

Registration of licensing agreement in Thailand

Department of Intellectual Property, Thailand

<http://www.ipthailand.go.th>

Consideration criteria

Licensing Agreement to use the patent is the contract, with which the patent/petty patent owners grants the specific right to the licensee. The permission shall not exceed the protection period as prescribed by law.

- The protection period of invention patent lasts 20 years.
- The protection period of petty patent lasts 6 years, or upon the petty patent renewal application according to Article 65 paragraph 2 of the laws.

Conditions of application submission

1. To register a licensing agreement, the applicant shall submit the form as determined by the Director-General, together with a licensing contract to use the invention patent/petty patent.
2. Authorization
 - 2.1 In case the applicant of the patent does not reside in the Kingdom of Thailand, he shall authorize the patent agent/patent attorney registered with the Director-General of the Department of Intellectual Property to act on his behalf. In this regard, the power of attorney shall be presented to the Director-General in accordance with the following regulations;
 - (i) If the authorization is done outside the Kingdom of Thailand, the signatures in the authorization letter or power of attorney shall be certified by the authorized official of the Thai embassy or consulate or Director of the office of the Ministry of Commerce located in the country where the principal or power grantor resides, or the person authorized to act on behalf of the said officials or the person authorized to certify the signature according to the law in that country, or
 - (ii) In case the authorization is done in the Kingdom of Thailand, the applicant shall submit a copy of passport or temporary residence certificate of the principal or power grantor, or any evidence indicating that at the time the authorization was made, the principal or power grantor was in Thailand.
 - 2.2 The Power of Attorney shall be attached with the revenue stamp of 30 Baht/patent agent or patent attorney/application.

Proceeding according to the official's instruction

1. In case that the official finds a correctable defect in the application, the official shall notify the applicant or his patent

agent/patent attorney for the correction. The applicant shall finish the correction within 90 days of the notification reception date. After such period, without the correction, the applicant shall be deemed to have abandoned the application, except the Director-General extends the period for correction as deemed appropriate due to any necessity.

2. After the applicant corrected the application, the applicant shall submit the correction application and the fee to the Department of Intellectual Property or the provincial office of the Ministry of Commerce. The corrected application shall enter the consideration and initial inspection processes respectively, similarly to the re-submission of the application.
3. In case of application submission via the website of the Department of Intellectual Property, the inspecting official shall check the completeness of information and details in the patent/petty patent application, request or other applications based on information and details appearing in the e-patent filing system. In this regard, the applicant shall present the application and supporting documents to the Department of Intellectual Property within 15 days of application number reception date and patent/petty patent application filing date via internet. The inspection of application submitted via internet shall be in accordance with the Notification of the Department of Intellectual Property Re: Principles and conditions for submission of patent/petty patent application, requests or other applications via internet.

Notes:

1. The working process starts after the inspection of the documents is completed, as specified in the manual of the public service.
2. In case the application or documentary evidence is not correct or incomplete, the official shall record the defect of the document or indicate the required additional documentary evidence (Record of conditions on application reception). The applicant shall correct the document and/or submit the additional document within 90 days of the application filing date. If the applicant fails to submit all additional documents within the specific period of time, the applicant shall be deemed to have abandoned the application. The official shall return the application to the applicant and inform the reason of the return and his appeal right.
3. Any person fee paid to the Department of Intellectual Property shall not be refunded in all cases, except
 - (i) The law stipulates that the fee must be refunded, or
 - (ii) The applicant double-paid or overpaid the fee, by which the faulty payment resulted from the mistake of the state

official, not the payer. In this regard, the Department of Intellectual Property shall consider the refund case by case.

4. In case the applicant is required to submit many additional documentary evidences, the applicant shall submit all additional documentary evidences in the same time.
5. In case the applicant submits the copy of the documentary evidence, the applicant shall certify the copy of the documentary evidence.
6. In case the applicant submits the document in foreign language, the applicant shall submit the document with Thai translation and the correct translation certification of the translator.
7. In case the applicant or the authorized patent agent/patent attorney does not submit the application by himself, and granted power to the other person to submit the application, the application submitter shall present a sub power

of attorney or temporary power of attorney, so that he is eligible to submit the application and sign in the record of conditions on application reception. If it appears that the application and the documentary evidence is not correct or incomplete, and the application submitter is not authorized to sign on the said record, the official shall not receive the application.

8. The working period does not include the time period when the applicant follows the official's instruction or corrects the application, or the period of temporary suspension of registration.

Relevant laws

- The Ministerial Regulation No.25 (B.E. 2542) issued by virtue of the Patent Act B.E. 2522 (Dated 24 September 1999).
- 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

World Intellectual Property Report 2019

The 2019 edition of WIPO's World Intellectual Property Report analyzed millions of patent and scientific publication records across several decades to conclude that innovative activity has grown increasingly collaborative and transnational, while originating in a few large clusters located in a small number of countries. Some 30 metropolitan hotspots alone accounted for 69 percent of patents and 48 percent of scientific activity during the 2015-2017 period. They are mostly located in five countries – China, Germany, Japan, the Republic of Korea and the United States of America (U.S.).

The report finds that innovation has become more collaborative. In the early 2000s, teams of scientists produced 64 percent of all scientific papers and teams of inventors were behind 54 percent of all patents. By the second half of the 2010s, these figures had grown to almost 88 and 68 percent, respectively.

Collaboration has also become more international in nature. The share of scientific collaborations with two or more researchers located in different countries grew to around 25 percent in 2017. For patents, the share of international co-inventions increased to 11 percent until 2009, but has since slightly fallen, partly because of rapid growth in domestic collaborations in certain countries. Most international collaboration takes place among the top metropolitan hotspots. The largest ten of them – San Francisco-San Jose, New York, Frankfurt, Tokyo, Boston, Shanghai, London, Beijing, Bengaluru, and Paris – account for 26 percent of all international co-inventions. The U.S. hotspots emerge as the most connected ones in the world.

The report delves deeper into the global innovation landscape of two industries undergoing profound change. One is the automotive sector, where the adoption of autonomous vehicles technology is causing disruption. New entrants – from within the automotive industry and from the information technology (IT) industry – are challenging established players.

Patent data suggest that traditional automakers and their suppliers are at the forefront of autonomous vehicles innovation. Ford, Toyota and Bosch – accounting for 357, 320 and 277 of AV patent families, respectively – are the top three autonomous vehicles patent applicants. However, non-automakers also feature in the list of top patent applicants. Google, and its autonomous vehicles subsidiary Waymo, are in eighth position with 156 patents, ahead of traditional automakers like Nissan, BMW, Toyota and Hyundai. Tech companies Uber and Delphi each have 62 AV patents and are jointly ranked 31st.

For more information, contact:

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Voluntary licensing of patents in the Philippines

The Intellectual Property Office, Philippines

<http://ipophil.gov.ph>

REPUBLIC ACT NO. 8293

SECTION 85. Voluntary License Contract — To encourage the transfer and dissemination of technology, prevent or control practices and conditions that may in particular cases constitute an abuse of intellectual property rights having an adverse effect on competition and trade, all technology transfer arrangements shall comply with the provisions of this Chapter. (n)

SECTION 86. Jurisdiction to Settle Disputes on Royalties — The Director of the Documentation, Information and Technology Transfer Bureau shall exercise quasi-judicial jurisdiction in the settlement of disputes between parties to a technology transfer arrangement arising from technology transfer payments, including the fixing of appropriate amount or rate of royalty. (n)

SECTION 87. Prohibited Clauses — Except in cases under Section 91, the following provisions shall be deemed prima facie to have an adverse effect on competition and trade:

87.1. Those which impose upon the licensee the obligation to acquire from a specific source capital goods, intermediate products, raw materials, and other technologies, or of permanently employing personnel indicated by the licensor;

87.2. Those pursuant to which the licensor reserves the right to fix the sale or resale prices of the products manufactured on the basis of the license;

87.3. Those that contain restrictions regarding the volume and structure of production;

87.4. Those that prohibit the use of competitive technologies in a nonexclusive technology transfer agreement;

87.5. Those that establish a full or partial purchase option in favor of the licensor;

87.6. Those that obligate the licensee to transfer for free to the licensor the inventions or improvements that may be obtained through the use of the licensed technology;

87.7. Those that require payment of royalties to the owners of patents for patents which are not used;

87.8. Those that prohibit the licensee to export the licensed product unless justified for the protection of the legitimate interest of the licensor such as exports to countries where exclusive licenses to manufacture and/or distribute the licensed product(s) have already been granted;

87.9. Those which restrict the use of the technology supplied after the expiration of the technology transfer arrangement, except in

cases of early termination of the technology transfer arrangement due to reason(s) attributable to the licensee;

87.10. Those which require payments for patents and other industrial property rights after their expiration, termination arrangement;

87.11. Those which require that the technology recipient shall not contest the validity of any of the patents of the technology supplier;

87.12. Those which restrict the research and development activities of the licensee designed to absorb and adapt the transferred technology to local conditions or to initiate research and development programs in connection with new products, processes or equipment;

87.13. Those which prevent the licensee from adapting the imported technology to local conditions, or introducing innovation to it, as long as it does not impair the quality standards prescribed by the licensor;

87.14. Those which exempt the licensor for liability for non-fulfillment of his responsibilities under the technology transfer arrangement and/or liability arising from third party suits brought about by the use of the licensed product or the licensed technology; and

87.15. Other clauses with equivalent effects. (Sec. 33-C (2), RA 165a)

SECTION 88. Mandatory Provisions — The following provisions shall be included in voluntary license contracts:

88.1. That the laws of the Philippines shall govern the interpretation of the same and in the event of litigation, the venue shall be the proper court in the place where the licensee has its principal office;

88.2. Continued access to improvements in techniques and processes related to the technology shall be made available during the period of the technology transfer arrangement;

88.3. In the event the technology transfer arrangement shall provide for arbitration, the Procedure of Arbitration of the Arbitration Law of the Philippines or the Arbitration Rules of the United Nations Commission on International Trade Law (UNCITRAL) or the Rules of Conciliation and Arbitration of the International Chamber of Commerce (ICC) shall apply and the venue of arbitration shall be the Philippines or any neutral country; and

88.4. The Philippine taxes on all payments relating to the technology transfer arrangement shall be borne by the licensor. (n) cdt

SECTION 89. Rights of Licensor — In the absence of any provision to the contrary in the technology transfer arrangement, the grant of a license shall not prevent the licensor from granting further licenses to third person nor from exploiting the subject matter of the technology transfer arrangement himself. (Sec. 33-B, R.A. 165a)

SECTION 90. Rights of Licensee — The licensee shall be entitled to exploit the subject matter of the technology transfer arrangement during the whole term of the technology transfer arrangement. (Sec. 33-C (1), R.A. 165a)

SECTION 91. Exceptional Cases — In exceptional or meritorious cases where substantial benefits will accrue to the economy, such as high technology content, increase in foreign exchange earnings, employment generation, regional dispersal of industries and/or substitution with or use of local raw materials, or in the

case of Board of Investments, registered companies with pioneer status, exemption from any of the above requirements may be allowed by the Documentation, Information and Technology Transfer Bureau after evaluation thereof on a case by case basis. (n)

SECTION 92. Non-Registration with the Documentation, Information and Technology Transfer Bureau — Technology transfer arrangements that conform with the provisions of Sections 86 and 87 need not be registered with the Documentation, Information and Technology Transfer Bureau. Nonconformance with any of the provisions of Sections 87 and 88, however, shall automatically render the technology transfer arrangement unenforceable, unless said technology transfer arrangement is approved and registered with the Documentation, Information and Technology Transfer Bureau under the provisions of Section 91 on exceptional cases. (n)

Publications on SMEs competitiveness

Innovation and SME Financing in Selected Asian Economies

This publication highlights the different policy measures taken by the governments of seven Asian economies to stimulate innovation among SMEs. It contributes to the current discourse on the importance of financing innovations to create a conducive environment for long-term SME growth.

Contact: Asian Productivity Organization, Leaf Square Hongo Building, 2F, 1-24-1 Hongo, Bunkyo-ku, Tokyo 113-0033, Japan. Tel: 81-3-3830-0411, Fax: 81-3-5840-5322, E-mail: apo@apo-tokyo.org, Web: <http://www.apo-tokyo.org>

Exchanging Value - Negotiating Technology Licensing Agreements: A Training Manual

The manual provides an introduction to some of the basic issues that arise in technology licensing negotiations and offers useful insights into how they may best be handled. In a highly competitive and dynamic marketplace, technology licensing is a useful option for companies seeking to maintain their competitive advantage and a healthy balance sheet. It covers a wide range of basic issues that arise during technology licensing negotiations and offers useful insights into how they may best be handled in practice.

Contact: Media Relations and Public Affairs Section, WIPO. Tel: + 41 22 338 8161 or 338 95 47, E-mail: publicinf@wipo.int, Web: <http://www.wipo.int>

Globalization and Performance of Small and Large Firms

The report examines whether and how globalization has differential effects on small and (or versus) large firms and aims at identifying policy issues to be addressed to achieve stronger and more resilient economic growth in East Asian countries. Globalization in this research is broadly defined to include trade and foreign direct investment (FDI) liberalization, trade (exports and imports), international capital flows, outsourcing and traded intermediate goods. The research conducted 10 country studies for 8 countries in the Asia-Pacific region, namely, China, Indonesia, Japan, Korea, Malaysia, Philippines, Thailand, and Viet Nam.

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