

NEWSLETTER

Grace period for IP cases during COVID-19 pandemic

COVID-19 Grace Period for Intellectual Property (IP) related Prosecution

As COVID-19 ("Coronavirus") continues rampage through the country, Thailand Department of Intellectual Property ("DIP") will be allowing applicant/owner to file a request for a grace period extending the usual deadline. This grace period is preliminary provided for those who is directly affected by COVID-19. Further explanations are below.

What does COVID-19 grace period cover?

Everything that is under the administration of DIP, including:

- patents
- petty patents
- design patents
- trademarks
- geographical indications, and
- topography of integrated circuits.

This grace period will apply to all IP related prosecution process, such as: application deadline, opposition deadline, registration deadline, office action deadline or any payment deadline.

Who can apply for this?

The owner/applicant.

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How does this work?

For individual, he/she must submit relevant documents showing evidence of sickness and treatment of COVID-19. In short, documents showing that COVID-19 has directly affected the ability to handle IP prosecution.

For company, it must prove that COVID-19 has directly impact and hinder the handling process of the related IP prosecution process. If the CEO or director became ill from COVID-19, he/she can submit related medical document on behalf of the company.

It is uncertain whether agent/lawyer can make a similar claim. At this time, it would seem that DIP will only allow a request made directly by the applicant/owner.

What happen after I submit the documents?

Once submitted, the examiner/registrar will review the request on a case-by-case basis. If approved, the applicant/owner will be granted a 30 days extension from the approval date. On the other hand, if the request is rejected, the applicant/owner can file an appeal within 15 days from the decision date. Once again, it is uncertain as to how DIP will calculate the dates.

Our recommendation

Avoid applying for a COVID-19 grace period unless it is necessary. Seeing multiple uncertainties, including document criteria, deadline on top of examiner/registrar own discretion, it may not be beneficial for owner/applicant to use this. There are considerable risks involve, if the request should fail it may subsequently cause the related IP matter to lapse.

Overall, we recommend that applicant/owner/agent maintain the formal deadline and prepare ahead of time. Our firm has implemented a work-from-home protocol and we are ready to assist you. If you have further question or concern, please contact us.

Required Documents:

- Copy of the passport of the affected person (important)
- Medical certificate showing COVID-19 infection (important)
- Document proving resident within COVID-19 outbreak areas (important)
- Document verifying high-risk individual, close proximity of the infected or close proximity to those returning from high-risk areas
- Any document that may prove direct impact from COVID-19 outbreak
- Document verifying COVID-19 infection or outbreak have ended (important)

It is also unclear as to how the Thai examiner/registrar will review these documents. Nonetheless, we have marked the important documents that should be submitted, and we will further discuss with the examiner/registrar if this should be the case.

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