

CHAPTER 21 INTELLECTUAL PROPERTY

For many years, Thailand has had a status of notoriety for the often flagrant abuses of intellectual property law that took place. The manufacturing, import and sale of counterfeit branded clothing, perfumes, cosmetics, watches, computer software, CDs and DVDs, and other products, often took place in the face of a lack of unwillingness of officials to enforce existing laws. Under pressure particularly from the United States and international organizations, Thailand has now made a greater effort to enforce its intellectual property laws.

Thai manufacturers, performing artists and filmmakers now increasingly realize that trademark and copyright laws may be used to protect their own branded products or creative work and to deter unlicensed use, copying or imitation, just as much as such laws may be used by foreigners.

As to international treaty obligations, Thailand is a party to the Trade-Related Aspects of Intellectual Property Rights (TRIPS) (1995), and the Berne Convention for the Protection of Literary and Artistic Works (1931), the fundamental treaty for protection of copyright in literary and artistic work.

In August 2017, Thailand acceded to the Madrid Protocol, the principle aspect of which is: where a Madrid country has already registered its trademark in another Madrid country, it will not be required to re-register its trademark in Thailand, subject to local rules, and other matters.

In this chapter, we consider the five principal Acts in this area, namely:

1. the Trademark Act
2. the Patent Act
3. the Copyright Act
4. the Trade Secrets Act
5. the Geographic Indications Act.

There are also other Acts that confer intellectual property rights. In 1999, an Act was passed to regulate the production of compact discs. In 2000, the Integrated Designs Act was passed, to give protection to designers and manufacturers of integrated circuits and circuit designs.

Trademarks

General Since 1931, Thailand has provided for a system of trademark registration. The current Act is the Trademark Act (1991) which became effective in February, 1992. The Act provides for service marks, certification marks and collective marks to be registrable, in addition to trademarks. In March 2013, Thailand adopted the Tenth Edition of the Nice Agreement, under which there

are 34 classifications of goods and 11 classifications of services for trademark purposes.

Trademark Act (1991)

Definitions The Act contains a number of definitions:

1. A *mark* means a photograph, drawing, device, brand, name, word, letter, manual, signature, combinations of colours, shape or configuration of an object or anyone or combination thereof.
2. A *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 owner of such trademark is used from goods under another person's trademark.
3. A *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 owner of such service mark from services under another person's service mark.
4. A *certification mark* means a mark used or proposed to be used by the owner 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.
5. A *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.

An extension of the definition of 'trademark' was made a number of years ago, so that sound marks would be added to the definition of a 'trademark'. To be registrable, a sound must not directly:

- describe the character or nature of the goods for which it is applied;
- be the natural sound of the goods; or
- be the sound produced by the function of the goods.

Trademark registration To be registrable, a trademark must

1. be distinctive;
2. not be prohibited under the Act;
3. not be the same as, or similar to, a trademark registered by another person.

Characteristics of a trademark A trademark which has any one of the following characteristics shall be deemed distinctive:

1. A personal name or surname, not being such according due to its ordinary signing, a name of a juristic person or trade name represented in a special manner.
2. A word or words that does not directly refer to the character or quality of the goods and is not a geographical name, as prescribed in regulations.
3. A combination of colours represented in a special manner, stylised letters, numerals or invented words.
4. The signature of the person who applies for registration, his business predecessor or the signature of another person.
5. A representation of the applicant, another person or a dead person with the permission of their descendants.
6. An invented device.

Names and words that do not have the characteristics under (1) or (2), if used as trademarks with goods which have been widely sold or advertised, subject to compliance with regulations, shall be deemed distinctive.

Unregistrable trademarks Trademarks that have the following characteristics cannot be registered:

1. State arms or crests, royal seals, official seals, *Chakri* emblems, emblems and insignia of royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces.
2. The national flag of Thailand, royal standard flags or official flags.
3. Royal names, royal monograms, abbreviations of royal names or royal monograms.
4. Representations of the King, Queen or heir to the throne.
5. Names, words, terms or emblems signifying the King, Queen or heir to the throne or members of the royal family.
6. National emblems and flags of foreign states, emblems and flags of international organizations, emblems of head of foreign states, official emblems and quality control and certification of foreign states or

- international organizations, names and monograms of foreign states or international organizations, unless permission is given by a competent official.
7. Official emblems and emblems of the Red Cross or the 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 agency for public enterprise or any other Thai government organisation, 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. Any mark which is contrary to public order, morality or public policy.
 10. A mark (whether registered or not) which is identical to a well-known mark, or so similar thereto that the public might be confused as to the owner or origin of the goods.
 11. Trademarks similar to those under (1) (2) (3) (5) (6) or (7) above.
 12. Geographical indications protected by law.
 13. Other trademarks, as prescribed by regulations.

Application to register An application for registration of a trademark may be made for specific goods in one class, or in different classes, but the kinds of goods for which protection is sought must be clearly specified. An application may not cover goods of different classes.

Multiple-class applications are now allowed, while single-class applications (as allowed under the current law) will also remain permissible.

Address in Thailand The applicant or his agent who applies for registration, must have an office or address for communication in Thailand.

Applications that comply with international conventions Where Thailand has acceded to an international convention concerning trademark protection, an application which complies with such convention is deemed to be an application under the Trademark Act.

Refusal of application An application will be refused where the trademark is:

1. Identical with a trademark already registered by another person.

2. So similar to the registered trademark of another person that the public may be confused or misled as to the owner or origin of the goods and such 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.

Associated trademarks Where registered or pending trademarks of the same owner covering goods of the same class or different classes but the same character are so similar to one another that the public might be confused or misled as to the owner or origin of the goods used by different persons, such trademarks will be registered as associated trademarks.

Amendment of application If it is considered that an unessential part of a trademark applied for is not registrable under the Act or an application for registration is contrary to the Act or is not in accordance with regulations, then the applicant will be directed to amend the application within 90 days.

Refusal of application If the entire trademark or an essential part thereof is not registrable under the Act, registration will be refused. The notice of refusal shall state the grounds.

Partial refusal If a trademark considered as a whole is registrable, but contains one or more parts that are common for some types or classes of goods, such that no applicant should have exclusive right thereto or which are not distinctive, the following orders can be made:

1. The applicant must within 90 days disclaim exclusive right to use of such part of the trademark.
2. The applicant must within 90 days make such other disclaimer as may be necessary in order to define the rights of the owner under such registrations.

Right of appeal There is a right of appeal against orders made under previous sections. Appeal must be made to the Trademark Board within 90 days.

Multiple applicants Where several applicants apply to register:

1. Where the trademarks are identical or so similar that the public might be confused or misled as to the owner or origin of the goods, and the applications cover goods in the same class or goods in different classes having the same character, the prior applicant shall be entitled to be registered as owner.

2. If the identical or similar trademarks are all registrable and the applications conform with the Act, the Registrar will order the applicants to comply with the provisions regarding agreement to register.
3. An applicant who does not agree that his trademark is identical with or similar to other trademarks may appeal to the Trademark Board within 90 days.

Agreement to register Within 90 days from an order made, the applicants must agree as to which one shall be the sole owner of the trademark and anyone of them shall inform the Registrar in writing within such period whether or not agreement has been reached. Where details of such agreement are notified as to which applicant is allowed by agreement to register, the application will be published.

Where no agreement has been reached or has not been notified within the permitted period, publication will be made of first application or of the first among those who have not abandoned their applications, as the case may be.

Application to register identical mark Where the applicants have been notified to comply with the Act and another applicant files an application for a trademark which is found to be identical with those of the other applicants or so similar thereto that the public might be confused or misled as to the owner or origin of the goods, the goods being of the same class or of the same character in a different class, registration will be refused. There is a right of appeal within 90 days.

Multiple registrations If there has been concurrent use in good faith and special circumstances make it proper to do so, registration by more than one owner of a mark which is identical with or similar to a registered trademark or to trademarks the subject of pending applications in respect of goods of the same class or goods of a different class but found to be of the same character, shall be made. Conditions and limitations as to the mode or place of use may be made. The applicants and registered trademark owner shall be notified of such decision. There is a right of appeal against such decision exercisable within 90 days.

First filing date A person who has filed a trademark application in a foreign country and applies for registration of a trademark in Thailand within six months from the first foreign application, he may claim the first foreign filing date as the filing date in Thailand provided that he fulfils one of the following requirements:

1. He is a Thai national or juristic person having its head office located in Thailand.
2. He is a national of a country that is party to a convention on trademark protection to which Thailand is also a party.

3. He is a national of a country which accords the same rights to Thai nationals or juristic persons having their head office located in Thailand.
4. He is domiciled or has an industrial or commercial establishment in Thailand or a country that is party to a convention on trademark protection to which Thailand is also a party.

Where the first foreign application is refused, withdrawn or abandoned, the applicant may not claim such rights.

Where application for first filing is refused Where a trademark application is filed in a foreign country where a previous application has been refused, withdrawn or abandoned within six months from the date of the first foreign application, the applicant may claim the rights under the paragraph above, provided that:

1. No claim for priority rights has been made.
2. The application may not be processed under the trademark law of the country where the application was filed.
3. The refusal, withdrawal or abandonment of the application has not been disclosed to the public.

Publication When an application for registration is considered acceptable, the application shall be ordered to be published.

Cancellation after publication If after the application has been ordered to be published, it appears that the trademark is not registrable or the application does not comply with the Act and the trademark has not been registered, the order shall be cancelled and the applicant notified in writing. There is a right of appeal against a cancellation order exercisable within 90 days.

Challenging publication If after publication, any person believes that he has a better right in the trademark than the applicant, or that the trademark is not registrable or that the application is not in conformity with the Act may, within 90 days of publication, file a notice of opposition with the Registrar, stating the grounds of the opposition.

A copy of the opposition must be sent to the applicant. The applicant must within 90 days, file a counterstatement, stating the grounds on which he relies in support of his application.

In considering the opposition, both parties may be ordered to give additional statements, written explanations or evidence.

The deadline for filing an appeal, opposition, counterstatement or disclaimer will be 60 days from the date on which the relevant order was received from the Trademarks Office. This deadline is non-extendable.

Decision The Registrar will notify both parties of his decision with reasons. Either party may appeal to the Trademark Board within 90 days. If a party is still dissatisfied, there is a further right of appeal to the Court within a further 90 days.

Registration Where no opposition is filed or the opposition is dismissed, registration of the trademark will be ordered. With effect from July 2015, registration fees must be paid within 60 days although an extension may be applied for.

Application by opposer Where the opposer has also applied for registration of a trademark which is identical with or similar to the trademark opposed and a final decision or judgement has been made to the effect that the opposer has better rights than the applicant, provided that the opposer's trademark is registrable and the application conforms with the Act, the Registrar will register the trademark.

Date of registration A trademark is usually deemed to be registered on the date of application.

Rights of trademark owner The person who is registered as the trademark owner has the exclusive right to use it for the goods for which it is registered.

Unregistered trademarks No person may bring legal proceedings to prevent or to recover damages for the infringement of an unregistered trademark. In such cases, the owner may bring legal proceedings for passing off.

Bona fide use Registration does not affect the bona fide use by a person of his own personal name, surname, name of his business or that of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods.

Transfer The right to a pending trademark application may be assigned or transferred by succession. Any transfer must be notified to the Registrar. The right to a registered trademark may be assigned or transferred by succession with or without the business concerned in the goods for which the trademark is registered. Associated trademarks may be assigned or transferred by succession only when they are all assigned or transferred together. Transfer by succession must be registered.

Assignment or inheritance of ownership does not extinguish licenses granted previously.

Amendment of registration The owner of a registered trademark may request amendment of the following particulars of registration:

1. The specification of goods, by cancelling some items.
2. The name, nationality, address and occupation of the owner of the trademark or his agent.
3. The office or address for communication.
4. Other particulars, as prescribed in regulations.

Period of validity Registration of a trademark is valid for 10 years from the date of registration. It may be renewed within 90 days prior to expiry, or within 6 months after expiry for a further period of 10 years.

Cancellation

1. The owner of a trademark may request cancellation of registration but where there is a registered license agreement, the consent of the licensee is required, unless the license agreement provides otherwise.
2. The Registrar may order cancellation where the owner violates or fails to comply with the conditions or restrictions prescribed upon registration or where the owner or his agent ceases to have an office or address in Thailand.
3. An interested person or the Registrar may petition the Trademark Board for cancellation if it appears that at the time of registration the trademark:
 - was not distinctive;
 - contained or consisted of prohibited characteristics;
 - was identical with a trademark registered by another person for goods of the same class or of a different class with the same character;
 - was so similar to a trademark registered by another person, that the public might be confused or misled as to the owner or origin of the goods for goods of the same class or of different class with the same character.

4. Any person who is of the opinion that any trademark is contrary to public order or good morality or to public policy may petition the Board for cancellation.

5. Any interested person or the Registrar may petition the Board to cancel a trademark registration if it is proved that at the time of registration the owner 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 owner can prove that such non-use was due to special circumstances in the trade and there was no intention not to use or to abandon the trademark.

Any application for cancellation must be served on the owner.

Any decision made may be appealed within 90 days.

Application for cancellation on other grounds

1. An interested person or the Registrar may apply to the Court for cancellation by 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.
2. Within five years from the date of registration, an interested person may petition the court to cancel a trademark registration by showing that he has better rights in the trademark than the person registered as its owner. If the applicant can prove that he has better rights 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 that the petitioner cannot prove that he has better rights than the trademark owner.

Licensing trademarks The owner of a registered trademark may license its use for all or some of the goods for which the trademark is registered. License agreements must be in writing and registered with the Intellectual Property Department. Conditions may be imposed. Registrations may be amended by mutual consent of the parties.

Cancellation of licensing agreement Cancellation of a registered license agreement may be made where:

1. The owner and the licensee jointly apply.
2. Either party applies for cancellation on expiry.

3. An interested person or the Registrar may apply for cancellation on the following grounds:
 - the use of the trademark by the licensee has confused or misled the public or is contrary to public order or morality, or public policy,
 - the trademark owner can no longer exercise effective control over the quality of the goods under the license, or
 - the trademark registration has been cancelled.

Implied rights of licensee Unless otherwise provided in the license agreement, a trademark owner has the following rights:

1. To use the trademark himself and to grant sublicenses.
2. To use the trademark throughout the country for all the goods for which the trademark is registered and for the entire term of the trademark registration and its renewals.

Service marks Provisions concerning trademarks also apply to service marks, *mutatis mutandis*.

Certification marks Except as otherwise provided, provisions concerning trademarks also apply to certification marks, *mutatis mutandis*.

Application to register a certification mark An applicant for registration of a certification mark, in addition to complying with the provisions on registration of trademarks, shall:

1. submit the regulations on use of the certification mark with the application for registration; and
2. show an ability to certify the characteristics of the goods or services as provided in the regulations above.

The regulations must indicate the origin, composition, method of production, quality or other characteristics that are to be certified including the rules, procedures and conditions for authorizing use of the certification mark.

Amendment The applicant may be required to amend the regulations within 60 days.

Refusal of application Where the applicant does not have sufficient ability to certify the characteristics of the goods or services as provided in the regulations or registration of the certification mark would not be in the public interest, the application may be refused

Publication In the publication of an application to register a certification mark, the essential elements of the regulations shall be indicated.

Amendment The owner of a registered certification mark may apply to amend the regulations on use, provided the public interest is not thereby affected.

Usage and licensing The owner of a registered certification mark may not use the mark on his own goods or services and may not license others to act as certifier by authorizing the use of the certification mark. Any authorization of others to use a certification mark for goods or services shall be in writing and signed by the owner of the certification mark.

Transfer The right to a registered certification mark may be transferred when:

1. transfer has been approved by the transferee showing that he has sufficient ability to certify the characteristics of the goods or services as indicated in the regulations on use of the certification mark,
2. the transfer is in writing, and
3. the transfer has been registered.

Termination The right to a certification mark terminates, when the owner dies or loses its status of a juristic person.

Collective marks In general, the provisions concerning trademarks apply to collective marks, mutatis mutandis.

Regulation Regulation of the registration of trademarks, certification marks, service marks and collective marks, the hearing of certain appeals and the issuing of regulations is delegated to a body called the Trademark Committee.

Enforcement The Act sets out a system of fines and imprisonment for breaches of duties imposed.

Any person who uses packaging materials bearing the trademark of another for the packaging of his own goods in order to lead the public to believe that the goods originated from the trademark owner will be liable to imprisonment or a fine.

Patents

The law regarding patents is set out in the Patent Act (1979), as amended by the Patent Act (1992) and the Patent Act (1999).

International aspects of patents Patents may be granted to Thai nationals and those holding nationality of countries that allow Thai nationals reciprocal rights.

In 2008, Thailand joined the Paris Convention for the protection of Industrial Property. In September 2009, Thailand ratified the Patent Co-operation Treaty. This means in general that a patent application filed in Thailand will, if granted, ensure patent protection in all other countries that have ratified the PCT.

Patent Act (1979)

Definitions The Act defines the following terms:

1. A *patent* means a document issued to grant protection for an invention or a design.
2. A *petty patent* means a document issued to grant protection for an invention under certain provisions of the Act.
3. An *invention* means any innovation or invention that creates a new product or process, or any improvement of a known product or process.
4. A *process* means any method, art or process of producing, maintaining or improving the quality of a product, including the application of such process.
5. A *design* means any form or composition of lines or colours which gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft.

Requirements for a patent A patent may be granted for an invention where the following conditions are satisfied:

1. the invention is new,
2. it involves an inventive step, and
3. it is capable of industrial application.

Definition of "new" An invention is new if it does not form part of the state of the art. State of the art includes any of the following inventions:

1. An invention which was widely known or used by others in the country before the date of application for the 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 for which a patent or petty patent was granted in this or a foreign country before the date of application.
4. An invention for which a patent or petty patent was applied in a foreign country more than 18 months before the date of the application and a patent or petty patent has not been granted for such invention.
5. An invention for which a patent or petty patent was applied for in this or a foreign country and the application was published before the date of application.

Interpretation Unlawful disclosure or disclosure made by the inventor, or made in consequence of display at an international exhibition, made within twelve months before the application was filed, does not amount to disclosure for this purpose.

An invention is deemed to involve an inventive step, if it is not obvious to a person ordinarily skilled in the art.

An invention is deemed to be capable of industrial application, if it can be made or used in any kind of industry, including handicrafts, agriculture and commerce.

Inventions not protected The following inventions are not protected:

1. Naturally occurring micro-organisms and their components, animals, plants or extracts from animals or plants.
2. Scientific or mathematical rules or theories.
3. Computer programs.
4. Methods of diagnosis treatment or cure of human or animal diseases.
5. Inventions that are contrary to public morality, health or welfare.

Transfer of patent application The right to apply may be assigned or transferred by succession, provided that it must be in writing and signed by both parties.

Rights of employers regarding inventions The right to apply for a patent for an invention made during employment or whilst performing a contract for a specific assignment belongs to the employer or the person having commissioned the work, unless the contract specifies otherwise. This applies where the contract does not require the employee to engage in any inventive activity, but the employee made the invention using any method or information that his employment has put at his disposal.

An employee-inventor has a right to remuneration in addition to his regular salary if the employer benefits from the invention. Such right may not be excluded by any contract provision. Any request for remuneration will be decided by the Director-General

Criteria for patent applicants An applicant to register a patent must come within one of the following categories:

1. He is a Thai national or juristic person with its head office in Thailand.
2. He is a national of a country that is party to a convention on patent protection to which Thailand is also a party.
3. He is a national of a country that allows Thai nationals or juristic persons having their head office in Thailand to apply for patents in that country.
4. He is domiciled or having an industrial or commercial establishment in Thailand or a country that is party to a convention on patent protection to which Thailand is also a party.

Joint inventors When an invention has been made by two or more persons jointly they shall apply for a patent jointly. If a joint inventor refuses to join in an application, cannot be found or reached or is not entitled to apply, the application may be made by the other inventor on his own behalf.

A joint inventor who did not apply, may subsequently join in the application at any time before the patent is granted.

Invention made by several persons If two or more persons have separately and independently made the same invention and each has applied for a patent, the person who applies first is entitled to the patent. If the application is filed on the same date, the applicants must agree whether a patent should be granted to one of them, or all of them jointly. If no agreement is reached within the period prescribed, they shall issue court proceedings within 90 days.

Contents of patent application The application for a patent must contain:

1. the name of the invention,

2. a brief statement of its nature and purpose,
3. a detailed description of the invention using full, concise, clear and exact terms so as to enable a 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 showing the best method to carry out the invention,
4. one or more clear and concise claims, and
5. other matters, as prescribed in regulations.

Where Thailand has acceded to an international agreement on patents, an application which complies with such international agreement is deemed to be an application made under the Act.

One invention or more An application must relate to one invention or to a group of inventions which are so linked that they form a single concept.

First filing date A person who applies to register an invention overseas may claim the first foreign filing date as the filing date in that country, if the application is filed in the country within 12 months from the first filing date in that foreign country.

Amendment An application may be amended, provided that such amendment does not enlarge the scope of the invention.

Examination of application Before granting a patent, the application must be examined to ensure conformity with the Act. A government department or foreign patent office may be requested to examine it. If it appears that the application relates to several distinct inventions which are not linked as to form a single concept, the applicant will be asked to separate the application into several applications, each of which relates to a single invention. Any separated application must be filed within 180 days, in which case filing will be deemed to take place on the first filing date.

Rejection of application, publication Where the application has been examined, a report will be sent to the Director-General.

If it appears that the Act has not been complied with, or the invention is not patentable, the application will be rejected.

Where the Act has been complied and it is not an unpatentable invention under the Act, the Director-General will order publication, subject to the applicant paying the fees.

After publication, the applicant may request that it be examined to ascertain that it fulfils the necessary requirements, within five years after publication or, where an opposition is filed and an appeal is made, within one year after the final decision has been made.

Refusal to grant patent Where an application has been published, if it appears that it does not comply with the Act, the grant of a patent will be refused. The refusal will be published.

Claim of better right Where an application has been published, any person who thinks that he is entitled to the patent, or that the application does not comply with the Act, such person may give notice of opposition within 90 days after publication. A copy will be sent to the applicant, who must file a counterstatement within 90 days of receipt of the copy. A notice of opposition and counterstatement must be accompanied by supporting evidence.

Opposition proceedings In opposition proceedings, the opposer and the applicant may introduce any evidence or make additional statements to support the grounds on which they rely. The Director-General will make his decision and notify the parties with his reasons.

Procedure after request for examination Where a request for examination has been made, examination will take place and a report filed with the Director-General. After considering this, if there are no grounds refuse the grant of a patent, and it has not been opposed, or the opposition has been dismissed, registration will be ordered, subject to payment of fees.

Where an opposition is filed and it is decided that the invention belongs to the opposer, the application will be rejected. If the opposer applies to register within 180 days after rejection of the applicant's application or the date of any final decision, he will be deemed to have applied on the same filing date as the applicant. Publication of the applicant's application will be deemed as the date of publication of the opposer's application. In such case, no person may oppose the opposer's application on the grounds that he has a better right to the invention than the opposer.

Period of validity An invention patent is valid for 20 years from the date of filing.

Rights of patent holder A patent holder has the following rights:

1. where the patent is for a product, the right to produce, use, sell, possess for sale, offer for sale or import the product; and
2. where the patent is for a process, the right to use the process, to produce, use, sell, possess for sale, offer for sale or import products produced by the process.

Permitted usage The following acts do not constitute infringement of a patent holder's rights:

1. An act for the purpose of study, research, experiment or analysis, provided that it does not unreasonably conflict with normal exploitation of the patent and does not unreasonably prejudice the legitimate interests of the patent owner.
2. Production of a patented product or use of a patented process, provided that the producer or user, acting in good faith and without knowing or having reasonable cause to know of the patent application, has engaged in production or has acquired equipment therefore prior to the date of filing the patent application in Thailand.
3. Compounding a drug specifically to fulfil a doctor's prescription, by a pharmacist or medical practitioner, including any acts done to such pharmaceutical product.
4. Any act in relation to an application for drug registration, where the applicant intends to produce, distribute or import the patented pharmaceutical product after expiry of the patent term.
5. Use of a device forming the subject matter of a patent in the body of ship or other accessories of a ship of a country that is a party to a convention on patent protection to which Thailand is also party, when such a vessel temporarily or accidentally enters Thai territorial waters, provided that such device is used exclusively for the needs of the ship.
6. Use of a device forming the subject matter of a patent in the construction or other accessories of an aircraft or land vehicle of a country that is a party to a convention on patent protection to which Thailand is also a party, when such aircraft or land vehicle temporarily or accidentally enters Thailand.
7. Use, sale, possession for sale, offering for sale or importing a patented product, when it has been produced or sold with the authority or consent of the patent holder.

Scope of the patent holder's rights The scope of a patent holder's rights are determined by considering the characteristics of the invention, its description and drawings, and will extend to the characteristics of the invention which, although not specifically stated in the claim, in the view of a person of ordinary skill in the relevant art, have substantially the same attributes, functions and effects.

Patent licensing and transfer The patent holder may license his patent or transfer the patent. Any license agreement:

1. may not impose upon the licensee any condition, restriction or any royalty term which is unreasonably anti-competitive; and
2. may not require the licensee to pay royalties after the patent has expired.

These provisions may not be excluded by contract.

Rights of joint owners Unless there is an agreement to the contrary, a joint owner of a patent may separately exercise the rights conferred under the previous section without the consent of the other joint owner, but a license or transfer may only be made with the consent of all joint owners. License agreements and transfers must be in writing.

Patent fees A patent holder must pay annual fees beginning the fifth year of the term of the patent. Payment must be made within 60 days from the beginning of the fifth year, and in every year thereafter. A surcharge is payable if fees are not paid. Fees can be paid in advance.

Availability of patent A patent holder may request that an entry to be made in the register to the effect that any other person may apply for a license. The Director-General may then grant a license under the patent to any person who applies, subject to such conditions, restrictions and royalty terms agreed by the patent holder and the applicant. If the patent holder and the applicant cannot agree terms, the Director-General may grant a license subject to such conditions, restrictions and royalty terms as he deems appropriate.

License application after failure to use After three years from the grant of a patent, or four years from the date of application, whichever is later, any person may apply for a license if it appears that the patentee has unreasonably failed to exercise his rights as follows:

1. the patented product has not been produced or the patented process has not been applied in the country without any legitimate reason, or
2. no product produced under the patent is sold in any domestic market, or the product is sold but at an unreasonably high price or it does not meet the public demand, without legitimate reason.

The license applicant must show that he has attempted to obtain a license from the patent holder and has proposed conditions and remuneration that are reasonable, but has been unable to reach an agreement within a reasonable period.

License to use patent of others If the making of a claim infringes the patent of another person, a patent holder who desires to exploit his own patent may apply for a license under the patent of the other where:

1. the invention of the applicant involves an important technical advance of considerable economic significance in relation to the invention for which the license is applied, or
2. the patent holder is entitled to a cross-license on reasonable terms.

provided that the applicant may not assign his license, unless he assigns his own patent.

The license applicant must show that he has attempted to obtain a license from the patent holder and has proposed conditions and remuneration that are reasonable in the circumstances but has been unable to reach an agreement within a reasonable period.

License to use patents of others: other cases If the maker of any claim in the patent has obtained a license and is likely to infringe a patent of any other person, a license applicant may apply for a license under the patent of the other person where:

1. the invention of the applicant involves an important technical advance of considerable economic significance in relation to the invention for which the license is applied, and
2. provided that the applicant may not assign any license granted.

The applicant must show that he has attempted to obtain a license from the patent holder and has proposed conditions and remuneration that are reasonable under the circumstances but has been unable to reach an agreement within a reasonable period.

Where a compulsory license has been granted under any of the above sections, the patent holder is entitled to remuneration.

Requirements for an application for a compulsory license In an application for a compulsory license, the applicant shall include details of the remuneration offered, conditions for use of the patent and restrictions on the rights of the patent holder and any exclusive licensee. In the second case, the applicant shall offer a license of his patent to the other party.

Where the Director-General decides that a license shall be granted he shall determine the royalty payable, conditions for use of the patent and any restrictions on the rights of the patent holder and the licensee, as agreed by the

parties. If no agreement has been reached within the period prescribed, he will determine the royalty and prescribe the conditions and restriction as he deems appropriate, provided that:

1. the scope and duration of the license shall be not more than is necessary under the circumstances;
2. the patent holder is entitled to grant other licenses;
3. the licensee is not entitled to transfer the license, except with as part of his business or goodwill relating to the licensed part;
4. the licensing shall be aimed predominantly to supply the domestic market; and
5. the remuneration is adequate.

Termination of compulsory license A compulsory license may be terminated if the circumstances that led to it being granted cease to exist and are unlikely to recur, provided that termination does not affect the rights or interests of the licensee under any license granted.

Government right to obtain compulsory license In order to carry out any public service or which is of vital importance to national defence, for the preservation or realization of natural resources or the environment, to prevent or relieve a severe shortage of food, drugs or other consumable items, or for any other public service, any government department may exercise any right to apply for a license by paying a royalty to the patent holder or his licensee. Such department must submit its offer including remuneration offered and conditions for use. The royalty rate shall be as agreed upon by the parties.

During a state of war or emergency, a government order may be issued to exercise any right under any patent necessary for national defence and security, and paying fair remuneration to the patent holder.

Invalidity of patent Any patent granted not in compliance with the Act is invalid. Invalidity may be challenged by any person. An application to cancel an invalid patent may be submitted to the Court by any interested person or the public prosecutor.

Cancellation of patent The Director-General may apply for cancellation, where:

1. a license has been issued and after two years from the date of the license, and

- the patent holder or the licensee has failed to produce the patented product or use the patented process without legitimate reason, or
 - no patented product or product derived from the patented process is sold or imported into Thailand, or such product is maintained at an unreasonably high price, and the Director-General determines that there are good grounds to cancel the patent, or
2. the patent holder has granted a license that does not comply with the Act.

Designs

Nature of designs A patent may be granted for a new design for industry, including handicrafts. The following designs are not new:

1. A design widely known or used by others in Thailand before the filing of the patent application.
2. A design disclosed or described in a document or a printed publication in Thailand or a foreign country before the filing of the patent application.
3. A design published before the filing of the patent application.
4. A design so nearly resembling any design in the three categories above, so as to be an imitation.

Unpatentable designs The following designs are unpatentable:

1. designs contrary to public order or morality, or
2. designs that are proscribed by regulations.

Contents of an application An application for a patent must contain:

1. a representation of the design;
2. an indication of the product for which the design is to be used;
3. a clear and concise claim;
4. other matters, as prescribed in regulations.

One product only An application for a patent may relate to a design to be used with only one product.

First filing overseas A person who has filed a patent application for a design in a foreign country may claim the first foreign filing date as the filing date in Thailand, if the application is filed within 6 months following the first filing date in the foreign country.

Rejection of application When an application has been published, but before the registration and grant of a patent, it appears that the application does not comply with the Act, the Director-General will reject the application. When an application has been rejected and the application was opposed, the opposition will then be considered.

Period of validity A design patent is valid for 10 years from the date of filing the application.

Rights of patent owner The patent holder shall have the right to use the patented design in the manufacture of a product or to sell, possess for sale, offer for sale or import a product embodying the patented design, except for the use of the design for the purpose of study or research.

Invalidity of patent Any patent which does not comply with the Act shall be invalid. The validity of a patent may be challenged by any person. An application to cancel an invalid patent may be submitted to the Court by any person who has an interest in the patent or by the public prosecutor:

Applicability Most of the provisions of the Act regarding invention patents apply to design patents.

Petty patents

Conditions for a petty patent A petty patent may be granted for an invention if:

1. the invention is new, and
2. it is capable of industrial application.

Conversion of application No application can be made for a petty patent and also a patent, for the same invention. An applicant for either may apply to convert his application, before registration has taken place. The applicant may claim the date of filing of the original application as the filing date of the converted application.

Examination of application The application will be examined as to its conformity with the Act and a report will be submitted to the Director-General.

If the application for a petty patent does not comply with the Act or the claimed invention is not protectable, the application will be refused. If the application for a

petty patent complies with the Act and the invention is protectable, the application will be granted, the invention registered and a petty patent issued, subject to payment of fees.

Examination after registration Within one year from the publication of the registration of the invention and the grant of a petty patent, any interested person may request an examination as to whether the invention satisfies the conditions under the Act. Where it is held that the invention does not satisfy the conditions under the Act, an examination will be ordered. The owner of the petty patent will be requested to submit a statement supporting his application within 60 days. After examination, if the Director-General determines that the invention does not satisfy the conditions under the Act, he shall submit his report to the Board to cancel the petty patent.

Period of validity A petty patent is valid for six years from the date of filing. An extension is possible for two periods each of two years, provided it is applied for 90 days before the expiry date.

Invalidity of design patent A petty patent granted without compliance with the Act shall be invalid. The invalidity may be challenged by any person. An application to cancel an invalid patent may be submitted to the court by any interested person or the public prosecutor.

Applicability Most of the provisions of the Act that apply to invention patents also apply to petty patents.

Regulation A Patent Committee is established to implement the Act, hear appeals and draft regulations.

Interpretation A person who applies for both a patent and a petty patent for the same invention not in compliance with the Act shall be deemed to have applied for a petty patent. If two or more persons have separately or independently made the same invention and one of them has made an application for a patent while the other person has applied for a petty patent, then:

1. the applicant who is the first to apply for a patent or petty patent shall be entitled to a patent or petty patent, as the case may be;
2. if the applications are filed on the same date, the applicants will be invited to agree whether the grant should be made to one of them or all of them jointly and whether it should be an application for a patent or petty patent. If no agreement is reached within the period prescribed, they may issue Court proceedings within 90 days.

Claim of better right Within 90 days following publication, the applicant for a petty patent, the owner of a petty patent, the applicant for a patent or a patent

holder who thinks that the registration of the invention and the grant of the patent or petty patent may not be in conformity with the Act for the reason that the invention is the same invention belonging to him, and he has applied for a petty patent or a patent on the same date on which such application for a patent or a petty patent was filed, may request an examination as to whether such application complies with the Act. After receipt, an examination will take place and a report will be prepared. Where the Director-General determines that the registration of the invention and the grant of a patent or petty patent is not in compliance with the Act, since it is for the same invention, and the application was filed on the same date as the application of the person requesting for the examination, he will invite the parties to agree on the person who should solely have the rights to the invention or whether they should jointly hold such rights. If no agreement is reached within the period prescribed, they will be regarded as jointly holding the rights to the invention.

Invalidity of patent or petty patent Any patent or petty patent granted not in compliance with the Act is invalid. Validity may be challenged by any person. If the registration and the grant of a patent or petty patent is not in compliance with the Act and the application for a patent and a petty patent for the invention were filed on the same date, the patent holder, the owner of the petty patent, any other interested person or the public prosecutor may request the Director- General to notify the parties to agree that the invention is to be the subject of either a patent or a petty patent. If no agreement is reached within the period prescribed, the patent holder and the owner of the petty patent shall be regarded as joint owners and the invention will be the subject of a petty patent.

Enforcement Civil proceedings may be taken to enforce violations of the Act. In addition, the Act prescribes fines and imprisonment for violation of certain duties. Injunctions may be applied for in certain circumstances. As to juristic persons, the person in charge or representative of a juristic person may face personal liability for violations.

Copyright

International aspects Thailand has acceded to the Berne Convention for the protection of Literary and Artistic works, and therefore a person who is a resident of a country that has signed the Berne Convention or a person whose works were first published in such a country may claim copyright protection in Thailand.

Copyright Act (1994)

Definitions The Copyright Act contains the following definitions:

An *author* is a person who makes or creates a work which is a copyright work by virtue of the Act.

copyright means the exclusive right to do any act by virtue of the Act, with respect to the work created by the author.

literary work means any kind of literary work including books, pamphlets, writings, printed matters, lectures, addresses, speeches and computer programs.

computer program means instructions, a set of instructions or any other things, which are used with a computer so as to operate the computer or to generate output, whatever the computer language is.

dramatic work means a work with respect to choreography, dancing, acting or performance of drama, including a pantomime.

artistic work means a work with one or more of the following characteristics:

1. a painting or drawing, meaning a creation or configuration consisting of lines, light, colours or other things and composed from one or more materials;
2. a sculpture, meaning a creation or configuration with tangible volume;
3. lithography, meaning the creation of a picture by a printing process and including a printing block or plate used in the printing;
4. architecture, meaning a design of a building or construction, an interior or exterior design, a landscape design or a creation of a model of a building or construction;
5. photography, meaning the creation of images with the use of image-recording equipment allowing light to pass through a lens to a film or piece of glass to be developed with liquid chemicals of a specific formula or any process that creates images, or a recording of images using other equipment or methods;
6. illustration, maps, structures, sketches or three-dimensional work with respect to geography, topography or science;
7. applied art, meaning work applying each or a composition of the work referred to in (1) to (6) for other use, apart from the appreciation of the merit of the work, such as for practical use, decoration of materials or appliances, or for commercial benefit.

It is irrelevant whether the work in (1) to (7) has artistic value. Photographs and plans of such work are also protected.

musical work means a work with respect to a song which is composed for playing or singing whether with a melody and lyrics or melody only, including arranged and transcribed musical notes or musical diagrams.

audiovisual work means a work consisting of a series of images recorded on any kind of material and capable of being replayed, with equipment necessary for such material, including the sounds accompanying such work, if any.

cinematographic work means audiovisual work consisting of a series of images which can be shown in succession as motion pictures, or can be recorded upon other materials so as to be shown in succession as motion pictures, including the sounds accompanying such motion pictures, if any.

sound recording means a work consisting of a series of musical sounds, the sound of a performance or any other sounds recorded on any kind of material and capable of being replayed with equipment necessary for such material, but excluding sounds accompanying a cinematographic work or another audiovisual work.

performer means a performer, musician, vocalist, choreographer, dancer, or a person who acts, sings, speaks, narrates or performs in accordance with a script or performs in any other manner.

broadcasting work means a work which is communicated to the public by means of radio broadcasting, sound and/ or video broadcasting on television or by any other similar means.

reproduction includes any method of copying, imitation, duplication, moulding, sound recording, video recording or sound and video recording for a significant part from the original or copies or publication in whole or in part and, as for a computer program, meaning duplication or copying of a program from any medium in a significant part by any method without creating a new work whether in whole or in part.

adaptation means reproduction by transformation, improvement, modification or emulation of the original work in a significant part without creating a new work whether in whole or in part.

communication to the public means making the work available to the public by means of performing, lecturing, preaching, music playing, causing its perception by sound or image, or constructing or distributing it by any other means.

publication means the distribution of duplicated copies of a work, whatever may be the form or character, with the consent of the creator where such copies are available to the public in a reasonable quantity having regard to the nature of the work; provided that the performance or playing of a dramatic work, a musical

work or a cinematographic work, a lecture or the recitation of a literary work, the sound and video broadcasting of a work, the exhibition of an artistic work and the construction of a work of architecture shall not constitute publication.

Meaning of copyright work Copyright work means creative work that is literary, dramatic, artistic, musical, audiovisual, cinematographic, sound recording, sound and video broadcasting work or any other work in the literary, scientific or artistic domain, whatever may be the mode or form of its expression.

Exclusion from protection Copyright protection does not extend to any idea or procedure, process or system or method of use or operation or concept, principle, discovery or scientific or mathematical theory.

Exclusion from copyright The following are not copyright works:

1. Daily news and facts that are mere information and are not a work in the literary, scientific or artistic domain.
2. The constitution and legislation.
3. Regulations, rules, announcements, orders, explanations and official correspondence of ministries, departments or any other government or local departments.
4. Judicial decisions, orders, rulings and official reports.
5. Translations and compilations of the above items made by ministries, departments or other government or local departments.

Requirements to be recognised as an author The author is the owner of copyright in a creative work, subject to the following conditions:

1. In the case of unpublished work, the author must be a Thai national or reside in Thailand or be a national of or reside in a country which is a member of a convention for the protection of copyright of which Thailand is a member, provided that residence must be at all times or for most of the time spent on the creation of the work.
2. In the case of published work, first publication must be made in Thailand or in a country which is a member of a convention for copyright protection of which Thailand is a member, or where first publication is made outside Thailand or in a country which is not member of a convention for copyright protection of which Thailand is a member, if the publication of the said work is subsequently made in Thailand or in a country which is member of a convention for copyright protection of which Thailand is a member within

30 days from first publication, or the author has the qualifications as prescribed above at the time of the first publication.

Where the author must be a Thai national, if the author is a juristic person, such person must be established under Thai law.

Work created by an employee Copyright in work created by a person in the course of employment vests in the author, unless it has been otherwise agreed in writing; provided that the employer is entitled to communicate such work to the public in accordance with the purpose of the employment.

Work created under a commission Copyright in a work created in the course of a commission vests in the employer, unless the author and the employer have agreed otherwise.

Adaptation Copyright in a work which is an adaptation of a copyright work with the consent of the owner vests in the person who makes such adaptation, but without prejudice to the owner of copyright in the work which is adapted.

Compilation or composition Copyright in a work which is a compilation or composition of copyright works with the consent of the owner, or a compilation or a composition of information or materials which are readable, or conveyable by a machine or other apparatus, vests in the person who makes the compilation or the composition. Provided that he has done so by means of selection or arrangement in a manner which is not an imitation of the work of another person but without prejudice to the owner of copyright in the works, information or other materials that are compiled or composed.

Rights of copyright owner The owner of a copyright has the exclusive rights of:

1. reproduction or adaptation;
2. communication to the public;
3. leasing the original or copies of a computer program, an audiovisual work, a cinematographic work and a sound recording;
4. conferring benefits from the copyright to others;
5. licensing the rights mentioned above with or without conditions, provided that the said conditions shall not unfairly restrict competition.

Transfer of copyright Copyright may be transferred. The owner of copyright may transfer it in whole or in part, for a limited duration or for the entire term of copyright protection. Transfer of copyright by any means other than inheritance,

must be in writing and signed by both parties. If the duration is not specified, the transfer is deemed to last for 10 years.

Any distribution of original or copied copyrighted work the ownership of which is lawfully acquired, does not amount to copyright infringement. .

Prohibited acts The author of a copyright work is entitled to identify himself as the creator and to prohibit the assignee or any person from distorting, shortening, adapting or doing anything to the work to the extent that such act would cause loss to the reputation or dignity of the creator. When the creator has died, his successors may enforce such rights by taking proceedings throughout the period of copyright protection.

Period of validity Copyright endures for the life of the creator and for 50 years after his death. In the case of joint authorship, copyright endures for the life of the joint authors and 50 years from the death of the last joint author.

Where the author is a juristic person, copyright endures for 50 years from its creation, provided that if the work is published during such period, copyright endures for fifty years from first publication.

Copyright in a photographic work, an audiovisual work, a cinematographic work, a sound recording or an audio and video broadcasting work endures for 50 years from creation, provided that if the work is published during such period, copyright endures for 50 years from first publication.

Copyright in a work of applied art endures for 25 years from creation, provided that if the work is published during such period, copyright endures for 50 years from first publication.

Copyright in a work which is created in the course of employment, instruction or control endures for 50 years from creation, provided that if the work is published during such period, copyright endures for 50 years from first publication.

Publication means publication with the owner's consent.

Infringement The following acts constitute infringement of copyright:

1. reproduction or adaptation, or
2. communication to the public.

With regard to audiovisual work, cinematographic work or a sound recording, the following are deemed to be infringement of copyright:

1. reproduction or adaptation;

2. communication to the public; or
3. leasing of the original or copies of the work.

With regard to sound and video broadcasting, the following are deemed to be an infringement of copyright:

1. making an audiovisual work, a cinematographic work, a sound recording or a sound and video broadcasting work whether in whole or in part;
2. re-broadcasting, whether in whole or in part;
3. making a sound and video broadcasting work to be heard or seen in public by charging money or other commercial benefit.

With regard to computer programs, the following are deemed to be an infringement of copyright:

1. reproduction or adaptation;
2. communication to the public;
3. leasing of the original or a copy of the work.

Violation by others Any person who knows or should have known that a work has been made by infringing the copyright of another person and commits any of the following acts for profit is deemed to infringe copyright:

1. selling, offering for sale, leasing, offering to lease, selling by hire purchase or offering to sell by hire purchase;
2. communication to the public;
3. distribution in a manner which may prejudicially affect the owner of the copyright;
4. self-importation or importation by order into Thailand.

No violation of copyright An act that violates the copyright of another person but which does not conflict with normal exploitation of the copyright work by the copyright owner and does not unreasonably prejudice the legitimate right of the owner of copyright is not deemed an infringement of copyright. The following do not constitute infringement:

1. Research or study of the work which is not for profit.

2. Use for personal benefit or for self benefit, together with the benefit of other family members or close relatives.
3. Comment, criticism or introduction of the work with an acknowledgement of the ownership of copyright in such work.
4. News reporting through the mass media, with an acknowledgement of copyright.
5. Reproduction, adaptation, exhibition or display in judicial proceedings or administrative proceedings by authorized officials or reporting such proceedings.
6. Reproduction, adaptation, exhibition or display by an instructor for the benefit of instruction provided that the act is not for profit.
7. Reproduction, adaptation in part of a work or abridgement or making a summary by an instructor or an educational institution for distribution or sale to students in a class or in an educational institution provided that the act is not for profit.
8. Use of the work as part of questions and answers in an examination.
9. Reasonable recitation, quotation, copying, emulation or reference in part from a copyright work, with an acknowledgement of copyright.
10. Reproduction of a copyright work by a librarian in the following cases is not infringement of copyright, provided that the purpose of such reproduction is not for profit and the Act is complied with:
 - reproduction for use in the library or another library.
 - reasonable reproduction in part of a work for another person, for the benefit of research or study.

Computer programs With regard to computer programs, the following cases do not constitute infringement, provided that the purpose is not for profit and the Act is complied with:

1. Research or study of the computer program.
2. Use for the benefit of the owner of a copy of the computer program.
3. Comment, criticism or introduction of the work with an acknowledgement of ownership.

4. News reporting through the mass media, with an acknowledgement of ownership.
5. Making a reasonable quantity of copies of a computer program by a person who has legitimately bought or obtained the program from another person with the intention of keeping them for maintenance or prevention of loss.
6. Reproduction, adaptation, exhibition or display in judicial proceedings or administrative proceedings by authorized officials or in reporting such proceedings.
7. Use of the computer program as part of questions and answers in an examination.
8. Adapting the computer program as necessary for use.
9. Making copies of the computer program so as to keep them for reference or research for public interest.

Any duplication of a copyright work required in order to allow a computer system to function normally does not amount to infringement.

Preventing distribution by ISPs A copyright owners may prevent distribution of copyright-infringing content by internet service providers. Where a copyright owner has grounds to believe that a copyright work has been the subject of infringement on a computer system, he can apply for an injunction against the ISP. This includes any person who provides access to the Internet or any services that allow communication over a computer system and any person who provides computer information storage services. The period of compliance will be specified. After an injunction is granted, the copyright owner must issue an action against the infringer within the period ordered by the court.

If the ISP does not control, initiate, or order the infringing act to be carried out it is exempt from liability after compliance with the court order, and is not liable for any loss incurred whilst complying with any order.

Dramatic or musical work The public performance of a dramatic work or musical work which is not for profit and the performers do not receive remuneration for their performance is not an infringement, provided that it is conducted by an association, foundation or another organization and the Act is complied with.

Performers moral right A performer is entitled to identify himself as a performer in the performance and has a right to protect his reputation by prohibiting any

person, including the assignees, from distorting, shortening, adapting, or performing or doing any other act to the extent that it would cause loss to the reputation or dignity of the performer.

Artistic work A drawing, painting, construction, engraving, moulding, carving, lithograph, photograph, cinematography, video broadcasting or any similar act of an artistic work, excluding architectural work, which is openly available in a public place is not an infringement of copyright.

Architectural work A drawing, painting, engraving, moulding, carving, lithograph, photograph, cinematography or video broadcasting of an architectural work is not deemed an infringement of copyright.

The photography or a cinematography or video broadcasting of a work of which an artistic work is a component is not deemed an infringement of copyright.

Joint ownership Where another person jointly owns the copyright in an artistic work, the subsequent creation by the same author of the artistic work in such a manner that a part of the original artistic work is reproduced or the printing pattern, sketch, plan, model or information derived from a study which has been applied in the creation of the original artistic work is used, is not an infringement of copyright, provided that the author does not reproduce or copy a significant part of the original artistic work.

Restoration of buildings Restoration to the same appearance of a building which is a copyright architectural work is not deemed an infringement of copyright.

Expiry of protection When the term of protection for a cinematographic work expires, the communication to public of the cinematographic work is not deemed an infringement of copyright in the literary work, dramatic work, artistic work, musical work, audiovisual work, sound recording or any work previously used to make such cinematographic work.

Government officials A reproduction of a copyright work for the benefit of government service by an authorized official which is in the possession of the government is not deemed an infringement of copyright, provided that the Act is complied with.

Performing rights A performer has the following exclusive rights concerning his performance of:

1. sound and video broadcasting or communication to the public of the performance, except for sound and video broadcasting or communication to the public from recorded material;

2. recording a performance which has not yet been recorded;
3. reproducing the recorded material of the performance which has been recorded without consent of the performer, or the recording material of the performance with consent of the performer for different purposes, or the recording material of the performance which has been done pursuant to the exceptions of the infringement of performer's rights by virtue of the Act.

Right to remuneration A person who directly uses a sound recording of a performance, which has been published for commercial purposes or copies thereof in a broadcast or a communication to public, must pay remuneration to the performer.

Who may claim performing rights A performer may claim performing rights if:

1. he has Thai nationality or habitually resides in Thailand, or
2. the performance or the major part of it takes place in Thailand or a country which is a member of a convention for the protection of performers' rights of which Thailand is also a member.

Right to claim remuneration A performer may claim remuneration, if:

1. the performer has Thai nationality or habitually resides in Thailand when the audio recording of the performance takes place or when he exercises a claim of his rights;
2. the audio recording of the performance or a major part of the audio recording takes place in Thailand or in a country which is a member of a convention for the protection of performers' rights of which Thailand is also a member.

Period of validity of performance rights Performance rights last for 50 years from the last day of the calendar year in which the performance takes place. Where the performance is recorded, it lasts for 50 years from the last day of the calendar year in which the recording takes place.

Transfer Performance rights are transferable, whether in whole or in part, for a fixed period or for the whole term of protection. Where there is more than one performer involved, each performer is entitled to assign his portion of his rights. Unless transfer is by inheritance, it must be made in writing and signed by both parties. If the duration is not specified, it is implied that transfer is for three years.

Application for licence A Thai national who wishes to seek a copyright license for a work which has already been communicated to the public for the benefit of study, teaching or research without a profit-seeking purpose may apply to the

Director-General together with evidence showing that the applicant has previously sought a license to translate the work into Thai or to reproduce copies of the translation published in Thai but his request has been refused or after a reasonable period of time has elapsed an agreement cannot be concluded, provided that at the time of submitting the application:

1. the copyright owner has not translated or authorized any person to translate the work into Thai for publication within three years after the first publication of the work;
2. the copyright owner has published a translation in Thai but more than three years ;
3. after the last publication of the translation, no further publication has been made; and
4. all editions of the published translation are out of print.

The Director-General may not grant the license for an application under paragraph 1 if the time specified in paragraph 1 or 2 has elapsed by less than six months

Where the Director-General grants the license, the grantee shall be solely entitled to translate or publish the licensed translation, provided no other person may be permitted to make a Thai translation from the same original copyright work if the time specified in the license has not elapsed or has elapsed by less than six months. The grantee may not transfer the license to another person.

If the copyright owner or licensee can show that he has made a Thai translation or has published the translated version in Thai, the content of which are identical to that of the printed material which are the subject of a license and has distributed the printed materials at a reasonable price comparable to that of related works being sold in Thailand, the Director-General shall order that the license granted shall be terminated.

Assessment of remuneration The parties will determine remuneration and the conditions of the license. In case the parties cannot reach the agreement, the Director- General shall order equitable remuneration to be paid taking into account the normal rate of remuneration in such business and shall stipulate license conditions as he deems appropriate.

Regulation A Copyright Committee is established to implement the Act, hear appeals and draft regulations.

Interpretation Copyright work performance rights of a country which is a member of a convention for protection of copyright or performer's rights of which Thailand is also a member shall be protected under this Act.

Enforcement The Act provides for a system of fines and imprisonment for breaches of specific sections of the Act. A person may also bring civil proceedings for damages for breach of certain duties under the Act, and may also be able to apply for an injunction.

2016 changes Two amending Acts were passed in 2016. The main changes are summarized below:

- *Rights Management Information*: RMI, (as defined) may not be deleted or altered if it may induce or cause infringement. Upon proof, a fine or imprisonment may be imposed. Importing an altered work or distributing it, is an infringement if done with knowledge.
- Technological invention measures may not be avoided: Technological measures (as defined) may not be avoided, or services for the purpose of such avoidance, knowing that such act may cause infringement, are now an offence subject to fine or imprisonment.
- A copyright owner may apply for an injunction against internet service providers to restrain use of infringing material.
- *Exhaustion of rights/fair use*: The Act now says that sale of an original work or copy by a party who has legally acquired such work or copy does not amount to infringement.
- *Temporary copying is fair use*: The Act provides that use that is necessary for the system or equipment to be used properly is not infringement.
- *Performers' moral rights are protected*: A performer may present himself as such, and may present and assignee or other party from deleting or adapting his performance that prejudices his reputation.
- Punitive damages of twice the principal amount may be awarded if the court rules infringement was intentional or intended to cause the work to be widely available to the public.
- *Handing over of infringing items*: It is now provided that infringing items must be confiscated and destroyed at the expense of the infringer.
- Recording of all or part of a film in a cinema is infringement. Use of the defence of copying for personal use is not permitted.

Trade Secrets

Trade Secrets Act (2002)

What is a trade secret? A trade secret means commercial information that is generally unknown, or accessible to people who usually have access to such information. The information must have commercial value due to its secrecy. 'Commercial information' means material containing facts or information, including formulae, collected works, programs, processes or techniques.

Dealings in trade secrets The owner of a trade secret may disclose or use it, or permit another person to do so. An owner may impose conditions on usage by another person. Transfer may take place by inheritance, but otherwise any transfer must be in writing and signed by the parties concerned. If the period of usage is not specified, then it is implied that usage is permitted for ten years.

Infringement of rights The disclosure, taking away, or usage of trade secrets without consent, contrary to commercial practice, is actionable. Actions contrary to commercial practice include breach of contract, breach of confidentiality or inducement of the same and other acts.

Permitted dealings The following acts do not constitute infringement:

1. Disclosure or usage after acquiring a trade secret by a juristic act, without knowledge that such secret has been obtained in breach of the rights of another person.
2. Disclosure or usage by a government agency regulating such trade secret, where necessary to protect the health or safety of the public or where necessary for other public benefit and without any commercial intent.
3. Independent discovery using one's own expertise.
4. Reverse engineering, provided the discoverer has acted in good faith, and excluding cases where the discoverer has agreed with the owner to conduct reverse engineering by other means.

Legal remedies Legal remedies available include the right to:

1. apply for a court order to restrain infringement, including applying for an injunction prior to issuing an action for damages;
2. issue proceedings to restrain infringement, as well as for damages for infringement; or

3. request the Committee to mediate the dispute. If mediation is sought, it does not prejudice the rights of the parties to litigate in court or to refer the dispute to arbitration.

Any proceedings must be issued in the Intellectual Property and International Trade Court.

Time limits for bringing claims Any court proceedings for infringement must be commenced within three years from the date of knowledge of infringement, provided that no proceedings may be issued after ten years from the actual date of infringement.

Powers of the court Where court proceedings have been issued then:

1. where the court determines that trade secret rights have been infringed, but there are special facts which do not justify the court in making a ruling, the court may still order the defendant to pay compensation;
2. where the court has issued an order prohibiting infringement, then if the trade secret has been generally disclosed, or the status of trade secret will end in the future, the infringer may apply for the setting aside of such an order;
3. the court may order the destruction or forfeiture of articles, machinery or equipment used in infringement.

Presumption of infringement Where the trade secret is a manufacturing process, and provided that the owner or controller of the secret has issued civil proceedings, if it is proved that the product made is similar to that produced by the trade secret owner or controller, then it will be presumed that the infringer has used that trade secret in his manufacturing, unless he proves otherwise.

Assessment of damages The court will assess damages by applying the following principles:

1. Damages can be awarded for actual loss. The infringer can also be ordered to repay any benefits that he has gained by infringement.
2. Where it is not possible to assess damages as above, then the court will award reasonable damages.
3. Where the infringement was intentional or malicious, and caused the trade secret to cease to be secret, the court may award additional damages under the last two headings, but not more than double the total of such damages awarded.

Regulation A Trade Secrets Commission is set up to implement the Act, mediate disputes and issue regulations. The Intellectual Property Department, a government agency, will have general powers to carry out any TSC resolution.

Regulatory offences In addition to the civil remedies outlined above, the Act also imposes fines and imprisonment for breaches of specific duties imposed under the Act.

2015 changes Some changes were made to the Act by an amendment that came into force in February 2015: (a) changes were made to the composition and organisation of the Trade Secrets Commission, and (b) the penalties for disclosure or use of trade secrets by government officers were reduced.

Geographic Indications

Geographic Indications Act (2003)

Background The Geographic Indication Act (2003) came into effect on 28 April 2004. The Act is intended to protect goods named after their place of origin that bear particular characteristics specific to that area, and which as a result enjoy a more favourable reputation with consumers. It also prohibits conduct that may mislead consumers as to the place of origin of goods.

Definitions The Act contains a number of key definitions:

A geographical indication means a name, symbol or other thing that is a name or represents a geographic origin and which indicates the goods originated from that geographic origin and the goods have the quality, reputation or specific characteristics of that geographic origin.

A geographic origin means an area of a country, district, region, or locality and includes seas, lakes, rivers, waterways, islands, mountains or other areas with the same character.

Goods means things that can be bought, sold, exchanged or transferred regardless of whether they originated naturally or are agricultural produce, handicrafts or industrial products.

Common name means the name generally known as the name for the goods.

Geographical Indications Commission The Act sets up a Geographical Indications Commission, which will be part of the Department of Intellectual Property, the government department that oversees all intellectual property matters. The Commission will be responsible for registering geographical indications, issuing regulations under the Act, and hearing appeals against certain decisions made under the Act.

Characteristics of a geographical indication A geographical indication must not be: (1) the general name of a product that uses a geographical indication or (2) contrary to public order good morality or government policy.

Foreign geographical indications For a foreign geographical indication to be protected, there must be evidence that: (1) it is a geographical indication protected under the law of that country down to the date when application is made to register it in Thailand.

Registration Registration of a geographical indication is not compulsory, but is required in order to claim the protections available under the Act. The applicant must be:

1. a public authority, government agency, state enterprise, local authority or other government entity having jurisdiction over the geographical source of the goods,
2. a natural person, group of persons, or juristic person engaged in business in relation to goods using the geographic indication and located in the geographic origin of the goods, or
3. a group of consumers, or organisation of consumers, of the goods using the geographical indication.

Foreign geographic indications A foreign applicant who wishes to register a foreign geographical indication:

1. must be a national of a country that is party to a convention or treaty that protects geographical indications to which Thailand is also a party; or
2. is domiciled or does business in Thailand or a country that is party to a convention or treaty that protects geographical indications to which Thailand is also a party.

Registration procedure The Act sets out the procedure for registration, the time limits for considering an application, suspension of the registration process, and rights of appeal to the Commission or to the Court.

The application must contain details concerning the quality, reputation, characteristics and geographic origin of the goods. If the application is approved it will be published. An objector must object within 90 days of publication. A disputed application will be determined by the Registrar (an official appointed by the Minister), subject to a right of appeal within 90 days of the decision to the Commission. There is a further right of appeal from the Commission to the Court, exercisable within 90 days of the Commission's decision.

If the application is not challenged, and after all rights of appeal have been determined in favour of the applicant, the indication will be registered with effect from the date of application.

Registration is valid indefinitely, unlike a trademark registration which is valid for ten years only and must be renewed before expiry.

Revision and revocation of registration The Registrar has power to revise a registration to correct errors made. The Registrar also has power to revoke a registration where it has proceeded unlawfully or where relevant matters have been concealed and on related grounds. An interested party, or an official, may request revocation.

Usage of an indication Where an indication has been registered, it may be used by a manufacturer who is located in the place that is the geographic origin of the goods, or a trader of the goods, subject to conditions in regulations. If the indication is used in breach of conditions imposed by the Registrar, then a warning letter can be issued and if this is ignored, the manufacturer or trader can be barred from using the indication for up to two years. There is a right of appeal.

Geographic indication for specific goods Regulations may be issued declaring any goods to be specific goods. In respect of specific goods, use of the geographic origin with goods that do not originate from that source is an infringement, regardless of whether it declares the actual geographic origin, by words or other means. If such usage has occurred for a period of ten years prior to 15 April 1994, then it is not regarded as an infringement.

Since the Act has been in force, regulations have been issued declaring the following goods to be specific goods: rice, silk, wine, liquor.

Enforcement Provided that the indication has been registered, then the Act defines the following criminal offences:

1. Use of an indication to show or make others believe that the goods do not originate from the geographic origin indicated.
2. Use of an indication to cause confusion or misunderstanding in the geographic origin of the goods and in the quality, reputation or character of the goods, in order to cause loss to others.

A civil action claiming damages for infringement may also be brought.

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