

Korean patent battle in Thailand

Tilleke & Gibbins



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The Supreme Court of Thailand recently announced its decision to uphold an appeal in a long-running patent battle between two Korean-owned companies in Thailand. The parties to this conflict compete in the manufacturing of rubber products, such as gloves and boots. The dispute arose because one company attempted to register a famous rubber boot for use in agriculture to be exclusively owned as a design patent in Thailand. The other company had not filed for protection of the boot because it had been used in Korea for a long time.

The conflict began in 2004 when Korean-owned Thai company Sinchok Siam Co Ltd launched a police criminal raid action to seize several latex boots and manufacturing moulds from the premises of Top Union Co Ltd, another Korean-owned company in Thailand.

Top Union's latex boot for use in agriculture was famous and had a long queue of orders. After being accused in this criminal patent infringement case, the company filed a civil suit to cancel Sinchok Siam's design patent for the disputed product at Thailand's Intellectual Property and International Trade Court (IP&IT Court).

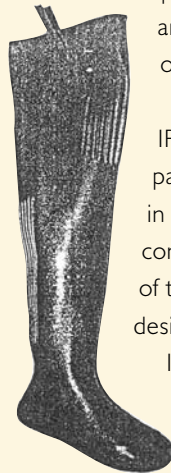
After submitting its complaint, Top Union filed a request to the court for interim relief, so that it could continue its business. The request also asked the court to prevent Sinchok Siam from taking any further criminal actions against Top Union, while it considered the validity of the design patent in the civil case. The court granted Top Union's request and ordered the company to pay a large deposit as a guarantee. However, prosecution of the criminal patent case ran simultaneously with the civil case.

In May of 2005, the court of first instance in the civil case considered the design patent of Sinchok Siam to be invalid. Although the defendant claimed that the disputed boot was also filed for registration as a patent in Korea, the court found that the Korean patent covering the boot was filed as a utility patent, not a design patent. The defendant's latex boot was filed for design patent registration in June of 2001. This meant that the defendant's product was already known and used by the time the application was filed with the Department of Intellectual Property, and thus did not qualify for design patent protection.

Following this ruling, Sinchok Siam appealed to the Supreme Court to reverse the IP&IT Court's decision. In its appeal, Sinchok Siam claimed that its boot was innovative and not obvious in ordinary products, particularly because of the rubber loop in its upper edge.

In May of 2007, the Supreme Court affirmed that the IP&IT Court's decision to cancel Sinchok Siam's design patent as the design of the latex boot had been disclosed in Thailand and a foreign country. The Supreme Court considered the company's claim on the innovative aspect of the boot's upper loop as irrelevant to the disputed boot design.

In the end Top Union succeeded in its fight to invalidate Sinchok Siam's Thai patent. Thus, the court in the criminal patent case needs to evaluate the facts that prove the invalidity of Sinchok Siam's patent. Ultimately, the design of the latex boot in dispute belongs in the public domain.



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