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# **INTELLECTUAL PROPERTY**

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This chapter provides a general overview of the intellectual property legal system in Thailand. The main bodies of law that cover intellectual property rights are the Trademark Act, B.E. 2534 (1991) (the “**Trademark Act**”), Patent Act, B.E. 2522 (1979) (the “**Patent Act**”), Copyright Act, B.E. 2537 (1994) (the “**Copyright Act**”), and the Trade Secrets Act, B.E. 2545 (2002) (the “**Trade Secrets Act**”).

### Trademark, Service Mark, Certification Mark, and Collective Mark

The Trademark Act, which is the current legislation on marks in Thailand, was enacted in 1991 and last amended in 2016.

Provisions for harmonization with the Madrid Protocol became applicable under the Trademark Act following Thailand’s accession to the Madrid Protocol as marked by the enactment of a Royal Decree effective on 7 November 2017.

#### Objects of Protection

The subject matter of protection under the Trademark Act is trademarks, service marks, certification marks, and collective marks.

#### Trademark Requirements

For a trademark to be registrable, it must possess the following elements:

##### Distinctiveness

For a trademark to be “distinctive”, certain conditions must be met including that it: (i) allows the general public or the consumer of the product to realize that the product with the trademark is different from those products of other parties; (ii) is not the general name of a product and (iii) does not refer directly to the nature or quality of the product. However, if there is evidence that a trademark being used relates to a product

that is widely sold or advertised, the trademark will be deemed distinctive. As such, a product that has achieved wide recognition will be exempted from the requirement of “distinctiveness”.

##### A Trademark must not Hold Characteristics Prohibited Under the Trademark Act

A trademark that holds prohibited characteristics under the Trademark Act cannot be registered. Prohibited characteristics include trademarks with characteristics related to a nation, royalty, royal house, local government, foreign and international organizations, trademarks that are contrary to public order and morals, marks that are the same as a generally known mark in accordance with the regulations of the Ministry of Commerce regardless of the presence or absence of a registration, and marks that are similar to said marks and that may cause confusion or misunderstanding among the public regarding the owner or place of origin of a product.

##### Trademarks that are not Similar to a Trademark Registered by Another Party

The first-to-file principle requires that trademarks not be the same or similar to previously registered trademarks or previously filed applications. The requirement refers to identical or similar marks and identical or similar designated goods or designated services, both of which are examined.

#### Application

A multiple-class application or registration is available under the Trademark Act and an application can cover goods and/or services in more than one international class. Descriptions of goods/services must be very specific and clear.

## Publication and Examination

After filing a trademark application with a competent office, i.e., the registrar at the Department of Intellectual Property, Ministry of Commerce (the “DIP”), if the requirements for registration are met, the registrar will issue an order to publicize the application for a trademark.

Upon the publication of a trademark application, and if there is no objection, or there is an objection but the registrar or the Trademark Committee overrules such objection, the registrar will order the registration of the trademark.

In some cases, during the application process, the applicant may be requested to disclaim the exclusive rights to use either one or some parts of the trademark if such portions of the trademark are generic terms for specific goods/services, or if one or more parts of the trademark are not distinctive. Although some parts of the trademark may possess some elements of distinctiveness, the applicant will not be eligible to exclusively use the said parts of such trademark.

## Objection to Trademark

Objections to a trademark are permitted prior to the granting of rights for the trademark for which an application has been disclosed. A party that believes that it has a higher priority right than the applicant, or that the application does not meet the trademark requirements, or that said trademark application violates provisions of the Trademark Act, may file an objection with the registrar within 60 days from the publication date of the trademark application.

## Duration

Trademark rights are effective for ten years from the date of the trademark application. For applications based on the Madrid Protocol, the date of the application is the date on which the international registration application is filed.

Furthermore, in the case of priority

applications under the Paris Convention or a priority application based on other international conventions, etc., the applicant may request that the date of priority application be the date of the application in Thailand.

A trademark holder may file an application for renewal three months prior to the expiration of the validity period and may renew the registered trademark for another ten years. Alternatively, a trademark holder may also file an application for renewal within six months after the expiration of the validity period, but this will incur a twenty percent additional renewal fee. If the trademark holder fails to renew the expired trademark within the said period, such trademark registration will be revoked.

## License and Transfer

A trademark holder may license the use of the trademark for all or part of the registered products and services to another party.

A licensing agreement for a trademark registered in Thailand is required to be executed in writing and be registered at the DIP. If it is not in writing and registered, the said licensing agreement may be deemed invalid.

## Invalidation and Revocation of Trademark Rights

Even if a trademark has been registered, its registration may be revoked by a decision from the DIP, Trademark Committee, or a court judgment.

The main reasons for the revocation of a trademark are: (i) lack of required characteristics (e.g., no distinctiveness, having prohibited characteristics, being the same as other registered marks, or being similar to other registered marks to an extent that they could be mistaken or confused for one another); (ii) violation of public order and morals; (iii) not being used in good faith for three years; (iv) having become a general name; and (v) existence of priority rights for the trademark held by another party.

### Services Mark, Certification Mark, and Collective Mark

For services marks, certification marks and collective marks, most provisions related to trademarks are applicable *mutatis mutandis*.

For certification marks, the key difference is the application for registration, which includes additional requirements as follows:

- (i) The rules governing the use of such certification trademarks must be submitted along with the application. Note that these registration rules may be amended, to an extent that it does not affect the public interest, upon approval from the registrar; and
- (ii) An applicant must be able to demonstrate that it has sufficient ability to certify such product(s).

For collective marks, the provision regarding trademark licensing are not applicable.

### Criminal Punishment and Injunction

Currently in Thailand, a significant proportion of trademark right enforcement takes the form of criminal punishment and injunctions.

Fines and/or imprisonment are imposed for violations of trademark laws. Such violations include: (i) acts of submitting false statements to the registrar or Trademark Committee; (ii) acts of counterfeiting a registered trademark; (iii) acts of imitating a registered trademark with the intention of causing misunderstanding or confusion among consumers; and (iv) acts that involve using a package or container that displays a registered trademark of another party for one's own product or a third party's product with the objective of misleading consumers into believing that it is the product of said party, or that a license has been granted for its use, etc.

Corporate entities are also subject to criminal punishment. Directors, managers, or supervisors of such entities who are responsible for the violation, whether by

giving an order, withholding an order, direct action, or omission, will also be subject to the same penalties.

In addition to criminal punishment, an injunction may be granted. If there is clear evidence that a person: (i) counterfeits or imitates a mark, or intends to do so; (ii) imports into Thailand a product with a counterfeit or imitated mark; or (iii) provide a service using a counterfeit or imitated mark, the rights holder of said registered trademark, service mark, certification mark, or collective mark may seek an order from the courts for an injunction to cease or protected from the said act.

### Patent, Utility Model Right (Petty Patent), and Design Right

The Patent Act prescribes matters regarding patents, utility models (petty patents), and designs (for convenience, this section provides a comparatively detailed explanation of patents, and the subsequent sections provide a brief explanation of utility models and designs, focusing on differences from patents). The Patent Act was enacted in 1979 and last amended in 2019 by Order No. 1/2562 of the National Council of Peace and Order.

#### Patent

##### Patentable Subject Matter

The subject matter of protection under a patent is an invention. An invention refers to a technological innovation or invention that creates a new product or manufacturing method, or improves upon a known product or manufacturing method. Manufacturing methods here refer to methods, techniques, or processes for manufacturing a product, or maintaining or improving the quality of a product, and are respectively defined as including the application of the manufacturing method.

##### Elements of Patentability

The elements of patentability that dictates whether an invention can be protected under

the Patent Act are: (i) novelty; (ii) inventiveness (recognized if an invention is not obvious to a person skilled in the art); and (iii) industrial applicability (the invention is beneficial to any kinds of industry in terms of their production, e.g., industrial production, handicrafts, agriculture, and commerce).

#### Unpatentability

Inventions that are not permitted to be patented are as follows:

- (i) naturally occurring microorganisms and the components therein, animals, plants, or animal or plant extracts;
- (ii) scientific or mathematical laws and theories;
- (iii) computer programs;
- (iv) methods for diagnosing, treating, or curing human or animal diseases; and
- (v) inventions contrary to public order, morals, health, or welfare.

Note that computer programs and methods of diagnosing, treating, or curing human or animal diseases are not eligible for protection.

#### Attribution of Rights to Obtain Patents and Moral Rights of an Inventor

An inventor, being the party with the right to apply for a patent, also has the right to be named as the inventor on the patent. As such, the right to obtain a patent, in principle, is primarily attributable to the inventor.

In the event of an invention has been made jointly by two or more parties, the right to obtain a patent for the invention is shared among the inventors.

The right to obtain a patent may be transferred by assignment or succession. Note that the transfer of the right to obtain a patent must be made in writing and signed by transferor and transferee.

#### Patent Objections

Upon the publication of a patent application, a party that deems itself to have the right to receive the patent rather than the applicant,

or a party that has other grounds to object, may file a patent objection with the examiner within 90 days after the publication date of the patent application.

The major point of note is that, after the publication of an application, objections can be filed prior to a substantive examination and can also be filed against usurped applications.

#### Effectiveness and Limitations of Patent Rights

A patent is valid for 20 years from the application date.

The scope of the exclusive rights of a patent right, the acts of implementation, is defined as follows:

- (i) Patents for Products: The manufacture of the patented product, use, sale, possession for sale, offer for sale, and import of the patented products; and
- (ii) Patents for Manufacturing Methods: The use of the patented method, production, sale, possession for sale, offer for sale, and import of the item manufactured through the patented method.

#### License and Transfer

A patent holder may permit another party to perform acts within the scope of the patent holder's exclusive rights by granting a license. In addition, a patent right may be transferred to another party. In this regard, patent licensing agreements and patent transfers must be made in writing and registered with the DIP, otherwise, they will be deemed invalid.

#### Invalidity of Patent

Registered patents that violate patent requirements are invalid. An interested person or public prosecutor may file a claim with the courts to cancel such invalid patent.

#### Utility Model Right (Petty Patent)

As previously stated, the Patent Act also prescribes matters related to utility models (also referred to as "**petty patents**" or



“utility models” in this book).

### Subject Matter of Protection

The subject matter of protection is, like patents, inventions.

### Utility Model (Petty Patent) Requirements

For patentability of a utility model, only novelty and industrial applicability are required.

### Request for Substantive Examination

An interested person, within one year from the publication of the invention registration and the granting of a utility model right, may issue a request to the competent officer to conduct a substantive examination to verify whether said patent meets the requirements for patentability of a utility model. If the invention does not meet these utility model requirements, said utility model rights will be revoked.

### Effectiveness and Limitations of Utility Model (Petty Patent) Rights

The effective period of a utility model right is six years from the application date, but this may be extended by two years twice. Therefore, the total maximum effective period is ten years from the application date. Furthermore, when a utility model right holder exercises those rights, there is no requirement for obtaining a technical evaluation of the utility model. Otherwise, the provisions related to patents apply *mutatis mutandis*.

### License and Transfer

The provisions related to patents apply *mutatis mutandis*.

### Invalidity of Utility Model (Petty Patent) Rights

Utility model rights that are granted but violate the utility model requirements are deemed invalid.

## Design Right

As previously described, the Patent Act also prescribes matters related to designs. The provisions related to patents apply *mutatis mutandis*.

### Subject Matter of Protection

A design is defined as a form or composition of lines or colors serving as a pattern for an industrial product or handicraft product that gives the product a special external appearance.

The subject matter of protection regarding design rights is new industrial designs, including handicraft designs.

### Elements of Patentability for Design

The elements of patentability for a design are novelty and industrial applicability. In this regard, designs that are contrary to public order and morals and designs prescribed by the Royal Decree are regarded as not meeting patentability requirements.

### Application Examination

A substantive examination is conducted.

### Objections to Design Rights

In principle, the provisions related to patents apply *mutatis mutandis*.

### Effectiveness and Limitations of Design Rights

The validity period of a design right is ten years from the date of application filing. Except in cases where a design is used for investigation or research, no parties other than the design right holder may hold the right to use the design in manufacturing a product, or the right to sell, possess for sale, supply for sale, or import products on which the design is implemented.

### License and Transfer

The provisions related to patents apply *mutatis mutandis*.

### Invalidity of Design Rights

Design rights that are granted but violate the design rights requirements are deemed invalid.

## Copyright

The Copyright Act was initially enacted in 1978 and then repealed and replaced by a new act in 1994, which was last amended on 24 February 2022 (the “**Amended Act**”). The Amended Act, which includes notice and takedown processes and safe harbor rules for service providers, became effective on 23 August 2022.

### Copyrightable Work

A copyrighted work is defined as a work of literature, dramatic work, artistic work, music, audiovisual material work, cinematographic work, audio recording, broadcasting work, and other work attributable to the fields of literature, science, or art, regardless of the format or form of expression.

However, copyright protection does not extend to ideas or procedures, processes, systems, methods of use, operations, concepts, principles, discoveries, or scientific or mathematical theories.

Performer rights are also protected. In addition, copyright management information and technical means have also become the subject matter of protection.

### Occurrence and Acquisition of Rights

The author of a copyrighted work becomes the copyright holder for the work they have created without requiring any special procedures, except in some exceptional cases. Copyright protection is not subject to any kind of formality.

The copyright of a work created by an author during the course of employment (employment-related works), unless otherwise agreed in writing, is attributable to the author. Even in such cases, the employer

has the right to communicate the work to the public in accordance with the purpose of the employment. On the other hand, the copyright of a work created by an author under a work for hire arrangement is attributable to the hirer, unless otherwise agreed to in writing.

### Exclusive Rights of Authors

A copyright holder has exclusive rights to perform the following acts related to the copyrighted work:

- (i) reproduction or adaptation;
- (ii) publication;
- (iii) rental of original works or copies of computer programs, audiovisual works, cinematographic works, and audio recordings;
- (iv) granting of benefits arising from the copyright to others; and
- (v) granting of rights stated in (i), (ii), or (iii) above, with or without conditions. However, such conditions must not unfairly restrict competition.

### Moral Rights of Authors

Unless otherwise agreed in writing, holders of copyrighted works and performers have attribution rights, identity preservation rights, and the right to prohibit acts that cause any harm to the honor of the work and the credibility of the author.

Moral rights are non-transferrable; however, inheritance is permitted, and the heirs of the copyright holder may exercise these rights during the copyright protection period.

### Safe Harbor Rules for Service Providers

The Amended Act provides an exemption from copyright infringement liability to a “Service Provider” who: (i) has explicitly announced and complied with service termination measures for users who have repeatedly infringed copyright; and (ii) meets specific requirements for the respective type of Service Provider. “Service Provider” is classified into four types, i.e.: (i) intermediary service provider; (ii) caching service provider; (iii) hosting service provider; and

(vi) search engine service provider.

### Notice and Takedown Process

Previously, the Copyright Act provided an impractical notice and takedown process which required a copyright owner to petition a court requesting for an order to take down infringed content on an online platform. Under the Amended Act, a copyright owner may take direct action against copyright infringement by providing a takedown notice to a Service Provider. The notice and takedown process under the Amended Act can be summarized as follows:

- (i) copyright owner provides a takedown notice to a Service Provider;
- (ii) upon receipt of the takedown notice, the Service Provider must either promptly takedown or restrict access to the copyright infringed content and inform the accused user;
- (iii) the accused user may submit to the Service Provider a counternotice to have the content reuploaded or the restriction

of access canceled;

- (iv) upon receipt of the counternotice, the Service Provider must provide a copy of the notice to the copyright owner and notify them that the content will be reuploaded or the content access restrictions will be lifted within 30 days after receipt of the counternotice; and
- (v) upon the lapse of the above period, the Service Provider must reupload the content or lift the content access restrictions unless the copyright owner files a lawsuit against the accused user and notifies the Service Provider within said period.

A takedown notice and counternotice must contain all information as required by the Amended Act.

### Protection Period

The protection period of a copyright varies in accordance with the type of work, as indicated below.

**Table 1 - Copyright Protection**

| Types of copyrighted work  | Protection period   |
|--|---|
| Copyrighted work created by a natural person (including photographic work) | The lifetime of the author and 50 years after his or her death.   |
| Copyrighted work created by a corporate entity                             | 50 years from the creation of the work.   |
| Copyright in audiovisual work, cinematographic work, audio recording work  | If the copyrighted work is published within this period, 50 years from the date of the initial publication.       |
| Copyright in applied art   | 25 years from the creation of the work.   |
|  | If the copyrighted work is published within this period, 25 years from the date of the initial publication.       |
| Performer rights   | 50 years from the final day of the calendar year of the performance.  |
|  | If the performance is recorded, 50 years from the final day of the calendar year in which the recording was made. |



## Copyright Infringement

Acts of copyright infringement are detailed for each type of copyrighted work as shown in Table 2 below.

**Table 2 - Acts of Rights Violation**

| Types of copyright work                                      | Violating acts   |
|--|--|
| General copyrighted work                                     | <ul style="list-style-type: none"> <li>• reproduction or adaptation</li> <li>• publication</li> </ul>  |
| Audiovisual work, cinematographic work, audio recording work | <ul style="list-style-type: none"> <li>• reproduction or adaptation</li> <li>• publication</li> <li>• rental of original or copy of the work</li> </ul>  |
| Cinematographic work   | <ul style="list-style-type: none"> <li>• recording of audio or video, or both from a movie in a cinema</li> </ul>  |
| Broadcasting work  | <ul style="list-style-type: none"> <li>• making of audiovisual material, cinematograph film, audio recording or broadcasting work, whether in whole or in part</li> <li>• rebroadcasting, whether in whole or in part</li> <li>• making arrangements for broadcasting work to be heard or seen by the public and collecting money or any other commercial benefits in return</li> </ul>  |
| Computer programs  | <ul style="list-style-type: none"> <li>• reproduction or adaptation</li> <li>• publication</li> <li>• rental of the original or copy of the work</li> </ul>  |
| Copyright infringement products                              | <ul style="list-style-type: none"> <li>• knowing, or having reason to know, that a work is a copyright infringed work and performing the following acts for profits:               <ul style="list-style-type: none"> <li>– sale, possession for sale, offering to sell, offering for lease, or offering for hire-purchase</li> <li>– publication</li> <li>– distribution in a manner which may cause damage to the copyright holder</li> <li>– importation into Thailand</li> </ul> </li> </ul> |

The use of copyrighted works belonging to other parties in a manner that does not conflict with exploitation of the copyrighted work by the copyright holder and does not unduly impair the legitimate rights of the copyright holder is not deemed a copyright infringement.

## Trade Secrets

The Trade Secrets Act was enacted in 2002 and last amended in 2015. Note that in Thailand, there is no specific law for the protection of well-known or prominent displays. However, in exceptional cases of passing off, even if the display is an unregistered trademark, the right to seek injunction and compensation for damage may be exercised.

## Subject Matter of Protection

Trade secrets are defined as commercial data that are not generally known or not yet accessible by persons who are normally connected with such information. The commercial value of such data comes from its secrecy, and the persons managing the trade secrets have maintained appropriate protocols to keep such information confidential. Commercial data referred to in this context is defined as items that communicate meaning, regardless of their form or method, to convey content, matters, and facts, etc., including programs, methods, techniques, formulas, models, and duties that are included in or constitute a manufacturing process. Like in many other countries, the requirements for qualifying as a trade secret

are as follows: (i) not being publicly known; (ii) having usefulness; and (iii) being managed and maintained as confidential.

### **Requirements for Protection**

A trade secret may be protected even without

undergoing special procedures associated with its establishment, and the protection is continuous without limit if the manager of said trade secret applies appropriate methods to protect its confidentiality.