

CHAPTER 4

PATENTS, COPYRIGHTS, TRADEMARKS

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Thailand recognizes three broad categories of property rights:

1. Patents
2. Copyrights
3. Trademarks

1. Patents

Thailand promulgated its first patent law, the Patent Act, in 1979, with significant amendments added in 1992. The Act protects inventions, product designs and pharmaceuticals. In 1997, a new intellectual property and international trade court began an operation, which has significantly improved enforcement. Appeals procedures at the trademark and patent offices have also been streamlined.

In January 2008, the National Legislative Assembly approved Thailand's plan to join the Paris Convention and the Patent Cooperation Treaty.

Thailand successfully became a party to the Paris Convention on August 2, 2008 and on September 24, 2009; Thailand submitted the instrument of accession to the Patent Cooperation Treaty (PCT), making Thailand the 142nd state to become a contracting party. The PCT became binding on Thailand 3 months from the date of submission, i.e., on 24 December 2009.

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.

Accession to the PCT will help to facilitate the registration of patents abroad for Thai inventors. The PCT registration system meets international standards and is accepted by numerous countries; thus, inventors can receive protection in PCT member countries, many of which are Thai export markets, such as the United States, Japan, Australia, China, and India. Thailand's participation in the PCT will also help applicants from other member countries seek patent protection for their inventions in Thailand.

1.1 Invention Patents

For an invention to be patentable, it must

- Have novelty;
- Involve an inventive step; and
- Be capable of being made or used for some kind of production activity.

Therefore, the following would not qualify for patents due to lack of novelty:

- An invention widely known or used by others in Thailand before the filing of the patent application;
- An invention, the subject matter of which was described in a document or printed publication, displayed or otherwise disclosed to the public in Thailand or a foreign country prior to the date of the application for the patent;
- An invention that has been granted a patent inside or outside Thailand prior to the date of the patent application;
- An invention for which an application for a patent was filed in a foreign country more than 18 months prior to the date of the patent application, the foreign patent not having been issued;
- An invention for which application for a patent was filed in Thailand or in a foreign country and that application was published before the date of application in Thailand.

The revised Patents Act provides that the following are not patentable:

- Microbes and any components thereof which exist naturally; animal, plant or extracted substances from animals or plants;
- Scientific or mathematical rules or theories;
- Computer programs;
- Methods of diagnoses, treatment or cure of human and animal diseases;
- Inventions those are contrary to public order or morality, public health or welfare.

In case an invention lacks an inventive step, the invention may be granted a petty patent if it is new and capable of industrial application. However, a petty patent and a patent shall not be granted for the same invention. The legal protection of a petty patent is less than of a patent, i.e. term of protection.

1.2 Patentable Product Designs

Product design means any form or composition of lines or colors which gives a special appearance to a product and can be used in industrial or handicraft applications.

A product design must be novel in order to be patented, i.e., it must not fall under any of the following conditions:

- A design widely known or used in Thailand before the filing of the patent application;
- A design picture, the subject matter or details of which have been displayed or disclosed in a document or printed publication inside or outside of Thailand before the filing of the application;
- A design that has been published in the patent journal under Section 65 and 28 before the filing of the patent application; and
- A design that so nearly resembles any of the product designs indicated in the points described above that it is apparently an imitation.

The following product designs are not patentable.

- Product designs which are contrary to public order and good morals;
- Product designs prescribed by Royal Decree.

1.3 Eligibility

An inventor or product designer has the right to apply for a patent, as does a successor or assignee of the right. An assignment must be made in writing, signed by both the assignor and the assignee.

If, during the course of employment or an employment contract specifically for creating an invention or design, an employee creates an invention or product design, the right to apply for a patent belongs to the employer unless otherwise provided by agreement.

The Patent Act requires that an applicant for a patent must be a Thai national or a national of a country which allows persons of Thai nationality to apply for patents in that country.

1.4 Term of Patents and Patent Holder Rights

Term

- The term of an invention patent is 20 years from the date of filing an application in Thailand, and is not renewable. The term of protection for a petty patent is 6 years from the date of filing an application in Thailand, which can be extended twice, for 2 years each.
- The term of a design patent is 10 years from the date of filing an application in Thailand.

Rights

- During the period of the validity of the patent, the patent holder has the exclusive right to produce, use, sell, have for sale, offer for sale, and import the patented invention or design. Any act of violation performed before the patent is granted, that would otherwise constitute an infringement of the patent, is not deemed an infringement.
- A patent holder has an exclusive right to use the words “Thai Patent”, or an abbreviation or translation thereof.
- A patent holder may assign the patent to another holder.
- A patent holder may grant a license to another person, subject to restrictions:
 - The patentee shall not impose upon the licensee any condition or restriction or any royalty covenant that is an unfair restraint of competition. Conditions, restrictions or covenants that unfairly restrain competition shall be prescribed by a Ministerial Regulation.
 - A patent holder may not require a licensee to pay a royalty or royalties after the validity of the patent has expired.
 - Conditions, restrictions, or royalties which are contrary to the above two points are null and void.
 - Any assignment of patent or license contract must be in writing and officially registered with the authority.

1.5 Compulsory Licensing

An application for a compulsory license may be made under the following circumstances:

1. If, after 3 years from granting of patent or petty patent or 4 years from date of application, whichever is later, the patentee or petty patentee has not enforced his/her lawful rights (Section 46 of the Thai Patent Act B.E. 2542).
2. If the exercise of the patent rights of one party (the junior patentee) may infringe another patentee (the senior patentee) provided that:
 - The junior patentee’s invention must be a substantial technological advancement which is beneficial to the economy, compared to the invention under the patent for which the license is being sought;
 - The senior patentee receives a cross-license to exploit the junior patentee’s patent rights; and
 - The junior patentee shall not assign a legal license to anyone unless it is an assignment together with his own patent (Section 47 and Section 47 bis of the Thai Patent Act B.E. 2542).
3. A Ministry or a Department may exploit an exclusive right by itself or by designating another person in a patent for the benefit of public utilities or national defense; the preservation or acquisition of natural resources or the environment; the prevention of severe shortage of food or medicine or other necessities for living; or other public interests (Sections 51 and 52 of the Thai Patent Act B.E. 2542).

1.6 Cancellation of Patents

The Director General may ask the Board of Patents to revoke a patent if:

1. 2 years after issuance of license, the patentee or licensee has not manufactured the product or applied process under the patent in the Kingdom without any legitimate reason, or for the time being the product is not being sold or imported for sale, or is being sold at an unreasonable high price; or
2. The patentee has licensed other persons to exercise the rights under the patent without conforming to prescribed procedures.

1.7 Foreign Patents

A foreign patent that has not been granted a separate patent in Thailand receives no protection under the Patent Act. However, foreign patent holders or owners of rights to inventions or designs in foreign countries may enter into business transactions with parties in Thailand and seek equivalent protection through contractual obligations in the form of a licensing agreement.

Since foreign patents, inventions and designs receive no protection under the Patent Act, no civil or criminal action can be taken against a third party who produces or sells a patented product in Thailand without paying fees to the holder of the foreign patent or who applies in Thailand for a patent on an invention or design already patented in other countries. Nevertheless, legal solutions to such conflicts may be available under separate legislation.

2. Copyrights[®]

The Copyright Act of 1994 protects literary, artistic works and performance rights by making it unlawful to reproduce or publish such works without the owner's permission.

2.1 Works Subject to Copyright

The Copyright Act protects works in the categories of literary work, including computer programs; dramatic, artistic and musical work; audiovisual material, cinematic film, recorded material; disseminated pictures or disseminated sound; or any other works in the fields of literature, science or fine arts.

The Copyright Act also protects computer software against reproduction or adaptation, publicity and rental of such software. Algorithms are not protected, however.

The "copyright" as defined by the Act means "the exclusive right to take any action concerning the work created or made by the creator". The Copyright Act also defines the word "creator" as the person who makes or creates the work which is a copyright work.

A copyright belongs to the creator of a work, subject to the following conditions:

1. In the case of unpublished work, the creator must be of Thai nationality or reside in Thailand or be a national of or reside in a country which is a member of the Convention on the Protection of Copyright, of which Thailand is a member, provided that the residence at all times or most of the time is spent on the creation of the work.
2. In the case of published work, the first publication must be made in Thailand or in a country that is a member of the Convention on the Protection of Copyright. In the case where the first publication was made outside Thailand or in a country which is not a member of the Convention, the work created must have been published in Thailand or in a country which is a member of the Convention within 30 days from the first publication, or the creator must have the qualification as prescribed in (1) at the time of the first publication.

In case where the creator is required to be a person of Thai nationality, and if the creator is a juristic person, such juristic person must be established under the Civil and Commercial Code of Thailand.

2.2 Copyright® Infringement

The Copyright Act includes a comprehensive list of the types of infringement covered by law:

Infringement by reproduction without authorization -- The Act defines the word "reproduction" as follows: "Reproduction includes copying by whatever means, imitating, duplicating, making printing blocks for, recording the sound of, taking pictures of, or recording the sound and taking pictures in substantial parts of the originals, from copies or from the publication, regardless of whether of the whole or in part."

Infringement by adaptation without authorization -- Adaptation, as defined by the Act, means reproduction by conversion. This involves substantial modification or emulation of the original work without creating a new character whether of the whole or in part.

- With regard to a literary work, it shall include a translation, a transformation or a collection by means of selection and arrangement,
- With regard to a computer program, it shall include a reproduction by means of transformation, modification of the program for the substantial part without the appearance of creating a new work,
- With regard to dramatic work, it shall include the transformation of a non-dramatic work into a dramatic work or dramatic work to a non-dramatic work, whether in the original language or in another language,
- With regard to artistic work, it shall include the transformation of a two-dimensional work or a three-dimensional work into a three-dimensional work or a two-dimensional work respectively, or the making of a model from the original work,
- With regard to musical work, it shall include an arrangement of tunes or an alteration of lyrics or rhythm.

Infringement by publicizing without permission -- It is an infringement of copyright to publicize a work without the consent of the copyright owner. "Publicize" means "present to the public by showing, lecturing, praying, playing, presenting with by sound and/or picture, constructing, distributing, selling, or by other means, the works done or created." The word "public" refers to the person or persons who are present, and not to the place where the performance occurs. A performance will not be regarded as being carried on in public if it is restricted to family and friends of the performer or of whoever is responsible for the performance

Infringement by producing audiovisual material, cinematic film, recorded material or dissemination of sound or picture whether of the whole or in part, or by rebroadcasting of sounds and visual images, whether of the whole or in part, or arranging for dissemination of sound or picture in public with commercial purposes.

2.3 Exceptions

Under the Act, any act that might ordinarily be deemed copyright infringement may not be so deemed if done for the following purposes:

- Research or education, without any commercial purposes;
- Use for one's own benefit or for the benefit of himself and a member of one's own family, or close relatives;
- Comment, criticism or recommendation of the work, with recognition of the copyright ownership of such work;
- Presenting news or otherwise reporting through the mass media, with recognition of the copyright ownership of the work;
- Reproduction, adaptation, performance or presentation for a court hearing or consideration by competent and authorized officers or for reporting on the outcome of such hearing or consideration;

- Copying, duplicating or adapting parts of the work, or making extracts or summaries, by teachers or by educational institutions for the purpose of distributing or selling to students in school classes or in educational institutions, provided that such activities are not for commercial purposes;
- Use of the work as parts of questions and answers in examinations.

In addition, citing, copying or imitating certain parts of the copyrighted works under the Act, with recognition of the copyright ownership of the work, shall not be deemed to be copyright infringement.

The Act also entitles librarians to reproduce works copyrighted under the Act, provided that complete reproduction is not done for commercial purposes.

2.4 Works Not Subject to Copyright under the Copyright Act.

The Act specifically provides that the followings are not deemed eligible for copyright protection:

- Daily news and facts that are, by nature, merely news items;
- The Constitution and laws;
- Announcements, orders and regulations of ministries, bureaus, departments or any other agency of the state or local jurisdiction;
- Court judgments, orders, rulings and official reports;
- Translations and collections of those items specified as above which are prepared by government agencies or local administrations.

2.5 International Copyrights

The Copyright Act of 1994 protects copyright works of a creator and the rights of a performer of a country party to conventions on copyright protection or conventions on performance rights protection to which Thailand is a party, or for works copyrighted under international organizations of which Thailand is a member.

2.6 Licensing and Assignment of Copyrights

The 1994 Act provides that a copyright owner is entitled to assign license to another person, whether of the whole or in part, to use or exercise rights with respect to his copyrighted work. The Act requires that an assignment of copyright by means other than inheritance must be made in writing and signed by the copyright owner and the assignee. In the event the assignment is made without specifying the assignment period, the assignment shall be valid for 10 years.

In the event of an assignment of a copyright, the creator of the copyrighted work retains the right to forbid the assignee to distort, shorten, adapt, or act otherwise in any manner against the work if such act would cause damage or injury to the reputation or prestige of the creator.

2.7 Copyright Protection Period

A copyright in literature, drama, artistry or music is valid throughout the lifetime of the creator, and for an additional 50 years thereafter. In the event the creator is a juristic person, the copyright will be valid for a period of 50 years following the creation of the work. The copyright for applied artistic work is valid for a period of 25 years following the creation of the work.

2.8 Penal Provisions

Persons who commit copyright infringement by means of reproduction without permission from the copyright owner may have a fine from 20,000 to 200,000 baht imposed upon them. If the copyright infringement is deemed to have been committed for commercial purposes, the offender may face punishment of imprisonment for a term from 6 months to 4 years, or a fine from 100,000 to 800,000 baht, or both.

3. Trademarks™

The Trademark Act of Thailand of 1991, as amended by Trademark Act (No. 2) of 2000, governs registration of and provides protection for trademarks. The Act defines a “trademark” as a symbol used in connection with goods for indicating that they are the goods of the owner of the trademark. The trademark must be “distinctive” and not identical or similar to those registered by others, and must not be prohibited under the Act.

3.1 Registration Procedure

A trademark (service mark, certification mark, collective mark) application must be:

- Completed on an official form in the Thai language, with specimens of the mark attached.
- Filed by the proprietor or his/her agent under a power of attorney, who must have a fixed place of business in Thailand or a contact address which the Trademark Registrar can contact.
- Filed with the Department of Intellectual Property.

According to the Trademark Act, for purposes of instituting legal proceedings relating to trademarks, service marks, certification marks, and collective marks, if the applicant or proprietor of a mark is not domiciled in Thailand, the business office or premises of such person or his/her agent, as stated in the application or recorded on the register, shall be considered as the domicile of such person.

If the Trademark Office deems that the trademark can be registered, and if no opposition to the trademark arises within 90 days of its publication in the official journal, the Trademark Registrar will grant a trademark registration.

3.2 Trademark Registration Period

Trademark registration is effective for a period of 10 years from the filing date of the application. The validity term does not include the period of time involved in legal proceedings. Owners of trademarks must file an application for renewal within 90 days prior to the expiration of their current trademark registration. A renewed trademark will be effective for an additional 10 years.

A trademark may be registered even if it is not being actively used. However, failure to utilize the trademark entitles third parties to challenge the rights of the trademark owner.

Registration of a geographical name as a trademark is quite restrictive, with only two exceptions: the name must not be a well-known geographical name, especially to the Thai public; the mark has gained recognition among the public through extensive use, proving that the product has been widely distributed and/or advertised under the mark for a long time, to the extent that Thai consumers are familiar with the product and can distinguish it from others.

Registration of a mark that is confusingly similar to a well-known mark, regardless of whether it has been registered in Thailand or not, is proscribed.

3.3 Penal Provisions for Trademark Infringement

The owner of a registered trademark has the exclusive right to use the trademark, and may initiate legal action against the violators. It is a criminal offense to represent a trademark as registered when it has not been legally registered, or to sell, possess for sale, or bring into the Kingdom objects under such a pretense. This offense is punishable by imprisonment of not exceeding 1 year or a fine of not exceeding 20,000 baht, or both. Presenting false evidence to register a trademark is punishable by a term of imprisonment of not exceeding 6 months or a fine of not exceeding 10,000 baht, or both.

Anyone who forges another person's trademark, registered in the Kingdom, or who sells, possesses for sale, or brings into the Kingdom objects with a forged trademark, shall be punishable by imprisonment of not exceeding 4 years or a fine of not exceeding 400,000 baht, or both.

Anyone who imitates another person's registered trademark in order to mislead the public into believing the imitation mark is that of the registered owner, or who sells, possesses for sale, or brings into the Kingdom objects with an imitated trademark, will be punishable by imprisonment of not exceeding 2 years or a fine of not exceeding 200,000 baht, or both.

Whoever repeats these offenses within a five-year period from the date of passing the punishment for another offense is liable to double punishment.

3.4 Service Marks, Certification Marks and Collective Marks

As of February 1992, these variations on trademarks are covered under all the provisions of the Act and hence receive the same protection as trademarks under the law. In the case of service marks, all the words "goods" mentioned in the Act's provisions shall mean "services".

Certification Marks

Applicants for certification marks must forward a copy of the regulations concerning the use of the certification mark together with the application for registration and demonstrate that they are well qualified to certify the merits of the goods or services.

The owner of a registered certification mark shall not use it for his own goods or services and shall not license any third person to act as certifier by authorizing the use of the mark, although they may license a third person to use the certification mark themselves. If they violate this rule, they are subject to a fine of not exceeding 20,000 baht.

The regulations concerning the use of the certification marks must:

- Specify the origin, composition, manufacturing process, quality and other characteristics of the goods and services to be certified;
- Include the rules, procedures and conditions in the granting of a license to use the certification marks.

3.5 The Board of Trademark Committee

In 1991, the Board of Trademarks was established to have the power and duties specified hereunder:

- To decide an appeal, order, or decisions of the Registrar under Trademark Act;
- To order a withdrawal of the registration of a trademarks, service marks or certification marks;
- To give advice to the Minister in the issuance of the Ministerial Regulations or Notifications;
- To consider other matters assigned by the Minister.