

CONCURRENT IP PROTECTION DOES NOT ALWAYS HAPPEN

Different intellectual property laws were created to protect different kinds of creations. Patent law protects industrial designs, products and processes that are novel, inventive and industrially applicable. A key criterion for patentability is that the invention must never have been disclosed to the public prior to filing the patent application. Thus, timing is of the essence when it comes to patent protection.

Trademark law, on the other hand, mainly focuses on brands, names, drawings, and the like. Trademarks may or may not be disclosed before the owner seeks registration.

Lastly, copyright law automatically protects “ideas” once expressed in certain forms. To be copyrighted, works of authorship do not need to be registered to gain worldwide protection in WTO member countries, unlike patents and trademarks.

Theoretically, to ensure that society benefits from protected works, a single creation should only enjoy intellectual property (IP) protection under one law, rather than benefiting from concurrent protection under multiple laws. Owners with IP rights should enjoy exclusivity over their creations for a limited time period, after which the creation must be shared in the public domain.

Fifteen years ago, however, a Supreme Court decision (Dika case 6379/2537) held that a unique patentable design of

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a pen was also protected under copyright law. More recently, another judgment by the Court (Dika case 7024/2549) found that a bottle’s unique patentable design was protected as a trademark. These two rulings by the Supreme Court brought smiles to many creators and inventors, as they learned that one creation may enjoy concurrent protection under different IP laws, which could lead to prolonging the exclusivity to their creations.

None of the Thai IP laws clearly states whether or not one creation may receive concurrent IP protection. Hence, if the same creation meets criteria set under several laws, such creation may enjoy duplicate protection.

Nevertheless, the Supreme Court cases discussed above may mislead some people into believing that if they failed to patent their design when it was new, the design would still be protected under copyright or trademark laws. This is not always true.

In fact, an industrial design cannot be copyrighted unless the creator can

prove that such design is considered an artistic or literary work of some kind.

The underlying concept behind the pen-design ruling was that the plaintiff was able to prove to the Court that the design was a “work of applied art”, as it was first drafted on paper, then after careful analysis was made into a mock-up model, and finally was produced as a real pen. If the plaintiff had not proved that skills, labour and judgment were used in creating the design, the Court might not have issued a ruling as pleasing to inventors.

As for the latter Dika judgment regarding the unique bottle design, the plaintiff also failed to patent the design when it was new, so it sought protection under the trademark law instead. This may seem like a good solution, as “a drawing, invented picture or even a shape of a three-dimensional object” can be registered as a trademark, and a design can always be rendered as a drawing.

However, trademark registration of a product design is never easy because the Registrar and the Board of Trademarks consistently reject product design trademarks, interpreting the designs as descriptive of the applied goods. For example, the design of a bottle would be considered descriptive of liquid goods because it is likely that the bottle would be used to hold liquid.

Therefore, most product designs are not granted trademarks unless the case

is brought to the Court and the creator can prove that the design can be used as a trademark for the purpose of distinguishing its product from products belonging to other proprietors. And even if the creator can establish this proof and is granted a trademark for the design, the difficulty of enforcing the right to the design remains. If someone else copies the design for purposes other than use as a trademark, then it may be difficult to prove that the trademark right of the design has been infringed.

The bottom line is that if a creation is patentable, its inventor should urgently file an application to register the creation before its lack of novelty makes it unpatentable. One should not count on the creation being automatically protected under the copyright law, even if the Supreme Court has sometimes ruled that an unpatented design can be protected as a copyrighted work. And when it comes to enforcing the right to a design, registering the design as a trademark may not provide the protection of the patent law. Therefore, it is recommended that inventions or designs be patented as soon as they are created.

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