

PATENTS SNAPSHOT

Asia Pacific



SPRUSON & FERGUSON

INTELLECTUAL PROPERTY



- Jurisdictions with physical offices and/or direct filing
- Other jurisdictions serviced

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PATENTS SNAPSHOT SUMMARY

JURISDICTION	PATENTABLE SUBJECT MATTER						DOUBLE PATENTING	OPPOSITION		PTE	FOREIGN FILING LICENSE	PARALLEL IMPORTS		DATA EXCLUSIVITY FOR NCE (YEARS)	PATENT-DRUG LINKAGE	ASPEC	PPH
	Compound	First Medical Use	Second Medical Use	Method of Treatment	Computer Programs	Business Method		Pre-grant	Post-grant			All Products	All Except Pharmaceuticals				
AUSTRALIA	✓	✓	✓	✓	✓	✗	✗	✓	✗	✓	✗	✗	✗	✓ (5)	✗	✗	EPO, GPPH
BANGLADESH	✓	✗	✗	✗	✗	✗	✗	✓ (Time-limited)	✗	✓	✗	✗	✗	✗	✗	✗	-
BRUNEI	✓	✓	✓	✗	✓	✓	✗	✗	✗	✓	✓	-	✓	✗	✓	✓	-
CHINA	✓	✓	✓	✗	✗	✗	✗	✗	✗	✗	✓	✓	-	✓ (6)	✓	✗	JP, US, DE, KR, RU, FI, DK, AT, MX, PL, CA, SG, MY, PT, ES, EPO, GB, SE, IL, HU, IS, EG, IP5
HONG KONG	✓	✓	✓	✗	✓ (**)	✗	✓	✗	✗	✗	✗	✗	✗	✗	✗	✗	-
INDIA	✓	✗	✗	✗	✗	✗	✗	✓	✓	✗	✓	✓	-	✗	✗	✗	-
INDONESIA	✓	✓	✗	✗	✗	✗	✗	✓	✓	✗	✗	✓	-	✗	✓	✓	JP
MALAYSIA	✓	✓	✓	✗	✓	✗	✗	✗	✗	✗	✓	✓	-	✓ (5)	✗	✓	JP, CN, EPO
MONGOLIA	✓	✓	✓	✗	✗	✗	✗	✓	✓	✗	✗	✓	-	✗	✗	✗	-
NEPAL	✓	✓	✓	✓	✓	✓	✗	✗	✓	✗	✗	✗	✗	✗	✗	✗	-

JURISDICTION	PATENTABLE SUBJECT MATTER						DOUBLE PATENTING	OPPOSITION		PTE	FOREIGN FILING LICENSE	PARALLEL IMPORTS		DATA EXCLUSIVITY FOR NCE (YEARS)	PATENT-DRUG LINKAGE	ASPEC	PPH
	Compound	First Medical Use	Second Medical Use	Method of Treatment	Computer Programs	Business Method		Pre-grant	Post-grant			All Products	All Except Pharmaceuticals				
NEW ZEALAND	✓	✓	✓	✗	✗	✗	✗	✓	✓	✗	✗	-	✓	✓ (5)	✗	✗	GPPH
PAKISTAN	✓	✗	✗	✗	✗	✗	✗	✓ (Time-limited)	✗	✗	✓	✗	✗	✗	✗	✗	-
PAPUA NEW GUINEA	✓	✓	✓	✗	✓	✗	✓	✓	✗	✗	✗	✓	-	✗	✗	✗	-
PHILIPPINES	✓	✓	✓(*)	✗	✗	✗	✗	✗	✗	✗	✗	✓	-	✓ (2-5)	✗	✓	US, KR, JP, EPO
SINGAPORE	✓	✓	✓	✗	✓	✓	✗	✗	✗	✓	✓	-	✓	✓ (5)	✓	✓	CN, MX, EPO, GPPH
SOUTH KOREA	✓	✓	✓	✗	✓	✗	✓	✗	✓	✓	✗	✓	-	✗	✓	✗	MX, PH, TW, VN, IP5, GPPH
SRI LANKA	✓	✓	✓	✗	✗	✗	✗	✗	✗	✗	✗	✓	-	✗	✗	✗	-
TAIWAN	✓	✓	✓	✗	✓	✓	✗	✗	✗	✓	✗	✓	-	✓ (5)	✓	✗	US, JP, ES, KR
THAILAND	✓	✓	✓	✗	✗	✓	✗	✓	✗	✗	✗	✗	✓	✗	✗	✓	JP
VIETNAM	✓	✗	✗	✗	✗	✗	✗	✓	✓	✗	✗	✓	-	✓ (5)	✗	✓	JP, KR

* See page 34 under patentable subject matter for further information. | ** In certain circumstances, software is patent eligible.

AUSTRALIA



Capital: Canberra

Population: 25,466,459 (July 2020 est.)

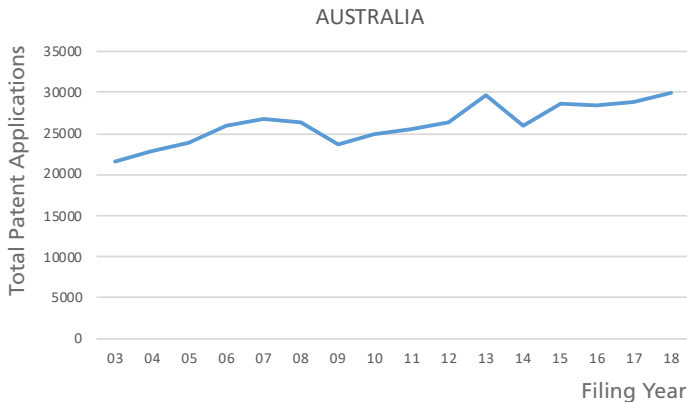
Languages: English

Area: 7,741,220 km²

Currency: Australian Dollar (AUD)

Legal System: English common law

FILING STATISTICS



Source: WIPO statistics database, March 2020
IP Australia, March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Ranked 11th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Enforceable jurisdiction
- > Potential for alternative dispute resolution in IP matters via arbitration, mediation, settlement
- > Infringement remedies – damages, account of profits and injunctions
- > Innocent infringer defence
- > Potential relief against groundless threats

Prosecution

- > National phase entry deadline for PCT applications in Australia: 31 months
- > Patentable subject matter – all subject matter is generally patentable except human beings and biological processes for their generation. Subject matter must result in an “artificially created state of affairs” in a “field of economic endeavour.” Mere schemes, plans or pure business methods have been found not to satisfy this test. For a computer-implemented invention, a technical contribution (a technical solution to a technical problem) is required
- > New description and support requirements introduced in 2013. Courts are taking guidance from UK and EPO decisions

- > Acceptance deadline 12 months (non-extendable) from date of first examination report
- > Generous extension of time provisions where a deadline cannot be met due to an error or omission beyond the Applicant's control, including national phase entry
- > Amendments allowed at any time, including after acceptance (provided that no new matter is claimed and claims remain supported)
- > Voluntary Divisional applications possible
- > Excess claim fees apply for claims in excess of 20 at acceptance
- > 12 month grace period for disclosures

Other issues

- > Pre-grant opposition available
- > Experimental use exceptions
- > Patent Term Extensions – possible
- > Pathways for the approval of biosimilars – available
- > Parallel importation – complex issue, but may be possible under certain conditions. Legislation amendments to clarify are currently under consideration.
- > Foreign filing license not required
- > Pharmaceutical Data Exclusivity Laws – data exclusivity (5 years) likely to be repealed
- > PPH with EPO
- > Member of the Global PPH

BANGLADESH



Capital: Dhaka

Population: 162,650,853 (July 2020 est.)

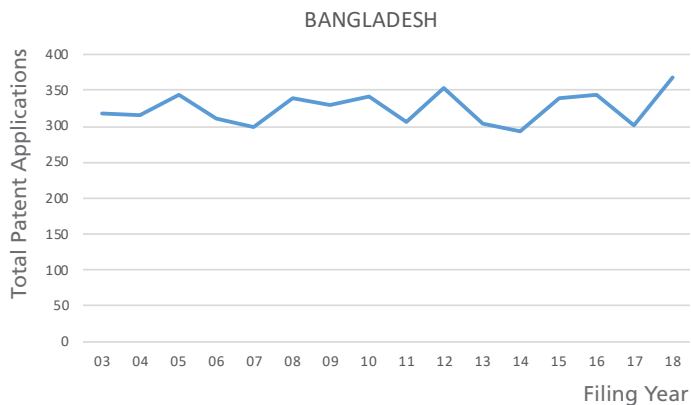
Languages: Bangla (official) and English

Area: 148,460 km²

Currency: Taka (Tk.)

Legal System: English common law

FILING STATISTICS



Source: WIPO statistics database, March 2020
Department of Patents, Designs and Trade Marks (DPDT), March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Ranked 100th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Patent can be effectively enforced in courts
- > During proceedings, a court may appoint an independent scientific advisor
- > Disputes may be settled via alternative dispute resolution (ADR)
- > Infringement remedies – damages, account of profits and injunctions
- > Innocent infringer defence
- > Potential relief against groundless threats

Prosecution

- > Patentable subject matter – any manner of new manufacture or improvement
- > Use claims are not allowed
- > Amendments to the claims are allowed during prosecution and substantive examination
- > Applies a strict approach to “added matter” when making amendments

- > Voluntary divisional applications are possible only before an application is taken up for substantive examination. Once an examination report is issued, a divisional application can be filed only if an examiner objects to the unity of invention.

Other issues

- > Not a PCT contracting State
- > Opposition after acceptance and before grant
- > Patents of addition is possible in respect of any improvement in or modification of an invention
- > Patent term extension possible at the discretion of the Government
- > Compulsory licensing may be applied when the demand for a patented article in Bangladesh is not being met to an adequate extent and on reasonable terms

BRUNEI



Capital: Bandar Seri Begawan

Population: 464,478 (July 2020 est.)

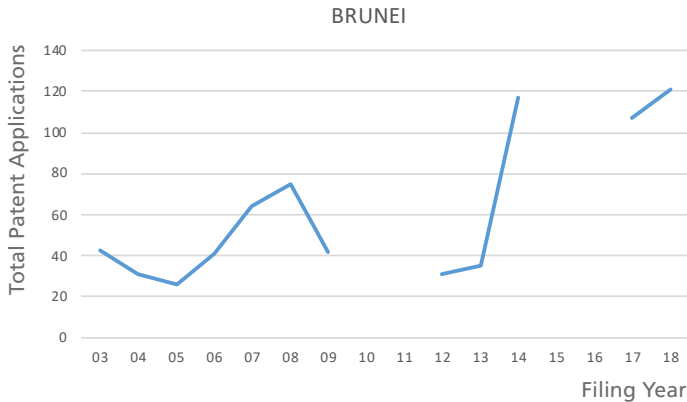
Languages: Malay (official), English, Chinese

Area: 5,765 km²

Currency: Bruneian dollar (BND)

Legal System: English common law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Ranked 62nd in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Moved to a regular direct filing country on 1 January 2012. Prior to 1 January 2012, Brunei patents were obtained via re-registration of a Singapore, Malaysia or United Kingdom patent
- > Limited patent cases to date
- > Infringement remedies – damages based on costs or an account of profits, injunctions, and delivery up
- > Innocent infringer defence
- > Potential relief against groundless threats

Prosecution

- > National phase entry deadline for PCT applications in Brunei: 30 months
- > Patentable subject matter – all subject matter patentable except methods of treatment of the human or animal body by surgery or therapy or of diagnosis; or inventions that may encourage offensive, immoral or anti-social behaviour

- > Patent obtained by one of three ways:
 - Requesting local search and examination
 - Requesting examination based on a search report (which includes an international search report) from an approved jurisdiction
 - On the basis of final examination results received in an approved jurisdiction
- > Applies a strict approach to “added matter” that is in alignment with the approach of the European Patent Office
- > Double patenting is a ground of revocation
- > Voluntary Divisional applications possible

Other issues

- > No pre or post-grant opposition
- > Patent Term Extensions – possible
- > Parallel importation – available except for pharmaceuticals under certain conditions
- > Foreign filing license – required and breach is a criminal offence
- > Patent-drug linkage
- > Participant in the ASEAN Patent Examination Co-operation (ASPEC)
- > The term of Brunei patents obtained by re-registration is 20 years from the date of grant of the UK, Malaysia or Singapore patent

CHINA



Capital: Beijing

Population: 1,394,015,977 (July 2020 est.)

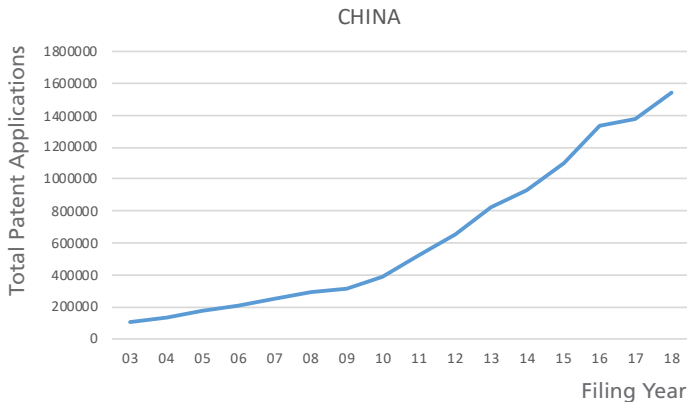
Languages: Mandarin (simplified characters)

Area: 9,596,960 km²

Currency: Chinese Yuan (CNY)

Legal System: Codified law

FILING STATISTICS



Source: WIPO statistics database, March 2020

China National Intellectual Property Administration (CNIPA), March 2020

KEY ISSUES

- > High number of patent filings (1.542 million in 2018) with double digit growth rates
- > The high and growing number of patent law suits filed in the last year demonstrates the importance of China as now being one of the world's major IP jurisdictions. Moreover, Chinese businesses have in recent years transitioned from being "participators" of the IP system to being "adopters" as demonstrated by the vast majority of IP law suits being filed in China which relate to domestic Chinese parties
- > Ranked 53rd in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

ENFORCEMENT

- > In a strategic move by the central government towards becoming an innovation country, notable improvements in IP enforcement have been observed
- > Problems with evidence preservation and a lack of support by the Courts in this regard as well as cumbersome formality requirements remain an issue in patent litigation*
- > While the conclusion of litigation proceedings can be rapid, preparation for litigation requires more efforts and strategic considerations than in other jurisdictions
- > Enforceability of court decisions is challenging, particularly if a small-size defendant tries to evade it*
- > Infringement remedies – damages based on infringer's gain, patentee's loss or established royalty, however often limited to statutory amounts (less than USD 160,000)*

- > Treble damages are considered in the currently pending 4th amendment of the patent law
- > Preliminary injunctions are still difficult to obtain in patent cases, although progress has recently been noted*

PROSECUTION

- > National phase entry deadline for PCT applications in China: 30 months (Extendible by 2 months for fee; translation needs to be finalised)
- > Patentable subject matter – exclusions include methods of treatment and diagnosis of the human and animal body as well as animal and plant varieties
- > Strict examination standards, for instance with regard to
 - Allowable subject matter for protection in the field of bio technology
 - Data support requirements both in view of insufficient disclosure and broadness of claims in examination (e.g. biological testing data)*
 - Proof of presence of an inventive step in the area of pharmaceuticals or other life sciences*
 - Limitations on allowable “added matter” (standard is similar with the approach of the European Patent Office)
- > Double patenting is a ground of revocation
- > Voluntary Divisional applications - possible within limitations

- > Utility model patent and design patent protection are possible:
 - No substantial examination, only check for obvious novelty deficiencies without search or indicators of bad faith applications
 - Granted within 6 - 9 months providing protection for a maximum of 10 years
 - Patentability will be checked during enforcement; lower inventive step requirements for utility model patents than invention patents
 - No protection for methods or processes by utility model patents

OTHER ISSUES

- > No pre or post-grant opposition
- > Significant restrictions for making amendments in an invalidation procedure
- > Patent Term Extensions – not yet, but under discussion for innovative drugs*
- > Highly relevant new regulations are upcoming for the pharma industry relating to the establishment of a more effective patent linkage, data protection and “orange book”-type regime*
- > Secrecy Examination before foreign filing for all inventions completed in China
- > Invention patent protection is important in pricing and bidding procedures in certain regulated areas (e.g. pharmaceuticals)
- > Parallel importation – no patent infringement

- > Pharmaceutical Data Exclusivity Laws – test data protection of 6 years against reliance on data submitted by the original applicant, under current reform to increase effectiveness and amend the scope
- > Patent-drug linkage – Requirement for generics to make declarations about relevant patents which would be prohibitive to registration before patent expiry, also under current reform to make it effective and define further links to the patent law
- > PPH agreements with Japan, US, Germany, Russia, Finland, Denmark, Mexico, Austria, Korea, Poland, Canada, Singapore, Malaysia, Portugal, Spain, United Kingdom, Sweden, Iceland, Israel, Hungary, Egypt and IP5 (EPO, USPTO, JPO, KIPO, SIPO)

* These issues are addressed for changes in the US-China Trade agreement of January 2020 and the laws & practice may change

HONG KONG



Population: 7,249,907 (July 2020 est.)

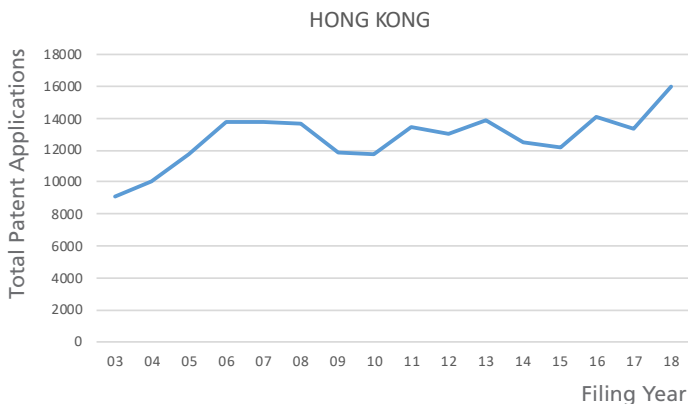
Languages: Chinese (official), English (official)

Area: 1,108 km²

Currency: Hong Kong Dollar (HKD)

Legal System: Based on English common law, supplemented by local legislation, separate from the People's Republic of China

FILING STATISTICS



Source: WIPO statistics database, March 2020

Intellectual Property Department (IDP) Hong Kong, March 2020

KEY ISSUES

- > Hong Kong patent rights must be pursued separately from mainland China (PRC)
- > Short-term patent system and original grant patent (OGP) system for grant of short-term patents and standard patents as direct filings with or without a claim of priority
- > Re-registration system for grant of standard patents designating from UKIPO, EPO and CNIPA
- > Ranked 5th in the world for having the best IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > An enforceable jurisdiction based on United Kingdom common law
- > Enforcement of patent rights against mainland China imports and exports that transit through Hong Kong is possible
- > Litigation is rare and there is no specialised IP court
- > Disputes are usually settled before trial or fought in mainland China; arbitration is effective in the handling of IP disputes
- > Infringement remedies: injunction, an order for delivery up of goods, damages or an account of profits
- > Legal remedy against groundless threats of infringement proceedings is available

- > Although Hong Kong patent rights do not extend into mainland China, it is possible to enforce Hong Kong arbitration awards and Court judgments in Chinese courts against Hong Kong infringers
- > Post registration amendments of standard patents is normally possible under certain circumstances
- > Substantive examination may be outsourced to the CNIPA
- > Restoration of a priority right may be allowed if an application is filed within 2 months after the expiry of the 12-month priority period

Prosecution

- > Substantive examination is required for the grant of a standard patent under the OGP system. Substantive examination must be filed within 3 years from the filing date or the earliest priority date
- > Hong Kong short-term patent applications undergo formality examination only
- > Search of short-term patent applications is conducted by the CNIPA in China
- > Identical-type double patenting is not allowed, i.e. if two claims are identical in scope or identical in substance
- > No patent term extensions possible

Other issues

- > Although there is no substantive examination for a short-term patent application before its grant, the short-term patent will be subject to post-grant substantive examination as a prerequisite to enforcement
- > Parallel importation of patented goods is prohibited
- > There is no patent-drug linkage in Hong Kong
- > Short-term patents can be granted within a very short time period (6-15 months)

INDIA



Capital: New Delhi

Population: 1,326,093,247 (July 2020 est.)

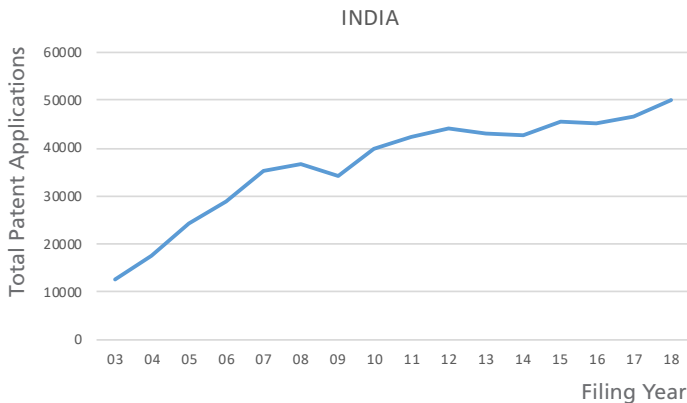
Languages: Hindi and English as official languages and 15 additional recognised regional languages

Area: 3,287,263 km²

Currency: Indian rupee (INR)

Legal System: English common law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in English or Hindi
- > Ranked 57th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Specialized courts for patent enforcement are not available. However, the Intellectual Property Appellate Board (IPAB) is available to hear appeals against decisions made by the Indian Intellectual Property Office (IPO). District courts are the Courts of first instance while the Indian High Courts hear the appeals from decisions of the District courts with a further appeal to the Supreme Court
- > The reliefs that a court may grant in a patent infringement suit include an injunction and, at the option of the plaintiff, either damages or an account of profits. The court may also order for the seizure and destruction of any infringing products
- > Infringement proceedings can take 2 to 3 years while revocation proceedings can take between 1 to 2 years
- > After the grant of an Indian patent, Patentees indicate whether or not the patent is being worked in India. Non-working of the patent in India allows third parties to request for a compulsory licence

Prosecution

- > National phase entry deadline for PCT applications in India: 31 months (not extendable)
- > Prosecution of an Indian patent applicant takes approximately about 3.5 to 5 years
- > Within 6 months after filing of an Indian patent application, and during further prosecution, the Applicant needs to update the Indian patent office regularly about the status of patent applications referring to the same invention filed in countries outside India (Section 8(1)). Non-compliance with this requirement can lead to revocation if the Court finds that the omission to supply the information was deliberate and the information not submitted was material to the grant of a patent
- > There are a number of exclusions to patentable subject matter in India. The list of non-patentable subject matter (Section 3) relates to:
 - Frivolous or contrary to well established natural laws
 - Invention against public order
 - Discovery of a scientific principle or formulation of an abstract theory
 - Discovery of new form of a known substance which does not result in enhancement of any efficacy, any new property or new use for a known substance or mere new use of a known process, machine or apparatus
 - Substance obtained by mere admixture
 - Mere arrangement or re-arrangement or duplication of known devices
 - Method of agriculture or horticulture
 - Process for medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or animals
 - Plants and animals in whole or any part thereof other than micro-organisms
 - A computer program per se, other than its technical application to industry
 - A mathematical method or business method, algorithms
 - A literary, dramatic, musical or artistic work or any other aesthetic creation
 - Scheme or rule or method of performing mental act or method of playing game
 - Topography of integrated circuits
 - Traditional knowledge
 - A presentation of information
 - Invention relating to atomic energy and inventions prejudicial to the interest of security of India
- > Excess claim fees are payable at national phase entry and are calculated according to the number of claims mentioned in the IPRP as published in the international phase. The excess claim fees can be reduced by cancellation of claims. However, cancellation of claims will be regarded as giving up the cancelled subject matter for the further prosecution, i.e. such subject matter cannot be reintroduced during a later time of the prosecution or when filing a divisional application

- > Request for examination deadline: 48 months from earliest priority date
- > 6 month deadline for putting application in order for grant after receipt of the First Examination Report which is extendable once by 3 months. After the end of the 6 month period for putting the application in order for grant, the Indian patent office often invites the Applicant to attend an oral hearing. Any outstanding objections are usually addressed and should be resolved during this oral hearing. The date for the oral hearing can be adjourned twice for one month
- > First Examination Report also often requires Applicant to provide patent office with copies of granted patents and the respective claims as well as latest office actions of and pending claims of other corresponding applications (Section 8(2)). Non-compliance is a ground for revocation
- > Renewal fees need to be paid only upon grant of an Indian patent. Back annuities need to be paid upon grant of a patent
- > The claims of a national phase application in India cannot be amended during prosecution beyond the scope of the claims as filed at the time of national phase entry. For example, if the claims at the time of national phase entry only contain method claims, it cannot be amended after national phase entry in India to also include product claims. Another example: a product claim claiming a compound with scope A can be refused in case the Examiner is of the opinion that the scope of an amended claim directed to A+ is not covered by the claims scope as filed at the time of national phase entry

Other issues

- > Pre or post-grant opposition exists
- > No Patent Term Extensions
- > Foreign filing license required
- > 18 month deadline for restoration of lapsed patent

INDONESIA



Capital: Jakarta

Population: 267,026,366 (July 2020 est.)

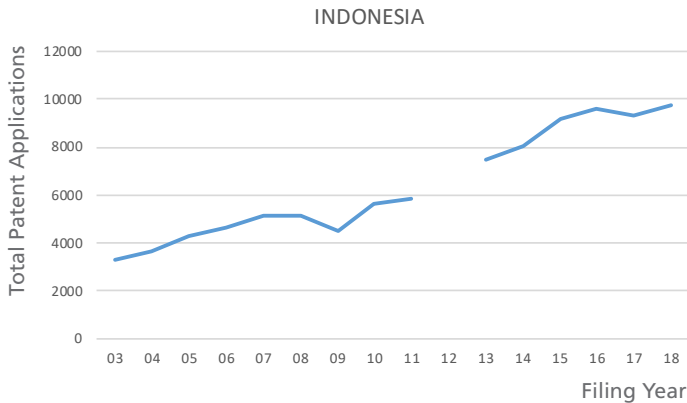
Languages: Bahasa Indonesia (official) & English

Area: 1,904,569 km²

Currency: Rupiah (IDR)

Legal System: Civil law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in Bahasa Indonesia
- > Ranked 51st in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Penal provisions – Deliberate patent infringement is a criminal offence punishable by imprisonment and/or a fine
- > Available remedies include injunctions, and if the infringement was deliberate, damages may be awarded
- > It is possible to obtain preliminary injunctions for restraint of continuing infringement
- > Alternative dispute resolution is available by arbitration
- > The following acts are excluded from patent infringement (either civil or criminal):
 - Importation of a pharmaceutical product which is patented in Indonesia, and the product is legally marketed in another country without the permission of the patent owner.
 - Manufacturing of a pharmaceutical product which is patented in Indonesia within five years before the patent protection expires, for the purpose of licensing and marketing after the patent protection of the patent expires.

Prosecution

- > National phase entry deadline for PCT applications in Indonesia: 31 months
- > Non-patentable subject matter – Methods of treatment of the human or animal body, inventions that may encourage offensive, immoral or anti-social behaviour, scientific / mathematical theories or methods, all living creatures (except micro-organisms), biological processes which are essential in producing plants or animals, and discoveries (new use of a known product and/or new form of an existing compound which does not offer significant increase in efficacy - second use and second medical use)
- > Voluntary divisional applications possible as long as original parent application has not been withdrawn, abandoned or granted
- > Substantive examination - The substantive examination period for a patent application is 30 months from the filing of the request for examination. Upon issuance of an examination report, the Applicant has three months to respond (extendable by up to three more months)

Other issues

- > Pre-and post-grant opposition available
- > Participant in the ASEAN Patent Examination Co-operation (ASPEC)
- > Compulsory license – If within 36 months from grant, a patent has not been implemented in Indonesia or only partially implemented by the patent holder, a third party may file a request for a compulsory license
- > PPH with Japan

MALAYSIA



Capital: Kuala Lumpur

Population: 32,652,083 (July 2020 est.)

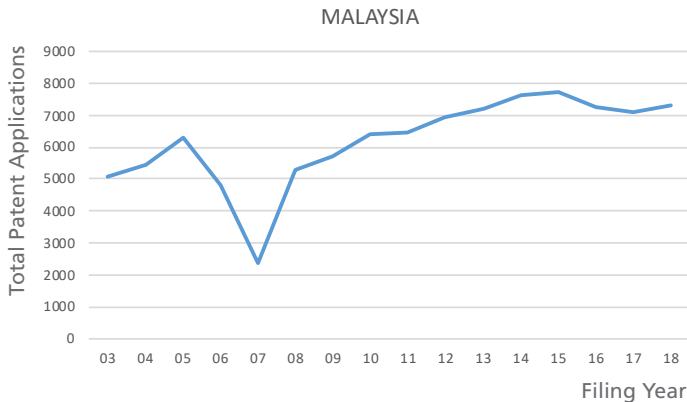
Languages: Malaysian (official), English, Chinese, Tamil

Area: 329,847 km²

Currency: Malaysian Ringgit (MYR)

Legal System: English common law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in Malay or English
- > Ranked 25th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Specialized IP Court for hearing IP-related cases
- > An enforceable jurisdiction that heavily relies on technical expert testimony
- > Relatively rapid conclusion of litigation proceedings with decisions typically issued within 12 to 18 months of initiation
- > Potential for alternative dispute resolution in IP matters via arbitration
- > "Imminent infringement" action available against any person who has performed acts which make it likely that infringement will occur
- > Infringement remedies - damages based on costs or an account of profits, injunctions, and delivery up and destruction of the infringing goods
- > Declaration of non-infringement available
- > Infringement actions may not be instituted after five (5) years from the act of infringement

Prosecution

- > National phase entry deadline for PCT applications in Malaysia: 30 months
- > Late national phase entry is at the discretion of the Registrar and the Applicant must show that the late national phase entry was unintentional
- > Patentable subject matter – all subject matter patentable except:
 - discoveries, scientific theories and mathematical methods
 - plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living microorganisms, microbiological processes and the products of such micro-organism processes
 - schemes, rules or methods for doing business, performing purely mental acts or playing games
 - methods for treatment of human or animal body by surgery or therapy, and diagnostic methods practiced on the human/animal body
 - inventions contrary to public order or morality
 - inventions prejudicial to the interest or security of the nation
- > Full Substantive Examination or Modified Substantive Examination routes available. Under Modified Substantive Examination, the grant of a corresponding patent application in Australia, Japan, The Republic of Korea, the U.K., the U.S., or at the EPO can be relied on for grant in Malaysia however care must be taken to ensure compliance with Malaysian laws
- > Expedited examination available on the following grounds: in national/public interest, there is on-going or potential infringement proceedings, the applicant has already commercialized the invention or intends to do so within two years, the invention relates to green technologies, and to meet conditions for obtaining monetary funds/benefits from the government or recognized institutions
- > Applies a strict approach to “added matter” that is in alignment with the approach of the UK and European Patent Offices
- > Double patenting is a ground of refusal to grant a patent
- > Voluntary divisional applications possible
- > Serial divisional applications possible
- > Grace period (12 months) available for prior disclosure by applicant, or due to abuse of rights of the applicant
- > Grace period (6 months) available for paying overdue renewal fees
- > The deadline to request a reinstatement of a lapsed patent is 2 years from the date of publication of the notice of patent lapse. The patent owner must show that the non-payment of renewal fees was due to accident, mistake or other unforeseeable circumstances
- > No provisions for submitting a General Power of Attorney in Malaysia and a specific Power of Attorney (Patents Form no. 17) is required for each application

Prosecution (continued)

- > A “utility innovation” patent is also available in addition to patent protection. A utility innovation:
 - does not require inventive step assessment
 - only allows one claim
 - is granted for a period of ten years from the filing date, but may be extendible for two consecutive five-year periods

Other issues

- > No pre or post-grant opposition; only post-grant patent invalidation available
- > Patent Term Extensions – not available
- > Parallel importation – available
- > Foreign filing license – required
- > Pharmaceutical Data Exclusivity Laws – data exclusivity (5 years for a new drug product containing a New Chemical Entity; 3 years for a secondary indication of a registered drug product)
- > No patent-drug linkage
- > Participant in the ASEAN Patent Examination Co-operation (ASPEC)
- > PPH with Japan, China and EPO

MONGOLIA

Capital: Ulaanbaatar

Population: 3,168,026 (July 2020 est.)

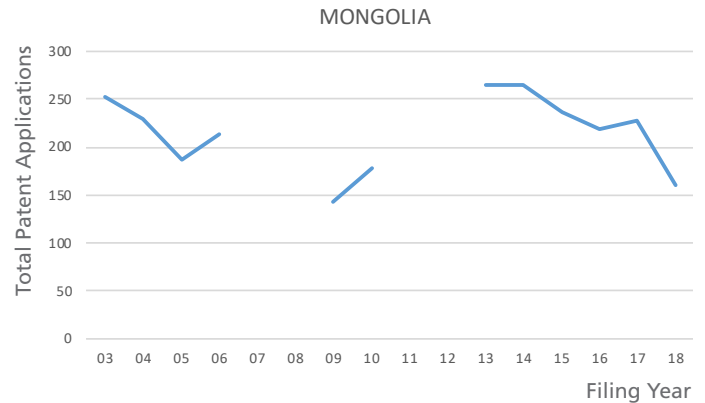
Languages: Mongolian

Area: 1,564,116 km²

Currency: Tögrög (MNT)

Legal System: Civil law system influenced by Soviet and Romano-Germanic legal systems

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > Ranked 131st in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Enforcement is a difficult task in Mongolia
- > Arbitration may be an alternative dispute resolution route however there are loss of trade secret issues due to lack of confidentiality obligations being applied to parties involved in the arbitration proceedings
- > For violation of patent legislation, administrative sanctions may be imposed, including fines of up to six (6) times the monthly salary of a violator and arrest for 7 to 14 days
- > A court will award compensation for damages for infringement of patent rights

Prosecution

- > National phase entry deadline for PCT applications in Mongolia: 31 months
- > Patentable subject matter – all subject matter patentable except:
 - a discovery, scientific theory or mathematical method
 - a computer program, algorithm
 - a scheme, rule or method for performing mental act, playing game or doing business
 - a solution contrary to public order or morality, or which is prejudicial to environment or human health

- a diagnostic or therapeutic method for the treatment of humans or animals
 - plants and animals other than micro-organisms, and the biological processes for the production of plants and animals
- > Any patents relating to human food supply or hygiene require certificates of no identified harm to the general public

Other issues

- > Post-grant opposition is available
- > Every license agreement needs to be registered with the Mongolian Intellectual Property Office (MIPO)
- > A patent owner may request MIPO to grant a license for the exploitation of his creation to any interested person



Capital: Kathmandu

Population: 30,327,877 (July 2020 est.)

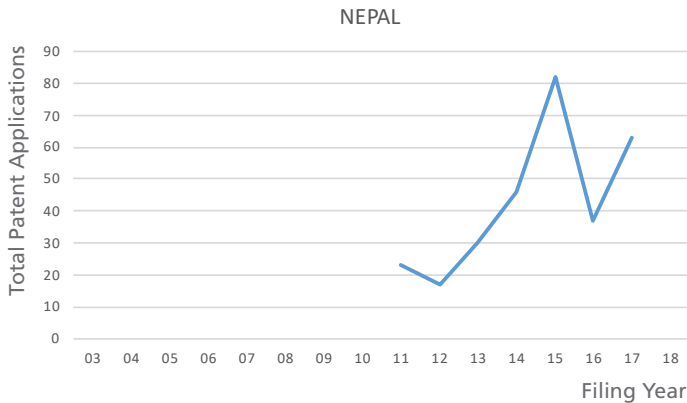
Languages: Nepali

Area: 147,181km²

Currency: Nepalese rupee (NPR)

Legal System: English common law and Hindu legal concepts

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

> Ranked 114th in the world for IP protection in the World Economic Forum’s Global Competitiveness Report 2019

Prosecution

- > Patent may be obtained for any useful invention relating to a new method of process or manufacture, operation or transmission of any material or a combination of material, or made on the basis of a new theory or formula
- > It is necessary for the applicant to submit a map and drawings together with his particulars at the time of applying for an application
- > Examination: The Department shall examine the invention to determine whether it is new and whether it is useful to the people in general
- > Publication: All registered patents, except those to be kept secret for national interest, shall be published in a journal. Interested parties can see or take a copy of the statement, drawing or sketch of a patent published in the journal or take a copy of such patent document on payment of a fee as prescribed
- > Opposition: Any complaint on any patent may be lodged to the Department within thirty-five days from the date on which the patent is seen or a copy of such patent document is taken
- > Registration Duration: 7 years from registration date

- > Renewal Duration: 7 years and can be renewed twice.
In other words, the patent proprietor may enjoy the exclusive patent rights for 21 years
- > Renewal Application: Within 35 days from the date of expiry
- > Grace Period for Renewal: Within 6 months after the expiry of the time-limit for renewal

Other issues

- > Paris Convention: Nepal is a member of the Paris Convention.
A certified copy of the convention application is required to validly claim priority

NEW ZEALAND



Capital: Wellington

Population: 4,925,477 (July 2020 est.)

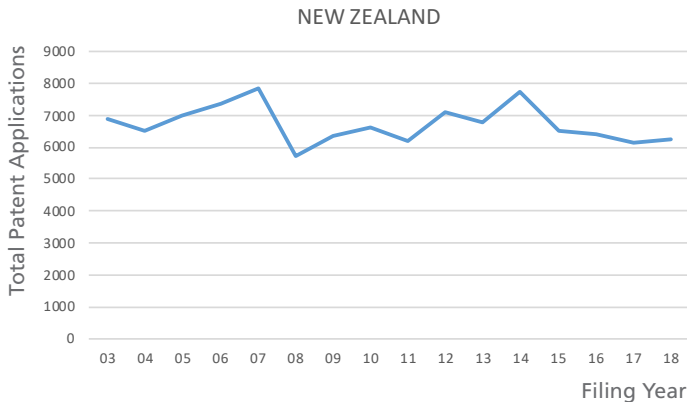
Languages: English, Māori

Area: 268,838 km²

Currency: New Zealand Dollar (NZD)

Legal System: English common law

FILING STATISTICS



Source: WIPO statistics database, March 2020
Intellectual Property Office of New Zealand (IPONZ), March 2020

KEY ISSUES

- > Litigation and prosecution may be in English or Māori
- > Ranked 10th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > An enforceable jurisdiction
- > Potential for alternative dispute resolution in IP matters via arbitration, mediation, settlement
- > Infringement remedies – damages, account of profits, injunctions
- > Innocent infringer defence
- > Potential relief against groundless threats

Prosecution

- > National phase entry deadline for PCT applications in New Zealand: 31 months
- > Patentable subject matter – all subject matter patentable except: diagnostic, therapeutic and surgical methods of treating humans; and computer programs
- > Voluntary Divisional applications possible, must be filed before acceptance of the parent
- > A new Patents Act came into force on 13 September 2014, affecting all standard applications filed on or after this date:
 - Inventive step examined alongside novelty and unity

- Acceptance deadline of 12 months (non-extendable) from date of first examination report
- Examination has to be requested within 2 months of receiving a direction, or within 5 years from the filing date
- Amendments allowed at any time, including after acceptance (provided no new matter is claimed and claims remain supported)
- Divisional applications proceed under whichever Act applies to parent
- Divisional applications proceeding under the new Act must be filed within 5 years of the filing date of the earliest application in the series
- > Extension of time only available for national phase entry and convention applications under certain conditions
- > Double patenting is strictly prohibited
- > Renewal fees payable only after grant
- > Accelerated examination available on request for “good and substantial reasons” and accompanied by evidence in support of the request
- > Member of Global PPH

Other issues

- > Pre-grant opposition and post-grant revocation before Intellectual Property Office of New Zealand (IPONZ) available
- > Patent Term Extensions – not available
- > Pathways for the approval of biosimilars - available
- > Parallel importation – available except for pharmaceuticals under certain conditions
- > Foreign filing license – no longer required under the new Act
- > Pharmaceutical Data exclusivity Laws – data exclusivity (5 years)

PAKISTAN



Capital: Islamabad

Population: 233,500,636 (July 2020 est.)

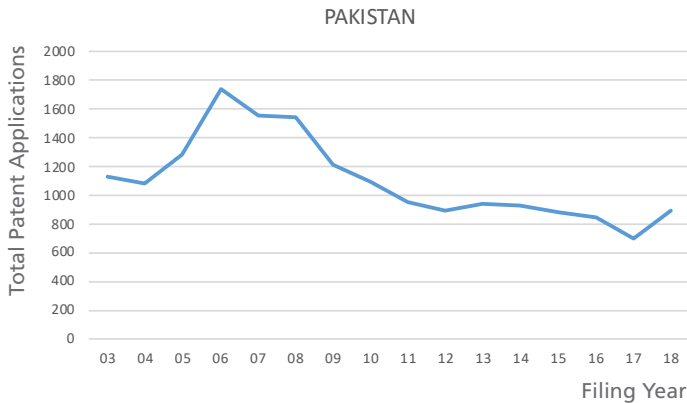
Languages: English (official) and Urdu

Area: 796,095 km²

Currency: Rupee (PKR)

Legal System: English common law and Islamic Sharia Law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Ranked 78th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Patent can be effectively enforced in courts
- > During proceedings, a court may appoint an independent scientific advisor
- > Disputes may be settled via alternative dispute resolution (ADR)
- > Infringement remedies – injunction, damages, or account of profits
- > Innocent infringer defence
- > Potential relief against groundless threats

Prosecution

- > Patentable subject matter – any new and useful product or process except:
 - a discovery, scientific theory or mathematical method
 - a literary, dramatic, musical or artistic work
 - a scheme, rule or method for performing a mental act, playing a game or doing business
 - presentation of information
 - substances that exist in nature or if isolated there from
 - prevention of commercial exploitation of invention

necessary to protect the public order or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment

- plant and animals and biological processes for the production of plants or animals
 - diagnostic, therapeutic and surgical methods for the treatment of humans or animals
 - a new or subsequent use of a known product or process
 - a mere change in physical appearance of a chemical product where chemical formula or process of manufacture remains the same and not fulfilling the criteria of patentability
- > Amendments to the claims are allowed during prosecution and substantive examination
 - > Strict approach to “added matter” when making amendments
 - > No fixed due date to respond to a substantive examination report
 - > Voluntary divisional applications possible any time before acceptance

Other issues

- > Not a PCT contracting state
- > Opposition period of 4 months after acceptance
- > For a non-convention application, a provisional specification can be filed. A complete specification must be filed within 2 months from filing the provisional specification

- > Patents of addition are possible in respect of any improvement in or modification of an invention
- > Compulsory licensing may apply on the basis of public interest, anticompetitive practice, refusal to grant license on reasonable terms, or the patent has not been exploited adequately

PAPUA NEW GUINEA



Capital: Port Moresby

Population: 7,259,456 (July 2020 est.)

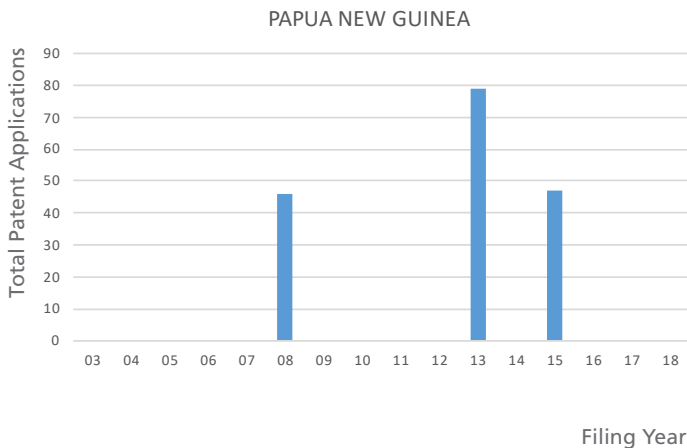
Languages: English, TokPisin (Pidgin), and HiriMotu (the lingua franca of the Papuan region)

Area: 462,840 km²

Currency: Kina (PGK)

Legal System: English common law (up to the date of independence, 16 September 1975); PNG “customary” law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Relatively new and developing patent system

Enforcement

- > Infringement remedies – damages, an account of profits and injunctions

Prosecution

- > Papua New Guinea accepts direct patent filings as well as applications filed via the PCT National Phase Entry system.
- > National phase entry deadline for PCT applications in Papua New Guinea: 31 months
- > The Patents Act expressly excludes from patentability:
 - a discovery, scientific theory or mathematical method
 - a scheme, rule or method for doing business
 - performing purely mental acts
 - playing games
 - diagnostic, therapeutic and surgical methods, but not including any products for use in any such methods, for the treatment of humans or animals
 - inventions, the commercial exploitation of which would be contrary to public order or morality; or seriously prejudice the environment

- > Applicant may rely on corresponding granted priority application, search/examination in the International Phase, a granted foreign patent (e.g. US, EP, AU, NZ, CA or GB); or request Substantive Examination (examined by IP Australia applying the PNG Patents and Industrial Designs Act)
- > Amendments allowed any time before grant with payment of fee
- > Voluntary Divisional applications possible

Other issues

- > Pre-grant opposition available
- > Patent Term Extensions – not available
- > Parallel importation – available
- > Foreign filing license not required
- > Pharmaceutical Data Exclusivity Laws – not available

PHILIPPINES



Capital: Manila

Population: 109,180,815 (July 2020 est.)

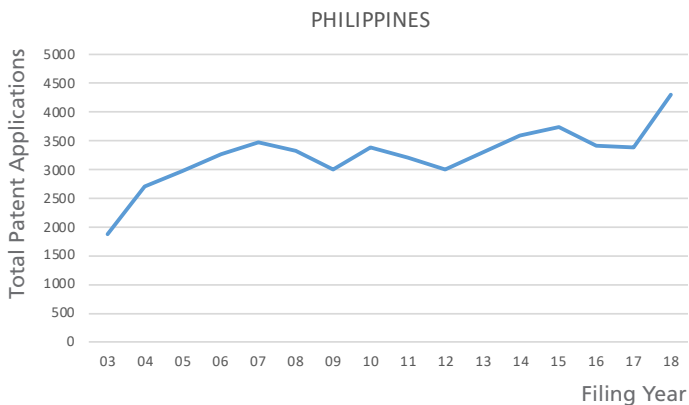
Languages: Tagalog and English

Area: 300,000 km²

Currency: Philippine pesos (PHP)

Legal System: Mixed legal system of civil, common, Islamic, and customary law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Ranked 55th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019
- > Removed from the United States Trade Representative (USTR) Special 301 Watch List (2014) which identifies countries that do not adequately and effectively protect intellectual property rights after having been on the list since 1994

Enforcement

- > Infringement remedies – damages based on an account of profit, delivery up and injunctions
- > Enforcement through civil court or IP Legal Tribunal
- > Potential for alternative dispute resolution in IP matters via mediation
- > Limitations period of four (4) years for bringing infringement actions

Prosecution

- > National phase entry deadline for PCT applications in Philippines: 30 months
- > Patentable subject matter – all subject matter patentable except scientific discoveries, scientific theories and mathematical methods; and in the case of drugs and medicines, the mere discovery of a new form or new property of a known substance which does not result in the enhancement of the known efficacy of that substance, or

the mere discovery of any new property or new use for a known substance, or the mere use of a known process unless such known process results in a new product that employs at least one new reactant. Salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations, and other derivatives of a known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy; mathematical methods, schemes, rules and methods of performing mental acts, playing games or doing business, and programs for computers, methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body, plant varieties or animal breeds or essentially biological process for the production of plants or animals, aesthetic creations and anything which is contrary to public order or morality

- > Voluntary divisional applications possible
- > Post-grant amendment possible
- > Third party observations must be made within 6 months of publication or request for exam

Other issues

- > Protection available for patents and utility models
- > Term of protection for patents – 20 years from filing date; utility models – 7 years from filing date
- > No pre or post-grant opposition
- > No Patent Term Extension available

- > No provisions for the requirement of a foreign filing license
- > Data exclusivity is available for the duration of the Bureau of Food and Drugs (BFAD) registration, which is typically between 2 to 5 years depending on the product
- > Declaration of non-infringement is not available
- > PPH with US, Japan, Korea and EPO
- > Participant of the ASEAN Patent Examination Co-operation (ASPEC)
- > Patent linkage system removed in 2006 allowing the Food and Drugs Authority of the Philippines (FDAP) to accept and consider applications for product registration without an obligation to verify the existence of a patent
- > Compulsory licenses may be granted on certain grounds including a grant of a special compulsory license in situations to ensure access to affordable medicines; and for manufacture and export of medicines to address a serious health problem overseas
- > International exhaustion regime – parallel importation of drugs or medicines is allowed in the Philippines as long as the drug or medicine has been introduced in the Philippines or anywhere else in the world by the patent owner, or by any party authorized to use the invention

SINGAPORE



Population: 6,209,660 (July 2020 est.)

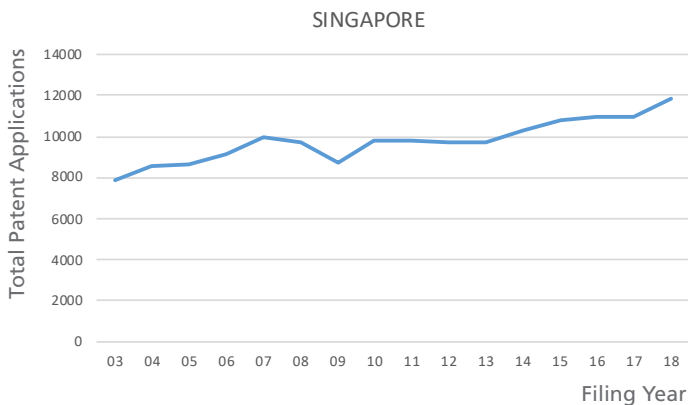
Languages: English (official), Chinese, Malay, Tamil

Area: 719.2 km²

Currency: Singapore Dollar (SGD)

Legal System: English common law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Ranked 2nd in the world for having the best IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > An enforceable jurisdiction that heavily relies on technical expert testimony
- > Rapid conclusion of litigation proceedings – decisions typically issued within 12 months of initiation
- > Potential for alternative dispute resolution in IP matters via arbitration
- > Infringement remedies – damages based on costs or an account of profits, injunctions, and delivery up
- > Innocent infringer defence
- > Potential relief against groundless threats

Prosecution

- > National phase entry deadline for PCT applications in Singapore: 30 months
- > Patentable subject matter – all subject matter patentable except methods of treatment of the human or animal body by surgery or therapy or of diagnosis; or inventions that may encourage offensive, immoral or anti-social behaviour

- > Singapore adopted new Patents Act that has a “positive examination” system from 14th February 2014:
 - Grant now obtained by requesting local search and examination or by supplementary examination
 - Examination procedure now includes a review process by an alternate examiner should the objections remain after the first phase of examination
 - Removal of “fast track” and “slow track” system and removal of post-grant search and examination
 - Generous extension of time provisions, including late entry of national phase by another 18 months
 - Amendments now only allowed before requesting examination and when responding to an adverse written opinion
- > Applies a strict approach to “added matter” that is in alignment with the approach of the European Patent Office
- > Double patenting is a ground of revocation
- > Voluntary Divisional applications possible

Other issues

- > No pre or post-grant opposition
- > Patent Term Extensions – possible
- > Parallel importation – available except for pharmaceuticals under certain conditions
- > Foreign filing license – required as breach may constitute criminal offence

- > Pharmaceutical Data Exclusivity Laws – data and market exclusivity (5 years)
- > Patent-drug linkage
- > PPH with China, Mexico & EPO
- > Member of Global PPH
- > Participant of the ASEAN Patent Examination Co-operation (ASPEC)

SOUTH KOREA



Capital: Seoul

Population: 51,835,110 (July 2020 est.)

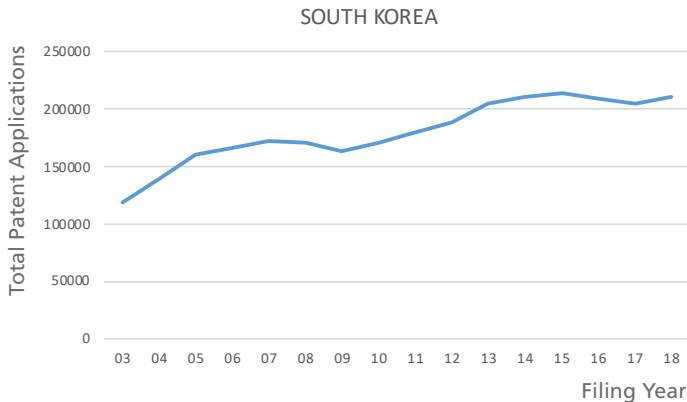
Languages: Korean

Area: 99,720 km²

Currency: South Korean won

Legal System: Civil law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in Korean
- > Ranked 50th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Types of remedies available – money damages or performance, constructive relief or declaratory relief (e.g. seeking a Declaration of Infringement). Punitive damages are not available
- > Types of defences available – seeking a Declaration of Invalidity / Non-Infringement
- > Alternative dispute resolution via a dispute committee for Industrial Property Rights

Prosecution

- > National phase entry deadline for PCT applications in South Korea: 31 months
- > Patentable subject matter – all subject matter patentable except methods of treatment of the human or animal body by surgery or therapy or of diagnosis or inventions that may contravene public order or morality or injure public health
- > Identical-type double patenting is not allowed, i.e. if two claims are identical in scope or identical in substance; only the first-filed invention may be patented. Obviousness-type double patenting may be allowed when the inventors are the same or when the applicants are the same before the prior-filed invention is opened to the public

- > Voluntary divisional applications are possible
- > Utility model registration application can be converted to a patent application
- > Accelerated examination is available for applications related to the “Fourth Industrial Revolution”. This expedited examination is available for inventions in seven core technological fields such as artificial intelligence, internet of things, 3D printing, autonomous vehicles, cognitive robotics, Big Data and cloud computing. This new expedited examination is expected to reduce the pendency period from currently 16.4 months to 5.7 months.

Other issues

- > Utility model registration applications available
- > No Foreign Filing License is required to file an application abroad even if an invention is made in Korea, except when the invention is necessary for national defence
- > Patent term extensions are applied to only pharmaceutical/ agrochemical products that are subject to official testing requirements
- > Computer programs that may be performed in a computer became patentable as of 1 July 2014
- > Effective 1 January 2015, priority patent applications may be filed without claims, e.g. as research notes or in thesis format, and in English
- > PPH with Mexico, Philippines, Taiwan, Vietnam and the IP5
- > Member of the Global PPH

SRI LANKA



Capital: Sri Jayewardenepura

Commercial Capital: Colombo

Population: 22,889,201 (July 2020 est.)

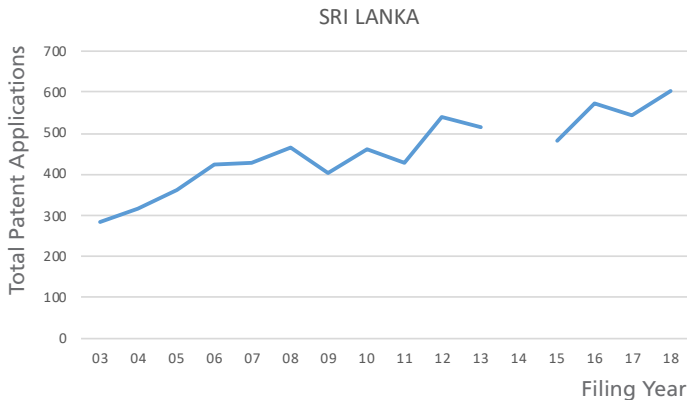
Languages: Sinhala, Tamil and English

Area: 65,610 km²

Currency: Sri Lankan Rupees (LKR)

Legal System: Mixed legal system of Roman-Dutch civil law, English common law, Jaffna Tamil customary law, and Muslim personal law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in English
- > Ranked 109th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Infringement remedies – injunctions, damages, accounts of profits and other relief as the Court may deem just and equitable

Prosecution

- > National phase entry deadline for PCT applications in Sri Lanka: 30 months
- > Patentable subject matter – the following subject matter are not considered to be patentable subject matter:
 - Discoveries, scientific theories, mathematical methods
 - Plants, animals and other microorganisms other than transgenic micro-organism and an essentially biological process for the production of plants and animals other than non-biological and microbiological processes
 - Schemes, rules, or methods for doing business, performing purely mental acts or playing games
 - Methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body (provided however, any product used in any such method shall be patentable)

- An invention which is useful in the utilisation of special nuclear material or atomic energy in an atomic weapon
 - Any invention, the prevention within Sri Lanka of the commercial exploitation of which is necessary to protect the public order, morality including the protection of human, animal or plant life or health or the avoidance of serious prejudice to the environment
- > Voluntary Divisional applications possible

Other issues

- > No pre or post-grant opposition
- > Patent Term Extensions – not possible
- > Parallel importation – available under certain conditions

TAIWAN (REPUBLIC OF CHINA)



Capital: Taipei

Population: 23,603,049 (July 2020 est.)

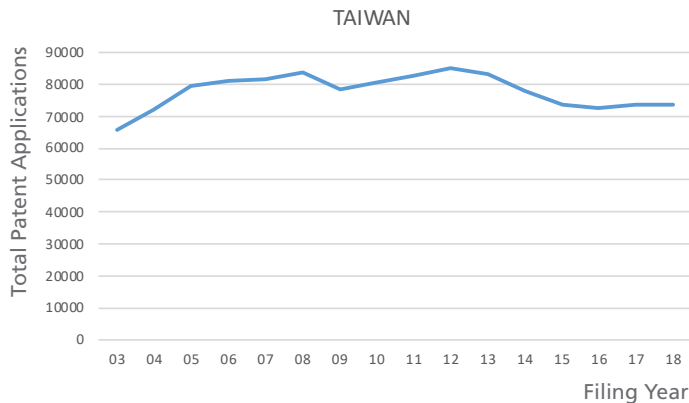
Languages: Standard Chinese

Area: 35,980 km²

Currency: New Taiwan dollar (NT\$) (TWD)

Legal System: Civil law

FILING STATISTICS



Source: Taiwan Intellectual Property Office (TIPO), March 2020

KEY ISSUES

- > All litigation and prosecution in Mandarin (Traditional)
- > Ranked 28th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > Specialized IP Court for patent litigation matters since 2008
- > Technical Examination Officers can be appointed to assist Judges in technical matters
- > Disputing parties allowed to engage experts to issue infringement / non-infringement opinions
- > Witness testimonies relied upon
- > Infringement proceedings are civil disputes, i.e., no criminal liability
- > Prior use (before filing date of patent) is a defence to patent infringement

Prosecution

- > Patentable subject matter – all subject matter patentable except animals, plants, and essential biological processes for the production of animals or plants; diagnostic, therapeutic and surgical methods for the treatment of humans or animals; inventions contrary to public order or morality
- > Local Substantive Examination procedure required
- > Voluntary amendments may not introduce subject-matter extending beyond the scope of the application as originally filed

- > Double patenting is a ground of refusal
- > Voluntary Divisional applications possible

Other issues

- > Not a Contracting State to the Patent Cooperation Treaty
- > Priority claim to an earlier application filed in a WTO country recognized by the TIPO
- > 12-month novelty grace period available for disclosures made by the Applicant in a pre-filing publication. The grace period does not apply to earlier patent applications filed with Applicant's consent
- > An invention can be protected under either an Invention Patent or a Utility Patent but not both
- > Patent Term Extensions – possible on grounds of delay in patent exploitation caused by requirement for regulatory approval
- > No pre or post-grant opposition procedure available presently
- > Parallel importation permitted
- > Pharmaceutical Data Exclusivity Laws – data and market exclusivity (5 years)
- > Patent Linkage available

THAILAND

Capital: Bangkok

Population: 68,977,400 (July 2020 est.)

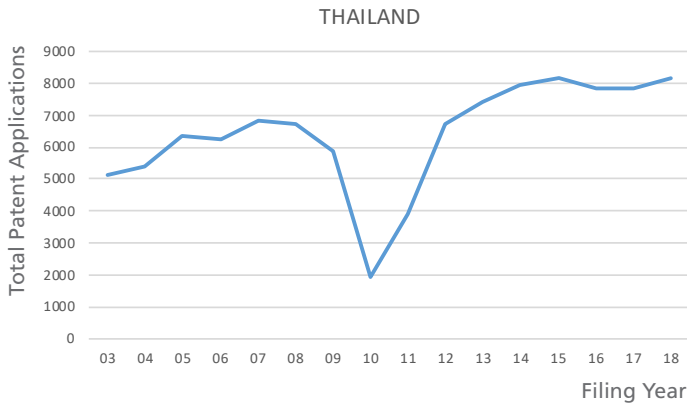
Languages: Thai & English

Area: 513,120 km²

Currency: Baht (THB)

Legal System: Civil law system with common law influences

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in Thai language
- > Ranked 99th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Litigation

- > Framework for patent infringement litigation is present but due to the low number of cases actually tried in a Court, there is not much case law to cite when compared to some other countries. The Court may consult any foreign law and may apply it to the extent that it does not conflict with Thai law
- > A specialised Court for deciding Intellectual Property cases exists (the Central Intellectual Property and International Trade Court) which consists of two professional judges and one associate judge. The associate judge has expertise in Intellectual Property or technical skills in order to assist the judges with technical aspects
- > Introduction of Specialized Appeal Court in 2016 - which will hear appeal cases from Central Intellectual Property and International Trade Court
- > Time taken for litigation proceedings may range from 18 to 24 months in the Central Intellectual Property Court and 24 to 30 months in the Supreme Court
- > Preliminary injunctions are possible, though rarely granted

- > Patent infringement is a criminal offence and is punishable by imprisonment not exceeding two years or a fine not exceeding four hundred thousand baht, or both
- > Infringement remedies – damages depending on the extent of the injury such as loss of benefits and expenses involved in the enforcement of the patentee's rights, injunctions and delivery up
- > Punitive damages are not available in Thailand
- > Doctrine of equivalents applies when construing a claim
- > Invalidity can be used as a defence and a separate proceeding can be filed
- > As an alternative to litigation, negotiation through the Mediation Center is possible. The two government agencies that facilitate mediation of intellectual property disputes in Thailand are the Department of Intellectual Property and the specialized Intellectual Property Court. The case will be mediated by a mediator who has a business or intellectual property background

Prosecution

- > National phase entry deadline for PCT applications in Thailand: 30 months
- > Unpatentable subject matter – (1) naturally occurring microorganisms and their components, (2) animals, plants, or extracts from animals or plants, (3) scientific or mathematical rules or theories, (4) computer programs, (5) methods of diagnosis, treatment or curation performed on a human or animal body, and (6) inventions contrary to public order, morality, health or welfare

- > Foreign patent applications that are filed in the 18-month period before the application date in Thailand are not relevant for novelty purposes, provided that the foreign application has not been published or granted
- > Post-publication opposition – possible
- > Request for examination within 5 years from the publication date. Examination can be expedited by providing examination results and grant of a patent from a country with a well-developed patent examination system
- > Voluntary amendments are possible before the publication of the application, or as directed by the Director-General, provided that such amendments do not enlarge the scope of the invention
- > Divisional applications only possible upon notification from an Examiner that the application relates to more than one invention

Other issues

- > Possible to pay all of the annual fees in advance in one payment instead of in annual payments. However, if the annual fees are subsequently revised or the patent is surrendered or cancelled, the patentee is not obligated to pay any increase in the annual fees or be entitled to a refund of the annual fees paid
- > Working requirement – a patent should be sufficiently worked in Thailand within the later of three years from the grant date, or four years from the application date
- > Patent Term Extensions – not possible

- > Compulsory licensing – possible, though rarely required as parties will settle and decide on a license
- > An inventor has the right to claim remuneration based on a granted patent in Thailand
- > Parallel importation – available except for pharmaceuticals
- > Foreign filing license – not required
- > Pharmaceutical Data Exclusivity Laws – Thailand does not offer data exclusivity protection but a limited form of data protection is provided under trade secrets law
- > Marketing exclusivity – a two- to four-year safety monitoring period is provided to pharmaceutical companies with granted marketing approvals to only sell their products to the government and private hospitals. No new generic drugs can be launched during this safety monitoring period
- > Patent-drug linkage – does not exist
- > PPH with Japan
- > Participant in the ASEAN Patent Examination Co-operation (ASPEC)

VIETNAM



Capital: Hanoi

Population: 98,721,275 (July 2020 est.)

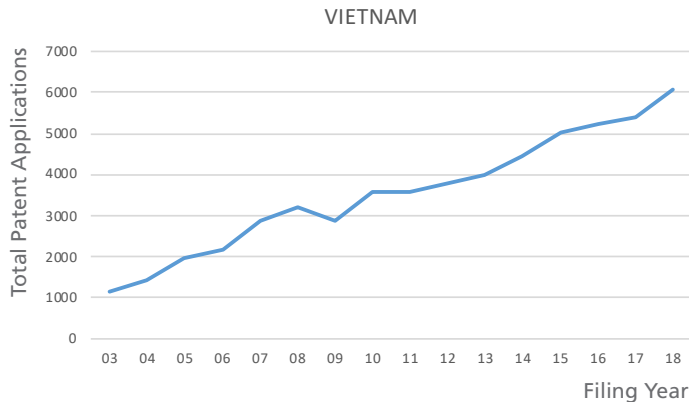
Languages: Vietnamese (official) & English

Area: 331,210 km²

Currency: Vietnam Dong (VND)

Legal System: Civil law

FILING STATISTICS



Source: WIPO statistics database, March 2020

KEY ISSUES

- > All litigation and prosecution in Vietnamese
- > A relatively large market with a growing middle class and consumer appetite for products from electronic goods to pharmaceuticals
- > A manufacturing base for many multi-national corporations
- > Ranked 105th in the world for IP protection in the World Economic Forum's Global Competitiveness Report 2019

Enforcement

- > An enforceable jurisdiction with both administrative and civil actions
- > Administrative actions are usually preferred as they are relatively quick and cost-effective if the aim is to stop the infringement. Additional sanctions and remedies are available
- > Very few litigation cases – courts and judges have little or no experience handling patent litigation. Infringement remedies include injunctions, damages (based on actual losses), public apologies or rectification, and destruction of infringing goods or articles
- > Preliminary injunctions are available
- > Potential for alternative dispute resolution in IP matters via mediation or arbitration

Prosecution

- > National phase entry deadline for PCT applications in Vietnam: 31 months
- > Subject matter excluded from patentability:
 - discoveries, scientific theories, mathematical methods
 - schemes, plans, rules or methods for performing mental acts, training domestic animals, playing games, doing business
 - computer programs
 - presentation of information
 - solutions of aesthetic characteristics only
 - plant varieties, animal varieties
 - process of essentially biological nature for production of plants/animals other than microbiological processes
 - disease prevention, diagnostic and treatment methods for humans and animals
 - inventions contrary to the interest of society, public order or harmful to national defence and security (includes gambling-related inventions)
- > Examination may be expedited if claims are amended to conform to allowed claims from a developed patent jurisdiction
- > Voluntary Divisional applications are possible; however, a divisional application must be directed to subject matter that is different from the parent application. Also, a further voluntary divisional application of a divisional application is not possible if the original parent has been granted.

Other issues

- > Opposition and invalidation procedures are available
- > No Patent Term Extension
- > Parallel importation – available
- > Foreign filing license – not available. First-filing in Vietnam is required for inventions made in Vietnam; failure to do so may result in loss of protection in Vietnam
- > Pharmaceutical Data Exclusivity Laws – data protection for up to 5 years
- > Participant in the ASEAN Patent Examination Co-operation (ASPEC)
- > PPH with Japan and Korea
- > 12-month general novelty grace period available with effect from 14 January 2019. Publication in an earlier patent application does not qualify for the grace period unless the publication was due to an error on the part of the patent office

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