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**BACKGROUND READING MATERIAL  
ON THE  
INTELLECTUAL PROPERTY SYSTEM  
OF  
THAILAND**



**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

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## PREFACE

The World Intellectual Property Organization (WIPO) is a specialized agency within the United Nations system of organizations. It is responsible for the promotion and protection of intellectual property throughout the world.

WIPO is cooperating with the developing countries of Asia and the Pacific in a comprehensive program of activities to facilitate the establishment and strengthening of intellectual property systems in the region. One of the components of this development cooperation program is the preparation and publication of guides, manuals and other training and information aids in the field of intellectual property.

In 1988 WIPO issued, under a development cooperation project funded by the United Nations Development Programme (UNDP) for countries of Asia and the Pacific, a publication entitled *Background Reading Material on Intellectual Property*. The publication consisted of a collection of reading materials on various aspects of intellectual property law, administration and practice and was prepared as a reference work for university students, government officials, lawyers and businessmen.

To complement that basic reference work, WIPO has commissioned a number of leading intellectual property scholars in the Asian and Pacific region, each to write a commentary on the intellectual property laws of his country as a "national supplement" to the *Background Reading Material on Intellectual Property*.

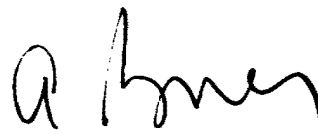
The author of the present book, entitled *Background Reading Material on the Intellectual Property System of Thailand*, is Dr. Dhajjai Subhapholsiri, Professor of Law, the Graduate School, Chulalongkorn University, Bangkok, who is an eminent author of a number of important writings on the substance and the teaching of Thai intellectual property law.

While primarily intended for law students, this book may also be of use as a reference work to government officials, attorneys and businessmen concerned with intellectual property law or its administration in Thailand.

Following a prefatory survey of the intellectual property system in Thailand, the topics addressed in this book are: patents; utility models; trademarks; copyright and neighboring rights; administration of intellectual property; the patent and trademark agent; and intellectual property litigation. Reproduced as annexes are the texts of the Patents Act B.E. 2522 (1979) as amended by the Patents Act (No. 2) B.E. 2535 (1992), the Trademarks Act B.E. 2534 (1991) and the Copyright Act B.E. 2521 (1978). The Trademarks Act, as recently revised, provides for protection of service marks in Thailand with effect from February 13, 1992.

WIPO wishes to record its deep appreciation to Professor Dhajjai for his contribution which should significantly increase understanding of the working of the intellectual property system of Thailand.

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Arpad Bogsch  
Director General

World Intellectual Property Organization

Geneva, April 1993

## TABLE OF CONTENTS

Preface .....	III
<b>1. The System of Intellectual Property .....</b>	<b>1</b>
1.1 The Concept of Intellectual Property .....	3
1.2 Copyright .....	3
1.3 Trademarks and Trade Names .....	4
1.3.1 Trademarks .....	4
1.3.2 Trade Names .....	5
1.4 Patents and Related Concepts .....	5
<b>2. Patents .....</b>	<b>11</b>
2.1 Introduction .....	13
2.2 Patentable Subject Matter .....	14
2.2.1 Inventions .....	14
2.2.2 Product Designs .....	15
2.3 Conditions of Patentability .....	16
2.3.1 Introduction .....	16
2.3.2 Novelty .....	16
2.3.3 Inventive Step .....	16
2.3.4 Industrial Applicability .....	17
2.3.5 Conditions of Patentability for a Design .....	17
2.4 Patent Application .....	17
2.4.1 Applicant for Patent .....	18
2.4.2 Contents of a Patent Application .....	19
2.5 Procedures for Grant of Patents .....	21
2.5.1 The Filing of the Application .....	21
2.5.2 Procedure for the Grant of a Patent .....	21
2.6 Scope of Exclusive Rights .....	23
2.6.1 Introduction .....	23
2.6.2 Exploitation of Patent Rights .....	23
2.7 Infringement .....	24
2.7.1 The Act of Infringement .....	24
2.7.2 Legal Sanctions .....	24
2.8 Contributory Infringement .....	25
2.9 Duration of Protection .....	25
2.10 Assignment and Licensing .....	26
2.10.1 Assignment .....	26
2.10.2 Licensing .....	26
2.11 Compulsory Licensing .....	28
2.11.1 Insufficient Working of a Patent .....	28
2.11.2 Interdependent Patents .....	29
2.11.3 Public Interest .....	29
2.12 Revocation of Patents .....	30
2.12.1 Invalidity of the Patent .....	30
2.12.2 Insufficient Working of the Patent .....	30
2.13 Surrender of Patents or Claims .....	30
2.14 Utility Models .....	31

<b>3. Trademarks</b> .....	<b>37</b>
3.1 Introduction .....	39
3.2 Scope of Trademark Law .....	39
3.2.1 Signs Which May Serve as Trademarks .....	40
3.2.2 Products on Which Trademarks Are Used .....	40
3.2.3 Service Marks, Certification Marks and Collective Marks .....	40
3.3 Policy Considerations in Trademark Law .....	40
3.3.1 Interests of Traders and Consumers .....	41
3.3.2 Trademarks and Economic Development .....	41
3.4 Criteria of Protectability .....	42
3.4.1 Requirement of Distinctiveness .....	42
3.4.2 Requirement of Absence of Misleading Character and of Absence of Violation of Public Order or Morality .....	44
3.5 Acquisition of Trademark Rights .....	45
3.6 Use Requirement .....	45
3.6.1 Introduction .....	45
3.6.2 Meaning of Use .....	46
3.6.3 Removal for Non-Use .....	47
3.6.4 Deceptive or Confusing Use .....	47
3.7 Conflicts With Prior Rights .....	48
3.8 Registration Procedures .....	48
3.8.1 Introduction .....	48
3.8.2 Application for Registration .....	49
3.8.3 Examination as to Form .....	49
3.8.4 Examination as to Substance .....	49
3.8.5 Advertisement .....	50
3.8.6 Opposition .....	50
3.8.7 Certificate of Registration .....	51
3.9 Duration of Protection .....	51
3.10 Renewal .....	51
3.11 Termination .....	51
3.12 Scope of Protection .....	53
3.12.1 Territorial .....	53
3.12.2 Temporal .....	53
3.12.3 Protected Acts .....	53
3.12.4 Legal Protection .....	54
3.12.5 Exceptions to the Scope of Trademark Protection .....	56
3.13 Parallel Importation .....	56
3.14 Counterfeiting .....	57
3.14.1 Introduction .....	57
3.14.2 Remedies and Enforcement .....	57
3.15 Transfer of Trademarks .....	58
3.16 Licensing .....	58
<b>4. Copyright and Neighboring Rights</b> .....	<b>65</b>
4.1 Introduction .....	67
4.2 Copyright Protection .....	68
4.3 Subject Matter of Copyright Protection .....	68

VI

4.4	Rights Comprised in Copyright .....	71
4.4.1	Reproduction Right .....	71
4.4.2	Adaptation Right .....	72
4.4.3	Publication Right .....	72
4.4.4	Moral Right .....	72
4.5	Neighboring Rights .....	73
4.6	Ownership of Copyright .....	74
4.7	Limitations on Copyright Protection .....	78
4.7.1	Temporal .....	78
4.7.2	Geographic .....	80
4.7.3	Permitted Use .....	80
4.8	Infringement .....	83
4.9	Remedies .....	85
4.9.1	Civil Action .....	85
4.9.2	Injunction .....	86
4.9.3	Criminal Action .....	86
4.10	Protection of Foreign Work .....	88
<b>5.</b>	<b>Administration of Intellectual Property .....</b>	<b>95</b>
5.1	Administrative Structure in the Industrial Property Offices .....	97
5.2	Patent Office .....	97
5.3	Trademark Office .....	98
<b>6.</b>	<b>The Patent and Trademark Agent .....</b>	<b>105</b>
6.1	Introduction .....	107
6.2	The Patent Agent—Functions .....	108
6.2.1	Introduction .....	108
6.2.2	The Pre-Application Phase .....	108
6.2.3	The Application Phase .....	109
6.2.4	Publication of the Application .....	109
6.2.5	Deferred Examination .....	109
6.2.6	Opposition .....	109
6.2.7	Substantive Examination .....	110
6.2.8	Role During the Life of the Patent .....	110
6.2.9	Applications for Foreign Clients .....	111
6.2.10	Foreign Applications for Domestic Clients .....	111
6.3	The Trademark Agent—Functions .....	111
6.3.1	Introduction .....	111
6.3.2	Selection of a Trademark .....	111
6.3.3	Application for Domestic Registration .....	112
6.3.4	Applications Registered Abroad by Domestic Trademark Owners ..	112
6.3.5	Licensing .....	113
6.3.6	Maintenance of Trademarks After Registration .....	113
<b>7.</b>	<b>Intellectual Property Litigation .....</b>	<b>119</b>
7.1	Introduction .....	121
7.2	Review of Industrial Property Office Decisions .....	121
7.2.1	Pre-Grant Appeals .....	121
7.2.2	Post-Grant Appeals .....	122
7.2.3	Appeal Procedures .....	123

7.3	Infringement Actions .....	123
7.3.1	Trademark Infringement and Passing-Off .....	123
7.3.2	Copyright Infringement .....	124
7.3.3	Patent Infringement .....	124
7.3.4	Evidence .....	124
7.4	Remedies .....	125
7.4.1	Interlocutory Injunction .....	125
7.4.2	Final Injunction .....	125
7.4.3	Damages .....	125

**ANNEXES**

Annex I	Patents Act B.E. 2522 (1979) as amended by Patents Act (No. 2) B.E. 2535 (1992) .....	131
Annex II	Trademarks Act B.E. 2534 (1991) .....	177
Annex III	Copyright Act., B.E. 2521 (1978) .....	211

## **CHAPTER 1**

### **THE SYSTEM OF INTELLECTUAL PROPERTY**

#### **SYNOPSIS**

**1.1 The Concept of Intellectual Property**

**1.2 Copyright**

**1.3 Trademarks and Trade Names**

**1.3.1 Trademarks**

**1.3.2 Trade Names**

**1.4 Patents and Related Concepts**



### 1.1 The Concept of Intellectual Property

The Thai legal system has long ago adopted the concept of intellectual property rights. The kinds of intellectual property rights recognized by the legal system are copyright, the trademark right and the patent right. They are recognized as property because the term "property," according to the Civil and Commercial Code, includes things as well as incorporeal subjects, susceptible of having a value and of being appropriated. The copyright, trademark right and patent right are established by the Copyright Act B.E. 2521 (1978), the Trademarks Act B.E. 2534 (1991) and the Patents Act B.E. 2522 (1979) as amended by the Patents Act B.E. 2535 (1992), respectively. The next topics will give an overview of these intellectual property rights. The details of each right will be discussed in the following chapters.

The intellectual property right is distinct from other conventional rights—*jus in personam* or the personal right, which entitles a person to demand another person to perform the obligation or to refrain from doing something pursuant to their contractual relationship or to a non-contractual relationship, e.g., tort, undue enrichment, etc., and *jus in rem* or the real right, which is the right of a person over a material thing—movable or immovable. Differently, the intellectual property right is the right to exclude other persons from exercising the same privileges which the law confers exclusively on the proprietor of such right. It is not the positive right to dispose of a tangible object as the so-called *jus in rem* but indeed the negative right to preclude others from using his particular rights.

The personal right or *jus in personam* is doctrinally not a property because it cannot be invoked against any person except the contracting party or the related party in a delict. On the contrary, *jus in rem* is a property because the proprietor of the right can invoke it against the whole world. Intellectual property is similar to the real right or *jus in rem* in this manner. In general, the owner of an intellectual property right can claim it against any infringer subject to some limitations, e.g., territorial enforcement.

It should be noted that the intellectual property right is independent of the real right, particularly ownership. The artist who creates a portrait holds the copyright in the work as well as the ownership in the tangible material. He may sell the portrait to another person but still retains the copyright with him unless the assignment of copyright is made together with the transfer of ownership. This doctrine applies equally to the author and the inventor.

In a broad sense, intellectual property may be understood to include other subjects which are the products of the human brain, e.g., trade names, trade secrets, etc. In a narrower legal sense, however, those subjects other than copyright, trademark rights and patent rights are not property even though they are regarded as legally enforceable. The major indicator of the non-property nature is that there is no law which grants the exclusive rights to the proprietor of such right. The owner of those rights, nonetheless, is protected by the law on torts if the unlawful act of another person causes actual injury to him.

### 1.2 Copyright

Copyright is currently governed by the Copyright Act B.E. 2521 (1978). The law grants the exclusive rights in relation to the work to the copyright owner. The Act provides that only the copyright owner has the basic rights of reproduction, adaptation and publication. It is actually the negative right to preclude other persons from exercising the rights which the law confers exclusively on the copyright owner.

The subject matter of copyright is specified by the Act, and includes the traditional works such as literary work, dramatic work, artistic work and musical work and more recent types of work, namely, cinematographic work, audiovisual work and sound and video broadcasting work. Pursuant to the Act, the work means a creative work in the

form of literary, dramatic, artistic, musical, audiovisual, cinematographic, sound and video broadcasting work, or any other work in the literary, scientific or artistic domain.

The copyright subsists when the work is created without the requirement of registration or any other formality. There is no condition of quality or novelty in the copyrightability.

In general, the term of protection lasts the life of the author and for 50 years after his death. However, the general term is subject to several exceptions prescribed by the Act. When the term of protection comes to an end, the work falls into the public domain. From that time, anyone can use the work without any authorization.

Infringement of copyright takes place if a person other than the copyright owner performs—without authorization—any of the following acts: reproduction, adaptation or publication without a license. In addition, there are some other acts which constitute infringement against some specific works. According to the Act, infringement is subject to both civil and criminal action. It is of interest that the Act stipulates several exceptions to infringement of copyright so as to balance the interests of the copyright owner and society.

The protection of foreign copyright is available under the Copyright Act as Thailand is a member of the Berne Union. In 1931, Thailand acceded to the Berlin Act of 1908 with some reservations and, in 1980, acceded to the Paris Act of 1971, but only for the administrative clauses. The Act lays down the principle that a copyright work, by virtue of the law of a Contracting State to the Berne Convention, shall enjoy protection under the Act. The protection, of course, is based on the principle of national treatment or assimilation.

### **1.3 Trademarks and Trade Names**

#### **1.3.1 Trademarks**

The trademark right is specifically recognized by the Trademarks Act B.E. 2534 (1991). The owner of a registered trademark is given the exclusive right to use his trademark with the registered goods. The Act also endorses the right of the owner of an unregistered trademark under the doctrine of passing-off.

The Trademarks Act is mostly concerned with the registration of trademarks. There are a number of provisions with respect to the characteristics of a registrable trademark, registration procedures, opposition and appeals. In addition, it lays down rules for the cancellation or revocation of a registered trademark.

The term of protection for a registered trademark is 10 years. The registration can be renewed for another 10-year term consecutively.

Infringement of a trademark right emerges when a person uses a registered trademark with registered goods without the trademark owner's permission. The owner of the registered trademark can bring a civil action against the infringer. Moreover, if the infringing act constitutes the willful forgery or imitation of a registered trademark, the trademark owner can also take criminal action in accordance with the Penal Code. The owner of a non-registered trademark can institute a passing-off action against the unauthorized user of his trademark. Likewise, the use of an unregistered trademark may become another criminal offense under the Penal Code.

Since Thailand is not a member of any international agreement on the registration of trademarks, the owner of a foreign trademark has to file an application for registration in Thailand. The present law does not accept the registration in another country to be effective in Thailand or even the priority date of registration. Nevertheless, the registration abroad may help facilitate the registration in Thailand, particularly regarding the establishment of distinctiveness of the trademark and, probably, the better right to register it.

The present Trademarks Act 1991, which supersedes the Trademarks Act 1931, includes service marks, certification marks and collective marks which were not recognized by the former Act. The registration of these related marks and their legal protection are very similar to conventional trademarks as the provisions of the trade-mark apply *mutatis mutandis*.

### 1.3.2 Trade Names

The right in a trade name is recognized by law even though it is not doctrinally regarded as intellectual property. The legal recognition is supported by a provision in the Civil and Commercial Code, which indeed protects the right of a natural person to use his own name. The law (Section 18) reads:

“If the right to the use of a name by a person entitled to it is disputed by another person, or if the interest of the person entitled to the name is injured by the fact that another person uses the same name without authority, the person entitled to the name may demand from the other person abatement of the injury. If a continuance of the injury is to be apprehended, he may apply for an injunction.”

However, the court has applied this law to the business name by analogy, for example, Supreme Court Decisions Nos. 949/2525, 321/2526, 3151/2524, 1346/2522.

In addition, the unauthorized use of a trade name may constitute a wrongful act which is governed by the law of torts, e.g., Supreme Court Decisions Nos. 1068/2524, 3070/2522, 64/2521. The injured natural person or juristic entity can seek legal remedies available in the law.

## 1.4 Patents and Related Concepts

The Patents Act B.E. 2522 (1979), which is amended by the Patents Act (No. 2) B.E. 2535, adopts two types of patents, i.e., patents for invention and design patents. The invention may be either in the form of a product or a process. The invention or the design must be registered in compliance with the Act in order to obtain legal protection.

To qualify for a patent, the invention must be new, non-obvious and capable of industrial application. Similarly, a design must be new and capable of industrial application and may include handicrafts.

Since the due registration triggers the patent protection, the Act elaborates the registration procedures ranging from the application to the grant of a patent. Under some circumstances, the applicant not only communicates with the registration authority but also appeals to the Board of Patents or the court.

The patent grants the exclusive rights to the patentee to manufacture the product or apply the patented process, sell or have in his possession for sale the patented products or the products manufactured by the application of the patented process. The exercise of such exclusive rights, however, is subject to some specified exceptions.

Any unauthorized act by a person which is tantamount to the exercise of the exclusive rights by the patentee constitutes an infringement unless the Act makes it an exception to the infringement. The infringement will empower the patentee to initiate legal proceedings—both civil and criminal.

As regards the duration of protection, patents for invention grant 15 years' protection, while design patents give a seven-year term of protection to the patentee. The term cannot be extended. The expiry of the term will release the invention or the design to the public domain. From that time, no one can claim the exclusive right in the invention or the design and everyone is equally free to make use of it.

The patentee may exploit the patent himself or voluntarily grant a license to another person. However, if he does not grant a license without legitimate reasons, the Act provides for a non-voluntary license, which means that a license will be available even without the patentee's consent. The so-called "compulsory license" is possible in any of the following situations—insufficient domestic working of a patent, interdependence of patents and public interest.

A patent which has been granted is subject to revocation. A patent may be revoked if it is later detected that its grant was not in compliance with the law. Besides, the law is very careful of unreasonable monopolization of a patent. After a patent is granted, it may be revoked on the ground that there is insufficient working of it.

Thailand is not a member of the Paris Convention for the Protection of Industrial Property or of any other multilateral or bilateral agreements on patent protection. A foreign inventor has to apply for a patent in Thailand in order to acquire legal protection. The Act does not accept the priority date of an application for the same invention that has been previously filed in another country. If the application has been filed abroad, the applicant must apply for a Thai patent within the following 12 months, otherwise its contents are considered state of the art.<sup>1</sup> Only a foreigner who is a national of a country which permits Thai nationals to apply for patents in that country can file a patent application.<sup>2</sup>

At present, there is no law which grants protection for utility models. Thai law is different from contemporary laws of some other civil law countries, e.g., Germany, Japan, etc., on this point. Moreover, the concept of granting an inventor's certificate as adopted in some socialist countries is not endorsed by Thai law.

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<sup>1</sup> Patents Act, Section 6, second paragraph, (4).

<sup>2</sup> Section 14.

## **CHAPTER 2**

### **PATENTS**

#### **SYNOPSIS**

- 2.1 Introduction**
- 2.2 Patentable Subject Matter**
  - 2.2.1 Inventions**
  - 2.2.2 Product Designs**
- 2.3 Conditions of Patentability**
  - 2.3.1 Introduction**
  - 2.3.2 Novelty**
  - 2.3.3 Inventive Step**
  - 2.3.4 Industrial Applicability**
  - 2.3.5 Conditions of Patentability for a Design**
- 2.4 Patent Application**
  - 2.4.1 Applicant for Patent**
  - 2.4.2 Contents of a Patent Application**
- 2.5 Procedures for Grant of Patents**
  - 2.5.1 The Filing of the Application**
  - 2.5.2 Procedure for the Grant of a Patent**
- 2.6 Scope of Exclusive Rights**
  - 2.6.1 Introduction**
  - 2.6.2 Exploitation of Patent Rights**
- 2.7 Infringement**
  - 2.7.1 The Act of Infringement**
  - 2.7.2 Legal Sanctions**
- 2.8 Contributory Infringement**
- 2.9 Duration of Protection**
- 2.10 Assignment and Licensing**
  - 2.10.1 Assignment**
  - 2.10.2 Licensing**

**2.11 Compulsory Licensing****2.11.1 Insufficient Working of a Patent****2.11.2 Interdependent Patents****2.11.3 Public Interest****2.12 Revocation of Patents****2.12.1 Invalidity of the Patent****2.12.2 Insufficient Working of the Patent****2.13 Surrender of Patents or Claims****2.14 Utility Models**

## 2.1 Introduction

There was a long-lasting attempt to enact the patent law in Thailand before it was finally passed in 1979. It is believed that the first draft of the patent law was made during the same period as the draft of the trademark law. There was a draft patent law entitled "Law on Patents," which was dated July 7, 1913. In comparison with the enactments at that time, the draft patent law, which consisted of 36 sections, was much more detailed than others. In 1925, another draft patent law was finished but nothing further was done with it. After that, there was a continuing attempt to draft the patent law along with the preparatory structuring of the patent system and the administration. In February 1965, the Government proposed the draft Patent Bill to the National Assembly. The Bill was strongly opposed by a number of the members of the Assembly on the ground that the patent law would be an obstacle to domestic industrial development. Besides, some members were uncertain about the readiness of the system's administration. Finally, the Government withdrew the Bill for reconsideration.

It was in 1978 that the Ministry of Commerce submitted the draft patent law to the Cabinet for approval, which then proposed the Bill to Parliament. The Legislature passed the law in February 1979. The Patents Act had been in force since September 12, 1979, before it was substantially amended in 1992.

The reasons for the enactment of the Patents Act 1979 as shown in the statute itself were twofold. The first reason was to promote the research and development of new inventions and designs which are useful to domestic agriculture, industry and commerce. The second reason aimed at the legal protection of inventors and designers by excluding others from copying or imitating their innovations.

The rationale of the amendment in 1992 is to improve the standard of patent protection so as to facilitate the expansion and development of the domestic economy, trade and industry and to promote research and development for the advancement of agriculture, industry and commerce.

The drafters of the amended Act took into account the generally accepted standard in various sources including the Paris Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the WIPO Model Law, the draft Patent Law Harmonization Treaty and the Draft Agreement on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods (TRIPS Agreement). A number of new provisions in the amended Act, therefore, are consistent with or similar to those in the above-mentioned references.

Prior to the enactment of the patent law, the patent right was not recognized by the legal system. There were a few cases that confirmed the non-protection in Thailand to patentees who had registered their patents in other jurisdictions. In those cases, the foreign patented subject matter was copied by local people. The court ruled that the copying was not a tort or infringement because the patent was not recognized by Thai law in the absence of the underlying legislation.<sup>1</sup> These cases clearly reflected the legal impact of the non-existence of the patent law.

At present, Thailand has not acceded to the Paris Convention or to any other international agreement concerning the protection of patents. However, the Thai Patents Act is, to a large extent, consistent with the criteria for protection specified in the Paris Convention. A Thai patent is granted for either an invention or a design. The former is called a patent for invention and the latter a design patent. The Thai law may be different from the laws of other countries which protect designs under the industrial design laws. The reasons for the inclusion of designs in the patent law are twofold. First, the law requires the novelty of the design, just as it does for the invention. Second, a design

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<sup>1</sup> Supreme Court Decisions Nos. 837/2507, 388/2509, 353/2510.

patent can be granted even though the design is not used for industry but for handicraft production. Now that both the invention and the design are subject matter of patents, it seems unavoidable to make alternating references to laws and procedures with respect to both types of patentable subject matter within each topic.

## 2.2 Patentable Subject Matter

In accordance with the Patents Act, the patentable subject matter is (1) inventions and (2) product designs. The inventions or designs must meet the required characteristics to be patentable.

### 2.2.1 Inventions

The Act defines "invention" as any innovation or invention which creates a new product or process, or any improvement of a known product or process.<sup>2</sup> A "process" means any process, art or method of producing, maintaining or improving the quality of a product, including the application of such process.<sup>3</sup>

There are two observations to be made with respect to the meaning of "invention":

(1) an invention which is protected by the patent law is an idea. It does not mean the object or the tangible products which are made out of the idea. It is the patentee who can exclusively use his idea or authorize others to use it. A buyer of a patented product can use the product but he cannot make the same product which has been patented;

(2) a creative idea which the patent law regards as an invention must be able to generate a new product or to preserve or to improve existing products. On the contrary, if the idea has nothing to do with production, preservation or improvement, it will not be considered an invention. For example, a scientific discovery as such is not an invention. But, if the discovery is applied to create a new product, the idea to create a product based on the discovery becomes an invention.<sup>4</sup>

### *Categories of inventions*

The Act refers to the outcome which results from the creative idea in three categories, namely, (1) products, (2) processes and (3) improvements of known products or processes.

(1) *Products*: the Act does not give a definition of "products." Thus, it is understood in accordance with the general understanding which means the tangible things of physical characters. The products may be classified as to the structure, elements, utilities, etc. The important classifications include: machine, apparatus, device, tool, article, chemical products.

(2) *Processes*: the Patents Act circumscribes processes to three categories:

(a) producing process, e.g., the process to produce wines, the process to melt metals, etc.;

(b) preserving or improving process, e.g., the process to preserve foods, etc.;

(c) application of a process, which means a new use of a known process.

(3) *Improvements of known products or processes*: this means a creative idea which appears in the correction, improvement or development of an existing process. Most of the inventions today are not pioneer inventions but are improvements of existing inventions.

<sup>2</sup> Patents Act, Section 3, second paragraph.

<sup>3</sup> *Ibid.*, third paragraph.

<sup>4</sup> Yanyong Puangraj, *Patent: Laws and Procedures*, Borpit Printing, Bangkok, 1990, p. 11.



The categorization of an invention to a product and a process not only indicates the difference of the output of the inventor's idea but also differentiates the protection given to either subject. The level of protection for the product is higher than that of the process. The patentee of a product has an exclusive right to make such product. Another person cannot make the same patented product even though he uses a different process. By contrast, the patentee of a process has an exclusive right in that patented process only and another person can make the same thing with another, different process.

### 2.2.2 *Product Designs*

A product design means any form or composition of lines or colors which gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft.<sup>5</sup> From the definition, a design is the formulation of a creative idea regarding the making of the external appearance of an object that is visually appealing. The difference between a design and an invention is that a design is a creative idea concerning the external ornamental aspects of a product, while an invention is a creative idea concerning the technical and functional aspects of a product which normally is not visually perceivable.

A design is an application of artistic ideas to create special features to an industrial product. A design usually increases the commercial value of a product. The essence is that the special features of a product must be used as the pattern of an industrial or handcrafted product.

#### *Non-patentable subject matter*

##### 1. *Invention*

Prior to the amendment in 1992, the Patents Act of 1979 provided that the following inventions or subject matter were not patentable:

- (1) food, beverages, pharmaceutical products or pharmaceutical ingredients;
- (2) machines directly used in agriculture;
- (3) animal or plant or biological processes for the production of animals or plants;
- (4) scientific or mathematical rules or theories;
- (5) computer programs;
- (6) inventions which are contrary to public order or morality, public health or welfare;
- (7) inventions prescribed in a Royal Decree.

The revised Patents Act curtails the exclusionary list to provide that the following are not patentable:

- (1) microbes and any components thereof which exist naturally; animal, plant and extracted substances from animals or plants;
- (2) scientific or mathematical rules or theories;
- (3) computer programs;
- (4) methods of diagnosis, therapy or curing the diseases of human beings or animals;
- (5) inventions which are contrary to public order or morality, public health or welfare.

##### 2. *Design*

The Act stipulates that the following designs are unpatentable, namely, (1) designs that are contrary to public order or morality, and (2) designs which are prescribed by Royal Decree.<sup>6</sup>

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<sup>5</sup> Patents Act, Section 3, fourth paragraph.

<sup>6</sup> Section 58.

## 2.3 Conditions of Patentability

### 2.3.1 Introduction

The conditions of patentability for an invention and a design are different. This Section will discuss the conditions for the former first and subsequently present those for the latter.

As generally accepted worldwide, the Patents Act sets the criteria for patentability for an invention by providing that:

“Subject to Section 9, ... a patent may be granted only for an invention in respect of which the following conditions are satisfied:

- (1) the invention is new;
- (2) it involves an inventive step; and
- (3) it is capable of industrial application.”<sup>7</sup>

Since the Act contains an exclusionary list of unpatentable subject matter, this provision emphasizes that even though the inventions identified in the list may meet the conditions of patentability, a patent cannot be granted for those excluded inventions.

### 2.3.2 Novelty

The Act further elaborates the condition for a new invention as follows:

“An invention is new if it does not form part of the state of the art. The state of the art also includes one of the following inventions:

- (1) an invention which was widely known or used by others in the country before the date of the application for a patent;
- (2) an invention the subject matter of which was described in a document or printed publication, displayed or otherwise disclosed to the public, in this or a foreign country before the date of the application for a patent;
- (3) an invention which was patented in this or a foreign country before the date of application for a patent;
- (4) an invention for which a patent was applied in a foreign country more than 12 months before the date of the application for a patent and a patent has not been granted for such invention;
- (5) an invention for which a patent was applied in this country, but the applicant had abandoned such application; this provision shall not affect the rights of the joint inventor who did not jointly apply for a patent.

A disclosure which was due to, or made in consequence of, the subject matter having been obtained unlawfully, or a disclosure which was due to, or made in consequence of, the inventor displaying the invention at an international exhibition or an official exhibition shall not be deemed to be a disclosure under subsection (2), above, if such disclosure was made within 12 months before the filing of an application for a patent.”<sup>8</sup>

### 2.3.3 Inventive Step

In addition to novelty, a patentable invention must contain an inventive step. The Act clarifies the meaning of inventive step with this provision:

“An invention shall be taken to involve an inventive step if it is not obvious to a person ordinarily skilled in the art.”<sup>9</sup>

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<sup>7</sup> Section 5.

<sup>8</sup> Section 6.

<sup>9</sup> Section 7.

From the definition, for an invention to be patentable it must not be obvious to a person who has a basic skill in such area. Because of this standard, the term “inventive step” may be used interchangeably with the term “non-obviousness.” The patent law, which aims at the technical development of inventions, has no purpose to protect the mere idea of a craftsman’s skill without any inventiveness.

The inventive step is measured by the knowledge of a person ordinarily skilled in the art. Hence, the determinative question as to this issue is whether a person having ordinary skill in the pertinent art is able to make the same invention or not. If the answer is positive, the invention will be deemed to lack an inventive step. On the contrary, if the answer turns out to be negative, the invention will be considered as having an inventive step. It should be noted that the intent of the patent law is to stimulate not only distinguished researchers but also persons of average skill to create innovations so as to receive protection in exchange for the knowledge they contribute to society.

#### 2.3.4 *Industrial Applicability*

A principle of the patent system is that the invention must be able to be used in practice so that society can benefit from the innovation by using the process or the finished product either in industry or for personal use. Thus, industrial applicability is another indispensable condition of patentability. The Patents Act introduces this condition and elaborates the capability of industrial application thus:

“[a]n invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including handicraft, agriculture and commerce.”<sup>10</sup>

According to the definition, it should be noted that the law extends the area in which the invention can be used, apart from industry, to handicraft, agriculture and commerce. The extension partly acts as an incentive to inventors who can create some inventions which may not be suitable for manufacture on an industrial scale. In general, the standard of industrial applicability is fulfilled by the reproducibility and the practicability of the invention.

#### 2.3.5 *Conditions of Patentability for a Design*

A patent may be granted for a new design for industry, including handicraft.<sup>11</sup> The Act does not define the term “new design” but conversely identifies the designs which are not deemed to be new. The designs which, according to the law, are not new are:

- “(1) a design which has been widely known or used by others in this country before the filing of the application for a patent;
- (2) a design which was disclosed or described in a document or a printed publication in this or a foreign country before the filing of the application for a patent;
- (3) a design which has been published under Section 65 and Section 28 before the filing of the application for a patent;
- (4) any design so nearly resembling any of the designs prescribed in (1), (2) or (3) as to be an imitation.”<sup>12</sup>

## 2.4 **Patent Application**

Patent protection does not automatically subsist. A person who is entitled to apply for a patent must file an application and follow the required procedures. The patent authorities will consider whether the application for a patent for invention or a design

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<sup>10</sup> Section 8.

<sup>11</sup> Section 56.

<sup>12</sup> Section 57.

patent should be granted. The legal protection will be effective when the patent is granted to the applicant.

The amended Act adopts the principle of the right of priority as provided in the Paris Convention. If the application is filed in Thailand within 12 months after the first filing in another jurisdiction, the applicant shall be deemed to have filed the application on the same date as the first filing in a foreign country provided that the country of citizenship of the applicant gives the same right to a Thai national.<sup>13</sup>

#### 2.4.1 *Applicant for Patent*

A person who is entitled to apply for a patent may be any one of the following individuals or entities:

- (1) an inventor or a designer or his heir;
- (2) an employer, a commissioner, government units, a government organization or a State enterprise;
- (3) the assignee of a right to apply for a patent.

(1) *An inventor or a designer or his heir:* an inventor or a designer is the owner of an idea who works out that idea and reduces it to an invention or a design. Undoubtedly, he deserves the right to apply for a patent.<sup>14</sup>

If the invention or the design is jointly made by several persons, the inventors or the designers have to apply for a patent together unless some of them refuse to participate in the same application or cannot be reached or are not entitled to the application. In such case, the rest of the inventors or the designers can file the application in their own names. Those who have missed the application may join it any time before the grant of a patent.<sup>15</sup>

The right of an inventor or a designer to apply for a patent can devolve on his heirs by way of inheritance. The lawful heirs will obtain such right to proceed with the application in their own names.<sup>16</sup>

(2) *An employer, a commissioner, government units, a government organization or a State enterprise:* the right to apply for a patent for an invention or a design made in the execution of an employment contract or a contract for performing certain work shall belong to the employer or the commissioner of the work, unless otherwise provided in the contract.<sup>17</sup> This provision also applies where an employment contract has nothing to do with any inventive activity but the employee makes the invention by using any means, data or report to which he has access due to his employment.<sup>18</sup> In the foregoing cases, however, an employee is entitled to remuneration from his employer in addition to his regular salary or fee if the employer benefits from the invention or the design.<sup>19</sup> The right to remuneration cannot be barred by any contractual arrangement.<sup>20</sup>

In case the inventor or the designer is a government official or a staff member in a government organization or a State enterprise and he has an official duty to invent or design, the right to apply for a patent shall vest in the Government. Nonetheless, he is entitled to remuneration as an employee in the private sector is, unless otherwise provided by the rules of his organization.<sup>21</sup>

<sup>13</sup> Sections 19bis and 60bis.

<sup>14</sup> Sections 10, first paragraph, and 65.

<sup>15</sup> Sections 15 and 65.

<sup>16</sup> Sections 10, second paragraph, and 65.

<sup>17</sup> Sections 11, first paragraph, and 65.

<sup>18</sup> Sections 11, second paragraph, and 65.

<sup>19</sup> Sections 12, first paragraph, and 65.

<sup>20</sup> Sections 12, third paragraph, and 65.

<sup>21</sup> Sections 13 and 65.

(3) *The assignee of the right to apply for a patent*: since the right to apply for a patent is transferable, anyone who acquires such right can assign his right to another person.<sup>22</sup> The assignment must be made in writing with the signatures of both the assignor and the assignee, otherwise the transaction will be deemed void.<sup>23</sup>

Apart from having the status as mentioned above in each of the three groups of persons entitled to apply for a patent, the applicant must have Thai nationality or the nationality of a country which allows persons of Thai nationality to apply for patents in that country.<sup>24</sup>

#### 2.4.2 *Contents of a Patent Application*

The patent application is a document which expresses the intention of the applicant to receive legal protection for his invention or design. The applicant must disclose the details of his invention or design in compliance with the requirements of the law and he must identify as clearly as possible the scope of the invention or the design for which he is seeking protection.

According to the patent law, there are two kinds of patent applications. One is the application for a patent for invention and the other is an application for a design patent. The contents of these two applications are different from each other.

##### 2.4.2.1 *Application for a patent for invention*

(a) *Request*. The Patents Act provides that the application for a patent must be in compliance with the rules and procedures prescribed in the Ministerial Regulations.<sup>25</sup> At present, it is the Ministerial Regulations of 1979 which govern an application for a patent. The Act requires that the following particulars be shown in the application, namely, (1) the title of the invention, (2) a brief statement of its nature and purposes, (3) a detailed description of the invention in such full, concise, clear and exact terms as to enable any person ordinarily skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention and setting forth the best mode contemplated by the inventor for carrying out his invention, (4) one or more clear and concise claims, and (5) other items as prescribed by the Ministerial Regulations.<sup>26</sup>

Each application must be prepared for one invention or several inventions which are so linked as to form a single inventive concept.<sup>27</sup> The application must consist of the following parts: (1) application form and supplemental documents, (2) detailed description of the invention, (3) claims, (4) drawings (if any), and (5) abstract.

The applicant must use the official application form. If the applicant is the inventor, he has to submit a form certifying that he is the inventor and that he has never assigned the right to apply for a patent to another person. If the applicant is not the inventor, he has to submit evidence showing his right to apply for a patent, for example, an employment contract, a court order appointing the administrator of an estate or a contract of assignment of the right to apply for a patent. Moreover, if the applicant does not handle the application himself, he has to file a power of attorney appointing a patent agent to apply for the patent on his behalf.

(b) *Descriptions*. This is the part of the application in which the patent law requires that the applicant make available the invention to the public in exchange for legal protection. The purpose of the disclosure of the invention is to give the public access

<sup>22</sup> Sections 10, second paragraph, and 65.

<sup>23</sup> *Ibid.*

<sup>24</sup> Sections 14 and 65.

<sup>25</sup> Section 17.

<sup>26</sup> *Ibid.*

<sup>27</sup> Section 18.

to the knowledge so that it can learn of the invention and further develop it. Consequently, the detailed description must be complete and clear enough so that a person having average skills in related disciplines is able to work out the invention successfully from the disclosed information. The description is also required to specify the best mode of carrying out the invention which is known to the inventor. Moreover, the description must explain the prior art of the invention or any related discipline which facilitates a better understanding of the invention. The references to this information, if any, are also required. An application which does not contain a detailed description of the invention or an insufficient description will be rejected.

(c) *Claims.* This section represents the part or parts of the invention which the applicant wishes to reserve for his own exploitation and exclude others from using it or them without permission. The claims are closely related to the description of the invention. The scope of the invention which is specified in the claims must not go beyond the scope of the actual invention and the detailed descriptions disclosed in the application. Thus, an applicant who wants to establish claims in any invention must fully disclose the invention in the description. The law requires the claims to be made clear and concise, otherwise the application for a patent may be rejected.<sup>28</sup>

The amended Act expands the scope of claims to cover not only what is literally prescribed in the patent documentation but also the invention which is not specifically stated in the claims but which contains the same qualifications or utility and can bring about the same result. This amended provision is aimed at giving more protection to the patentee and at deterring inappropriate exploitation of his invention.<sup>29</sup>

(d) *Drawings.* This section helps the readers of patent documents to understand the descriptions of the invention better. The Regulation concerned makes it a requirement for an application to contain drawings which are necessary for a better understanding of the invention. Drawings are normally deemed necessary if the inventions are in the mechanical field or that of physics. An applicant who fails to submit the necessary drawings may be refused registration.<sup>30</sup> The drawings must be in conformity with the description of the invention. Moreover, they must comply with the Regulations concerned.

(e) *Abstract.* This part of the application facilitates a quick search and study of the invention. Each application must contain an abstract. If the applicant fails to submit the abstract, the application will be dismissed.<sup>31</sup> The abstract must summarize the essence of the invention as disclosed in the description, claims and drawings (if any). It must be presented in such a manner that it can contribute to a better understanding of the technical problems, the technical solutions and the application of the invention. The abstract must be clear and concise with a length not exceeding 200 words.

#### 2.4.2.2 *Application for a design patent*

(a) *Request.* The request, which must be made on the official form accompanied by relevant documents, functions as the expression of the intention of the applicant to receive legal protection and to confirm the status of the applicant.

(b) *Claims.* In this part, the applicant must specify the scope of the design which he wishes to have protected. As the nature of a design is not as complicated as that of an invention, the Regulation requires the applicant to identify only one single claim.

(c) *Pictures of the design.* This section presents the details of the design for which protection is being sought. Because of the visual representation of the design, the pictures

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<sup>28</sup> Section 17(4).

<sup>29</sup> Section 36*bis*.

<sup>30</sup> Section 17(5).

<sup>31</sup> Section 28(1).

of the design are the most important part of the application and must be submitted together with the application.<sup>32</sup>

(d) *Descriptions.* The descriptions are not required to be submitted with the application because the design is the external feature of a product which can be easily seen in the pictures. Nonetheless, an applicant who wants to give additional details of the design for a better understanding thereof may submit a description not exceeding 100 words.

The rules and regulations which govern patent applications, apart from the Patents Act the related provisions of which are cited herein, include a number of Ministerial Regulations and Announcements of the Department of Intellectual Property that are not specifically cited. The applicant must, of course, follow those Regulations in order to complete his application.

## 2.5 Procedures for Grant of Patents

The application for a patent and the grant of a patent are important matters which may have an impact upon the interested parties and the public. Therefore, the Patents Act lays down the procedures for the filing of a patent application and for the grant of a patent, brief details of which are given below.

### 2.5.1 *The Filing of the Application*

The applicant may either submit his application together with the application fee by hand to the Patent Division, Department of Intellectual Property, Ministry of Commerce or mail it to the same addressee.

### 2.5.2 *Procedure for the Grant of a Patent*

After the application is correctly filed, the following procedures, which will be handled by the officials and the applicant as well as other interested persons, will ensue.

#### 2.5.2.1 *Preliminary examination*

An official will examine whether the application is complete and whether the applicant has duly paid the application fee. The official can order the applicant to rectify any errors. The official will make the preliminary examination by examining whether each part of the application is correct, whether the invention is patentable and whether the applicant is entitled to apply for the patent.<sup>33</sup> If any defect is found, the official will order the applicant to correct the application within the specified time.

#### 2.5.2.2 *Publication of the application*

An application that passes the preliminary examination will be published by the Patent Division. At this stage, the applicant is required to send the printing blocks of drawings and to pay the publication fee.<sup>34</sup> The purposes of publication are twofold. First, it makes possible the opposition by another person against the application. Second, it helps make the public cognizant of the application so that it can supply relevant information which may be used for the grant of a patent.<sup>35</sup>

#### 2.5.2.3 *Opposition*

When the application has been published, any person who thinks that he has a better right to apply for the patent, or thinks that the invention or the design is not

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<sup>32</sup> Section 59(1).

<sup>33</sup> Section 24(1).

<sup>34</sup> Sections 28, second paragraph, and 65.

<sup>35</sup> Puangraj, *op. cit.*, p. 65.

patentable, or the applicant is not entitled to apply for the patent, may give notice of opposition to the competent official within 90 days from the date of publication.<sup>36</sup>

The said official will send a copy of such notice to the applicant. The applicant has to file a counterstatement within 90 days after receipt of such copy of notice. If the applicant fails to file such counterstatement within the said period, he shall be deemed to have abandoned his application.<sup>37</sup> The applicant or the opposer may introduce additional evidence to support his position.<sup>38</sup> The Director-General of the Department of Intellectual Property will consider the opposition and give a ruling. The applicant and the opposer will be informed of the ruling with the underlying reasons. The parties concerned may appeal to the Board of Patents against such ruling.

#### *2.5.2.4 Examination of the invention or the design*

The examination of the invention or the design will take place after publication of the application.

The examining steps with respect to an invention and a design are different. In the case of an invention, the official will carry out the examination only when the applicant has filed a request therefor within five years from the date of publication or within one year from the final ruling in case an opposition had been filed, depending on which period expires later.<sup>39</sup> For a design, the official will conduct the examination irrespective of a request from the applicant.<sup>40</sup>

In examining the invention or the design, the competent official will make a search of the Thai patent documents as well as the foreign patent documents which are kept at the Department of Intellectual Property. Moreover, the Director-General may, in order to facilitate the examination of a patent application, request any government department, unit or organization, any foreign or international patent office or organization, to examine the application. At present, the Department requests the Australian Patent Office and the European Patent Office to examine applications.<sup>41</sup>

#### *2.5.2.5 Registration and grant of patent*

When the examination has been concluded, the official will submit the examination report to the Director-General. If the Director-General sees no reason to refuse the grant of a patent and there is no opposition, or there is an opposition and he has ruled in favor of the applicant, the Director-General will order the registration of the invention or the design and the grant of a patent.<sup>42</sup> The applicant has to pay the patent fee within 60 days from the date of receipt of the notice from the competent official or he will be deemed to have abandoned the application. Within 15 days after the payment of the fee, the patent will be granted to the applicant.<sup>43</sup>

Where the Director-General considers that the invention or the design is not qualified for a patent, the application will be dismissed.<sup>44</sup>

#### *2.5.2.6 Appeal*

When the Director-General has made an order to register an invention or a design and to grant a patent, or to reject the application, or the authority has ruled that indeed

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<sup>36</sup> Patents Act, Sections 31, first paragraph, and 65.

<sup>37</sup> Sections 31, second paragraph, and 65.

<sup>38</sup> Sections 32, first paragraph, and 65.

<sup>39</sup> Section 29, first paragraph.

<sup>40</sup> Section 61, first paragraph.

<sup>41</sup> Section 25.

<sup>42</sup> Sections 33, second paragraph, and 65.

<sup>43</sup> Sections 33, third paragraph, and 65.

<sup>44</sup> *Ibid.*



the opposer, not the applicant, is entitled to apply for a patent, the interested party can appeal to the Board of Patents within 60 days from the date of receipt of the order or the ruling. If he fails to appeal within the said period, the order or ruling of the Director-General will be final.<sup>45</sup> If the appeal is duly made and the interested party is not satisfied with the decision of the Board, he can appeal the decision to the competent court within 60 days from the date of receipt of the decision. The decision of the Board will be deemed final if no appeal to the court is filed within the time.<sup>46</sup>

The Board of Patents is a committee appointed by the Cabinet. The Board is chaired by the Under-Secretary of State for Commerce and consists of 12 other members. The authorities and the duties of the Board are stipulated by the Patents Act.<sup>47</sup>

## 2.6 Scope of Exclusive Rights

### 2.6.1 Introduction

The provision with respect to the exclusive rights conferred by the patent for invention states that only the patentee shall have the right to manufacture the product or apply the patented process, sell or have in his possession for sale the patented product or the products manufactured by applying the patented process.<sup>48</sup> Similarly, a patentee of a design patent is granted the exclusive right to use the design in the manufacture of products, or sell or have in his possession the products which are manufactured with the patented design.<sup>49</sup> The exclusive rights are subject to some exceptions, which will be mentioned in the following topic.

Within the context of the patent law, the exclusive rights are elaborated as the rights of the patentee to seek benefits from his patented invention or design that exclude others from exploiting the invention or the design without his authorization. The significant legal effects of such exclusive rights are twofold: (1) patent infringement will occur if another person exercises each of the rights granted by law to the patentee without permission; and (2) the patentee is entitled to authorize others to use his invention or design.<sup>50</sup>

### 2.6.2 Exploitation of Patent Rights

#### (a) Invention

The exclusive rights of the patentee are:

(1) in case of a product patent, the right to manufacture, use, sell, possess for sale, offer for sale or import the patented products;

(2) in case of a process patent, the right to use the patented process, manufacture, use, sell, possess for sale, offer for sale or import the products which are manufactured by the patented process.

However, the exclusive rights are subject to the following exceptions:

- (1) any act for the purpose of education, study, experiment or research;
- (2) the manufacture of the patented product or the use of the patented process or the operation of business or the possession of equipment for such operation in good faith before the filing of the patent application within Thailand;
- (3) any act in relation to the patented product acquired in good faith;

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<sup>45</sup> Section 72, first paragraph.

<sup>46</sup> Section 74, first paragraph.

<sup>47</sup> Sections 66 to 71.

<sup>48</sup> Section 36.

<sup>49</sup> Section 63.

<sup>50</sup> Puangraj, *op. cit.*, p. 94.

(4) preparation of a medicine according to a physician's prescription by a licensed medical doctor or pharmacist;

(5) any act in relation to the registration of medicine provided the applicant wishes to manufacture, sell or import the patented pharmaceutical products after the expiry of the patent.

*(b) Design*

The patentee of a design has the exclusive rights to use the design, or to sell, or to have in his possession for sale a product using the design. The nature of these rights is similar to the rights of the patentee of an invention which have already been discussed. The exclusive rights in a patented design are subject to an exception, namely, the use of the design for the purpose of education or research.<sup>51</sup>

The 1979 Act used to allow the importation of patented products or products manufactured by a patented process by another person under some circumstances.<sup>52</sup> This was an exception to the exclusive rights of the patentee. The 1992 amended Act, however, abrogates this provision on the ground that there are sufficient preventive measures for dealing with abuse of a patent.

## 2.7 Infringement

### 2.7.1 *The Act of Infringement*

As mentioned in the foregoing topic, the Patents Act provides exclusive rights with respect to a patented invention or design. The exclusive rights are understood as the negative rights to exclude others from doing that which the patentee alone is authorized by law to do. The Act does not directly state that an unauthorized act by another person constitutes an infringement. Nonetheless, the Act considers some acts contrary to the exercise of the exclusive rights as criminal offenses. It is an offense if a person who has no rights under the Act uses a patented product or process or design.<sup>53</sup> Moreover, it is also an offense if a person sells or has in his possession for sale any product manufactured under a patented product or process or design knowing that such product was manufactured by a person having no rights in the patented product or process or design.<sup>54</sup> Because of the establishment of criminal acts and the grant of exclusive rights to the patentee, it can be concluded that infringement occurs if another person, without the patentee's authorization, performs the same acts which the law provides that only the patentee can do.

Subject to the exceptions, the acts which are deemed infringing acts against the patented invention or design are as follows:

- (1) the manufacture of the patented products;
- (2) the use, sale, possession for sale, offer for sale or importation of the patented products;
- (3) the use of the patented process;
- (4) the use, sale, possession for sale, offer for sale or importation of the products which are manufactured with the patented process.

### 2.7.2 *Legal Sanctions*

When the exclusive rights are infringed, the patentee can institute either a criminal action or a civil action, or both, to enforce his rights.

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<sup>51</sup> Section 63.

<sup>52</sup> Section 77, first and second paragraphs.

<sup>53</sup> Section 85.

<sup>54</sup> Section 86.

### 2.7.2.1 *Civil sanctions*

The Patents Act is silent as to the civil sanctions ensuing from patent infringement. Hence, civil tort law as provided in the Civil and Commercial Code will apply. The principle of civil tort law is that any person who, willfully or negligently, unlawfully endangers the life, body, health, liberty, property or any right of another person is said to commit a wrongful act and is liable to make compensation therefor.<sup>55</sup> The legal remedies provided by the law include damages, the order to stop the infringement and the order to prohibit further infringement. The patentee must ensure that he files the suit within the time limits—one year from when he learns of the infringement and the person liable for the infringement or within 10 years as from the infringement.<sup>56</sup>

The defendant in an infringement case may, in his defense, invoke the following:

- the defendant has not infringed the plaintiff's exclusive rights. For example, he has not used the plaintiff's patented process in the manufacture of his products;
- the plaintiff's patent is not valid. For example, the invention is not new;
- the plaintiff is not entitled to institute the action in his own name. For example, the plaintiff is not the patentee but the licensee;
- the case is barred by prescription.

### 2.7.2.2 *Criminal sanctions*

Unauthorized acts against the exclusive rights in a patent are criminal offenses. The unauthorized manufacture of a patented product or use of a patented process or design shall be subject to criminal punishment of imprisonment not exceeding three years or a fine not exceeding 300,000 baht, or both.<sup>57</sup> If any person sells or has in his possession for sale any product manufactured under a patented invention or process or design with the knowledge that such product had been manufactured by an unauthorized person, he shall be punished with imprisonment not exceeding two years or a fine not exceeding 20,000 baht, or both.<sup>58</sup> The patentee or the authorized person can institute criminal action against the offender.

Where an offense has been committed by a legal entity, the authorized representative of the entity shall be guilty of such offense, unless he can prove that the offense was committed without his knowledge or consent.<sup>59</sup>

## 2.8 **Contributory Infringement**

Although the Patents Act does not specify the acts which constitute contributory infringement, the existing laws can determine the occurrence and the legal effect of the contributory infringement. In a civil case, the contributory infringement is considered a wrongful act which is subject to the law of tort. The criminal law holds guilty a person who instigates or assists the commission of an offense.<sup>60</sup> Thus, if the act is an offense concerning a patent, the person who takes part in the contributory infringement will be criminally liable.

## 2.9 **Duration of Protection**

A patent for an invention is valid for 20 years from the date of filing the application. A design patent will expire 10 years from the date of filing the application.

<sup>55</sup> Civil and Commercial Code, Section 420.

<sup>56</sup> Section 448.

<sup>57</sup> Patents Act, Section 85.

<sup>58</sup> Section 86.

<sup>59</sup> Section 88.

<sup>60</sup> Penal Code, Section 84.

Although the duration of a patent starts from the date of filing the application, the exclusive rights do not subsist until the patent is granted. The exploitation of the invention or the design being applied for the patent, prior to the grant of the patent, is not an infringement unless the act occurs after the application for the patent has been published and that person knows of such publication.<sup>61</sup> The exception has been added to the amended Act to give more protection to the patentee. However, the claim for damages can be instituted only after the patent has been granted.

The rights and duties of the patentee will come to an end if the patent is no longer in force. The termination of the patent may be due to the expiration of the patent term, failure to pay the annual fee, or revocation of the patent.

## 2.10 Assignment and Licensing

### 2.10.1 Assignment

The patentee can assign his patent to another person.<sup>62</sup> The Act requires that the assignment be made in writing and registered in compliance with the conditions and procedures prescribed in the relevant Ministerial Regulations.<sup>63</sup> A patent can be inherited by the patentee's successors. Since it is transferable, it is also subject to legal execution.

### 2.10.2 Licensing

The patentee can authorize another person to use his patented invention or design. The authorization, which is normally called "licensing," provides the licensor with remuneration and grants the licensee the right to exercise the patentee's exclusive rights, and thus protects the latter from allegations of infringement.

The licensing of a patent is a common practice in industry. Normally, it is part of the whole licensing package that includes the licensing of trademarks or trade names, technical know-how and manufacturing rights. The Patents Act recognizes the patentee's right to license his patent. However, voluntary licensing may have an unfavorable economic and social impact. Therefore, the law has to intervene in licensing to a certain extent by providing that:

(1) the patentee shall not impose upon the licensee any condition or restriction or any royalty covenant which is an unfair restraint of competition.

Conditions, restrictions or covenants which unfairly restrain competition shall be prescribed by a Ministerial Regulation;

(2) the patentee shall not require the licensee to pay royalties after the patent has expired.

Conditions, restrictions or royalty covenants which are contrary to the above-mentioned provisions are null and void.

Prior to the amendment, the 1979 Act provided a similar framework, with different wording, stating that the conditions, restrictions or royalty terms which prejudiced the development of local industry, handicraft, agriculture or commerce were invalid. Ministerial Regulation No. 7, which was proclaimed in 1986, set the prohibited restrictions as follows:

(1) prescribing to the authorized person the right to supply materials for use in the manufacture, either wholly or partly, from the patentee or from the supplier designated or assigned by the patentee, irrespective of whether or not there are any considerations in return for the materials used in the manufacture, except if it can be proved that it is necessary to do so in order for the product to be

<sup>61</sup> Patents Act, Sections 35*bis* and 62*bis*.

<sup>62</sup> Section 38.

<sup>63</sup> Section 41.

made in accordance with the patent, and the considerations in return shall not be higher than the price of materials of equal quality that can be acquired from other persons;

(2) prohibiting the authorized person from acquiring materials for use in the manufacture, either wholly or partly, from the supplier designated by the patentee, except if it can be proved that in case such prescription is not made, the product made will not be in accordance with the patent;

(3) prescribing to the authorized person the right to sell or distribute the products made at more than one-half thereof to the patentee or the person assigned by the patentee;

(4) prescribing to the authorized person the right to authorize the sale or distribution of the products made, either wholly or partly, to the patentee or the person assigned by the patentee;

(5) limiting the quantity of manufacture, sale or distribution of the products of the authorized person;

(6) prohibiting the authorized person to sell or distribute the product made in other countries, except when the patentee is the patentee of the product in such countries and has already authorized other persons to sell or distribute the product under the patent solely in such countries before making a contract with the authorized person to exercise the rights under the patent;

(7) prescribing conditions or restrictions for the authorized person concerning the hire of personnel in the manufacture of the product by using the authorized invention or product design, except if it can be proved that it is necessary to do so in order for the product to be made in accordance with the patent;

(8) prescribing conditions or restrictions for the authorized persons concerning the study, research, experiment, or development of the invention or product design;

(9) prescribing conditions or restrictions for the authorized person in using the invention or product design of another person other than the authorized invention or product design;

(10) prescribing to the authorized person to use the invention or product design of another patentee when it is not necessary to do so, by collecting royalties for such use;

(11) prescribing that the patentee has the power to fix the selling price or distribution prices of the product;

(12) exempting or limiting the responsibilities of the patentee in case the authorized invention or product design is defective whereby such cannot be examined easily at the time of making the contract of exercising the rights under the patent;

(13) prohibiting the authorized person from claiming or setting up as a defense that the patentee's patent is not valid under Section 54 or Section 64;

(14) fixing royalties for the authorization of the exercising of rights under the patent at too high a rate or at a rate that is not fair when compared with the rate prescribed in the contract for exercising rights under the patent concluded by the patentee and other authorized persons;

(15) prescribing that the authorized person reveal an invention or product design which has been improved by the authorized person, or allow the patentee to seek benefits from the said invention or product design without fixing suitable royalties for the authorized person.

The rules and regulations with respect to the licensing of patents as prescribed in the Patents Act and in the Ministerial Regulation are consistent with those in other countries. They should not be viewed as too restrictive or not sufficiently flexible because the patentee and the licensee are free to agree on many important matters insofar as they are not in conflict with the restrictions. For example, the parties can choose either

an exclusive or a non-exclusive license. The law also allows the parties to select the method for the calculation of the royalties, e.g., production, sales or profits.<sup>64</sup>

While the Ministerial Regulation by virtue of the amended Act has not been issued, it is expected that it will maintain almost the same substance as Ministerial Regulation No. 7.

## 2.11 Compulsory Licensing

The Patents Act contains several provisions with respect to compulsory licensing. The basic principle underlying the provisions on compulsory licensing is that a patent may be used by another person without the consent of the patentee, provided that the user has to pay a reasonable remuneration for that use, except when the patent is used by the Government for security purposes. According to the Act, compulsory licensing is available in the following three cases.

### 2.11.1 *Insufficient Working of a Patent*

The Act permits compulsory licensing if it appears that there has been insufficient working of the patent. The rule is that, after the expiration of three years from the grant of a patent or four years from filing the application, whichever lapses later, any person may file a request with the Director-General of the Department of Intellectual Property for a compulsory license if any of the following facts exists when such a request is made:

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

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

The applicant is required to show that he has attempted to obtain a license by offering sufficient conditions and royalties to the patentee but agreement could not be reached in due time.<sup>65</sup>

The procedure for applying for a compulsory license in case of insufficient working of a patent is prescribed in Ministerial Regulation No. 6 (1979), Clause 14, as follows:

“Any person who wishes to obtain a license pursuant to Section 46 must file an application in the form prescribed and printed by the Director-General with the competent officer at the Department of Commercial Registration, Ministry of Commerce.

In applying for a license, the applicant must:

(1) file evidence to show that, within three years from the grant of the patent, the patented product has not been manufactured or the patented process has not been applied in the country without any appropriate reason, or the products manufactured under the patent have not been sold in a domestic market, or were sold at unreasonably high prices, or the sales do not meet the domestic demand without any appropriate reason;

(2) set forth the amount of remuneration, the conditions for the exploitation of the patent, and the restrictions of the rights of the patentee;

(3) file evidence showing the financial status of the applicant and his investment planning for the manufacture or distribution of the products.”

The foregoing Regulation is expected to be revised soon so as to comply with the amended version of Section 46.

<sup>64</sup> Puangraj, *op. cit.*, p. 106.

<sup>65</sup> Patents Act, Section 46.

### 2.11.2 *Interdependent Patents*

The Patents Act makes a compulsory license available when the exploitation of a patent is likely to constitute infringement of another person's patent. The patentee of a patent which is about to be exploited may apply for a compulsory license to use another person's patent, subject to the following conditions:

- (1) the compulsory license will not cause unreasonable prejudice to the exercise of rights by another patentee or by his licensee;
- (2) the invention under the patent of the applicant is very important to the economy or to domestic demand;
- (3) the applicant cannot exploit his patent commercially unless he is granted a compulsory license.<sup>66</sup>

In Ministerial Regulation No. 6 (1979), Clause 15 elaborates the procedure for applying for a compulsory license for interdependent patents and any patentee who wishes to obtain a license therefor must file an application, in the form prescribed by the Director-General, with the competent officer at the Department of Commercial Registration, Ministry of Commerce, and the applicant must:

- (1) show that
  - (a) the grant of such license will not cause unreasonable prejudice to the exercise of rights by another patentee or by his licensee,
  - (b) the invention under the patent of the applicant is very important to commerce or to domestic demand, and
  - (c) the applicant cannot exploit his patent commercially unless he is granted the compulsory license;
- (2) set forth the amount of remuneration, conditions for the exploitation of the patent, and the restrictions on the rights of the patentee and his licensee; and
- (3) indicate that the applicant will offer a license on his patent to the other party in return.

As for the above two cases of compulsory licensing, when the Director-General decides that the applicant is entitled to a compulsory license, the Director-General will set forth the royalties and the conditions for the use of the patent and the restrictions on the rights of the patentee and his licensee, as agreed upon by the patentee and the applicant. If no agreement can be reached within the period specified by the Director-General, the Director-General will fix the royalties and prescribe the conditions and restrictions as he deems appropriate. Either party may appeal the decision of the Director-General to the Board of Patents within 60 days from the date he is informed of the decision.<sup>67</sup> A party can appeal the Board of Patents' ruling to the court within 60 days, otherwise the ruling is deemed final.<sup>68</sup>

### 2.11.3 *Public Interest*

The Act authorizes the Government to use the patent for the benefit of the public in two circumstances.

First, a Ministry, Bureau or Department may use any patented invention by itself or authorize another person to use it for the benefit of public utilities or national defense, for the preservation or acquisition of natural resources or the environment, for the prevention of severe shortages of food or medicine, or for other public interests without commercial purpose. The authority concerned is obliged to pay a royalty to the patentee or the licensee with immediate notification to the patentee.<sup>69</sup>

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<sup>66</sup> Section 47.

<sup>67</sup> Section 50.

<sup>68</sup> Section 74.

<sup>69</sup> Section 51.

Second, the Government may use any patent during a state of war or emergency as necessary for the benefit of national defense or national security provided that it pays an appropriate royalty to the patentee. The exercise of this power by the Government must be authorized by a Royal Decree which identifies the patentee and the number of the patent except where necessary.<sup>70</sup>

## 2.12 Revocation of Patents

According to the Patents Act, a patent may be revoked for two reasons, namely, (1) invalidity of the patent and (2) insufficient working of the patent.

### 2.12.1 *Invalidity of the Patent*

The Act permits an interested person or a public prosecutor to institute an action for the revocation of a patent on the ground that the patent is invalid because it was not granted in compliance with Sections 5, 9, 10, 11 and 14. For example, the patent is granted despite the fact that the invention or the design is not new or that the invention is indeed not patentable.<sup>71</sup>

### 2.12.2 *Insufficient Working of the Patent*

The Director-General may submit a petition to the Board of Patents to revoke an invention patent for the following reason:

After the lapse of two years after the issuance of a compulsory license, it turns out that such compulsory licensing cannot effectively relieve the reasons for the issuance of a compulsory license. This means that there is no manufacture of the patented product or no application of the patented process within the country without appropriate reason or there is no supply of the patented product or the products manufactured with the patented process or there is a supply at excessively high prices or the supply does not meet domestic needs without appropriate reason.<sup>72</sup>

Where the patent is revoked by order of the Board of Patents, the patentee may appeal such order by taking an action to the competent court within 30 days from the date he is notified of the order. If the patentee fails to do so within the time, the order of the Board will be final.<sup>73</sup>

## 2.13 Surrender of Patents or Claims

The patentee may surrender the patent or any claim thereto. The patentee must have received the consent of the joint patentee or the licensee, if any, before he files the notice of surrender to the competent authority.<sup>74</sup> However, Ministerial Regulation No. 8 (1986) provides that the surrender cannot be made in the following circumstances: (1) there is a lawsuit pending in the court alleging that the patent that infringes, or of which a claim is proposed to be surrendered infringes, a patent of another person; or (2) there is a lawsuit pending in the court requesting the revocation of the patent due to the alleged invalidity.

The surrender of a patent results in the legal protection ceasing. When the surrender takes effect, no one will have the exclusive rights in the invention or the design and everyone will gain free access to the subject. By contrast, the surrender of a claim does not effect the existence of the patent but merely means the waiver of such claim only.

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<sup>70</sup> Section 52.

<sup>71</sup> Sections 54 and 64.

<sup>72</sup> Section 55.

<sup>73</sup> Section 74.

<sup>74</sup> Section 53.



**2.14 Utility Models**

Inventions are protected by the Patents Act 1979. In Thailand, there is no other law which protects utility models or petty patents, as they are called in some countries. Therefore, an invention which does not qualify for a patent will not be legally protected.

## **CHAPTER 3**

### **TRADEMARKS**

#### **SYNOPSIS**

- 3.1 Introduction**
- 3.2 Scope of Trademark Law**
  - 3.2.1 Signs Which May Serve as Trademarks**
  - 3.2.2 Products on Which Trademarks Are Used**
  - 3.2.3 Service Marks, Certification Marks and Collective Marks**
- 3.3 Policy Considerations in Trademark Law**
  - 3.3.1 Interests of Traders and Consumers**
  - 3.3.2 Trademarks and Economic Development**
- 3.4 Criteria of Protectability**
  - 3.4.1 Requirement of Distinctiveness**
  - 3.4.2 Requirement of Absence of Misleading Character and of Absence of Violation of Public Order or Morality**
- 3.5 Acquisition of Trademark Rights**
- 3.6 Use Requirement**
  - 3.6.1 Introduction**
  - 3.6.2 Meaning of Use**
  - 3.6.3 Removal for Non-Use**
  - 3.6.4 Deceptive or Confusing Use**
- 3.7 Conflicts With Prior Rights**
- 3.8 Registration Procedures**
  - 3.8.1 Introduction**
  - 3.8.2 Application for Registration**
  - 3.8.3 Examination as to Form**
  - 3.8.4 Examination as to Substance**
  - 3.8.5 Advertisement**
  - 3.8.6 Opposition**
  - 3.8.7 Certificate of Registration**
- 3.9 Duration of Protection**
- 3.10 Renewal**
- 3.11 Termination**

**3.12 Scope of Protection****3.12.1 Territorial****3.12.2 Temporal****3.12.3 Protected Acts****3.12.4 Legal Protection****3.12.5 Exceptions to the Scope of Trademark Protection****3.13 Parallel Importation****3.14 Counterfeiting****3.14.1 Introduction****3.14.2 Remedies and Enforcement****3.15 Transfer of Trademarks****3.16 Licensing**

### 3.1 Introduction

In the old days when Thailand was wholly an agricultural society, trademarks, which were very important to trades and services, did not play an important role and were rarely used. Thailand then developed trade relations with several foreign countries. Increasing numbers of foreign goods were sold in Thailand and increasing numbers of foreign businesses were established in the country. Foreign traders introduced commercial practices by using trademarks with their goods and called for the protection of their trademark rights. It was in 1910 that the Royal Government initiated its responsibility with respect to the matter of trademarks by establishing the so-called Registry of Trademarks in the Ministry of Agriculture. Four years later, a trademark law, which was entitled the "Act on Trade Marks and Trade Names B.E. 2457 (1914)" was promulgated. The Act provided mostly for the registration process of trademarks. There were only a few disputes among the local trademark owners. As for foreign marks, any foreign government which demanded that the Thai Government take care of the unauthorized use of foreign trademarks by local manufacturers usually entered into a Treaty of Amity with the Kingdom of Thailand, which normally bound each contracting party to give protection to foreign trademark owners.

As time went by, the administration of trademarks became more and more important and needed more efficient operation. In order to systematize the trademark administration of the country, the Department of Commercial Registration was established in B.E. 2466 (1923) and attached to the Ministry of Commerce. The registration work, which was formerly undertaken by the Ministry of Agriculture, was transferred to the newly established Department. One major responsibility of the Department was, of course, the registration of trademarks.<sup>1</sup>

The Act on Trade Marks and Trade Names B.E. 2457 (1914) remained in force until it was replaced by the Trademarks Act B.E. 2474 (1931). The 1931 Act had been amended twice. The first amendment was made in 1933 concerning the appeal process. The second amendment saw the alteration and addition of several provisions to the Act in 1961.

As a matter of fact, the Trademarks Act of 1931 was passed such a long time ago that it had become obsolete and unable to respond to the economic and commercial development of the country. The Act did not include service marks and certification marks despite the fact that they were actually used in commerce. In other countries, such marks were recognized and legally protected. It did not regulate licensing of trademarks, which might be good for the licensor and the licensee because it did not place a burden on them, but it might be detrimental to consumers of the goods if the licensor were not able to monitor the manufacture of the goods as to whether they followed the correct manufacturing process or not. Moreover, it was submitted that the application of the 1931 Act often generated practical problems due to the lack of necessary stipulations as well as some unclear provisions, for example, the authority of the Registrar and the Board of Trademarks, the right of the applicant to registration. In order to remedy the deficiencies in the present law, the Government proposed a new Trademark Bill to the Legislature. Ultimately, the new Trademarks Act was passed and has been in force since February 13, 1991.

### 3.2 Scope of Trademark Law

In order to indicate the subject matter with which the Trademarks Act is concerned, this topic will briefly describe the signs which may serve as trademarks and the objects with which they are used. In addition, it will touch upon the widely-used service marks

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<sup>1</sup> See "History of the Department of Commercial Registration, the Royal Announcement establishing the Department of Commercial Registration and appointing the Legal Advisor of the Trade Expansion Council," *Journal of the Department of Commercial Registration* 1 (January-February 1983), pp. 5-10.

and certification marks, which are not recognized by the law yet, merely to distinguish them from conventional trademarks.

### 3.2.1 *Signs Which May Serve as Trademarks*

According to the Trademarks Act, a mark which may be used as a trademark shall include a photograph, portrait, invented picture, brand, name, word, letter, numeral, signature or any combination thereof but not including a product design according to the Patents Act.<sup>2</sup> Therefore, it is a fundamental requirement that a mark be visible. Sound or smell is not regarded as a mark under the Thai law. Generally, visible marks which are used as trademarks include letters, numbers, words and pictures. However, whether or not those marks may serve as registered trademarks is subject to other conditions which will be discussed later.

### 3.2.2 *Products on Which Trademarks Are Used*

The Trademarks Act makes it clear that a trademark is a mark which is used with goods and nothing else. A trademark is defined as a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trademark, by virtue of manufacture, selection, certification, dealing with, or offering for sale.<sup>3</sup> Therefore, any mark which does not have the fundamental function mentioned above is not deemed a trademark in the strict sense. For example, a mark used as a representation of a service business, which is a so-called service mark, or a mark used to certify the source of goods or the quality of others, which is generally called a certification mark, is not a trademark.

### 3.2.3 *Service Marks, Certification Marks and Collective Marks*

The abrogated Trademarks Act of 1931 did not cover service marks, certification marks and collective marks. The present Trademarks Act 1991 brings those marks within the purview of the law by regulating the process of registration and granting legal protection. The provisions for conventional trademarks apply to service marks, certification marks and collective marks *mutatis mutandis*.

A service mark means a mark which is used or proposed to be used with or in connection with a service in order to distinguish the service which uses such mark from the services which use other marks.

A certification mark means a mark which is used or proposed to be used by the owner of the mark with or in connection with the goods or services of other persons in order to certify the source of origin, ingredients, manufacturing process, quality or other characteristics of the goods or to certify the nature, quality, types or other characteristics of the services.

A collective mark means a mark which is used or proposed to be used by the same group of companies or business enterprises or by the members of an association, cooperative, union, federation, group of persons or other governmental or private organization.

## 3.3 **Policy Considerations in Trademark Law**

Basically, a trademark law is aimed at protecting the benefits of traders and consumers. The protection given to traders is usually the right to use their own trademarks exclusively. Consumers are also protected by law through the requirement to register, which prevents the likelihood of confusion and deception. Apart from the protective aspect,

<sup>2</sup> Trademarks Act, Section 4, first paragraph.

<sup>3</sup> Section 4, second paragraph.

the trademark law also plays an important role in the promotion of goods domestically and internationally. It is true that trademark protection is now a trade-related issue in international trade.

### 3.3.1 *Interests of Traders and Consumers*

A trademark is regarded as being very meaningful to traders and consumers because it can perform these four basic functions:<sup>4</sup>

- (i) a distinguishing or differentiation function;
- (ii) an origin or source function;
- (iii) a quality function; and
- (iv) an advertising function.

By performing each function, a trademark is useful to both traders and consumers. For example, when a trademark functions as a guarantee of quality, it assures the buyers of a certain quality of the goods sold under the same mark because of its established reputation. Of course, the consumers' decision to purchase directly benefits the trader's business.

As to how the Trademarks Act plays a role in protecting traders and consumers, one needs to go through the text of the Act. It can be inferred from the law that some provisions are in favor of the traders' interests and some of the same provisions, in certain cases, secure the benefits of the consumers. For example, a trademark owner is safeguarded by the law which prohibits the registration of a mark which in fact belongs to another person. On the other hand, the same provision may be seen as protecting consumers because such prohibition precludes the confusion which is very likely to be created in the consumers' minds had the mark been registered.

### 3.3.2 *Trademarks and Economic Development*

The trademark is regarded as the best medium to convey messages regarding the goods to the consumers. The most important information which the trademark usually communicates to the consumer is the source of origin of the goods and their quality. The trademark also helps stimulate demand for the goods and increase the supply of such goods to respond to that demand. The higher purchasing power of the people and the increasing production of goods take part in the growth of several sectors concerned. The expansion of manufacturing capacity of trademarked goods needs more production of raw materials or components either vertically or horizontally.

In Thailand, trademark protection has direct and indirect effects on economic development. The effective protection directly stimulates the production of more quality goods of protected well-known marks, which is conducive to more investment, employment and distribution of income. The goods which are manufactured increasingly are those of indigenous trademarks and those of foreign marks through licensing transactions. Protection also facilitates the production or importation of goods which suitably serves the needs of individuals and industry. Without appropriate protection, the manufacturers or the importers may hesitate to introduce the goods to the domestic market. By the same token, the system helps control and get rid of illegal trademarks that cause serious damage to *bona fide* traders as well as deception and confusion among the public.

In addition, trademark protection also has an indirect but important effect on the growth of the economy. The inadequate and ineffective protection of intellectual property is now a condition for trade retaliation from at least one trading partner country. Retaliation may cause serious damage to the export trade of Thailand. In order to prevent such an unfavorable situation, the protection of trademarks among other branches of intellec-

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<sup>4</sup> See *Background Reading Material on Intellectual Property*, World Intellectual Property Organization, Geneva, 1988, WIPO Publication No. 659(E), pp. 148-151.

tual property is necessary and, consequently, helpful for maintaining the export trade with other trading partners. It is, therefore, another aspect of trademark protection which is related to the economic development of the country.

### 3.4 Criteria of Protectability

Trademarks are fully protected by law if they are duly registered. To be qualified for registration, a trademark must meet two requirements. The requirements, which are consistent with the standard accepted worldwide, are twofold: requirement of distinctiveness and requirement of non-existence of a misleading character and of violation of public order or morality.

#### 3.4.1 Requirement of Distinctiveness

A distinctive trademark is a trademark which enables the public or consumers to know and understand that the goods bearing such trademark are distinguished from other goods.<sup>5</sup>

A trademark which consists of any of the following essential elements is deemed to be distinctive:<sup>6</sup>

- (1) a name, a surname of a natural person which is not a generally known surname, a juristic person's name or a trade name which is shown in a special feature;
- (2) a word or a statement which gives no direct indication of the nature or quality of the goods and which is not a geographical name as prescribed by Ministerial Announcement;
- (3) an invented letter, numeral or word;
- (4) the signature of the applicant for trademark registration or of the previous owner of the applicant's business or the signature of a person with his permission;
- (5) a picture of the applicant for registration or of a person with his permission or, in case of his death, the permission of his ascendants, descendants and spouse, if any;
- (6) an invented picture.

A name, word or statement which does not fall within (1) or (2), above, may be deemed distinctive if the goods bearing such trademark have been widely distributed or advertised in accordance with the criteria prescribed by Ministerial Announcement.

The marks specified in (1) to (6) are inherently distinctive. They are registrable subject to the fulfillment of other requirements even though the marks have not been previously used in trade before the registration. The reason for the immediate registrability is that the trademark is so inherently distinctive that any buyer of goods bearing such mark can perceive it as a trademark and distinguish it from other trademarks in the marketplace.

By contrast, a trademark which is not inherently distinctive cannot be registered in the absence of actual use in trade. The Act requires proof of sufficient distributorship or advertising of the goods bearing the trademark. The proof of such commercial activities will point out the distinctiveness which occurs after a period of use. In other words, distinctiveness may be acquired through use.

In brief, the requirement of distinctiveness, whether inherent or acquired, is essential because the distinctiveness enables buyers to identify the goods and distinguish them from other goods which bear different marks.

<sup>5</sup> Trademarks Act, Section 7, first paragraph.

<sup>6</sup> *Ibid*, second paragraph.

(a) *Inherent distinctiveness*

The state of inherent distinctiveness is itemized in the Act as provided above. Basically, it should be noted that the law makes each subject of inherent distinctiveness independent of one another. It means, therefore, that a trademark which meets at least one characteristic of inherent distinctiveness is qualified for registration even though it does not match another manner of inherent distinctiveness. For example, although the trademark "MILAN" is generally known as a geographical name, it is considered registrable as the company's name which is shown in a special feature.

(1) *A name, a surname of a natural person which is not a generally known surname, a juristic person's name or a trade name which is shown in a special feature.* The registrability of these names as trademarks is subject to exhibition in a special feature. In most cases, the special feature is made with invented or distinctively designed letters. For example, the designed trademarks "FUJI ELECTRIC," "ITT."

(2) *A word or a statement giving no direct indication of the nature or quality of the goods and which is not a geographical name as prescribed by Ministerial Announcement.* This subsection consists of two parts concerning a word or statement which is not directly related to the character or quality of the goods and those which are not prohibited geographical names.

The words which give a direct indication of the character or quality of the goods may be either of the following types:

(i) words which merely describe the ingredients, components, quality, capacity or other matters which are relevant to the goods. Trademarks which are considered merely descriptive and consequently are not accepted for registration are, for example, "HERBAL" for cosmetics which are understood as having herbs as ingredients, "WIPE-OUT" for insecticides, "SCREENWIPE" for cloth to be used for cleaning computer and television screens, "NOSETAB" for a nasal medicine, "SUPER CUT" for an electrical circuit breaker;

(ii) words which directly identify the kinds of goods. For example, "CELLOPHANE," "ASPIRIN," "COLA," etc.

The above-mentioned types of words are restricted for trademark registration. However, the law does not preclude a word or statement which indirectly indicates the nature or quality of goods. Marks of such indirect indication are sometimes referred to as merely suggestive marks. Examples of registrable suggestive marks are "TOUGH MAN" for medicine, "SKINCALM" for body lotion, "SKIN LESS SKIN" for condoms.

As for the restricted geographical names, the Ministerial Announcement which will prescribe the unregistrable geographical names is at present under consideration and is expected to be promulgated soon.

(3) *An invented letter, numeral or word.* The invented word is interpreted as a word specifically invented which is readable but has no literary meaning. The invented word may derive from an adaptation of words with a literary meaning provided that the new word is moderately different from the combined original words and cannot be translated. It is a fact that this criterion is at the discretion of the Registrar or the Board of Trademarks. For example, "CAPILL" and "FABRICARE" are registered as invented work trademarks.

Interestingly, the abbreviation of a company's name is allowed to be registered as an invented word on condition that the abbreviation becomes readable and carries no meaning. For example, "AHE" (Asia Health Equipment Co. Ltd.), "UPS" (United Parcel Service of America, Inc.), "BAO" (Bangkok Assay Office Co. Ltd.).

(4) *The signature of the applicant for trademark registration or of the previous owner of the applicant's business or the signature of a person with his permission.* The signature is not required to be shown in a special manner because it is distinctive in itself.



(5) *A picture of the applicant for registration or of a person with his permission or, in case of his death, with his ascendants', descendants' and spouse's permission, if any.* Even though the picture or portrait of another person can be used as a trademark, the registration requires evidence of valid permission.

(6) *An invented picture.* The meaning of this term is not clear but it is understood that a picture which is registrable must not be merely natural. For example, a picture of an animal may not be registrable unless it is duly adapted or invented to some extent.

*(b) Acquisition of distinctiveness through use*

The Trademarks Act allows the registration of trademarks that are not inherently distinctive upon the submission of evidence supporting the acquired distinctiveness thereof. In practice, proof of distinctiveness is usually made by showing that distinctiveness has been acquired through use since the buyers get acquainted with the actually used marks as trademarks for particular goods. Hence, the evidence must be able to show the duration and frequency of use of the trademark. For such purpose, the evidence is always drawn from purchase orders, invoices, advertisements, public relations' activities, etc. This rule offers the opportunity to re-apply for trademark registration if the former registration has been rejected due to lack of inherent distinctiveness. For example, the trademark "CHRISTIAN DIOR" for watches was once rejected on the ground that it was a personal name which was not shown in a special or specific feature and so was not inherently distinctive. However, the trademark was later registered upon re-filing of the application together with satisfactory evidence of acquired distinctiveness.

*(c) Loss of distinctiveness*

The distinctiveness of a trademark may be acquired through use. On the other hand, use of a trademark may cause the loss of distinctiveness. This situation may occur either to a trademark with inherent distinctiveness or to a trademark with acquired distinctiveness. Loss of distinctiveness will ensue if the trademark is so well known for a product that the public finally use the mark as the generic name of the same kind of product even when manufactured by other entrepreneurs. Consequently, owners of popular trademarks always try to prevent the loss of distinctiveness because this can have an unfavorable impact. The legal consequences of the loss of distinctiveness differ in various countries. According to the Trademarks Act, a trademark the distinctiveness of which is lost is subject to removal from the Register by an order of the court.

*3.4.2 Requirement of Absence of Misleading Character and of Absence of Violation of Public Order or Morality*

There are two additional requirements for the registrability of a trademark: the absence of misleading character and the absence of violation of public order or morality.

*(a) Misleading trademarks*

The Trademarks Act deals with the matter of misleading trademarks in Section 7(2), as already mentioned, where marks with a direct indication of the character or quality of goods are not allowed for registration. This prohibition applies whether the indication is true or not. The indicating mark is considered to lack distinctiveness. A mark will be considered deceptive if it is likely to mislead the buyers of the ingredients, quality, etc., of the goods. On the contrary, if the buyers are not likely to be misled by the trademarks, the marks are not regarded as being deceptive. For example, the trademark "IVORY" for soaps is not deceptive because no one would think that the soap is made of ivory.

*(b) Public order and morality*

The Trademarks Act adopts the principle that a trademark must not be contrary to public order or morality. It clearly provides that a trademark which consists of

any of the stipulated things is not registrable.<sup>7</sup> The prohibition includes symbols or representations relating to the Monarchy, national flags and other things. Item (10) specifically restricts the use of any mark which is contrary to public order, morality or public policy. This provision remains the same as it was in the 1931 Act and examples resulting from the application of the old law can illustrate the role of this law. There were some trademarks which were ruled contrary to public order or morality where it was admissible that the trademark which was filed for registration was indeed the trademark of another person and no authorization for registration was given. Examples of trademarks which were rejected on this ground are "VISA," "DARKIE," "BAMBI," etc. Besides, the trademark which comprises an adored or respected symbol or name was ruled to be against public order or morality. For example, a mark which resembled the national symbol of Singapore was not accepted for registration on this ground.

### 3.5 Acquisition of Trademark Rights

In general, exclusive rights in a trademark may be obtained through use or through registration.<sup>8</sup> According to the Trademarks Act, exclusive rights in a trademark are obtained through registration. The Act provides that, subject to Sections 27 and 68, a person who is registered as the proprietor of a trademark has an exclusive right to use the registered trademark with the registered goods.<sup>9</sup>

Therefore, the registrant acquires the exclusive rights in his registered trademark only for specific classes of goods. The exclusive rights do not extend to use of the trademark in other classes. In such circumstance, the right of the owner of a registered trademark regarding the unregistered classes is equal to that of an owner of an unregistered trademark. The above-mentioned principle, however, does not mean that the owner of an unregistered trademark is completely deprived of any protection. Indeed, the Act protects the owner of an unregistered trademark to some extent. Although he has no exclusive rights in his trademark, he may be able to take action against an unauthorized user of his trademark if such use is passing-off or he may be able to file an action for revocation of a trademark from the Register against another person if he can prove that he has a better title to the trademark.

### 3.6 Use Requirement

#### 3.6.1 Introduction

There are three different systems concerning the requirement of use of a trademark in order to obtain the exclusive rights. The first system is characterized by the requirement that a trademark must be in actual use in order to qualify for registration. The second system requires that the application for registration of a trademark be accompanied by a declaration from the trademark owner certifying that he intends to use the trademark. The third system permits the acquisition of an exclusive right in respect of a trademark without any use of the latter and without any declaration of intent to use, but requires that the trademark be used within certain time limits.<sup>10</sup>

The Thai Trademarks Act adopts the third system. The Act does not explicitly require that a mark be used before registration. Moreover, the definition of trademark, which includes the mark used or proposed to be used with the goods, also indicates that there is no such implied requirement. Although a trademark which has not been used before can be registered, it may be subject to revocation if it is not actually used in commerce after registration.

<sup>7</sup> Section 8.

<sup>8</sup> *Background Reading Material on Intellectual Property, op. cit.*, pp. 160-161.

<sup>9</sup> Trademarks Act, Section 44.

<sup>10</sup> *Background Reading Material on Intellectual Property, op. cit.*, pp. 161-162.

### 3.6.2 *Meaning of Use*

#### (a) *Visual representation*

The Act does not stipulate the method of use of a trademark. However, it is certain that a trademark must be used in such a way that it can be perceived visually because a trademark is defined as including various marks and signs, all of them being visible by nature. Neither sound nor odor is recognized as a trademark under Thai law. Therefore, a method of use other than visual representation is not accepted as use of a trademark. Moreover, the trademark must be used or proposed to be used on or in connection with goods. The use on the goods, of course, includes the presentation of the trademark on the packaging or containers of goods in case direct use of the content of goods is not possible, e.g., detergents, food, soft drinks, etc. Use in connection with goods is intended to include use in related commercial documents and printed matter, e.g., invoices, receipts, menus, tags, etc.

#### (b) *Advertisements*

There has not been a precedent yet whether the use of a trademark in advertising or other promotional media constitutes sufficient use to prevent the revocation of a trademark for non-use. However, there is an acceptable position that use which is not on or in connection with goods should not be considered as a correct use in terms of the maintenance of a trademark.

The underlying reason is that use which is not on or in connection with goods cannot serve the major function of the trademark—the distinguishing or differentiation function. Use in advertisements or other promotional media is auxiliary to use on or in connection with goods but such use alone does not constitute sufficient use of a trademark.

The question whether use in advertising media is sufficient or not may find a different response if the question is concerned with infringement. It is widely accepted that use of a protected trademark by an unauthorized user in an advertising medium constitutes an infringement. However, unlike the trademark laws in some countries, the Trademarks Act does not specify the acts which are deemed to be infringing acts. Such omission of transparent rules sometimes causes difficulties with respect to the determination whether an alleged act is an infringement or not.

#### (c) *Extent and amount*

Since the Act does not require use prior to registration, the extent and amount of use is not important for such purpose. But the requirement of use by the owner of the trademark or by an authorized person is indispensable in an action for revocation of the trademark that is registered by a person who is not the real owner of the mark. The Act provides that the owner of a trademark can file an action for revocation of a trademark on the ground that he has a better title to it.<sup>11</sup> In most cases, the court justifies better title to a trademark as use of such trademark by the owner or by an authorized person on goods sold in the country prior to registration of the same or a similar trademark by another person. In one case, however, it was held that use of the trademark on goods manufactured in the territory and wholly exported sufficed the requirement of domestic use by the owner of the trademark to support the better title in the trademark.

#### (d) *Use indicating origin*

The main function of a trademark is to indicate the origin of goods or of a service. A trademark must be distinctive so as to be capable of performing such function. The use of a trademark for another purpose may destroy the status of the trademark. There is an interesting criminal case with respect to trademarks which acknowledges the relationship between the trademark and its use. The plaintiff, a manufacturer of sporting shoes, used its registered trademark as a design of the soles of the shoes. The defendant, which

<sup>11</sup> Trademarks Act, Section 67.

is another manufacturer of sporting shoes, used the same configuration for its products. The plaintiff filed a criminal action against the defendant for the forgery of its trademark. The court held that the registered mark was not used by the plaintiff as a trademark; therefore, the mark was not regarded legally as a trademark and the case was dismissed.<sup>12</sup>

*(e) Use through licensee*

The question always arises whether use by a licensee constitutes use by the owner of the trademark. The license of a trademark usually attaches to a license to manufacture a specific product by a local industry. Although there has not been a judicial precedent, the new trademark law makes it clear that use of a trademark by a legitimate licensee is deemed use by the trademark proprietor.<sup>13</sup>

**3.6.3 Removal for Non-Use**

The Trademarks Act is similar to the trademark laws of most countries with respect to removal from the Register for non-use. According to the Act, the competent court can order removal of a registered trademark from the Register because of non-use if (a) the trademark was registered without any *bona fide* intention to use it with the goods and in fact it has never actually been used with such goods or (b) the trademark has never been used with the goods during the three-year period preceding the action for removal. There is an exception to the cause of action if the non-use is due to special trade circumstances and not because of any intention to refrain from using or to abandon the trademark with respect to the goods.<sup>14</sup>

**3.6.4 Deceptive or Confusing Use**

**3.6.4.1 The trademark is not distinctive as prescribed by law<sup>15</sup>**

A trademark which is not distinctive may be regarded as deceptive particularly when it directly indicates the nature or quality of the goods.<sup>16</sup> Likewise, a trademark which is prohibited by law particularly because it is contrary to public order or morality on the ground that it indeed belongs to another person may create confusion among the public as to the source or origin of the goods.<sup>17</sup> The Act authorizes an interested person or the Registrar to petition the Board of Trademarks to cancel the registration of the trademark on this ground.

**3.6.4.2 The trademark is contrary to public order, morality or public policy<sup>18</sup>**

The Act allows any person who considers a trademark contrary to public order, morality or public policy to request the Board of Trademarks to cancel the registration of such trademark. That the trademark is indeed another person's trademark and not the applicant's is thus contrary to public order, morality or public policy and becomes a ground for cancellation.

**3.6.4.3 The trademark becomes generic<sup>19</sup>**

An interested person or the Registrar may petition the court to cancel the registration of a trademark on the ground that the trademark has become generic for the registered goods. The use of a generic term would cause confusion where a mark, particularly a word mark, functions as the trademark for that kind of goods.

<sup>12</sup> Supreme Court Decision No. 958-959/2506.

<sup>13</sup> Trademarks Act, Section 70.

<sup>14</sup> Section 63.

<sup>15</sup> Section 61.

<sup>16</sup> Section 7(2).

<sup>17</sup> Section 8(10).

<sup>18</sup> Section 62.

<sup>19</sup> Section 66.

### 3.7 Conflicts With Prior Rights

A person who is registered as the proprietor of a trademark is considered to be its proprietor and to have the exclusive rights to use it for all the goods of the class or classes in respect of which registration has been granted. However, a trademark which is registered may possibly be a trademark, a trade name or even a copyright work or a design of another person who has not given permission for the use of his intellectual output. In this case, the exclusive rights in a trademark will inevitably conflict with other prior rights. The problem will arise whether such conflict of rights has any effect on the validity of the exclusive rights in a trademark.

The Act deals with this problem in two steps—before and after registration. If it is established before registration that the trademark for which registration is sought is identical or very similar to a registered mark of the same class, the Registrar can refuse the registration.<sup>20</sup> If the trademark for which registration is sought is identical or very similar to a registered trademark but it is proposed to use it with a different class of goods, the registration of the trademark can be refused on the ground that it is contrary to public policy and morality and that it has been filed for registration without the consent of the real owner of the trademark.<sup>21</sup> By the same token, if a trademark that is filed for registration is indeed a trade name or a copyright work or a design of another person, the Registrar can reject the registration as the unauthorized utilization of another person's asset makes the trademark contrary to public policy and morality.<sup>22</sup> By applying these existing rules, the Registrar can prevent the occurrence of conflicts of trademark rights with prior rights. In case a trademark has already been registered, the Act grants the exclusive rights to the person who is registered as the proprietor of the trademark so that he can enforce his rights against infringers. However, the Act makes the registration subject to cancellation. The Act provides that any interested person can file a civil action for cancellation. A trademark which has been registered will be struck off the Register if the plaintiff can prove that he has a better title to the trademark.<sup>23</sup> Besides, a registered trademark which is contrary to public order, morality or public policy can be later cancelled by the Board of Trademarks.<sup>24</sup>

While the duly registered trademark brings exclusive rights to the trademark owner, the Act affirms that the registration will not interfere with any use in good faith by a person of his own name or place of business or that of any of his predecessors in such business, or the use in good faith by any person of a description of the character or quality of his goods.<sup>25</sup>

### 3.8 Registration Procedures

#### 3.8.1 Introduction

An application for registration of a trademark is to be filed with the Trademark Division, Department of Intellectual Property, Ministry of Commerce. The Division is responsible for the examination of the application and the registrability of a trademark before the Department of Intellectual Property grants a certificate of registration. The Division is also in charge of other registration work with respect to trademarks. The Head of the Division is normally appointed Registrar. Above the Registrar, there is the Board of Trademarks. The Board of Trademarks mainly considers appeals from applicants whose applications have been rejected by the Registrar. The decision of the Board is final. The

<sup>20</sup> Section 13.

<sup>21</sup> Section 8(10).

<sup>22</sup> *Ibid.*

<sup>23</sup> Section 67.

<sup>24</sup> Sections 61 and 62.

<sup>25</sup> Section 47.

Board of Trademarks consists of the Director-General of the Department of Intellectual Property as Chairman and other members, not more than six persons, to be appointed by the Cabinet.

In practice, the applicant conducts a search at the Trademark Division before he files his application so as to be certain that the trademark which is about to be filed for registration is not identical or similar to another registered trademark particularly in the same class of goods. After a thorough search, the applicant will begin the registration procedure.

### 3.8.2 *Application for Registration*

The filing of the application must comply with Ministerial Regulation No. 1, which specifies the method of filing and the documents required.

The applicant may register the trademark for goods in one or several classes. The application must clearly identify the specific goods. One application is used for goods in the same class only.<sup>26</sup>

The present Trademarks Act adopts the International Classification of Goods and Services which was established in accordance with the Nice Agreement of 1957, as revised at Stockholm in 1967 and at Geneva in 1977.

### 3.8.3 *Examination as to Form*

The Trademark Division will make a preliminary examination of the application form as to whether it is correctly filled in and whether the relevant documents are attached thereto. If the application has not been completed, the applicant will be allowed to correct it and re-submit it.

### 3.8.4 *Examination as to Substance*

The examination of substantive aspects of the application seems to be the most important part of the registration process. At this stage, the Trademark Division considers whether the trademark is distinctive, whether it is a prohibited mark and whether it is identical or similar to a trademark already registered for the same goods or the same class.

As to the examination of distinctiveness, the Registrar will first consider if the trademark conforms with each of the particulars accepted by the Act to be registrable. The trademark will be deemed inherently distinctive and immediately registrable if it is consistent with the character specified by the law. On the other hand, the Registrar may demand additional evidence of distinctiveness if the trademark is not inherently distinctive. The Act provides that a trademark which is not inherently distinctive may be registrable if the evidence of acquired distinctiveness is sufficiently presented.<sup>27</sup> Failure to present evidence showing that the non-inherently distinctive mark has gained the recognition of the consumers that it is a trademark will result in the rejection of the application. The evidence that is admissible for this purpose includes purchase orders, invoices and advertising materials.

The examination as to whether or not the trademark is a prohibited mark is based on a specific provision of the Act.<sup>28</sup> Trademarks are rejected for registration as being prohibited marks in almost every case because they are held to be trademarks or another kind of intellectual asset of another person. The Registrar invokes the contrariety to public policy or morality to refuse the registration for such trademarks.

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<sup>26</sup> Section 9.

<sup>27</sup> Section 7.

<sup>28</sup> Section 8.

The Trademark Division usually puts special emphasis on the examination as to whether the trademark for which registration is sought is identical or similar to any registered trademark of the same class because approval for registration of an identical or similar trademark will cause confusion among buyers. The Act contains a provision which the Registrar can rely on. The law authorizes the Registrar to reject a trademark if it is identical to a trademark already registered by another proprietor in respect of goods of the same class, or so similar to such a trademark that the similarity may confuse the public.<sup>29</sup> The examination will be limited to the same class or classes of goods in which the relevant trademarks are already registered and to be registered.

Where each of several persons claims to be the proprietor of the same trademark or of nearly identical trademarks in respect of the same goods or description of goods and to be registered as such proprietor, the Registrar shall notify by registered letter all applicants thereof and instruct them to reach a settlement or to bring an action to the court. If within 90 days from the date of the notice the Registrar has not been notified that an agreement has been reached or that an action has been filed, the Registrar shall proceed with the registration of that trademark for the first filed application. If the parties concerned have come to an agreement, the registration shall be made in accordance with the terms thereof.<sup>30</sup>

In case of concurrent use in good faith of the same trademark by different proprietors or of other special circumstances which are deemed proper by the Registrar to permit the registration, the Registrar may permit the registration of the same trademark or of nearly identical ones of the same goods or description of goods for more than one proprietor, subject to such conditions or limitations, if any, as to the mode or place of use or other conditions and limitations as the Registrar may think proper to impose. The Registrar shall notify in writing the proprietors of trademarks who have applied for registration that the registration has been permitted with or without conditions or limitations, or has been refused.<sup>31</sup>

If a trademark contains matter common in trade or of character not distinctive of such goods, the Registrar may, before permitting or refusing the registration, require the proprietor to disclaim any right to the exclusive use of any part or parts of such trademark, or of all or any portion of such matters which are common in trade or may require the proprietor to make such other disclaimer as the Registrar may consider necessary for the purpose of determining the proprietor's rights under such registration.<sup>32</sup>

### 3.8.5 *Advertisement*

If, after the examination as to form and the examination as to substance, the Registrar deems it appropriate to accept the trademark to be registered, the Registrar must advertise the application for registration of such trademark in the *Trademark Gazette*.<sup>33</sup> The advertisement is intended to make the public, particularly the owner of an identical or a similar trademark, aware of the application so they can take appropriate measures to protect their rights.

### 3.8.6 *Opposition*

Within 90 days from the date of the advertisement of the application, any person is entitled to submit to the Registrar written notice of opposition to the application for registration.<sup>34</sup> The notice must present the grounds for opposition. The Registrar will

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<sup>29</sup> Section 13.

<sup>30</sup> Sections 21 to 26.

<sup>31</sup> Section 27. See the application of this provision in the Board of Trademarks' Ruling No. 302/2507 and the Supreme Court's Decision No. 1607/2509.

<sup>32</sup> Section 19.

<sup>33</sup> Section 29.

<sup>34</sup> Section 35.

send the notice of opposition to the applicant who has to submit a counterstatement to the Registrar within 90 days from the delivery of such notice, otherwise he will be deemed to have abandoned his application. The Registrar has to forward the counterstatement to the opposer without delay. After that, the Registrar may give his decision with or without hearing the oral arguments from both sides. The party which the Registrar's decision is against may appeal to either the Board of Trademarks or the court within 90 days from the date he is notified of the Registrar's ruling. If an appeal takes place, the Registrar has to suspend the registration procedure until the Board of Trademarks or the court has reached a final decision. If no appeal is made within the 90-day period, the right to appeal to the Board of Trademarks or to the court shall cease.<sup>35</sup>

On the other hand, if no notice of opposition is filed within 90 days from the date of advertising the application, the Registrar will order that the trademark being applied for be recorded in the Register.<sup>36</sup> The applicant will receive a certificate of registration issued by the Department of Intellectual Property.

### 3.8.7 *Certificate of Registration*

A certificate of registration will be granted to the applicant by the Department of Intellectual Property.<sup>37</sup> The certificate will include the name of the applicant, the class of goods and the specific kinds of goods, a sample of the registered trademark and the date of issue. If a trademark is registered without limitation of color, it shall be deemed to be registered for all colors.<sup>38</sup> The certificate will be valid for 10 years from the date of the application. It can be renewed for another 10 years after each expiration.

### 3.9 **Duration of Protection**

According to the Trademarks Act, the effect of the registration is valid for 10 years.<sup>39</sup> The effect of the registration begins on the date of filing for registration, which is deemed for the purpose of the law to be the date of registration.<sup>40</sup> The retroactive effect may shorten the remaining period of protection but it is advantageous to deal with the infringement which has occurred after the filing date of the application but before the issuing date of the certificate of registration.

After the registration expires and no renewal is made, the trademark will be protected as a non-registered trademark, the protection of which is much less than that of a registered trademark.

### 3.10 **Renewal**

The registered proprietor of a trademark may, within 90 days before the expiration of the registration, apply to renew the registration of his trademark for a further period of 10 years from the date of the expiration of the preceding registration.<sup>41</sup> If the renewal is approved, the Registrar shall record the renewal in the certificate of registration.

### 3.11 **Termination**

In accordance with the Trademarks Act, the registration of a trademark may be terminated due to either of the following two causes: non-renewal or removal.

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<sup>35</sup> Section 39.

<sup>36</sup> Section 40.

<sup>37</sup> Section 43.

<sup>38</sup> Section 45.

<sup>39</sup> Section 53.

<sup>40</sup> Section 42.

<sup>41</sup> Section 54.



The registration of a trademark is valid for 10 years and it is extendable for another 10 years for an unlimited number of times. If the trademark proprietor does not apply for renewal, the registration shall be deemed automatically cancelled.<sup>42</sup>

As regards removal of a trademark from the Register, the Act provides that the removal may be made by the Registrar or the Board of Trademarks or the court, depending on the reason for removal.

*(a) Removal by the Registrar*

The Registrar can order the removal of a trademark from the Register in the following circumstances:

- (1) a registered trademark owner files the application for renewal in time but fails to comply with the Ministerial Regulation and does not correct it within 30 days after receiving an instruction from the Registrar;<sup>43</sup>
- (2) a registered trademark proprietor voluntarily requests the Registrar to cancel his trademark registration;<sup>44</sup>
- (3) a registered trademark proprietor fails to comply with the conditions or restrictions stipulated by the Registrar;<sup>45</sup>
- (4) a registered trademark proprietor or his agent dissolves his registered offices in Thailand.<sup>46</sup>

The Act requires the Registrar to notify his order of cancellation in writing to the trademark owner without delay. The trademark owner can appeal to the Board of Trademarks within 90 days after receiving the notice, otherwise the Registrar's order shall be deemed final.<sup>47</sup>

*(b) Removal by the Board of Trademarks*

The Board of Trademarks is empowered to cancel a trademark registration under these three circumstances:

- (1) an interested person or the Registrar who files the petition can prove that the trademark when being registered was not distinctive according to Section 7 or was prohibited by Section 8;<sup>48</sup>
- (2) a person who considers the trademark to be against public order, morality or public policy files a petition for the cancellation of such trademark;<sup>49</sup>
- (3) an interested person or the Registrar who files the petition can prove that the trademark owner did not intend in good faith to use the trademark when it was registered with the registered goods and subsequently did not use it in good faith or that during three years prior to the petition there has been no actual use of the trademark with the registered goods unless the trademark owner can show that the non-use was due to special circumstances and not to an intention not to use or to abandon the trademark.<sup>50</sup>

The petitioner or the trademark owner or his licensee may appeal the Board of Trademarks' ruling to the court within 90 days after receiving the order in writing, otherwise the Board's order shall be deemed final.<sup>51</sup>

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<sup>42</sup> Section 56.

<sup>43</sup> Section 55.

<sup>44</sup> Section 57.

<sup>45</sup> Section 58.

<sup>46</sup> Section 59.

<sup>47</sup> Section 60.

<sup>48</sup> Section 61.

<sup>49</sup> Section 62.

<sup>50</sup> Section 63.

<sup>51</sup> Section 65.

(c) *Removal by the Court*

The registration of a trademark may be cancelled by the competent court under the following circumstances:

(1) an interested person or the Registrar who petitions the court can prove that at the time of petition the trademark had become so common in trade of goods or classes of goods that it has lost its meaning as a trademark;<sup>52</sup>

(2) an interested person institutes an action within five years as from the date the Registrar accepted the trademark for registration and can prove that he has a better title to the trademark.<sup>53</sup> The court recognizes the better title only when the goods bearing the disputed trademark were sold in Thailand before or when the defendant filed the application for registration.<sup>54</sup> If such fact is not affirmed, the court would not recognize that the plaintiff has the better title and would dismiss the case.<sup>55</sup>

### 3.12 Scope of Protection

#### 3.12.1 *Territorial*

The Trademarks Act grants exclusive rights to the registered proprietor of a trademark. The registration is effective all over and only within the country. Thailand is not a member of any international or regional organization which renders the effect of registration in other member countries. While the registration takes effect in the whole territory, the plaintiff has to institute his case in the right jurisdiction.

#### 3.12.2 *Temporal*

Each registration of a trademark lasts for a period of 10 years. The registration may be renewed for another term of 10 years for an unlimited number of times. Therefore, subject to consecutive renewal, the term of protection will not be limited. On the contrary, if the expired registration is not renewed, the protection will cease and the registration of such trademark will be revoked.

#### 3.12.3 *Protected Acts*

##### (a) *Use of the mark*

As the Act grants the exclusive right to the registered proprietor of the trademark to use it with the goods of a class or several classes, it means that the registered trademark proprietor has the right to exclude others from using his trademark with the same registered goods. If another person uses the trademark for such goods, he evidently infringes the trademark right of the registered proprietor.

##### (b) *Use of the mark on similar products*

If the Act is strictly interpreted, use by another person of the registered trademark on products which are not registered should not constitute an infringement because it is not the same manner of use for which the proprietor has the exclusive right. The Act does not contain a provision which includes the acts deemed to be infringements as some foreign trademark laws do. There has not been a case where the court has ruled that such use is an infringement of an exclusive right. According to the Act, however, the problem may be applied with the law on passing-off, which is adopted in the Trademarks Act. If use even with the goods not registered by the proprietor causes confusion among consumers that the goods being sold by the user originate from the registered proprietor,

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<sup>52</sup> Section 66.

<sup>53</sup> Section 67.

<sup>54</sup> For example, Supreme Court's Decisions Nos. 1957/2531, 3142/2532, 4006/2532

<sup>55</sup> *Ibid.*, 4535/2533, 4540/2533.

passing-off will be established and the proprietor of the registered trademark can take action as if his exclusive rights were infringed.

*(c) Restraining the use of similar marks*

Here the same problem arises whether the use of a mark similar to the registered trademark is an infringement of the exclusive right. Since the Act is silent as to the acts which are deemed to be infringing acts, the court has to resort to trademark passing-off to deal with this problem. The confusion of the buyers with respect to the source of origin of the goods becomes determinative. However, if the mark is so similar to the registered one, it seems to be highly acceptable to consider such use an infringement because the use of such mark is hardly different from the direct use of the registered trademark.

*(d) Other cases*

There are a few unprecedented cases concerning infringement which may go to court. The first question is whether the use by another person of a registered trademark not in connection with the goods, for example, in advertising media, on a shop signboard, constitutes an infringement. The second question concerns the use of a registered trademark for comparative purposes. For example, the label of a perfume with its own brand may refer to another perfume of a different trademark in order to inform buyers of the same quality but at different prices. The last problem arises with the use of a well-known trademark with goods or services which does not cause confusion as to the origin of the goods or service.

These issues have not been decided by the judicial branch. It is, therefore, still interesting to see whether the court will apply trademark law or tort law when dealing with these problems.

#### 3.12.4 *Legal Protection*

*(a) Registered trademark*

In case a registered trademark is alleged to be infringed, the proprietor of the trademark can take action against the infringer and can petition for the following remedies: damages, no further use of the trademark by the defendant, seizing the goods bearing the infringed mark. Besides, the registered proprietor may file an action for removal of the trademark if his trademark is registered by another person for another class of goods by claiming that he has a better title to the trademark. As for criminal sanctions, there are two laws which impose punishment on the offender with respect to trademarks, namely, the Penal Code and the Trademarks Act. When the new Trademarks Act, which contains several provisions dealing with offenses related to trademarks, was promulgated, similar provisions laid down in the Penal Code were not abrogated. The relevant provisions of the Penal Code read as follows:

*“Section 273.* Whoever forges another person’s registered trademark, whether it be registered within or outside the Kingdom, shall be punished with imprisonment not exceeding three years, or a fine not exceeding 6,000 baht, or both.

*Section 274.* Whoever imitates another person’s registered trademark, whether it be registered within or outside the Kingdom, in order to make the public believe that it is the registered trademark of such other person, shall be punished with imprisonment not exceeding one year or a fine not exceeding 2,000 baht, or both.

*Section 275.* Whoever brings into the Kingdom, disposes of or exposes for disposal goods bearing a name, figure, artificial mark or any wording as provided in Section 272(1), or goods bearing the forged or imitated trademark belonging to the other person according to Section 273 or 274, shall be liable to the same punishment as provided in such Section.”

The Trademarks Act provides for similar offenses in Sections 108, 109, 110 as follows:

“*Section 108.* Whoever forges another person’s trademark, service mark, certification mark or collective mark which is registered in Thailand, shall be punished with imprisonment not exceeding four years or a fine not exceeding 400,000 baht, or both.

*Section 109.* Whoever imitates another person’s trademark, service mark, certification mark or collective mark which is registered in Thailand in order to make the public believe that it is the mark of such other person, shall be punished with imprisonment not exceeding two years or a fine not exceeding 200,000 baht, or both.

*Section 110.* Whoever

(1) imports, sells, offers for sale or keeps in his possession for sale any goods which bear a forged trademark, certification mark or collective mark according to Section 108 or an imitated mark according to Section 109 or

(2) gives or offers any service which uses a forged service mark, certification mark or collective mark according to Section 108 or an imitated mark according Section 109,

shall be punished with the penalties provided in such Section.”

Despite the similarity, the major differences between the two laws are twofold. First, the place of registration according to the Penal Code may be Thailand or another country while that according to the Trademarks Act must be Thailand only. If a trademark registered in another country is forged or imitated, the Penal Code is applicable. Second, the punishment under the Trademarks Act is much more severe than that in the Penal Code.

*(b) Non-registered trademark*

The proprietor of a non-registered trademark in Thailand can take civil action if his trademark is used by another person in a passing-off manner. The Act provides that “Nothing in this Act shall be deemed to affect the rights of action of a non-registered trademark owner against any person for passing off goods as those of the trademark owner.”<sup>56</sup> This provision makes clear that the owner of a trademark which is not registered in Thailand at all, or is registered only in respect of certain classes of goods, can institute a passing-off action against an unauthorized user of his trademark. Passing-off occurs where the defendant uses an identical or similar mark together with other components, for example, packaging or get up, to misrepresent that the goods originate from the plaintiff. To be successful in a passing-off claim, the plaintiff has to prove that the defendant has marketed his products in such a way as to be likely to deceive the public of the origin of the goods. In order to prove there has been a likelihood of deception in the mind of the public, the plaintiff must show that his mark is so widely recognized that the use of such mark or similar mark by another at any time would lead to the inference on the part of the buying public that the goods were manufactured by the plaintiff or with the plaintiff’s permission. In a passing-off action, the proprietor of a non-registered trademark can seek the same remedies as the proprietor of a registered trademark. Apart from the passing-off action, he is entitled to take an action for removal of a trademark from the Register if he can establish that he has a better title to the trademark. The action for removal may be filed separately from or together with the passing-off claim.

The proprietor of a non-registered trademark is also protected by criminal law to some extent. The Penal Code refers to the non-registered trademark in the following provision:

“*Section 272.* Whoever

(1) uses a name, figure, artificial mark or any wording in carrying on trade of the other person, or causes the same to appear on goods, packaging, coverings,

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<sup>56</sup> Trademarks Act, Section 46, second paragraph.

advertisements, price lists, business letters or the like in order to make the public believe that it is the goods or trade of such other person;

(2) ...;

(3) ...;

shall be punished with imprisonment not exceeding one year, or a fine not exceeding 2,000 baht, or both.”

The term “artificial mark” in Section 272(1) has been interpreted by the Supreme Court in Decision No. 782, 783/2508 to include a non-registered trademark. Therefore, the owner of a trademark which is not registered in Thailand or elsewhere can invoke this provision against a party using his trademark. To constitute an offense, the defendant must act with the intention of misleading the public to believe that the goods or trade of another is involved. The law further states that this criminal offense is compoundable, which means that the litigants can settle the case at any time before the final judgment. This provision is not proposed to be changed by the Trademark Bill because it deals with unregistered trademarks which are outside the purview of the Bill.

### 3.12.5 *Exceptions to the Scope of Trademark Protection*

There are two different cases which the scope of protection may not reach.

#### (a) *Use of own name and other necessary indications*

The Act provides a buffer between the exclusive right acquired through the registration and use in good faith by a person of his own name or other specific indications. The rule is that the registration of a trademark may not interfere with any *bona fide* use by a person of his own name or place of business, or that of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods.<sup>57</sup> *Bona fide* use is interpreted as use not as a trademark or in a way likely to confuse the public with the registered trademark of another person.

#### (b) *Exhaustion of trademark rights*

The general rule laid down by the BIRPI Model Law for Developing Countries is that the registered owner of a trademark cannot preclude others from using the mark in relation to goods which have been lawfully sold in the country under that mark.<sup>58</sup> So far, there has not been any conspicuous case within the jurisdiction which coincides with this rule. However, there are some criminal cases which may be viewed as confirmation of the trademark rights against the use of a trademark with goods not sold by the proprietor of the trademark or his authorized dealer. According to the Penal Code, Section 271(1), it is an offense to use a name, figure, artificial mark or any wording in carrying on trade of the other person in order to mislead the public that it is the goods or trade of such other person. In those cases, the defendants used the trademarks of other persons with their goods or businesses without permission. The facts indicated that the defendants had the intention to make the public believe that the goods or businesses were related to the plaintiffs. The goods in those cases were not the goods distributed by the trademark proprietor or his agents. The Supreme Court held the defendants guilty. Therefore, these cases may be consistent with the general rule that the right of the trademark owner is not exhausted with respect to goods not lawfully sold by him.

### 3.13 **Parallel Importation**

Parallel importation produces problems for the manufacturer or the importer of products who has previously used a trademark lawfully. It can cause an unexpected decrease in his market share. Before the goods are widely accepted in the market, the manufacturer or the licensor has to invest a lot of money. The investment includes the royalties paid

<sup>57</sup> Section 47.

<sup>58</sup> *Background Reading Material on Intellectual Property, op. cit.*, p. 175.

for the right to manufacture and for the authorized use of the trademark, marketing expenses and promotional expenses. The parallel importer does not have to bear these costs since the goods have already been established in the market. Therefore, he can sell the same goods at a much lower price. The former manufacturer or importer will have difficulty in competing with the parallel importer.

Different jurisdictions may view the problem of parallel importation differently. It may be acceptable in some countries due to economic reasons that the consumers pay less for the same later imported goods. Some jurisdictions, however, regard this activity as an unfair trade practice which is subject to legal sanctions.

Within the Thai jurisdiction, the court applies trademark law and civil tort law to the problem of parallel importation. So far, there have been a number of cases which show the evolution of law. The precedent is that the registered proprietor of a trademark can take action against the importer of registered goods which bear a registered trademark because the import constitutes use of the registered trademark to which no one except the registered proprietor has the exclusive right.<sup>59</sup> Of course, the registered proprietor includes the lawful assignee of the trademark.<sup>60</sup> On the other hand, the local distributor of the goods, even being a sole distributor, does not have the right to file an action against a parallel importer because he is not the registered owner of the trademark.<sup>61</sup> Parallel importation is not a criminal offense concerning a trademark because the trademark used with the imported goods is the original one. There is no forgery or imitation of the trademark at all.

### 3.14 Counterfeiting

#### 3.14.1 Introduction

Generally, counterfeiting is the application of a well-known trademark to the goods produced by a person who is not the proprietor of the trademark and does not have the right to manufacture them. Counterfeiting may or may not have a deceptive effect, depending on the intent of the manufacturer of the fake goods and the knowledge of the buyers. If it can cause deception, it is harmful to both the consumers and the owner of the trademark. It is injurious to the buyers because they pay much money for low quality goods which they never really want. Besides, some fake goods may be dangerous or cause accidents to the user. This is a serious problem that counterfeiting can bring about. On the other hand, counterfeiting may not cause deception. In this case, the buyers know that the goods are fake even though a well-known trademark is used but they are pleased to spend money on them. However, the practice impairs the reputation and the economic interest of the real owner of the trademark and the trader of such goods. It is understandable that buyers with high purchasing power would not buy expensive goods the duplicates of which are easily seen on the street.

#### 3.14.2 Remedies and Enforcement

If the registered trademark is used in counterfeiting, trademark infringement is involved and the proprietor of a trademark can exercise his exclusive right against the counterfeiter. In case the trademark is not registered, the owner of the trademark has to resort to a passing-off claim.<sup>62</sup>

According to criminal law, counterfeiting is, in almost every case, forgery of a trademark, which is a criminal offense. It is only the degree of penalties which differs between forgery of a registered trademark and an unregistered trademark.<sup>63</sup>

<sup>59</sup> Supreme Court Decisions Nos. 657/2499, 1271-3/2508, 1669-72/2523.

<sup>60</sup> *Ibid.*, No. 2031-2/2526.

<sup>61</sup> *Ibid.*, Nos. 366/2500, 882/2504.

<sup>62</sup> See 3.12.4 (Legal Protection).

<sup>63</sup> *Ibid.*

### 3.15 Transfer of Trademarks

The former Trademarks Act 1931 required that the trademark be transferred together with the business concerned. The new Trademarks Act changes this rule by not making it compulsory to transfer the trademark with the business.<sup>64</sup>

In cases where the trademarks are registered as associated marks, the transfer or inheritance must be made in a whole set of associated marks and not separately.<sup>65</sup> The rationale for this requirement is to prevent confusion because the associated marks are so similar that if they were separately used by different owners, the public would be confused as to the origin of the goods.

The transfer of a registered trademark must be registered with the Registrar and be in conformity with the relevant Ministerial Regulation.<sup>66</sup>

### 3.16 Licensing

Licensing authorizes the legitimate use of a trademark without which use may be an infringement. The authorization to use a trademark is normally granted through a licensing agreement which stipulates the rights and duties of the licensor and the licensee. The licensee cannot sub-license the trademark unless he is permitted to do so. Since the licensee is not the owner of the trademark, he cannot assign the trademark to another person. In addition, he cannot institute legal proceedings against an infringer in his own name.

The former Trademarks Act provided nothing as to licensing. By contrast, the present Trademarks Act 1991 explicitly regulates the licensing transaction. A license to use a trademark registered in Thailand must be made in writing and registered with the Registrar in accordance with the Ministerial Regulation. The application for such registration is required to show these two particulars: (1) conditions or stipulations between the licensor and the licensee that the licensor shall be entitled to control the quality of the goods using the trademark, and (2) the goods which the licensed trademark is to be used with.<sup>67</sup>

The trademark owner or the applicant for the license registration may appeal the Registrar's decision as to the registrability of the license agreement to the Board of Trademarks within 90 days, otherwise the Registrar's decision shall be deemed final. The ruling of the Board of Trademarks on this matter shall be final.<sup>68</sup>

It is noteworthy that the law accepts use by the licensee as use by the licensor.<sup>69</sup> This would be a good defense for the trademark owner against an allegation of non-use in Thailand.

The registration of a license may be cancelled by the Registrar upon a request from the trademark owner and the licensee jointly or from each party stating that the license has expired.<sup>70</sup>

Moreover, an interested person or the Registrar may petition the Board of Trademarks to cancel the registration of a licensing agreement on the grounds that (1) use of the licensed trademark by the licensee causes confusion among the public or becomes contrary to public order, morality or public policy; or (2) the trademark owner is no longer able to control the quality of the goods using the licensed trademark.<sup>71</sup>

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<sup>64</sup> Trademarks Act, Section 49.

<sup>65</sup> Section 50.

<sup>66</sup> Section 51.

<sup>67</sup> Section 68.

<sup>68</sup> Section 69.

<sup>69</sup> Section 70.

<sup>70</sup> Section 72, first and second paragraphs.

<sup>71</sup> *Ibid.*, third paragraph.

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The Act clearly provides that a trademark license shall cease to be in force if the registration of such trademark is cancelled.<sup>72</sup>

Unless the license is made exclusive, the trademark owner can use the trademark or license other licensees.<sup>73</sup> The licensee may use the trademark countrywide and throughout the term of trademark registration unless the agreement specifies otherwise.<sup>74</sup> Assignment of the license or the sub-license is not allowed unless the agreement provides otherwise.<sup>75</sup>

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<sup>72</sup> Section 76.

<sup>73</sup> Section 77.

<sup>74</sup> Section 78.

<sup>75</sup> Section 79.



## **CHAPTER 4**

### **COPYRIGHT AND NEIGHBORING RIGHTS**

#### **SYNOPSIS**

- 4.1 Introduction**
- 4.2 Copyright Protection**
- 4.3 Subject Matter of Copyright Protection**
- 4.4 Rights Comprised in Copyright**
  - 4.4.1 Reproduction Right**
  - 4.4.2 Adaptation Right**
  - 4.4.3 Publication Right**
  - 4.4.4 Moral Right**
- 4.5 Neighboring Rights**
- 4.6 Ownership of Copyright**
- 4.7 Limitations on Copyright Protection**
  - 4.7.1 Temporal**
  - 4.7.2 Geographic**
  - 4.7.3 Permitted Use**
- 4.8 Infringement**
- 4.9 Remedies**
  - 4.9.1 Civil Action**
  - 4.9.2 Injunction**
  - 4.9.3 Criminal Action**
- 4.10 Protection of Foreign Work**

#### 4.1 Introduction

The history of copyright law in Thailand can be traced back to B.E. 2435 (1892), when the Announcement of the Vachirayan Library (now the National Library) was made by the Library Committee. The Announcement is regarded as the first copyright law of the country mainly because its principle was consistent with that of copyright by excluding others from making partial or whole reproductions of the Vachirayanvises books which were archived in the Library. The Announcement, however, applied only to the Vachirayanvises books. Nine years later, the Authors' Ownership Act B.E. 2444 (1901) was promulgated. This Act extended the coverage to other kinds of books in addition to the Vachirayanvises books. Interestingly, the law was much influenced by English law, namely, the Statute of Queen Anne 1709 and the Literary Copyright Act 1842. The Act had been in force for 13 years before it was amended in B.E. 2457 (1914), with the main purpose of extending protection to other types of printed matter, for example, pamphlets, loose-leaves, maps, musical sheets. In this amendment, however, the term "ownership" was still used in the context of "copyright" as adopted in some countries at that time. Thailand then became more modernized and established good relations with foreign countries, particularly western States. It is due to the narrow scope of the existing law, together with foreign countries urging Thailand to elevate its law to international standards, that the improvement of the existing copyright law became a necessity. For various reasons, Thailand decided to accede to the Berne Convention which required its members to enact a law which gave copyright protection in compliance with the provisions of the Convention. As a result, the Act for the Protection of Literary and Artistic Works B.E. 2474 (1931) was promulgated and came into force in 1931.

The 1931 Act repealed the previous 1901 Act and its amendment. Soon after the enactment, Thailand was accepted in the Berne Union and has been a party to the Berne Convention since July 17, 1931. The 1931 Act had been in force without any amendment for so long that it was outpaced by technological changes and the law failed to deter copyright infringement because of its weak penalties. A new Bill was then prepared so as to overcome such weak points. The Berne Convention as well as the Tunis Model Law were taken into consideration in order to draft a new law which would be suitably responsive to the social and economic situation of the country. The drafting work and legislative process took almost six years before the new law, entitled the "Copyright Act B.E. 2521 (1978)," was enacted. The Act authorizes the enactment of a Royal Decree to set conditions for the protection of foreign copyright. Therefore, five years later, the Royal Decree Providing Conditions for the Protection of International Copyright B.E. 2526 (1983) was proclaimed. It is noteworthy that the Act was proposed to be amended by the Government in 1988. The Amendment Bill had been approved by the House of Representatives and was about to be sent to the Senate. However, the House was dissolved the next day, which resulted in the lapse of the Bill. Therefore, the Copyright Act which first came into force in 1978 has never been amended.

The Thai copyright law stemmed from a purely domestic initiative at the very outset. It was then developed with much foreign influence. Up until now, the law is in line with international standards to the extent that Thailand is obliged to be bound. Now that there has been much evolution in this field of law all over the world, it is to be expected that the Thai copyright law will undergo some changes in the near future.

Throughout the application of the copyright law in Thailand, there have not been very many court decisions. The cases, however, are very useful with respect to the interpretation of law. This chapter will refer to some related cases when it goes through the provisions of the Copyright Act B.E. 2521 (1978) (which hereinafter will be referred to as the "Copyright Act" or the "Act") and the Royal Decree Providing Conditions for the Protection of International Copyright B.E. 2526 (1983).

## 4.2 Copyright Protection

The reason for copyright protection in Thailand was first evidently expressed in the Authors' Ownership Act B.E. 2444 (1901). It explicitly affirmed the author's rights to benefit from his work and to exclude others from exploiting the author's creation without the latter's permission. The preamble also referred to the existence of laws protecting the author's rights in other civilized countries. The law seemed to place a lot of emphasis on economic reasons. The concept of public interest, however, was not clearly reflected in the law then. It was in the Act for the Protection of Literary and Artistic Works B.E. 2474 (1931) that the interest of the public was explicitly incorporated.

Currently, the Copyright Act contains a specific part, entitled "Exceptions of Infringement of Copyright," which identifies the acts that are not deemed to be infringement. It is the intent of the law to set a balance of interest between the author and the user of a work. However, it seems to be normal that the more advantages the user enjoys, the less protection the copyright owner receives. Therefore, the balance of interest between these two groups is always debatable. The demand that the point of balance should be adjusted always comes from the copyright proprietors. For example, the copyright owner of an audiovisual work argues that the publication of the work, even without a direct profit from such publication, should not be, as it is in the present law, exempt from being an infringement. Moreover, it has been criticized that the boundary of general exceptions to infringement is so broad that it can hardly limit the use of a work by others.

The Copyright Act, nevertheless, grants quite strong copyright protection. By giving the copyright owner the exclusive rights in his work, anyone who is not authorized to use the protected work but does so is liable for infringement and is subject to civil and criminal sanctions. The copyright owner is entitled to various remedies in a civil action. In a criminal case, the extent of the penalty prescribed by law is stringent enough to have a deterrent effect on would-be infringers.

## 4.3 Subject Matter of Copyright Protection

According to the Copyright Act, the subject matter of copyright protection is referred to as "work," which is defined as a creative work in the form of literary, dramatic, artistic, musical, audiovisual, cinematographic, sound and video broadcasting work, or any other work in the literary, scientific or artistic domain.<sup>1</sup> The meaning of each type of work is given by the law, which will be described later.

To be a protected work, the work must meet the fundamental characteristics of a subject matter of copyright protection. Basically, the work must be the expression of an idea shown in any form which is accepted by law. This requirement is not clearly stated in the Act but is implied in the definition of "work" mentioned above. By the same token, the concept of originality exists in the law but is not addressed in clear language. Although the law does not state that the work must be original as such, it alludes to this fundamental element in the definition of "author," which means a person who makes or creates a work on his own initiative.<sup>2</sup> This statement is clear enough that the work must originate from the author's labor and intellect. The work is a subject of copyright protection irrespective of the extent of its quality. The Act is seen to adopt this basic principle where it classifies various types of artistic work and concludes that a work as described is an artistic work even without artistic value.<sup>3</sup> The Act does not clearly relate the non-requirement of quality to other works. But, it is doctrinally understood that it is not only the artistic work which does not require artistic value, but also other types of work which do not count on quality as a condition of being a protected work.

<sup>1</sup> Copyright Act, Section 4, second paragraph.

<sup>2</sup> *Ibid.*, first paragraph.

<sup>3</sup> *Ibid.*, seventh paragraph.

The types of work protected by the Copyright Act are as follows:<sup>4</sup>

— *literary work*: every production in the literary domain, irrespective of its mode or form of expression, such as books, pamphlets, writings, printings, lectures, sermons, addresses, sound records and/or other pictures;

— *dramatic work*: a work relating to choreography, dancing, action or performance in dramatic composition, and includes pantomime;

— *artistic work*: a work of any one or more of the following descriptions:

- (1) *work of painting and drawing*: a work of creating a configuration which is composed of any one or more lines, lights, colors or other things made on a single kind or various kinds of material;
- (2) *work of sculpture*: a work of creating a configuration of tangible volume;
- (3) *work of lithography*: a work of creating a picture through the process of printing and includes a printing block or pattern used for the printing;
- (4) *work of architecture*: a design of a building or a construction, an interior or exterior decoration as well as a decoration of the surrounding of a building or a construction, or the creation of a model of a building or a construction;
- (5) *photographic work*: a work of creating a picture by using a video recorder causing the light to pass through the lens towards a film or mirror and developing the film or mirror by chemicals of a specific formula or any process capable of creating a picture or video recording by using other instruments or means;
- (6) *work on illustrations, maps, structures, sketches, or three-dimensional works in relation to geography, topography, or science*;
- (7) *work of applied art*: a composition of any one or more of the works under (1) to (6) to be utilized in addition to the appreciation of the merit of those works, such as those used for utility, decoration of materials or appliances, or trading purposes;

Each work described above is an artistic work whether with or without artistic value, and shall include a photograph and a plan of such work;

— *musical work*: a musical composition for playing or singing, whether with words and/or rhythm, and includes a musical book, musical note or musical diagram, the tunes in which have been arranged and transcribed;

— *audiovisual work*: a sound record, disc, audiotape, videotape or any other thing for sound and/or video recording, which is capable of being replayed, whether to be supported by other equipment;

— *cinematographic work*: an audiovisual work composed of sequences of visual images, with or without sounds, and recorded on any kind of material, so that such material can:

- (1) be shown as a motion picture, or
- (2) be recorded on another material so as to be shown as a motion picture;

— *sound and video broadcasting work*: a work communicated to the public by means of radio broadcasting, sound and video broadcasting on television or by other similar means;

— *any other work in the literary, scientific or artistic domains*: this broad language is intended to be a sweeping phrase to cushion any other type of work which falls outside the foregoing defined works. The question is which work comes within the scope of this phrase. So far, there has been a very important work which is claimed to be this type of work. Computer software was once explained to be a work protected by copyright

<sup>4</sup> *Ibid.*, fourth to tenth paragraphs.

as being a work in the scientific domain. Such interpretation occurred after a question had been raised by the Thai Industry Association with the Ministry of Education in 1984 on whether computer software was a copyright work or not. The problem was referred to the Office of the Juridical Council of which one duty among others was to give legal opinions to the Government. Giving the opinion in June 1984 that computer software was a work in the scientific domain, the Office of the Juridical Council reasoned that software was a result of labor, skill and intellectual input which was reproducible or adaptable. The opinion, however, does not have a binding authority. The same issue has never been considered by the judicial branch. As in other developing countries, the issue of the copyrightability of computer software is still controversial in Thailand. In the absence of a judicial decision affirming that computer software is a copyrightable work and in the absence of a clear-cut policy of the Government to provide protection, the attempt to amend the Copyright Act to grant protection for computer software seems to be far from achieving success in the near future.

The above-mentioned types of work are subject matter of copyright whether they are published or not. However, the Act is silent with respect to the fixation of work in tangible mediums of expression. There are some specific kinds of literary work, namely, lectures, sermons, addresses, speeches, where it is questionable whether or not they have to be reduced to writing at the time the works are made in order to be protected by copyright. There are different opinions on this matter. One opinion is that the work must be fixed in writing to be a copyright work. Therefore, an oral expression made *impromptu* is excluded from copyright protection, while an oral work which is backed by the written medium stands within the realm of protection as a literary work. The reason for this position is mostly based on the analogy to the ordinary types of literary work such as books, articles, etc., which are in written form. The other opinion supports the copyrightability of the unwritten work. It is reasoned that the Act does not explicitly exclude it from protection. Therefore, the law should be interpreted in favor of rather than in prejudice to the author. Besides, the result of such interpretation is consistent with the laws in some other civil law countries which provide copyright protection for the "oral work."<sup>5</sup> This specific legal question is still debatable and awaits a judicial decision.

*Non-Copyright Work.* There is a provision in the Copyright Act which specifically provides that some things are not regarded as works and are not within the scope of copyright protection. The law provides that:

"The following shall not be regarded as the works in which copyright subsists by virtue of this Act:

- (1) news of the day and facts having the nature of information which are not works in the literary, scientific or artistic domain;
- (2) constitutions and legislation;
- (3) regulations, rules, announcements, orders, explanations and correspondence of the Ministries, sub-Ministries, Departments or any other State or local units;
- (4) judgments, orders, decisions and official reports;
- (5) translations and collections of those in (1) to (4) made by the Ministries, sub-Ministries, Departments or any other State or local units."<sup>6</sup>

Although each of the above-mentioned is not a work protected by copyright, it should be noted that a new creation out of a non-copyright item may generate a work if it fulfills the basic requirements for copyright, as mentioned at the beginning of this

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<sup>5</sup> For example, French Copyright Law 1957 and the Copyright Law 1965 of the Federal Republic of Germany.

<sup>6</sup> Copyright Act, Section 32.

sub-topic. For example, the Supreme Court ruled in Decision No. 508/2508 that the translation of the Civil Code (which was not a protected work) was the original creation of the author and became a literary work under the Act for the Protection of Literary and Artistic Works B.E. 2474 (1931). The judgment, which was correctly made in accordance with the principle of copyright law, still prevails within the context of the present Copyright Act.

Apart from being a non-copyright thing according to the provisions of law, a creation may not be protected by copyright if it is an illegal matter or a thing which is made contrary to public order or morality. Even though the Act remains silent as to this condition, the Supreme Court has spelled out this doctrine in Decision No. 3705/2530 in 1987. In that case, the work in dispute was an obscene videotape of which the making or possession was illegal under the Penal Code. The Court relied on the interpretation of the term "work," which meant "a creative work..." to rule that the videotape was by no means a creative work and, therefore, was not qualified to be a copyright work. The judgment is regarded as consistent with the purpose of the copyright law and public policy.

#### 4.4 Rights Comprised in Copyright

It is obvious that the owner of copyright in a protected work can use his work as he likes. Such positive right, of course, is not the essence of copyright. The owner of copyright is granted the exclusive rights by law so as to prohibit others from using his work without his permission. It is this negative right that typifies the nature of copyright. However, it is more easily understandable to describe the exclusive rights in a positive way by saying what the owner of copyright can do with his work instead of what he can do against unauthorized users. The Copyright Act also takes this positive approach of presentation. The law defines "copyright" as "the exclusive right to do any act in relation to the work made by the author."<sup>7</sup>

This definition is clarified by another provision that the owner of copyright shall enjoy the exclusive rights of

- (1) reproduction or adaptation;
- (2) publication;
- (3) granting benefits accruing from the copyright to other persons;
- (4) granting a license to another person to use the rights under (1) or (2), with or without imposing any condition.<sup>8</sup>

It should be explained that the rights mentioned in items (3) and (4) are not the exclusive rights *per se* in terms of copyright. They are, indeed, the positive rights of the copyright owner to exercise his exclusive rights of reproduction, adaptation and publication. By the same token, whereas the Act recognizes the assignment of copyright, the owner of copyright may assign his copyright to another person. Hence, only the rights of reproduction, adaptation and publication are to be further discussed herein.

##### 4.4.1 *Reproduction Right*

By virtue of the exclusive right of reproduction, the owner of copyright is entitled to exclude others from making copies of his work. The term "reproduction" is defined by law in a broad sense that it includes any mode of copying, imitation, duplication, block-making, sound recording, video recording or sound and video recording, from the original, duplicate or advertisement of its significant substance, whether wholly or partly.<sup>9</sup> From this definition, therefore, it is understandable that the reproduction right which is conferred by the law as a major right is broad enough to include minor rights such as the recording right and the motion picture right.

<sup>7</sup> Section 4, third paragraph.

<sup>8</sup> Section 13.

<sup>9</sup> Section 4, eleventh paragraph.

#### 4.4.2 *Adaptation Right*

The copyright owner can prohibit others from adapting his work without his permission. In other words, adaptation without authorization is an infringement. The nature of adaptation may not be clearly understood as reproduction. So, the Act defines the term "adaptation" in a lengthy manner as follows:<sup>10</sup>

"'adaptation' means a reproduction by conversion, improvement, addition or copying of significant substance from the original, but not the creation of a new work, whether wholly or partly, and

- (1) in relation to a literary work, includes a translation of a literary work, conversion of a literary work, or a collection of literary works by selection and rearrangement of their contents;
- (2) in relation to a dramatic work, includes a conversion of a non-dramatic work into a dramatic work or vice versa, whether in its original language or a different language;
- (3) in relation to an artistic work, includes a conversion of the work in a two-dimensional or three-dimensional form into a three-dimensional or two-dimensional form, or a production of a model from the original;
- (4) in relation to a musical work, includes an arrangement or transcription of tunes or an alteration of the words of a song or rhythm."

#### 4.4.3 *Publication Right*

The owner of copyright has the exclusive right to publish his protected work. Therefore, any publication made by another person of a work protected by copyright needs to be authorized by the owner of the copyright. Otherwise, the act constitutes an infringement and the infringer is subject to legal sanctions. "Publication" is defined as making the work available to the public by means of performing, lecturing, praying, playing, causing it to be heard or seen, constructing, disposing of or by any other means. The definition is broad enough to bring within it any act of public performance and broadcasting.<sup>11</sup> Therefore, the publication right can be understood as including the performing right and the broadcasting right without any necessity to mention them separately.

The above-mentioned definitions of reproduction, adaptation and publication are to be used in two circumstances: first, when the scope of the exclusive rights is to be spelled out and second, when the determination whether an act is an infringement is to be made.

#### 4.4.4 *Moral Right*

The moral right is usually referred to by its French name (*droit moral*) because it originated in French law, from whence it found its way into all continental European and Latin American laws and into the Berne Convention.<sup>12</sup> There are three basic moral rights:<sup>13</sup>

1. *Droit de divulgation* (the right of publication) is the right to decide whether the work is to be made public.
2. *Droit de paternité* (right of paternity) is the right to claim authorship of the published work.
3. *Droit au respect de l'œuvre* (right of integrity) is the right of the author to safeguard his reputation by preserving the integrity of the work.

<sup>10</sup> *Ibid.*, twelfth paragraph.

<sup>11</sup> Section 4, thirteenth paragraph.

<sup>12</sup> Stephen M. Stewart, *International Copyrights and Neighbouring Rights*, Butterworth & Co. (Publishers) Ltd., London, 1983, p. 15.

<sup>13</sup> *Ibid.*, p. 60.

Similarly, the Berne Convention endorses two prerogatives of the authors: (1) the right to claim authorship of the work; and (2) the right to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the work which would be prejudicial to the author's honor or reputation. These rights, which are generally known as the moral rights of authors, are required to be independent of the usual economic rights and to remain with the author even after he has transferred his economic rights.<sup>14</sup>

The Copyright Act refers to the moral right by providing that: "In the case where the copyright has been assigned under the second paragraph, the author still has a personal right to prohibit the assignee from distorting, abridging, adapting or doing any acts in relation to the work to such an extent as to cause injury to the reputation or goodwill of the author."<sup>15</sup> The provision consists of two significant elements. First, it emphasizes the independence of the moral right from the economic rights that, even though the copyright has been assigned to another person, the moral right still adheres to the author. Second, it affirms the so-called right of integrity of the author to safeguard his reputation. The law, however, does not say whether the author has the right to claim authorship of the work particularly by demanding that his name be shown in copies of the work or not be used in connection with the work without his permission. Moreover, being as concise as it is, the provision leaves some questions open. How long is the duration of the moral right? Does it last for the author's life or until the expiry of the economic rights? Can the moral right be transferred together with the economic rights if the author wishes to do so? Can the moral right be waived with the consent of the author? Can the author's heirs exercise this right after his death? The law remains silent on these questions and they have never been raised before the Court.

#### 4.5 Neighboring Rights

While copyright is the exclusive right granted to the author of the work, neighboring rights are the rights belonging to the person who uses his skills or technological capability to present the works to the public at large. It is the vital need of those who publicize the works to receive some legal protection for their contribution to the dissemination of those works which has gradually formulated the concept of neighboring rights. Without such legal protection, these persons would be deprived of the benefits they should have received as well as the recognition of their endeavors. It is generally accepted that neighboring rights include the rights of performers, producers of phonograms and broadcasting organizations. The right of performers is the right to prevent fixation and direct broadcasting or communication to the public of their performances without their consent. The right of producers of phonograms is to authorize or prohibit reproduction of their phonograms and the import and distribution of unauthorized duplicates. The right of broadcasting organizations is given to authorize or prohibit rebroadcasting, fixation and reproduction of their broadcasts.<sup>16</sup>

Whereas neighboring rights are directly related to copyright both in terms of the subsistence of rights and the exercise of rights, the copyright laws of most countries which adopt neighboring rights usually incorporate some or all of these rights in the same laws.<sup>17</sup> The Copyright Act never mentions neighboring rights but seems to adopt some of them as copyright. The law classifies phonograms and broadcasts as works protected by copyright. A phonogram is regarded as a kind of audiovisual work which, by definition, means a sound record, disc, audiotape, videotape or any other thing for sound and/or video recording, which is capable of being replayed, whether to be supported by the other

<sup>14</sup> Berne Convention, Article 6*bis*(1).

<sup>15</sup> Copyright Act, Section 15.

<sup>16</sup> *Background Reading Material on Intellectual Property*, World Intellectual Property Organization, Geneva, 1988, WIPO Publication No. 659(E), p. 218.

<sup>17</sup> *Ibid.*



facilities.<sup>18</sup> Likewise, a broadcast is a work according to the definition of “sound and video broadcasting work” which means a work communicated to the public by means of radio broadcasting, sound and video broadcasting on television or by similar means.<sup>19</sup> Both types of work, therefore, are clearly protected by copyright. The producers of phonograms and the broadcasting organizations as the owners of copyright can resort to legal sanctions if their copyright is infringed. The following acts against an audiovisual work protected by copyright shall constitute an infringement: (1) reproduction or adaptation; (2) publication without permission.<sup>20</sup> With respect to a sound and video broadcasting work, the law describes the acts which constitute infringement if done against the work as follows: (1) a production of cinematographic work, audiovisual work or sound and video broadcasting work, whether wholly or partly; (2) a rebroadcasting of sounds and visual images, whether wholly or partly; (3) an arrangement of the sound and video broadcasting work to be heard and/or seen by the public, by asking for money payment or other trading benefits in return.<sup>21</sup> Under the umbrella of copyright law, the producers of phonograms and the broadcasting organizations are well protected. The rights of performers, by contrast, are not mentioned in the copyright law. There is no other specific law which protects this kind of neighboring right. It is arguable whether an act which causes actual prejudice to a performer’s benefit would constitute a tort which entitles the injured person to seek legal remedies while the relevant law is silent as to this kind of right.

#### 4.6 Ownership of Copyright

The Copyright Act lays down the basic principle that the copyright vests in the author who has created the work. Since Thailand is a member of the Berne Union, the subsistence of copyright is not subject to registration or any formality. The Act, however, sets the conditions for the author to be entitled to the copyright. The conditions follow the principles of the Berne Convention and appear similar to the laws of other member countries. The conditions are established as follows:

- (1) in case the work has not been published, the author must be a Thai national or stay in Thailand at all times or most of the time during the creation of the work;
- (2) in case the work has been published, the first publication must have been effected in Thailand or the author must be qualified according to that prescribed in (1) at the time of the first publication.<sup>22</sup>

The Thai copyright law acknowledges that a juristic person can be an author of a work protected by copyright. The term “Thai national” used in the conditions mentioned above applies to either a Thai natural person or a Thai juristic person. The Nationality Act B.E. 2508 (1965) is usually referred to when the determination whether or not a natural person has Thai nationality is to be made. In case of a juristic person, the Act regards a juristic person as a Thai national if it is incorporated under the relevant law of Thailand.<sup>23</sup>

It is important to emphasize that the definition of publication used in the context of subsistence of copyright is very different from that used in relation to the exclusive rights and the infringement of copyright where publication means making the work available to the public by means of performing, lecturing, praying, playing, causing it to be heard or seen, constructing, disposing of or by any other means. But publication with respect

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<sup>18</sup> Copyright Act, Section 4, eighth paragraph.

<sup>19</sup> *Ibid.*, tenth paragraph.

<sup>20</sup> Section 25.

<sup>21</sup> Section 26.

<sup>22</sup> Section 6, first paragraph.

<sup>23</sup> *Ibid.*, second paragraph.

to the subsistence of copyright as discussed here means a disposition of the duplicated copies of a work, regardless of its form or character, with the consent of the author, by making duplicated copies available to a reasonable number of the public, having due regard to the nature of the work, but does not include a performance or display of dramatic, musical or cinematographic works, lecturing or delivering a speech on literary work, sound and video broadcasting of any work, exhibition of artistic work and construction of a work of architecture.<sup>24</sup> The meaning is, of course, given in consistency with the Berne Convention.<sup>25</sup>

The creation of the work which underlies the ownership of copyright may occur in various ways. Basically, the author may create the whole work without any reference to another work or he may cite another work or make some extractions from another work. Alternatively, the author may start with an existing work and add his intellectual input to create a new work. This kind of work is generally called a derivative work. Normally, a derivative work is in the form of either an adaptation or a collection. The author of a derivative work obtains the separate copyright in the newly created work if he has been permitted by the owner of the copyright in the existing work to use it as a source for his work. There are three provisions regarding the subsistence of copyright in a derivative work which should be read together as follows:

“In case of a work being by its nature an adaptation of the work protected by this Act and adapted with the consent of the owner of the copyright, the person making such an adaptation shall, without prejudice to the right of the owner of the copyright in the original work which is adapted, be entitled to the copyright by virtue of this Act.”<sup>26</sup>

“In case of a work being by its nature a collection or a composition of the works protected by this Act and created with the consent of the owner of the copyright, the person making such a collection or composition shall, without prejudice to the right of the owner of the copyright in the original works which are collected or composed, be entitled to the copyright by virtue of this Act.”<sup>27</sup>

“Section 6, Section 7 and Section 8 shall apply *mutatis mutandis* to the grant of copyright under Section 9 or Section 10.”<sup>28</sup>

The last foregoing provision affirms that the adaptation or the collection must fulfill the conditions of Thai nationality or creation of work in Thailand or first publication in Thailand so as to be protected by law and the contract of employment or the commission, if any, must be considered so as to point out who is the owner of the copyright in such work.

The Copyright Act establishes three exceptions to the principle that the author is the first owner of the copyright, which are as follows:

(1) *Work made in employment*: the Act adopts the Roman Law approach that, in case of a work made in employment, the employee is regarded as the author of the work and becomes the owner of the copyright in such work. Nonetheless, the Act allows the employer and the employee to agree otherwise in writing. It is possible, therefore, that the ownership of the copyright in a work made under an employment contract vests in the employer either wholly or partly if it is so agreed. The provision which supports this exception reads:

<sup>24</sup> *Ibid.*, third paragraph.

<sup>25</sup> Berne Convention, Berlin Act, 1908, Article 4, fourth paragraph.

<sup>26</sup> Copyright Act, Section 9.

<sup>27</sup> Section 10.

<sup>28</sup> Section 11.

“Unless it has been agreed otherwise in writing, the author shall be entitled to the copyright in the work he has created in his capacity of officer or employee, but the employer is entitled to cause the publication of that work in accordance with the purpose of the employment.”<sup>29</sup>

(2) *Commissioned work*: the author who creates the work is not an employee but an independent contractor who accepts to create a work which is specified and commissioned by the commissioner. In response to the question as to who is the owner of the copyright in such commissioned work, different legal systems create different legal presumptions. The United States law equates the author of a commissioned work with an employed author. The United Kingdom law creates a presumption of ownership in favor of the author but provides exceptions in the case of photographs, paintings, portraits, engravings, where the commissioner is presumed to be the copyright owner. In French law, there is a presumption in favor of the author.<sup>30</sup> The Thai Copyright Act deals with this kind of work by establishing the principle that the copyright belongs to the person who or entity which commissions the work unless the commissioner and the author can agree otherwise. The agreement, if any, is not required to be in writing. The commissioned work, therefore, draws up another exception to the basic principle that the author is the owner of the copyright in the work created by him. The relevant provision reads as follows:

“Unless the author and the commissioner have agreed otherwise, the commissioner shall be entitled to the copyright in the work which the author has been commissioned to create.”<sup>31</sup>

(3) *Work made in official duty*: since the relationship between the personnel in government service and the governmental organizations is not based on a contractual basis, the Copyright Act provides another rule with respect to the owner of the copyright in a work made by a government officer in his official duty. If the creation of the work is part of his official duty or in implementation of an order, the government unit to which the officer is attached holds the copyright in the work created by the officer. This rule applies also to a work made by a person employed by the Government and, therefore, the rule for a work made in private employment does not apply. The intent of the law is to facilitate the Government in attaining the copyright regardless of the consent of the author. However, the law allows the parties concerned to have a different settlement by consent as to the ownership of copyright. This rule is presented in the following provision:

“The Ministries, sub-Ministries, Departments or any other State or local agencies shall be entitled to the copyright in the works created under their employment or direction or control, unless it has been agreed otherwise.”<sup>32</sup>

It should be noted that State enterprises are understood to be within the meaning of “State or local agencies.”

*Co-ownership of copyright*: it is not unusual for a work to be co-authored. In that case, more than one person may hold jointly the ownership in copyright. The co-owners may agree upon the proportion of copyright of each person, otherwise it is presumed by the general rule of law that the co-owners have equal rights. Apart from the result in the co-ownership in copyright, the co-authorship also indicates the counting method of the term of protection which will be discussed later.

*Assignment of copyright*: it is a general principle that copyright is absolutely independent of ownership in the tangible medium of work. The Copyright Act does not

<sup>29</sup> Section 7.

<sup>30</sup> See Stewart, *op. cit.*, p. 65.

<sup>31</sup> Copyright Act, Section 8.

<sup>32</sup> Section 12.

provide for this principle. However, there have been a few Supreme Court decisions which interpret the law as adopting such principle. In Decision No. 2219/2531, the Court ruled that the transaction between the plaintiff, who was an artist, and the defendant was merely the selling and buying of a number of paintings and was not the transfer of the copyright in those works where there was no evidence that the parties intended to do so together with the sale of the paintings. The reproduction of the paintings by the defendant in the form of New Year cards without the plaintiff's permission was, therefore, an infringement. Likewise, in Decision No. 3830/2525, the admissible evidence indicated that the co-plaintiff in a criminal case merely bought a cinematographic film from another person without being assigned the copyright in the movie. The Court ruled that the plaintiff was not the copyright owner and could not institute the criminal action in his own name.

The copyright may be transferred from one person to another by inheritance or by a juristic act. As the estate of the deceased, the copyright may devolve on the heirs by a will or by law. The Copyright Act does not require any formality for this means of assignment. By contrast, the Act requires that the assignment of copyright by a juristic act must be made in writing. This requirement has a very important legal implication. Wherever the law requires the act to be made in writing, the transaction must be made in written form and all parties concerned must put their signatures thereon. The omission of such a formality will cause the act to be void.<sup>33</sup> The lawful assignment of copyright is referred to in the following provision:

“The copyright may be assigned from one person to another.

In an assignment of copyright to another person, the owner of the copyright may assign it wholly or partly and may assign it for a limited period of time or for the entire term of protection of the copyright.

An assignment of copyright by any means other than by succession shall be made in writing.

In the case where the copyright had been assigned under the second paragraph, the author still has a personal right to prohibit the assignee from distorting, abridging, adapting or doing any acts with respect to the work to such an extent as to cause injury to the reputation or goodwill of the author.”<sup>34</sup>

*Licensing of copyright:* the licensing of copyright means the authorization by the owner of copyright to another person to exercise the exclusive rights of the owner. In a licensing transaction, the owner becomes the licensor and the authorized person the licensee. Licensing benefits both parties. The licensee can use the work protected by copyright to the extent to which he is authorized by the license, without which such act may cause infringement. The licensor can utilize the license as an efficient tool to make an economic gain. Licensing keeps the ownership of copyright with the licensor while the assignment deprives the owner of the copyright of his exclusive rights at least for a period of time. Normally, a license benefits a copyright owner more than an assignment does.

The Copyright Act explicitly entitles the owner of copyright to license his exclusive rights of reproduction, adaptation or publication.<sup>35</sup> The Act allows the licensor to license his rights more than once if the licensing agreement does not mention otherwise in writing. The provision which supports this advantage reads:

“In the case where the owner of copyright by virtue of this Act grants a license to a person to exercise the rights under Section 13(4), and there is no written agreement imposing any specific condition, the license shall be regarded as a non-exclusive license.”<sup>36</sup>

<sup>33</sup> Civil and Commercial Code, Section 15: “An act which is not in the form prescribed by law is void.”

<sup>34</sup> Copyright Act, Section 15.

<sup>35</sup> Section 13(4).

<sup>36</sup> Section 14.

A license for a limited time is very similar to an assignment for a limited term. Both transactions authorize the licensee or the assignee to exercise the rights of the licensor or the assignor within a specified time. The only major difference is the transfer of copyright from one person to another. In a licensing transaction, the copyright still vests in the licensor-owner of the copyright. The assignment, by contrast, renders the transfer of copyright from the assignor to the assignee. This similarity may give rise to a legal problem regarding the rights and duties of the parties concerned. If the assignment is not made in writing as required by the Act, the assignment will be void. The problem is whether the parties have any legal relationship with each other under any other transaction although the assignment is invalid. There is a provision in the law on contracts which can apply to this issue and may give a positive answer. The law reads, "If a void act complies with the requirements of another act, it is valid as the other act, if it may be assumed that such validity would have been intended by the parties had they known of the invalidity of the intended act."<sup>37</sup> Based upon this law, if the content of the assignment contract also serves as that of a licensing agreement and it can be assumed that the parties would have expected to be bound by a license if they had known that the assignment would not be valid, the invalid assignment contract becomes effective as a licensing agreement and the relationship between the parties is that of licensor-licensee.

#### 4.7 Limitations on Copyright Protection

In simple language, copyright is granted to an author as a reward for his intellectual input in the creation of a work which eventually benefits society at large. However, it is a reality that there is a conflict of interest between two groups of people—the authors on the one hand and the users of the work on the other. The authors, of course, want their works to be strictly protected for as long as possible while the users want to make use of the works conveniently and as soon as possible. The legislation, therefore, must establish a balance of interest between the authors and the public. The basic strategy is that, by conferring the exclusive rights on the owner of the copyright, the law also imposes some limitations on the enforcement of copyright with the purpose of ensuring that the public has some lawful access to the work. The limitations cover a number of aspects and they seem to be widely accepted in the copyright laws of most countries. Generally, major limitations of copyright protection refer to these three aspects: temporal, geographic and permitted use. The Thai Copyright Act also adopts these limitations. The details of each limitation are as follows.

##### 4.7.1 *Temporal*

The temporal limitation of copyright protection means that the copyright is protected for a period of time. The Act prescribes the duration of copyright in Sections 13 to 22. The term of protection follows the framework set by the Berne Convention (Berlin Act), which states:

"The term of protection granted by the present Convention shall include the life of the author and 50 years after his death.

Nevertheless, in case such term of protection should not be uniformly adopted by all the countries of the Union, the term shall be regulated by the law of the country where protection is claimed, and must not exceed the term fixed in the country of origin of the work. Consequently the contracting countries shall only be bound to apply the provisions of the preceding paragraph insofar as such provisions are consistent with their domestic laws.

For photographic works and works produced by a process analogous to photography, for posthumous works, for anonymous or pseudonymous works, the term of protection shall be regulated by the law of the country where protection

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<sup>37</sup> Civil and Commercial Code, Section 136.

is claimed, provided that the said term shall not exceed the term fixed in the country of origin of the work."<sup>38</sup>

In compliance with Article 7, first paragraph, of the Berne Convention (Berlin Act), the Act provides the general term of copyright that:

"Subject to Section 18 and Section 19, the copyright in a work by virtue of this Act shall subsist for the life of the author and shall continue to subsist until the end of a period of 50 years from the death of the author.

In case of a work of joint authorship, the copyright in such work shall subsist for the life of the joint authors and shall continue to subsist until the end of the period of 50 years from the death of the last surviving joint author.

If the author or every joint author is dead before the publication of the work, the copyright shall subsist for a period of 50 years from the date of its publication."<sup>39</sup>

The Berne Convention allows member countries to regulate different terms of protection if the general terms are not adopted and if the terms of protection for particular types of work, namely, photographic works and works produced by a process analogous to photography, posthumous works, anonymous works and pseudonymous works are to be fixed.<sup>40</sup> Hence, the Act deals separately with the terms of protection for works created by juristic persons, works made on official duty and works mentioned specifically in the Berne Convention. The term is not tied to the author's life. The following are the terms of copyright which differ from the basic term of author's life plus 50 years.

*Work created by a juristic person:* the copyright shall subsist for 50 years from the date of creation, but if the work is published during the said period, the copyright shall continue to subsist for 50 years from the date of first publication.<sup>41</sup>

*Pseudonymous and anonymous work:* the copyright shall subsist for 50 years from the date of creation, but if the work is published during the said period, the copyright shall continue to subsist for 50 years from the date of first publication.<sup>42</sup>

*Photographic, audiovisual, cinematographic, sound and video broadcasting work:* the copyright shall subsist for 50 years from the date of creation, but if the work is published during the said period, the copyright shall continue to subsist for 50 years from the date of first publication.<sup>43</sup>

*Work of applied art:* the copyright shall subsist for 25 years from the date of creation, but if the work is published during the said period, the copyright shall continue to subsist for 25 years from the date of first publication.<sup>44</sup>

*Work made in employment or in official duty:* the copyright shall subsist for 50 years from the date of creation, but if the work is published during the said period, the copyright shall continue to subsist for 50 years from the date of first publication.<sup>45</sup>

The above-mentioned publication, which is a milestone for the calculation of the term of protection, means publication with the consent of the owner of the copyright.<sup>46</sup>

<sup>38</sup> Berne Convention, Berlin Act, 1908, Article 7.

<sup>39</sup> Copyright Act, Section 16.

<sup>40</sup> Berne Convention, Berlin Act, 1908, Article 7, second and third paragraphs.

<sup>41</sup> Copyright Act, Section 16, fourth paragraph.

<sup>42</sup> Section 17.

<sup>43</sup> Section 18.

<sup>44</sup> Section 19.

<sup>45</sup> Section 20.

<sup>46</sup> Section 21.

In order to abolish the difficulty of identifying the exact date of termination of the copyright due mainly to its long-lasting nature, the Act presumes the last day of the calendar year in which the copyright comes to an end as the date of termination, unless the exact date of termination can be shown.<sup>47</sup>

It is a principle of copyright law that when the copyright comes to a conclusion, the work falls into the public domain and no one can claim exclusive rights in it. This principle undoubtedly fosters public interest. The Act confirms this doctrine with a provision which reads:

“The publication of any work protected by copyright after the termination of the term of protection of copyright shall not give rise to the revival of copyright in that work.”<sup>48</sup>

The doctrine of “falling into the public domain” was likewise adopted in the former Thai copyright laws and could be seen in a few Supreme Court Decisions.<sup>49</sup>

#### 4.7.2 Geographic

According to the Copyright Act, the geographical limitation is to be considered in two circumstances: the acquisition of copyright and the exercise of copyright. With respect to the acquisition of copyright, the geographical limitation takes effect as a condition that the work must be created or first published in Thailand. This condition appears in a relevant provision which reads:

“The author shall be entitled to copyright in the work he has created under the following conditions:

(1) in the case where the work has not been published, the author must be a Thai national *or stay in Thailand at all times or most of the time during the creation of the work*;

(2) in the case where the work has been published, *the first publication must have been effected in Thailand* or the author must be qualified according to that prescribed in (1) at the time of the first publication.”<sup>50</sup>

The limitation in the exercise of copyright means that the protection is effective within Thai jurisdiction only and the owner of copyright can enforce his rights against the infringing acts which are committed within Thailand. By contrast, the owner of copyright cannot take any action against the unauthorized use of his work in another country unless the work is protected by the law of that country. It should be noted, however, that these limitations may not exist if the countries concerned, i.e., the country of origin of the work and the country where the protection is claimed, are party to an international convention for copyright protection.<sup>51</sup> As Thailand is party to the Berne Convention, the criteria for the protection of foreign works will be discussed separately later.

#### 4.7.3 Permitted Use

The doctrine of so-called “fair use”<sup>52</sup> or “fair dealing”<sup>53</sup> is another form of limitation of copyright protection. It permits other persons to use the work protected by copyright

<sup>47</sup> Section 22.

<sup>48</sup> Section 23.

<sup>49</sup> Decisions No. 881/2472 (literary work) and No. 848/2519 (musical work).

<sup>50</sup> Copyright Act, Section 6.

<sup>51</sup> The two major worldwide conventions are the Berne Convention for the Protection of Literary and Artistic Works and the Universal Copyright Convention.

<sup>52</sup> The term used in the United States Copyright Act 1976.

<sup>53</sup> The term used in United Kingdom Copyright Act 1956.

to the extent that is allowed by law even without the authorization of the copyright owner. The permissible acts are deemed lawful and, consequently, do not constitute infringements. This type of limitation is intended to be another way, in addition to the duration of copyright, of helping to set a balance of interest between the owners of copyright and the public. This limitation becomes very meaningful to the users of the work. Without the limitation, the public will have access to the work only after the copyright comes to an end when the work may no longer be contemporarily beneficial to the public.

The Copyright Act adopts the doctrine of fair use under the heading "Exceptions to Infringement of Copyright," which comprises Sections 30 to 41.<sup>54</sup> The acts which are deemed to be exempt from infringing acts are described as follows:

(a) An act which is done to the work protected by this Act shall not constitute an infringement of copyright insofar as such act is done with any of the following purposes:

- (1) research or study;
- (2) use for one's own benefit or use for one's own benefit and for the benefit of members of one's family, or relatives and friends;
- (3) criticism, comment or review of the work accompanied by an acknowledgment of the ownership of the copyright in such work;
- (4) report of current events through the mass media, accompanied by an acknowledgment of the ownership of copyright in such work;
- (5) reproduction, adaptation, exhibition or making available for the purpose of judicial or administrative proceedings under the law, or for the purpose of reporting the said proceedings;
- (6) reproduction, adaptation, exhibition or making available by a teacher for teaching purposes;
- (7) copying, duplicating, adapting a part of such work or abridging or making a summary by a teacher or educational institution according to the suitability of purposes and to the necessary quantity, for distributing or selling to students in the class or in an educational institution; provided that it shall not be made for profit and shall not cause inappropriate prejudice to the owner of the copyright, having due regard to the fairness in conferring benefits on the owner of the copyright and in providing education to the public;
- (8) use the work as a part of questions and answers in an examination.<sup>55</sup>

(b) A citation or extract from, duplication or imitation of or reference reasonably to a work protected by this Act with an acknowledgment of the ownership of the copyright in such work shall not constitute an infringement.<sup>56</sup>

(c) A reproduction of a work protected by this Act made by a librarian for non profit-making purposes shall not constitute an infringement in the following cases:

- (1) reproduction for use in the library or other libraries;
- (2) reasonable reproduction of some parts of a work for another person to use in research or study;

The quantity of copies reproduced must not exceed the number required with due regard to suitability.<sup>57</sup>

(d) A publication of an audiovisual or cinematographic work suitably made for profit-making purposes shall not constitute an infringement in the following cases:

<sup>54</sup> Except Section 32, which deals with non-copyright matters.

<sup>55</sup> Copyright Act, Section 30.

<sup>56</sup> Section 31.

<sup>57</sup> Section 33.



- (1) the publication is for entertaining the people who use the service of a restaurant, hotel, resort, transport station or vehicle;
- (2) the publication is made for entertainment by an association, foundation or other organization having a charitable, educational, religious or social-welfare purpose.<sup>58</sup>

(e) The drawing, painting, construction, engraving, sculpturing, carving, lithographing, photograph-taking, movie-taking, video-broadcasting or any similar act of an artistic work, except an architectural work which is located in public, shall not constitute an infringement of copyright in such artistic work.<sup>59</sup>

(f) The drawing, painting, engraving, sculpturing, carving, lithographing, photograph-taking, movie-taking or video-broadcasting of a work of architecture shall not constitute an infringement of copyright in such work of architecture.<sup>60</sup>

(g) The photograph-taking or movie-taking or video-broadcasting of any work in which an artistic work is a component shall not constitute an infringement of copyright in such artistic work.<sup>61</sup>

(h) In case the copyright in an artistic work is jointly owned by a person other than the author, a subsequent creation of an artistic work in such a manner as to be a reproduction of a part of the former work or use of the pattern, sketch, plan, model or data derived from a study used in the creation of the former artistic work shall not constitute an infringement of copyright in such artistic work if it appears that the author does not reproduce or copy the original artistic work in its material form.<sup>62</sup>

(i) The restoration of a building being a work of architecture shall not constitute an infringement.<sup>63</sup>

(j) The publication of a cinematographic work after the term of copyright in such work has ended shall not constitute an infringement of copyright in the literary work, dramatic work, artistic work, musical work, audiovisual work or any work used in creating the cinematographic work.<sup>64</sup>

(k) The reproduction of a work protected by this Act for any person which is done by an official or in accordance with an order issued by an official while the work is in the possession of a government service shall not constitute an infringement of copyright in such work.<sup>65</sup>

There have been two comments with respect to the exceptions to infringement. The first comment deals with misplacement of the general criteria for fair use. It can be seen that the general criteria are mentioned specifically in item (7) of Section 30, which reads:

“(7) copying, duplicating, adapting a part of such work or abridging or making a summary by a teacher or educational institution according to the suitability of purposes and the necessary quantity, for distributing or selling to students in the class or in an educational institution; *provided that it shall neither be made for profit nor cause inappropriate prejudice to the owner of the copyright, having due regard to the fairness in conferring benefits on the owner of the copyright and to providing education to the public.*”

<sup>58</sup> Section 34.

<sup>59</sup> Section 35.

<sup>60</sup> Section 36.

<sup>61</sup> Section 37.

<sup>62</sup> Section 38.

<sup>63</sup> Section 39.

<sup>64</sup> Section 40.

<sup>65</sup> Section 41.

Written this way, such criteria may be understood as applying only to acts with certain purposes as specified in item (7) but not applying to the cases given in items (1) to (6) and (8). Such understanding, however, seems to be inconsistent with the concept of fair use. It is suggested that this defect be treated by providing the general criteria or framework to be used in the consideration of fair use in the first paragraph so that they can generally apply in all cases. A solution in this manner, of course, requires the amendment of Section 30. The second comment was made against the justification of Section 34 which legalizes the fair use of audiovisual and cinematographic works subject to certain conditions.<sup>66</sup>

#### 4.8 Infringement

Infringement is directly related to the exclusive rights of the owner of copyright. Basically, infringement occurs when each or all of the exclusive rights are exercised by another person without permission from the copyright owner. For example, the owner of copyright has an exclusive right to reproduce his work. Anyone who reproduces such work without his authorization commits an infringement of that copyright. In other words, such unauthorized act becomes an infringing act.

According to the Copyright Act, there are two levels of infringement—primary and secondary. Primary infringement is an act with respect to a protected work by an unauthorized person in the same manner as the exercise of exclusive rights by the owner of the copyright. On the other hand, the secondary infringement covers the subsequent acts against the protected work after the occurrence of the primary infringement.

##### (a) Primary infringement

The law comprises a general rule on primary infringement and two specific provisions for infringement against particular types of work.

The general rule is provided as follows:

“Any of the following acts with respect to the work protected by this Act shall constitute an infringement of copyright:

- (1) reproduction or adaptation;
- (2) publication without permission in accordance with Section 13.”<sup>67</sup>

The acts which are deemed infringing acts by virtue of this provision are certainly the same acts which the owner of copyright has the exclusive rights to perform. Therefore, the definitions of the terms “reproduction,” “adaptation” and “publication” which were cited under 4.4 (Rights Comprised in Copyright), above, also apply to this matter. For the sake of convenience, those definitions are reiterated below:<sup>68</sup>

“*reproduction*’ includes any mode of copying, imitation, duplication, block-making, sound recording, video recording or sound and video recording, from the original, duplicate or advertisement of its significant substance, whether wholly or partly;

“*adaptation*’ means a reproduction by conversion, improvement, addition or copying of significant substance from the original, but not creation of a new work, whether wholly or partly, and

- (1) in relation to a literary work, includes a translation of literary work, conversion of literary work, or collection of literary works by selection and rearrangement of their contents;

<sup>66</sup> See Section 34 at (d), *supra*.

<sup>67</sup> Section 24.

<sup>68</sup> Section 4, eleventh, twelfth and thirteenth paragraphs.

(2) in relation to a dramatic work, includes a conversion of the version of a non-dramatic work into a dramatic work or vice versa, whether in its original language or a different language;

(3) in relation to an artistic work, includes a conversion of the work in a two-dimensional or three-dimensional form into a three-dimensional or two-dimensional form, or a production of a model from the original;

(4) in relation to a musical work, includes an arrangement or transcription of tunes or an alteration of the words of song or rhythm; '*publication*' means making the work available to the public by means of performing, lecturing, praying, playing, causing it to be heard or seen, constructing, disposing of or by any other means."

Apart from the general rule regarding the infringement of copyright, there are two additional provisions which apply only to infringement of certain types of work. The first provision applies to infringement of an audiovisual work or a cinematographic work and the second deals particularly with infringement of a sound and video broadcasting work.

(1) *Infringement of an audiovisual work or a cinematographic work*: any reproduction, adaptation or publication without permission whether of the sound and/or visual images shall constitute an infringement of copyright.<sup>69</sup> The reason for the separation of this provision from the general rule is that there are particular exceptions to infringement of these types of work in another provision.<sup>70</sup>

(2) *Infringement of a sound and video broadcasting work*: any of the following acts shall constitute infringement of copyright:

- (i) a production of cinematographic work, audiovisual work or sound and video broadcasting work, whether wholly or partly;
- (ii) a rebroadcasting of sound and visual images, whether wholly or partly;
- (iii) an arrangement of the sound and video broadcasting work to be heard and/or seen by the public, by charging money or other commercial benefits.<sup>71</sup>

The infringement with respect to a sound and video broadcasting work is specifically provided because the ordinary infringing acts may hardly cover certain acts which ought to be infringing acts against this work.

*(b) Secondary infringement*

Being distinguishable from primary infringement, secondary infringement takes place when certain acts are done with the materials which derive from primary infringement. The purpose of the law to make such act an infringement is understood as a mechanism to block the channels through which the illegal copies of a work may be distributed. The Copyright Act includes a single provision with regard to the secondary infringement which reads:

"Any person who performs any of the following acts with respect to the matters which are made in infringement with his knowledge shall be deemed to infringe copyright:

- (1) selling, leasing, selling by hire purchase or offering for sale, lease or sale by hire purchase;
- (2) making a publication;
- (3) distributing in such a manner as to be prejudicial to the owner of the copyright;

<sup>69</sup> Section 25.

<sup>70</sup> Section 34. See 4.7.3 (Permitted Use) in 4.7 (Limitations on Copyright Protection).

<sup>71</sup> Section 26.

(4) importing or placing an order for importation into the country for any purpose except for private use.”<sup>72</sup>

To date, there have been a number of infringement cases which have been decided by the Supreme Court. All of them deal with the issue of primary infringement. Here are the references of those cases: Decisions Nos. 466/2478, 974/2478, 125/2485, 1263/2496, 1016/2497, 508/2508, 408/2510, 2358/2520, 96/2523.

#### 4.9 Remedies

According to the Thai legal system, there are three types of remedies which are available to persons whose copyright has been infringed. The owner of copyright can take civil action in order to seek civil redress. He is also entitled to seek urgent remedy from an injunction granted by the court which has accepted his civil case. In addition, the Thai law empowers the owner of copyright to take criminal action against the infringement.

##### 4.9.1 Civil Action

The Copyright Act specifies the acts which constitute infringement. However, it does not say anything about the legal remedies which the owner of copyright in a civil case can seek. Indeed, it is the Civil and Commercial Code that plays an important role in an infringement case. An infringement case is usually instituted under the umbrella of the tort law or the so-called “law on wrongful acts.” The principle of law is enacted: “A person who, willfully or negligently, unlawfully injures the life, body, health, liberty, property or any right of another person, is said to commit a wrongful act and is liable to make compensation therefor.”<sup>73</sup> The civil law empowers a competent court to grant appropriate legal remedies depending on the nature and harshness of the wrongful acts.<sup>74</sup> In an infringement case, the role of the Copyright Act is to recognize the copyright as a legal right and to identify the acts of infringement. Since copyright is a legal right recognized by law, it comes within the purview of the tort law whenever the right is infringed. The laws on wrongful acts apply to copyright infringement cases unless the Copyright Act sustains specific provisions for it. The remedies which the court in a civil action usually grants to the plaintiff are damages, an order to stop the infringement, and an order to the defendant to remove the infringing copies from the market. The claim for damages seems to be a problem for the plaintiff because it is very difficult to prove his actual damages. The court has to exercise its discretion in awarding an amount of damages which it thinks suitable.

In a civil case, the Copyright Act makes some presumptions as to the owner of the copyright that has been infringed. The presumptions are, of course, rebuttable, and are available in the following three cases:

(a) it is presumed that the work in dispute is a work protected by the Copyright Act and that the plaintiff is the owner of the copyright in such work, unless the defendant argues otherwise;<sup>75</sup>

(b) it is presumed that the person whose name or nominal symbol appearing on the work and who claims copyright in the work is the author of such work;<sup>76</sup>

(c) it is presumed that the printer or the publisher or the printer and publisher of the work, which bears no name or nominal symbol of any person or bears a name or a nominal symbol of a person who does not claim copyright in the work and bears

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<sup>72</sup> Section 27.

<sup>73</sup> Civil and Commercial Code, Section 420.

<sup>74</sup> *Ibid.*, Section 438.

<sup>75</sup> Copyright Act, Section 28, first paragraph.

<sup>76</sup> *Ibid.*, second paragraph.

a name or a nominal symbol of a person who claims to be the printer or the publisher or the printer and publisher, is the owner of the copyright in such work.<sup>77</sup>

The time limitation for a civil action is specifically prescribed by the Copyright Act. No action for infringement of copyright can be filed later than three years from the day the owner of the copyright becomes aware of the infringement and of the infringer, provided that the action is instituted not later than 10 years from the date of infringement of the copyright.<sup>78</sup> The general time limitation for a tort case, therefore, does not apply to a copyright infringement case. The specific time limitation provided by the Copyright Act is more advantageous to the owner of copyright than the general term because it is longer than the latter, which provides for a one-year limitation from the time the injured person becomes aware of the wrongful act and the tortfeasor and subject to a maximum of 10 years from the date of the wrongful act.<sup>79</sup>

#### 4.9.2 *Injunction*

In a civil case, the plaintiff can seek an injunction from the competent court to avail himself of temporary protection prior to the judgment. The conditions and nature of protection are set forth in the Code of Civil Procedure. A civil action for copyright infringement must be processed under the procedural code and the plaintiff is entitled to seek a temporary injunction. According to the law, the plaintiff in an infringement case may petition the competent court at the time he files his complaint or at any time before the judgment to request an injunction to prohibit the defendant from continuing the infringement or to stop or prevent the disposal, destruction, transfer, sale, mobilization or distribution of any property in dispute.<sup>80</sup> The court may order the plaintiff to deposit an amount of money as security for the compensation for any damage which the defendant may unduly suffer from the grant of an injunction.<sup>81</sup> If the court is satisfied with the admissible evidence that the defendant intends to continue infringing or to transfer or sell or distribute his property or to mobilize it outside the court's jurisdiction or that the property in dispute is to be used up, destroyed or transferred to another person, the court may grant an injunction.<sup>82</sup> In case of emergency, the law allows the plaintiff to ask for the urgent issuance of an injunction to prevent imminent or further damage.<sup>83</sup>

It should be noted that the plaintiff in an infringement case cannot seek an injunction before his complaint is filed. The Thai legal system does not make available a court order in the same manner as the so-called "Anton Piller Order," which is available in some common law countries.<sup>84</sup>

#### 4.9.3 *Criminal Action*

An infringement of copyright also constitutes a criminal offense. The Copyright Act imposes penalties for different levels of offense. To enforce criminal sanctions, the owner of copyright may either file a law suit in a competent court or request the police authorities to arrest the infringer and search for and seize the illegal works. Whichever channel of legal sanctions is chosen, the owner of copyright is bound by a time frame which results from the fact that the offense is deemed by the Act to be a compoundable offense, which means that a settlement to abandon the case can be reached any time

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<sup>77</sup> *Ibid.*, third paragraph.

<sup>78</sup> Section 29.

<sup>79</sup> Civil and Commercial Code, Section 448.

<sup>80</sup> Code of Civil Procedure, Section 254.

<sup>81</sup> Section 257.

<sup>82</sup> Section 255.

<sup>83</sup> Section 266.

<sup>84</sup> See *Background Reading Material on Intellectual Property, op. cit.*, pp. 226 and 227.

before the final judgment.<sup>85</sup> The owner of copyright must file his criminal action or notify the police within three months from the day the offense and the offender become known to him, otherwise the criminal sanctions will be barred by prescription.<sup>86</sup> However, if the owner of copyright has notified the police, the period for bringing an action to court becomes five years as from the date of the offense.<sup>87</sup>

If the owner of the copyright notifies the police of the offense, the police can issue a search warrant which authorizes them to search relevant premises and to seize illegal copies. This is an efficient way to restrain the infringement as quickly as possible.

The Copyright Act provides for the offenses and penalties as follows:

(a) primary infringement is a criminal offense the penalty for which is a fine ranging from 10,000 to 100,000 baht. If, however, the offense is committed for a commercial purpose, the penalty is either a fine ranging from 20,000 to 200,000 baht or imprisonment not exceeding one year and a fine ranging from 20,000 to 200,000 baht;<sup>88</sup>

(b) secondary infringement is a criminal offense for which the penalty is a fine ranging from 5,000 to 50,000 baht. If, however, the offense is committed for a commercial purpose, the penalty is either a fine ranging from 10,000 to 100,000 baht or imprisonment not exceeding six months and a fine ranging from 10,000 to 100,000 baht.<sup>89</sup>

According to the Code of Criminal Procedure, the owner of the copyright is the injured person who can institute the suit or the notification. Another person may be able to lodge a criminal case if he is authorized to do so by the owner of copyright. If it is determined in a criminal case that the person claiming to be the injured person is not the owner of the copyright, the court can dismiss the case without dealing with the issue of infringement.<sup>90</sup>

Although the general provisions in the Penal Code can apply to offenses under other laws, the Copyright Act contains some special sanctions which particularly apply to a criminal offense of infringement. These specific measures are provided as follows:

(a) any person who, having been convicted of an offense of infringement, commits another offense within five years from the date he completes his punishment, shall be liable to a double penalty;<sup>91</sup>

(b) if a juristic person commits an offense of infringement, every director or manager of such entity shall be regarded as a joint offender with the juristic person, unless he can prove that such act was done without his knowledge or consent;<sup>92</sup>

(c) materials made or imported into the country which constitute an infringement of copyright and which are still owned by the offender shall become the property of the owner of the copyright. Articles used in the commission of an offense shall be forfeited;<sup>93</sup>

(d) one half of the fine shall be paid to the owner of the copyright, but the payment shall not be prejudicial to the right of the owner of the copyright to bring a civil action for actual damages beyond such amount.<sup>94</sup>

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<sup>85</sup> Copyright Act, Section 48.

<sup>86</sup> Penal Code, Section 96.

<sup>87</sup> Section 95.

<sup>88</sup> Copyright Act, Section 43.

<sup>89</sup> Section 44.

<sup>90</sup> For example, Supreme Court Decision No. 3830/2525.

<sup>91</sup> Copyright Act, Section 45.

<sup>92</sup> Section 46.

<sup>93</sup> Section 47.

<sup>94</sup> Section 48.

#### 4.10 Protection of Foreign Work

The Copyright Act gives protection to a foreign work in two ways. Protection may be available to a foreign author if he spends all or most of his time creating the work in Thailand or he first publishes the work in Thailand. This method of protection was discussed in topic 4.6 (Ownership of Copyright). The other method of protection is through the international system of copyright protection in which Thailand is involved.

Thailand first joined the international copyright system when it acceded to the Berne Convention for the Protection of Literary and Artistic Works in 1931. It is the only multilateral convention on copyright protection of which Thailand is a contracting party. Thailand chose to be bound by the Berlin Act, 1908, with some reservations. Prior to admission to the Berne Union and the Berne Convention, Thailand passed the Act for the Protection of Literary and Artistic Works B.E. 2474 (1931) in order to fulfill the requirement of the Berne Convention that a contracting country had to make provisions for the protection of the works mentioned in the Convention.<sup>95</sup> The 1931 Act, which has been in force since June 16, 1931, was replaced by the present Copyright Act of 1978. At the time it came into force, the 1931 Act included a part on international copyright which was to take effect on Thailand becoming a member of the Berne Union. Thailand became a party to the Berne Convention and a member of the Berne Union on July 16, 1931.

In acceding to the Berne Convention, Thailand made six reservations, which are briefly stated below:

- (1) Article 2, fourth paragraph, of the Berlin Act, 1908 (*protection of works of art applied to industry*), is replaced by Article 4 of the Berne Convention, 1886, which does not include these works among literary and artistic works;
- (2) Article 4, second paragraph, of the Berlin Act, 1908, is replaced by Article 2, second paragraph, of the Berne Convention, 1886, in respect of compliance with the *conditions and formalities* required by the law of the country of origin of the work;
- (3) Article 8 of the Berlin Act, 1908, is replaced by Article 5 of the Berne Convention, 1886, as modified by Article 1(III), of the Paris Additional Act, 1896, in respect of the exclusive right of authors to make or to authorize translation of their works;
- (4) Article 9 of the Berlin Act, 1908, is replaced by Article 7 of the Berne Convention, 1886, as modified by Article 1(IV), of the Paris Additional Act, 1896, in respect of the reproduction of articles published in newspapers or periodicals;
- (5) Article 11 of the Berlin Act, 1908, is replaced by Article 9 of the Berne Convention, 1886, and point 2 of the Final Protocol of the latter, in respect of the right of *public performance of dramatic, dramatico-musical and musical works*;
- (6) Article 18 of the Berlin Act, 1908 (*application of this Convention to works not yet in the public domain in their country of origin at the date of the entry into force of the Convention*), is replaced by Article 14 of the Berne Convention, 1886, and point 4 of the Final Protocol of the latter, as modified by Article 2(II), of the Paris Additional Act, 1896.

The Copyright Act B.E. 2521 (1978), which repeals and replaces the Act for the Protection of Literary and Artistic Works B.E. 2474 (1931), inherits international copyright protection. The Act, however, contains only a single provision which lays down major criteria for the protection of foreign works. The Act leaves the conditions of the protection to be set forth by a Royal Decree. The provision in relation to international copyright, which is based on the principle of national treatment, reads:

<sup>95</sup> Berne Convention, Berlin Act, 1908, Article 2, third paragraph.

“Any work protected by the copyright law of a Contracting State of the Convention for the protection of copyright of which Thailand is also a Contracting State and the law of such country extends reciprocal protection to the works of other Contracting States of the Convention or to a work of an international organization of which Thailand is a member, shall be protected by this Act *subject to the conditions laid down by Royal Decree.*”<sup>96</sup>

In 1980, Thailand adjusted its accession to the Berne Convention by adopting the administrative clauses of the Paris Act, 1971 (Articles 22 to 38), instead of those in the Berlin Act, 1908. The new accession took effect on December 29, 1980.

The Royal Decree Providing Conditions for the Protection of International Copyright B.E. 2526 (1983), which was enacted by virtue of the Copyright Act, entered into force on February 10, 1983, and has been effective since then. The Royal Decree performs two basic functions. First, it elaborates a general term used in the Act. The term “Convention” in the Act is defined as “the International Convention for the Protection of Literary and Artistic Works, concluded at Berne in September 1886, revised at Berlin on November 13, 1908, and completed by the Additional Protocol signed at Berne on March 20, 1914.”<sup>97</sup> The Act seems to emphasize the substantive aspects of the protection as it does not mention the Paris Act, 1971, for the administrative clauses in the definition. Second, the Royal Decree sets forth the conditions for the protection. The conditions are formulated by some connecting factors with a Contracting State of the Convention, namely, nationality of the author, country of creation of the work, country of first publication.

The Royal Decree provides the conditions for the protection of a foreign copyright as follows:

“(1) In case of an unpublished work, the author must be a national or subject of a Contracting State of the Convention, or the author must have a habitual residence in a Contracting State of the Convention at all times or most of the time of the creation.

In case of a published work, the first publication must have been made in a Contracting State of the Convention.

(2) Such work must be in compliance with the conditions and means provided by the copyright law of the country of origin.”<sup>98</sup>

The foregoing condition in paragraph (2) is the recognition of a reservation where Thailand chose not to be bound by Article 4, second paragraph, of the Berlin Act, 1908, which provides that “The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise are independent of the existence of protection in the country of origin of the work.” Article 2, second paragraph, of the Berne Convention of 1886 reads, “*The enjoyment of these rights shall be subject to the accomplishment of the conditions and formalities prescribed by law in the country of origin of the work...*”

The Royal Decree defines the “country of origin” as

“(1) the country of which the author is a national or subject or in which the author has an habitual residence at all times or most of the time of creation, in case the work is unpublished;

(2) the country of first publication, in case the work is published;

(3) the country where its law gives the shortest term of protection, in case the work is published simultaneously in several Contracting States of the Convention;

<sup>96</sup> Section 42.

<sup>97</sup> Royal Decree, Section 3, first paragraph.

<sup>98</sup> Section 4.



(4) the Contracting State of the Convention, in case the work is published simultaneously in a Non-Contracting State and in a Contracting State of the Convention."<sup>99</sup>

As to the term of protection, the Royal Decree provides that the foreign work shall enjoy the term of protection given by the law of the country of origin but not exceeding the term of protection under the Thai copyright law.<sup>100</sup> Again, this provision is the implementation of a reservation where Article 4, second paragraph, of the Berlin Act, 1908, is replaced by Article 2, second paragraph, of the 1886 Convention, which results in the obligation of Thailand to grant a term of protection no longer than that granted in the country of origin.

Another reservation which is explicitly shown in the Royal Decree concerns the cessation of the exclusive right of translation after the lapse of 10 years from the date of first publication. The reservation derives from the adoption of Article 5 of the Berne Convention 1886 as modified by Article 1(III), of the Paris Additional Act, 1896, to replace Article 8 of the Berlin Act, 1908. As regards this matter, the Royal Decree provides that:

"In case of a literary or dramatic work, if the owner of copyright does not make or authorize the translation into the Thai language and publish such translation in Thailand within 10 years from the last day of the calendar year of first publication of such literary and dramatic work, the exclusive right of reproduction, adaptation or publication of the translation in Thailand shall cease."<sup>101</sup>

There has been a long-lasting controversy regarding other reservations which are not written in the Royal Decree. The problem is whether those reservations are still in effect. One opinion is shown that they still exist because Thailand has never shown its intention to cancel them. The other opinion, however, is that the particular reservations which are not incorporated in the law are ineffective because they are merely international formalities but are not regarded by the legal system as enforceable as legal norms. The issue is still being debated and is in need of judicial clarification.

There have been some cases involving international copyright. However, those cases did not deal with substantive issues but with procedural issues.<sup>102</sup> Due to the lack of judicial precedents, it is still a normal situation in Thailand that there are a number of problems in the area of the protection of international copyright which have not met determinative answers.

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<sup>99</sup> Section 3, second paragraph.

<sup>100</sup> Section 5, first paragraph.

<sup>101</sup> Section 5, second paragraph.

<sup>102</sup> Supreme Court Decisions Nos. 2358/2520, 89/2521 and 1637/2531.

## **CHAPTER 5**

### **ADMINISTRATION OF INTELLECTUAL PROPERTY**

#### **SYNOPSIS**

**5.1 Administrative Structure in the Industrial Property Offices**

**5.2 Patent Office**

**5.3 Trademark Office**

### 5.1 Administrative Structure in the Industrial Property Offices

Formerly, patents and trademarks were handled by the Patent and Trademark Division in the Department of Commercial Registration, Ministry of Commerce. As a result of the rapid increase in applications for the registration of inventions, designs and trademarks, the Division was split into two, namely, the Patent Division and the Trademark Division. At present, the two Divisions are attached to the newly established Department of Intellectual Property.

Both Divisions are government units. The personnel working on the examination and the registration of patents and trademarks are all government officials. The Divisions operate in accordance with the relevant Acts, Ministerial Regulations, Department's Announcements and the Division's orders. The fees are fixed by law but may be adjusted not exceeding the existing rates, be reduced or waived by Ministerial Regulations which must be published in the Government Gazette.

The decisions or orders with respect to applications for the registration of patents or trademarks may be appealed to the Patent Board or the Trademark Board, as the case may be. The Boards mainly function as reviewing bodies. The Under-Secretary of State for Commerce chairs the Patent Board with 12 or less other members to be appointed by the Cabinet. The Trademark Board is chaired by the Director-General of the Department of Intellectual Property, with not more than six members to be appointed by the Cabinet. Although the chair persons of the two Boards are high-ranking government officials, other members may consist of distinguished persons not in government service. The ruling of the Trademark Board and the Patent Board can be appealed to the court. The final judgment will bind the registration authority.

### 5.2 Patent Office

#### (a) Tasks

The Patent Division in the Department of Intellectual Property, Ministry of Commerce, functions as the patent office. Its main task is to receive and to examine applications for patents for invention or design patents and whether or not a patent should be granted. During the registration process, it may have to deal with oppositions to registrations from any interested persons. The publication of the application is another important task of the Patent Division. After that, the Division is responsible for the substantive examination of the invention or the design. The Patent Office also assumes the duty to instruct the applicant to pay the fee before the patent is granted and the annual fee after the patent has been granted.

#### (b) Examination as to form

Upon receiving the patent application, the competent officer of the Division has to check whether the application form has been completely filled in and has been prepared in compliance with the regulations which consist mainly of the Ministerial Regulations of 1979 and 1980. In case of insignificant defects or errors, the applicant will be permitted to correct them. If the applicant does not correct the application as instructed by the officer, it will be refused. The office also has to check whether the applicant has paid the application fee.

#### (c) Publication of the application

When the Director-General orders the publication of the application, the officer will instruct the applicant to pay the publication fee. After the payment is duly made, the application will be published.

#### (d) Examination as to substance

After publication, the applicant must request examination of the invention within five years from the publication. As for designs, the examination can take place without

a request from the applicant. The examination will be focused on the three elements of invention patentability, namely, novelty, non-obviousness and industrial applicability or, in case of a design, mainly on novelty. The examination is performed by the officers of the Patent Division. The determination of novelty requires searching the prior art in Thailand as well as in foreign countries. At the present time, the Patent Division receives assistance from the Australian Patent Office and the European Patent Office in examining patent applications.

*(e) Refusal or grant*

An application may be rejected either before or after publication on various grounds, i.e., the application is not correct and no rectification is made in time, the invention is found non-patentable, or the applicant is not entitled to file the application.

Where the application has no defect, the invention or design is patentable and the applicant fully complies with the applicable rules and regulations, the Department of Intellectual Property will grant a patent certificate to the applicant. The Patent Register and other documents are kept at the Patent Division.

*(f) Maintenance of patents*

To maintain the effectiveness of a patent, the patentee must begin to pay the annual fee from the fifth year of the term of the patent until the fifteenth year, which is the expiry year of the patent. Failure to make the payment will result in an additional charge of 30% of the outstanding fee and the lapse of the patent, respectively. It is, therefore, the duty of the Patent Division to monitor and regularly request payment from the patentee.

*(g) Compulsory licenses*

The Patent Division undertakes the task of receiving applications for compulsory licenses from any interested person or from another patentee who requires a license in order to avoid the risk of infringement. The Director-General of the Department of Intellectual Property has the authority to approve the application if it is in compliance with the law and the regulations concerned. In some cases, the Director-General will have to fix the remuneration, conditions or restrictions for the license. The competent officers of the Patent Division have to check the application and prepare the necessary information for the Director-General to decide whether or not the non-voluntary license should be granted.

*(h) Patent information service*

At present, the Patent Division offers a limited patent information service to the public, which mostly provides the local patent documentation for searches. Since it is being expanded, it is expected that the Division will be able to offer a larger-scale service to the public when the project is completed.

### 5.3 Trademark Office

*(a) Tasks*

Officially, the Trademark Office is the Trademark Division in the Department of Intellectual Property, Ministry of Commerce. Its major task is to receive applications for trademark registration and to consider whether a trademark should be accepted for registration or be rejected. After receiving each application, the Office will publish the application if it considers the trademark is qualified for registration. Another servicing task which benefits the general public, not only the applicants, is the availability of trademark searches. Anyone who wishes to register a trademark can make a search at the Trademark Division before he files his application in order to find out if the trademark he wishes to register is identical or similar to another registered trademark because the sameness or similarity will be a hindrance to his application. Like the Patent Office, the Trademark Office assumes the duty of handling oppositions to applications for registration, if any occur during the registration process.

*(b) Examination as to form*

To file an application, the applicant must use the official application forms. The important data required to be supplied in the application form are the name of the trademark owner, the name of the trademark agent (if any), a power of attorney showing the appointment of a trademark agent, the address of the trademark owner or a trademark agent in Thailand, the trademark for which registration is sought and the goods with which the trademark is intended to be used. At the present time, the classification of goods according to the Trademarks Act is totally different to the International Classification. The Trademark Office will check compliance with these requirements. Some minor errors may be allowed to be corrected.

In addition to examination of the application form, the Office has to check if the registration fee has been duly paid by the applicant. The registration fee varies with the number of goods or classes of goods to be registered. An applicant may register his trademark for a single kind of goods or several classes of goods if he deems it necessary for the protection. In general, the registration is made for at least the whole class of goods rather than one or some kinds of goods in a class.

*(c) Examination as to the grounds of non-registrability*

The Trademark Office has to examine whether the trademark possesses the characteristics which are essential for registration. The conditions of the registrability of a trademark are threefold: (1) the trademark must be distinctive; (2) the trademark is not of a character which is prohibited by law; for example, a mark which is contrary to public policy or morality, or offensive to respected institutions, or likely to mislead the public; and (3) the trademark is not identical or similar to another registered trademark for the same goods or same class of goods. The examination of the first two elements is different from the third condition. To decide whether the trademark is distinctive or is prohibited by law, the Trademark Office can rely solely on the law and the regulations concerned. By contrast, in considering whether the trademark meets the third condition, the Trademark Office has to make a search and compare it with existing trademarks registered for the same goods. The Office has its guidelines for the consideration of the similarity of trademarks.

*(d) Registration or refusal*

If the trademark fulfills the requirements for registrability and the applicant has complied with the registration procedures, the Trademark Office will record the trademark in the Register. A certificate of registration will be issued by the Department of Intellectual Property to the applicant. On the contrary, the application for registration will be refused if the trademark does not meet all the requirements for registrability or if it does but the applicant fails to abide by the registration procedures.

*(e) Renewal of registration*

The Trademark Office has to inform the trademark owner of the expiry date of the registration. This task has to be conducted not less than three months before the expiration of the most recent registration. If the trademark owner requests the renewal of the registration, the Office will renew the registration for another 10 years from the most recent expiry date. If the proprietor of the trademark does not renew the registration, the Trademark Office, through the Registrar, can revoke such registration. The Act requires that the Registrar notify the trademark owner or his agent before proceeding with the revocation.

*(f) Revocation of registration*

The registration of a trademark may be revoked by the Registrar, the Board of Trademarks or the court, depending on the ground for the revocation. Whatever the ground for revocation is and whoever orders the revocation, the Trademark Office undertakes the administrative work of cancelling the trademark in the Register after the order or ruling is final.

*(g) Search service*

The Trademark Office provides the search service for the public. Normally, the persons who make searches are the agents of the trademark proprietors who wish to have their trademarks registered. In practice, the search is an indispensable step before an application for registration is filed. At the present time, the search has to be done manually using documentation files. Searching using microfiche is now available for part of the registration data. In the near future, the trademark information will be wholly computerized. With much financial support and advice from the World Intellectual Property Organization, the computerization project has started and is making steady progress.

## **CHAPTER 6**

### **THE PATENT AND TRADEMARK AGENT**

#### **SYNOPSIS**

##### **6.1 Introduction**

##### **6.2 The Patent Agent—Functions**

###### **6.2.1 Introduction**

###### **6.2.2 The Pre-Application Phase**

###### **6.2.3 The Application Phase**

###### **6.2.4 Publication of the Application**

###### **6.2.5 Deferred Examination**

###### **6.2.6 Opposition**

###### **6.2.7 Substantive Examination**

###### **6.2.8 Role During the Life of the Patent**

###### **6.2.9 Applications for Foreign Clients**

###### **6.2.10 Foreign Applications for Domestic Clients**

##### **6.3 The Trademark Agent—Functions**

###### **6.3.1 Introduction**

###### **6.3.2 Selection of a Trademark**

###### **6.3.3 Application for Domestic Registration**

###### **6.3.4 Applications Registered Abroad by Domestic Trademark Owners**

###### **6.3.5 Licensing**

###### **6.3.6 Maintenance of Trademarks After Registration**

## 6.1 Introduction

There is no patent agency system in Thailand. Section 11 of the Commerce Ministerial Regulation dated October 29, 1979, issued under the Patents Act B.E. 2522 (1979) merely provides that an applicant, opposer, respondent or appellant, with no residence in Thailand, must appoint an agent listed with the Department of Commercial Registration to act for him. Section 12 provides that an applicant, with a residence in Thailand, may similarly do so. There are no specific laws to control or supervise the performance of a patent agent. Nevertheless, the Patents Act itself imposes a penalty for disclosing particulars of a patent application before its publication. Clause 3 of the Commercial Registration Department Announcement dated February 21, 1980, empowers the Director-General of the Department to revoke a patent agent's permit if he acts or omits to act resulting in damage to an applicant, opposer, respondent or appellant. Other applicable laws are the general contract and tort provisions under the Civil and Commercial Code and the Penal Code on disclosure of confidential information or industrial secrets, obtained through the profession or occupations of trust. In any event, there has, so far, not been any case which has involved the ethics of a patent agent.

Under the Commercial Registration Department Announcements dated February 21, 1980, and May 26, 1980, patent agents fall into two categories all having to be listed with the Department of Intellectual Property. Class A agents are those with a knowledge of patent law and with a bachelor degree, or equivalent, in science, engineering, architecture or law. Class B agents are those who do not have the qualifications of Class A agents. At present, no special requirements are imposed for Class B agents so as to encourage applications for the listing.<sup>1</sup>

As a normal practice, companies in Thailand do not have a patent division or in-house patent attorneys. As the research and development of new inventions is very limited for local companies, it is not necessary to have a patent division or full-time legal officers. For a foreign company doing business in Thailand, the important research and development activities are usually not conducted in Thailand. The patent department, therefore, is organized within the foreign headquarters or a branch thereof, which undertakes advanced research and development. If a business entity wishes to apply for a Thai patent, it will use the services of an independent patent agent or patent attorney. The normal practice in Thailand is that it appoints a local law firm specializing in patent registration to be its agent.

Trademark agents were mentioned in the Trademarks Act B.E. 2474 (1931) with regard to the application procedure for registration of a trademark. Likewise, it is clearly recognized in the Trademarks Act B.E. 2534 (1991). The law does not impose any qualification on a trademark agent. Generally, trademark agents are legal counsellors or practicing lawyers. As a trademark is necessary for each product, the handling of trademarks may be a continuing task in a manufacturing or a trading company. So, a company may employ one or more in-house trademark attorneys to take care of the company's trademarks. Some companies in Thailand have their own legal staff to handle the registration and maintenance of trademarks. However, most companies usually seek legal services from law firms sporadically when they want their trademarks to be registered. In practice, trademark litigation is handled by an experienced law firm rather than an in-house attorney.

There is no exclusive association of patent agents or trademark agents in the country. Nonetheless, there is a professional association called the "Copyright, Patent and Trademark Association" the majority of whose members are intellectual property lawyers. The Association sometimes holds seminars on patents and trademarks in which interested persons discuss and exchange ideas on various problems.

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<sup>1</sup> Boonma Tejavaniya, "The Patent Agent in Patent Litigation," a paper presented at the WIPO National Workshop on Patent Agency, Manila, July 11 to 13, 1990.



## 6.2 The Patent Agent—Functions

### 6.2.1 Introduction

Generally speaking, patent agents in Thailand perform the same functions as those in other countries. Their role usually starts with advice on whether the invention or the design is patentable and should be patented. If the inventor or the designer decides to apply for a patent for invention or design, the agent will act on behalf of the former throughout the procedure up to grant. The agent may possibly have to represent the inventor or the patentee in a patent dispute or litigation.

### 6.2.2 The Pre-Application Phase

#### (a) Secrecy

If an inventor has developed a new invention, the first question the inventor will ask the patent agent is whether he should patent his invention or keep it a secret. The patent agent has to explain the advantages and disadvantages of the two alternatives. Naturally, the local inventor always hesitates to patent his invention because of the worry regarding the high cost and the lengthy granting procedure. The agent has to take into account the nature of the invention, the desire of the inventor, the possibility of patenting the invention and other factors in order to convince the inventor of the advantages of a patent in comparison with secrecy. Therefore, this seems to be the first task of a patent agent and must be based on good understanding of the patent system.

#### (b) Determining patentability

Basically the patent agent must know the conditions of patentability, namely, novelty, non-obviousness or inventive step and industrial applicability. The difficult task is to check whether the invention meets those conditions. While the condition of industrial applicability is usually not a problem, the consideration whether the invention is new and involves inventive step needs expertise in patent search. A patent agent who can perform this task by himself must possess a scientific and technological education. At present, the Thai patent agents, most of whom are lawyers, handle this task with much help from scientists and engineers. However, local patent agents seldom do this work because most local inventors are researchers in universities or companies who are capable of undertaking the state-of-the-art search to verify novelty and non-obviousness themselves. The patent agent must bear in mind that, according to the Patents Act, an application in a foreign country more than 12 months before a domestic application or a domestic application which is deemed abandoned by the applicant will disqualify the patentability of an invention because the law deems the invention under such circumstances no longer new.

#### (c) Determining in which countries to seek patent protection

When thinking about the foreign countries in which the invention should be registered for a patent, the patent agent always takes into account whether the invention is likely to be licensed or assigned to a potential licensee or assignee in any particular country, or whether the invention is likely to be manufactured in such country, or whether there is a possibility of unauthorized use in such country. If the invention belongs to a transnational corporation, the invention is likely to be patented in several countries. In case the invention is developed by an independent researcher, the choice of a foreign country in which to patent the invention seems to be an important matter. In practice, it is suggested that the invention be patented in the country where the local industry tends to be interested in manufacturing the invention. The main reason is that foreign industry will not negotiate for a license unless the invention has been duly patented in that country because of the risk of undesirable low-cost competition from other local competitors.

*(d) Preparation of the application*

The preparation of the application is subject to a number of rules and regulations. It is the responsibility of the patent agent to prepare the application and supplementary documents correctly. The patent agent must use the official application form and he must use the method of writing and the symbols laid down by the Ministerial Regulations of 1979 and 1981 (descriptions of the invention, claims, abstract and drawings), the Ministerial Announcements dated October 9, 1979 (codes for product design), and the Commercial Registration Department's Announcements dated November 9, 1979 (drawing symbols), and December 14, 1982 (forms and printing blocks).

**6.2.3 The Application Phase**

*(a) Filing the application*

It is the task of the patent agent to file the completed application with the right officer and at the right time. The timeliness of the filing is very important, particularly when another application for a patent has been previously filed in another country. In such case, the agent must file the subsequent application within 12 months from the previous filing, otherwise the invention will be deemed not new.

*(b) Correcting the application*

After the application has been filed, the registration authority will communicate with the agent. If the documentation is not complete or not correct, the patent agent will be instructed to submit additional documents or to correct the submitted documents. It is the responsibility of the agent to complete the documents as soon as possible. In case the patent agent does not have the required documents to hand or it is beyond his capacity to correct the application, he has to coordinate with the inventor or the writer of the description and claims to rectify it in the given time. Failure to perform this duty in time may result in an adverse effect upon the applicant because the law deems the application to have been abandoned by the applicant.

**6.2.4 Publication of the Application**

When the application is completed, it will be published by the Patent Office. At this stage, the publication fee must be paid. Default in payment may result in the presumed abandonment of the application. It is, therefore, the duty of the patent agent to be cognizant of this procedure and to have the fee duly paid by the applicant himself or advanced by the agent on behalf of the applicant.

**6.2.5 Deferred Examination**

The law provides that the applicant has to request the substantive examination as to whether the invention is qualified for patentability within five years from publication or, in case of opposition and appeal against a decision of the Director-General, within one year from the day the Board of Patents' ruling becomes final, depending on which period lapses later. The patent agent, therefore, has to keep a record of the date of publication and the time when the request for examination has to be submitted.

**6.2.6 Opposition**

After the publication of the application, there may be an opposition against the application from anyone who thinks that he has a better right in the invention to apply for the patent or that the application is not in compliance with the law. The registration authority, upon receipt of the notice of opposition, will send a copy thereof to the applicant or his patent agent. The patent agent has to discuss with the applicant how to defend the application. The agent must file the counterstatement with the competent officer within 90 days of receipt of the opposition notice, otherwise the application will be deemed abandoned.

### 6.2.7 *Substantive Examination*

In relation to (d), when the time to request the substantive examination approaches, the patent agent has to consult the applicant whether the request should be submitted or not. It is possible that the applicant may not be willing to proceed with the application because he thinks that the invention is not commercially worthwhile or he cannot afford further expenses. If it is agreed that the substantive examination should be requested, the patent agent must file the request within the time limit, otherwise the application will be deemed abandoned.

### 6.2.8 *Role During the Life of the Patent*

#### (a) *Maintenance*

The law requires payment of the patent fee starting from the fifth year until the fifteenth and last year of the patent. The fee is imposed on a progressive basis. Payment is due within 60 days from the beginning of each year. Timely non-payment will make the patentee liable for an additional fee of 30% of the outstanding fee. Failure to pay the fee together with the additional charge within 180 days from the due date will cause the termination of the patent. Hence, it is another important responsibility of the patent agent to record the dates on which each annual payment will become due. In addition, the agent may have to give careful advice if the applicant asks whether the patent should be maintained or not. In such circumstance, the patent agent has to take various factors into consideration, particularly if the patent has already been licensed.

#### (b) *Invalidation proceedings*

The Patents Act provides that any person may claim the invalidity of a patent which has been granted on the ground that the grant is not in accordance with the law. In addition, an interested person or a public prosecutor may bring an action to the court to cancel a patent on the ground of invalidity. The law also empowers the Board of Patents, upon the request of the Director-General of the Department of Intellectual Property, to revoke a patent on the ground of insufficient working thereof without legitimate reasons, which include the non-production of patented products or the non-use of the patented process and the insufficient supply of goods at a reasonable price. The patent agent must step in to form arguments against the allegations because he is supposed to be aware of the legal and technical characteristics of the invention or the design. His cooperation with the inventor and the attorney, if any, is very useful in maintaining the effectiveness of the patent.

#### (c) *Compulsory licenses*

According to the Act, compulsory licensing is possible in three cases, namely, (1) insufficient working of the patent in Thailand, (2) interdependent patent, and (3) public interest. The patent agent may have an important role in the first two cases, particularly if the applicant does not agree with the non-voluntary license. He may have to help argue that there has indeed been sufficient working of the patent or that the insufficient working was necessitated by some legitimate reasons. As regards an interdependent patent which involves at least two patents, the patentee who wants to receive a license has to affirm, with the help of his agent, that the license will not cause injury to the other patentee and that his working of the patent will be of great importance to commerce or will respond to domestic demand but he cannot make use of his patent efficiently unless the license is granted. The other patentee who resists the license may, with the help of his agent, argue that a compulsory license, if granted, will unreasonably prejudice the exercise of his patent rights. It is understandable that the patent agent has an important role in this task.

#### (d) *Infringement*

Patent infringement is the cause of a civil and a criminal action. An infringement occurs when another person has done something that the patent grants to the patentee the right to do exclusively. The decisive point in patent litigation is always the scope

of protection of the patent. To determine the scope of protection, one must look at the claims. At this point, it can be seen that the patent agent will have an important role in testifying to the scope of the claims which have been registered. Moreover, since an infringement action usually involves technicality, the patent agent who is also a technical specialist can help introduce the technical evidence required for each issue in the case. The participation of the patent agent in an infringement action is always important, no matter whether he is on the plaintiff's or the defendant's side.

#### 6.2.9 *Applications for Foreign Clients*

In general, the task to be performed by the patent agent for his foreign client is almost the same as for a local client. However, there are two observations which the patent agent should always bear in mind. Firstly, the law does not allow all foreigners to apply for a Thai patent. The limitation is that only foreigners who are nationals of the countries which allow persons of Thai nationality to apply for patents in those countries can apply for Thai patents. Consequently, the agent must check the law of the country of which the applicant has the nationality before he starts his mandate. Secondly, the correspondence between the foreign applicant who usually resides abroad and the agent must be made within certain schedules so as to meet the deadline of each registration step and litigation procedure.

#### 6.2.10 *Foreign Applications for Domestic Clients*

If the client decides to have his invention patented in a certain foreign country, the local patent agent should facilitate the procedure for grant abroad as much as he can. The agent should recommend a qualified foreign patent agent to handle the application. Moreover, the agent should supply the client with information as to the expenses to be incurred and the time to be spent. After the foreign agent is appointed, the local agent still has to help the applicant in several ways. The agent may act as a coordinator between the foreign agent and the applicant. When the foreign granting procedure is going on, the local agent may report the progress of the application and advise the applicant with respect to any doubts that the latter may have. Without the assistance of the local patent agent, the applicant undoubtedly faces difficulties in communicating and working together with the foreign agent.

### 6.3 **The Trademark Agent—Functions**

#### 6.3.1 *Introduction*

A trademark agent normally performs the following tasks:

- to help the client to select or design the trademark;
- to advise whether or not the trademark should be registered and how to apply for the registration;
- to apply for the registration and to proceed until the trademark is registered;
- to maintain the validity of the trademark registration;
- to advise the client concerning trademark transactions, e.g., license, assignment, etc.;
- to prevent unauthorized use of the trademark;
- to represent the client in trademark litigation either offensively or defensively.

#### 6.3.2 *Selection of a Trademark*

A trademark agent or a trademark attorney has an important role in helping the client to select the most suitable trademark. An experienced agent may be able to give advice as to the aesthetic character or the marketing attractiveness of the trademark.

Much more importantly, the agent has to keep the design or the selection of a trademark in line with legal standards. A trademark should be inherently distinctive. In case the client insists on a trademark which is not inherently distinctive, the agent has to evaluate the possibility of it acquiring distinctiveness through use. If he does not foresee such possibility, he should advise the client to abandon the trademark because it will not be accepted for registration.

In addition, the agent has to be careful about the legally prohibited character of a trademark as specified by the law. The client should be advised to avoid the adoption of a trademark which is identical or similar to another trademark, particularly that which has been previously registered for the same products because the similarity brings about the risk of being non-registrable. The agent may discourage the client from taking a foreign trademark for his own although it is likely that the client can register it because it has not been registered in Thailand and the Registrar is likely to be unaware that it in fact belongs to a foreign owner. The law allows the real owner to bring an action to court to revoke the registration of such trademark. The agent can explain that the free-riding practice may not be worth the risk of revocation and future legal liability.

### 6.3.3 *Application for Domestic Registration*

After the search and the selection of a trademark, the trademark agent usually files the application for registration on behalf of the owner of the trademark. The application must, of course, follow the relevant rules and procedures. An agent who knows the regulations and follows them can expedite the application process. An experienced agent will prepare to submit evidence of actual use to prove the acquired distinctiveness of the trademark should the trademark lack inherent distinctiveness.

It is possible that, during the registration process, the registration authority may request the correction or the additional introduction of evidence or documents. It is the responsibility of the trademark agent to abide by the request or produce arguments against it. If the matter is important enough, he may have to consult the client about the most acceptable position.

Another important task of the trademark agent which may arise during registration is the handling of opposition. The law allows an interested person to oppose the registration by filing a notice of opposition with the Registrar. The Registrar will send the notice to the agent. The agent, with or without instructions from the client, will make a counterstatement. If the agent fails to perform this task or performs it inefficiently, the Registrar may rule in favor of the opposer and consequently reject the application. In case the client still wants his trademark to be registered, he has to assume the burden of appealing the Registrar's order to the Board of Trademarks or the court, as the case may be. Hence, the handling of opposition is an important responsibility of the trademark agent to protect the client's interest.

### 6.3.4 *Applications Registered Abroad by Domestic Trademark Owners*

There are a number of local manufacturers and exporters which have their trademarks registered abroad. In practice, the application for a foreign registration is filed after the application in Thailand. The local agent should advise the trademark owner regarding the registration abroad, especially the countries in which the goods are sold. Moreover, the agent should be able to give information as to the registration procedures and the expenses which the client will have to incur. To perform this preliminary task, the local agent has to obtain information from an agent in the relevant foreign country. If the client agrees to have his trademark registered abroad, the local agent should recommend a foreign trademark agent who will undertake the registration work. Although the client has appointed a foreign agent, the local agent should still play a coordinating role between the client and the foreign agent throughout the registration process.

### 6.3.5 *Licensing*

The licensing transactions in Thailand are mostly the licensing of foreign marks to local licensees. Nonetheless, a trademark agent or attorney plays an important role regarding the licensing process. The usual task is to review the licensing agreement which is normally proposed by the licensor. The agent always represents the local licensee in negotiations with the licensor. In a licensing transaction, the agent works closely with the client to negotiate the most favorable terms and conditions subject to the laws and regulations. Since a trademark license normally includes several elements, for example, tax, remittance, etc., the trademark agent who deals with a license must have sufficient knowledge of those relevant laws.

### 6.3.6 *Maintenance of Trademarks After Registration*

The trademark agent has two major tasks regarding the maintenance of trademarks after registration.

One task is the renewal of the trademark. The registration lasts for 10 years and it needs to be renewed for a further 10-year period after the lapse of each registration term. The agent must keep good records of the trademark so that he can renew the trademark in time. Non-renewal will have a serious effect on the client because the protection will cease and the trademark will be removed from the Register.

The second task is the prevention of the improper use of the trademark. Improper use probably turns the trademark into a generic name or sign which will deprive the owner of the exclusive right to use it. Moreover, a registered trademark can be removed from the Register if it is established that it has become common in trade. A trademark agent should regularly monitor the use of the trademark in the mass media and the use by other persons, including that of the licensee of that trademark. If the agent detects improper use, he should initiate immediate measures to halt further use and, if necessary, to take legal proceedings so as to stop the use and to seek appropriate remedies.

## **CHAPTER 7**

### **INTELLECTUAL PROPERTY LITIGATION**

#### **SYNOPSIS**

##### **7.1 Introduction**

##### **7.2 Review of Industrial Property Office Decisions**

- 7.2.1 Pre-Grant Appeals**
- 7.2.2 Post-Grant Appeals**
- 7.2.3 Appeal Procedures**

##### **7.3 Infringement Actions**

- 7.3.1 Trademark Infringement and Passing-Off**
- 7.3.2 Copyright Infringement**
- 7.3.3 Patent Infringement**
- 7.3.4 Evidence**

##### **7.4 Remedies**

- 7.4.1 Interlocutory Injunction**
- 7.4.2 Final Injunction**
- 7.4.3 Damages**

## 7.1 Introduction

Before industrial property litigation goes to court, there may be an administrative appeal against the decision of the Trademark Registrar or of the Director-General in case of a patent. As copyright subsists without any formality, by contrast, there is no administrative order or decision to invoke a similar administrative appeal.

Whatever the kind of intellectual property, the court usually plays a decisive role in any dispute or disagreement, ranging from hearing appeals against the decisions of the authorities to adjudicating infringement cases.

## 7.2 Review of Industrial Property Office Decisions

The Patents Act and the Trademarks Act stipulate the circumstances where appeals can be made to certain authorities. The right to appeal may occur before or after the subject matter is registered, depending on the ground of the order or ruling to be appealed against.

### 7.2.1 Pre-Grant Appeals

In case of a patent, a pre-grant appeal may be either an appeal against the order of the officer to the Director-General or against the order or the decision of the Director-General to the Board of Patents.

There is only one situation which helps an appeal against an order of an officer to the Director-General. If the officer examines the application and finds that the application comprises several unrelated inventions, the officer will request the applicant to make a separate application for each invention in accordance with the rules set forth in Ministerial Regulation No. 3, 1980, Clause 6. However, if the applicant does not agree with the order, he may appeal to the Director-General within 120 days. The decision of the Director-General in response to an appeal is final.<sup>1</sup>

As regards an appeal to the Board of Patents, the Act states that an interested party can appeal the order or the decision of the Director-General to the Board of Patents within 60 days from receipt of such order or decision in the following cases:

- (1) when the Director-General has fixed the special remuneration for the employee-inventor if the employer actually exploits the invention;<sup>2</sup>
- (2) when the Director-General has ruled whether a co-inventor who has not jointly filed the application can later be added to the application;<sup>3</sup>
- (3) when the Director-General dismisses an application before publication on the ground that the application is not in compliance with the law or the invention is non-patentable;<sup>4</sup>
- (4) when the Director-General dismisses an application after publication on the ground that the invention lacks the fundamental requirements of novelty, non-obviousness and industrial applicability; or the invention is non-patentable; or the applicant is not entitled to file the application; or the applicant does not have the nationality and his country of citizenship does not permit a Thai national to apply for a patent;<sup>5</sup>
- (5) when the Director-General orders the registration of the invention and the grant of a patent;<sup>6</sup>

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<sup>1</sup> Patents Act, Section 26.

<sup>2</sup> Sections 12 and 72.

<sup>3</sup> Sections 15 and 72.

<sup>4</sup> Sections 28 and 72.

<sup>5</sup> Sections 30 and 72.

<sup>6</sup> Sections 33 and 72.



(6) when the Director-General rules that the opposer to an application is entitled to file the application and rejects the existing application.<sup>7</sup>

The above-mentioned causes of pre-grant appeals, with the exception of (4), are also available with respect to design patents.<sup>8</sup>

After the Board of Patents has received the appeal, it will rule either for or against the appellant. Any interested party who disagrees with the ruling may appeal to the competent court within 60 days of being notified of such ruling. Failure to take action within the time specified will make the Board's ruling decisive and final.<sup>9</sup>

### 7.2.2 *Post-Grant Appeals*

The Patents Act allows appeals to take place after a patent has been granted in three cases, which are given below. The patentee may appeal the order or the decision of the Director-General to the Board of Patents after being notified of the order or the decision, otherwise the order or the decision will be regarded as final:

(1) when the Director-General has fixed the conditions, restrictions and remuneration for a patent license where the patentee has expressed his consent allowing another person to use his patent, subject to the terms and conditions to be agreed upon between the patentee and the licensee but agreement cannot be reached. The appeal must be made within 30 days;<sup>10</sup>

(2) when the Director-General has ruled with respect to the availability of a compulsory license due to the insufficient working of the patent or the interdependence of patents. The appeal must be made within 60 days;<sup>11</sup>

(3) when the Director-General has ruled that a compulsory license as in (2) is permissible and the Director-General has fixed the remuneration, conditions and restrictions for the use of the patent because the parties concerned cannot reach agreement on those matters. The appeal must be made within 60 days.<sup>12</sup>

Under the Trademarks Act, an interested person can institute pre-grant appeals—appeals before the trademark is registered. The appeal is to be made against the decision of the Registrar to the Board of Trademarks within 90 days of being informed of the decision. In brief, the appeals are available in the following cases:

(1) when the Registrar orders the registration of trademarks as associated marks;<sup>13</sup>

(2) when the Registrar orders the change of a trademark for which an application has been filed;<sup>14</sup>

(3) when the Registrar rejects an application on the ground that the appearance of the trademark is prohibited, or the trademark is identical or similar to another registered trademark, or the application is not in compliance with the law;<sup>15</sup>

(4) when the Registrar orders a disclaimer of a part or parts of a trademark as a condition for registration due to its common use in trade;<sup>16</sup>

(5) when the Registrar orders the registration of a trademark which is identical or similar to another person's trademark but has been used by the applicant in good

<sup>7</sup> Sections 34 and 72.

<sup>8</sup> Section 72.

<sup>9</sup> Section 74.

<sup>10</sup> Section 45.

<sup>11</sup> Section 49.

<sup>12</sup> Section 50.

<sup>13</sup> Trademarks Act, Sections 14 and 18.

<sup>14</sup> Sections 15 and 18.

<sup>15</sup> Sections 16 and 18.

<sup>16</sup> Sections 17 and 18.

faith, or the registration is supported by a special reason, or when the application for registration of such trademark is rejected;<sup>17</sup>

(6) when the Registrar has given his decision as to who is entitled to register a trademark between the applicant and the opposer. Alternatively, in this particular case, the party may choose to bring an action to the court instead of appealing to the Board of Trademarks.<sup>18</sup>

### 7.2.3 *Appeal Procedures*

#### (a) *Introduction*

The appeal procedures are governed by various sources of rules depending on the step of the appeal. An appeal to the Director-General, to the Board of Patents or to the Board of Trademarks must follow the rules and regulations set forth in the Patent Act or the Trademarks Act and the related Ministerial Regulations. An appeal to the court, on the other hand, is governed by the Code of Civil Procedure.

#### (b) *Identification of issues*

Before the trial starts, the court may order a procedure to identify the controversial issues. Upon examining the pleadings and hearing the arguments of the litigants, the court will identify the issues to be determined in the trial. If necessary, the court may prescribe the sequence of the introduction of evidence by each party.

## 7.3 **Infringement Actions**

### 7.3.1 *Trademark Infringement and Passing-Off*

#### (a) *Trademark infringement*

The Trademarks Act confers exclusive rights on the registered owner of the trademark to use the trademark with the registered class or classes of goods.<sup>19</sup> Strictly speaking, therefore, infringement occurs when a person uses a registered trademark without authorization with registered goods. In an infringement case, the registration of the trademark is essential. Without due registration, no infringement claim can be raised. The injured owner of the trademark has to turn to a passing-off claim instead.

#### (b) *Passing-off*

Although it is a civil law country, Thailand has adopted the concept of common law passing-off in the Trademarks Act. The Act paves the way for the application of a passing-off claim when there is misrepresentation that the goods being sold by the defendant originate from the plaintiff.<sup>20</sup> Passing-off is very favorable to the owner of a trademark which is not registered at all or registered for some specific goods. As mentioned above, the owner of a trademark cannot invoke an infringement claim when his trademark is not registered or registered for some goods only and another person is using it with unregistered goods without his permission. In such circumstance, the trademark owner can resort to a passing-off action, provided that confusion as to the origin of the goods actually takes place.

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<sup>17</sup> Section 27.

<sup>18</sup> Section 37.

<sup>19</sup> Section 44.

<sup>20</sup> Section 46, second paragraph.

### 7.3.2 *Copyright Infringement*

The Copyright Act states the acts which constitute infringement. Infringement may be divided into two categories, namely, primary infringement and secondary infringement. Generally, primary infringement is any act of reproduction, adaptation or publication of the work without the copyright owner's permission.<sup>21</sup> Secondary infringement is a subsequent act with respect to the materials which are the results of the primary infringement.<sup>22</sup> For example, the distribution of pirated books constitutes a secondary infringement.

### 7.3.3 *Patent Infringement*

The Patents Act recognizes the exclusive rights of the patentee in his invention or design.<sup>23</sup> Therefore, whoever unauthorizedly exercises the right which is given exclusively to the patentee is considered to have committed a patent infringement. The scope of the claims is vital in an infringement case. The exclusive right of the patentee is limited to the claims described in the application. The plaintiff has to state in his complaint the coverage of his claims and the act of the defendant which is alleged to be an infringement. In a patent infringement case, the proof of infringement is much more difficult than that in a copyright or trademark case because of the involvement of relevant technologies.

### 7.3.4 *Evidence*

According to the Code of Civil Procedure, the forms of evidence to be introduced in a civil case include documentary evidence, material evidence, oral evidence supplied by an ordinary witness or an expert. The law also provides details as to the presentation of the evidence to the court and the admissibility of the evidence.

Each infringement case may require different forms of evidence. In a trademark infringement case, the certificate of registration as documentary evidence is indispensable to substantiate the plaintiff's right to institute the action. Besides, the goods bearing the infringed trademark are very important material evidence. Due to the vivid existing visible evidence, oral evidence does not seem to be necessary in an infringement case. In a passing-off case, on the other hand, material evidence, namely, the goods bearing the plaintiff's trademark and oral evidence given by misled buyers-witnesses, is very important to prove that passing-off has occurred. The proof of a copyright infringement is much based on material evidence. The court plays a most important role in deciding whether there is a substantial taking of a work which constitutes infringement or not. The introduction of evidence in a patent infringement case is likely to be the most complicated one. Since various fields of technology are involved, the court cannot easily decide the case on its own knowledge and discretion. When a patent for an invention is alleged to have been infringed, the documentary evidence and the material evidence which are introduced in court are usually not sufficient for the court to make a judgment. Expert evidence from both sides is introduced to explain the scope of the claims as well as the difference between the invention as circumscribed by the claims and the product or process of the defendant. The expert evidence also plays a key role in verifying the patent if the validity of the patent is questioned by the defendant. Apart from the complexity of the content of the dispute, an infringement case tends to consume much time. As for the alleged infringement of a design, by contrast, expert evidence is not really necessary because the subject matter is visible and the registered claims are normally not complicated. The court, therefore, is able to reach a decision after scrutinizing the documentary evidence together with the material evidence. However, expert evidence may become necessary if the validity of a design patent is challenged by the defendant. In such circumstance, the registration authority will be called in to testify.

<sup>21</sup> Copyright Act, Section 24.

<sup>22</sup> Section 27.

<sup>23</sup> Patents Act, Section 36.

## 7.4 Remedies

Subject to the legal system, the remedies available in intellectual property actions are interlocutory injunctions, final injunctions and damages.

### 7.4.1 *Interlocutory Injunction*

It is possible under the Code of Civil Procedure to seek an interim or interlocutory injunction after the plaintiff has filed an action and before the trial begins. The purpose of the law is to prevent the plaintiff from further loss and to obstruct the mobilization of the evidence to be shown in the litigation. Nonetheless, the court will not grant an injunction unless the plaintiff can provide proof, as the law requires, to the satisfaction of the court in order to prevent willful injury to the defendant. Due to the substantial proof and the lengthy procedure, therefore, an interlocutory injunction is rarely sought by the plaintiffs in intellectual property lawsuits.

### 7.4.2 *Final Injunction*

The usual final injunctions in intellectual property infringement cases include the order to stop further infringement, the order to withdraw the infringing goods from the market, the order to destroy the infringing goods and the order to correct the confusion of the public as to the origin of the goods. The court will issue the orders which are suitable to the kind of subject matter and the nature of the infringement, provided that the plaintiff has requested such orders.

It should be noted that the court in a copyright infringement case, upon the request of the plaintiff, can order the surrender of the infringing copies in the defendant's possession to the plaintiff. This is an additional remedy which the Copyright Act specifically provides for the copyright owner.<sup>24</sup> There is no such remedy for the patentee or the trademark owner. In a patent or a trademark infringement case, the infringing products or the counterfeit goods are forfeited by the judgment and become the property of the State. The court may, however, order the forfeited objects to be destroyed or made useless.<sup>25</sup>

### 7.4.3 *Damages*

It is normal practice that the plaintiff in an infringement case asks for a specific amount of damages. The court will award the damages if the plaintiff can prove his case or as the court deems appropriate on a case by case basis. Punitive damages are not available in the legal system. The court has to take into account the reliability of the proof of actual damage. Generally, the plaintiff is hesitant to disclose his financial and marketing documents to be examined by the court and the defendant. In the absence of complete documentary evidence, the court has to assess the damages which the court itself thinks the plaintiff deserves. Another difficulty arises from the cause-effect relationship between the alleged infringement by the defendant and the injury of the plaintiff. Perhaps the claimed injury was not caused by the infringing act. For example, the plaintiff claims that the volume of sales of his copyrighted work has dropped drastically because of the defendant's infringement. The defendant may be able to prove that the infringement has no causal connection with the decrease in the plaintiff's volume of sales, i.e., the goods lose popularity among the buyers because another new product has been launched on the market. Because of the difficulty of providing proof, it is normal that the amount of damages awarded by the court is usually much less than what the plaintiff has asked for.

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<sup>24</sup> Copyright Act, Section 47.

<sup>25</sup> Penal Code, Section 35.

**ANNEX I**

**PATENTS ACT**

**B.E. 2522 (1979) as amended by  
PATENTS ACT (No. 2) B.E. 2535 (1992)**

**PATENTS ACT**  
**B.E. 2522(1979) as amended by**  
**PATENTS ACT (No.2) B.E. 2535(1992)**

**H. M. KING BHUMIBOL ADULYADEJ**  
**Given on the 11th day of March B. E. 2522 (1979)**  
**being the 34th year of the present reign**

By royal command of His Majesty King Bhumibol Adulyadej  
it is hereby proclaimed that:

Whereas it is deemed expedient that there be a law to  
provide protection for inventions and designs,

**IT IS HEREBY ENACTED** by the King's Most Excellent  
Majesty, by and with the advice and consent of the national  
legislature as follows:

**Section 1.** This Act shall be called the "Patents Act B.E.  
2522".

*Title*

**Section 2.** This Act shall come into force upon the expiration  
of one hundred and eighty days from the date of its  
publication in the Government Gazette.

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*The Patents Act was published in Vol. 96, Part 35 of the Government  
Gazette dated 16th March 1979 and therefore in force on 12th  
September 1979 and Act No. 2 was published in Vol. 109, Part 34  
dated 3rd April 1992 and in force on 30 September 1992.*

**CHAPTER 1****GENERAL****Section 3. In this Act:***Definitions*

"patent" means a document issued under the provisions of this Act to give protection to an invention or a design,

"invention" means any discovery or invention resulting in a new product or process, or any improvement of a product or process,

"process" means any process, art or method of producing, maintaining or improving the quality of a product, including the application of such process,

"design" means any configuration of a product or composition of lines or colors which gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft,

"patentee" includes the transferee of a patent,

"Board" means the "Patent Board",

"competent officer" means a person appointed by the Minister to act under this Act,

"Director-General" means the Director-General of the Department of Commercial Registration including any person acting under his authority,<sup>1</sup>

"Minister" means the Minister in charge of the execution of this Act.

**Section 4.** The Minister of Commerce shall be in charge of the execution of this Act and shall have power to appoint competent officers and to issue Ministerial Regulations

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<sup>1</sup> *By the Act on Transfer of Some of the Authority and Administration of the Commercial Registration Department to the Intellectual Property Department B.E. 2535 (1992), published in Government Gazette Vol. 109, Part 16 dated 4 March 1992, the Director-General of the Department of Intellectual Property assumes the authority of the Director-General of the Commercial Registration Department.*

prescribing fees not exceeding those prescribed in the annex to this Act, reductions and waivers of fees and other matters pursuant hereto.

Such Ministerial Regulations shall take effect upon publication in the Government Gazette.

## CHAPTER 2

### INVENTION PATENTS

#### PART 1

##### APPLICATIONS FOR PATENTS

**Section 5.** Subject to Section 9, a patent may be granted only for an invention in respect of which the following conditions are satisfied:

*Patentable inventions*

- (1) the invention is new,
- (2) it involves an inventive step, and
- (3) it is capable of industrial application.

**Section 6.\*** An invention is new if it does not form part of the state of the art.

The state of the art shall also include the following:

*Novelty*

- (1) an invention widely known or used in the Kingdom prior to the date of the patent application;
- (2) an invention of which the essentials or specification were disclosed in a published document or printed matter, whether in this or a foreign country, prior to the date of the patent application and whether the disclosure is by document, printed matter, exhibition or public disclosure by any means whatsoever;
- (3) an invention patented in this or a foreign country prior to the date of the patent application;
- (4) an invention for which an application for a patent was filed in a foreign country more than twelve months prior to the date of the patent application, the foreign patent not having been issued;



(5) an invention for which an application for a patent was filed in this country but abandoned by the applicant provided, however, the rights of co-inventors and others who did not apply for such patent shall not be affected.

Disclosure of the essentials or specification due to or in consequence of an unlawful act, or disclosure of the essentials or specification by the inventor including display of the inventor's work at an international exhibition or an official public exhibition provided such disclosure occurred within a period of twelve months prior to the date of filing the patent application shall not be deemed to be a disclosure under sub-section (2)<sup>2</sup>.

*Excused disclosure*

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<sup>2</sup> *Patents Act '79 Section 6. An invention is new if it does not form part of the state of the art.*

*The state of the art shall also include the following:*

*(1) an invention widely known or used in the Kingdom prior to the date of the patent application;*

*(2) an invention of which the essentials or particulars were disclosed in a published document or printed matter, whether in this or a foreign country, prior to the date of the patent application and whether the disclosure is by document, printed matter, exhibition or public disclosure by any means whatsoever;*

*(3) an invention patented in this or a foreign country prior to the date of the patent application;*

*(4) an invention for which an application for a patent was filed in a foreign country more than twelve months prior to the date of the patent application, the foreign patent not having been issued;*

*(5) an invention for which an application for a patent was filed in this country but abandoned by the applicant provided, however, the rights of a co-inventor who did not apply for such patent shall not be affected.*

*Disclosure of the essentials or specification due to, or made in consequence of an unlawful act, or due to, or made in consequence of the inventor having displayed the invention at an international exhibition or an official public exhibition if occurring within a period of one hundred eighty days prior to the date of filing the patent application shall not be deemed to be a disclosure under sub-section (2).*

**Section 7.** An invention shall be held to involve an inventive step if it is not obvious to a person having ordinary skill in the art.

*Inventive step*

**Section 8.** An invention shall be held to be capable of industrial application if it can be put to use in industry, including handicraft, agriculture and commerce.

*Industrial application*

**Section 9.\*** The following inventions are not protected under the Act:-

*Non-patentable inventions*

- (1) naturally existing microorganisms and their components, animals, plants or animal and plant extracts;
- (2) scientific or mathematical rules or theories;
- (3) computer programs;
- (4) methods of diagnosis, treatment and care of human and animal diseases;
- (5) inventions contrary to public order, morality, health or welfare.<sup>3</sup>

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<sup>3</sup> *PA '79 Section 9. The following inventions are not patentable:-*

- (1) *food, beverages, pharmaceuticals or pharmaceutical ingredients;*
  - (2) *machinery for direct use in agriculture;*
  - (3) *varieties of animals or plants or biological processes for the production of animals or plants;*
  - (4) *scientific or mathematical rules or theories;*
  - (5) *computer programs;*
  - (6) *inventions contrary to public order, morality, public health or welfare;*
  - (7) *inventions proscribed by Royal Decree.*
- Royal Decrees issued under (7) shall not apply to applications already filed.*

Section 10.\* The inventor is entitled to apply for a patent and to be named in the patent as the inventor.<sup>4</sup>

*Right to apply for a patent*

The right to apply for a patent may be assigned or inherited.

The assignment of the right to apply for a patent must be in writing and shall require the signatures of the assignor and assignee.

*Assignment*

Section 11. The right to apply for a patent for an invention made by an employee in the course of his employment or under a contract the object of which is to make inventions shall belong to the employer unless otherwise provided in the contract.

*Employees' inventions*

The provisions of the first paragraph shall apply where an employee has made an invention by the use of means, statistics or reports made available or found out by virtue of his employment contract even though the employment contract does not relate to inventions.

Section 12. In order to encourage invention and in fairness to the employee in the circumstances provided in Section 11, paragraph one, the employee-inventor shall be entitled to remuneration from his employer other than his regular salary if the employer benefits from or uses the invention.

*Compensation for employee inventors*

In the circumstances provided in Section 11, paragraph two, the employee-inventor shall be entitled to remuneration.

The right to remuneration may not be extinguished by employment contract.

Applications to exercise the right under paragraph one or two shall be submitted to the Director-General in accordance with the rules and procedures prescribed in Ministerial Regulations. The Director-General shall have the power to fix such remuneration as he deems fit taking into account the employee's salary, the importance of the invention, benefits

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<sup>4</sup> PA '79 Section 10, para. one. The inventor is entitled to apply for a patent.

derived and to be derived by the employer from the invention and other conditions prescribed in Ministerial Regulations.

**Section 13.** In order to encourage invention by government officials and employees of state organizations and enterprises, government officials and employees of state organizations and enterprises shall be deemed to have the same rights as employees under Section 12, unless otherwise provided by the rules of the government or of the state organization or enterprise.

*Invention by  
government  
employees*

**Section 14.** A patent applicant must be a national of Thailand or of a country which allows Thai nationals to apply for patents.

*Nationality of  
applicant*

**Section 15.** When an invention is made by two or more persons jointly, such persons may apply for a patent jointly.

*Co-inventors*

If a co-inventor refuses to join in a patent application or cannot be reached or is not entitled to make an application for a patent, the application may be made by the other inventor(s) on his (their) own behalf.

A co-inventor who did not join in an application for a patent may make a request to join at any time before the patent is granted. Upon receipt of such request, the competent officer shall notify the applicant and co-inventors of the date on which the request will be examined. The applicant and each of the joint applicants shall be furnished with a copy of the request.

In the course of examination under paragraph three, the competent officer may summon the applicant and joint applicants to make statements or deliver additional documents or items. When the competent officer has completed his examination and the Director-General has given his decision, the applicant and joint applicants shall be notified thereof.

**Section 16.** If two or more persons have independently made the same invention, the first to apply for a patent shall be entitled thereto. If applications have been filed on the same date, the applicants shall agree whether a patent should be

*Rival applicants*

DS&B 1992

granted to one of them or to all of them jointly. If no agreement is reached within the period prescribed by the Director-General, the parties shall, within ninety days thereafter, bring the case to court. If they fail to do so within such period, they shall be deemed to have abandoned their applications.

**Section 17.** Applications for patents shall be made in accordance with the rules and procedures prescribed in Ministerial Regulations. Every application for a patent shall include:

*Making of applications*

- (1) the title of the invention;
- (2) the nature and purpose of the invention;
- (3) a specification containing a complete, concise and clear description of the invention such as will enable a person of ordinary skill in the relevant art to perform the invention and setting forth the best means known to the inventor of carrying out the invention;
- (4) clear claims;
- (5) other particulars as may be prescribed in Ministerial Regulations.

**Section 18.** An application for a patent shall be for only one invention or for a group of inventions which are so linked as to be regarded as a single invention.

*Unity of invention*

**Section 19.\*** A person who has exhibited his invention at a public exhibition sponsored or authorized by a state organization and held in Thailand and has applied for a patent for such invention within twelve months of the opening date of the exhibition shall be deemed to have filed his application on such opening date.<sup>5</sup>

*Priority for disclosure at government exhibition*

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<sup>5</sup> *PA '79 Section 19.* A person who has exhibited his invention in an exhibition which is sponsored or authorized by the Thai government and held in Thailand and has applied for a patent for such invention within one hundred and eighty days after the opening date of the exhibition shall be deemed to have filed his application on such opening date.

**Section 19 bis.\*** Whoever files an invention patent application in Thailand within twelve months of filing the first corresponding application outside the Kingdom shall be entitled to claim the priority of the first foreign filing date provided the country of the applicant's nationality gives similar rights to Thai nationals.<sup>6</sup>

*Priority of foreign filing*

**Section 20.** An applicant may amend his application for a patent in accordance with the rules and procedures prescribed in Ministerial Regulations provided that such amendment does not add to the essential elements of the invention.

*Amendments*

**Section 21.** All officers whose duties are connected with patent applications shall refrain from disclosing the specification of the invention or permitting any person to inspect or make a copy thereof by any means before the publication of such application under Section 28, unless authorized by law or by the applicant or unless the applicant has abandoned the application.

*Non-disclosure of applications*

**Section 22.** Before publication under Section 28, no person shall disclose the specification of the invention knowing that a patent application for the invention has been filed or by committing any act which is likely to cause damage to the applicant unless authorized by law or by the applicant or unless the applicant has abandoned the application.

**Section 23.** If it appears to the Director-General that an invention for which a patent application has been filed should, in the interest of national security, be kept secret, he is empowered to direct that the essential elements and specification thereof shall be kept secret until otherwise ordered.

*Secrecy orders*

No person including the applicant, knowing that the application has been directed by the Director-General to be kept secret pursuant to the first paragraph, shall disclose the essential elements or specification of the invention unless authorized by law.

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<sup>6</sup> Added by Patents Act '92 Section 7.

**PART II****GRANT OF PATENTS**

**Section 24.** Before granting a patent for the protection of an invention, the competent officer shall, in accordance with the rules, procedures and conditions prescribed in Ministerial Regulations,

*Preliminary examination*

- (1) examine the application as to its conformity with Section 17,
- (2) examine whether the invention comes within Section 5.

**Section 25.** To determine whether to grant a patent, the Director-General may request any governmental service, unit or organization or any foreign governmental or international patent office or organization to examine the application as to its eligibility under Sections 5, 6, 7, 8 and 9 or the specification as to its conformity with Section 17(3). The Director-General may treat such examinations as having been done by the competent officer.

*Outside search and examination*

**Section 26.** Upon examination, if it appears that an application relates to a group of inventions which are not so linked as to be regarded as a single invention, the competent officer shall give notice to the applicant requiring him to file divisional applications, each for a single invention.

*Divisional applications*

If the applicant files a divisional application within one hundred and twenty days after the receipt of notice under the first paragraph, he shall be deemed to have filed that application on the filing date of his first application. The division of applications shall be governed by the rules and procedures prescribed in Ministerial Regulations.

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

**Section 27.** In the course of examination of an application, the competent officer may summon the applicant to make statements or deliver additional documents or items.

*Hearings*

DS&B 1992

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

*Disclosure of  
foreign search  
reports*

Foreign language documents required to be submitted shall be accompanied by a Thai translation.

*Foreign language  
documents*

If, within ninety days, an applicant fails to comply with an order of the competent officer under paragraph one or fails to submit the papers required under paragraph two, he shall be deemed to have abandoned his application. In case of necessity, the Director-General may extend such period as he thinks fit.

*Extensions of time  
for response*

Section 28.\* When the competent officer has submitted the examination report to the Director-General,

(1) if it appears to the Director-General that the provisions of Section 17 have not been complied with, or the invention is not patentable under Section 9, he shall reject the application and the competent officer shall promptly notify the applicant of the rejection; or

*Rejection for  
prima facie defects*

(2) if it appears to the Director-General that the provisions of Section 17 have been complied with and the invention is not unpatentable under Section 9, the Director-General shall order the application to be published.

*Publication orders*

When the application is ordered to be published, the competent officer shall notify the applicant to pay the publication fee.<sup>7</sup>

*Payment of  
publication fees*

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<sup>7</sup> PA '79 Section 28, para. two. When the application is ordered to be published, the competent officer shall notify the applicant to pay the publication fee within sixty days from the date of receipt of such notice. If the applicant fails to pay the fee as aforesaid, he shall be deemed to have abandoned his application.



Section 29. After publication of the application under Section 28, the applicant shall request the competent officer to examine the invention as to its conformity with Section 5 either within five years after publication of such application or, in case there is an opposition and an appeal is lodged with the Director-General under Sections 33 and 34, within one year after the final decision has been made, depending on which period expires later. If the applicant fails to make such a request within the said period, he shall be deemed to have abandoned his application.

*Deferred  
substantive  
examination*

The cost, if any, of an examination by any governmental service, unit or organization, or any foreign governmental or international patent office or organization requested by the Director-General pursuant to Section 25, shall be paid to the competent officer by the applicant within sixty days of notification by the competent officer. If the applicant fails to pay within the said period, he shall be deemed to have abandoned his application.

Section 30. After publication under Section 28, if it appears that an application does not comply with the provisions of Section 5, 9, 10, 11 or 14, the Director-General shall reject the application and the competent officer shall so notify the applicant and, in the event of opposition under Section 31, the opposing party. The decision of the Director-General shall be published in accordance with the rules and procedures prescribed in Ministerial Regulations.

*Rejection after  
publication*

Section 31.\* After publication of an application under Section 28, any person who believes that he has a better right to the patent than the applicant, or that the application does not comply with the provisions of Section 5, 9, 10, 11 or 14, may oppose the application within ninety days from the date of its publication.<sup>8</sup>

*Opposition after  
publication*

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<sup>8</sup> PA '79 Section 31. *para one.* After publication of an application under Section 28, any person who believes that he has a better right to the patent than the applicant, or that the application does not comply with the provisions of Section 5, 9, 10, 11, or 14, may oppose the application within one hundred eighty days from the date of its publication.

On receipt of a notice of opposition under paragraph one, the competent officer shall send a copy to the applicant. The applicant shall file a counterstatement within ninety days of receipt of the opposition. If the applicant fails to file a counterstatement, he shall be deemed to have abandoned his application.

The notice of opposition and counterstatement shall be accompanied by supporting evidence.

**Section 32.** In an opposition proceeding, the opponent and the applicant may submit additional evidence or statements in accordance with the procedures prescribed by the Director-General.

When the Director-General has made his decision under Section 33 or Section 34, the applicant and the opponent shall be notified of the decision and order and the grounds thereof.

**Section 33.** Where the applicant has requested examination under Section 29 and the competent officer has under Section 24 completed it, the competent officer shall submit his examination report to the Director-General.

*Grant of patent*

When the Director-General has considered the examination report under paragraph one and sees no reason to refuse the grant of a patent, and no opposition has been filed under Section 31 or an opposition has been filed but the Director-General has decided that the invention belongs to the applicant, the Director-General shall order the patent to be registered and granted to the applicant. The competent officer shall notify the applicant that the fee for the grant of the patent must be paid within sixty days from the date on which such notice is received.

When the fee has been paid in accordance with paragraph two, the patent shall be registered and granted to the applicant within fifteen days after the payment of the fee but not before the expiration of the appeal period prescribed in Section 72. If the fee is not paid within the period prescribed in paragraph two the applicant shall be deemed to have abandoned his application.

*Payment of fee*

Patents shall be in the form prescribed in Ministerial Regulations.

**Section 34.** In the event of an opposition in which the Director-General has decided that the invention belongs to the opponent, the Director-General shall reject the application.

*Consequence of successful opposition*

Where the decision of the Director-General rejecting the application is not appealed by the applicant or is appealed and the Board or the court has made a final decision or judgment, if the opponent files an application for a patent of the invention within one hundred eighty days after rejection by the Director-General or from the date on which the decision or judgment becomes final, as the case may be, he shall be deemed to have filed his application on the applicant's filing date and the publication of the applicant's application under Section 28 shall be deemed to be publication of the opponent's application. In the latter case, no person may oppose the application of the opponent on the grounds of better title.

Before granting a patent to the opponent, the competent officer shall examine the application and invention in accordance with Section 24. The provisions of Section 29 shall also apply to the opponent.

### PART III

#### RIGHTS OF THE PATENTEE

**Section 35.\*** Invention patents shall be valid for twenty years from the date of application. The term of a patent shall not include the duration of court proceedings under Section 16 or Section 74.<sup>9</sup>

*Term of patent*

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<sup>9</sup> *PA '79 Section 35. Invention patents shall be valid for fifteen years from the date of application. Any act in violation of Section 36 committed before the grant of a patent shall not be deemed an infringement of the patentee's rights.*

*The term of a patent under paragraph one shall not include the duration of court proceedings under Section 16 or Section 74.*

**Section 35 bis.\*** Any act in violation of Section 36 committed before the grant of a patent shall not be deemed an infringement of the patentee's rights unless the act is in respect of an invention under a pending patent application which has been published under Section 28, the person so acting knowing of the patent application or having been informed in writing thereof, in which case the applicant shall be entitled to damages from the infringer. Complaints to the court for such damages shall be filed after the patent is granted.<sup>10</sup>

*Damages for wilful  
infringement  
retroactive to  
publication date*

**Section 36.\*** The patentee shall have sole rights as follows:-

*Rights of patentee*

- (1) in respect of product patents, the right to produce, use, sell, have for sale, offer for sale and import the patented products,
- (2) in respect of process patents, to right to use the patented process, to produce, use, sell, have for sale, offer for sale and import products made by the patented process.

The preceding paragraph shall not apply to:-

- (1) any act for the benefit of education, research or experimentation;
- (2) production of the patented product or use of the patented process where the producer or user, in good faith, has engaged in the production or has acquired the equipment therefor prior to the date of the patent application in Thailand, Section 19 bis not being applicable hereto;
- (3) any act in respect of products acquired in good faith;
- (4) the compounding of drugs under a physician's prescription by a professional pharmacist or medical practitioner including acts in respect thereto;

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<sup>10</sup> *Added by PA '92 Section 11.*

(5) any act in respect of applications for drug registration, the applicant intending to produce, sell or import the patented pharmaceutical when the patent expires.<sup>11</sup>

**Section 36 bis.\*** The rights of the patentee to the patented invention under Section 36 shall be delimited by the claims. In deciding what are the delimitations of the claims, the characteristics of the invention as set forth in the specification and drawings shall be considered.

*Patent  
interpretation*

The delimitation of the claims shall extend protection to characteristics of the 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.<sup>12</sup>

*Doctrine of  
equivalents*

**Section 37.** The patentee shall have the right to use the words "Thai Patent", their abbreviation or foreign words of the same meaning on the patented product, its container or packing and in advertisements of the invention.

*Marking right*

The indication under paragraph one must be accompanied by the patent number.

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<sup>11</sup> *PA '79 Section 36. Subject to Section 77, the patentee shall have the exclusive right to manufacture the patented product or use the patented process and to sell or keep for sale the patented product or the product made by the patented process.*

*The provisions of the first paragraph shall not apply to:*

*(1) manufacture of the patented product or use of the patented process for the purpose of education, experiment or research;*

*(2) manufacture of the patented product or use of the patented process where the manufacturer or user, in good faith, has engaged in the manufacture or has acquired the equipment therefor prior to the publication of the application;*

*(3) the sale or keeping for sale of products acquired in good faith.*

<sup>12</sup> *Added by PA '92 Section 13.*

Section 38. The patentee may license any other person to exercise his patent rights under Sections 36 and 37 and may assign his patent to any other person.

*Licensing and assignment*

Section 39.\* In granting a license under Section 38,

*Prohibition of restrictive conditions*

(1) the patentee shall not stipulate any condition, restriction or compensation which would have the effect of unfairly limiting competition.

The type of condition, restriction or compensation which would have the effect of limiting competition unfairly under paragraph one shall be prescribed in Ministerial Regulations.

(2) the patentee may not require the licensee to pay compensation for use of the patented invention after the patent has expired under Section 35.

Conditions, restrictions and compensation terms contrary to the provisions of this Section shall be void.<sup>13</sup>

Section 40. Subject to Section 42, unless otherwise agreed, a joint owner of a patent may separately exercise his rights under Sections 36 and 37 without the consent of the other joint owners but a patent may be licensed or assigned under Section 38 only with the consent of all joint owners.

*Rights of co-proprietors*

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<sup>13</sup> PA '79 Section 39. In granting a license under Section 38,

(1) the patentee shall not stipulate any condition, restriction or compensation which would have the effect of prejudicing or hindering the development of national industry, handicraft, agriculture or commerce.

The type of conditions, restrictions or compensation which would have the effect of prejudicing or hindering development under paragraph one shall be prescribed in Ministerial Regulations.

(2) the patentee may not require the licensee to pay compensation after the patent has expired under Section 35.

Conditions, restrictions and compensation terms contrary to the provisions of this Section shall be void.

Section 41.\* Patent licenses and assignments under Section 38 shall be in writing and registered with the competent officer in accordance with the rules, procedures and conditions prescribed in Ministerial Regulations.

*Registration of  
licenses and  
assignments*

On finding that any provision of a license agreement is contrary to Section 39, the Director-General shall refer the agreement to the Board. If the Board decides that the agreement is contrary to Section 39, the Director-General shall refuse registration unless the parties to the agreement intend that invalid provisions be severable in which case the Director-General may allow registration of the valid part of the agreement.<sup>14</sup>

Section 42. The registration of the transfer of a patent by inheritance shall be governed by the rules and procedures prescribed in Ministerial Regulations.

*Inheritance of  
patents*

#### PART IV

#### ANNUAL FEES

Section 43. A patentee shall pay annual fees prescribed in Ministerial Regulations beginning the fifth year of the term of the patent. Payment shall be made within sixty days from the first day of the fifth year of the term of the patent and of every year thereafter.

*Annuities*

If a patent is granted after the first day of the fifth year of the term of the patent, the annual fees in respect of the fifth year to the year of grant shall be paid within sixty days from the date of grant.

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<sup>14</sup> PA '79 Section 41, para. three. The decision of the Board under paragraph two shall be final.

Section 44.\* If an annual fee is not paid within the period prescribed in Section 43, the patentee shall pay a surcharge of thirty percent of the unpaid fee.

*Late payment*

If the annual fee and the surcharge are not paid within six months from the expiration of the period prescribed in Section 43, the patent shall lapse.<sup>15</sup>

## PART V

### THE EXERCISE OF PATENT RIGHTS

Section 45. A patentee may, in accordance with the rules and procedures prescribed in Ministerial Regulations, apply for an entry to be made in the Patent Register to the effect that licenses under the patent are to be available to others.

*Licenses of right*

After an entry has been made, the Director-General shall grant to any applicant a license under the patent containing such terms, restrictions and compensation provisions as may be agreed upon by the patentee and the applicant. If the patentee and the applicant cannot agree within the period fixed by the Director-General, the Director-General shall stipulate such terms, restrictions and compensation as he deems appropriate.

A party concerned may appeal a decision of the Director-General under paragraph two to the Board within thirty days from receipt thereof. The decision of the Board shall be final.

Applications for and grants of license under paragraph two shall conform to the rules and procedures prescribed in Ministerial Regulations.

Where an entry is made under paragraph one the annual fees in respect of the patent shall be reduced as prescribed in Ministerial Regulations but to not less than half the annual fees.

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<sup>15</sup> PA '79 Section 44, para. two. If the annual fee and the surcharge are not paid within one hundred eighty days from the expiration of the period prescribed in Section 43, the patent shall lapse.



**Section 46.\*** After the expiration of three years from the grant of a patent, or four years from the date of application, whichever is later, any person may apply to the Director-General for a license if it appears at the time when such request is filed:-

*Compulsory  
licensing*

(1) that, without sufficient reason, the patented product is not being produced or the patented process is not being used in the country; or

(2) that, without sufficient reason, the patented products or products produced by the patented process are not being sold in the country, or, if sold, are sold at unreasonably high prices or in quantity insufficient to meet domestic public demand.

Whether applying under (1) or (2), the applicant for a license must show that he made an effort to obtain a license from the patentee having proposed conditions and compensation reasonable under the circumstances but was unable to come to terms within a reasonable period.

Applications for patent licenses shall be in accordance with the rules, procedures and conditions prescribed in Ministerial Regulations.<sup>16</sup>

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<sup>16</sup> *PA '79 Section 46. After the expiration of three years from the grant of a patent, any person may apply to the Director-General for a license if it appears at the time when such application is filed:-*

*(1) that, without sufficient reason, the patented product is not being manufactured or the patented process is not being used in the country; or*

*(2) that, without sufficient reason, the patented products or products produced by the patented process are not being sold in the country, or, if sold, are sold at unreasonably high prices or in quantity insufficient to meet public demand.*

*Applications for licenses shall comply with the rules, procedures and conditions prescribed in Ministerial Regulations.*

**Section 46 bis.\*** On finding that the facts under Section 46 (1) or (2) exist, but no one has applied for a patent license, the Director-General shall cause to be advertised in the Government Gazette that without sufficient reason there has been no production of a patented product or use of a patented process within the Kingdom or that without sufficient reason there has been no sale of a patented product or product made by a patented process or there has been such sale at unreasonably high prices or in quantity insufficient to meet domestic demand, as the case may be.

Before advertising in the Government Gazette under paragraph one, the Director-General shall order an examination of the facts and notify the patentee or patent licensee to submit an answer. The answer shall be filed within sixty days from the date of receipt of the order. The Director-General may summon any person to give further statements or submit documents or other things.

When the advertisement appears in the Government Gazette, other persons shall be entitled to apply for a license of such patent.

Applications for patent licenses shall be in accordance with the rules, procedures and conditions prescribed in Ministerial Regulations.<sup>17</sup>

**Section 47.\*** If the working of any claim contained in a patent is likely to constitute an infringement of the patent claims of another person, the patentee desiring to work his own patent may apply to the Director-General for a license under the patent of such other person if it appears that:-

(1) the grant of such license will not unreasonably affect the exercise of the rights of the other patentee or his licensees under Section 38,

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<sup>17</sup> *Added by PA '92 Section 18.*

(2) the invention of the patentee who applies for such license is of great economic importance or meets domestic public demand, and

(3) the patentee who applies for such license will not be able to work his patent economically unless he is licensed under the other patent as requested.

For this purpose, the applicant for a license must show that he made an effort to obtain a license from the patentee having proposed conditions and compensation reasonable under the circumstances but was unable to come to terms within a reasonable period.

Applications for a patent license shall be in accordance with the forms, rules procedures and conditions prescribed in Ministerial Regulations.<sup>18</sup>

Section 48.\* Where a license is granted under Section 46, 46 bis or 47, the patentee shall be entitled to compensation.

*Compensation for compulsory licenses*

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<sup>18</sup> *PA '79 Section 47. If the working of any claim contained in a patent is likely to constitute an infringement of the patent of another person, the patentee desiring to work his own patent may apply to the Director-General for a license under the patent of such other person provided:-*

*(1) the grant of such license will not unreasonably affect the working of the patent of such other person or his licensees under Section 38,*

*(2) the invention of the patentee who applies for such license is, within the country, of great commercial importance or meets public demand, and.*

*(3) the patentee who applies for such license will not be able to work his patent commercially unless he is licensed by the other person. Applications for a license shall follow the forms, rules, procedures and conditions prescribed in Ministerial Regulations.*

Where a license is granted under Section 46, 46 bis or 47, the licensee under Section 38 shall be entitled to the compensation provided he has the exclusive right to grant licenses to other persons. In such case, the patentee shall not be entitled to compensation.<sup>19</sup>

**Section 49.\*** In an application for a license made under Section 46, 46 bis or 47, the applicant shall, together with the request for a license, propose an amount of compensation, conditions for the exercise of the patent rights and restrictions of the rights of the patentee and licensee under Section 48 paragraph two and, in an application for a license under Section 47, shall also offer a license under his patent in compensation to the other party.

*Compulsory  
licensing procedure*

When an application for a license is filed under Section 46, 46 bis or Section 47, the competent officer shall notify the applicant, the patentee and the licensee under Section 48 paragraph two of the date on which the application will be examined. The patentee and the licensee under Section 48 paragraph two shall be furnished with a copy of the application.

During the course of examination under paragraph two, the competent officer may summon the applicant, the patentee and the exclusive licensee under Section 48 paragraph two to make statements or to deliver additional documents or items. When the competent officer has completed his examination and the Director-General has given his decision, the applicant, the patentee and the licensee under Section 48 paragraph two shall be notified thereof.

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<sup>19</sup> *PA '79 Section 48. Where a license is granted under Section 46 or 47, the patentee shall be entitled to compensation.*

*Where a license is granted under Section 46 or 47, the licensee under Section 38 shall be entitled to the compensation provided he has the exclusive right to grant licenses to other persons. In such case, the patentee shall not be entitled to compensation.*

A decision of the Director-General under paragraph three may be appealed to the Board by a party concerned within sixty days from the date of receipt thereof.<sup>20</sup>

**Section 50.\*** Upon deciding that a license shall be granted to an applicant under Section 46, 46 bis or 47, the Director-General shall stipulate compensation, conditions for the exercise of the patent rights and restrictions of the rights of the patentee and licensee under Section 48 paragraph two in accordance with the agreement between the patentee and applicant. If no agreement is reached by the two parties within the period fixed by the Director-General, the Director-General shall stipulate such compensation, conditions and restrictions as he deems appropriate subject to the following rules:-

*Power to fix terms*

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<sup>20</sup> PA '79 Section 49. *In an application for a license made under Sections 46 or 47, the applicant shall, together with the request for a license, propose an amount of compensation, conditions for the working of the patent and restrictions of the rights of the patentee and licensee under Section 48 paragraph two and, in an application for a license under Section 47, shall also offer a license under his patent in compensation to the other party.*

*When an application for a license is filed under Section 46 or Section 47, the competent officer shall notify the applicant, the patentee and the licensee under Section 48 paragraph two of the date on which the application will be examined. The patentee and the licensee under Section 48 paragraph two shall be furnished with a copy of the application.*

*During the course of examination under paragraph two, the competent officer may summon the applicant, the patentee and the exclusive licensee under Section 48 paragraph two to make statements or to deliver additional documents or items. When the competent officer has completed his examination and the Director-General has given his decision, the applicant, the patentee and the licensee under Section 48 paragraph two shall be notified thereof.*

*A decision of the Director-General under paragraph three may be appealed to the Board by a party concerned within thirty days from the date on which such decision is received. The decision of the Board shall be final.*

- (1) the extent and period of time of the license shall not be more than necessary under the circumstances;
- (2) the patentee shall also be entitled to appoint other licensees under his patent;
- (3) the licensee shall not be entitled to assign the license to others unless the business or goodwill of the business concerned with the license is also assigned;
- (4) the licensing shall be aimed primarily at meeting domestic public demand;
- (5) the compensation must be adequate under the circumstances.

Upon stipulating compensation, conditions for the exercise of the patent rights and restrictions thereof, the Director-General shall issue a license to the licensee.

A party concerned may appeal an order of the Director-General under paragraph one to the Board within sixty days from the date of receipt thereof.

The issue of patent licenses under paragraph two shall follow the forms, rules and procedures prescribed in Ministerial Regulations.<sup>21</sup>

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<sup>21</sup> PA '79 Section 50. Upon deciding that a license shall be granted to an applicant under Section 46 or 47, the Director-General shall stipulate compensation, conditions for the working of the patent and restrictions of the rights of the patentee and licensee under Section 48 paragraph two in accordance with the agreement between the patentee and applicant. If no agreement is reached by the two parties within the period of fixed by the Director-General, the Director-General shall stipulate such compensation, conditions and restrictions as he deems appropriate. When the Director-General has done so, he shall issue a license to the applicant.

A party concerned may appeal a decision of the Director-General under paragraph one to the Board within thirty days from the date of receipt thereof.

The issue of patent licenses under paragraph two shall follow the forms, rules and procedures prescribed in Ministerial Regulations.

**Section 50 bis.\*** A patent license issued under Section 46 or 46 bis may be terminated if it appears that the reason for giving the license has ceased to exist and is not likely to recur provided the termination does not affect the rights or interests of the licensee under the license.

Applications for termination of a license under the first paragraph shall be in accordance with the forms, rules and procedures prescribed in Ministerial Regulations, the provisions of Section 49, paragraphs two and three and Section 50 applying *mutatis mutandis*.<sup>22</sup>

**Section 51.\*** In the interest of activities of public utility or essential to national defence, or for the preservation or realization of natural resources or the environment or to relieve a severe shortage of food or drugs or for other public benefit without a commercial objective, ministries, public bodies and departments, themselves or through others, may exercise any patent right under Section 36 but in so doing shall pay compensation to the patentee or licensee under Section 48 paragraph two without being subject to the provisions of Sections 46, 46 bis and Section 47, and shall so notify the patentee in writing without delay.

In such cases, a proposal for compensation and license terms shall be submitted to the Director-General. The compensation fixed shall be that agreed between the ministry, public body or department and the patentee and Section 50 shall apply *mutatis mutandis*.<sup>23</sup>

<sup>22</sup> *Added by PA '92 Section 20.*

<sup>23</sup> *PA '79 Section 51. In the interest of activities of public utility or essential to national defence, or for the realization of natural resources or agricultural or industrial development, or for other public benefit, ministries, public bodies and departments may exploit any patent by paying compensation to the patentee or licensee under Section 48 paragraph two without being subject to the provisions of Section 46 and Section 47.*

*In such cases, a proposal for compensation and license terms shall be submitted to the Director-General. The compensation fixed shall be that agreed between the ministry, public body or department and the patentee and Section 50 shall apply mutatis mutandis.*

*Use of patented inventions by the State*

**Section 52.\*** During a state of war or emergency, the state shall have the power, upon paying reasonable compensation to the patentee, to exercise any patent right if necessary for the defense of the country and security of the nation. The power under this Section shall be exercised by Royal Decree giving the name of the patentee and patent number except that, if necessary, neither need be stated.<sup>24</sup>

## PART VI

### SURRENDER OF PATENTS OR CLAIMS AND CANCELLATION OF PATENTS

**Section 53.** A patentee may surrender his patent or any claim or claims thereunder in accordance with the rules and procedures prescribed in Ministerial Regulations.

*Surrender of patent*

To surrender a patent or claim under paragraph one, if the patent is jointly owned by two or more persons, the consent of all shall be required and if licenses have been granted under Section 38, 45, 46 or 47, the consent of all licensees shall also be required.

**Section 54.** Any patent issued contrary to the provisions of Section 5, 9, 10, 11 or 14 is invalid.

*Cancellation for  
invalidity*

The invalidity of a patent under paragraph one may be raised by any person. A petition to cancel an invalid patent may be submitted to the court by an interested person or by the public prosecutor.

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<sup>24</sup> *PA '79 Section 52. During a state of war or emergency, the state shall have the power to exercise any patent right if necessary for the defense of the country and security of the nation. The power under this Section shall be exercised by Royal Decree giving the name of the patentee and patent number except that, if necessary, neither need be stated.*



**Section 55.\*** The Director-General may request the Board to cancel a patent in the following cases:-

- (1) two years after the issue of a license under Section 50 if it appears the licensing has been unable effectively to prevent or alleviate the condition for which a license was issued under Section 46 or 46 bis, or
- (2) the patentee has licensed another person to exercise the patent rights in violation of Section 41.

*Cancellation for non-working or inadequate sale*

Before requesting the Board to cancel a patent, the Director-General shall order an inquiry and notify the patentee and licensees to submit their briefs within sixty days from the date of receipt of notification. The Director-General may summon any person to make statements or deliver any additional documents or items.<sup>25</sup>

After the inquiry, if it appears there are reasonable grounds for cancelling the patent the Director-General shall submit his report to the Board for cancellation of the patent.

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<sup>25</sup> *PA '79 Section 55, para. one and two. After the expiry of six years from the grant of a patent, The Director-General may request the Board to cancel it if it appears:-*

- (1) *that for no sufficient reason the patented product is not being manufactured or the patented process is not being used in the country;*  
*or*
- (2) *that, for no sufficient reason the patented product or product produced by a patented process is not being sold in the country, or if sold is sold at an unreasonably high price or in quantity insufficient to meet public demand.*

*Before requesting the Board to cancel a patent, the Director-General shall order an inquiry and notify the patentee and licensees to submit their briefs within thirty days from the date of receipt of notification. The Director-General may summon any person to make statements or deliver any additional documents or items.*

## PART VII

## MEASURES APPLYING TO DRUG PATENTS

**Section 55 bis.\*** Holders of patents for drugs or processes concerning drugs or their ingredients shall report data and submit documents relating to information as follows:

*Drug patentees to give information*

- (1) the domestic selling price of drugs protected by the patent as required by the Drug Patent Board;
- (2) the cost of production and distribution of the drugs protected under the patent known to the patentee or under the control of the patentee as required by the Drug Patent Board;
- (3) particulars relating to domestic licensees under the drug patent or drug or drug ingredient process patent (if any).

The reports under the first paragraph shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.<sup>26</sup>

**Section 55 ter.\*** There shall be a committee called the "Drug Patent Board" composed of the Under-Secretary of the Ministry of Commerce as chairman, Director-General of the Commercial Registration Department<sup>27</sup>, Secretary-General of the Food and Drug Commission and Director of the Office of the Consumer Protection Board as members and not more than six additional qualified members appointed by the Council of Ministers of which at least three shall be appointed from the private sector with the Director-General of the Internal Trade Department as member and secretary.

*Drug Patent Board*

The provisions on term of office of Section 67 and 68 shall apply to the qualified members *mutatis mutandis*.

The provisions of Section 69 on meetings shall apply to meetings of the Drug Patent Board *mutatis mutandis*.<sup>28</sup>

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<sup>26, 28</sup> *Added by PA '92 Section 24.*

<sup>27</sup> *See Footnote 1.*

**Section 55 quater.\*** The Drug Patent Board shall have the following powers and duties:-

(1) to follow and compare the price of drugs protected by patents with the price of unpatented drugs of the same category;

(2) to take action under Section 55 quinque in the event there is no sale of the patented drug or the drug is sold at an unreasonably high price or the price is increased in excess of the consumer price index without sufficient reason or without sufficient reason the supply of the drug is insufficient to meet domestic public demand;

(3) to submit opinions to the Council of Ministers concerning policy in respect of drug patents and patents on processes for drugs and their ingredients as well as policy and measures to promote research and development of drugs and processes for drugs and their ingredients;

(4) with the approval of the Ministry of Finance, to consider and prescribe regulations concerning the subsidizing of research and development of drugs and processes for drugs and their ingredients.

*Powers:*

*to compare prices*

*to report abuses*

*to give policy opinions*

*to promote research and development*

In the performance of its duties under the first paragraph, in addition to considering information and documents reported under Section 55 bis, the Drug Patent Board is empowered to require the patentee or licensee or any person to give information or opinions or to submit data or documents concerned.<sup>29</sup>

**Section 55 quinque.\*** In the event the Drug Patent Board finds there has been no sale of a drug protected by patent or its sale is at an excessive price or its price has been increased in excess of the rise of the consumer price index without sufficient reason or the supply of the drug is insufficient to meet domestic public demand without sufficient reason, it is empowered to do one of the following:-

*Abuse reports to Price Fixing Committee or Director-General for compulsory licensing*

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<sup>29</sup> *Added by PA '92 Section 24.*

(1) to notify the Central Committee on Price Fixing and Monopoly Prevention to consider action under the law on price fixing and monopoly prevention;

(2) to notify the Director-General to consider action under Section 46 bis.<sup>30</sup>

**Section 55 sexto.\*** Prior to taking one of the measures under Section 55 quinqué, the Drug Patent Board shall inform the patentee and interested persons giving them an opportunity, within thirty days of receipt of notification, to present data, information and reasons for or against the taking of such action.<sup>31</sup>

*Patentee and interested persons to be notified*

**Section 55 septo.\*** If it finds it appropriate to do so, the Drug Patent Board may appoint one or more sub-committees to perform the duties assigned by the Drug Patent Board. The provisions of Section 69 shall apply to meetings of the sub-committees *mutatis mutandis*.<sup>32</sup>

### CHAPTER III

#### DESIGN PATENTS

**Section 56.** Patents may be granted under this Act for new industrial and handicraft designs.

*Patentable designs*

**Section 57.** The following designs shall not be deemed to be new:-

*Novelty*

(1) a design widely known or used in this country prior to the date of the patent application,

(2) a design of which the representation, essentials or specification were disclosed in a published document or printed matter, whether in this or a foreign country, prior to the date of the patent application,

(3) a design which had been published under Sections 65 and 28 before the filing of the patent application,

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<sup>30, 31, 32</sup> *Added by PA '92 Section 24.*

(4) a design which so nearly resembles any of the designs prescribed in (1), (2) or (3) as to appear to be an imitation.

**Section 58.** The following are not patentable:-

- (1) designs that are contrary to public order or morality;
- (2) designs proscribed by Royal Decree.

*Unpatentable designs*

**Section 59.** Applications for patents shall be made in accordance with the rules and procedures prescribed in Ministerial Regulations.

*Making of applications*

Every application for a patent shall include:

- (1) a representation of the design,
- (2) a statement of the product for which the design is to be used,
- (3) clear claims,
- (4) other matters as prescribed in Ministerial Regulations.

**Section 60.** Each patent application shall relate to a design for use with only one kind of product.

*Application to cover single kind of product*

The products under the first paragraph shall be prescribed by the Minister in the Government Gazette.

**Section 60 bis.\*** Whoever files a design patent application in Thailand within six months of filing a corresponding application outside the Kingdom shall be entitled to claim the priority of the first foreign filing date provided the country of the applicant's nationality gives similar rights to Thai nationals.<sup>33</sup>

**Section 61.** When an application is published under Sections 65 and 28, but before the Director-General orders the registration and issue of a patent for the design, if it appears that the application does not comply with the provisions of Section 56, 58 or Sections 65, 10, 11 and 14, the Director-

*Examination*

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<sup>33</sup> *Added by PA '92 Section 25.*

General shall reject the application. The competent officer shall notify the applicant and the opposing party under Section 65 and 31 of the decision and a copy thereof shall be displayed at the place where patent applications are filed.

Where the Director-General rejects an application under paragraph one and an opposition is lodged under Sections 65 and 31, the Director-General shall proceed to consider the opposition in accordance with Sections 65 and 32.

**Section 62.\*** Design patents shall be valid for ten years from the date of application. The term of a patent shall not include the duration of court proceedings under Sections 65 and 16 or Section 74.<sup>34</sup>

**Section 62 bis.\*** Any act in violation of Section 63 committed before the grant of a patent shall not be deemed an infringement of the patentee's rights unless the act is in respect of a design under a pending patent application which has been published under Sections 65 and 28, the person so acting knowing of the design patent application or having been informed in writing thereof, in which case the applicant shall be entitled to damages from the infringer. Complaints to the court for such damages shall be filed after the patent is granted.<sup>35</sup>

**Section 63.\*** The patentee shall have the sole right to use the patented design for manufactured products and to sell, keep for sale, offer for sale or import products using the patented

*Opposition*

*Term of design patent*

*Damages for wilful infringement retroactive to publication date*

*Rights of patentee*

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<sup>34</sup> PA '79 Section 62. Design patents shall be valid for seven years from the date of application. Any act in violation of Section 63 committed before the grant of a patent shall not be deemed an infringement of the patentee's rights.

The term of a patent under paragraph one shall not include the duration of court proceedings under Sections 65 and 16 or Section 74.

<sup>35</sup> Added by PA '92 Section 27.

design unless the design is used for the benefit of education or research.<sup>36</sup>

**Section 64.** Any patent issued contrary to the provisions of Section 56 or 58 or Section 65 in conjunction with Sections 10, 11 and 14 is invalid.

*Cancellation for invalidity*

The invalidity of a patent under paragraph one may be raised by any person. A petition to cancel an invalid patent may be submitted to the court by an interested person or by the public prosecutor.

**Section 65.** The provisions of Sections 10, 11, 12, 13, 14, 15, 16, 19, 20, 21, 22, 27, 28, 29, 31, 32, 33, 34, 37, 38, 39, 40, 41, 42, 43, 44 and 53 in Chapter II on invention patents shall apply, *mutatis mutandis*, to design patents in Chapter III.

*Applicable sections*

#### CHAPTER IV

##### PATENT BOARD

**Section 66.** There shall be a committee called the "Patent Board" composed of the Under-Secretary of the Ministry of Commerce as chairman and not more than twelve qualified members appointed by the Council of Ministers.

*Composition of Patent Board*

The Board may appoint any person to be Secretary or Assistant Secretary.

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<sup>36</sup> *PA '79 Section 63. Subject to Section 77, the patentee shall have the exclusive right to use the patented design for manufactured products and to sell and keep for sale products using the patented design.*

*The provisions of the preceding paragraph shall not apply to:-*

*(1) reproduction of the patented design for the purpose of education or research;*

*(2) the sale or keeping for sale of products acquired in good faith.*

**Section 67.** Members of the Board appointed by the Council of Ministers shall hold office for a term of two years.

*Term of office*

The term of office of members appointed to fill interim vacancies or of members added by interim appointments shall be the remainder of the term of the previously appointed members.

Members who have vacated office may be reappointed.

**Section 68.** A member appointed by the Council of Ministers shall vacate office upon:-

*Termination of office*

- (1) death,
- (2) resignation,
- (3) discharge by the Council of Ministers,
- (4) becoming bankrupt,
- (5) becoming an incompetent or a quasi-incompetent person, or
- (6) being imprisoned under a final judgment except for a petty offence or an offence committed through negligence.

**Section 69.** A quorum for meetings of the Board shall consist of not less than one half of the total number of members. If the Chairman is absent from a meeting or is unable to act, the Board shall elect one of its members to preside.

*Voting*

Decisions at meetings shall be taken by a majority vote.

Each member shall have one vote. In case of a tie, the presiding chairman shall have an additional casting vote.

**Section 70.\*** The Board shall have the following powers and duties:

*Powers*

- (1) to advise or consult with the Minister on the issuing of Ministerial Regulations under this Act,
- (2) to decide appeals made against orders or decisions of the Director-General under Sections 45, 49, 50 and 72,



- (3) to act under Sections 41 and 55,
- (4) to consider other matters referred by the Minister.<sup>37</sup>

**Section 71.** The Board is empowered to appoint subcommittees to advise the Board. The provisions of Section 69 shall apply, *mutatis mutandis*, to meetings of the subcommittees.

**Section 72.\*** Where an order or a decision is given by the Director-General under Sections 12, 15, 28, 30, 33, 34, 49, 50, 61 or under Section 65 in conjunction with Sections 12, 15, 28, 33, and 34, an interested person under those Sections may appeal to the Board within sixty days after receipt of such order or decision. If no appeal is filed within the said period, the order or decision of the Director-General shall be final.<sup>38</sup>

*Appeals to the Board*

Appeals under the preceding paragraph shall be submitted to the competent officer. If there are other parties involved, the competent officer shall send a copy of the appeal to each of them.

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<sup>37</sup> *PA '79 Section 70. The Board shall have the following powers and duties:*

- (1) to advise or consult with the Minister on the issuing of Royal Decrees and Ministerial Regulations under this Act,
- (2) to decide appeals made against orders or decisions of the Director-General under Sections 45, 49, 50 and 72,
- (3) to act under Sections 41, 55 and 77,
- (4) to consider other matters referred by the Minister.

<sup>38</sup> *PA '79 Section 72, para one. Where an order or a decision is given by the Director-General under Section 12, 15, 28, 30, 33, 34 or 61 or under Sections 65 and 12, 15, 28, 33 and 34, any interested party under those Sections may appeal to the Board within thirty days after receipt of such order or decision. If no appeal is filed within the said period, the order or decision of the Director-General shall be final.*

**Section 73.** In considering an appeal against an order or decision of the Director-General or a report of the Director-General made under Section 55 on cancellation of a patent, the Board may require the opponent, the respondent, the patentee or the licensee, as the case may be, to submit evidence or additional statements in accordance with the rules prescribed by the Board.

*Subpoena powers*

**Section 74.\*** Decisions and orders of the Board under Sections 41, 49, 50, 55 and 72 with the grounds thereof shall be notified to the appellant, other parties involved, the patentee and the licensee, as the case may be. Any party in disagreement with a decision or order may appeal to the court within sixty days from the receipt of notification. Otherwise the decision of the Board shall be final.<sup>39</sup>

*Decision and appeal to court within 60 days*

In cases brought under this Act, the court shall not order the Board or Director-General to pay court fees on behalf of other parties.

## CHAPTER V

### MISCELLANEOUS

**Section 75.** No person, without being entitled to do so under this Act, shall use the words "Thai Patent" or their abbreviation or foreign letters having the same meaning or any other words having the same meaning on any product, container or product package or in advertising any invention or design.

*Use of "Thai Patent"*

**Section 76.** No person, other than an applicant of a pending patent application, shall use the words "Patent Pending" or other words having the same meaning on any product, container or product package or in advertising any invention or design.

*Use of "Patent Pending"*

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<sup>39</sup> PA '79 Section 74, para one. Decisions and orders of the Board under Sections 55 and 72 with the grounds thereof shall be notified to the applicant, other parties involved, the patentee and the licensee, as the case may be. Any party in disagreement with a decision or order may appeal to the court within thirty days from the receipt of notification. Otherwise the decision of the Board shall be final.

**Section 77.\*** In the event a process patentee sues an infringer of his patent rights in a civil action and can prove that the defendant's product is the same as or similar to the product made by the patentee's process, it shall be presumed that the defendant used the patentee's process unless the defendant can prove otherwise.<sup>40</sup>

*Presumption that similar product made by patented process*

**Section 77 bis.\*** If there is clear evidence that someone is doing or is about to do anything in violation of a patentee's rights under Section 36 or 63, the patentee may apply to the court for an injunction against the said person to stop or

*Anticipatory injunction*

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<sup>40</sup> *P. A.'79 Section 77. Before a patented product is manufactured or a patented process or design is used, any person may import foreign-made products covered by such patent. However, in accordance with the rules and conditions prescribed by the Board, the Director-General may, with the approval of the Board, prohibit such importation if so requested by the patentee and if it appears that the patentee has made preparations for the manufacture of products under the patent.*

*When a patented product has been manufactured or a patented process or design has been used, and after notification in the Government Gazette under paragraph three, no person may import a foreign-made product covered by the patent or made by a patented process or in a patented design for commercial purposes, except that in case of necessity where the sale of the product does not meet popular demand any person may apply to the Board for permission to import such product. Applications shall comply with the rules, procedures and conditions prescribed in Ministerial Regulations.*

*When manufacture of products under a patent has commenced, the manufacturer shall inform the competent officer. When the competent officer, upon investigation, finds that the patent has been so worked, he shall report this to the Director-General who shall give notice in the Government Gazette that the product or process or design has been worked. The notification shall take effect sixty days after publication.*

*An application under paragraph two shall not affect the cancellation of a patent under Section 55(2).*

refrain from committing such act. The issue of such an injunction shall not deprive the patentee of the right to demand damages under Section 77 ter.<sup>41</sup>

**Section 77 ter.\*** If there is an infringement of a patent under Section 36 or Section 63, the court is empowered to order the infringer to pay damages to the patentee of an amount the court finds appropriate taking into account the severity of the damage as well as the lost benefits and expenses required to enforce the rights of the patentee.<sup>42</sup>

*Scope of damages*

**Section 77 quater.\*** All goods in the possession of the infringer which infringe the rights of the patentee under Section 36 or 63 shall be confiscated. If it thinks fit, the court may order the destruction of the goods or other measures to prevent further distribution of the goods.<sup>43</sup>

*Confiscation and destruction of infringements*

**Section 78.** Lost or materially damaged patents or licenses may be replaced upon application by the owner in accordance with the rules and procedures prescribed in Ministerial Regulations.

*Loss of damaged patents and licenses*

**Section 79.** All applications, oppositions, counterstatements and appeals under this Act shall be on the forms and in the number of copies prescribed by the Director-General.

*Formal requirements*

**Section 80.** A fee, as prescribed in Ministerial Regulations, shall be paid for each application for a patent, publication of an application for a patent, request for examination of an invention, opposition to the grant of a patent, application for the registration of a patent license agreement, application for the assignment of a patent, application for an entry to be made in a patent that any person may apply for a license, application for a license, a license certificate, appeal against an order or a decision of the Director-General, a replacement patent or license, any other request or application, the making of a copy of a document and certification of a document.

*Fees*

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<sup>41, 42, 43</sup> Added by PA '92 Section 33.

**CHAPTER VI**  
**OFFENCES AND PENALTIES**

**Section 81.** Any official who violates Section 21 or Section 23, paragraph two or Section 65 in conjunction with Section 21 shall be liable to imprisonment for not more than two years or a fine not exceeding two hundred thousand baht or both.

*Unauthorized disclosure by officials*

**Section 82.** Any person who violates Section 22 or Section 65 in conjunction with Section 22 shall be liable to imprisonment for not more than six months or a fine not exceeding twenty thousand baht or both.

*Unauthorized disclosure of applications by others*

**Section 83.** Any person who violates Section 23 paragraph two shall be liable to imprisonment for not more than one year or a fine not exceeding fifty thousand baht or both.

*Violation of secrecy orders by non-officials*

**Section 83 bis.\*** Any person who does not report data or submit documents under Section 55 bis or does not comply with an order of the Drug Patent Board under Section 55 quater, paragraph two shall be liable to imprisonment for not more than six months or a fine not exceeding one hundred thousand bath or both.<sup>44</sup>

*Failure to supply information on patented drugs*

**Section 83 ter.\*** Any person who discloses information under Section 55 quinqué acquired or uncovered in consequence of the carrying out of this Act shall be liable to imprisonment for not more than one year or a fine not exceeding two hundred thousand baht or both unless such disclosure was in the course of official action or in the interests of examination or legal proceedings.

*Unauthorized disclosure of drug information*

Any person who, having acquired or uncovered information from the persons under the first paragraph in consequence of official action or examination or legal proceedings, discloses such information in a way likely to cause damage to any person shall be liable to the same penalty.<sup>45</sup>

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<sup>44, 45</sup> *Added by PA '92 Section 34.*

Section 83 quater.\* If the offense under Section 83 bis is a continuing action, the offender shall be liable to a fine not exceeding one hundred thousand baht per day.<sup>46</sup>

Section 84. Any person who violates Section 75 or Section 76 shall be liable to imprisonment for not more than one year or a fine not exceeding two hundred thousand baht or both.

*Unwarranted use of words "Thai Patent" or "Patent Pending"*

Section 85.\* Any person who does anything under Section 36 or Section 63 without the permission of the patentee shall be liable to imprisonment for not more than two years or a fine not exceeding four hundred thousand baht or both.<sup>47</sup>

*Patent infringement*

Section 86.\*<sup>48</sup>

Section 87. An applicant for an invention or design patent who, in order to obtain a patent, makes a false statement to the competent officer shall be liable to imprisonment for not more than six months or a fine not exceeding five thousand baht or both.

*Liability for false statements*

Section 88. In the event an offender punishable under this Act is a juristic person, the persons in charge of or representing such juristic person, except those who can prove that the juristic person acted without their knowledge or consent, shall be liable to the penalties prescribed by law for the offence.

*Liability of managers and directors*

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<sup>46</sup> *Added by PA '92 Section 34.*

<sup>47</sup> *PA '79 Section 85. Any person who, without being entitled to do so under this Act, produces a patented product or uses a patented process or a patented design shall be punished with imprisonment not exceeding three years or a fine not exceeding three hundred thousand baht or both.*

<sup>48</sup> *Repealed by PA '92 Section 36. PA '79 Section 86. Any person who sells or keeps for sale a product made under a patent or by a patented process or in a patented design, knowing that the producer of such product had no right to do so under this Act, shall be punished with imprisonment not exceeding two years or a fine not exceeding twenty thousand baht or both.*

**PATENTS ACT (No. 2) 2535 (1992)**

**Section 38.** Patents issued prior to the date this Act comes into force [30 September 1992] shall be governed by the provisions of the Patents Act B. E. 2522 (1992).

**Section 39.** Patent applications filed prior to the date this Act comes into force in respect of which the Director General has not given an order under Section 33 or 34 or under Section 65 in conjunction with Sections 33 or 34 of the Patents Act B. E. 2522 (1979) shall be deemed applications under the Patents Act B. E. 2522 amended by this Act, *mutatis mutandis*.

## SCHEDULE OF FEES

	Baht	<i>Maximum fees</i>
(1) An application for a patent	1,000	
(2) Publication of a patent application	500	
(3) A request for patent examination	500	
(4) An opposition to a patent application	1,000	
(5) A patent	1,000	
(6) Annual fees for invention patents:		
fifth year	2,000	
sixth year	4,000	
seventh year	6,000	
eighth year	8,000	
ninth year	10,000	
tenth year	12,000	
eleventh year	14,000	
twelfth year	16,000	
thirteenth year	18,000	
fourteenth year	20,000	
fifteenth year	30,000	
sixteenth year	40,000	
seventeenth year	50,000	
eighteenth year	60,000	
nineteenth year	70,000	
twentieth year	80,000	
(7) Annual fees for design patents:		
fifth year	1,000	
sixth year	2,000	
seventh year	3,000	
eighth year	4,000	
ninth year	5,000	
tenth year	6,000	



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(8) An application for the registration of a patent license	500
(9) An application to record the assignment of a patent	500
(10) A patent license	1,000
(11) A replacement patent or license	100
(12) An appeal against an order or decision of the Director-General	1,000
(13) Copies of documents, each	10
(14) Certifying copies of documents of more than ten pages, each	100
of not more than ten pages, each	10
(15) Any other application	100

*[N.B. The marginal notes have been added for convenience. They are not part of the Act.]*

**ANNEX II**

**TRADEMARKS ACT**

**B.E. 2534 (1991)**

# TRADEMARKS ACT

## B.E. 2534 (1991)

**H.M. KING BHUMIBOL ADULYADEJ**

Given on the 28th day of October

B.E. 2534 (1991)

being the 46th year of the present reign.

By royal command of His Majesty King Bhumipol Aduldej it is hereby proclaimed that:

Whereas it is proper to amend the law on trademarks,

**IT IS HEREBY ENACTED** by the King's Most Excellent Majesty with the advice and consent of the national legislature as follows:

**Section 1.** This Act shall be cited as the Trademarks Act B.E. 2534.

*Title*

**Section 2.** This Act shall come into force at the expiration of ninety days from the date of publication in the Government Gazette.\*

*Act comes into force  
90 days after publication*

**Section 3.** The following shall be repealed:

*Previous laws repealed*

(1) Trademarks Act B.E. 2474

(2) Trademarks Act (No.3) B.E. 2504.

All laws, regulations and other rules insofar as they are provided for herein or are contrary to or inconsistent with the provisions hereof shall be superseded by this Act.

**Section 4.** In this Act:-

*Definitions*

“mark” means a photograph, drawing, device, brand, name, word, letter, numeral, signature, or any one or combination thereof but not including industrial designs under the law on patents;

“trademark” means a mark used or proposed to be used on or in connection with goods to distinguish the goods with which the trademark of the proprietor of such trademark is used from goods under another person's trademark;

\* Published in the Government Gazette Vol. 108, Part 199 on 15th November, 1991 and in force on 13th February, 1992.

“service mark” means a mark used or proposed to be used on or in connection with services to distinguish the services using the service mark of the proprietor of such service mark from services under another person’s service mark;

“certification mark” means a mark used or proposed to be used by the proprietor thereof on or in connection with goods or services of another person to certify the origin, composition, method of production, quality or other characteristics of such goods or to certify as to the nature, quality, type or other characteristics of such services;

“collective mark” means a trademark or service mark used or proposed to be used by companies or enterprises of the same group or by members of an association, cooperative, union, confederation, group of persons or any other state or private organization;

“licensee” means a person licensed under this Act by the proprietor of a registered trademark or service mark to use such trademark or service mark;

“Registrar” means the person appointed by the minister to be registrar to act pursuant hereto;

“Director General” means the Director-General of the Commercial Registration Department;

“Board” means the Trademark Board;

“Minister” means the minister in charge under this Act.

**Section 5.** The Minister of Commerce shall be in charge of the execution of this Act and shall have the power to appoint the Registrar, issue ministerial regulations prescribing fees no higher than those given in the schedule annexed hereto and prescribing other matters and issue notifications in order to carry out the provisions of this Act.

*Minister of Commerce  
in charge*

Such regulations and notifications shall take effect upon publication in the Government Gazette.

**CHAPTER I  
TRADEMARKS**

**Part 1**

**Trademark Applications**

**Section 6.** To be registrable, a trademark must

*Requisites for  
registrability*

- (1) be distinctive;
- (2) not be prohibited under this Act;
- (3) not be the same as or similar to a trademark registered by another person.

**Section 7.** A distinctive trademark is one which enables the public or users to distinguish the goods with which the trademark is used from other goods.

*Distinctive marks*

A trademark having one or more of the following essential particulars shall be deemed distinctive:-

- (1) a personal name, a surname not being such according to its ordinary signification, a name of a juristic person or a tradename represented in a special manner;
- (2) a word or words having no direct reference to the character or quality of the goods and not being a geographical name designated by the Minister by notification;
- (3) stylized letters, numerals or words;
- (4) the signature of the applicant for registration or some predecessor in his business or the signature of another person with his or her permission;
- (5) a representation of the applicant or of another person with his or her permission or of a dead person with the permission of his or her ascendants, descendants and spouse, if any;
- (6) an invented device.

Names and words not included under (1) or (2) if used as trademarks with goods which have been widely sold or advertised in accordance with the rules prescribed by the Minister by notification and if it is proved that the rules have been duly met shall be deemed distinctive.

*Acquired distinctiveness  
may be proved*

DS&B 1991

**Section 8.** Trademarks of the following description shall not be registrable:-

*Prohibited marks*

- (1) state arms or crests, official emblems, the royal standard, official and national flags of Thailand;
- (2) national emblems and flags of foreign states, emblems and flags of international organizations of which Thailand is a member or which are widely known, unless permission is given by the competent officer of the foreign state or international organization;
- (3) royal names and royal monograms;
- (4) representations of the King, Queen or royal descendants;
- (5) royal and official seals and seals of office;
- (6) emblems and insignia of the royal orders and decorations;
- (7) emblems of the Red Cross or appellations "Red Cross" or "Geneva Cross";
- (8) a mark identical with or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Thai government or a Thai government department or enterprise, a foreign government or international organization unless such medal, diploma, certificate or mark has been actually awarded to the applicant for goods and is used in combination with the trademark;
- (9) trademarks similar to those under (1) (2) (3) (5) (6) or (7);
- (10) any mark which is contrary to public order, morality or public policy;
- (11) a mark which is the same as a generally famous mark, registered or not, or so similar thereto that the public might be confused as to the proprietor or origin of the goods;
- (12) other trademarks designated by the Minister by notification.

*Famous marks not registrable by others*

**Section 9.** Application for registration of a trademark may be made for specific goods in one class or in different classes but the particular kinds of goods for which protection is desired shall be clearly specified.

*Goods must be specified*

An application may not cover goods in more than one class.

*One class per application*  
DS&B 1991

The classification of goods shall be as prescribed by the Minister by notification.

*Minister may select  
International  
Classification*

**Section 10.** For a trademark to be registrable, the applicant or his agent shall have an office or address in Thailand for communication by the Registrar.

*Address for service in  
Thailand*

**Section 11.** Applications for trademark registration shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

*Formal requirements  
for applications*

**Section 12.** In considering trademark applications, the Registrar shall have the following powers:-

*Registrar's powers in  
dealing with applications*

- (1) in writing to ask or summon the applicant to give an oral statement or submit a written statement or submit any document or evidence concerning the application for examination or consideration;
- (2) require the applicant to translate any document or evidence in a foreign language into Thai within such period or time as he may find reasonable;
- (3) invite anyone to give information, explanations, advice or opinions.

If an applicant does not, without sufficient reason, comply with an order of the Registrar under (1) or (2), the application shall be deemed to be abandoned.

**Section 13.** Subject to Section 27, the Registrar shall not register a trademark applied for upon finding that:-

*Confusing similarity  
with registered marks  
in same class or, if  
goods alike, in  
different classes*

(1) it is the same as a trademark already registered by someone else or,

(2) it is so similar to another's registered trademark that the public might be confused or misled as to the proprietor or origin of the goods,

provided the application is for goods of the same class or for goods of a different class found by the Registrar to be of the same character.

**Section 14.** In the event registered or pending trademarks of the same proprietor covering goods of the same class or of different classes but of the same character so resemble one another that the public

*Association of  
resembling marks*

might be confused or misled as to the proprietor or origin of the goods if used by different persons, the Registrar shall require the trademarks to be registered as associated trademarks and shall in writing promptly notify the applicant.

**Section 15.** If, in the opinion of the Registrar,

(1) any unessential part of a trademark applied for is not registrable under Section 6, or

(2) any application for registration is contrary to Section 9 or Section 10 or is not in accordance with the rules and procedures prescribed in Ministerial Regulations under Section 11,

the Registrar shall require and in writing promptly notify the applicant to amend the application within ninety days from the date of receipt of the order.

*Correction of applications within 90 days*

**Section 16.** If, in the opinion of the Registrar, the entire trademark or any essential part thereof is not registrable under Section 6, the Registrar shall refuse registration and shall in writing promptly inform the applicant of the order giving the grounds therefor.

*Rejection for non-registrability of essential part of mark*

**Section 17.** If, in the opinion of the Registrar, a trademark considered as a whole is registrable under Section 6 but contains one or more parts which are common to the trade for some types or classes of goods such that no applicant should have exclusive right thereto or which are not distinctive, the Registrar may

*Registration subject to disclaimer*

(1) order the applicant, within ninety days from receipt of the order, to disclaim exclusive right to use of such part of the trademark;

(2) order the applicant, within ninety days from receipt of the order, to make such other disclaimer as the Registrar may consider needful for the purpose of defining the proprietor's rights under such registration.

Pursuant to the first paragraph, the Registrar shall have the power to declare by notification what is common to the trade with respect to certain types or classes of goods.

The Registrar shall in writing promptly inform the applicant of any order under the first paragraph giving the grounds therefor.

DS&B 1991



**Section 18.** The applicant shall be entitled to appeal orders of the Registrar under Sections 14, 15, 16 and 17 to the Trademark Board within ninety days from receipt thereof. Decisions of the Trademark Board shall be final.

*Registrability rulings  
appealable to Board  
within 90 days*

If the Board decides that an order of the Registrar under Section 14 is correct, the Registrar shall take further action with respect to such application.

If the Board decides that an order of the Registrar under Section 15 or 17 is correct, the applicant shall comply with the order of the Registrar within ninety days from receipt of the decision of the Board.

If the Board decides that an order of the Registrar under Section 14, 15, 16 or 17 is incorrect, the Registrar shall take further action with respect to such application.

**Section 19.** If an applicant does not appeal under Section 18, para. one, and does not comply with an order of the Registrar under Section 15 or 17, as the case may be, or if the applicant appeals under Section 18, para. one, but does not comply with Section 18, para. three, the application shall be deemed abandoned.

*Application  
abandoned if no  
appeal filed*

**Section 20.** Subject to Sections 21, 22, 23, 24, 25, 26, 35 and 41, where several applicants file applications for registration of trademarks which in the opinion of the Registrar are the same or so similar that the public might be confused or misled as to the proprietor or origin of the goods and the applications cover goods in the same class or goods in different classes having, in the opinion of the Registrar, the same character, the prior applicant shall be entitled to be registered as the proprietor.

*Rival claimants:  
prior applicant  
entitled to  
registration*

**Section 21.** If, in the opinion of the Registrar, the same or similar trademarks under Section 20 are all registrable under Section 6 and the applications are in conformity with the provisions of this Act, the Registrar shall order the applicants to comply with Section 24 and shall promptly inform the applicants in writing.

*Rival claimants: to  
come to terms or appeal  
determination of  
similarity within  
90 days.*

An applicant who does not agree that his trademark is the same as or similar to other trademarks under Section 20, shall be entitled to appeal the order of the Registrar under para. one to the Board within ninety days from receipt of the order, Sections 18 and 19 applying *mutatis mutandis*.

**Section 22.** If, in the opinion of the Registrar, one or more of the same or similar trademarks under Section 20 come within Section 15 (1) or (2) or Section 17 but others are registrable under Section 6 and the applications are in compliance with the provisions of this Act, the Registrar shall order the applicants of the trademarks within Section 15 (1) or (2) or Section 17 to comply with Section 15 or 17 as the case may be and shall hold the duly registrable applications in abeyance. The Registrar shall promptly inform the applicants in writing and the provisions of Section 21, para. two, shall apply *mutatis mutandis*.

*Pending applications  
of rival claimants given  
time to be amended*

If it appears that an applicant whose trademark is found by the Registrar to come within Section 15 (1) or (2) or Section 17 complies with the order of the Registrar under Section 15 or appeals under Section 18, para. one, and the Board decides the order of the Registrar is incorrect, the Registrar shall order the applicant and the applicants whose applications have been held in abeyance under para. one to comply with Section 24 and shall promptly inform the applicants thereof in writing.

If it appears that all of the applicants whose trademarks have been found by the Registrar to come within Section 15 (1) or (2) or Section 17 abandon their applications under Section 19: –

(1) if there are other applications held in abeyance under para. one, the Registrar shall order the applicants to comply with Section 24 and shall promptly inform the applicants in writing;

(2) if there is only one application held in abeyance under para. one, the Registrar shall order the advertisement of that application under Section 29.

**Section 23.** If the Registrar finds that all of the applications for the same or similar trademarks under Section 20 come within Section 15 (1) or (2) or Section 17, the Registrar shall order the applicants to comply with Section 15 or Section 17 as the case may be and shall hold the applications in abeyance. The Registrar shall promptly inform the applicants in writing and Section 21 para. two shall apply *mutatis mutandis*.

If it appears that such applicants have complied with the order of the Registrar under Section 15 or 17 or have appealed under Section 18, para. one, and the Board has decided that the order of the Registrar

is not correct, the Registrar shall order the applicants to comply with Section 24 and shall promptly inform the applicants in writing. But if it appears that only one of the said applicants has complied with the order of the Registrar under Section 15 or 17 or has appealed under Section 18, para. one, and the Board has decided that the order of the Registrar is not correct, the Registrar shall order the advertisement of that trademark application under Section 29.

**Section 24.** Within ninety days from the date of receipt of the order of the Registrar under Section 21, para. one, Section 22, para. two or three (1) or Section 23 para. two, the applicants shall agree as to which one shall be the sole proprietor of the trademark and any of the applicants shall inform the Registrar in writing within such period whether or not agreement has been reached.

*90 days to come to terms. Multiple owners of similar marks not allowed by agreement*

**Section 25.** In the event the Registrar has been informed within the period specified in Section 24 as to which applicant is allowed by agreement to register, the Registrar shall order that application advertised under Section 29.

If informed within the period prescribed in Section 24 that no agreement has been reached or if not informed within the said period, the Registrar, under Section 29, shall order the advertisement of the trademark of the first applicant or of the first among those who have not abandoned their applications, as the case may be.

**Section 26.** In the event the Registrar has already given notice to the applicants to comply with Section 24 and another applicant files an application for a trademark which the Registrar finds to be the same as those of the other applicants or so similar thereto that the public might be confused or misled as to the proprietor or origin of the goods, the goods being of the same class or of the same character in a different class, the Registrar shall refuse registration and shall promptly inform the applicant in writing, Section 21, para. two, applying *mutatis mutandis*.

*After rival claimants notices issued, later resembling applications rejected*

**Section 27.** If of the opinion there has been honest concurrent user or special circumstances which make it proper to do so, the Registrar may allow the registration by more than one proprietor of a trademark which is the same as or similar to a registered trademark under Section 13 or to pending trademarks under Section 20 in respect of goods of the same class or goods of a different class but found by the Registrar to be of the same character subject to such conditions and limitations as to the mode or place of user or such

*Honest concurrent user or special circumstances may justify resembling marks*

other conditions and limitations as the Registrar may think fit to impose. The Registrar shall promptly so inform the applicants and registered trademark proprietor in writing giving the grounds.

The applicant or registered trademark proprietor shall be entitled to appeal an order of the Registrar under para. one to the Board within ninety days from the date of receipt thereof.

Decisions of the Board under para. two shall be final.

**Section 28.** If a trademark first filed for registration in a foreign country is filed in Thailand within six months from its first filing, the first foreign filing date shall be deemed the filing date in Thailand, provided the country of first filing grants similar rights to persons who have their real principal place of business in Thailand and to Thai nationals.

*Six months priority  
filing date allowed  
under certain  
circumstances*

For the purpose of this Section, the country of first filing shall be one in which the applicant has his real principal place of business or his domicile or of which the applicant is a national.

## PART 2

### TRADEMARK REGISTRATION AND THE EFFECT OF REGISTRATION

**Section 29.** When an application for registration of a trademark is considered acceptable, the Registrar shall order the application to be advertised.

*Registrable marks  
to be advertised*

When an order under the first paragraph is given, the Registrar shall so inform the applicant in writing and shall require the payment of the advertisement fee within thirty days of receipt of the notice. If the applicant does not pay the fee within the prescribed time, the application shall be deemed abandoned.

Advertisement of applications shall be in accordance with the procedures prescribed in Ministerial Regulations.

**Section 30.** If, after a trademark application has been ordered advertised under Section 29, para. one, it appears to the Registrar that the trademark is not registrable under Section 6 or the application is not in accordance with the provisions of this Act

*During  
advertisement marks  
may be found  
unregistrable*

making necessary the cancellation of the advertisement order and provided the trademark is not already registered, the Registrar shall cancel such order and shall promptly inform the applicant in writing giving the grounds.

In the event a cancellation order is given after advertisement under Section 29, the cancellation order shall be advertised in the manner prescribed in Ministerial Regulations.

**Section 31.** The applicant shall be entitled to appeal a cancellation order under Section 30, para. one to the Board within ninety days from receipt thereof.

*Revocation of advertisement appealable within 90 days*

In the event the applicant does not appeal under para. one, the Registrar shall order the return of the advertisement fee to the applicant.

If the Board decides that the cancellation order of the Registrar is correct, the Board shall also order the return of the advertisement fee to the applicant.

If the Board decides the cancellation order of the Registrar is not correct, the Registrar shall:-

- (1) if the order was given under Section 30, para. one, prior to advertisement under Section 29, proceed with advertisement of the trademark;
- (2) if the cancellation order was advertised under Section 30, para. two, proceed to advertise the trademark again without charge to the applicant for the advertisement.

Decisions of the Board under paragraphs three and four shall be final

**Section 32.** If the Registrar's cancellation order under Section 30 is given after an opposition is filed under Section 35, the Registrar shall promptly notify the opposer in writing.

*Revocation of advertisement during opposition*

**Section 33.** In cases under Section 32, if the Registrar has not yet decided the opposition, it shall be held in abeyance until the expiration of the period for appeal under Section 31, para. one or until a decision of the Board is given under Section 31, paragraphs three or four, as the case may be.

If the Board decides the cancellation order of the Registrar under Section 30 is correct, the Registrar shall dismiss the opposition and shall promptly inform the opposer in writing. Such order shall be final.

If the Board decides the cancellation order of the Registrar under Section 30 is not correct, the Registrar shall proceed to decide the opposition.

**Section 34.** In cases under Section 32, if an appeal has been taken under Section 37 against the Registrar's decision in an opposition, the Registrar shall inform the Board and Section 33 shall apply *mutatis mutandis*.

*Effect of  
revocation of  
advertisement  
during appeal*

**Section 35.** Upon advertisement of a trademark application under Section 29, any person who is of opinion he has better title to the trademark than the applicant or that the trademark is not registrable under Section 6 or that the application is not in conformity with this Act may, within ninety days from the date of advertisement under Section 29, file a notice of opposition with the Registrar stating the grounds of the opposition.

*Opposition allowed  
within 90 days of  
advertisement.  
Grounds: better title,  
non-registrability*

Oppositions under the first paragraph shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 36.** If an opposition is filed under Section 35, the Registrar shall promptly send a copy thereof to the applicant and the applicant shall, within ninety days from the date of receipt thereof, file a counterstatement stating the grounds on which he relies in support of his application.

*90 days to file  
counterstatement*

If the applicant does not do so, the application shall be deemed abandoned.

In the event the applicant acts under para. one, the Registrar shall promptly send a copy of the counterstatement to the opposer. Before giving a decision, the Registrar may require the opposer and applicant to give additional statements, written explanations or evidence.

**Section 37.** The Registrar shall in writing promptly inform the applicant and opposer of his decision and the grounds thereof.

*Appeal to Board  
within 90 days allowed  
against an opposition  
decision*

The applicant or opposer shall be entitled to appeal the decision of the Registrar to the Board within ninety days from the date of receipt thereof. The Board shall decide the appeal promptly.

**Section 38.** When the Board has given its decision, the decision and the grounds thereof shall in writing be notified promptly to the applicant and opposer:

The applicant or opposer shall be entitled to appeal the decision of the Board by filing a case in court within ninety days of the date of receipt of the decision.

*Appeal to court after  
appeal to Board  
allowed within 90 days*

A case may be filed in court under para. two after the steps prescribed in Section 37, para. two, have been taken.

**Section 39.** In the event no appeal against the decision of the Registrar is taken within the period prescribed in Section 37, para. two or no appeal has been taken against the decision of the Board within the period prescribed in Section 38 para. two, the decision of the Registrar or of the Board, as the case may be, shall be final.

*Without appeal,  
decision is final*

**Section 40.** In the event there is no opposition under Section 35 or by a final decision or judgment the applicant is entitled to registration, the Registrar shall order the registration of the trademark.

*Registration fee  
payable within  
30 days of notice*

When an order to register a trademark has been given under the first paragraph, the Registrar shall so inform the applicant in writing and the registration fee shall be paid within thirty days of receipt of the notice. If the applicant does not pay the fee within the prescribed period, the application shall be deemed abandoned.

Registration of trademarks shall be in the manner prescribed in Ministerial Regulations.

**Section 41.** In the event an opposer under Section 35 applies for registration of a trademark which is the same as or similar to the trademark opposed and by a final decision or judgment the opposer has better title than the opposed applicant and if the opposer's trademark is registrable under Section 6 and the application conforms to the provisions of this Act, the Registrar shall register such trademark in the manner prescribed in Ministerial Regulations without need to advertise the opposer's trademark again.

*Opposer's resembling  
trademark  
application not  
required to be  
advertised*

**Section 42.** A trademark when registered shall be deemed registered as of the date of application for registration or as of the priority date under Section 28.

*Registration term  
begins on  
application date*

**Section 43.** Upon registration of a trademark, the Registrar shall issue to the applicant a certificate of registration in the form prescribed in Ministerial Regulations.

*Registration certificate*

If a registration certificate is materially damaged or lost, the trademark proprietor may apply to the Registrar for a replacement.

The issue of a replacement registration certificate shall be in accordance with the rules and in the form prescribed in Ministerial Regulations.

**Section 44.** Subject to Sections 27 and 68, a person who is registered as the proprietor of a trademark shall have the exclusive right to use it for the goods for which it is registered.

*Exclusive right of trademark owner*

**Section 45.** A trademark registered without limitation of color shall be deemed to be registered for all colors.

*Registration covers all colors*

**Section 46.** No person shall be entitled to bring legal proceedings to prevent or to recover damages for the infringement of an unregistered trademark.

*Except for passing-off no legal proceedings unless mark is registered*

The provisions of this Section shall not affect the right of the proprietor of an unregistered trademark to bring legal proceedings against any person for passing off goods as those of the proprietor of the trademark.

**Section 47.** No registration under this Act shall interfere with any bona fide use by a person of his own personal or surname or the name of his place of business or that of any of his predecessors in business or the use by any person of any bona fide description of the character or quality of his goods.

*Saving of right to one's name or business name or descriptive use of words*

### PART 3

#### CHANGES IN REGISTRATION OF TRADEMARKS

**Section 48.** The right to a pending trademark application may be transferred or inherited.

*Pending applications may be assigned or inherited*

The transfer of the right to an application under the first paragraph shall be notified to the Registrar prior to registration by the transferor or transferee.

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In the event of the death of the applicant, any heir or the administrator of the estate shall, prior to registration, notify the Registrar in order to give effect to the right to inherit the application.

The transfer or inheritance of rights to trademark applications under para. one shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 49.** The right to a registered trademark may be transferred or inherited with or without the business concerned in the goods for which the trademark is registered.

*Assignment of registered marks with or without goodwill*

**Section 50.** Associated trademarks may be transferred or inherited only when transferred or inherited together.

*Assignment of associated marks*

**Section 51.** The transfer or inheritance of a registered trademark must be registered with the Registrar.

*Assignment must be registered*

Applications to register the transfer or inheritance of the right to a trademark under the first paragraph shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 52.** The proprietor of a registered trademark may request the Registrar to amend only the following particulars of registration:

*Amendment of registered marks limited to:-*

- (1) the specification of goods by way of cancelling certain items;
- (2) the name, nationality, address and occupation of the proprietor of the trademark and his agent if any;
- (3) the office or address for communication by the Registrar;
- (4) other particulars as may be prescribed in Ministerial Regulations.

*restriction of goods,*

*name and address,*

*address for service,*

*other particulars as prescribed*

Applications to amend the particulars of registration under the first paragraph shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

#### PART 4

#### RENEWAL AND CANCELLATION OF TRADEMARK REGISTRATION

**Section 53.** The registration of a trademark is valid for ten years from the date of registration under Section 42 and may be renewed under Section 54.

*Registration valid  
for 10 years and  
renewable*

In calculating the period of validity of a trademark registration under the first paragraph, the amount of time taken by court proceedings under Section 38 shall not be included.

*Time taken for court  
proceedings after opposition no.  
counted.*

**Section 54.** The proprietor of a trademark may, within 90 days before the expiration of the trademark registration, apply to the Registrar to renew the registration. When an application for renewal is filed within the prescribed period, the trademark shall continue to be deemed registered until the Registrar orders otherwise.

*Renewal allowed 90  
days before expiration*

The renewal of trademarks shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 55.** In the event the proprietor of a trademark has applied for renewal within the period prescribed in Section 54, para. one, and the Registrar finds the application in accordance with the rules and procedures prescribed in Ministerial Regulations under Section 54, para. two, the Registrar shall renew the registration for a further period of ten years from the date of expiration of the registration or of the last renewal thereof, as the case may be.

*Renewal term 10 years*

If the proprietor of a trademark has applied for renewal under Section 54, para. one, but the Registrar finds the application is not in accordance with the rules and procedures prescribed in Ministerial Regulations under Section 54 para. two, the Registrar shall require the proprietor to correct the application within thirty days from the date of receipt of such order and so inform the proprietor promptly in writing. If the proprietor does not comply with the order within the time prescribed, the Registrar shall order the cancellation of the trademark registration.

*30 days to correct  
faulty renewal  
applications*

In case of necessity making the proprietor unable to comply with the order of the Registrar within the period prescribed under para. two, the Registrar is empowered to extend the period as may be necessary under the circumstances.

*Extension available*

**Section 56.** In the event a proprietor does not apply for renewal of the trademark registration within the period prescribed under Section 54, para. one, the registration of the trademark shall be deemed cancelled.

*Cancellation for non-renewal. No grace period*

**Section 57.** The proprietor of a trademark may request the Registrar to cancel his trademark registration but in the event the trademark is the subject of a registered license agreement, the consent of the licensee shall be required unless the license agreement provides otherwise.

*Voluntary cancellation with consent of licensee*

Requests for cancellation of a registered trademark under para. one shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 58.** If it appears to the Registrar that the proprietor of a registered trademark has not complied with the conditions or restrictions prescribed by the Registrar upon registration, the Registrar is empowered to order the cancellation of the trademark registration.

*Cancellation by Registrar for non-observance of conditions*

**Section 59.** If the proprietor or his agent ceases to have in Thailand the office or address as registered, the Registrar shall cancel the trademark registration.

*Cancellation for no longer having registered address in Thailand*

If the Registrar has reason to believe that the proprietor of a registered trademark or his agent has ceased to have the office or address in Thailand as registered, the Registrar shall notify the proprietor or his agent in writing at the registered office or address to give a written explanation to the Registrar within fifteen days or receipt of the Registrar's notice.

*Procedure*

If no reply is received within the period prescribed in para. two, the Registrar shall advertise that the trademark is to be cancelled in accordance with the procedures prescribed in Ministerial Regulations.

If still no reply is received within fifteen days from the date of advertisement under para. three, the Registrar shall order the cancellation of the trademark registration.

**Section 60.** An order to cancel a trademark registration under Section 55, para. two, Section 58 or 59, para. one, stating the grounds therefor, shall be promptly notified in writing to the proprietor.

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The proprietor of the trademark may appeal the Registrar's order under the first paragraph to the Board within ninety days from the date of receipt thereof. If no appeal is filed within the period prescribed, the order of the Registrar shall be deemed final.

*Cancellation orders  
appealable to Board  
within 90 days*

Decisions of the Board under para. two shall be final.

*No appeal to court*

**Section 61.** An interested person or the Registrar may petition the Board to order the cancellation of any trademark if it appears that at the time of registration the trademark was not distinctive under Section 7 or was proscribed under Section 8.

*Petitions to Board for  
cancellation: on  
grounds of  
unregistrability*

**Section 62.** Any person who is of the opinion that any trademark is contrary to public order or morality or to public policy may petition the Board to cancel the trademark registration.

*on grounds of public  
policy*

**Section 63.** An interested person or the Registrar may petition the Board to cancel any trademark registration if it is proved that at the time of registration the proprietor of the trademark had no bona fide intention to use the trademark with the goods for which it was registered and in fact there was no bona fide use whatsoever of the trademark for such goods or that during the three years prior to the petition for cancellation there was no bona fide use of the trademark for the goods for which it was registered unless the proprietor can prove that the non-use was due to special circumstances in the trade and not to an intention not to use or to abandon the trademark for the goods for which it was registered.

*on grounds of non-use*

*Special circumstances  
a defense*

**Section 64.** On receipt of a petition under Section 61, 62, or 63, the Board in writing shall notify the proprietor and licensees, if any, to submit a reply to the Board within sixty days from the date of receipt of the notification of the Board.

*Proprietor and  
licensees have 60  
days to reply*

**Section 65.** Orders of the Board to cancel or not to cancel a trademark registration under Section 61, 62, or 63 shall be promptly notified in writing to the petitioner for cancellation, the proprietor of the trademark and licensees if any.

The petitioner for cancellation, proprietor of the trademark or licensees shall be entitled to appeal the order of the Board under para. one to the court within ninety days from the date of receipt thereof. If no appeal is filed within the period prescribed, the order of the Board shall be deemed final.

*Appeal to court  
allowed within 90 days*

**Section 66.** An interested person or the Registrar may petition the court to cancel any registered trademark upon a showing that at the time of filing the legal action the trademark had become common to the trade for certain kinds or classes of goods to the extent that to the trade or in the public eye the trademark had lost its meaning as a trademark.

*Cancellation by court for becoming common to the trade*

**Section 67.** Within five years of the date of the Registrar's order to register a trademark under Section 40, an interested person may petition the court to cancel a trademark registration upon a showing that he has better title than the person registered as its proprietor.

*Cancellation by court on grounds of better title. 5 year limitation on suits*

If the petitioner shows better title for only some of the goods of the class in which the mark has been registered, the court shall restrict the registration to the goods for which better title has not been shown.

## PART 5

### TRADEMARK LICENSING

**Section 68.** The proprietor of a registered trademark may license another person to use the trademark for all or some of the goods for which the trademark is registered.

*Trademarks can be licensed*

Trademark license agreements under the first paragraph shall be in writing and registered with the Registrar.

*Licenses must be registered*

Applications to register a license agreement under para. two shall be in accordance with the rules and procedures prescribed in Ministerial Regulations and shall show at least the following particulars:

*License agreements must provide for quality control and specify goods*

(1) terms and conditions between the trademark proprietor and licensee to insure effective control by the registered proprietor of the trademark over the quality of the goods of the licensee;

(2) the goods for which the trademark is to be licensed.

**Section 69.** If of the opinion that a license agreement under Section 68 will not cause the public to be confused or misled and is not contrary to public order or morality or to public policy, the Registrar shall order registration of the agreement and for this purpose may impose conditions or restrictions. But if of the opinion that the license agreement will confuse or mislead the public or is

*Registrar may reject misleading or objectionable license agreements or impose conditions*

contrary to public order or morality or to public policy, the Registrar shall refuse to register the license.

Orders of the Registrar under para. one shall be promptly notified in writing to the proprietor of the trademark and persons who have applied to be registered as licensees. In the event the Registrar has imposed conditions or restrictions or has refused registration, the said persons shall also be informed of the reason therefor.

The proprietor of the trademark or licensee applicant shall be entitled to appeal the order of the Registrar under para. one to the Board within ninety days from the date of receipt of the Registrar's notification. If no appeal is filed within the prescribed time, the order shall be deemed final.

*Orders appealable  
within 90 days*

Decisions of the Board under para. three shall be final.

**Section 70.** Use of the trademark on goods by the licensee in his business shall be deemed use by the trademark proprietor.

*Use by licensee  
attributed to trademark  
owner*

**Section 71.** The trademark proprietor together with the licensees may apply to the Registrar to amend the registration of a trademark license agreement in respect of the goods covered by the license or other conditions and restrictions included by the proprietor and Section 69 shall apply *mutatis mutandis*.

*Amendment of  
licenses*

Applications to amend the registration of license agreements under para. one shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 72.** The trademark proprietor together with the licensees may apply to the Registrar to cancel the registration of a license agreement.

*Voluntary cancellation  
of licenses*

Either the trademark proprietor or the licensee may apply to the Registrar to cancel the registration of a license agreement which can be shown to have expired.

An interested person or the Registrar may petition the Board to cancel the registration of a trademark license agreement if it is shown that:-

*Cancellation of license  
registration by third  
parties*

(1) use of the trademark by the licensee confuses or misleads the public or is contrary to public order or morality or to public policy, or

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(2) the trademark proprietor is no longer capable of exercising effective control over the quality of the trademarked goods.

Cancellation of trademark licenses under this Section shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 73.** On receipt of an application under Section 72, para. two or three, the Registrar or Board, as the case may be, in writing shall notify the trademark proprietor or licensee, as the case may be, to submit a reply within a period prescribed of not less than fifteen nor more than sixty days from the date of receipt of the notification.

*15-60 days allowed  
for reply to license  
registration cancellation  
petitions*

In considering applications under Sections 71 and 72, the Registrar or Board, as the case may be, may require persons concerned to submit evidence or additional information.

**Section 74.** Orders of the Registrar under Section 72, para. two, together with the grounds thereof shall be promptly notified in writing to the trademark proprietor and licensees. Such orders shall take effect from the date of receipt of the notification.

*License  
cancellation appealable  
to Board within 90 days*

The trademark proprietor and licensees shall be entitled to appeal an order of the Registrar under para. one to the Board within ninety days of receipt thereof. If no appeal is submitted within the prescribed period, the order of the Registrar shall be deemed final.

**Section 75.** Orders of the Board under Section 72, para. three, together with the grounds thereof shall be promptly notified in writing to the trademark proprietor, licensees, petitioning interested person and Registrar. Such orders shall take effect from the date of receipt of the notification.

*Third party cancellation  
appealable to court within  
90 days*

The interested person or the Registrar is entitled to appeal the order of the Board to the court within ninety days from the date of receipt thereof. If no appeal is submitted within the prescribed period, the order of the Board shall be deemed final.

**Section 76.** If a trademark registration is cancelled, the licensing thereof shall cease to have effect.

*Lapse of mark ends  
licensing*

**Section 77.** If not otherwise provided in the license agreement, the trademark proprietor shall have the right to use the trademark himself and to license persons other than the licensee to do so.

*Licenses non-exclusive  
unless otherwise  
provided*

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**Section 78.** If not otherwise provided in the license agreement, the licensee shall have the right to use the trademark throughout the country for all the goods for which the trademark is registered for as long as the trademark is registered and renewed.

*Licenses comprehensive unless otherwise provided*

**Section 79.** If not otherwise provided in the license agreement, the licensee may not transfer the license to third persons nor sublicense others to use the trademark.

*Licenses not assignable unless otherwise provided*

## CHAPTER II

### SERVICE AND CERTIFICATION MARKS

**Section 80.** The provisions relation to trademarks shall apply to service marks *mutatis mutandis* and the word "goods" in those provisions shall include "services".

*Trademark provisions applicable to service marks*

**Section 81.** Except as otherwise provided in this Chapter, the provisions relating to trademarks shall apply to certification marks *mutatis mutandis*.

*Trademark provisions applicable to certification marks*

**Section 82.** The applicant for registration of a certification mark, in addition to complying with the provisions on registration of trademarks, shall:-

*Rules on certification and proof of capacity to certify required*

(1) submit the rules on use of the certification mark together with the application for registration and

(2) demonstrate an ability to certify the characteristics of the goods or services as provided in the rules under (1).

The rules under (1) shall indicate the origin, composition, method of production, quality or other characteristics which are to be certified including the rules, procedures and conditions for authorizing use of the certification mark.

**Section 83.** The Registrar may require the applicant for registration of a certification mark to amend the rules on use of the certification mark as he may think fit within sixty days of the date of receipt of the order and shall in writing promptly notify the applicant of the order with the grounds therefor. Sections 18 and 19 shall apply to appeals against orders of the Registrar *mutatis mutandis*.

*Registrar may require amendment of certification rules*



**Section 84.** If of the opinion that the applicant for registration of a certification mark does not have sufficient ability to certify the characteristics of the goods or services as provided in the rules on use of the certification mark or that registration of the certification mark would not be in the public interest, the Registrar shall refuse registration and shall in writing promptly notify the applicant of the order with the grounds therefor. Sections 18 and 19 shall apply to appeals against orders of the Registrar *mutatis mutandis*.

*Grounds of refusal  
of certification marks*

**Section 85.** On advertising an application for registration of a certification mark, the Registrar shall indicate the main points of the rules on use of the certification mark.

*Highlights of  
certification rules to  
be advertised*

**Section 86.** The proprietor of a registered certification mark may apply to amend the rules on use of the certification mark provided the public interest is not thereby affected.

*Certification rules  
amendable*

Amendments under the first paragraph shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 87.** If of the opinion an amendment of the rules under Section 86 should be registered, the Registrar shall order the registration and the advertisement of the main points of the amendment.

*Amendments to be  
advertised*

The Registrar shall in writing promptly notify the proprietor of the certification mark of the order to advertise the amendment under para. one.

**Section 88.** If of the opinion an amendment of the rules under Section 86 should not be registered, the Registrar shall refuse registration and in writing promptly notify the proprietor of the certification mark giving the grounds therefor.

*Amendments may be  
refused*

**Section 89.** The proprietor of the certification mark or any person who has been or will be prejudiced by an order of the Registrar under Section 87 or 88 shall be entitled to appeal the order to the Board within 90 days from the date of advertisement under Section 87 or from the date of receipt of the Registrar's order under Section 88, as the case may be.

*Refusal appealable by  
owner or interested  
party within 90 days*

The decision of the Board under para. one shall be final.

**Section 90.** The proprietor of a registered certification mark may not use the mark on his own goods or services and may not license other persons to act as certifier through use of the trademark.

*Power to certify not  
licensable*

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**Section 91.** Authorization to others to use a certification mark for goods or services shall be in writing signed by the proprietor of the certification mark.

*Authorizations to use certification marks must be in writing*

**Section 92.** The right to a registered certification mark may be transferred when:-

(1) the Registrar has given his approval on a showing by the transferee that he has sufficient ability to certify the characteristics of the goods or services as indicated in the rules on use of the certification mark,

*Assignment of certification marks allowed if assignee is capable*

(2) the transfer is in writing, and

(3) is registered by the Registrar.

In cases where the Registrar does not give approval or refuses to register the transfer, Section 84 shall apply *mutatis mutandis*.

Applications for approval to transfer rights and for registration of the transfer under the first paragraph shall be in accordance with the rules and procedures prescribed in Ministerial Regulations.

**Section 93.** The right to a certification mark shall terminate when the proprietor dies or loses its status.

*Rights to certification marks lapse on demise of owner*

### CHAPTER III

#### COLLECTIVE MARKS

**Section 94.** Except for the provisions of Chapter I, Part 5, the provisions on trademarks shall apply to collective marks *mutatis mutandis*.

*Except for licensing, trademark provisions apply to collective marks*

### CHAPTER IV

#### TRADEMARK BOARD

**Section 95.** There shall be a committee called the Trademark Board composed of the Director General of the Trade Registration Department as chairman and the Supreme Public Prosecutor or his

*Trademark Board composition*

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representative, Secretary General of the Juridical Council or his representative and no fewer than four nor more than eight other qualified persons appointed by the Council of Ministers as members.

The Board may appoint any person to be secretary or assistant secretary.

**Section 96.** The Board shall have the following powers and duties:-

(1) to decide appeals against orders or decisions of the Registrar under this Act;

(2) to order the cancellation of trademarks, service marks and certification marks under this Act;

(3) to advise and counsel the Minister on the issue of Ministerial Regulations and notifications under this Act;

(4) to consider other matters assigned by the Minister.

**Section 97.** Members of the Board appointed by the Council of Ministers shall serve for a term of four years.

The term for interim appointees, whether appointed as additional members or replacement members, shall be for the unexpired term of the previously appointed members.

A member whose term has expired may be reappointed.

**Section 98.** Apart from vacating office at the expiration of their term under Section 97, members of the Board appointed by the Council of Ministers shall vacate office upon:-

(1) death,

(2) resignation,

(3) dismissal by the Council of Ministers,

(4) being adjudged bankrupt,

(5) being adjudged incompetent or quasi-incompetent,

(6) imprisonment under a final sentence of imprisonment unless for an offence of negligence or a petty offence.

*Powers of Board:*

*to review orders of Registrar*

*to cancel marks*

*to advise the Minister*

*Term of office 4 years*

*Termination of office*

**Section 99.** A quorum for meetings of the Board shall consist of at least one-half of the total number of members.

*Procedure for meetings of the Board*

If the chairman does not attend or is not at the place of meeting, the meeting shall elect one of the members chairman for the meeting.

Decisions of the Board shall be by majority vote, each member having one vote. In case of a tied vote, the chairman of the meeting shall have an additional casting vote.

**Section 100.** The Board may appoint sub-committees to consider or do whatever may be assigned by the Board.

Section 99 shall apply to meetings of sub-committees *mutatis mutandis*.

**Section 101.** Appeals to the Board under this Act shall be submitted to the Registrar on the forms prescribed by the Director General.

*Appeals to Board filed through the Registrar*

The procedure for deciding appeals shall be as prescribed by the Board.

**Section 102.** In the performance of its duties under this Act, the Board is empowered in writing to inquire of or summon the Registrar, appellants or other persons concerned to give information, explanations or opinions or to submit relevant documents or other evidence for consideration.

*Inquiry powers of the Board*

## CHAPTER V

### MISCELLANEOUS

**Section 103.** Any person is entitled, during office hours, to inspect the register of trademarks, service marks, certification marks and collective marks and files thereof, to obtain copies or certified copies of documents and apply for certification by the Registrar of particulars of registration on payment of the fees prescribed in Ministerial Regulations.

*Register open to inspection and copying*

**Section 104.** Summonses, notices and other communications to an applicant, opposer, proprietor of a registered trademark, service mark, certification mark or collective mark, licensee or any

*Notices to be sent by registered mail*

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other person pursuant to this Act shall be sent by registered post with an acknowledgement of receipt to the office or address given in the application for registration or as registered, as the case may be.

If delivery by the means set forth in the first paragraph fails, service may be made by an officer or by again sending by registered post with an acknowledgement of receipt. If service is by an officer, if the recipient is not present, the communication may be delivered to any person of legal age who lives or works in the office or at the address or it may be posted in a conspicuous place at the office or address of the recipient.

*Alternative service*

Seven days after delivery by the means set forth in para. two, the communication shall be deemed to have been received by the addressee.

**Section 105.** For the purpose of legal proceedings concerning trademarks, service marks, certification marks and collective marks under this Act, if the applicant or proprietor is not domiciled in Thailand, the office or address of the person or his agent given in the application or registration, shall be deemed the domicile of such person.

*Address for service deemed domicile*

**Section 106.** In the event the Registrar petitions the Board to order the cancellation of the trademark, service mark, certification mark or collective mark or the cancellation of a license agreement pertaining to a trademark or service mark, the Registrar shall be exempt from the payment of fees under this Act.

*Registrar not liable for fees for cancellation of marks or licenses*

## CHAPTER VI

### PENALTIES

**Section 107.** Whoever makes a false statement to the Registrar or Board in an application, opposition or other document filed concerning an application for registration, amendment of a registration, renewal of a registration or cancellation of the registration of a trademark, service mark, certification mark or collective mark or a license pertaining to a trademark or service mark shall be liable to imprisonment for not more than six months or a fine of not more than ten thousand baht or both.

*Penalty for false statements*

**Section 108.** Whoever counterfeits a trademark, service mark, certification mark or collective mark registered in the Kingdom by another person shall be liable to imprisonment for not more than four years or a fine of not more than four hundred thousand baht or both.

*Penalty for counterfeiting*

**Section 109.** Whoever imitates a trademark, service mark, certification mark or collective mark registered in the Kingdom by another person in order to mislead the public into believing that it is the trademark, service mark, certification mark or collective mark of such other person shall be liable to imprisonment for not more than two years or a fine of not more than two hundred thousand baht or both.

*Penalty for intentional infringement*

**Section 110.** Whoever:-

(1) imports, sells, offers for sale or has for the purpose of sale goods bearing a counterfeit trademark, service mark, certification mark or collective mark under Section 108 or an imitation trademark, service mark, certification mark or collective mark under Section 109, or

*Penalty for sale or possession of goods or giving services under unlawful marks*

(2) gives or offers a service under a counterfeit service mark, certification mark or collective mark under Section 108 or an imitation service mark, certification mark or collective mark under Section 109, shall be liable to the penalties provided in those Sections.

**Section 111.** Whoever:-

(1) represents as registered in the Kingdom a trademark, service mark, certification mark or collective mark which is not so registered,

*Penalty for falsely representing a mark as registered*

(2) sells or has for the purpose of sale goods bearing a trademark or certification mark under (1) which he knows to be falsely represented, or

*Penalty for sale of goods or giving services under mark known to be falsely represented as registered*

(3) gives or offers a service under a service mark, certification mark or collective mark under (1) which he knows to be falsely represented,

shall be liable to imprisonment for not more than one year or a fine of not more than twenty thousand baht or both.

- Section 112.** Whoever violates Section 90 shall be liable to a fine of not more than twenty thousand baht. *Penalty for misuse of certification mark*
- Section 113.** The penalty for an offence under this Act committed within five years from the date of discharge of a sentence for another offence under this Act shall be doubled. *Double penalty for recidivism*
- Section 114.** In the event an offender liable under this Act is a juristic person, the managing director, manager or representative of such juristic person shall also be liable to the penalty prescribed for such offence unless he can prove that he had neither knowledge of nor consented to the commission of the offence by the juristic person. *Company officers liable*
- Section 115.** All goods which are imported, sold, offered for sale or had for the purpose of sale in violation of this Act shall be confiscated whether or not anyone has been convicted of the offence. *Confiscation of goods bearing unlawful marks*
- Section 116.** If there is clear evidence someone is committing or is about to commit an act under Sections 108, 109 or 110, the proprietor of the trademark, service mark, certification mark or collective mark may apply to the court to enjoin such act. *Preventive injunction*

#### PROVISIONAL MEASURES

- Section 117.** Trademarks which have been and continue to be registered under Trademarks Act B.E. 2474 on the date this Act comes into force shall be deemed trademarks under this Act. *Existing trademark registrations adopted*
- Section 118.** The Trademark Board under the Trademarks Act B.E. 2474 in office on the date this Act comes into force shall, for not more than sixty days, continue to exercise their functions until there is a Trademark Board under this Act. *Old Trademark Board continues to function for up to 60 days*
- Section 119.** All applications for trademark registration, applications to amend registrations, applications to transfer rights to trademarks and applications to renew trademarks submitted under the Trademarks Act B.E. 2474, if, prior to the date this Act comes into force, the Registrar:- *Pending marks not yet examined are processed under new Act but if already examined, under the old Act*

(1) has given no order with respect thereto, shall be treated as having been submitted under this Act and further action shall be taken under this Act;

(2) has given any order with respect thereto, shall be further handled under the Trademarks Act B.E. 2474 until the matter becomes final.

**Section 120.** On applying for renewal of a trademark registered under the Trademarks Act B.E. 2474 in respect of all goods in any class, the proprietor shall clearly specify the kinds of goods for which protection is desired. In such case, the provisions of Section 9 shall apply *mutatis mutandis*.

*On renewal coverage of all goods in class not allowed*

**Section 121.** Appeals against orders or decisions of the Registrar and oppositions under the Trademarks Act B.E. 2474 which are pending prior to the date this Act comes into force shall be governed by the Trademarks Act B.E. 2474 until they become final.

*Pending appeals and oppositions to be treated under the old Act*

**Section 122.** Periods of time for submitting appeals, oppositions, counterstatements and notifications to the Registrar that agreement has been reached or legal proceedings filed under the Trademarks Act B.E. 2474 if unexpired prior to the date this Act comes into force shall be counted anew from the date this Act comes into force.

*Unexpired time limits under old Act begin to run again under new Act*

**Section 123.** All Ministerial Regulations, notifications, rules and orders issued under the Trademarks Act B.E. 2474 shall continue in effect insofar as they are not contrary to or inconsistent with this Act until the Ministerial Regulations and notifications issued under this Act take effect.

*Consistent existing rules and regulations remain in force until replaced*



### SCHEDULE OF FEES

		<i>[ Maximum fees ]</i>
		Baht
(1)	Applications for registration of a trademark, service mark, certification mark or collective mark	<i>for each kind of goods or service</i> 500
(2)	Advertisement of an application under (1)	<i>per application</i> 200
(3)	Printing blocks for trademarks, service marks, certification marks or collective marks exceeding 5 cm. in length or width (Fractions of a centimeter shall be counted as a centimeter.)	<i>per centimeter of excess</i> 100
(4)	Opposition to applications under (1)	<i>each</i> 1,000
(5)	Applications to transfer pending trademarks, service marks, certification marks or collective marks	<i>per application</i> 1,000
(6)	Registration fee for a trademark, service mark, certification mark or collective mark	<i>for each kind of goods or service</i> 300
(7)	Replacement certificates of registration	<i>each</i> 100
(8)	Applications to register transfer or inheritance of a trademark, service mark, certification mark or collective mark	<i>per application</i> 1,000
(9)	Amendments of registered particulars under (6)	<i>per application</i> 200
(10)	Renewal of a registration under (6)	<i>for each kind of goods or service</i> 1,000
(11)	Petitions to the Board to cancel a registration under (6)	<i>each</i> 500
(12)	Applications to register a trademark or service mark license	<i>per application</i> 500
(13)	Registration of a trademark or service mark license agreement	<i>per agreement</i> 1,000

		<i>[ Maximum fees ]</i>	
			Baht
(14)	Amendments of particulars in registrations under (13)	<i>per application</i>	200
(15)	Applications to cancel registrations under (13)	<i>per application</i>	200
(16)	Amendments of applications under (1) (8) or (12)	<i>per request</i>	100
(17)	Applications to amend certification mark rules		
	a) prior to registration of the mark	<i>per application</i>	100
	b) after registration of the mark	<i>per application</i>	200
(18)	Appeals		
	a) against an order of the Registrar under Sec. 16,17,27 or a decision of the Registrar under Sec. 37	<i>each</i>	2,000
	b) under other sections	<i>each</i>	1,000
(19)	Applications to examine the register and files (Fractions of an hour shall be counted as one hour)	<i>per hour</i>	100
(20)	Requests for certified extracts from the register of trademarks, service marks, certification marks or collective marks	<i>per set</i>	200
(21)	Requests to make photocopies of documents	<i>per page</i>	10
(22)	Applications for certified copies of documents in the same matter		
	a) of not more than 10 pages	<i>per page</i>	10
	b) of more than 10 pages	<i>per document</i>	100
(23)	Applications for certification concerning particulars of registration	<i>each</i>	50
(24)	Other requests	<i>per application</i>	100

[ NB: The marginal notes have been added for convenience and are not part of the Act. ]

**ANNEX III**

**COPYRIGHT STATUTE**

**Copyright Act, B.E. 2521 (1978)**

## COPYRIGHT STATUTE

## Copyright Act, B.E. 2521 (1978)

## [omissions]

*Section 1.* This Act is called the "Copyright Act, B. E. 2521".

*Section 2.* This Act shall come into force as from the day following the date of its publication in the Government Gazette.

*Section 3.* The Act for the Protection of Literary and Artistic Works, B.E. 2474 shall be repealed.

*Section 4.* In this Act:

"author" means a person who makes or creates a work by his own initiative;

"work" means a creative work in the form of literary, dramatic, artistic, musical, audio-visual, cinematographic, sound and video broadcasting work, or any other work in the literary, scientific or artistic domain;

"copyright" means the exclusive right to do any act in relation to the work made by the author;

"literary work" means every production in the literary domain, irrespective of its mode or form of expression, such as books, pamphlets, writings, printings, lectures, sermons, addresses, speeches, sound records and/or other pictures;

"dramatic work" means a work relating to choreography, dancing, action or performance in dramatic composition, and includes a pantomime;

"artistic work" means a work of any one or more of the following descriptions:

(1) work of painting and drawing, which is a work of creating a configuration which is a composition of any one or more of lines, lights, colours or other things made on the material of one or more descriptions;

(2) work of sculpture which is a work of creating a configuration in relation to the touchable volume;

(3) work of lithography which is a work of creating a picture through the process of printing and includes a printing block or pattern used for printing purposes;

(4) work of architecture which is a design of a building or construction, an interior or ex-

terior decoration as well as a decoration of the surrounding of a building or construction, or the creation of a model of building or construction;

(5) photographic work which is a work of creating a picture by using video recorder causing the light to pass through the lens towards a film or mirror and developing the film or mirror by chemicals of specific formula or any process capable of creating a picture, or video recording by using other instruments or means;

(6) work on illustrations, maps, structures, sketches, or three-dimensional works in relation to geography, topography, or science;

(7) work of applied arts which is a composition of any one or more of the works under (1) to (6) used for other purposes apart from appreciating the value thereof, such as that used for utility, decorating material or thing which is equipment, or trading purpose;

Whether with or without artistic value, and shall include the photograph and plan of such work;

"musical work" means a musical composition for playing or singing, whether with words and/or rhythm, and includes a musical book, musical note or musical diagram, the tunes in which have been arranged and transcribed;

"audio-visual work" means a sound record, disc, audiotape, videotape or any other thing for sound and/or video recording, which is capable of being replayed, whether to be supported by the other facilities;

"cinematographic work" means an audio-visual work composed of any sequence of visual images, with or without sounds, and recorded on the material of any description, so that such material may:

(1) be shown as moving pictures, or

(2) be recorded on the other material so as to be capable of being shown as moving pictures;

"sound and video broadcasting work" means a work communicated to the public by means of radio broadcasting,

*Date of Act:* December 11, 1978.

*Date of entry into force:* December 19, 1978.

*Official Text published in the Government Gazette,* Vol. 95, Part 143, Special issue of December 18, 1978.

sound and video broadcasting on television or by other similar means;

“reproduction” includes any mode of copying, emulation, duplication, block-making, sound recording, video recording or sound and video recording, from the original duplicate or advertisement in its material form, whether wholly or in part;

“adaptation” means a reproduction by conversion, improvement, amendment or copying of the original in its material form, and not being in the nature of making a new work, whether wholly or in part, and

(1) in relation to a literary work, includes a translation of literary work, conversion of literary work, or collection of literary works by selection and arrangement of their contents;

(2) in relation to a dramatic work, includes a conversion of the version of a non-dramatic work into a dramatic work or *vice versa*, whether in its original language or a different language;

(3) in relation to an artistic work, includes a conversion of the work in a two-dimensional or three-dimensional form into a three-dimensional or two-dimensional form, or a production of a model from the original;

(4) in relation to a musical work, includes an arrangement or transcription of tunes or an alteration of the words of song or rhythm;

“publication” means making the work available to the public by means of performing, lecturing, praying, playing, causing it to be heard or seen, constructing, disposing or by any other means.

*Section 5.* The Minister of Education shall have charge and control of the execution of this Act.

## CHAPTER 1

### COPYRIGHT

*Section 6.* The author shall be entitled to the copyright in the work he has created under the following conditions:

(1) in the case where the work has not been published, the author must be a Thai national or stay in the Kingdom at all time or most of the time during the creation of the work;

(2) in the case where the work has been published, the first publication must have been effected in the Kingdom or the author must be qualified according to that pre-

scribed in (1) at the time of the first publication.

In the case where the author must be a Thai national, if he is a juristic person, such juristic person must be incorporated under the law of Thailand.

The publication under paragraph one (1) and (2) means a disposition of the duplicated copies of a work, regardless of its form or character, with the consent of the author, by making duplicated copies available to a reasonable number of the public having due regards to the nature of the work, but does not include a performance or display of dramatic, musical or cinematographic works, lecturing or delivering a speech on literary work, sound and video broadcasting about any work, exhibition of artistic work and construction of a work of architecture.

*Section 7.* Unless it has been agreed otherwise in writing, the author shall be entitled to the copyright in the work he has created in the capacity of officer or employee, but the employer is entitled to cause the publication of that work in accordance with the purpose of the employment.

*Section 8.* Unless the author and the employer have agreed otherwise, the employer shall be entitled to the copyright in the work the author was specifically commissioned to make.

*Section 9.* In case of a work being by its nature an adaptation of the work copyrighted by virtue of this Act with the consent of the owner of the copyright, the person making such an adaptation shall, without prejudice to the right of the owner of the copyright in the work of the original author which was adapted, be entitled to the copyright by virtue of this Act.

*Section 10.* In case of a work being by its nature a collection or composition of the works copyrighted by virtue of this Act with the consent of the owner of the copyright, the person making such a collection or composition shall, without prejudice to the right of the owner of the copyright in the works of the original authors which were collected or composed, be entitled to the copyright by virtue of this Act.

*Section 11.* Section 6, section 7 and section 8 shall apply *mutatis mutandis* to the grant of copyright under section 9 or section 10.

*Section 12.* The Ministries, sub-Ministries, Departments or any other state or local agencies shall be entitled to the copyright in the works created under their employment or direction or control, unless it has been agreed otherwise.

## CHAPTER 2

### PROTECTION OF COPYRIGHT

*Section 13.* Subject to section 7, section 8 and section 12, the owner of the copyright shall enjoy the exclusive right of

- (1) reproduction or adaptation;
- (2) publication;
- (3) granting benefits accruing from the copyright to other persons;
- (4) granting licence to other persons to use the rights under (1) or (2), with or without imposing any condition.

*Section 14.* In the case where the owner of the copyright by virtue of this Act grants licence to a person to use the right under section 13(4), and there is no written agreement imposing any specific condition, the licence shall be regarded as a non-exclusive licence.

*Section 15.* The copyright may be assigned from one to another.

In an assignment of copyright to the other person, the owner of the copyright may assign it wholly or in part and may assign it for a limited period of time or for the entire term of protection of the copyright.

An assignment of copyright by any other means except by means of succession shall be made in writing.

In the case where the copyright had been assigned under paragraph two, the author still has a personal right to prohibit the assignee from distorting, abridging, adapting or doing any acts in relation to the work to such extent as to cause injury to the reputation or goodwill of the author.

## CHAPTER 3

### TERM OF PROTECTION OF COPYRIGHT

*Section 16.* Subject to section 18 and section 19, the copyright in a work by virtue of this Act shall subsist for life of the author and shall continue to subsist until the end of the period of fifty years from the death of the author.

In case of a work of joint authorship, the copyright in such work shall subsist for the life of the joint authors and shall continue to subsist until the end of the period of fifty years from the death of the last surviving joint author.

If the author or every joint author was dead before the publication of the work, the copyright shall subsist for a period of fifty years from the date of its publication.

In case of the author being a juristic person, the copyright in such work shall subsist for a period of fifty years from the date of its creation but, if the work is published during the said period, the copyright shall continue to subsist for a period of fifty years from the date of its first publication.

*Section 17.* As for the work copyrighted by virtue of this Act being a pseudonymous or anonymous work, the copyright in such work shall subsist for a period of fifty years from the date of its creation but, if the work is published during the said period, the copyright shall continue to subsist for a period of fifty years from the date of its first publication.

In case of the identity of the author being disclosed, section 16 shall apply *mutatis mutandis*.

*Section 18.* The copyright in the photographic, audio-visual, cinematographic or sound and video broadcasting work shall subsist for a period of fifty years from the date of its creation but, if the work is published during the said period, the copyright shall continue to subsist for a period of fifty years from the date of its first publication.

*Section 19.* The copyright in the work of applied art shall subsist for a period of twenty-five years from the date of its creation but, if the work is published during the said period, the copyright shall continue to subsist for a period of twenty-five years from the date of its first publication.

*Section 20.* The copyright in the work created in accordance with the employment or direction or control under section 12 shall subsist for a period of fifty years from the date of its creation but, if the work is published during the said period, the copyright shall continue to subsist for a period of fifty years from the date of its first publication.

*Section 21.* The publication of the work

under section 16, section 17, section 18, section 19 or section 20, which is the commencement of the term of protection of the copyright, means publication of the work with the consent of the owner of the copyright.

*Section 22.* When the term of protection of the copyright comes to an end in any year and if the date of termination of the term of protection of the copyright is not the last day of the calendar year or the exact date of termination of the term of protection of the copyright cannot be known, the copyright in the work shall continue to subsist until the last day of that calendar year.

*Section 23.* The publication of any copyrighted work after the termination of the term of protection of copyright shall not give rise to the copyright in that work anew.

#### CHAPTER 4

##### INFRINGEMENT OF COPYRIGHT

*Section 24.* Any one of the following acts in relation to the work copyrighted by virtue of this Act shall constitute an infringement of copyright:

- (1) reproduction or adaptation;
- (2) publication without a licence under section 13.

*Section 25.* Any one of the following acts in relation to an audio-visual work or cinematographic work copyrighted by virtue of this Act, whether in relation to its sound and/or visual images, shall constitute an infringement of copyright:

- (1) reproduction or adaptation;
- (2) publication without a licence under section 13.

*Section 26.* Any one of the following acts in relation to a sound and video broadcasting work copyrighted by virtue of this Act shall constitute an infringement of copyright:

- (1) a production of cinematographic work, audio-visual work or sound and video broadcasting work, whether wholly or in part;
- (2) a rebroadcasting of sounds and visual images, whether wholly or in part;
- (3) an arrangement of the sound and video broadcasting work to be heard and/or seen by the public, by asking for money payment or other trading benefits in return.

*Section 27.* Any person, to his knowledge of any work constituting an infringement of the copyright of other person, doing any of the following acts in relation to such work:

- (1) selling, leasing, selling by hire-purchase or offering to sell, let or sell by hire-purchase;
  - (2) publishing;
  - (3) distributing in such a manner as to be prejudicial to the owner of the copyright;
  - (4) importing or making an order for importation into the Kingdom for any purpose other than for private use,
- shall be deemed to commit an infringement of copyright.

*Section 28.* In an action for infringement of copyright, it shall be presumed that the work to which the action relates is the work in which copyright subsists by virtue of this Act and the plaintiff is the owner of the copyright therein, unless the defendant argues that the copyright does not subsist therein or disputes the right of the plaintiff.

In case of the work bearing the name or nominal symbol of any person purporting to be the owner of the copyright, the person whose name or nominal symbol appears thereon shall be presumed to be the author of the work.

In case of the work bearing no name or nominal symbol or bearing the name or nominal symbol of any person but such person does not purport to be the owner of the copyright, and bearing the name or nominal symbol of other person who purports to be the printer, publisher or printer and publisher, shall be presumed to be the owner of the copyright.

*Section 29.* No action for infringement of copyright shall be entered later than three years from the day when the owner of the copyright becomes aware of the infringement and the identity of the offender but it must not be entered later than ten years from the date of infringement of copyright.

#### CHAPTER 5

##### EXCEPTIONS FROM INFRINGEMENT OF COPYRIGHT

*Section 30.* An act done in relation to the work copyrighted by virtue of this Act shall not constitute an infringement of copyright

insofar as it has as its object any one of the following purposes:

- (1) research or study;
- (2) use for one's own benefits or use for one's own benefits and for the benefits of members of his family, or relatives and friends;
- (3) criticism, comment or review of the work accompanied by an acknowledgement of the ownership of the copyright in such work;
- (4) report of current events through the mass-media accompanied by an acknowledgement of the ownership of the copyright in such work;
- (5) reproduction, adaptation, exhibition or making available for the purpose of judicial or administrative proceedings under the law, or for the purpose of a report of the said proceedings;
- (6) reproduction, adaptation, exhibition or making available by a teacher for teaching purposes;
- (7) copying, duplicating, adapting a part of such work or abridging or making a summary by a teacher or educational institution according to the suitability of purposes and to the necessary number, for distributing or selling to students in the class or in an educational institution; provided that it shall neither be made for profit or cause to the owner of the copyright greater injury than should be reasonably expected, having due regard to social justice in conferring benefits to the owner of the copyright and to the necessity of providing education to the public;
- (8) utilising the work as a part of the examination questions and answers.

*Section 31.* A reasonable recitation of, copying from, emulation of, or reference to any part of the work copyrighted by virtue of this Act, which is accompanied by an acknowledgement of the ownership of the copyright in such work, shall not constitute an infringement of copyright.

*Section 32.* The followings shall not be regarded as the works in which copyright subsists by virtue of this Act:

- (1) news of the day and facts having the character of being information only, which are not in the literary, scientific or artistic domain;
- (2) Constitutions and legislations;
- (3) regulations, by-laws, notifications, or-

ders, explanations and correspondence of the Ministries, sub-Ministries, Departments or any other state or local units;

(4) judgments, orders, decisions and reports of the government;

(5) translation and collection of those in (1) to (4) made by the Ministries, sub-Ministries, Departments or any other state or local units.

*Section 33.* A reproduction, by the librarian of a library, of the work copyrighted by virtue of this Act, if not being made for profit-making purposes, shall not constitute an infringement of copyright in the following cases:

(1) reproduction for use in the library or for supplying to the other libraries;

(2) reasonable reproduction of certain part of the work for supplying to the other person for the purpose of research or study.

The number of copies reproduced under (1) and (2) shall, having due regard to the suitability of purposes, not be beyond necessity.

*Section 34.* A suitable publication of audio-visual or cinematographic work, if not being made or conducted for profit as a result of such publication, shall not constitute an infringement of copyright in the following cases:

(1) causing the work to be heard or seen for the pleasure of the people who use the service of a restaurant, hotel, resort, transport station or vehicle;

(2) causing the work to be heard or seen for pleasure, by an association, foundation or other organization having a charitable, educational, religious or social-welfare purpose.

*Section 35.* The drawing, painting, building, engraving, moulding, carving, lithographing, photographing, cinematographic taking, video broadcasting or any similar act in relation to any artistic work which is displayed in a public place and is not the work of architecture, shall not constitute an infringement of copyright in such artistic work.

*Section 36.* The drawing, painting, engraving, moulding, carving, lithographing, photographing, cinematographic taking, or video broadcasting, in relation to the work of architecture, shall not constitute an infringement of copyright in such work of architecture.

*Section 37.* The photographing or cine-



matographic taking or video broadcasting or any work in which any artistic work is included as a component part shall not constitute an infringement of copyright in such artistic work.

*Section 38.* In case of the copyright in any artistic work being jointly owned by the author and the other person, a subsequent production of such artistic work in such a manner as to be a reproduction of a part of the original artistic work or use of printing pattern, sketch, plan, model or data acquired from the study used in the original artistic work by such author shall not constitute an infringement of the copyright in such work if it appears that the author does not reproduce or copy the original artistic work in its material form.

*Section 39.* In case of a building being a work of architecture copyrighted by virtue of this Act, the restoration of such building shall not constitute an infringement of copyright.

*Section 40.* In case of the term of protection of the copyright in any cinematographic work having come to an end, the publication of such cinematographic work shall not constitute an infringement of copyright in the literary work, dramatic work, artistic work, musical work, audio-visual work or work included in the cinematographic work.

*Section 41.* A reproduction for supplying to any person for the service of the government, by an official or under the direction of the official, of a work copyrighted by virtue of this Act, which is in the possession of the government, shall not constitute an infringement of copyright.

## CHAPTER 6

### INTERNATIONAL COPYRIGHT

*Section 42.* Any work copyrighted by virtue of the law of a Contracting State to the Convention relating to the protection of copyright to which Thailand is also a Contracting State and the law of such country extends a reciprocal protection to the copyrighted works of the other Contracting States to the said Convention or any copyrighted work of an international organization of which Thailand is a member, shall enjoy protection by virtue of this Act, subject to the conditions to be provided by a Royal Decree.

## CHAPTER 7

### PENALTIES

*Section 43.* Any person infringing the copyright under section 24, section 25 or section 26 shall be liable to a fine from ten thousand Baht to one hundred thousand Baht.

If the offence under paragraph one is committed for trading purpose, the offender shall be liable to a fine from twenty thousand Baht to two hundred thousand Baht or to imprisonment for a term not exceeding one year and to a fine from twenty thousand Baht to two hundred thousand Baht.

*Section 44.* Any person infringing the copyright under section 27 shall be liable to a fine from five thousand Baht to fifty thousand Baht.

If the offence under paragraph one is committed for trading purpose, the offender shall be liable to a fine from ten thousand Baht to one hundred thousand Baht or to imprisonment for a term not exceeding six months and to a fine from ten thousand Baht to one hundred thousand Baht.

*Section 45.* Any person who, having been convicted of an offence under this Act, commits an offence hereunder again within five years from the date he is released from his punishment, shall be liable to double penalty.

*Section 46.* In the case where a juristic person commits an offence under this Act, every director or manager of such juristic person shall be regarded as joint offenders with the juristic person, unless he can prove that such act of the juristic person has been done without his knowledge or consent.

*Section 47.* All articles made or imported into the Kingdom, which constitute an infringement of copyright under this Act, and owned by the offender under section 43 or section 44, shall become the property of the owner of the copyright, whereas all articles used for committing an offence shall be forfeited.

*Section 48.* The offences under this Act shall be compoundable offences.

*Section 49.* One-half of the fine paid according to a judgment shall be payable to the owner of the copyright but the payment shall not be prejudicial to the right of the owner of

the copyright to bring a civil action for the recovery of damages which are in excess of the amount of the fine the owner of the copyright has received.

#### TRANSITORY PROVISION

*Section 50.* The work copyrighted by virtue of the Act for the Protection of Literary and Artistic works, B. E. 2474 on the date this Act

comes into force shall enjoy the protection of the copyright by virtue of this Act.

The work made before this Act comes into force and not being copyrighted by virtue of the Act for the Protection of Literary and Artistic Works, B. E. 2474, which is qualified to be protected by this Act, shall enjoy the protection of the copyright hereunder.

**THAILAND: ITEM 1A**  
**ROYAL DECREE**  
**PROVIDING CONDITIONS FOR THE PROTECTION OF**  
**INTERNATIONAL COPYRIGHT**

*Section 1.* This Royal Decree is called the "Royal Decree Providing Conditions for the Protection of International Copyright, B.E. 2526."

*Section 2.* This Royal Decree shall come into force as from the day following the date of its publication in the Government Gazette.

*Section 3.* In this Royal Decree: "Convention" means the International Convention for the Protection of Literary and Artistic Works, concluded at Berne in September 1886, revised at Berlin on 13th November 1908, and completed by the Additional Protocol signed at Berne on 20th March 1914;

"country of origin" means

- (i) the country of which the author is a national, subject or resident, at all time or most of the time during the creation of the work, in the case of unpublished works;
- (ii) the country of the first publication, in the case of published works;
- (iii) the country the laws of which grant the shortest term of protection, in the case of works published simultaneously in several Contracting States to the Convention; or
- (iv) the Contracting State to the Convention, in the case of works published simultaneously in a Non-Contracting State and in a Contracting State to the Convention.

*Section 4.* Any work in which interna-

tional copyright subsists shall enjoy protection by virtue of the law on copyright under the following conditions:

- (i) In the case of unpublished work, the author must be a national, subject or resident of the Contracting State to the Convention, at all time or most of the time during the creation of the work. In the case of published work, the first publication must have been effected in the Contracting State to the Convention.
- (ii) Such work must be in accordance with the conditions and procedure provided by the law on copyright of the country of origin.

*Section 5.* The copyright shall subsist in the work under section 4 for a period provided by the law of the country of origin, but it shall not exceed the term of protection under the law on copyright.

In the case of literary or dramatic work, if the owner of copyright does not make or authorise the translation in Thai language and publish such translation in the Kingdom within ten years from the last day of the year of the first publication of such literary or dramatic work, the exclusive right of reproduction, adaptation or publication of the translation in the Kingdom shall be deemed extinguished.

*Section 6.* The Minister of Education shall have charge and control of the execution of this Act.

*Date of Decree:* 1983.

*Date of Entry into Force:* February 10, 1983.

*Official Thai text* published in the *Government Gazette*, Vol. 100, Part 15, special issue, of February 9, 1983 (B.E. 2526).

*Observation:* Official English translation provided by the Government of Thailand.