

Ministerial Regulations No. 26 (B.E. 2542) Issued under the Patent Act B.E. 2522

By virtue of the power granted under Sections 4 and 45 of the Patent Act B.E. 2522, Section 46 paragraph three of the Patent Act B.E. 2522 as amended by the Patent Act (No. 2) B.E. 2535 and Section 47, 47bis, 50, 50bis and 65decies of the Patent Act B.E. 2522 as amended by the Patent Act (No. 3) B.E. 2542, the Minister of Commerce issues the Ministerial Regulations as follows:

Clause 1

The Ministerial Regulations No. 14 (B.E. 2535) issued under the Patent Act B.E. 2522 shall be repealed.

Clause 2

Any patentee or owner of a petty patent who has not granted an exclusive license to any other person may request for an entry to be made in the register of patents or petty patents indicating his consent to the effect that any other person may obtain a license. The request together with a statement specifying that he shall not withdraw such consent in the form prescribed by the Director-General shall be submitted to the competent officer or sent by a registered mail to the competent officer at any of the following places: (1) the Department of Intellectual Property, Ministry of Commerce; (2) any provincial commercial office or governmental office prescribed by the Director-General.

Clause 3

When the patentee or the owner of a petty patent has filed the request under Clause 2 or the entry has been made in the register, the patentee shall not grant any exclusive license to any other person.

Clause 4

Where a request has been received, the competent officer shall examine the documents and evidence submitted to support the request. Where it does not appear that the request sets any conditions for the granting of licenses or the patentee or the owner of the petty patent has granted any exclusive license, the competent officer shall submit his report to the Director-General. In case where there are joint owners of the patent or petty patent and all joint owners have indicated their consents to grant licenses to any ³⁴ other person, the competent officer shall record such consents in the request before submitting his report to the Director-General.

Clause 5

When the Director-General has approved an entry into the register to the effect that any other person may obtain a license, the competent officer shall make such an entry in the patent register or the petty patent register and notify the patentee of the decision and also publish the entry in an open area within the Department of Intellectual Property, Ministry of Commerce, for at least thirty days.

Clause 6

Any person who wishes to obtain a license under any patent or petty patent in respect of which an entry is made shall file an application in the form prescribed by the Director-General to the competent officer or send by a registered mail to the competent officer at any of the following places: (1) the Department of Intellectual Property, Ministry of Commerce; (2) any provincial commercial office or governmental office prescribed by the Director-General. The application for a license under the first paragraph shall set forth the proposed conditions, the restrictions on the rights and the amount of remuneration.

Clause 7

Within thirty days following the receipt of the application for a license, the competent officer shall notify the patentee or the owner of a petty patent of such application in writing and also send to him a copy of the application, and instruct him to respond in writing whether or not he agrees to the conditions, restrictions and amount of remuneration proposed by the applicant within ninety days following the receipt of the notification.

Clause 8

In cases where the patentee or the owner of a petty patent agrees to the conditions, restrictions and amount of remuneration proposed by the applicant, the Director-General shall grant a license under such conditions, restrictions and amount of royalty, and the competent officer shall notify the applicant and the patentee or the owner of a petty patent of the decision.

Clause 9

If no agreement is reached by the patentee or the owner of a petty patent and the applicant, either because the patentee or the owner of a petty patent disagrees to the conditions, restrictions and amount of remuneration proposed by the applicant or it appears that the patentee or the owner of a petty patent has received the notification from the competent officer but fails to respond within the period prescribed in Clause 7, the Director-General shall instruct the patentee or the owner of a petty patent and the applicant to reach an agreement within the period prescribed by the Director-General. In cases where both sides fail to reach an agreement within the prescribed period, the Director-General shall grant a license to the applicant and fix the conditions, restrictions and amount of remuneration as he deems appropriate, taking into account the following matters: (1) the importance of the invention; (2) the status and nature of business of the applicant; (3) the conditions, restrictions and amount of remuneration fixed for other licenses; (4) the benefits to be derived by the licensee from the invention; (5) the benefits derived or expected to be derived by the patentee from the

invention; (6) the conditions, restrictions and remuneration as fixed by the Board of Patents in its decisions.

Clause 10

Where an entry is made to the patent register or the petty patent register to the effect that any person may obtain license, the annual fees in respect of the patent or the petty patent register after the date of entry shall be reduced by one-half.

Clause 11

Any person who wishes to obtain a license pursuant to Section 46 or Sections 65decies and 46 shall file an application in the form prescribed by the Director-General with the competent officer or send by a registered mail to the competent officer at any of the following places: (1) the Department of Intellectual Property, Ministry of Commerce; (2) any provincial commercial office or governmental office prescribed by the Director-General. In applying for a license under the first paragraph, the applicant shall: (1) file evidence to show that, within three years following the grant of the patent or petty patent, the patented product has not been produced³⁶ or the patented process has not been applied in the country without any legitimate reason, or no product produced under the patent or petty patent is sold in any domestic market or that such a product is sold but at

unreasonably high prices or does not meet the public demand, without any legitimate reason; (2) file evidence to show that the applicant has made an effort to obtain a license from the patentee or the owner of a petty patent, as the case may be, having proposed conditions and remuneration reasonably sufficient under the circumstances but unable to reach an agreement within a reasonable period; (3) set forth the proposed scope and duration for the exploitation of the patent or petty patent, as the case may be, with the evidence to show that it is appropriate under the circumstances; (4) set forth the proposed remuneration, conditions for the exploitation of the patent or petty patent and restrictions on the rights of the patentee or the owner of petty patent and his exclusive licensee under Section 48 paragraph two or Sections 65decies and 48 paragraph two, as the case may be, and provide relevant information as to remuneration for the exploitation of the invention for which a license is applied or comparable inventions of others; (5) provide relevant facts to show that the proposed licensing shall be aimed predominately for the supply of the domestic market; (6) file evidence showing the proposed plans for the manufacture, distribution or importation of the products covered by the patent or petty patent.

Clause 12

Any patentee or owner of a petty patent who wishes to obtain a license under the patent of another person pursuant to Section 47 or petty patent of another person under Sections 65decies and 47 shall file an application in the form prescribed by the Director-General with the competent officer or send by a registered mail to the competent officer at any of the following places: (1) the Department of Intellectual Property, Ministry of Commerce; (2) any

provincial commercial office or governmental office prescribed by the Director-General. In applying for a license under the first paragraph, the applicant shall: (1) show by the evidence that: (a) the invention of the applicant involves an important technical advance of considerable economic significance in relation to the invention for which the license is applied; 37 (b) the patentee or the owner of a petty patent shall be entitled to a cross-license on reasonable terms; (c) the applicant shall not assign his right in the license to other persons except with the assignment of his patent or petty patent; (2) propose remuneration, conditions for the exploitation of the patent or petty patent and restrictions on the rights of the patentee or the owner of a petty patent and his exclusive licensee under Section 48 paragraph two or Section 65decies and 48 paragraph two, as the case may be; (3) agree to cross-license his patent or petty patent to the patentee or the owner of a petty patent; (4) show by the evidence that he has made an effort to obtain a license from the patentee or the owner of a petty patent, having proposed remuneration and conditions reasonably sufficient under the circumstances but it was unable to reach an agreement in a reasonable period.

Clause 13

Any patentee or owner of a petty patent who wishes to obtain a license under a patent of another person under Section 47bis or petty patent of another

person under Sections 65decies and 47bis, as the case may be, shall file an application in the form prescribed by the Director-General with the competent officer or send by a registered mail to the competent officer at any of the following places: (1) the Department of Intellectual Property, Ministry of Commerce; (2) any provincial commercial office or governmental office prescribed by the Director-General. In applying for a license under the first paragraph, the applicant shall: (1) show by the evidence that: (a) the invention of the applicant involves an important technical advance of considerable economic significance in relation to the invention for which the license is applied; (b) the applicant shall not assign his right in the license to other persons except with the assignment of his patent or petty patent; (2) propose remuneration, conditions for the exploitation of the patent or petty patent and restrictions on the rights of the patentee or the owner of a petty patent and his exclusive licensee under Section 48 paragraph two or Section 65decies and 48 paragraph two, as the case may be; (3) show by the evidence that he has made an effort to obtain a license from the patentee or the owner of a petty patent, having proposed remuneration and conditions reasonably sufficient under the circumstances but it was unable to reach an agreement in a reasonable period.

Clause 14

Where the Director-General has ordered that a license be granted and the applicant has paid the fees, the competent officer shall issue a licensing certificate to the applicant and record the details of such license in the register of patents or petty patents. In the case where an appeal against the decision of the Director-General to the Board of Patents is made by any

party, when the Board has made a decision and granted a license to the applicant and the fees paid by the applicant, the competent officer shall issue a licensing certificate to the applicant and record the details of such license in the register of patents or petty patents. In the case where an appeal against the decision of the Board to the court is made by any party, when the court has rendered a judgement granting a license to the applicant and he has paid the relevant fees, the competent officer shall issue a licensing certificate to the applicant and record the details of such license in the register of patents or petty patents.

Clause 15

The licensing certificate shall be in Form PI/201-B and PP/201-B annexed to these Ministerial Regulations.

Clause 16

The patentee, the owner of a petty patent, the exclusive licensee under Section 48 paragraph two or Sections 65decies and 48 paragraph two, as the case may be, may submit a request for the termination of the license granted by the reasons under Section 46 or Section 65decies and 46 in the form prescribed by the Director-General to the competent officer or by a registered mail to the competent officer at any of the following places: (1) the Department of Intellectual Property, Ministry of Commerce; (2) any provincial commercial office or governmental office prescribed by the Director-General. In submitting the request under the first paragraph, the applicant shall show by evidence the following: (1) the circumstances that

led to the grant of the license has ceased to exist and are unlikely to recur; and (2) the termination of the license would not affect the rights and interests of the licensee under the license.

Clause 17

When the Director-General has ordered the termination of a licensing 39 certificate, the competent officer shall, without delay, notify the patentee, the owner of a petty patent, the licensee under Section 38 or Section 65decies and 38.

Clause 18

In the case where an appeal is not made by any party or where an appeal is made but the Board has given a final decision or the court has rendered a final judgement to terminate the licensing certificate, the competent officer shall record such termination in the register of patents or petty patents.

Clause 19

The request for the recordation of consent to the effect that any person may obtain a license, the application for and grant of licensing certificate under Section 45, 46, 46bis, 47 or 50 approved or issued before the entry into force of the Patent Act (No. 3) B.E. 2542 shall comply with the procedures, rules and conditions set forth in the Ministerial Regulations No. 14 (B.E. 2535) issued under the Patent Act B.E. 2522.

Given on September 24, 1999