

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Mr. Vuttikrai Leewiraphan  
Director General  
Department of Intellectual Property  
Ministry of Commerce  
563 Nonthaburi Road, Bangkrasor Muang  
Nonthaburi 11000  
Thailand

Dear Mr. Leewiraphan,

## **Re: JIPA Comments on the amendment bill of Thailand Patent Act**

We, the Japan Intellectual Property Association "JIPA", are a private user organization with about 970 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property system of other countries and make recommendations for more effective implementation of the systems. (<http://www.jipa.or.jp/english/index.html>)

Having learned the amendment bill of Thailand Patent Act on your website, we would like to offer our opinions as follows.

Your consideration on our opinions would be greatly appreciated.

Sincerely yours,

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Tatsuya MORI  
Managing Director

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Makoto FUKUOKA  
Managing Director  
Japan Intellectual Property Association

## **Comments on Draft Revision of the Thai Patent Act (1)**

### **Section 5: Exception to lack of novelty of invention**

We express our appreciation to the introduction of "disclose by an applicant, or an inventor or a person who gets a permission from the applicant," in addition to "inventor" as an exception to lack of novelty of an invention.

Meanwhile, it is unclear whether "disclosure to the public through an arbitrary method" includes "a case where a product is announced by itself through the Internet, product sales or the like."

In various scenes of product developments of companies, there are many demands for early publication of technologies. In particular, technical information disclosed through the Internet is equivalent to technical information published in the form of journals, books and others, and in addition, it is available in a prompt and convenient manner; and there is an increasing number of cases where researchers or inventors, with the purpose of early publicizing their research achievements or inventions, utilize the Internet as an opportunity for presentation.

In consideration of the above, it is requested to stipulate in the text of provisions or examination standards that the disclosure of important matters or details on the technical information includes "announcement of a product by themselves through the Internet, product sales and the like."

### **Section 10: Patent applications related to genetic resources and traditional knowledge**

We consider that the utilization of genetic resources and sharing of benefits discussed in the Convention on Biological Diversity and the Nagoya Protocol should not be connected to the patent system. Therefore, it is requested to delete Section 17/1, which obliges a patent applicant to submit a source indication of a genetic resource and related references.

If the above request is not acceptable, it is requested to limit "genetic resources or traditional knowledge" to "Thailand-derived genetic resources or traditional knowledge" in consideration of the balance between the national interests of your country and the procedural burden on patent applicants.

In connection with this Section, the definition of "genetic resources" in the

Section 3 of the draft revision of the Patent Act includes "derivatives" and is broader than the definition of "genetic resources" in the Convention on Biological Diversity and the Nagoya Protocol. To keep consistency with the definition of the Convention on Biological Diversity and the Nagoya Protocol, it is requested to delete "derivatives" from the definition of "genetic resources." Next, it is requested to delete the provision "to submit an application form for permission before use thereof and a statement of agreement on benefit-sharing together with a patent application form." There exist many countries that do not institutionalize obtaining of "an application form for permission before use thereof and a statement of agreement on benefit-sharing." In addition, although the definition of "genetic resources" in Section 3 of the draft revision includes "derivatives" as described above, it is not easy to obtain such an application form for permission and a statement of agreement on "derivatives." If this provision is incorporated into the Patent Act, this increases the procedural burden on a patent applicant and hampers the implementation of the first-to-file doctrine. Therefore, we request you to eliminate a submission requirement or ease the timing or method of submission.

Further, the provision stipulates "the patent applicant should specify its source." However, it is sometimes difficult for the patent applicant him/herself to specify its source, and thus, in such a case, we request you to exempt the applicant from the obligation to specify the source.

Finally, if Section 17/1 of the revision should be adopted, even if an applicant violates the requirement, we request you not to use such a violation as a rejection reason or an invalidation reason. It is sometimes very difficult for a patent applicant to specify a source of a genetic resource as described above, and it is also assumed that the source of a genetic resource is found after the filing of a patent application or registration of a patent, and thus it is requested that the revision should not give an unexpected disadvantage to a patent applicant.

### **Section 15: Divisional application to examiner**

The draft revision of the Patent Act stipulates that "If the applicant does not agree with Examiner's order, the applicant shall file an appeal against the order to Director-General within 60 days from receipt of the order." Meanwhile, Section 26 before the revision stipulates that "If the applicant does not agree with the requirement to separate the application, he shall appeal to the Director-

General within 120 days."

Foreign residents sometimes have difficulty in filing an appeal within 60 days.

Accordingly, it is requested to set the term for foreign residents to file an appeal to within 120 days as in the past.

### **Section 16: Information used for examination on corresponding foreign patent application**

The draft revision stipulates that an extension for submission is permitted when a request for the extension is filed with a fee within 90 days. However, it is considered too stringent to an applicant that if a request is not filed within a designated period for the additional procedure, an application is deemed to be withdrawn. At the same time, this provision is unclear as to the examination results of which country must be submitted, and there is a concern that an applicant would be forced to assume an unnecessary burden. In addition, there is a doubt whether it is necessary to submit information used for examination even before an examination request; and if submission of such information is required regardless of whether or not an examination request is filed, there is a concern that it would be a heavy burden on an applicant.

Accordingly, we request a system in which submission of a patent publication of a corresponding foreign patent application (in that case, a patent of any country is acceptable) and a Thai translation thereof is sufficient.

In addition, it is requested that the timing of submission should be clarified by stating "submitting at the time of or after an examination request and within a predetermined period from receipt of a foreign country examination result."

### **Section 19: Introduction of relief measure on period for examination request on invention**

The draft revision of the Patent Act stipulates "Section 29. The applicant may request the competent office to proceed with the examination of whether an invention is a patentable invention based on Section 5 within 3 years from the filing date of the patent application in the Kingdom of Thailand. If the applicant fails to make such a request within the predetermined period, the applicant shall be deemed to have abandoned the application."

However, if a patent application is deemed to be abandoned due to the

occurrence of an unavoidable event such as a natural disaster or a disease that does not allow a patent applicant to file an examination request within the predetermined period, it is too stringent to a patent applicant. In this regard, when an applicant has "a justifiable reason" such as an unavoidable event, several countries do not deem that an application is abandoned but they provide a relief measure such as an extension of the period for an examination request.

Therefore, for a case where an applicant having "a justifiable reason" such as an unavoidable event cannot complete the procedure within a predetermined period for an examination request, it is requested that a relief measure should be provided to the applicant.

### **Section 23: Introduction of relief measure on opposition**

The draft revision of the Patent Act stipulates that "when the officer receives an opposition described in the first paragraph, the officer shall send a copy of the opposition to the applicant and the applicant shall file a counterstatement within 90 days following the receipt of the copy of the opposition. If the applicant fails to file a counterstatement, the applicant shall be deemed to have abandoned the application." However, the abandonment disposition of Section 32/2 is not taken as a subject for appeal (Revision of the first paragraph of Section 74 of the 1979 Patent Act in Section 61 in the revised Patent Act).

However, there is a possibility that a patent applicant cannot file a counterstatement due to an unavoidable event such as a natural disaster or a disease; and if no opportunity for a counterstatement is given to the applicant through the abandonment disposition, it is too stringent to the applicant. In Japan, if a patentee fails to file a counterstatement against an opposition, an opportunity is given by filing a suit of dissatisfaction against a decision on opposition later.

Therefore, it is requested to provide a further opportunity for counterstatement on the abandonment disposition of a patent application.

### **Section 27: Correction of mistranslation after registration**

The draft revision of the Patent Act stipulates that "Section 37/1. With respect to a patent certificate issued with a minor error or mistake, a patentee can file a request for correction or addition to Director-General with the payment

of a fee for correction of the patent certificate." We are grateful that the availability of an error correction after registration is put in statutory form.

Meanwhile, the draft revision of the Patent Act states that "However, the correction should not modify the essence or scope of an invention protected based on the patent certificate, and should be carried out with the consent of a joint owner of a patent right." It is unclear whether mistranslations can be corrected for the scope of claims after registration.

It is considered disadvantageous for foreign companies to have no opportunity for correction of a mistranslation in Thai compared to applicants dealing with Thai as the native language. In addition, there are many cases where a mistranslation is found after exercise of a right; and if the mistranslation cannot be corrected at that time, this hampers legitimate exercise of the right against a malicious person working the patent.

Therefore, it is requested to stipulate in written form in the provision or the examination standards that it is possible to make not only correction of an error after registration but also correction of an error or mistranslation before registration. At the same time, in order to avoid a confusion derived from a broader interpretation of the applicant, it is requested to provide examples to show what degree of error correction is acceptable in the examination standards.

In addition, at a scene for exercise of a right, restriction of a claim is sometimes required within the scope disclosed in the specification. Accordingly, it is requested to modify a provision to allow restriction of a claim within the scope disclosed in the specification after registration.

## **Section 29: Licensing of patent right**

A record to an examiner is required, but it is requested to modify a provision not to require such a record. It is considered that such a record is not necessary as long as there exists a (licensing) contract between parties.

### **Others:**

#### **(1) Adoption of system for withdrawal of patent application before publication**

In relation with manufacturing development, sometimes it is found after the filing that a trade secret is included in a patent application; or an applicant wants

to avoid publication of the patent application due to a policy change of business.

However, even when the draft revision of the Patent Act is reviewed, it does not include a provision that allows withdrawal of a patent application.

Therefore, it is requested to include a provision allowing withdrawal of a patent application in the Patent Act.

## **(2) Adoption of system of term extension of patent right**

The draft revision of the Patent Act fails to adopt a system of term extension of a patent right.

However, particularly in the field of pharmaceuticals, agrochemicals or the like, a long period for collection of experimental data and examination thereon is needed for a permission based on the governmental laws and regulations for guarantee of the safety, etc.; and thus it is impossible to enjoy a benefit resulting from an exclusive right even when a patent right continues for that period. Then, the problem is that a period of the patent corresponding to that period is useless. These laws and regulations are necessary, but as a result thereof, a benefit originally obtainable during the period of a patent is reduced by the period required to satisfy the laws and regulations.

Therefore, with respect to working of a patent invention, which requires a considerable period to satisfy the laws for guarantee of the safety, etc., it is requested to provide a system that allows registration of an extension of the term of a patent right while limiting the extension to a certain length in a case where there is a period in which the patent invention cannot be worked.

## **(3) Introduction of provision for indirect infringement**

We are grateful that Sections 25 and 26 of the draft revision of the Patent Act stipulate details on prohibited acts by parties other than a patentee. However, if the 1979 Patent Act and Sections 25 and 26 of the draft revision of the Patent Act refer to the working of a patent invention as the working of the constitution as a whole of the patent invention, the working of part of the patent invention is not regarded as infringement of the patent right.

This would cause the following disadvantages.

- (i) If there is a party that does not infringe a patent but conducts a so-called preliminary act highly likely to infringe when the party is left as it is, this act cannot be prohibited.
- (ii) infringement of a patent right is constituted by a requirement wherein the

working of a patent is carried out with the purpose of production, etc., and thus it is interpreted that none of those capable of only partial production or final assembly as an individual or at home, for example, a manufacturer of parts finally used for assembling, are responsible for infringement.

If these acts are not effectively prohibited, the effect of a patent right is diminished.

To prevent such a case, it is requested to clearly stipulate that these acts (indirect infringement) be infringement of a right in the Patent Act.

#### **(4) Abolition of authentication system (power of attorney)**

Even when the draft revision of the Patent Act is reviewed, authorization of a power of attorney is still required (Section 17 of the 1979 Patent Act, Section 21, No. 13 of the ministerial regulations in 1999 based on the provision of the revised Patent Act in 1999). Although a burden is necessary for the authorization procedure, companies hardly utilize it; and thus it is requested that authorization is not required for a power of attorney.

## **Comments on Draft Revision of the Thai Patent Act (2)**

### Section 3: Modification of contents on the definition of "Design"

We appreciate the introduction of a partial design system in which a partial scope is defined as a right.

On a worldwide basis, the number of countries that have introduced a partial design system is increasing. Considering that about 40% of design applications is for partial design in Japan, there are many demands therefor from users; and it is considered that there are high needs for introduction of a partial design system. We are deeply grateful that users' needs are appropriately reflected in the draft revision.

### Section 57(2): Exceptions to publicly known designs

We appreciate the expansion of cases where exceptions to lack of novelty are applied.

### Section 60/4: Introduction of related design system

We appreciate the introduction of the system. In the process of design development, a plurality of products are sometimes designed based on a common concept, and the introduction of a related design system that can comprehensively protect these products as a "group" is a system that users have definitely desired. We are deeply grateful that the users' demand is taken into consideration and reflected in the draft revision.

Meanwhile, a further extension of a period for which a related design can be filed is demanded. In the design development, model changes are often carried out by adding a modification to a design little by little depending on a market trend after development of a product. If there is a restriction on the period for filing, that is "within 6 months from the filing of a principal design or before the publication of the principal design," it is difficult to file a design including a minor model change as a related design. It is considered that the restriction of before the publication of the principal design should be removed and a term of 6 months from the filing should be extended at least 2 to 3 years.

### Section 60/7: Introduction of a system not to publicize an application for a certain period

We appreciated the introduction of the system. After the filing of a design,

public announcement of a product is sometimes delayed for a business reason; and in this case the design would be publicized earlier than the public announcement of the product depending on the term of delay. Therefore, the introduction of a system not to publicize an application for a certain period is a system that users have desired. We are deeply grateful that the users' demand is taken into consideration and reflected in the draft revision.

However, because the certain extendable period is unclear, it is requested to clarify it. In Japan, a secret design system allows publication to be extended to 36 months after registration, and thus it is requested to clearly stipulate an equivalent period therefor in the section.

In addition, it is also requested that an extension can be withdrawn. Even when a request for extension on a design is made once, the design is sometimes brought into a situation where early acquisition of a right is needed for a reason such as changing of a public announcement schedule of a product or finding of a counterfeit. Considering that countries or regions such as Japan or Europe that have introduced a system for delaying publication permit a procedure for withdrawal of an extension, it is requested to introduce the withdrawal of an extension together with the extension request.

In addition, it is also requested to issue a publication after registration in the future although only "publication of an application" is available at present in your country. For a case where the contents of an application are amended in the process of substantive examination or opposition after publication of the application, it may be impossible to accurately understand a right only from the publication of the application. In such a case, issuance of a publication of a registered design including amended contents is desired.

#### Section 62: Term of right

We appreciate that the term of a right is extended to 15 years. However, in consideration of the actual circumstance where there are an increasing number of products that penetrate their brands by continuous use of a product design for a long term, a much longer term of a right is demanded. Based on the fact that a maximum of 25 years is permitted for the term of a right in Europe, Japan or the like, a further extension of the term of a right is requested in your country.

#### Sections 65/1, 65/2, 65/3, 65/4, 65/5, 65/6, 65/7, 65/8, 65/9, 65/10 and 65/11: International registration of industrial designs based on Hague Agreement

We appreciate that your country participates in Hague Agreement. The number of member countries of the Hague Agreement is increasing, and many merits such as improvement of efficiency in filing procedures or cost reduction in managing rights will be enjoyed by users that file applications in many countries and regions including your country.

Others: Early granting

The period required from filing of a design application to granting thereof in your country is about 4 years (according to JETRO's survey in 2014), and it is relatively long; and thus it is requested to shorten the period up to granting. A longer period from the filing to the granting would shorten the period for substantial use of a right and cause difficulty in substantially protecting a product with a short life cycle; and these bring disadvantageous situations to right holders and they are not desirous to users. Although not listed in the contents of the present draft revision, it is requested to consider the abolition of a system of publication of unexamined applications and a system for opposition, and the introduction of an accelerated examination system in the long term in order to contribute to earlier establishment of rights.

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