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Thailand

Patent Litigation

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This country-specific Q&A provides an overview of patent litigation laws and regulations applicable in Thailand.

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Thailand: Patent Litigation

1. What is the forum for the conduct of patent litigation?

A patent infringement lawsuit must be filed with the Central Intellectual Property and International Trade Court (the CIPIT Court), which is established as a specialized Court with the exclusive jurisdiction over all intellectual property-related disputes in Thailand nationwide. Each case will be considered by a quorum of three judges, consisting of two professional judges and one associated judge, who is selected from qualified persons in the relevant fields.

2. What is the typical timeline and form of first instance patent litigation proceedings?

According to the Act on Timeframe for the Judicial Procedure (effective as from January 23, 2023), most types of lawsuits at the court of the first instance should be completed within one year from acceptance of the complaint. Due to a more complicated nature of a patent litigation, however, the procedure may take longer, e.g. 18 months at the CIPIT Court, depending on complexity of the case as well as the number of witnesses to be presented by both parties.

In addition to raising arguments against the complaint, the defendant may counterclaim in the same lawsuit seeking invalidation of the patent on the grounds that the relevant invention is not patentable. It is also possible for the defendant to initiate a separate lawsuit against the plaintiff and the Department of Intellectual Property for cancellation of the patent reasoning that it is not lawfully granted. In that case, the Court may order both of the infringement case and the cancellation case to be consolidated for a more efficient procedure. All relevant issues, e.g. the plaintiff's standing to file the lawsuit, the claim construction, the infringement, the compensation, and the validity of the patent, will then be considered altogether in a single lawsuit.

3. Can interim and final decisions in patent cases be appealed?

A decision from the CIPIT Court may be appealed further to the Specialized Court of Appeal, which should render a decision in about 10-12 months. The decision from the

Court of Appeal is normally final except for certain cases where parties may request permission to file further appeals to the Supreme Court, e.g. cases relating to public interest, cases relating to inconsistent precedents, and cases relating to international laws. To appeal against the Court of Appeal's decision, the party shall submit an appeal and a request for permission to appeal with the Supreme Court. The other party will be allowed to submit an objection letter to the request. If the permission is not granted the decision of the Court of Appeal will become final. If the permission is granted, the Supreme Court will accept the appeal for further consideration and allow the other party to submit an answer on substantive issues of the appeal.

There will be no hearing or presentation of witnesses at the Specialized Court of Appeal or the Supreme Court. The high Courts will render decisions based on the appeals, the answers, as well as the evidence presented at the CIPIT Court.

4. Which acts constitute direct patent infringement?

What constitutes patent infringement would depend on the types of patents, namely a product patent or a process patent. For the product patent, the patentee shall have the exclusive rights to produce, use, sell, possess for sale, offer for sale, and import the patented product. For the process patent, the patentee has the exclusive rights to use the patented process, to produce, use, sell, possess for sale, offer for sale and import products produced by using the patented process. A third party's above action without authorization from the patentee would constitute patent infringement.

5. Do the concepts of indirect patent infringement or contributory infringement exist? If, so what are the elements of such forms of infringement?

The Thai laws do not expressly recognize the concept of indirect patent infringement or contributory infringement. However, the Thai Civil and Commercial Code sets the general principle on a tort that parties jointly committing a tort shall be jointly liable for the damage caused by such a tort. This general principle may be applicable to

indirect or contributory infringement to a certain extent. In a criminal case, the general principle on a co-offender and a support may apply.

6. How is the scope of protection of patent claims construed?

The scope of patent protection shall be construed in accordance with the scope of the claim. The specification as well as the drawings must also be taken into account. In addition to the literal infringement, the Patent Act also recognizes the doctrine of equivalents that the scope of the claim shall be extended to protect the inventions which are not specifically stated in the claim but are of similar properties, utilities, and effects from the perspective of a person with an ordinary skill in the relevant field. The prosecution history should also be considered.

7. What are the key defences to patent infringement?

In defending against a patent infringement lawsuit, a defendant may claim non-infringement that its disputed action does not fall within the scope of the patent or that such action falls under patent infringement exemptions. In some cases, the defendant may also counterclaim seeking invalidation of the patent on the grounds that the invention is not patentable. The defendant may also seek cancellation of the patent on the grounds that it is not lawfully granted, e.g. insufficient disclosure, by filing a separate lawsuit against the plaintiff and the Department of Intellectual Property.

It is also a rather common practice for some Thai defence lawyers to question other legal issues in order to require the plaintiff to prove these issues to the Court, e.g. the plaintiffs' legal status, the plaintiffs' standings for filing the lawsuits, and the validity of the plaintiffs' powers of attorney.

8. What are the key grounds of patent invalidity?

A patent may become invalid if the invention does not meet the patentability requirement. In other words, it is not novel, does not involve an inventive step, and/or not capable of industrial application. The patent may also be invalidated if the patentee is not eligible to file a patent application or an invention falls within the scope of a non-patentable invention, e.g. computer program and methods of diagnosis, treatment and cure of human and animal diseases. If the application procedure is unlawful,

the patent may also be cancelled.

9. How is prior art considered in the context of an invalidity action?

Absolute novelty is required in Thailand. For assessing novelty, a single prior art is used. On the issue of inventive step, however, multiple prior arts can be used in assessment whether the invention is obvious to a person with an ordinary skill in the relevant field. The functions, the results, and the utilities of the inventions must be taken into comparison. A hindsight approach is unlawful. There is no provision that limit the use of a prior art for assessing only certain grounds of invalidation but not others.

10. Can a patentee seek to amend a patent that is in the midst of patent litigation?

It is not possible to amend the patent after grant or during the patent lawsuit. The claim can be amended only before grant.

11. Is some form of patent term extension available?

A patent term may be extended in case of a lawsuit during an examination procedure, e.g. an appeal against an opposition decision to Court. In that case, the period of the lawsuit shall not be included in the 20-year protection period.

12. How are technical matters considered in patent litigation proceedings?

It is uncommon for the Court to appoint an expert witness pursuant to both parties' agreement. Each party normally has its own expert witness testify to support its claims and arguments. The expert witness may submit an opinion in form of a written witness statement to the Court. However, the witness will have to appear in Court for cross-examination by the other parties' lawyers.

13. Is some form of discovery/disclosure and/or court-mandated evidence seizure/protection (e.g. saisie-contrefaçon) available, either before the commencement of or during patent litigation proceedings?

According to the new Regulation of the CIPIT Court

(effective as from July 1, 2023), the Court may schedule a date for evidence disclosure before presentation of witnesses. On that date, both parties are required to submit all evidence in their possession for the other party's review. Evidence not disclosed on the said date shall not be admissible.

14. Are there procedures available which would assist a patentee to determine infringement of a process patent?

The Patent Act provides assumption of infringement in favour of a process patentee. If the patentee can prove that the defendant's product is of the same or similar character as the product produced by the patented process, the defendant shall be presumed to use the patented process. However, this assumption is not absolute. The defendant may still prove otherwise that it uses a different process for producing the disputed product.

15. Are there established mechanisms to protect confidential information required to be disclosed/exchanged in the course of patent litigation (e.g. confidentiality clubs)?

It is possible to request confidential hearings, in which only the disputed parties are allowed in a courtroom.

16. Is there a system of post-grant opposition proceedings? If so, how does this system interact with the patent litigation system?

The opposition can be filed only within 90 days from the publication date of the application (pre-grant publication). There is no post-grant opposition procedure. It is possible to initiate an invalidation action only after grant.

17. To what extent are decisions from other fora/jurisdictions relevant or influential, and if so, are there any particularly influential fora/jurisdictions?

Grant of an equivalent patent in other examining jurisdictions may be supporting evidence on the issue of patentability. However, the Thai Court will still have to consider the substantive issues of the case in accordance with the Thai laws.

18. How does a court determine whether it has jurisdiction to hear a patent action?

The CIPIT Court has the exclusive jurisdiction for all intellectual property cases in Thailand. Thus, the CIPIT Court is empowered to consider the issues of both patent infringement and patent validity in Thailand.

19. What are the options for alternative dispute resolution (ADR) in patent cases? Are they commonly used? Are there any mandatory ADR provisions in patent cases?

An arbitration is possible under the Thai laws, but it is very uncommon for patent infringement cases as the parties normally do not agree to have the cases resolved by the arbitration.

In case of a patent lawsuit, the Court usually encourage parties to amicably settle the case by agreement. Subject to both parties' agreement, the Court will schedule a mediation session for the parties to negotiate in presence of a mediator, selected by the Court among qualified persons. If the case cannot be settled by agreement, the Court will then proceed with hearings.

20. What are the key procedural steps that must be satisfied before a patent action can be commenced? Are there any limitation periods for commencing an action?

There is no legal prerequisite before initiating a patent infringement lawsuit. A patentee may file a complaint immediately upon occurrence of the infringement. In practice, however, it is very common to issue a demand letter first.

For seeking damages, the complaint must be filed within the prescribed period of one year from the patentee's awareness of the infringement. In case of ongoing infringement, the complaint may be filed any time as long as the infringement remains ongoing provided that the patentee may be entitled to claim damages only for a period of one year before the complaint date.

21. Which parties have standing to bring a patent infringement action? Under which circumstances will a patent licensee have standing to bring an action?

Under the Thai law, the licensee may not have legal

standing to initiate a patent infringement lawsuit. This is because the licensee only has contractual rights, which may be enforceable against its contractual party (i.e. the licensor) only, not exclusive or absolute rights enforceable against a third party.

22. Who has standing to bring an invalidity action against a patent? Is any particular connection to the patentee or patent required?

Any party may raise the issue of invalidity of the patent. Nonetheless, only an interested party and the public prosecutor is entitled to initiate an invalidation action.

23. Are interim injunctions available in patent litigation proceedings?

In case of clear evidence of an infringement being conducted or to be conducted, a patentee may request the Court to order an infringer to cease or refrain from the infringement. In such a request, the patentee will have to prove to the Court that there is a legal basis for taking actions against the infringer and that there are reasonable grounds for the Court to grant the interim injunction. The Court will grant the injunction if it is of the opinion that the patentee's damage cannot be sufficiently compensated by means of monetary damages.

24. What final remedies, both monetary and non-monetary, are available for patent infringement? Of these, which are most commonly sought and which are typically ordered?

In a patent infringement lawsuit, a plaintiff may seek (i) injunction against infringement, and (ii) damages. If the infringement can be proved, the Court will normally order injunction. To obtain damages, the plaintiff will have to further prove the amount of damages actually and directly caused to the plaintiff by the infringement.

25. On what basis are damages for patent infringement calculated? Is it possible to obtain additional or exemplary damages? Can the successful party elect between different monetary remedies?

The amount of damages is subject largely to the Court's discretion. The Court is empowered to grant damages in the amount as it deems appropriate based on severity of the damage, the lost benefit, and the necessary expenses

required for enforcement. If the plaintiff cannot sufficiently substantiate the claimed amount, the Court will grant damages in the amount as it deems appropriate. In practice, the Court appears very reluctant to grant high damages.

26. How readily are final injunctions granted in patent litigation proceedings?

If an infringement is found, the Court usually orders injunction against the infringement without considering the public interest or proportionality of the injunction. This may be because the Court considers the patentee's rights to be exclusive and absolute.

27. Are there provisions for obtaining declaratory relief, and if so, what are the legal and procedural requirements for obtaining such relief?

The Thai Civil Procedural Code does not provide a procedure for a potential infringer to request a non-infringement relief. Under the Code, a civil lawsuit can be initiated only in case where a party's rights are disputed, e.g. a patentee claiming an infringement against its patent.

28. What are the costs typically incurred by each party to patent litigation proceedings at first instance? What are the typical costs of an appeal at each appellate level?

Professional fees for all procedures in a patent infringement lawsuit at the CIPIT Court's level should be approximately THB 2,000,000. This would depend largely on complexity of the case as well as the relevant invention. In case where damages are sought, there will be an official court fee at the rate of 2% on the claimed amount (subject to some exceptions).

29. Can the successful party to a patent litigation action recover its costs?

The Court is empowered to order a losing party to compensate a prevailing party for a lawyer's fees. In determining the amount of the fee, the Court shall consider the complexity of the case as well as the time and the work required for the case. In any event, the fees shall not exceed 5% of the claimed amount for the CIPIT Court and 3% of the claimed amount for the higher courts. This amount is unrealistically low.

30. What are the biggest patent litigation growth areas in your jurisdiction in terms of industry sector?

Currently, there may not be many patent infringement lawsuits in Thailand, possibly due to the delay in the examination procedures in the field of pharmaceutical inventions as well as the difficulty in proving damages. Moreover, some cases can be settled by means of a settlement agreement under which the alleged infringers agree to pay royalty fees to the patentees.

31. How has or will the Unified Patent Court impact patent litigation in your jurisdiction?

We have not seen any impact from the Unified Patent Court to a patent litigation in Thailand so far. It is possible that a decision of the Unified Patent Court may be taken into consideration of the Thai Court in a similar case in the future.

32. What do you predict will be the most contentious patent litigation issues in your jurisdiction over the next twelve months?

It has been common in Thailand for the defendant to defend by seeking invalidation/cancellation of the plaintiff's patent. This can be very threatening for the plaintiff because, if the patent is invalidated, the plaintiff will not be entitled to take actions against the defendant

or any other infringer. Hence, the validity of the patent has been a critical issue in a patent infringement lawsuit. This trend should also continue the future.

33. Which aspects of patent litigation, either substantive or procedural, are most in need of reform in your jurisdiction?

The damages in a patent infringement lawsuit should be high enough to sufficiently compensate the plaintiff's financial loss and reward the plaintiff's for its attempt in creating the invention. The high damages would be helpful in deterring infringement.

As precedents show that the Court appears very reluctant to grant high damages, the plaintiff will have to formulate a sound method for calculating its damages.

34. What are the biggest challenges and opportunities confronting the international patent system?

It is more common for an inventor to apply for equivalent or similar patents in multiple jurisdictions. In case of the same infringement action taking place in those jurisdictions, the patentee will have an option to do forum shopping by strategically selecting the jurisdiction with the most favourable patent and legal systems, e.g. a lower rate of patent invalidation, a higher chance of interim injunction, higher damages, and a shorter litigation timeframe.

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