Judgment of the Central Intellectual Property and International Trade Court

Case no. (Black) IP 34/2544	AIDS Access Foundation and others	**Plaintiffs**
Case no. (Red) IP 93/2545	Bristol-Myers Squibb Co., Ltd.	**Defendant**
	Department of Intellectual Property	**Joint Defendant**

Patent Act B.E.2522 (1979), sections 3, 17, 20, 36, 36 bis, 53, 54

The patent owner's exclusive right is legally empowered to prevent third parties not having the patentee's consent from any act of exploiting his invention. In view of everyday-life consumers, a substantial difference between general products or inventions and medicines may be perceived as the former are slightly optional means while the latter prove to be basic essentials for survival. On this account, greater importance of human life safeguard and health care should be stressed prior to any property rights, as assured internationally through the Declaration on the TRIPS Agreement and Public Health adopted on 14 November 2001 by the Ministerial Conference of the World Trade Organization (WTO), Fourth Session at Doha, the State of Qatar, affirming that "the [TRIPS] Agreement can and should be interpreted and implemented in a manner supportive of WTO Members' right to protect public health and, in particular, to promote access to medicines for all". With respect to such principles as aforesaid, any interested parties or parties injured by a grant of patent for one's medicine are deemed to include not only the producers or traders of rival pharmaceutical products but also the patients or parties in need of such patentable pharmaceuticals.

Under section 3 of the Patent Act B.E. 2522 (1979), a patentable invention with regard to product is defined as any discovery or creation considered to constitute a new product. A patentable pharmaceutical, especially a patentable pharmaceutical composition or formula is, therefore, required to be novel and any dosing unit is regarded as the substance of such pharmaceutical invention. Under section 17 of the Patent Act B.E. 2522 (1979), an application for a patent shall contain certain particulars including a description of the invention (the "description") and a claim or claims. As the patent applicant is required to

disclose the description to the public in return for the exclusive right to be lawfully conferred on the patent applicant by society, most details of technical information and knowledge with regard to the invention should be publicly disseminated. The scope or subject-matter of an invention for which the patent applicant seeks statutory protection is defined by a claim or claims. As a prime test to determine whether any patent is found infringed or not, the claim or claims must be clear and concise. Accordingly, both the description and the claim or claims are deemed the utmost importance to any patent application. The scope of an invention as defined by a claim or claims for which the patent applicant seeks statutory protection shall be supported by, comply with, and not extend beyond, the disclosed description. Under section 20 of the Patent Act B.E. 2522 (1997), a patent application may not be amended by the patentee in such a way that it contains subject-matter which extends beyond the substance of the invention. In terms of such provision, the substance of an invention means both the description required to benefit society and a claim or claims defining the scope or subject-matter of the right or profit for which the patentee seeks statutory protection. A mixture of both units must be taken into consideration. Only single aspect is deemed insufficient. A phrase “from about 5 to 100 milligram per dosing unit” which is crossed off the original claims is held to alter the substance of the claims because such unlimited quantity per dosing unit in pharmaceutical composition as conferred upon the patentee denotes an extended protection beyond the scope stated in the initial claims. As a result, the scope or subject-matter for which the patentee seeks protection under the amended claims is extended beyond that disclosed in the description. To delete the aforesaid phrase from the original claims is held prohibitive due to extending the substance of that invention.

The Patent Act B.E. 2522 (1979) provides only for the surrender, revocation, and partial cancellation of a patent, without any provision regarding amendment to the claims. Nonetheless, legal consequences of revocation or partial cancellation of a patent are apparently graver than those of amendment to the claims: (1) the protection conferred on the patentee becomes promptly extinct when the patent is revoked; and (2) the protected subject-matter within the scope of the invention is limited to the remaining effective claims available after the claims are cancelled in part. Accordingly, an amendment to the claims is deemed more beneficial than the revocation or partial cancellation of a patent. Where no

statutory provision for amendment to claims is explicitly prohibited, the plaintiffs are entitled to amend the defendant's patent by filing an application for restoration of the original phrase "from about 5 to 100 milligram per dosing unit" to be included back to Claims 1 and 2 as existed previously.

Translated by Warakhom Liangpandh