

REVIEW OF THE PROVISIONS OF ARTICLE 27.3(b)

Information from Members

Addendum

THAILAND¹

The present document represents the information requested by the Council for Trade-Related Aspects of Intellectual Property Rights which the Secretariat has received from Thailand, by means of a communication from its Permanent Mission, dated 8 August 2001.

A. PATENT PROTECTION OF PLANT AND ANIMAL INVENTIONS

1. *To what extent are inventions concerning plants or animals, whether products or processes, patentable under your country's law, if they meet the conditions for patentability stipulated in Article 27.1 of the TRIPS Agreement?*

According to the Patent Act, B.E.2522 as amended by the Patent Act (No. 2), B.E.2535 and the Patent Act (No. 3), B.E.2542 (hereinafter "the Patent Act"), a patent may be granted for any invention, whether product or process, which is new, involves an inventive step and is capable of industrial application (Section 5).

Under Section 9 of the Patent Act, plants and animals *per se*, however, are not patentable, regardless of the fact that such inventions meet the above-mentioned conditions for patentability. Nevertheless, there is no provision in the Patent Act precluding methods or processes for the production of plants and animals from patentability. In other words, although plants and animals are not patentable, methods or processes for the production of plants and animals may be patented under the Patent Act.

2. *Where any such inventions are not patentable, even if they meet these conditions:*

(i) *To what extent is this due to per se exclusions from patentability?*

According to Section 9, not only plants and animals are excluded from patent protection, extracts therefrom (both from plants or animals) are also not patentable.

In addition, Section 9 also excludes "methods" of diagnosis, treatment or cure of human and animal diseases from patentability.

¹ An illustrative list of questions prepared by the Secretariat in response to a request from the Council is available in document IP/C/W/122.

- (ii) *To what extent is this based on other grounds (for example because conditions for patentability other than those stipulated in Article 27.1 are not met or in order to protect ordre public or morality (see Article 27.2 of the Agreement))?*

Any inventions contrary to public order, morality, health or welfare are not protected under the Patent Act (Section 9(5)).

3. *Please describe any specific provisions, guidelines, final judicial decisions and administrative rulings of general application concerning the application of the conditions for patentability stipulated in Article 27.1 to subject-matter addressed by Article 27.3(b).*

Not available because plants and animals are not patentable subject-matter under the Patent Act according to Section 9 (see the reply to question A.1).

4. *Where plant varieties are not as such patentable subject-matter under your country's law, please indicate the extent to which the scope of protection under patents for inventions concerning plants can nevertheless embrace plant varieties or a botanical taxon whose plants express a trait covered by the claims of a patent.*

Plant varieties *per se* are not patentable subject-matter under the Patent Act, but any process for obtaining new plant varieties may be patentable, provided that it is new, involves an inventive step and is capable of industrial application. (Plant varieties are, however, protected under the Plant Varieties Protection Act, B.E.2542 (1999), see the reply to question B.4)

5. *Please provide any definitions used under your country's law with regard to subject-matter specifically excluded from patentability or specifically patentable (e.g. micro-organisms, microbiological processes, non-biological processes, plant varieties).*

While Section 9 of the Patent Act explicitly states that plants, animals or extracts from animals or plants as well as naturally occurring micro-organisms and their components are excluded from patentability, there exists no definition of those terms in the Act itself.

Only the term "plant" is defined by Section 3 of the Plant Varieties Protection Act, B.E.2542 (1999) as follows: "plant means a living organism in the kingdoms of plants and shall include mushroom and seaweed but exclude other micro-organisms".

6. *To what extent is subject-matter that is identical to what occurs in nature patentable under your country's law?*

The definition of the term "invention" stipulated in Section 3 of the Patent Act, which reads: "invention means any innovation or invention which creates a new product or process, or any improvement of a known product or process", may, to some extent, reflect the underlying principle of the patent system that patents shall not be granted for things occurring in nature. Along that line is the provision of Section 9(1), which excludes micro-organisms and their components already existing in nature as well as extracts of plants and animals from patentability.

With regard to the subject-matter identical to what occurs in nature, according to the Patent Act, neither modified nor naturally existing plants and animals can be patented. However, modified micro-organisms and modification of their components are patentable (Section 9).

7. *Explain the requirements under your country's law for ensuring adequate disclosure of the patentable inventions referred to above.*

There is no special requirement for ensuring adequate disclosure in the case of inventions referred to under question A.6. However, the general provisions for ensuring adequate disclosure as set forth in Section 17 of the Patent Act shall also apply to this type of invention as follows:

- the patent application shall contain a detailed description of the invention;
- such a description shall be, as such, full, concise and clear and exact terms as to enable any 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
- the description shall set forth the best mode contemplated by the inventor (the applicant) to carry out his invention.

8. *What rights are conferred upon owners of the patents referred to above? Are product and process patents subject to the same rules as other patents? Do they benefit from the same protection as stipulated in Article 28 of the TRIPS Agreement?*

The above-referenced product and process patents are subject to the same rules as other patents, and the owners of which benefit from the same protection as stipulated in Article 28 of the TRIPS Agreement as follows:

- where the subject-matter of the patent is a "product", the patentee shall enjoy the right to produce, use, sell, have in the possession for sale, offer for sale or import the patented products; and
- where the subject-matter of the patent is a "process", the patentee shall have the right to use the patented process, produce, use, sell, have in the possession for sale, offer for sale or import the product produced by the patented process.

In addition, the owners of the patents may authorize any other person, by granting a licence, to exercise the above-mentioned rights conferred to him, and may also assign his patent to any persons (Section 38).

9. *Are there any specific exceptions to these rights (affecting the scope or duration of the patents referred to above)? To what extent are exceptions, available in respect of plant variety rights (e.g. those referred to under question B.4(i) below), available in respect of rights conferred upon patent owners?*

There is no specific exception to those rights of the patentee referred to above. However, general exceptions as set forth in Section 36, paragraph 2 of the Patent Act shall still apply, e.g., an act for the purpose of study, research, experimentation or analysis shall be deemed an exception to the rights of the patentee if it does not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner.

10. *Are there any specific provisions under your country's law for compulsory licensing in respect of the patents referred to above?*

No. All cases of compulsory licensing are subjected to the same rules.

B. PROTECTION OF PLANT VARIETIES

1. *Does your country's law provide for the protection of plant varieties by plant breeder's rights, plant patents or any other sui generis system for the protection of plant varieties?*

Yes.

2. (a) *If your country is a party to the International Convention for the Protection of New Varieties of Plants (UPOV), please indicate which Act or Acts of the UPOV Convention your country has signed; which it has ratified; to which it has acceded; and to the standards of which its law conforms but to which it has not (yet) adhered.*

(b) *If your country is not a party to the UPOV Convention, does the protection offered to plant varieties under your country's law conform to the standards of any of the Acts of the UPOV Convention and, if so, which?*

Thailand is not a party to the UPOV Convention. However, the Plant Varieties Protection Act has some subject-matters which conform to the 1978 Act of the UPOV Convention. The Act protects the new protected varieties based on novelty, distinctness, uniformity and stability.

3. *Please indicate whether concurrent protection under your country's plant variety protection law and its patent law is available (see also question A.4 above).*

The Plant Varieties Protection Act is offered to both asexually and sexually produced plant varieties, the Patent Act provides patent protection to the only procedure of produced plant varieties.

4. *Please provide the following details of your country's sui generis system for the protection of plant varieties:*

(a) *the relevant laws and regulations and, if they have been notified to the Council for TRIPS, a reference to the relevant WTO documents;*

The protection of new plant varieties in Thailand is under the Plant Varieties Protection Act, B.E.2542 (1999) (IP/N/1/THA/P/1).

(b) *the definition of "plant variety";*

According to Section 3 of the Act, plant variety means a plant grouping of similar or identical genetic and botanical characteristics, with particular features which are uniform, stable and distinct from other grouping in the same species of plant and shall include trees, the propagation of which is conducive to the plant grouping of the aforesaid features.

(c) *the conditions required for protection;*

According to Sections 11 and 12 of the Act, the conditions required for the protection of new plant varieties are novelty, distinctness, uniformity, stability, not exploited in or outside the Kingdom for more than one year and distinct from other plant varieties existing on the date of filing the application.

- (d) *the extent to which subject-matter that is already known to the public or identical to what occurs in nature is protectable under your country's sui generis system for the protection of plant varieties;*

According to Sections 52 and 53 of the Act, subject-matters are: a person who collects, procures or gathers general domestic plant varieties, wild plant varieties or any part of such plant varieties for the purposes of variety development, education, experiment or research for commercial or non-commercial purposes shall make a profit-sharing agreement and comply with the Regulation prescribed by the Commission.

- (e) *the extent to which protection can be based on characteristics of germplasm, as opposed to characteristics of plant varieties derived from such germplasm;*

The Plant Varieties Protection Act, B.E.2542 has granted protection only for the new plant varieties derived from any germplasm.

- (f) *who is entitled to the rights;*

The right holder of a new plant variety.

- (g) *the procedure for the acquisition of rights, including the authority in charge of administering the rights;*

The application for registration of a new plant variety should be made in accordance with the subject-matters in Section 19 of the Act. A breeder who applies for registration should declare the details and procedures prescribed in the Ministerial Regulation. The application would be examined by the competent official and considered by the Director-General of the Department of Agriculture, Ministry of Agriculture and Cooperatives which is the authority in charge of administering the rights.

- (h) *the rights conferred;*

The Plant Varieties Protection Act, B.E.2542 provides the right holder of a new plant variety to have the exclusive right to produce, sell or distribute in any manner, import, export or possess for any purpose, the propagating material of the new plant variety.

- (i) *exceptions to the rights conferred, such as:*

- *acts performed for research or experimental purposes;*

Yes, there are exceptions under the Act to the rights for research or experimental purposes in Section 33, paragraph 2.

- *acts performed to develop new varieties of plants;*

Yes, there are exceptions under the Act to the rights for developing new varieties of plants in Section 33, paragraph 2.

- *acts performed to commercialize such newly developed varieties;*

Yes, there are exceptions under the Act to the right to commercialize such newly developed varieties in Section 33, paragraphs 1 and 2.

- *any "farmer's privilege" (e.g. acts performed by a farmer on his own land in respect of seed saved from the previous harvest);*

Yes, there are exceptions under the Act to the rights for "farmer's privilege" in Section 33, paragraph 4.

- *acts done privately and for non-commercial purposes;*

Yes, there are exceptions under the Act to the rights for doing privately and non-commercial purposes in Section 33, paragraph 5.

- *compulsory licensing.*

Yes, there is compulsory licensing under the Act in Sections 36 and 37. The Minister of the Ministry of Agriculture and Cooperatives with the approval of the Commission, has the power to issue a Notification prohibiting the production, sale, distribution in any manner, importation or exportation of new plant varieties for the period of time. The Director-General of the Department of Agriculture, with the approval of the Commission, has the power to authorize the use of the right holder of a new plant variety in case of no sale or insufficient of the propagating material of that new plant variety.

- (j) *the duration of protection;*

According to Section 31 of the Act, the variety protection right shall expire at:

- The end of the 12th calendar year following the date of the registration of its establishment for biennials.
- The end of the 17th calendar year following the date of the registration of its establishment for trees.
- The end of the 27th calendar year following the date of the registration of its establishment for tree-based utilizations.

- (k) *transfer of rights;*

According to Section 32 of the Act, the right holder of a new plant variety may authorize any person to use his rights in his new plant variety or may assign such rights to other persons.

- (l) *the enforcement of the rights.*

According to Sections 61 and 62 of the Act, the infringement of the right of the right holder of a new plant variety and a local domestic plant variety would be ordered by the Court to pay the right holder such an amount of compensation as the Court deems appropriate. All infringing plant varieties are confiscated by the Court and proceeded by the Department of Agriculture with the approval of the Commission.

According to Sections 63-68 of the Act, any person who commits an offence shall be punished by imprisonment for a term of not more than two years or by a fine not exceeding four hundred thousand Baht (B 400,000) or both.
