

Ministerial Regulations
On the Application for Patent Protection to Implement the Patent Treaty
Cooperation B.E. 2552 (2009)

By virtue of the powers vested in the provisions in Section 4 and Section 24 of the Patent Act B.E. 2522 and Section 17 and Section 65 decies of the Patent Act B.E. 2522 as amended by the Patent Act (No.3) B.E. 2522 in which contain provisions in relation to the restriction of Rights and Liberties of the Persons, in respect of which Section 29 and in conjunction with Section 41 and Section 43 of the Constitution of the Kingdom of Thailand so permit by the virtue of provisions of law, the Minister of Commerce hereby issues a Ministerial Regulations as follows:

Clause 1 This Ministerial Regulations shall be implemented from 24 December, 2009 onwards.

Clause 2 In this Ministerial Regulations,

“treaty” means the Patent Cooperation Treaty done at Washington on June 19, 1970;

“regulation” means regulations under the Treaty;

“international application” means an application for invention protection filed under the Treaty;

“applicant” means an applicant of an international application;

“priority date” means

(1) the international filing date of such application or;

(2) where the application contains priority claims under Clause 16, the filing date of the earliest application whose priority is so claimed;

“International bureau” means the International bureau of the World Intellectual Property Organization;

“International examination authority” means a patent office of the Contracting States or an International organization appointed by the Patent Cooperation Treaty [PCT] Assembly to examine and report opinions regarding corresponding prior arts of an international application;

“International preliminary examination authority” means a patent office of the Contracting States or an International organization appointed by the Patent Cooperation Treaty [PCT] Assembly to consider and prepare preliminary reviews

on whether the invention under such international application has novelty, inventive steps and industrial applicability.

Clause 3 This Ministerial Regulations shall be implemented for an application for invention protection under the Treaty, to which Thailand has acceded on 24 September, 2009.

Chapter 1

The International Application for invention protection in the Contracting States

Clause 4 A person who is a Thai national or a Thai resident may file an international application to the Department of Intellectual Property.

A person who is a Thai resident may refer to a person who is in a middle of a genuine and serious industrial or commercial operation in Thailand as well as a juristic person whose principle office is located in Thailand.

In case where a person whose nationality and residence is in the other Contracting States files an international application to the Department of Intellectual Property, it is required that the applicant pay the fee in the same rate as described in Clause 10 for a transmittal of the international application and that the Department of Intellectual Property transmits the international application to the International bureau for the next procedure.

In case where multiple applicants file for an international application, at least one of the applicants must be a person prescribed in the precedent paragraphs, as the case may be.

Clause 5 In case where an applicant wishes to authorize any other person to act on behalf of himself, it shall be done with a registered representative according to the Ministerial Regulations No.21 (B.E.2542) issued under the Patent Act B.E.2522.

To authorize power to a representative according to the precedent paragraph, it is required that the applicant must file a power of attorney following the procedure prescribed by the Director-General together with an international application or in case where the applicant whose signature is appeared on such international application, the applicant may also appoint a representative by describing such authorization in the international application.

Clause 6 An international application shall include items as follows

- (1) a request
- (2) a description/ a specification
- (3) claims
- (4) drawings (if any) and
- (5) an abstract

Items under the precedent paragraph shall follow the format of an international application prescribed following the Treaty by the Director-General.

Clause 7 An international application must contain no message or drawing which is in contrary to the Public Order or good morals or contemptuous to any other person. If the Department of Intellectual Property is of the view that such international application includes a message or a drawing following the aforementioned description, a notification shall be lodged to notify the applicant to amend the message or drawing and to inform the International bureau and the International preliminary examination authority as well.

Clause 8 An applicant is required to file three [3] sets of complete international application and annexed document in Thai or English language to the Department of Intellectual Property.

The Department of Intellectual Property is required to prescribe an application number on the international application and identify each copy of the international applications as the international application filed to the International bureau, the international application filed to the International examination authority or the international application filed to the receiving Office.

Clause 9 In case where an applicant files an international application and annexed document in Thai language, the applicant is required to prepare an English-language copy of the application and file to the Department of Intellectual Property within a month after the Department of Intellectual Property receives the international application.

In case where the Department of Intellectual Property does not receive the translation before the notification under Clause 13 (1), the Department of Intellectual Property is required to notify about the prescribed period for the preparation of translation according to the precedent paragraph in the notification as well.

In case where an applicant is unable to file a translation within the prescribed period according to the precedent paragraph, the applicant may file

the translation within a month after the notification under Clause 13 (1) from the Department of Intellectual Property is lodged or within two [2] months after the Department of Intellectual Property receives the international application, depending on which period ends latterly. Fee for delayed translation must be paid by 25 per cent of the filing fee of the international application.

Once the deadline of the precedent paragraph is expired, if the applicant does not file the translation to the Department of Intellectual Property, it shall be deemed that the applicant cancels the international application and the Department of Intellectual Property shall be required to publish the cancellation of such international application to the public at the Department of Intellectual Property as well as inform the International bureau and the applicant, unless the applicant files the translation and pay the fee for delayed filing of the translation prior to the publication of the cancellation of the international application and prior to the 15-month period after the priority date.

Clause 10 An applicant must pay the filing fee of an international application, the fee for international examination and the fee for the transmittal of an international application within a month after the Department of Intellectual Property receives the international application and within the rate prescribed by the Director-General.

In case where an applicant does not pay the fees or partially pays the fees within the prescribed period under the precedent paragraph, the Department of Intellectual Property is required to notify the applicant to complete the overdue payment and pay for the delayed payment within a month after the day prescribed in the notification. The surcharge for delayed payment shall follow the rate prescribed by the Director-General but it must not be less than the fee for the transmittal of the international application and not more than 50 per cent of the filing fee of the international application.

In case where an applicant does not pay the fees or partially pays the fees within the prescribed period under the precedent paragraph, it shall be deemed that the applicant cancels the international application and the Department of Intellectual Property shall publish the cancellation of the international application to the public at the Department of Intellectual Property as well as inform the International bureau and the applicant.

Clause 11 The Department of Intellectual Property is required to prescribe the receiving date of an international application as the filing date of the international application. Where it appears that on the receiving date of the international

application, the applicant is qualified by the descriptions prescribed in the first paragraph and the fourth paragraph of Clause 4 and the international application conforms with every prescription as follows:

(1) the international application uses the language prescribed in Clause 8 and;

(2) the international application contains messages and document as follows:

(a) a message which states that the applicant wishes to file an international application;

(b) a message which states that the applicant wishes to apply for an invention protection in the Contracting State;

(c) the applicant's name;

(d) documents which include specification and claims;

Clause 12 In case where an international application is not in compliance with the prescription under Clause 11, the Department of Intellectual Property is required to lodge a notification to the applicant asking the applicant to amend the deficiency within two months after the date prescribed in the notification.

If the applicant completes the amendment within the prescribed period under the precedent paragraph, the Department of Intellectual Property is required to prescribe the receiving date of the correct and complete international application as the filing date of the international application.

In case where the applicant does not complete the amendment within the prescribed period of the precedent paragraph, the Department of Intellectual Property is required to inform the applicant about the reason why the procedure cannot be processed and to record the international application as an evidence as well as inform the International bureau.

Clause 13 When the Department of Intellectual Property prescribes a filing date of an international application under Clause 11 or Clause 12, the Department of Intellectual Property is required to store the international application filed to the receiving Office at the Department of Intellectual Property and proceed as follows:

(1) lodge a notification informing the application number and the filing date of the international application to the applicant instantly;

(2) transmit the international application filed for the international bureau and a copy of the notification under (1) to the International bureau prior to the end of the 13-month period after the priority date;

(3) transmit the international application filed for the International examination authority to the International examination authority prior to the end of the 13-month period after the priority date when the applicant completely pays the fee for the international examination and transmits the translation under Clause 9;

(4) transmit the translation under Clause 9 to the International bureau instantly;

(5) transfer the filing fee for the international application and the fee for the international examination to the International examination authority;

Clause 14 When the Department of Intellectual Property prescribed the filing date of an international application under Clause 11 or Clause 12, if an error is found in the international application, it shall be processed as follows:

(1) In case where there is no signature, address, nationality or residence of the applicant's appearing on the international application or there is no title of the invention or abstract or the application does not conform with the format prescribed by the Director-General, the Department of Intellectual Property is required to lodge a notification to inform the applicant to amend the error within two [2] months after the date prescribed on the notification;

If the applicant correctly and completely amends the error within the time prescribed in the precedent paragraph, the Department of Intellectual Property is required to transmit the amended document to the International bureau and the International examination authority;

(2) In case where the international application does not conform with the prescription in Clause 11, the Department of Intellectual Property is required to lodge a notification to the applicant within 4 months after the filing date of the international application explaining the reason why a proceeding to cancel the international application is made;

The applicant shall have the right to file an argument to the Department of Intellectual Property within a month after receiving the notification under (2) of the precedent paragraph. If the applicant does not file an argument within the prescribed time or the Department of Intellectual Property does not agree with the argument, it shall be deemed that the applicant cancels the international application and the Department of Intellectual Property shall publish the cancellation of the international application to the public at the Department of Intellectual Property.

Clause 15 When an applicant receives a notification from the International bureau informing that the International bureau has not received the international application filed for the International bureau, the applicant may ask the Department of Intellectual Property to certify a copy of the international application free of charge and the applicant is required to send the copy of such international application to the International bureau.

The Department of Intellectual Property may deny the request for a certified copy of the international application on grounds as follows:

(1) the copy of the international application that the applicant submits for a certificate is different from the previously filed international application; or

(2) the Department of Intellectual Property already transmits the international application filed for the International bureau to the International bureau and the International bureau notifies the Department of Intellectual Property that it has already received such international application.

In case where the International bureau does not receive the international application or its copy under the precedent paragraph within three [3] months after the day that the International bureau lodges a notification to the applicant to inform that it has not received the international application filed for the International bureau under the precedent paragraph, it shall be deemed that the applicant cancels the international application.

Clause 16 An applicant may be able to apply for invention protection starting from the day that the priority application is filed before the international application under the Treaty if the applicant files an international application for the same invention within 12 months after the priority date.

For the application following the precedent paragraph, the applicant is required to include the claim for priority date in the international application and file a copy of the filed priority application as well as a certificate from the patent office of the country where such priority application is filed to the Department of Intellectual Property or the International bureau within 16 months after the priority date.

In case where the applicant filed the priority application to the Department of Intellectual Property, the applicant may prepare a request and file to the Department of Intellectual Property asking for a transmittal of a copy of the priority application filed in Thailand together with a certificate to the International bureau for the applicant within 16 months after the priority date. The applicant shall pay for all expenses of such transmittal.

Clause 17 In case where an applicant cannot file an international application within 12 months after the priority date, if the applicant wishes to claim for the right under Clause 16, the applicant may file a request to renew the right of the invention protection starting from the priority date made to the Department of Intellectual Property within 2 months after the deadline of the application under Clause 16 of the precedent paragraph as well as provide reasons and evidences proving that he proceeds with cautions, as the case may be.

If the Department of Intellectual Property is of the view that the applicant proceeds with caution, as the case may be, but he cannot meet with the prescribed schedule, the Department of Intellectual Property is required to proceed with the request.

Clause 18 An applicant may cancel an international application at any time prior to the end of the 13-month period since the priority date to any of the authorities as follows:

- (1) the Department of Intellectual Property
- (2) the International bureau or
- (3) the International preliminary examination authority, in case where the applicant wishes to request for an international preliminary examination.

The cancellation of the international application must follow the procedures prescribed following the Treaty by the Director-General and it shall be enforced when the Department of Intellectual Property or the International bureau or the International preliminary examination authority is notified about the cancellation of the international application.

In case where the Department of Intellectual Property is notified about the cancellation of the international application following the precedent paragraph, the Department of Intellectual Property is required to notify the International bureau about such cancellation instantly and in case where the international application filed for the International examination authority is already transmitted to the International examination authority following Clause 13, the Department of Intellectual Property is required to notify the International examination authority about such cancellation as well.

Clause 19 The Department of Intellectual Property is required to refund the filing fee of the international application or the fee for the international examination to the applicant, in cases as follows:

(1) In case where no proceeding is made with the international application under the third paragraph of Clause 12

(2) In case where the international application is cancelled following the third paragraph of Clause 10, the fourth paragraph of Clause 14 (1), the second paragraph of Clause 14 (2) and the third paragraph of Clause 15 or in case where the applicant cancels the international application following Clause 18 before transmitting the international application filed for the International bureau to the International bureau or before transmitting the international application filed for the International examination authority to the International examination authority, as the case may be.

Clause 20 In case where there are many International examination authorities certified by the Treaty, the Director-General is required to publish a list of the International examination authority that the Department of Intellectual Property assigns to proceed with the examination of the international applications filed by applicants to the Department of Intellectual Property and inform the International bureau.

In case where the Director-General publishes the list containing more than one International examination authorities, the applicant is required to prescribe, in the international application, the International examination authority chosen for the examination of the international application.

Clause 21 In case where there are many International preliminary examination authorities, the Director-General is required to publish a list of the International preliminary examination authorities that the Department of Intellectual Property assigns to proceed with the examination of the international applications filed by applicants to the Department of Intellectual Property and inform the International bureau.

In case where an applicant wishes to have an International preliminary examination authority prescribed by the Director-General as the International preliminary examination authority of the invention under his international application, he is required to file a request directly to such International preliminary examination authority or file through the Department of Intellectual Property and transmit the request to the International preliminary examination authority and the applicant is required to pay the fee for the international preliminary examination directly to the International preliminary examination authority.

Chapter 2

Process and International Application for Invention Protection in Thailand

Clause 22 An applicant who already files an international application in the Contracting States, if wishes to apply for an invention protection in Thailand, is required to notify the Department of Intellectual Property following the procedure prescribed by the Director-General and file a translation in Thai language and pay for patent or petty patent application fee in the rate prescribed in this Act within 30 months after the priority date.

In case where an applicant does not proceed within the period prescribed in the precedent paragraph, it shall be deemed that the international application is invalid in Thailand.

Clause 23 In case where an applicant is unable to proceed within the 30-month period prescribed in the first paragraph of Clause 22, the applicant may file a request to renew the right for the international application to still be enforced in Thailand to the Department of Intellectual Property within two [2] months after the day that causes the process to fall out of schedule or within 12 months after the deadline prescribed in the precedent paragraph of Clause 22, depending on which period ends first, by providing reasons and evidences and then proceed following the prescription in Clause 22.

When the Department of Intellectual Property already considers the request under the precedent paragraph and is of the view that the applicant proceeds with cautions as the case may be but he cannot proceed following the schedule, the Department of Intellectual Property is required to proceed with the international application following the procedures prescribed in this Act and inform the applicant.

Clause 24 An applicant who already files an international application in the Contracting States and wishes to apply for an invention protection in Thailand may ask the Department of Intellectual Property to review the result of the consideration regarding the international application in cases as follows:

- (1) In case where the receiving Office of the Contracting States refuses to prescribe the filing date of the international application; or
- (2) In case where the international application is cancelled;

For the filing of an application under the precedent paragraph, the applicant is required to file a request to the International bureau within two [2] months after the applicant is notified with the result of the consideration in order to ask the International bureau to transmit such international application to the Department of Intellectual Property.

Where it appears to the Department of Intellectual Property that the result of the consideration of the international application under the precedent paragraph is mistakenly or ignorantly made by the receiving Office of the Contracting States or the International bureau, the Department of Intellectual Property is required to proceed with the international application following the procedures prescribed in this act and such international application shall be deemed as a patent or petty-patent application filed to the Department of Intellectual Property.

Clause 25 The Department of Intellectual Property is required to proceed with the international application filed for invention prevention in Thailand under Clause 22 when the deadline of 30 months after the priority date is met unless the applicant files a request to have the proceeding made prior to such deadline.

Given on 30 October B.E. 2552

Porntiva Nakasai

The Minister of Commerce

Note:- The reason of the implementation of this Ministerial Regulations is because Thailand has acceded to the Patent Cooperation Treaty of which objective is to prescribe that an applicant who applies for invention protection and has nationality and residence in the Contracting States can only file an international application once in order to be able to apply for invention protection in other Contracting States, which is to accommodate the applicant who applies for invention protection, in conjunction with Section 17 of the Patent Act B.E. 2522 as amended by the Patent Act (No.3) B.E. 2542 issued so that patent applications follow the rules and procedures set forth in the Ministerial Regulations. These Ministerial Regulations are therefore issued.