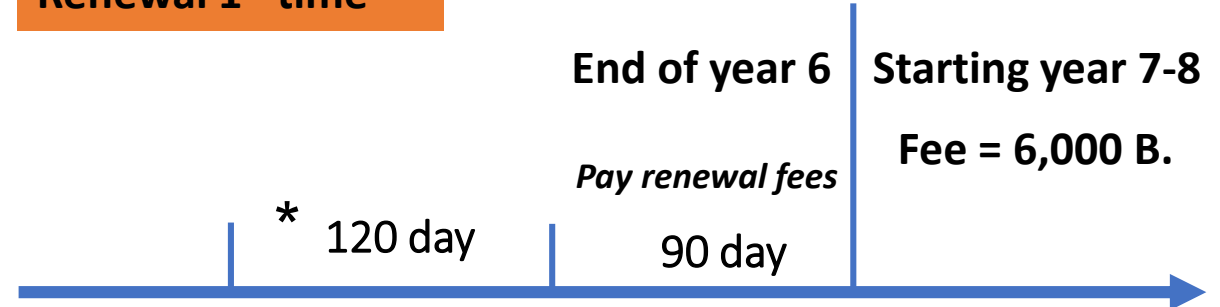
Pay renewal fee (Petty patent)

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.

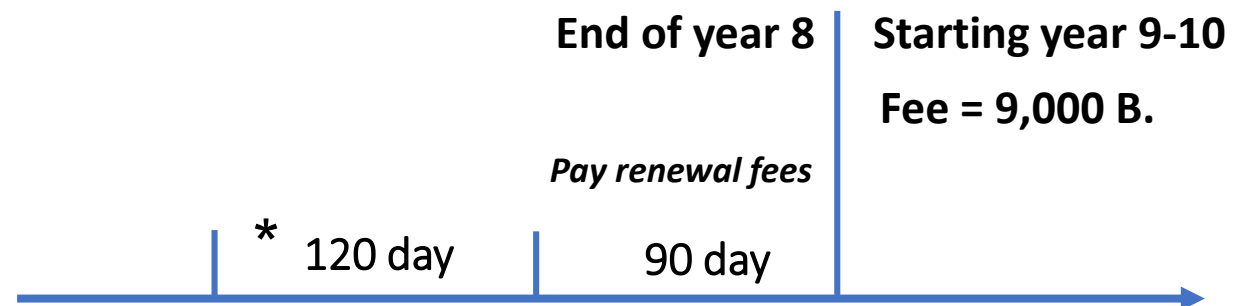
If an application for any such extension must be submitted within 90 days prior to the expiration of the petty patent. the term of protection for petty patents will be shorter than that for ordinary patents,

if the petty patent term is calculated to include the two allowable extensions. equivalent to 10 years from the date the application is filed

Renewal 1st time



Renewal 2nd time



* Patent Office – Issued a notification of pay renewal fee (4 months in advance before paying renewal fee)



assignment agreement/Licensing agreement

Under Section 41 of the Thai Patent Act, a patent assignment agreement /Licensing agreement must be registered in compliance with the requirements, procedures and conditions prescribed by the relevant Ministerial Regulations,

When you applying for the registration of the assignment of a patent, Clause 6 of Ministerial Regulation No. 25 requires the assignee to submit an application or send it via registered post to the competent officer of DIP-Thailand

In order to be valid and enforceable. Section 152 of the Thai Civil and Commercial Code further provides that an act (agreement) which is not in the form prescribed by law is void.

Patent holders can grant license to another person must be in writing and registered with the Thai Patent Office.

“the license agreement cannot contain any terms that tend to unfairly limit competition” prescribed by Clause 3-5 of Ministerial Regulation No. 25

To file an application for registration of a patent assignment agreement ,license agreement the following documents are required:

- A notarized Power of Attorney of the assignee;
- A notarized Power of Attorney of the assignor;
- The original Patent Assignment Agreement notarized by a Notary Public;
- Thai translation of the Power of Attorney, its Notarial Acknowledgement, and Assignment Agreement; and
- A copy of the certificate of patent registration.

1) Any person may apply to the Director-General for a license. Sec.46

If patentee unjustifiably fails to exercise his legitimate rights as follows

(1) that the patented product has not been produced or the patented process has not been applied in the country, without any legitimate reason; or

(2) that no product produced under the patent is sold in any domestic market, or that such a product is sold but at unreasonably high prices or does not meet the public demand, without any legitimate reason.

(the applicant for a license must show that he has made an effort to obtain a license from the patentee having proposed conditions and remuneration reasonably sufficient under the circumstances, but was unable to reach an agreement within a reasonable period.)

An application for compulsory license may be made according to the following circumstances:

- 1) after three years from issuance of patent/petty patent or four years from application date, whichever is later, patentee or petty patentee has not exploited his/her lawful rights. (Sec. 46)
- 2) 2) the exercise of the patent rights of one party may infringe another patentee provided that it must satisfy the conditions specified in the Act. (Sec 47)
- 3) a Ministry or a Department may exploit an exclusive right in a patent by itself or by designating another person, or the Prime Minister with the Cabinet's consent may order the use of any patent under some conditions according to the Act. (Sec 51, 52)

Note

Under the Section 46 of the Thailand Patent Act, the patent holder must work his patented invention within the country. The obligation includes:

1. manufacturing the patented product or apply the patented process in Thailand; or
2. making available in the Thai market of the patented article or the product obtained by the patented process in quantity and at prices that can meet the domestic demand for such a product



กรมทรัพย์สินทางปัญญา
DEPARTMENT OF INTELLECTUAL PROPERTY

*Conditions of application submission

[Invention Patent /petty patent Registration](#)

Supporting documents for invention patent registration

[Registration of Licensing Agreement](#)

[Supporting documents for registration of licensing agreement](#)

[Registration of transfer of patent and petty patent](#)

Supporting documents for Transfer of Patent and Petty Patent

[Patent renewal](#)

Supporting documents for patent /petty patent renewal

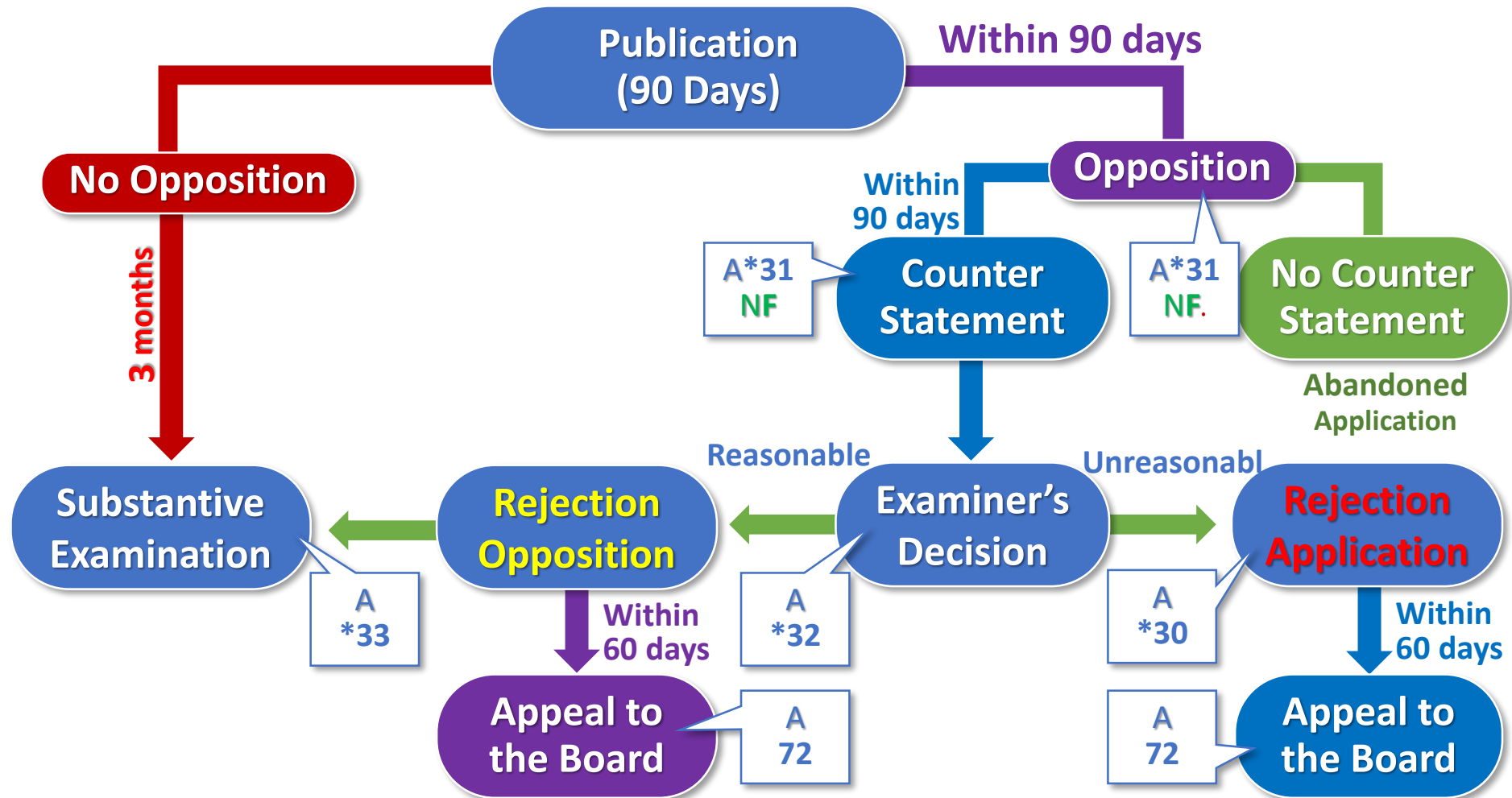
*Form /fees

Can be find more information at

<https://www.ipthailand.go.th/th/patent-007.html>

<https://www.ipthailand.go.th/en/patent-002.html>

Procedure opposition patent of DIP-TH



The Applicant

The Officer

The Opposing Party

Is there a way for a patent applicant to expedite the examination process by the Thai Patent Office?

Patent Prosecution Process

1. Filing Stage
2. Preliminary Examination Stage
3. Publication Stage
4. Substantive Examination Stage
5. Registration Stage

after this stage



Accelerating Examination Options

1. **ASEAN Patent Examination Co-operation (ASPEC) Program**
 - Objectives – to reduce repetitive work / to obtain faster turnaround time and to obtain better search and examination results
 - Advantages - a first action can be expected within 6 months and an extra fee is not charged
 - Disadvantages – translation costs and the examiner will utilize examination reports as *a guide only*
 - ASEPC route – application number and information on prior applications, copies of search report, examination report, claims referenced, and claim correspondence table (optional)
2. **Patent Prosecution Highway (PPH) Pilot Program**
 - Objectives – to use the examination results of the application that claim priority to a corresponding Japanese application
 - Advantages - a first action can be expected within 6 months
 - Disadvantages – the examiner will utilize examination reports as a guide only
 - PPH route – the PPH Pilot Program Request Form, copies of all office actions, Examination Search Report, the corresponding Japanese patent, the patent publication cover page, all claims determined to be patentable, references cited, and claim correspondence table (optional)

Statistics

- Only one application (from 18 applications enrolled) in the ASPEC program has matured to grant with approximately 7 months.
- 50% of applications in the PPH program have matured to grant with approximately 7 - 15 months.
- 30% of applications in the PPH program have received no results.



The pendency - Patent and Petty patent

ASPEC Statistical Data

Group	Number of ASPEC Request			Grant	Amend ment	Sum
	2012- 2018	2019	Total			
Engineering	23	4	27	12 (52.17%)	5 (21.74%)	17 (73.91%)
Biotechnology	7	0	7	3 (42.85%)	2 (28.57%)	5 (71.42%)
Petrochemical	9	4	13	2 (20.00%)	5 (50.00%)	7 (70.00%)
Physics	39	9	48	12 (29.27%)	12 (29.27%)	24 (58.54%)
Electricity	39	2	41	10 (25.64%)	17 (43.59%)	27 (69.23%)
Chemical Technology	23	5	28	5 (20.83%)	15 (62.50%)	20 (83.33%)
Pharmaceutical	8	1	9	0 (0.00%)	2 (40.00%)	2 (40.00%)
Accumulating Total	148	25	173	44 (28.76%)	58 (37.90%)	102 (66.66%)
				base on 15 JUL 2019		

Group	Number of ASPEC Request			First Action- Average Pendency (months)
	2012-2018	2019	Total	
Engineering	23	4	27	9
Biotechnology	7	0	7	13
Petrochemical	9	4	13	16
Physics	39	9	48	11
Electricity	39	2	41	16
Chemical Technology	23	5	28	9
Pharmaceutical	8	1	9	7
Accumulating Total	148	25	173	11.6



The pendency - Patent and Petty patent

Number of PPH application

Group	PPH (NT)		PPH (PCT)		All PPH	
	Grant	Total	Grant	Total	Grant	Total
Chemical Technology	50	96	58	261	108	357
Biotechnology	12	15	6	32	18	47
Petrochemical	30	46	69	158	99	204
Physics	36	49	220	391	256	440
Electricity	15	39	49	132	64	171
Pharmaceutical	3	9	9	74	12	83
Engineering	105	170	211	421	316	591
					873	1893

Average First Action PPH

group	PPH (NT)	PPH (PCT)	All PPH
Chemical Technology	11.64	15.08	13.42
Biotechnology	8.79	7.08	8.00
Petrochemical	40.60	11.94	20.16
Physics	8.21	7.72	7.78
Electricity	8.42	14.47	12.97
Pharmaceutical	13.17	15.77	15.28
Engineering	5.01	6.10	5.76
Average			11.9

Chemical group

15

months

Physical group

7

Months

Info.
July 2019

Patent	2017 Y.	2018 Y.	2019 Y.
Re.exm. – Close the case (Average)	4.5 year	3.75 year	3.12 year
First Action (Average)	3.5 year	3.1 year	2.83 year

Petty patent

First OA 6- 12 month

Info.–E-patent ,July 2019

THANK YOU