

# Accelerating patent examination in Thailand – Regional fast-tracks

As the substantive examination tends to be lengthy in Thailand, although reforms are underway to shorten the process, ASEAN and Japanese patent holders may request that the examination be expedited under one of the two operational fast-track systems. It may shorten the process by up to 3 years.

These fast-track paths are also called “Patent Prosecution Highway” (PPH), referring to a program that allows patent applicants to request accelerated substantive examination of their patent applications by utilizing a positive examination outcome from other patent offices. These PPH programs are subject to bilateral or regional agreements between countries. They can be used with a number of patent offices worldwide, for instance with the United States Patent and Trademark Office (USPTO), the Intellectual Property Office of Singapore (SG) and the Japanese Patent Office (JPO), as well as with patent offices across Europe and several in the ASEAN region.

## PPH pilot program with Japan

The Thai Department of Intellectual Property (DIP) and the JPO are cooperating since 2014 to accelerate the substantive examination of patents based on prior applications filed in Japan or Thailand. This pilot program is currently in force until December 2025, and will probably be extended further by additional 2-year periods.

This procedure is available for (i) applications claiming priority from a JPO application, (ii) national phase PCT applications based on a JPO application, (iii) national phase PCT applications without priority claim or with priority claim of a prior PCT application without priority claim, where the PCT national phase has also been filed in Japan. Once the application or some of its claims is/are declared patentable by the JPO, the applicant may ask that the corresponding patent application pending before the DIP be examined under the PPH program. It is possible to request for the PPH program either through e-filing or in person when requesting substantive examination or at a later time, but before any office action is issued by the DIP during the substantive examination=.

## Several documents are required:

1. The PPH request form.
2. Copies of all office actions issued during substantive examination by the JPO, along with their translations in either English or Thai.
3. Copies of all claims declared patentable by the JPO, along with their translations in either English or Thai.
4. Copies of references cited by the JPO examiner; the translation of the references is not required.

5. A table connecting the claims of the JPO application with the application submitted to the DIP. After receiving the request, it will take approximately 6-10 months from the date on which the request is filed to receive the first office action, which may either require the applicant to file an amendment or to proceed with the payment of the grant fee.

In general, Thai examiners tend to align their assessment with the examination results of the JPO; they would only carry out an additional examination to ensure that the patent application meets the specific requirements set out by the Thai Patent Act and corresponding regulations. No official fee is charged for participation in the PPH pilot program.

### **ASEAN Patent Examination Co-Operation (“ASPEC”)**

ASPEC is a patent work-sharing program implemented by the IP offices of 9 countries in ASEAN: Brunei, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand and Vietnam. It is operational in Thailand since 2013. It promotes the use of search and examination reports or PCT reports issued by another participating IP office to speed up the examination by the IP office designated subsequently. It is free of charge for the applicant. The ASPEC request can be filed together with the substantive examination request, at the designated IP office or through the ASEAN IP portal. In Thailand, it is possible to file an ASPEC request through either e-filing or in person, before any office actions is issued by the DIP during the substantive examination of the application. All relevant documents must be provided in English.

### **The required documents are as follows:**

1. The duly filled ASPEC request form.
2. A copy of the prior search report.
3. A copy of the examination results.
4. A copy of the patent certificate (if any).
5. ASPEC claims correspondence table.

As of July 2023, 320 ASPEC requests have been filed in Thailand, mainly by holders of a patent application in Singapore (76%). The average time from the filing of the ASPEC request to the first office action in the 6 ASEAN States where it has been used is 9.3 months.

### **References:**

- <https://www.jpo.go.jp>
- <https://www.aseanip.org>
- <https://www.ipthailand.go.th>
- <https://www.ipthailand.go.th>