

# EXEMPTION OF INVENTION PATENT INFRINGEMENT UNDER THE PATENT ACT B.E 2522 (1979) AND AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS)

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**Abstract** - Invention Patent under the Patent Act B.E. 2522 (1979) means the certificate issued by the government sector to the patent registration applicant with the main purpose to provide protection to the patentee with exclusive right to produce, use, sell, obtain for sale, present, or import invention that specified in the patent to Thailand. However, the exclusive right to conduct such business as mentioned above to the patentee may cause market monopoly problems where the patentee is solely responsible for the production and sell the invention without having competitors. In this case, the patentee can control the marketing mechanism and set the price of the invention as high as they need. Moreover, the numbers of such invention may be too little to meet the needs of consumers. This problem can have serious effect on people. If the protected invention is an important factor in the lives of the general public such as medicines and medical instruments, if the patentee has exclusive right on the market, the invention price may be too high to effort for the people, especially those from the developing countries, or it may be inadequate for the needs of people. In order to solve this problem, TRIPS Agreement contains provisions that give Member States the power to impose exceptions to the exclusive rights of patent owner without having unreasonable opposition to the normal benefits of patents. In addition, it must not cause damages on the reputation without having the reasons on the equitable benefits of the patent owner. Thailand, one of the member states of the TRIPS Agreement, set out several exceptions to the infringement of invention patents in no. 36, paragraph 2, of the Patent Act, BE 2522 (1979), for example. This provision is in line with the TRIPS Agreement, and it provides opportunity for the people to use benefits of invention patent very well.

**Index Terms** - Exemption of invention patent infringement, Patent Act B.E. 2522 (1979), TRIPS

## I. INTRODUCTION

Currently, the intellectual property protection has played an important role in international trade as it is used as an important tool to secure the protection of new inventions. The exclusive right is provided to the inventor to exclude or prohibit another person from producing, selling or seeking for benefits from the invention or product. In this case, it can be assured that if one has invested and invented, valuable and appropriate rewards will be received. When such guarantee is presented, there will be the motivation on inventing more inventions, and it is resulted to the technological development and progress (Abbott, 2002). International agreement related to intellectual property rights which is important at present is Trade-Related Aspects of Intellectual Property Rights or TRIPS, which is considered as the Primary Law, and it is the minimum standard for protecting the international intellectual property that the Member States shall issue their own internal rules in order not to be contrary or opposed with the TRIPS Agreement. That means, than or equal to the protection afforded by the TRIPS Agreement. However, Member States cannot issue their own internal rules for protection of intellectual property rights lower than those specified in TRIPS (Abbott, 2002). Thailand, which is one of the WTO members, is required to enter into a TRIPS Agreement and to improve its intellectual property laws in line with the

minimum standards set forth in the agreement. The Patent Act, BE 2522 (1979), defined the characteristics of three inventions that can be applied for patent into 3 factors as follows: first characteristic, it shall be newly invented, that is, it shall be the invention which has not been existed. Next, it must be an invention with a higher inventive stage, that is, it shall be the invention that is not easily visible by those who have common skills for that type of work. The third factor is inventions that can be applied in the industry include inventions that can be used in the production of industrial goods, including handicrafts, agricultures, and commerce as it can be produced in large quantities, and it can be used not only in theoretical way, but in practical way as well (Chaiyot Hemaratchata, 2016). The acquisition of a patent is not automatically acquired as a copyright. Nevertheless, a patent shall be applied and registered with a government sector, which means, the government sector is the organization that issues a patent. However, when a patent is registered and issued to a person, such person will be a patentee who shall have the exclusive right to produce, use, sell, obtain for sale, present, or import invention that specified in the patent to Thailand. If other persons produce, use, sell, obtain for sale, present, or import invention that specified in the patent to Thailand without having consent from the patentee, it is a violation of invention patent which leads to the legal penalty. The patentee's right may cause a marketing

technology, those who have the patent has the exclusive right to produce and sell the invention and without having infringement. In this case the patentee can control the marketing mechanism and set the price of the invention as high as they want because the absence of such invention may be not into to meet the needs of consumers. This problem can have serious effect on people. If the patented invention is an important factor in the lives of the general public such as medicines and medical instruments. If the patentee has exclusive right on the market, the invention price may be too high to afford for the people, especially those from the developing countries such as Thailand where most of the population are ranged from poor to middle-class and they cannot approach the medicines or necessary inventions due to the lack of opportunity and high in price. In addition, the government has inadequate budget to support such public policy. On the other hand, TRIPS Agreement contains provisions that solve the problems of exclusive right on marketing on the patentee by specified the exemption of invention patent that gives the Member States the power to issue an internal law which imposes the exemption on the exclusive right of the patentee only not to have unreasonable opposition to the normal benefits of patents, and it must not cause damages without reasons to the equitable benefits of the patent owner. In this research, the researchers focus on the concepts, principles, and problems of patent infringement as well as the invention of the TRIPS Agreement by comparing laws, the use, and the interpretation of the exemption of the invention patent infringement to access to Thailand's inventions that have patents whether it may be used in accordance with the intention of the TRIPS Agreement or not. This research is used as a guideline for the law development to make it appropriate and complies with international agreements, and it is to ensure that the law is properly enforced and that it will guide the proper implementation of the patent infringement exemption in order to balance the rights of the patentee and the public.

## II. RESEARCH PURPOSES

1. To study the concepts, principles, and methods of patent protection and the exemption on the patent infringement by comparing the TRIPS Agreement with the Patent Act B.E. 2522 (1979);
2. To study the problem of access to the protected inventions under the TRIPS Agreement with the Patent Act B.E. 2522 (1979)

## III. SCOPE OF THE RESEARCH

The study of the exemption for invention patent infringement under the Patent Act B.E. 2522 (1979) is a study of the concepts, principles, and social impacts of an action that is considered as an

exemption for invention patent infringement under the Patent Act B.E. 2522 (1979) enforced in Thailand. Thus, it is to compare with the principles of TRIPS Agreement.

## IV. RESEARCH METHODOLOGY

The comparative study of concepts and principles related to the exemption for invention patent infringement under Thai Law and TRIPS Agreement. It is a research process to find the appropriate measures and comply with international agreements to be applied to Thai law by using Qualitative Research, and it is conducted as a documentary research by studying and collecting related data and laws, regulations, judicial decisions, texts, journals, academic articles, thesis, research, report, and documents published on the internet to bring knowledge into the analysis, synthesis, comparison and processing in the future (Surasak Meesha 2016).

## V. EXPECTED BENEFITS

1. To acknowledge the legal principles of the international agreement and Thai law in the protection of invention patent and invention patent infringement;
2. To acknowledge the measures and guidelines in enacting and enforcing the law in accordance with international agreements. At the same time, the law also has the primary intention of promoting public policy;
3. To be able to apply the knowledge gained from the study as a guide for determining appropriate public policy and measures to protect the rights of the patentee simultaneously with the promotion to access to medicines effectively.

## VI. RESEARCH RESULT

Patent Protection under the TRIPS Agreement specified any actions to import, sell, or distribute has the purpose to sell for profits without using consent from a patentee, it is considered as a violation on the patent of the patentee, and the protection period is 20 years from the date of filing patent registration application. For the exemption of the invention patent infringement or the action which is not considered as the violation on the patent, the TRIPS Agreement provides for the exemption of invention patent infringement in neutral by providing the Member States the power to impose an exemption on the exclusive right over the patent by having the conditions that such exemption must not have unreasonable opposition to the normal benefits of patents, and it must not cause damage without reasons to the equitable benefits of the patent owner by considering the equitable right of the patent party.

The protection on the invention patent under the Patent Act B.E. 2522 (1979) specified the exemption on the invention patent infringement in several factors as follows:

First, any actions performed for the benefits of study, research, test, or experiment. Thus, it must not be opposed to the normal usage for benefits of the patentee or it must not immoderately damage the equitable benefits of the patentee.

Second, by performing the production of the product or process registered by the patentee, the manufacturer of the product or user has operated the business or has the tools or equipment for operating such business in good faith before the date of application for a patent in the Kingdom, and the manufacturer or user of the process is unaware or have no sufficient reason to know about the registration.

Third, the preparation of specific prescription drugs by the medical profession or medical practitioners, including action on the medical product.

Fourth, any actions performed as the application for the registration of drugs, and the applicant is intended to manufacture, distribute, or import patented pharmaceutical products after such patent expired.

Fifth, using, selling, having for sale, presenting for sale, or importing the patented products to the kingdom if the patentee allowed or consented to produce or sell such products.

Hence, the Patent Act B.E. 2522 (1979) imposed an exemption for invention patent infringement in accordance with the TRIPS Agreement. Thus, it is to prevent market monopoly and promote more on public policy.

## VII. CONCLUSIONS

The exemption on the invention patent infringement under Patent Act B.E. 2522 (1979) is accordance with TRIPS Agreement. However, the exemption under the Patent Act B.E. 2522 has drawback that need to be revised because it is unclear and, there is no balance between the benefits of the patent and the public.

## VIII. SUGGESTIONS

Even though the Patent Act B.E. 2522 (1979) imposed the exemption of invention patent infringement in accordance with the TRIPS Agreement, the exemption under the Patent Act B.E. 2522 is unclear. Additionally, there is no balance between the benefits of the patent and the public. Therefore, the researcher recommends the following amendments to the law.

- The above patent exemption is only providing benefits for some people such as academics and medical professionals. The law should be amended to allow the public to use patented inventions for the benefits of themselves which are not for commercial

gains and are not contrary to the normal usage to obtain the benefits of the patent, and it must not unreasonably cause damages to the equitable rights of the patentee.

- There should be a limitation on the duration, purpose, and scope of the patentee's use of the patented invention that meets the exemption of invention patent infringement. Thus, it is not to cause unreasonable damages to the patentee.

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