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## 1. 7 Domnern Somgiat & Boonma 法律事務所への質問書及び回答書

タイ法律事務所

### 1. 事務所概要

- [1] 貴所の所員構成（人数・内訳）について、教えてください。
- ・ 全所員数
  - ・ 資格別（弁護士総数、知的財産担当弁護士の人数、特許技術者、事務スタッフ、その他）
  - ・ 業務別（発明特許・小特許・意匠特許、商標、著作権、その他）
  - ・ 技術分野別（機械系、電気通信系、化学系、バイオ系、その他）
  - ・ 日本人スタッフ、日本語対応可能なスタッフ
  - ・ 元審査官・審判官・裁判官
- [2] 貴所の業務について、以下の内訳（%）とそのうちの日本企業の割合を教えてください。また、発明特許の出願について、多い技術分野や得意な技術分野があれば教えてください。
- ・ 業務別（出願関連、訴訟関連）
  - ・ 出願系（発明特許、小特許、意匠特許、商標）
  - ・ 訴訟系（発明特許、小特許、意匠特許、商標、著作権）
- [3] 貴所の業務について、2014年度の出願件数を教えてください。
- ・ 特許（国内企業）
  - ・ 特許（外国企業）
  - ・ 小特許（国内企業）
  - ・ 小特許（外国企業）
  - ・ 商標（国内企業）
  - ・ 商標（外国企業）
  - ・ 意匠（国内企業）
  - ・ 意匠（外国企業）
- [4] 2000年以降に貴所で取り扱った特許に関する異議申立（特許法31条等）、審判（特許法72条等）、及び取消訴訟（特許法54条等）の件数を教えてください。
- [5] 2000年以降に貴所で取り扱った侵害訴訟の件数を教えてください。
- ・ 特許
  - ・ 小特許
  - ・ 商標
  - ・ 意匠
  - ・ 著作権
- [6] 他の事務所と比較して、貴所の特徴があれば、教えてください。

### 2. Patent Prosecution

#### (1) 審査制度について

- [7] タイの発明特許出願において、審査の遅滞が問題となることがあります。審査を促進するために、出願人が取り得る有効な手段があれば教えてください。
- [8] PPH, ASPEC の利用件数のデータがあれば御教示下さい。また、申請～登録までの期間がお分かりであれば御教示下さい。
- [9] PPHの導入に伴い、PPH申請が無い通常の案件が後回しにされて審査が更に遅くなるという事象は生じていないでしょうか？
- [10] 出願公開を早めるために、出願人が取り得る有効な手段があれば教えてください。
- [11] 特許法27条に関して、外国の審査結果はいつ提出するのがよいですか？対応する複数の外国出願で審査結果が得られた場合、その全ての国について審査結果を提出する必要

がありますか？

[12] 特許出願人が早期に権利化を希望する場合、「優先審査」「早期審査」の制度を利用できるとされています。この「優先審査」「早期審査」の制度について教えてください。

a) 「優先審査」を申請するためには、申請書中で侵害事実を証明することが必要とされています。具体的に、審査をスムーズに進めるためにはどのような資料を集めるべきでしょうか？

b) 「早期審査」を申請するためには、外国の審査結果及びそのタイ語訳を提出することが必要とされています。この外国の審査結果について、その対象国の明文規定がありません。どの国の審査結果を提出すればいいのでしょうか？実体審査を行っている国の審査結果であればいいのでしょうか？また、提出する書類は最終審査結果だけでいいのでしょうか？審査経過に関する書類（調査報告、拒絶理由通知、応答書類等）やそのタイ語訳も提出する必要があるのでしょうか？提出書類に関するガイドラインがあれば、教えてください。

c) PCT 出願のタイ移行出願において、国際段階の予備調査報告で特許性を肯定する調査結果が得られた場合、この調査報告に基づいて早期審査を申請することはできますか？

[13] 「優先審査」「早期審査」以外に、早期権利化に有効な方法（例えば、外国の審査結果を提出した後に面接審査を行うなど）があれば教えてください。

[14] 面接審査について、利用状況を教えてください。面接審査の効果や、日本企業が利用する上での留意点があれば、教えてください。

[15] 技術分野別に審査のスピードに差が生じると言うことは無いでしょうか？

#### (2) 発明特許・小特許の保護対象

[16] 特許法第9条によると、土壌からスクリーニングされた新規な微生物や動植物の抽出物が不特許事由となっています。なぜ、微生物や動植物の抽出物が保護対象にならないのでしょうか？この規定はタイ特有であり、飲食品メーカーなどがタイに特許出願を行う際に留意を要する点です。「微生物や抽出物を含む飲食品」は保護対象となりますか？微生物や抽出物を保護対象とするのに有効なクレームの記載方法があれば、教えてください。

[17] ソフトウェア（コンピュータプログラム）発明またはソフトウェア関連発明に関する最近の運用を御教示下さい。

[18] 出願時に未公開の先願に対する新規性の判断について教えてください。出願時に未公開の先願に基づいて新規性がないとして拒絶されますか。後願に対し、先願の出願人が同一か否かでその判断基準は変化しますか。

#### (3) 進歩性の判断基準

[19] その出願の日前の当業者にとって自明でないか否かを判断する進歩性の判断について、タイの最高裁判決によれば、「当業者」とは「タイ国内における当業者」を指し、この基準は、発明者の出生地に関わらず適用されると聞いています。この理解は合っていますか？上記の「当業者」の見解に関する最高裁判決の概要を教えてください。

[20] 進歩性の判断が争点となった訴訟の事例をご存知でしたら、その内容について教えてください。

[21] 米国におけるいわゆる”secondary consideration”について、タイにおいても進歩性を肯定するのに有効と聞いています。審査、訴訟において、どの程度説明できれば、進歩性を認められるのでしょうか？

#### (4) 分割出願

[22] 審査官は審査請求が行われた後の実態審査の間だけ、分割出願要求を通知することができるかと伺っております。出願人が分割出願を要求できるのはいつまででしょうか。特許許可を受けた後であっても、登録料を納付前であれば、分割出願を行うことは運用上可能でしょうか？実例または特許庁からの通達等がありましたら教えて下さい。

[23] 特許法 26 条では、その出願が単一性を有さない場合、複数の出願に分割するよう求める旨が規定されています。分割した後もその分割出願が単一性を有しないと判断された場合、当該分割出願から更に分割を行うことは可能でしょうか？このような分割を行う場合、それが可能な期限はあるか。

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(5) 異議申立

[24] 異議申立(第 31 条)にかかる費用の概算(庁費用及び代理人費用に分けてお願いします)を教えてください。

[25] 異議申立の際に争われる事由(新規性、進歩性、産業上の利用可能性、冒認出願、職務発明等)について、全体の異議申立に対してそれぞれどの程度の割合か教えてください。

[26] 異議申立によって冒認出願の取戻しが可能と特許法に規定されておりますが(第 34 条)、異議申立期間が過ぎた場合は、どのような手続きによって冒認出願を取り戻すことができるのでしょうか?

[27] 異議申立の他に、第三者にとっては情報提供制度を利用することも考えられます。各々の費用の違いと、権利化阻止の確率の違いについて御教示下さい。

[28] 登録前に、自発的に補正できる時期を教えてください。

[29] 特許権者は、登録後にクレームを補正することは可能でしょうか?可能な場合、その目的(例えば、削除に限る、減縮に限る等)に制限はないでしょうか?

(6) 翻訳

[30] 出願書類について、タイ語への翻訳は貴所スタッフが行いますか?貴所スタッフが行う場合、そのスタッフはどの程度の技術的スキルを持っていますか?技術系の大学を出ている、技術系企業の勤務経験があるなど教えてください。

[31] 誤訳が日本企業の中で問題になることがあります。誤訳を防止するために貴所でなされている対策があれば、教えてください。

[32] 誤訳を防止するために、日本の出願人ができる対策があれば、教えてください。

(7) 期限管理/データベース

[33] タイの公開時期が一定でなく、審査請求期限管理が難しい状況かと思われまます。貴所では特許出願をどのようにウォッチングしていますか?

[34] 分割出願された出願の公開は、分割後どの程度で行われるのでしょうか?その場合、分割出願に関する審査請求期限を御教示下さい。

[35] 特許の登録クレームを把握するには、DIP へ行って包袋閲覧をしないと難しいと理解していますが正しいでしょうか?また、第三者にとって、そもそも特定の案件が登録されたか否かを知ることは可能でしょうか?

[36] DIP のホームページ上の検索以外に、タイ特許の調査に関して有効な検索データベースはあるのでしょうか?

[37] 判例を閲覧可能なデータベースはあるのでしょうか?

[38] 異議申立期間は、出願公開から 3 月と期間が限られており、早期に第三者の出願公開とその内容を把握することが必要になります。また、タイでの知財訴訟が増えてくると登録されたかどうかと言う審査の最終結果や登録クレームを簡易に把握するニーズが高まると考えられます。第三者は、どの様にしてこう言った把握を簡易に行うことが出来るのでしょうか?

[39] 審査書類等の包袋閲覧、特許原簿の確認等がオンラインで可能となる計画はありますでしょうか。また、電子出願がオンラインにて可能となるサービスの計画はありますでしょうか。

(8) その他

[40] 日本企業がタイで特許出願するにあたり、留意すべき事項があれば教えてください。

[41] 日本の特許出願人に対して、要望・提案があれば教えてください。

### 3. Enforcement

(1) Patent litigation

[42] タイにおける知的財産権の侵害品のルートは、国内生産と外国流入とでは、どちらが多いですか?

[43] 訴訟を提起する際、企業側で侵害に関する証拠を収集する必要があります。これらの証拠を収集する際、こういった資料が有効資料とされるのでしょうか?また、裁判審理を

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スムーズに進めるためには、どのような資料を集めるべきなのでしょう？

[44] 貴所の侵害調査体制（例えば、調査部を自社で保有している、外部調査会社と連携しているなど）について教えてください。

[45] 知的財産権の侵害者に対し、刑事責任を追及するためには、「故意」に当該行為を行ったことを立証する必要がありますが、具体的にどのような証拠を集めればよいのでしょうか？

[46] 侵害に関する証拠について、公証は必要でしょうか？

[47] 貴所では、下記のケース（2件）があった場合、どのように権利侵害品を入手しますか？具体的な手順を教えてください。

Case 1：被疑侵害品が店頭で販売されている場合（B to C）

Case 2：被疑侵害品が店頭販売されておらず、企業同士で取引される場合（B to B）

[48] 訴訟の提起から判決までどれくらいの日数を要していますか？特許、小特許、意匠で裁判期間に差はありますか？

[49] 発明特許や小特許を対象とした事件について、近年、増加傾向にあると聞いています。特許や小特許を対象とした事件に関する傾向や、最近の目だった例があれば教えてください。また、発明特許及び小特許に基づく侵害訴訟について、貴所で取扱った事件の概要（権利者の国、裁判所、技術分野、侵害事実と具体的な対応など）を可能な範囲で教えてください。

[50] 特許権に基づく権利行使における留意点があれば教えてください。また、特許権者が無効な特許に基づいた権利行使により責めを負った事例をご存知であれば、教えてください。また、小特許や意匠において、そのような事例があればご教示ください。小特許では、無効な権利に基づいた権利行使について、権利者の責任が、特許と比較して大きくなりますか。特許権侵害事件の裁判において、民事事件、刑事事件に関わらず被告は特許権が無効であることを主張できるのでしょうか？その場合、裁判官は、その裁判において特許の有効・無効を判断するのでしょうか？

[51] 過去の判例はどの程度、後の判決に拘束力を与えるのでしょうか？

[52] 特許訴訟に関して、最近の傾向、特筆すべき事例はありますか？

[53] 知的財産権の侵害者に対して権利行使する場合に、想定される必要経費（例えば、レイド捜査官の交通費・宿泊費・日当、摘発品の処分費用など）について教えてください。

[54] 均等論が特許法で規定されておりますが（36条の2）、裁判所が均等論を判断する際にどのような事項に基づいて判断するか教えてください。また、その中でもどの事項を重要視するか、優先順位があれば教えてください。

[55] 均等論に関して争った訴訟のうち、上記の判断基準に関して参考になるケースがございましたら、その内容について教えてください。

[56] 均等論に関して争った訴訟の件数、並びに、それら訴訟における判断の内訳（均等論を認める判決の件数、均等論を認めない判決の件数、それ以外）を教えてください。

### (2) 訴訟以外の手段

[57] 知的財産権者は、権利侵害を発見した場合、CIPITCへ提訴する以外に、タイ警察の経済犯罪調査部（ECID; Economic Crime Investigation Division）や、商務省知的財産局（DIP; Department of Intellectual Property）の知的財産権侵害抑止調整センター（Centre for Coordination of Deterrence Against Intellectual Property Violation）に対して告発するというルートがありますが、これらはどのように使い分けるのがいいのでしょうか？それぞれのメリット・デメリットを教えてください。

### (3) 仲裁

[58] 知的財産侵害事件について知的財産局（Department of Intellectual Property）の仲裁による解決が利用されるケースは年間何件ぐらいあるか、ご存知であれば教えてください。

[59] 仲裁による解決の場合のメリット、デメリットを教えてください。

[60] 特許権侵害事件についても仲裁による解決が利用されるケースもあるか、ご存知であ

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れば教えてください。

(4) 先使用权

[61] 貴所において、証拠保全の作業を実施した経験はありますか？

[62] 先使用权を立証する証拠について、公証制度はありますか？

[63] 特許法第 36 条の特許権者の専有権の例外の(2)について、適用事例はありますか？また、この条文では製法の善意利用が規定されていますが、物の発明について同様の規定がありますか？あるいは、同様に解釈された事例はありますか？

(5) その他

[64] 特許権侵害の訴訟を行う上で日本企業が注意すべき点等があれば教えてください。

[65] タイ企業の特許に関する活用事例やその考え方を教えてください。特に、タイ企業で特許を積極的に活用している企業があれば、教えてください。

**4. 小特許 (Petty Patents)**

[66] タイ自国民による出願について、小特許が多いように思います。小特許は発明特許よりも登録要件が少なく、実体審査を受けることなく登録されるという特徴があります。その他に、小特許のメリット・デメリットがあれば、教えてください。

**5. ライセンス**

[67] 貴所において、ライセンス契約の作成や相談を受ける件数は年間何件くらいでしょうか？

[68] 特許法第 41 条には、ライセンス契約等の政府登録義務が規定されています。貴所で取扱ったライセンス契約のうち、特許法第 41 条に基づき政府登録を行った割合は、どのくらいでしょうか？その割合の傾向において、近年変化がありましたか？

[69] ライセンス契約を登録しなかった場合、特許権者にはどのような不利益が生じますか？ライセンス契約の政府登録義務をさらに強化し、登録違反には刑罰を設ける動きがあると聞いています。現状と今後について教えてください。

[70] 特許法第 45 条、47 条等には、特許庁長官がロイヤリティを定める旨の規定があります。特許庁長官がロイヤリティを定めた事例をご存知であれば、教えてください。(4) 特許法第 46 条について、特許法第 45 条のライセンス許諾準備の登録有無で差がありますか？

**6. その他**

(1) 職務発明制度

[71] 特許法第 12 条には、報酬の請求を長官にすることが規定されています。長官への報酬の請求に関する事例をご存じであれば、その内容（認められた対価の額、算定の考え方等）について教えてください。

[72] 特許法第 12 条の手続きを起ささないため、或いは起きた場合の報酬金の高額化を回避するため、企業としてどのような社内規定を設けるべきか教えてください。また社内規定以外にも留意点があれば教えてください。社内規定として、1 件毎に定額で良いのか、実施規模に応じて報酬金の額も変える必要があるのか御教示下さい。

[73] 発明者への報酬額について、ガイドラインはありますか？

(2) 特許法改正

[74] タイ知的財産法に関する改正や条約への加入の動きがあれば、その内容及び進捗に関して教えてください。

(3) 代理人資格

[75] 訴訟代理人となる「弁護士」、特許出願等の代理人となる「特許弁理士 (Registered Patent Agent)」になるには技術的背景（理工学系の博士号が必須等）は、必要でしょうか？

(4) その他

[76] 企業から受ける知的財産に関する相談内容で多いのはどのような内容でしょうか？

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日系企業とその他の国の企業で違う点があれば教えてください。

以上

## **1. Office Overview**

- [1] Could you tell us the following staff information in your firm?
- Total number of the staff
  - Each number of *qualified* people (i.e. total number of *attorneys at law*, number of *attorneys at law in charge of intellectual properties*, *patent technicians*) and the number of support staff except for the above people
  - Each number of technical staff related to invention patents, petty patents, design patents, trademarks and copyrights
  - Each number of your staffs who handle mechanical engineering, telecommunication, chemistry and bio-technology
  - The number of Japanese staff or Japanese usable staff (if exists)
  - The number of Ex-examiners, ex-examiners at appeal board and ex-judges (if exists)
- [2] As for the business of your firm, could you inform us of the following items and how amount Japanese companies account for in each item(%)? Could you also inform us of technical fields related to invention patent for which your firm handles most frequently and/or in which your firm has the strongest skills?
- The work ratio of IP applications and IP litigations
  - Each proportion of invention patents, petty patents, design patents and trademarks in total IP applications in your firm
  - Each proportion of invention patents, petty patents, design patents, trademarks and copyrights in total IP litigations in your firm
- [3] As for the business of your firm, could you inform us of the number of applications in the 2014 fiscal year?
- Patents (from domestic companies)
  - Patents (from foreign companies)
  - Petty patents (from domestic companies)
  - Petty patents (from foreign companies)
  - Design patents (from domestic companies)
  - Design patents (from foreign companies)
  - Trademarks (from domestic companies)
  - Trademarks (from foreign companies)
- [4] Could you inform us of the numbers of oppositions (Article 31, etc. of the Patent Law), appeals (Article 72, etc. of the Patent Law), and revocation litigations (Article 54, etc. of the Patent Law) with regard to patents handled by your firm since 2000?
- [5] Could you inform us of the number of infringement litigations handled by your firm since 2000 with regard to following area?
- Patents
  - Petty patents
  - Design patents
  - Trademarks
  - Copyrights

- [6] Could you inform us of the strength of your firm as compared to the other firm?

## **2. Patents Prosecution**

### **(1) Regarding examination system**

- [7] Delay in the examination of patent applications in Thailand is sometimes problematic. Could you inform us of effective means, if any, which applicants can take in order to accelerate the examination?
- [8] Could you inform us of statistic data regarding the number of PPH and ASPEC? Please also inform us of the time period from requesting PPH or ASPEC to patent registration.
- [9] Do you think there is any case that examination for normal cases not requesting PPH are postponed because of a lot of PPH applications and further delay is occurring?
- [10] Could you inform us of any effective means for applicants which allows applications to be published earlier?
- [11] Regarding Article 27 of the Patent Law, when should we submit the foreign examination results? If we have examination results for a plurality of corresponding foreign applications, should we submit them for all of these countries?
- [12] We understand that a patent applicant can use systems of "priority examination" and "accelerated examination". Could you inform us of the following issues concerning "priority examination" and "accelerated examination".
- a) In order to request a priority examination, the fact of infringement is supposed to be proved. Specifically, what materials should we collect in order to allow the priority examination smoothly?
  - b) In order to request an accelerated examination, results of foreign examination and its Thai translations thereof need to be submitted. Of which country should we submit the results of examination? Are the results of substantive examination for *any* country sufficient? In addition, are the documents to be submitted sufficient only for the final examination results? Do documents relating to prosecution history (search report, notice of reasons for rejection, response documents, etc.) and the Thai translations also need to be submitted? Could you inform us of guidelines on the documents to be submitted, if any?
  - c) In the case of a national entry to Thailand from a PCT international phase, if we have obtained search results affirming (positive) patentability in the preliminary search report of the international phase, can you request an accelerated examination on the basis of this search report?
- [13] Could you inform us of any effective methods for getting the right earlier except for the "priority examination" or "accelerated examination" (for example, setting an interview after we have submitted foreign examination results)?
- [14] Could you inform us as to how the interview can be used in the examination? Could you inform us of any merits of the interview and points to be noted when an applicant or Japanese companies use it.

- [15] Are there any difference in the speed of the examination among technical fields (i.e. IPC)?
- (2) Subject of protection by the invention patents and petty patents
- [16] According to Article 9 of the Patent Law, novel microorganisms screened from the soil and extracts from plants and animals are not patentable. Why microorganisms screened from the soil and extracts from plants and animals are not protected? Are "Foods and drinks which contain microorganisms or extracts" protected? Could you inform us of any method for reciting claims effective for protecting microorganisms or extracts?
- [17] Could you inform us of recent operation in software (computer program) inventions or software-related inventions with regard to patentability issue or inventive step?
- [18] Can an application be rejected for the reason that the application does not have novelty over prior application(s) which is/are not published at the time of the filing of the application? In such a case, does the judgment differ whether the applicant is the same or not as the prior application(s)?
- (3) Criteria on the inventive step
- [19] According to the Supreme Court of Thailand, the term "person skilled in the art" refers to the "person skilled in the art in Thailand", and that this criterion is applied regardless of the inventor's birthplace. Is this understanding right? Please give us a brief outline of the Supreme Court decision on the above view of "person skilled in the art".
- [20] If you know the other cases in which judgment on the inventive step was at issue in the litigation, could you inform us of its contents.
- [21] As for the so-called "secondary consideration" in the United States, we have heard that it is effective for allowing the inventive step to be admitted in Thailand as well. How much explanation is necessary for allowing the inventive step in an examination or litigation?
- (4) Divisional application
- [22] We have heard that the Examiner can notify a demand for divisional application only during the substantial examination after the request for examination has been made. Until when the applicant can request a divisional application? Does the operation allow to file a divisional application even after the patent is granted as far as the registration fee is not yet paid? Please give us examples or any general notification from the Patent Office.
- [23] Article 26 of the Patent Law provides that, if the application does not satisfy a unity, the application shall be demanded to divide into a plurality of applications. If examiner regards that a divisional application does not also satisfy a unity even after the division is made, is it possible to file a further divisional application? When such a division is made, is there any possible limit?
- (5) Opposition
- [24] Could you inform us of the approximate cost of the opposition (Article 31) (please break down the cost into the Official cost and the attorney fees).
- [25] Could you inform us of each percentage of reasons to be contested in the opposition (reasons: novelty, inventive step, industrial applicability,

- misappropriated application, employee's invention etc.) relative to the total cases of the opposition?
- [26] The Patent Law (Article 34) provides that the misappropriated application (applied by not a real inventor) can be regained by the opposition but by what procedure can a misappropriated application be regained if the opposition period has elapsed?
- [27] Could you teach us about the difference in the respective costs and about the difference in the probability of blocking the grant of patent between oppositions and provision of information?
- [28] Could you inform us of the timing and period in which a voluntary amendment can be made prior to the registration?
- [29] Can the patent holder amend the claims after the registration? If possible, is there any limitation (for example, only removal of claims or only narrowing amendment)?
- (6) Translation
- [30] Is translation of the application documents to Thai conducted by your firm staff? If your firm staff will conduct translation, how much technical skills do such staff have? Could you inform us, for example, whether they have a degree from technical university/college, or whether they have a work experience in technical companies?
- [31] Could you inform us of any measures for preventing mistranslations by your firm?
- [32] Could you inform us of any measures which Japanese applicants can take in order to prevent mistranslations?
- (7) Deadline management/database
- [33] Because the timing when an application is published in Thailand is not constant, the management of examination deadline seems to be difficult. How does your firm watch or check such timing of patent applications?
- [34] When a divisional application is published after the division is carried out? Please teach us about the examination deadline for the divisional application.
- [35] We have heard that the granted claims for a third party cannot be checked unless you go to the DIP and browse the file wrapper. Is this understanding correct? Besides, is it possible for the third party to know whether a specific application has been granted or not (i.e. to know the current status of the application)?
- [36] Is there any effective search database for Thailand patents other than the search on the DIP website?
- [37] Is there any database in which we can browse judicial precedents related to IP?
- [38] The opposition period is limited to three months after the application is published. Therefore, it is required to catch the fact rapidly that a third-party application is published and also to know its contents. In addition, we suppose that the needs to know the final result of examination easily, i.e., whether the application has been registered or not, will increase as the number of intellectual property litigations increases in Thailand. Can the third party know these matters in any simple way?

[39] Is there any plan which enables the file wrapper to be browsed and the patent ledger to be confirmed by online? In addition, is there any plan of services which enables electronic filing by online?

(8) Others

[40] Could you inform us of any matters to keep in mind for the Japanese companies to file a patent application in Thailand?

[41] If your firm has any request or proposal to Japanese companies, we'll be glad to let us know.

### **3. Enforcement**

(1) Patent litigation

[42] Which number is bigger as for the amount of the counterfeited goods in Thailand, with regard to the domestic production or the influx from foreign countries?

[43] Generally, to file a lawsuit, companies will need to collect evidences of infringement. Upon collecting these evidences, what kind of material will be effective?

[44] Could you inform us of the infringement investigation system of your firm (for example, your firm holds an in-house investigation department, or your firm is in cooperation with an external investigation company)?

[45] It is necessary to prove that the infringement act has been conducted "willfully" in order to pursue criminal responsibility for the infringer(s) of the intellectual property rights, but what evidences do we need to collect specifically?

[46] Is a notary required for evidences of the infringement, or strongly recommended?

[47] For the following two cases, how does your firm obtain the infringing goods? Does your firm make use of an investigation companies usually?

Case 1: If the suspected infringing goods are sold to customers directly in a market

Case 2: If the suspected infringing goods are not sold to customers in a market but only traded between companies

[48] Generally, how long does it take from filing litigation to decision from court? With regard to a period length for trial, is there any difference among patents, petty patents, designs, and trademarks?

[49] We have heard that there is an increasing trend of the cases in which invention patents and petty patents are involved in recent years. Could you inform us of any trends of cases in which invention patents and petty patents are involved? Besides, could you inform us of the overview of the case handled by your firm? (countries of the patent holder, court, technical fields, infringement facts and specific action thereagainst, etc.)

[50] Could you inform us of any points to be noted in the enforcements of patent rights? Besides, if you know a case(s) in which the IP right holder bore a responsibility due to the enforcements based on an invalid patents, could you inform us of such case(s). Is it different between the responsibility of invention patent holder, petty patent holder and design patent holder larger due to the enforcements based on an invalid right? In the trials of patent infringement cases, is it possible for the defendant to claim that the patent right is invalid regardless that it is a civil case or a

- criminal case? In such a case, does the judge decide whether the patent is valid or invalid in the trial?
- [51] We'd like to know how amount any former judicial decision affects latter decision.
- [52] We'd like to know any trends of litigation cases and remarkable example(s) in which invention patents are involved.
- [53] Could you inform us of an amount of the assumed expenses (for example, travel expenses and accommodation expenses and per diem of raid investigator(s), disposal costs of seized goods, etc.) needed for enforcing the IP rights against the infringer?
- [54] Could you inform us on what matters the court judges the doctrine of equivalents? Could you also inform us of any priority order according to which the court puts greater value among them?
- [55] If there is any case which would be helpful for understanding the above criteria among the lawsuits related to the doctrine of equivalents, could you inform us of its contents?
- [56] Could you inform us of the number of lawsuits which were contested with respect to the doctrine of equivalents, as well as the breakdown of the judgments in those litigations (number of judgments which admitted the doctrine of equivalents, the number of judgments which did not admit the doctrine of equivalents, and others)?
- (2) Non-litigation means
- [57] An IP right holder can raise a litigation to the CIPITC, and besides right holder has a route of raising an accusation to the Economic Crime Investigation Division (ECID) of the Thai police or to the Centre for Coordination of Deterrence Against Intellectual Property Violation of DIP. Could you inform us of any respective advantages and disadvantages?
- (3) Arbitration
- [58] If you know the number of cases in which arbitration by DIP is utilized per year, could you inform us of the approximate number?
- [59] Could you inform us of any advantages and disadvantages in the case of a resolution by arbitration?
- [60] If you know whether the resolution by arbitration is used for patent infringement cases, could you inform us of that?
- (4) Right of prior use
- [61] Has your firm experienced the work of preservation of evidence?
- [62] Do you have a notary system for evidences to prove the right of prior use?
- [63] Is there any case in which exception (2) of Article 36 of the Patent Law which provides exception of the exclusive right of the patent holder was applied? Good faith use of the production process is provided in this article. Is there a similar provision for the invention of a product? Or, is there any case in which it is similarly interpreted for the invention of a product?
- (5) Others
- [64] Could you inform us of any points for which Japanese companies should be careful in conducting a litigation relating to patent infringement?
- [65] Could you inform us of cases in which patents are utilized by Thai companies?

#### **4. Petty Patents**

- [66] Many applications by Thailand applicants seem to be petty patents. Petty patents have a feature that they are registered without substantive examination. Could you inform us of any advantages and disadvantages of petty patents in addition to this?

#### **5. License**

- [67] How many cases per year does your firm drafts and/or is your firm asked for advices on License Agreement?
- [68] Article 41 of the Patent Law provides an obligation that the license agreement should be registered to the government. Concerning the license agreements handled by your firm, how much proportion was government registered according to Article 41? Is there any change in the trend in recent years?
- [69] If the license agreement is not registered, what disadvantage is caused to the patent holder? We have heard that there is a movement of further strengthening the obligation of government registration of the license agreement and providing a punishment for the violation of the registration. Could you inform us of the present and future situations?
- [70] Article 45 or the like of the Patent Law provides that the Commissioner of DIP shall determine the royalties. If you know the case the Commissioner determined the royalties, could you inform us of that?

#### **6. Others**

(1) Employee's invention

- [71] If you know the case related Article 12 of the Patent Law, could you inform us of its contents? (the amount of the admitted compensation, how it is calculated, etc.)
- [72] In order not to cause the proceedings under Article 12 of the Patent Law, or in order to avoid the expensive compensation in the case of such proceedings being caused, could you inform us what internal regulations a company should make? Could you also inform us of any points to be noted other than the internal regulations? Please also teach us whether it can be a straight-line basis for every case or the amount of compensation need to change depending on the implementation scale as internal regulations?

- [73] Are there any guidelines for the reward money to the inventor?

(2) Patent Law amendment

- [74] If there is a movement for amending the Thai intellectual property laws and/or Treaty accession, could you also inform us of its content and progress?

(3) Attorney qualification

- [75] Is technical background necessary (for example, doctorate of science or engineering is required) for being a "lawyer at law" who works as a counsel in litigations or a "Registered Patents Agent" who works as an agent for filing a patent application?

(4) Others

- [76] What contents are your firm frequently asked of by companies with regard to IP-related issues?

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End of Document

**Domnern Somgiat & Boonma Law Office Ltd.**  
Answers to JIPA Questionnaire 2015

**1. Office Overview**

[1] The total number of staff members

We have 135 members in total. There are 6 partners, 5 of whom are attorneys at law. In total we have 17 attorneys at law. There are 8 in-house technicians and one in-house design specialist. We also have 46 outside technical experts specialized in various fields of science and technology including electrical engineering, chemical engineering, mechanical engineering, chemistry, biotechnology and pharmacy who work for us exclusively.

In-house, there are 2 members who handle chemistry work, 1 who handles pharmacology work, 1 who handles electronic work, 2 who handle biotechnology work, 1 who handles toxicology work, 1 who handles pharmaceutical science work, 1 who handles biochemistry and 1 who handles electrical engineering work.

We have no Japanese staff members or members who can speak Japanese.

We have 3 former patent examiners working in-house.

[2] We handle most frequently patent applications in the fields of chemistry, pharmacy, mechanical engineering and electrical engineering.

The work ratio of IP prosecution work and IP litigation work is 90% to 10%.

On average, we handle approximately 2,300 patent applications, 30 petty patent applications, 450 design patent applications and 4,000 trademark applications per year.

The proportions of IP prosecution work are 33.92% patent, 0.44% petty patent, 6.64% design patent and 59% trademark.

The proportions of IP litigation work are 95% trademark, 5% copyright and 5% patent.

[3] In 2014, we filed:

- 1 patent application for domestic companies
- 2,322 patent applications for foreign companies
- 3 petty patent applications for domestic companies
- 24 petty patent applications for foreign companies
- 0 design patent application for domestic companies
- 460 design patent applications for foreign companies
- 51 trademark applications for domestic companies
- 4,660 trademark applications for foreign companies

[4] On average, we have filed 5-10 patent opposition/appeal/revocation cases per year since 2000.

[5] Since 2000, we have handled 2,314 IP enforcement cases, 292 of which have been litigation cases, 15 of which have been patent litigation cases and 5 of which have been copyright litigation cases.

[6] We are a large boutique IP firm. We have teams of experienced IP practitioners and proper division of work in areas of specialization and interest of our members. From time to time, we have joint discussions among partners, attorneys at law, paralegals and supporting staff members. Our members are qualified and well-trained. They are also looked after well so that they are capable, enthusiastic and energetic to work. We regularly sponsor our members from all departments in attending local and international seminars, conferences, workshops and training courses. We are highly computerized and constantly update and protect our computer systems. We are also in the initial phase of working in a paperless environment as we have been developing a paperless system for working and storing our work files for quick and safe use of information.

## **2. Patents Prosecution**

### **(1) Regarding examination system**

[7] There is no official provision concerning accelerating examination in Thailand. However, as the Examiners cannot perform examination on their own and always follow examination result of other corresponding patents, submission of such result and conforming the claims to such patent may help speed up examination of Thai case.

Moreover, there is the PPH program between Thailand and Japan. However, such program will end on December 31, 2015.

[8] Official statistic is presently not available. For our office, there have been about 50 applications filing the PPH request and about 15 applications filing the ASPEC request. It could take about 6-12 months or even more after requesting examination under such program before an official action is received.

[9] We think so too. From our experience, the examination under PPH request is faster than the normal examination while a number of the examiners remains the same. However, it also depends on the workload of each particular Examiner.

[10] Although there is no fixed period within which an application is published, it is possible to submit a formal letter to the Director of the Patent Office requesting the examiners to expedite examination followed by telephone contacts from time to time.

[11] Although there is 90 day due date for submission of the examination reports under Section 27 of the Thai Patents Act, the Thai Patent Office does not fully enforce this due date. In practice, all documents can be submitted at the time of filing a request for substantive examination or after that. It is not necessary to disclose the examination results of every foreign counterpart applications to the Thai Patent Office. Selecting one from those of the examining countries e.g. EP, US, UK or AU would serve the purpose. Presently, it is recommended to submit PCT search report when received. This can ensure that Section 27 had been fulfilled.

[12] There is no “priority examination” or “accelerated examination” system in Thailand.

a) It is possible to submit a formal letter to the Thai Patent Office asking the Examiner to expedite consideration of the application. No evidence is required to support the letter. However, it depends on the workload of each Examiner.

b) The documents required to support examination are a copy of the selected foreign patent, office actions and search report issued therein. Amending the claims to conform to those of said patent would help expedition of the Thai application. Regarding the Thai translation, under the Thai Ministerial Regulations, it is necessary to translate all the documents submitted into Thai. However, we have made an agreement with the Thai Patent Office that only the allowed claims and relevant portions of the selected patent as well as the office actions will be translated. Most of the examiners prefer basing the examination on the patent granted in an examining country e.g. EP, US, UK or AU.

c) Submission of “positive” search and examination report suppose to help speed up the procedure of the application. However, in practice as the Thai Examiners cannot perform substantive examination on their own and are reluctant to make a decision and to grant a patent based on mere search report, consequently, during substantive examination, they would request submission of copy of the corresponding patent, office actions and search report issued therein to base examination on. Most of them prefer basing the examination on the patent granted in and examining country e.g. EP, US, UK or AU.

[13] Although there is no provision concerning acceleration of examination proceedings in Thailand, periodical request, officially or informally, such as telephone conversation with the Examiner in charge could be of help. Setting an interview with the Examiner would depend on each particular Examiner’s requirement.

[14] It is possible to have an interview with the Examiner. However, the Thai Examiners will not initiate actual examination until a copy of the examination report issued in the corresponding application has been submitted. This is because the Thai Examiners cannot perform examination on their own and

always rely on the result of corresponding application in other countries which perform examination as to novelty and inventive step.

[15] The patent applications directed to pharmaceutical would take more time than the patent applications in other technical fields because of the sensitivity of drug patent issue in Thailand.

## (2) Subject of protection by the invention patents and petty patent

[16] It is clearly prescribed that naturally occurring microorganism and their components, animals, plants or extracts from animals or plants are not patentable under Section 9(1) of the Thai Patents Act. The ground of their unpatentability is also provided in the present Patent Examination Manual that any inventions without human intervention on their essential feature or those derived from a discovery are not patentable. Microorganisms screened from the soil, plant and animal extract are deemed to be naturally occurring. Purification or isolation method does not cause physical or chemical change to said naturally occurring microorganisms, plant and animal extracts and hence their unpatentability.

It should be noted that plant cell and animal cell are also not patentable although it is genetically modified. The Thai Patent Office has treated the patentability of plant or animal cell in the same manner as the patentability of plant and animals. Plant cell and animal cell are considered as progenitor which can be developed into mature plant and animal respectively like their seed or embryo. However, modified genetic materials such as DNA, RNA or protein as well as method for producing those materials or method for producing the modified plant or animal might be patentable.

As to the claims directed to food and drinks which contain microorganisms or extracts, they are allowable provided that there is a recitation of at least one of other ingredients other than microorganisms or extracts in the claims. The claimed food and drinks which contain only microorganisms or extracts alone are not allowed.

Method for obtaining microorganisms or extract or method for producing food and drinks contain microorganisms or extract is patentable. For example:

“Method for producing food containing microorganism X comprising steps of.....step a)...step b).... and step c)”.

Claims directed to microorganisms screened from the soil, plant or animal extract are not allowable but the Thai Patent Office allowed claims directed to use of said microorganism, plant or animal extract. For example:

“Use of microorganism/extract X for manufacture of a food composition/medicament/etc. for preventing/reducing a condition Y”.

Claims directed to a composition comprising microorganisms screened from the soil, plant or animal extract are allowable. For example:

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“A composition/food/drink X comprising microorganism/extract X and pharmaceutically acceptable carrier”

Please note that the above claim formats are the claims which do not contrary to Section 9(1) of the Thai Patents Act which bars naturally existing microorganism and their components, animals, plants or animal and plant extracts. Novelty and inventive step of the claims are still required.

[17] The computer program per se is not patentable under the provision of Section 9(3) of the Thai Patents Act. According to present practice, software invention is not patentable. However, the software-related invention and computer readable storage medium is allowable, provided that the subject matter of the invention is new and involves an inventive step. According to the Thai Patent Examination Guideline, claimed invention is patentable if it is not implemented in a general-purpose computer, or provides a new and non-obvious “technical solution” to a “technical problem”.

[18] Under the Thai Examiner Manual, if the prior application is not published at the time of the filing of the application, the examiner cannot use that prior art for rejecting the application. However, pursuant to Section 6(4) of the Thai Patents Act, if the application has been filed in a foreign country more than **18 months** prior to the date of filing of the Thai application, even if it has not been published at the time of filing the Thai application, it could be deemed a prior art and can be used as a basis for novelty rejection.

### (3) Criteria on the inventive step

[19] To be discussed in the meeting.

[20] To be discussed in the meeting.

[21] To be discussed in the meeting.

### (4) Divisional application

[22] It is not possible to file a divisional application voluntarily. It can be filed only in response to an office action ordering same. We therefore normally suggest that copy of all the foreign patent(s) the applicant wishes to amend the claims to conform to should be submitted for the Examiner’s consideration who will decide whether or not divisional application is required. If so, he will order the applicant to file division application. Moreover, amendment may be made only before grant. If the Examiner allows the application, it is no longer possible to file an amendment/divisional application.

[23] The Examiner will decide how many divisional applications(s) is required. The applicant can appeal to the Director-General if he does not agree with said decision.

### (5) Opposition

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[24] The approximate costs for opposition against an application in Thailand are as follows (excluding 7% value added tax):

Professional Services fee:		
Opposition	YEN	60,000
Expenses:		
including: Translation of English document into Thai including typing (if any)	YEN	2000 per 100 words
Photostat, transportation etc.		
Disbursements:		
Official fee:	BAHT	1,000

[25] There are a small number of opposition filed in Thailand. The reasons of the oppositions mostly are on lack of novelty and inventive step.

[26] The misappropriated application (applied by not a real inventor) can be regained under Sec 34 of the Thai Patents Act only by filing an opposition under Sec 31 of the Thai Patents Act. However, the interested party can file a complaint to the IP Court to cancel the invalid patent under Sec 54 of the Thai Patents Act after the opposition period has lapsed but the patent right will not be regained.

[27] The cost and efficiency of Opposition is relatively higher than those of the voluntary provision of information (so called "third-party observation"). The Examiner in charge may or may not take the information provided by the third party into account when assessing novelty and inventive step of a patent application. Therefore, we would normally recommend filing an opposition in time rather than submission of state of the art to the Patent Office.

[28] The voluntary amendment can be filed any time before the registration of patent provided that no new subject matter is added to the invention originally filled.

[29] The patent holder cannot amend claims after the patent has been granted. However, the patent holder may surrender any claim or claims, according to the Section 53 of the Thai Patents Act i.e. the whole claim(s) will have to be cancelled.

#### (6) Translation

[30] Translation of the patent specification to be filed is carried out by our technical assistants who are skilled in the relevant art and proficient in English and Thai, and who mostly have a doctor of science degree in the relevant field.

[31] Firstly, we review the translated application and adjust the patent terminology before filing. Secondly, upon making amendment to conform to the corresponding foreign patents, we review the translation again especially the claims. Thirdly, upon receiving official actions requiring amendments, we review

the translation again. Finally, upon receiving the notice of allowance, we review the translation once again in every details to assure the accuracy of the issued patent. This is because the Thai patent cannot be amended after grant. These aforesaid are supported by our team of technical assistants in the relevant fields. We routinely perform the above steps of review as the quality of translation is of utmost importance.

[32] Please be advised that we can accept either your English translation of Japanese patent applications We do not suggest computer-assisted translation. In case you provide us with the English translation, you may wish to suggest the translator to translate the application in consistent manner. For example, it is translated as “pipe” in the English translation of original Japanese application but later it is translated as “tube” in the English translation of the granted claims of Japanese translation. Even though some English words are interchangeable, we highly recommend using same English word throughout the specification and throughout prosecutions where the English translation of some documents or an argument is required. In addition, you may wish to suggest the translator to translate the Japanese technical term based on the definition or description provided in the disclosure of the invention rather based on a Japanese-English dictionary. This is because each invention although in the same art does describe the definition of the term disclosed therein in different ways.

#### (7) Deadline management/database

[33] Our firm is provided with self-developed customized computer software and dedicated staffs to maintain docketing of important dates.

Regarding management of time limit for filing a request for substantive examination, although there is no fixed period within which an application is published, we usually inform our clients the due date for filing a request for substantive examination at the time when we report the publication of patent application in Thailand.

Normally, we will send a reminder letter 3-6 months before the due date for requesting substantive examination and will automatically file a request for same to keep the application alive unless we hear from the clients to the contrary.

[34] The divisional application will be prosecuted though all normal steps as a new application. There is no fixed period within which the divisional application is published. It could take from 2 to 4 years or even more depending on the Examiner in charge of the case. The applicant must file a request of substantive examination within five years after the publication date of the new divisional application.

[35] Your understanding is correct. The granted claims of a patent are not published in the DIP website. One has to go to the DIP and check the granted claims from the files. However, the status of a patent application (granted,

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pending, abandoned, lapse) is shown in the DIP website and is supposed to be updated on a monthly basis but it is not presently very reliable.

[36] We have created our own database for Thai published patent applications using information derived from the Thai official patent Gazette which is published every month. We do not trust DIP website.

[37] You can browse Thai juridical precedents related to IP free of charge from the Thai Central IP and International Trade Court's website (<http://www.ipitc.coj.go.th>). However, it is published in Thai language only and not all the cases are published.

[38] Unfortunately, there is no other way but to manually browse the file-wrapper at the DIP.

[39] Under the current policies and laws, we do not think that the file-wrapper can be browsed nor the patent ledger can be confirmed online. However, starting this year, the Thai Patent Office is currently conducting a pilot project for filing patent application electronically (called E-Filing) in which every documents will be submitted online. However, we do not know if official documents will be included and open-to-public.

#### (8) Others

[40] and [41] Please see our answer No. [32].

### **3. Enforcement**

#### **(1) Patent Litigation**

[42] Influx from foreign countries is bigger.

[43] Yes, it is necessary to collect evidence of infringement. The materials that need to be collect depend on each case and have to be advised on a case-by-case basis.

[44] We have in-house investigators who can conduct basic investigation work such as finding the location of a suspected infringer, conducting counterfeit goods market surveys and conducting counterfeit sample purchases. Our investigators do not have the capability of carrying out deep investigation work such as planting themselves in a factory suspected of making counterfeit goods. We normally sub-contract that type of work to a professional investigation firm at our client's instructions.

[45] Yes, it is. The evidence that needs to be collected is the one that clearly shows that infringement has taken place.

[46] Some evidence will have to be notarized and consularized. For example, an affidavit from the trademark owner needs to be so.

[47] Case 1: We send our in-house investigator to buy the infringing product from a store that sells it. Case 2: We have our investigator visit the selling company posing as a representative of another company (a potential customer) and ask to purchase a sample to show to that other company's board of directors.

[48] It can take 18-36 months in the IP & IT Court (a court of first instance) and 24-48 months in the Supreme Court (the court of last resort).

[49] There are important invention patent litigation cases handled by us of which final court decisions became available just earlier this year. Please see the case summaries below.

### **CASE SUMMARIES**

#### **(A) Civil Case Red No. Tor.Por.58/2552 (IP & IT Court)**

*Agarwood Siam Co., Ltd., Plaintiff, vs. Touchwood Forestry Co., Ltd. and its directors, Defendants*

On 10 July 2007 Agarwood Siam filed a civil lawsuit with the IP & IT Court (a court of first instance) against Touchwood Forestry and its directors claiming that the defendants infringed the plaintiff's Thai Patent No. 18985, which was a patent on a process to induce agarwood in aquilaria trees, by using the process patented by the plaintiff and making, selling, possessing for sale and offering for sale agarwood that the defendants obtained from using the process. The plaintiff sought an injunction against the alleged infringement and also damages in the

amount of THB 134,000,000. The IP & IT Court found that the process used by the defendants was different from the plaintiff's process and dismissed the case. On 22 May 2009 the plaintiff appealed the IP & IT Court decision to the Supreme Court (the court of last resort) and the Supreme Court affirmed the decision of the lower court. The Supreme Court decision (No. 14948/2557) was announced in June 2015. The decision is final.

**(B) Civil Case Red No. Tor.Por.82/2552 (IP & IT Court)**

*Touchwood Forestry Co., Ltd., Plaintiff, vs. Agarwood Siam Co., Ltd., First Defendant, the Department of Intellectual Property, Second Defendant, and the Director-General of the Department of Intellectual Property, Third Defendant*

On 5 October 2007 Touchwood Forestry filed a patent invalidation lawsuit with the IP & IT Court against Agarwood Siam, the Department of Intellectual Property (DIP) and the DIP's Director-General as a counter-attack against Agarwood Siam's attack on Touchwood Forestry. In this lawsuit, Touchwood Forestry sought an invalidation of Agarwood's Patent No. 18985, claiming that the agarwood-induction process covered by the patent lacked an inventive step and that there were irregularities (within the DIP) involved in the examination of Agarwood Siam's patent application and the granting of Patent No. 18985 to Agarwood Siam. On 9 July 2010 the IP & IT Court gave a decision invalidating the patent, saying that it was convinced by Touchwood Forestry's evidence that Agarwood Siam's process lacked an inventive step and that there really were irregularities involved in the examination of the patent application and the granting of the patent. The defendants appealed the IP & IT Court decision to the Supreme Court and the Supreme Court affirmed the decision of the lower court. The Supreme Court decision (No. 18329/2557) was announced in September 2015. The decision is final.

[50] In a civil case, the defendant can challenge the validity of the plaintiff's patent by filing a counter-suit in the existing case to try to invalidate the patent. In a criminal case, the defendant can also challenge the validity of the injured party's patent but he will have to file a separate patent invalidation case against the injured party (in the form of a civil lawsuit).

[51] In Thailand, decisions of the Supreme Court are normally followed in latter cases. Although Supreme Court decisions are not law, they have persuasive authority.

[52] Please see Answer No. 49.

[53] The expenses vary, depending on various factors in each case.

[54] In case a patentee files a patent infringement lawsuit against an alleged infringer on the basis that the patentee's claims extend protection to the characteristic of his invention which, although not specifically stated in the claims, in the view of a person of ordinary skill in the art or science concerned with the invention, have properties, utility and effect similar to those stated in the claims,

the courts have the authority to consider whether this use of the doctrine of equivalents is justified. For example, in a pharmaceutical patent dispute, the precursor used by the alleged infringer may not be the same as that specified in the patentee's claims but can be used equivalently.

[55] There is one patent infringement lawsuit which we handled in 2008 in which the doctrine of equivalents was involved. In that case, our client, a European pharmaceutical company, after obtaining a Thai patent for a process for manufacturing a pharmaceutical product for the treatment of certain types of cancer, found that a local Thai company imported a product of the same type from an Indian pharmaceutical company to sell in Thailand. After determining that the Indian company must have used the patented manufacturing process in manufacturing its product, our client demanded that the importer stop importing and selling the product in Thailand but to no avail. Our client then filed a patent infringement lawsuit against the importer in the IP & IT Court. Although the importer argued that there was no infringement because there were some differences in the process used by our client and the process used by the Indian manufacturer. According to the importer, in making its product, the Indian manufacturer did not use the same solvent as our client's solvent and that the Indian manufacturer used a precipitation method as a step in the manufacturing as opposed to our client's crystallization method. Our client raised the doctrine of equivalents to counter the argument. The IP & IT Court decided in our client's favor, ordering the Thai importer to stop importing and selling the infringing product. The Thai importer appealed the decision to the Supreme Court. Unfortunately, the Supreme Court reversed the decision, saying that the evidence showed that the Indian manufacturer did not use our client's process or an equivalent process but it relied on another process which it had patented in the United States, which was different from our client's process. The decision was final.

[56] We do not have the statistics. So far there has been only one case which we handled ourselves.

## (2) Non-litigation Means

[57] The ECID can only handle criminal cases and prefers to handle cases which are not too complicated. For example, straight-forward, simple trademark counterfeiting, copyright infringement or design patent infringement cases are suitable for handling by the ECID. Therefore, if you have a complicated patent infringement case, we do not recommend that you entrust it to the ECID.

The DSI can handle more complicated cases but the cases will have to be very high-profiled. For example, they must involve large quantities of infringing goods. (Nevertheless, the cases must still be criminal cases only.)

The DIP's IP enforcement center does not have the authority to arrest infringers. It must always work in conjunction with the police or the DSI.

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(3) Arbitration

[58] We do not have the information.

[59] The advantage is that it can save costs and time. There are no disadvantages.

[60] We do not have the information.

(4) Right of prior use

[61] Although we have not experienced the work of preservation of evidence of prior use, we are of the opinion that the evidence proved by a notary public can be used for establishing a right of prior use. However, Thai courts also require that the evidence be legalized by a Thai consulate in the country which it was obtained.

[62] No, we do not.

[63] Since the Thai Patents Act came into force in 1979, no case relating to rights of prior use under Section 36(2) has been decided by the Supreme Court. Thus, there is no precedent for this. There are no other similar sections in the Act that provide for the use of a process in good faith.

(5) Others

[64] Thai courts do not treat Japanese companies different from companies of other nationalities.

[65] To be discussed in the meeting.

#### **4. Petty Patents**

[66] The petty patent is suitable for protecting an easy-to-made invention or invention having small improvement over the prior art and/or short-life cycle or fast-changing technology. The advantage is it issues faster than normal patent. The drawback of the petty patent is that it is not strong as there is no substantive examination. The request for examination is not mandatory and can be filed by any interested party including the applicant within one year after registration.

#### **5. License**

[67] We handle a few license contracts annually.

[68] About 90% of license contracts handled by our office have been registered with the Thai Patent Office.

[69] A patent license agreement must be registered with the Thai Patent Office under Section 41 of the Patents Act. Absent registration, the agreement would become void under the Civil and Commercial Code and it follows that working of the licensed patent by the licensee would not be recognized as working by the patentee himself. Consequently, the patent under license may be subject to compulsory licensing and cancellation eventually.

Under the newly proposed amendments of the Thai Patents Act, a license agreement must be recorded with the DIP within 90 days from the date of the agreement. The current requirements of registration of a license agreement will be changed. The details of the new requirements of recordation of the license agreement are being discussed among the officials of DIP.

[70] To our knowledge, there has been no case which the Director-General set a royalty in accordance with Sections 45 and 41. The guideline for setting a royalty is provided in the Ministerial Regulation No. 26, clause 9 issued in 1999.

## **6. Others**

### **(1) Employee's invention**

[71] As far as we know, there is no court case related to Article 12 of the Thai Patents Act.

[72] Companies should have internal regulations relevant to compensation for employee invention in order to avoid such conflict. This regulation should, for example, define the meaning of employee invention, provide sufficient amount of monetary reward to the inventor, and include a means for resolving any conflict arise therefrom.

[73] Please be advised that there is no official guideline. However, there is a general criteria stipulated in the Ministerial Regulations No. 24 (1999) regarding the inventor remuneration. For your information, in one Research Institute in Thailand, an amount of Baht 5,000 is paid to the inventor for each patent application filed. The monetary reward of Baht 30,000 is paid to the inventor whose patent application is granted. If the invention is utilized or licensed, the inventor would be paid in the amount of 30-70% of the income generated from utilization of the invention.

### **(2) Patent Law amendment**

[74] The newly proposed amendments of the Thai Patents Act are being discussed among the officials of the DIP.

### **(3) Attorney qualification**

[75] A qualified patent agent must be registered with the DIP. According to the DIP's Notification, to qualify as a patent agent, he/she must have a bachelor degree in any field, attended a training course arranged by the DIP or

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completed a course on intellectual property laws arranged by an institution or any other agency, which course having been approved by the DIP.

An attorney at law can also be a patent agent if he/she has the qualifications specified by the DIP's Notification. A patent agent having no law degree cannot be an attorney-at-law. To qualify as the attorney-at-law, he/she must also have completed a training course and passed an examination held by the Law Society of Thailand. Only a lawyer can handle litigation but, as far as patent infringement is concerned, a lawyer should work closely with a patent agent having the pertinent technical background.

There is no statutory distinction between a patent agent and a patent attorney. They both have the same roles and tasks in prosecution of patent applications. It is understood that a patent attorney is one who possesses a law degree and is admitted to the bar whereas a patent agent does not and is not.

#### Others

[76] Apart from regular prosecution and litigation on IP rights, we also provide consultation on general practices of IP rights in Thailand, infringement analysis and remedy, overseas filing in the region (such as Vietnam, Cambodia), remuneration system for employee inventors and sometimes licensing agreement.