

# DESIGN THAILAND





INTELLECTUAL PROPERTY

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Title: Design Guide in Thailand

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## Generic considerations & Definitions

For design matters, Thailand is bound by the following treaties:

Treaty	Monitoring body	Accession date
Paris Convention for the Protection of Industrial Property (1883)	World Intellectual Property Organization (WIPO)	2008
Trade-Related Aspects of Intellectual Property Rights Agreement (1995)	World Trade Organization (WTO)	1995

Thailand is **not a member** of the Hague Agreement which established a system for international registration of designs.

Although Thailand has not ratified the Locarno Agreement, the DIP follows the **Locarno Classification** to organize Thailand's design database and classify design patents and applications since 1990.

The WIPO defines an industrial design as "*the ornamental aspect of an article*", which can be in two or three dimensions.<sup>1</sup>

Under Thai law, a design is a "patent" and is described by the **Patent Act B.E. 2522 (1979)** as **any form or composition of lines or colors** which gives a **special appearance to a product** and can **serve as a pattern for a product of industry or handicraft**.<sup>2</sup>  
separate guide.

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**As of early 2023, Thailand is in the process of adopting a new Patent Act which will bring significant substantive and procedural changes to the current patent examination rules. This Guide will be updated once the new Patent Act comes into effect.**

**In particular, the new Patent Act will extend the design protection period to 15 years (currently 10).**

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<sup>1</sup> Retrieved from: <https://www.wipo.int/designs/en/> (last accessed 08/10/2020).

<sup>2</sup> Section 3 Patent Act B.E. 2522.

## Basic registrability criteria

A patent can be granted for a design if it meets the following two conditions:<sup>3</sup>

- It must be new.
- It must have an industrial application, which includes handicrafts.

Designs that are deemed contrary to public order or morality or that have been prescribed by a Royal Decree cannot be patented.<sup>4</sup>

### Under which circumstances is a design not “new”?

According to [Section 57 of Patent Act B.E. 2522](#), there are 4 instances in which a design does not meet the novelty requirements:

1. When it was widely known or used in Thailand by others before filing the design application.
2. When it was disclosed in a document in Thailand or a foreign country before the filing date, with the exception of designs presented to the public during fairs, exhibitions or academic seminars within 12 months prior to the application date.
3. When the design was published in Thailand or a foreign country before the Thai filing date of the application.
4. When a design is similar to any design described above (already widely used or known, already disclosed or already published) to the extent that it could be seen as an imitation.

These provisions do not prejudice the right for the applicant (derived from the Paris Convention) to file a design application in Thailand **within 6 months** of the date of filing of the foreign application and claim the corresponding priority date.

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<sup>3</sup> [Section 56 Patent Act B.E. 2522](#).

<sup>4</sup> [Section 58 Patent Act B.E. 2522](#).



## Filing requirements



### Basic filing requirements

To file a design application in Thailand, the following documents need to be submitted to the Thai Department of Intellectual Property (DIP):<sup>5</sup>

1. A **graphic representation of the design**: 7 different views should be submitted, unless some views are identical; the views should ideally be provided as drawings, with a white background. While it is not mandated by any regulation to provide drawings instead of photos, examiners increasingly tend to request drawings.
2. An indication of the product with which the design will be used (only when it is not apparent from the design title or the drawings).
3. A short claim.
4. A scanned color copy of a **simply signed Deed of Assignment (DOA)** if the applicant is not the creator OR a scanned color copy of a **simply signed statement of the applicant's rights** if the applicant is the creator.
5. A copy of a notarized **Power of Attorney** (executed by the applicant or their legal representative) appointing the agent in Thailand – this document will cover required information on the applicant (name, address and nationality or country of incorporation).

If the applicant is a Thai national/corporation, a Power of Attorney (simply signed – no notarization needed) can be submitted together with a signed copy of the applicant's national identity card (for individuals) or of the company registration certificate issued in the last 6 months (for corporations).

**Late filing** of the DOA, statement of applicant's rights and Power of Attorney is possible upon request, within **90 days** from the date of filing the trademark application.

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<sup>5</sup> Section 17 Patent Act B.E. 2522 sets out the formal requirements.

The **official fee** for filing the design application is THB250.

Unlike applications for invention patents that can be made for a group of closely connected inventions, a design application shall identify **only one product** with which the design is to be used.<sup>6</sup> In addition, if the applicant wishes to protect more than one embodiment of the design, it is imperative to file a **separate design application for each embodiment**.



### **Additional requirements when claiming priority**

For a design application claiming priority of a foreign application, it is required to submit the scanned color copy of the **certified copy of the priority application**. Such a priority-based application must be filed within **6 months** of the filing date of the foreign application.

#### **Assignment of priority right**

Assignment of a priority right is possible for design applications, provided that the owner of the foreign application signs a deed of assignment with the applicant who wishes to file an application for the same design in Thailand. The original document needs to be submitted to the DIP.

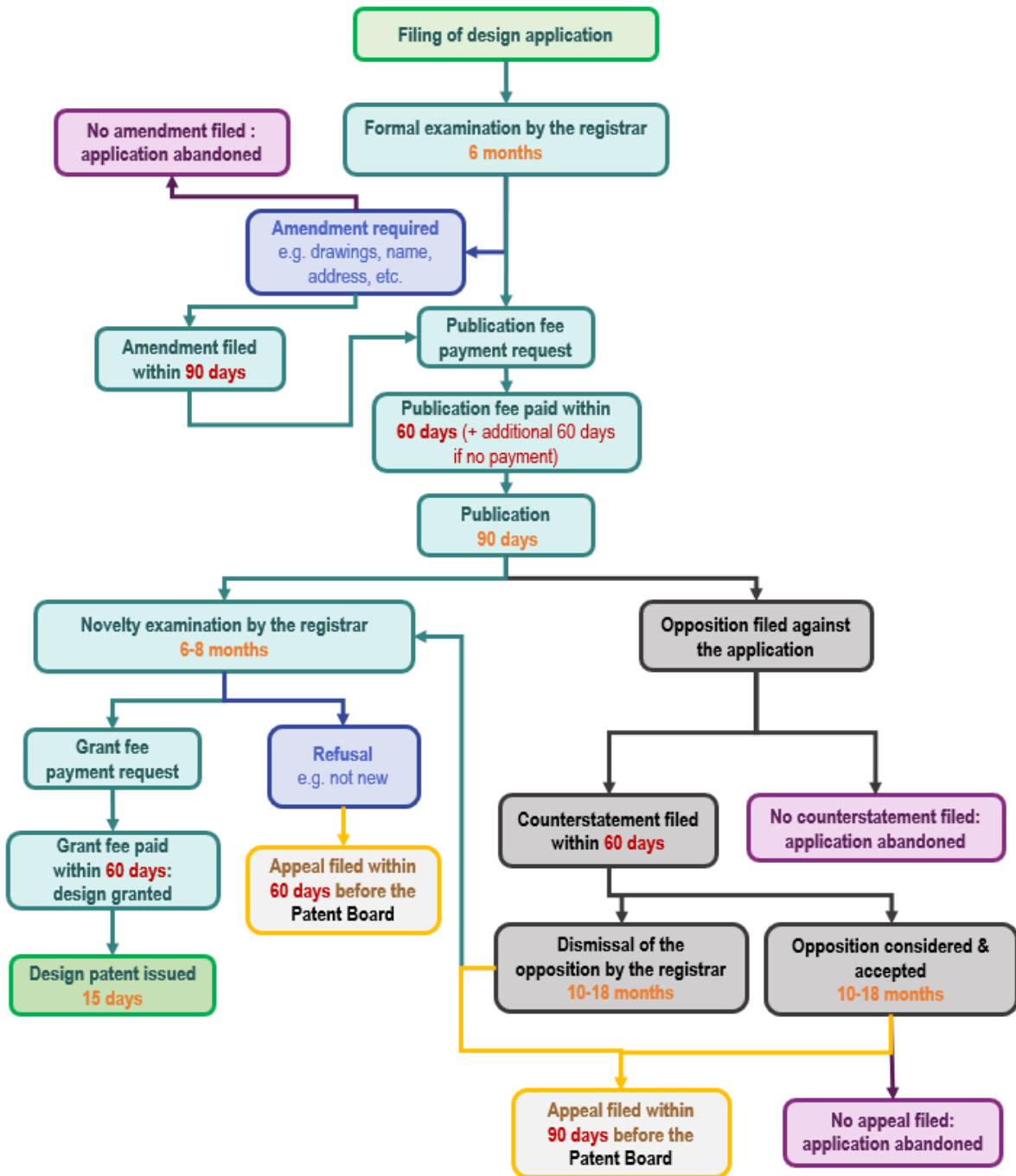
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<sup>6</sup> Section 60 Patent Act B.E. 2522.

# Prosecution procedure

The design registration process in Thailand takes approximately **16 to 24 months**.

## FROM FILING TO GRANT - FLOWCHART







## Formal examination

Following the filing of the application, the Thai Patent Office will take at least 6 months to undertake the preliminary examination of the application. If the application does not comply with the regulations, the applicant will be asked to amend the application within 90 days from receiving such request.



## Publication

If the application complies with the formal regulations, the applicant will be asked to pay the publication fee (THB250) within 60 days of receiving the notice. If the applicant fails to pay the publication fee in these 60 days, a second (and last) notice will be issued, granting the applicant another 60 days to process the payment.<sup>7</sup>

### Deferring the publication of a design application

It is possible to defer the publication of the application by submitting a letter to the DIP explaining the motives of the deferment and specifying an ulterior preferred time for the publication. The publication will be held until the date indicated in this letter.

The application will then be published in the Thai Patent Gazette. Third parties may file an opposition against the application within 90 days from the publication date and present supporting documents within 30 days from the date of submitting the opposition. If no counterstatement is filed within 60 days from the day the applicant was notified of the opposition, the application will be deemed abandoned.



## Substantive examination and grant

If no opposition is filed or if the opposition was unsuccessful, the examiner will perform the novelty examination of the application, which can last 6 to 8 months.

If the novelty examination is satisfactory, the applicant will then be required to pay the issuance fee (THB500) to obtain the design patent, within 60 days

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<sup>7</sup> Section 28 Patent Act B.E. 2522.

of receiving such notice. The design certificate will be issued in the weeks following the payment.

If the registrar considers that the design application does not meet the novelty requirements, the applicant can challenge this decision before the Patent Board within 60 days of being notified of the rejection of the application (see appeal flowchart in Annex).

## Term of protection

The protection of a design can be extended for a maximum of **10 years from the Thai filing date**, provided that the applicant duly pays the annuity fees, yearly or as a lump sum, starting from the 5th year, as described below:

Year	Fee (THB)	Year	Fee (THB)
5 <sup>th</sup> to 10 <sup>th</sup> (lump sum)	7,500	8 <sup>th</sup>	1,400
5 <sup>th</sup>	500	9 <sup>th</sup>	2,000
6 <sup>th</sup>	650	10 <sup>th</sup>	2,750
7 <sup>th</sup>	950		

The payment of the fees shall be made **within 60 days from the beginning of each new term**, or earlier if a notification letter from the DIP is received. If the patentee fails to extend the patent within this prescribed period, an additional 120-day grace period will be granted to file the request to extend the patent, sanctioned by a 30% surcharge of the annuity fees due.

If the annuity fees are not paid within this timeline and the cancellation of the patent is ordered by the DIP, the patentee will have one last chance to extend the term of the patent by filing such request within 60 days of receiving the notice of the cancellation order, provided that the failure to pay on time can be justified by necessity.<sup>8</sup>

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<sup>8</sup> Section 43 Patent Act B.E. 2522.

## Design licensing

During the validity period of the design patent, the patentee may license the exclusive rights derived from the patent to any third party, in exchange for the payment of royalties.<sup>9</sup> The license agreement must be recorded at the DIP and specify the conditions, restrictions and royalty terms of the licensing.

The original licensing contract, signed by the patent owner, the licensee and two witnesses, must be submitted to the DIP.

## Assignment

The patentee may assign the design patent to any third party.<sup>10</sup> The transfer may also occur by inheritance following the death of the patent owner.

The original deed of assignment, the original last will or the original death certificate (as the case may be) should be submitted to the DIP to register the assignment.

## Cancellation & Invalidation

A design patent may be invalidated if it has been granted in violation of the rules prescribed in the Patent Act. Any person who has an interest in the design patent or the public prosecutor can introduce such a petition to cancel it before the IP&IT Court.<sup>11</sup>

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<sup>9</sup> Sections 38 and 39 Patent Act B.E. 2522.

<sup>10</sup> Section 38 Patent Act B.E. 2522.

<sup>11</sup> Section 64 Patent Act B.E. 2522.

## Design rights enforcement

A design patent confers to its owner the exclusive right to (1) use the design in the manufacturing of a product and (2) to sell, retail or import a product embodying the patented design.<sup>12</sup>

These rights can be limited only for research or study purposes.

In case of infringement, some preventive measures and legal remedies are available to the design patent owner under Thai law.

### Preventive measures

#### ⊕ Preliminary injunction

If the patent owner can present clear evidence that any person is committing or about to commit any act infringing their rights, they may petition the Court to issue a preliminary injunction in order to stop or prevent the infringement.<sup>13</sup> However, Thai courts rarely grant such injunctions.

#### ⊕ Anton Piller order

Alternatively, with the aim of seizing evidence of infringement, the patent owner may ask the Court to issue an Anton Piller order, provided that it can be demonstrated that it would be critical to ensure that proof of the infringement will not be destroyed once the alleged infringer is notified of the legal proceedings.<sup>14</sup>

### Civil proceedings

An infringement action may be filed within 1 year from the date where the claimant discovered the infringement, but not past 10 years from the date of infringement. The petitioner should be able to provide evidence of infringement and proof that they are the owner of a valid patent.

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<sup>12</sup> Section 63 Patent Act B.E. 2522.

<sup>13</sup> Section 77 bis Patent Act B.E. 2522.

<sup>14</sup> The Establishment of and Procedure for Intellectual Property and International Trade Court, B.E. 2539 (1996), Sections 28 and 29; Rules for Intellectual and Property and International Trade Cases, B.E. 2540 (1997), Rules 20 and 21.

The Court can grant damages to the owner of the patent, the amount of which will depend on the loss of benefits due to the infringement and the enforcement and judicial expense engaged by the patent owner.<sup>15</sup>

## **Criminal proceedings**

Criminal proceedings may be conducted in parallel with civil proceedings at the initiative of the person who is the owner of a valid patent. The Court will consider the evidence of infringement provided, as well as proof that the alleged infringer had the intention to commit the infringement.

The Patent Act provides that infringement of patent rights can be sanctioned by imprisonment of up to 2 years and/or a fine of a maximum of THB400,000.<sup>16</sup>

## **Alternative dispute resolution**

The DIP has set up a **mediation** procedure for parties who seek to resolve an IP dispute amicably and at minimal costs.

In addition, parties can always choose to resort to **arbitration**. Thailand has two main bodies that provide arbitration and mediation services: the Thai Arbitration Institute (TAI), founded in 1990, and the Thailand Arbitration Center (THAC), instituted by the 2007 Act of Arbitration Center and functional since 2015.

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<sup>15</sup> Section 77 ter Patent Act B.E. 2522.

<sup>16</sup> Section 85 Patent Act B.E. 2522.

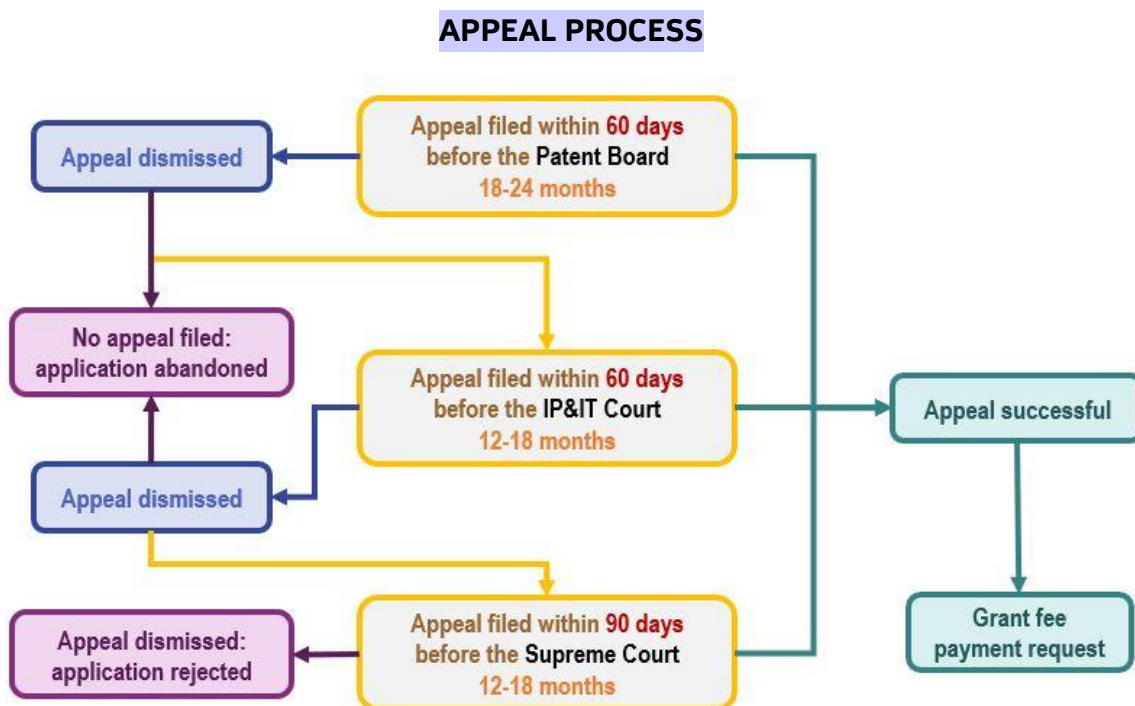


## ANNEX 1 – Official fees

Type	Amount (THB)
Filing	250
Late filing	50
Priority claim	50
Publication	250
Deferring publication	50
Grant	500
Opposition	250
Amendment	50
Appeal (Patent Board)	500
Assignment of application	50
Assignment of design patent	250
Recording license agreement	250

All fees can be retrieved from the DIP website.<sup>17</sup>

## ANNEX 2 – Design appeal flowchart



<sup>17</sup> <https://www.ipthailand.go.th/en/design-patent-006.html> (last accessed 08/02/2021).

**We assist our clients in protecting their designs and enforcing related rights. For more information, advice or quotation, please do not hesitate to contact us at [patent@tmp-ip.com](mailto:patent@tmp-ip.com).**