(31) Judgment

Black Case No. Tor Por 34/2544
Red Case No. Tor Por 93/2545

The Central Intellectual Property and International Trade Court
1 October 2002

Aids Access Foundation, No. 1,
Mrs. Wanida Chaichana, No. 2,
Mr. Hurn Ruangsuksud, No. 3 — Plaintiffs

Case between

Bristol-Mayer Squibb Company — Defendant
The Department of Intellectual Property — Co-Defendant

RE: Patent

The three Plaintiffs submitted and amended the plaint to the effect that, the Plaintiff No. 1 is a juristic person registered as a foundation, having its objectives to support welfare, physically and mentally, to the persons infected with HIV, so as to make the people to acknowledge their rights. The objectives also include cooperating with other non-profit organizations. The Plaintiffs No. 2 and No. 3 are the patient suffering AIDS disease (Acquired Immunodeficiency Syndrome) due to the infection with HIV (Human Immunodeficiency Virus). The Defendant is a juristic person registered as a limited company under the law of the United State of America. The Defendant applied for the Inventive Patent to the Department of Intellectual Property for the invention named "Better formula for oral use of Dydeoxy Purine Nuecleocide" or so called "DDI". The Department of Intellectual Property had advertised such application. Later on, the Defendant submitted to the Department of Intellectual Property a report from a foreign country, and submitted an application to amend the application for the Inventive Patent. All of the application for the Inventive Patent, the advertisement, the application to amend the application for the Inventive Patent which based on the Australian patent as a basis for applying for the Patent stipulated in the Patent claim, Clause 1 and Clause 2 that: "from about 5 to 100 m.g. per dose". Subsequently, the Department of Intellectual Property granted a Patent to the Defendant, but it conspired with the Defendant to intentionally delete the phrase "from about 5 to 100 m.g. per dose" from the Patent claim, Clause 1 and Clause 2. This amounts to illegal amendment to the Inventive Patent in material sense. This will allow the Defendant to rely on the conditions set forth in the Inventive Patent to produce HIV anti-virus medicine of whatever dose, which affect directly to the others' right to use medicine. The Plaintiffs suffered distress from the illegal exercise of right of the Defendant. The Court is requested to order the Defendant to amend the Inventive Patent No. 7600 in Clause 1 and Clause 2 by inserting phrase "from about 5 to 100 m.g. per dose" therein, if the Defendant failed to do so, the Plaintiffs will take the judgment to that effect to amend the Inventive Patent as mentioned above at the Defendant's cost. The Defendant must also pay cost of advertisement of the amended Patent claim in five daily newspapers for 10 days at the Defendant's cost.

During the court hearing, the Court summoned the Department of Intellectual Property as a Co-Defendant for the sake of justice, pursuant to section 57(3)(b) of the Civil Procedure Code.

The Defendant submitted and amended statements of defense to the effect that the Plaintiffs and the Defendant had no legal relationship with each other. There is no legal provision entitling the Plaintiffs or any person to apply to the Court to amend the Inventive Patent granted by the Department of Intellectual Property. The Plaintiffs do not have authority to take the legal action, nor do they have authority to enforce the Defendant to advertise the amended Patent in the daily newspapers as claimed. The Defendant has invented the "better formula for oral use of Dydeoxy Purine Nuecleocide according to the application for Patent, which provides positive effect for the treatment of AIDS; it should be regarded as an advantage for the patients of this disease, including the three Plaintiffs. The grant of Inventive Patent to the Defendant did not affect the Plaintiffs' right. The Defendant has complied with the procedures for the application for Patent as set forth by relevant laws, i.e. submitting application for Patent, advertising the application, and submitting application for the examination of the invention. Subsequently, the Defendant submitted an application to amend the application for Inventive Patent in relation to the Patent claim, which is not to be regarded as material to the invention. After having examined the facts, the officer at the Department of Intellectual Property deemed it appropriate to grant the Inventive Patent to the Defendant, as the invention is legal. The amendment of the Patent claim was therefore legal and correct. Nonetheless, the fact that the Defendant amended the Patent claim by deleting the phrase stipulating the portion of the Dydeoxy Purine Nuecleocide per dose did not cause any damage to the Plaintiffs, because the portion for use must be in accordance with the details of invention, pursuant to Section 36 bis of the Patent Act. The Defendant was granted the Patent pursuant to its legitimate right. The Defendant has never used the Patent in illegal way or to cause any harm to the Thai society as a whole. The Patent was legally granted to the Defendant. Therefore the Plaintiffs do not have any legal authority to enforce the Defendant to amend the Patent claim. The claim must be dismissed.

The Co-Defendant contended that the Plaintiff No. 1 does not have an objective to manufacture HIV anti-virus medicine. The Plaintiff No. 2 and No. 3 are patients who suffer from AIDS, but they can choose other medicines to cure the disease without having to use DDI. The three Plaintiffs are not the manufacturers of medicine. They are not injured or interested parties entitled to claim for the amendment of the Defendant's Patent. This case does not fall within one of any case stipulated in section 54 of the Patent Act whereby the law entitles certain persons to assert invalidity of or to revoke the Patent. The Plaintiffs are not entitled to claim in this case. The Co-Defendant has exercised its powers vested in it by law within due scope when it granted a Patent to the Defendant who submitted an application for it. The fact that the Patent claim does not contain the phrase "from about 5 to 100 m.g. per dose" does not make the Defendant to be entitled to manufacture HIV anti-virus medicine of any dose as claimed by the Plaintiff. Section 36 bis of the Patent Act provides that the scope of invention shall be determined by the Patent claim, taking into account the nature of invention from the details of the invention. Therefore, the Defendant cannot manufacture the medicine otherwise than the dose prescribed in the details of the invention. The order of the Director General of the Department of Intellectual Property to permit the registration of the Patent for the Defendant was a legal and

final order. The Plaintiffs are not entitled to commence this legal action. The Plaintiff's claim did not request to enforce the Co-Defendant, nor has any legal provision permit the Court to do so.

The Court settled the following issues as issues in dispute:

1. Whether the Plaintiffs' rights have been challenged, or whether they are interested parties who are entitled to make this claim.

2. Whether the Plaintiffs are entitled to enforce the Defendant to register the amendment of the Defendant's Patent, and to force the Defendant the pay the cost of advertisement of the amended Patent claim in the daily newspapers.

3. Whether the amendment of the Patent claim by the Defendant/ Co-Defendant shall be regarded as material amendment, and whether it is lawful.

4. Whether the rights of the Patent holder is limited to those stipulated in the Patent claim, or details of the invention must be considered as a part of the scope of his rights.

The Plaintiffs have to present their witnesses first.

In the course of hearing, the Plaintiffs proved their case as follows. The Plaintiff No. 1 is a juristic person in the category of a foundation, registered as an association or entity, having objectives to promote the prevention of AIDS in the families, community and society; to promote the physical and mental welfare of the HIV patients; to promote the recognition and respect of rights of the HIV patients and their families; to cooperate with other non-beneficial organizations, as appeared in the certificate of incorporation of the association, Exhibit Jor 12. Mrs. Darawan Thammarak is the president of the foundation, acting as the authorized representative of the Plaintiff No. 1. The Plaintiff No. 1 gives advice to persons infected HIV as to their health problems, as well as to their families. The Plaintiff No. 2 and No. 3 are customers of the Plaintiff No. 1. The Plaintiff No. 2 and No. 3 have infected by HIV, as per the doctor's report, Exhibit Jor 13 and Jor 14 respectively. The Plaintiffs No. 2 and No. 3 have the right to be treated with anti-virus medicine, which is the best solution for treatment. The treatment must be initiated by either on of the three basic medicines i.e. AZT, 3TC and DDI to prevent the anti-medicine effect. If the patient is treated with medicine otherwise than those basic medicines, he will not be able to return to use the basic medicine anymore. The DDI cannot be replaced by other medicine. At the present, the anti-virus medicines are very expensive. By way of example, the DDI in dispute costs Baht 40 per one tablet. The patients need to consume anti-virus about 150 m.g. per day, which amounts to two tablets of DDI, or Baht 80 per day. The Plaintiffs No. 2 and No. 3 have insufficient income to afford the purchase of such medicine. The Plaintiff No. 1 has to provide service to the Plaintiff No. 2 and No. 3 so as to enable them to be treated with anti-virus. Even though the Pharmaceutical Association has manufactured dry DDI, it is difficult to carry and it will make other people know that the person who uses that medicine has infected by HIV. Moreover, the dry DDI has side effect in causing diarrhea to the person who consumes it. The Plaintiff No. 1 thus reviewed the Patent to DDI and found a suspicion as to it, because the application stipulated the Patent claim from about 5 to

100 m.g. per dose, while the Inventive Patent actually granted did not have such phrase. This is an obstacle to the invention of anti-virus. The Plaintiff No. 1 is of the view that there should be adjudication as to the definite scope of the Patent claim of the Defendant in regard to the manufacturing of DDI. Upon examination of documents at the office of the Co-Defendant, it was apparent that the application for Patent in dispute (Exhibit Jor 1) submitted by the Defendant to the Co-Defendant on 7 July 1993, and the advertisement of such application (Exhibit Jor 4) published on 15 December 1993, stipulated in Clause 1 and Clause 2 the phrase "from about 5 to 100 m.g. per dose". Subsequently, the Co-Defendant notified to the Defendant in writing to correct the name of the chemical substance from the abbreviation to full name. Details appear as per a letter re: the result of examination of application for Patent dated 25 January 1993, as well as a list of items that require corrections (Exhibit Jor 4 and Jor 5 respectively). The contents of those two documents did not require that the phrase "from about 5 to 100 m.g. per dose" be amended. Accordingly, the Defendant requested the relevant officer to inspect the invention on 7 February 1997. The Defendant submitted a report of inspection from foreign country on 27 February 1997, and took the Australian Patent No. 657337 as the report of inspection. In such a report, there existed a phrase "from about 5 to 100 m.g. per dose" as a Patent claim. Details appear in the report of inspection of the Australian Patent (Exhibit Jor 7). Subsequently, on 13 May 1997, the Defendant submitted another application to amend the original application for Patent. The representative of the Defendant insisted that such application complied with Section 20 of the Patent Act, i.e. it was not to add more material parts to the invention. Details appear in the application to amend the original application (Exhibit Jor 8). It was this latter application that is a dispute in this case, because it purported to delete the phrase "from about 5 to 100 m.g. per dose". Since the Patent holder is entitled to use the Patent in accordance with the Patent claim, and since the Defendant's Patent does not have the phrase "from about 5 to 100 m.g. per dose", the Defendant is free to use the Patent without limit. The determination of the range of amount of medicine per dose shall be regarded as a material part of the manufacturing of the medicine. Therefore, the deletion of phrase "from about 5 to 100 m.g. per dose" is the amendment of material parts of the invention. Such amendment is therefore unlawful. The Pharmaceutical Authority has attempted to manufacture DDI tablets of more than 100 m.g. per dose to sell at the price of about Baht 20 each. However, the Defendant's representative argued that the scope of Patent claim of the Defendant was so wide, the Pharmaceutical Authority thus decided not to pursue the manufacturing of the medicine. At the present, the HIV patients are in need of use of anti-virus medicine in order to prolong their lives. The lack of opportunity to access to medicine due to the expensiveness of the medicine prejudices the human rights of the patients to proper medical treatment.

The Defendant proved its case that the application to amend the Patent claim Clause 1 and Clause 2 by deleting the phrase "from about 5 to 100 m.g. per dose" according to the Exhibit Jor 8 was inspected and approved by the inspector as not a material amendment to the invention. Subsequently, the inspector viewed that it was appropriate to grant the Patent to the Defendant since the invention was lawful pursuant to Section 5 of the Patent Act, and proposed his opinion to the Director General of the Co-Defendant to grant the Patent. Details appear in the memorandum re: the result of inspection of invention dated 29 October 1997, Exhibit Jor 9. The Co-Defendant granted the Patent to the Defendant correctly and lawfully. It did not conspire with the Defendant to amend the Patent unlawfully. The unlawful

amendment must be an amendment to material part of the invention, i.e. the amendment as to invention techniques that result in the invention being different from the previous one such that it cannot be expectable. The material amendment of the invention means only the adding of material contents of the invention disclosed in the application already submitted. The Patent claim is merely the scope of protection of the invention, which has to be in compliant with the details of invention. In practice the applicants for Patent usually write the Paten claim as wide as possible to extend as much protection as possible. It is a duty of the inspector to consider whether the Patent claim applied for is redundant with the existing invention; whether the Patent claim is in accordance with the details of invention; whether there is any material technique in the Patent claim that is not disclosed in the details of invention; or whether the scope of invention applied for protection as appeared in the Patent claim is beyond those disclosed in the details of invention. If it appears that the Patent claim is not in accordance with the invention, or if any problem arises, the inspector shall inform the applicant to correct the problem and shall not refuse to grant the Patent at once. Therefore, the deletion of the phrase "from about 5 to 100 m.g. per dose" without adding any material part to the invention is not prohibited by law. Apart from Thailand, the United States of America and Australia, the Defendant also applied for Invention Patent in other countries, including Japan. The application for Patent that the Defendant submitted to the Japanese authority contained an amendment to the Paten claim, Clause 1 and Clause 2 by deleting the phrase "from about 5 to 100 m.g. per dose", just like the application in this case. The Japanese inspector viewed such amendment as not contrary to the law and not to add any material part to the invention, and thus granted Patent to the Defendant. Details appear in the affidavit of the Patent representative of the Defendant in Japan, Exhibit Lor 6. The Japanese law and regulations in relation to the consideration and inspection of application for Patent are very strict and are globally recognized by other countries, including Thailand. This is to support that the deletion of Patent claim by deleting the proportion per dose is not prohibited by law. The application for Patent may be amended at any time before the Patent is granted. The application for Patent which is advertised is merely a preliminary inspection of documents and not an inspection of the contents of the invention. Therefore, it is usual that the applications for Patent so advertised as well as the scope of protection stipulated in the Patent claim have been amended to be different from those advertised. Thus the scope of protection in the Patent claim may be amended from wide to narrow, or from narrow to wide without any limitation until the Patent is granted, provided that it is disclosed in the details of invention. However, once the Patent is granted, the scope of protection according to the Patent claim is not amendable. There is no provision of law that allows such amendment, except where the Patent claim is revoked under Section 53. Scope of protection for invention under the Patent in dispute shall be according to the Patent claim and details of invention. The Defendant and the others can manufacture anti-virus medicine outside the scope of protection. If the Defendant so manufacture, it will not be protected; if the others so manufacture, the Defendant cannot bring any legal action against them. The Defendant did not misuse the Patent or used it beyond the scope so as to harm the Plaintiffs. The Plaintiffs and other Thai citizen can find anti-virus medicine of different formula from that of the Defendant. The Plaintiffs' right was not prejudiced. The Plaintiffs and the Defendant did not have any legal relationship with each other. There is no provision of law entitling the Plaintiffs or anyone to apply to the Court to amend the Patent granted by the Co-Defendant. The Plaintiffs did not have authority

to bring this legal action nor had it power to enforce the Defendant to advertise the amendment of Patent in daily newspapers.

The Co-Defendant did not prove its case.

The Court, upon considering the plaint, answer and all evidence submitted by all parties, found that the Plaintiff No. 1 is a juristic person in the category of foundation, having its objectives to promote the physical and mental welfare of the HIV patients so as to be recognized by the social, as well as to cooperate with other non-profit organizations. The Plaintiffs No. 2 and No. 3 are patients infected by HIV, or known as AIDS. The Defendant is a juristic person in the category of limited company, incorporated under the law of the United States of America. On 7 July 1992, the Defendant applied for the Invention Patent to the Co-Defendant for the invention name "Better formula for oral use of Dydeoxy Purine Nuecleocide" or DDI. The Defendant stipulated its Patent claim in relation to the pharmaceutical formula the phrase "from about 5 to 100 m.g. per dose". Subsequently, the Co-Defendant advertised the application for Patent on 15 December 1993 with the phrase "from about 5 to 100 m.g. per dose". Later on the Defendant asked for the inspection of the invention on 7 February 1997, and submitted a report of inspection from foreign country on 27 February 1997, taking the Australian Patent No. 657337 as the result of inspection of the Patent. In such report, there existed a phrase "from about 5 to 100 m.g. per dose" in the Patent claim. On the same day, the Defendant applied for the amendment of the application for Patent because it wanted to submit the report of inspection from foreign country and to inform the status of inspection of Patent from Australia without intention to amend the Patent claim. However, the translation of the report of inspection from Australia contained the Patent claim of the phrase "from about 5 to 100 m.g. per dose", which was inaccurate translation from the Australian report of inspection, which in fact stipulated "from about 5 to 150 m.g. per dose". Later, on 13 May 1997, the Defendant submitted another application to amend the Patent claim by deleting the phrase "from about 5 to 100 m.g. per dose". The representative of the Defendant insisted that such deletion was not an addition of material part to the invention. The inspector of the Co-Defendant has considered and did not object that it was a material amendment to the invention. The matter was passed onto the supervisors until the Co-Defendant granted the Patent without the phrase "from about 5 to 100 m.g. per dose" to the Defendant eventually.

The first issue that requires consideration is whether the three Plaintiffs' rights have been prejudiced or whether they are injured parties entitling to claim in this case or not. In this issue, the Plaintiffs had Mr. Nimitr Tienudom, a director of the AIDS Access Foundation, the Plaintiff No. 1, to testify confirming the damage suffered by the Plaintiffs that the fact that the Defendant as a holder of the Patent with the scope of protection as stipulated in the Paten claim in dispute resulted in the Defendant being able to monopolize the manufacturing of DDI and sell them at high price, whilst the Patent of the Defendant is unlawful. As a result, the Plaintiffs could not afford the purchase of such medicine. The Plaintiffs No. 2 and No. 3 lacked opportunity to access to the medicine and suffered serious distress. The Defendant and the Co-Defendant contended that the Plaintiffs had no legal relationship with the Defendant. The Plaintiffs were not the manufacturer of medicine; they were not injured parties in this case. The Defendant's Patent did not prejudice the Plaintiff's right. The Court views that the Defendant as the holder of the Patent has an absolute power to prevent

the others to seek any benefit from the invention of DDI, whether to manufacture for use, for sale, or to import such medicine in the Kingdom, without the consent from the Defendant. **Since the medicine is one of the fundamental factors necessary for human being, as distinct from other products or other invention that the consumers may or may not choose for consumption. The treatment of life and health of the human is of the most important than any other property. This was recognized internationally in the 4th Ministerial Meeting of the World Trade Organization at Doha, Quatar from 9 to 14 November 2001, in which it was confirmed of the importance of the Treaty on the Rights on Intellectual Property (TRIPS) in relation to the public health. It was insisted that the TPIPS be interpreted and implemented so as to promote the rights of the members to protect the countries' public health, especially, the promotion and support of the access to medicine of the people as a whole. Therefore, the injured parties from the grant of Patent are not limited to the manufacturers or the sellers of medicine protected by the Patent. The patients or those in need of the medicine are also interested parties to the grant of the Patent.** Even though the Plaintiffs No. 2 and No. 3 have never had legal relationship with the Defendant, and are not the manufacturer of medicine nor are they business competitor of the Defendant, they are patients of a disease that requires treatment from the medicine protected by the Defendant's Patent. The Plaintiffs No. 2 and No. 3 are therefore the direct interested parties. As for the Plaintiff No. 1, even though it is not a patient who requires the same treatment, it is a foundation with the objectives to promote and support physical and mental welfare of the HIV patients, including to cooperate with other non-profit organizations in order to obtain AIDS treatment medicine, and to help the HIV patients who have less opportunity in the society to receive their legal rights, including to act on behalf of those who cannot disclose themselves to the public. Whereas the Plaintiff No. 1 has a function to help the HIV patients to access to the medicine, it is also an interested party having the right to allege the unlawful Patent of the Defendant. The three Plaintiffs are therefore injured parties, entitled to claim in this case. Regarding the appointment of authority to bring legal action in this case of the Plaintiff No. 1, the fact that there is no document showing that Mrs. Darawan Thammarak is in the position of the president of the foundation, which is the representative of the Plaintiff No. 1, but other documents of the Plaintiff No. 1, such as the certificate of establishment of the association stipulates that Mrs. Darawan was the applicant for the establishment of the foundation. In the foundation account or the Power of Attorney authorizing the changes in the foundation also stipulate the name of Mrs. Darawan as the manager. Mrs. Darawan also signed in the Articles of Association. In addition, Mr. Nimitr, the Plaintiffs' witness, acting as a director of the Plaintiff No. 1 also testified confirming that Mrs. Darawan is a president of the foundation. The Court believes that Mrs. Darawan is an authorized representative of the Plaintiff No. 1. The use of different position names is merely insignificant deficiency, which does not affect the authority to bring legal action.

The next issue is whether the amendment made by the Defendant and/or the Co-Defendant in the Invention Patent is material amendment, and whether the amendment is lawful. In this issue, since the facts become final that the Defendant applied for the amendment of the Patent by deleting the phrase "from about 5 to 100 m.g. per dose" from the original Patent claim, it should first be considered whether such amendment is the material amendment to the invention or not. The Plaintiffs presented Ass. Prof. Dr. Jakkris Kuanpoj, a lecturer in law faculty, Sukhothai

Thammadhirat University, to testify as to the point of law that the stipulation of Patent claim by determining the amount of dosage "from about 5 to 100 m.g. per dose" is the stipulation of the Patent claim which allows the patent holder to prevent the others from using the same dosage in the Patent claim. The deletion of such phrase amounts to material amendment because it added more absolute rights to the patent holder than previously was in the original Patent claim. In addition, Mrs. Ajchara Ekseangsri, an officer of the Pharmaceutical Association testified for the Plaintiffs confirming the pharmaceutical principle that the determination of range of dosage is of fundamental to the manufacturing of medicine. The consumption of medicine by the patients must be in the appropriate dosage, no more or less. The Defendant and the Co-Defendant presented Mr. Suradej Assawintrangula, an officer of the Co-Defendant who acted as the inspector for Patent, who testified that the material part of the invention is the details of invention. Therefore, the amendment which can be deemed material must be the amendment of details of invention. If no amendment is made to the details of invention, it shall not be deemed to be material amendment to the invention. Moreover, Miss Prupyoch Srikijjaporn, managing director of the legal consultant and the representative of the Defendant to apply for Patent on behalf of the Defendant, submitted affidavit and testified on such affidavit that the details of invention reveals the invention, and explains the details in technique of the invention. The material amendment to the invention means only the adding material content to the invention as disclosed in the application for the Patent. The witnesses of both parties are all the experts of their own work, but the witnesses of the Defendant have been related to the Defendant, the admission of the testimony of those witnesses must be made with caution. This is different from the witnesses on the Plaintiffs' side who are independent witnesses having no interest with the parties. It is believed that the testimonies of the witnesses are made in good faith. When considering from the principle of Patent law which provides protection to the invention, section 3 of the Patent Act defines "invention" in relation to the product as the creation or development that results in a new product. The medicine which may be granted Patent must therefore be the invention of new medicine product. The nature of medicine products to be protected may be pure substance or medicine formula. In the case of pure substance, it must be the creation of a new pure substance. In the case of medicine formula, it must be the creation of a new formula of the medicine. Therefore, the formula or the determination of dosage of the medicine is an essential part of the invention of medicine products, which is consistent with the testimony of Mrs. Ajchara, the Plaintiff's witness. When an application for Patent is made, section 17 requires that the application must contain the name of the invention, the nature and aims of the invention, details of the invention, Patent claim, and such other items as the conclusion of invention as determined in the Ministerial Regulations No. 21 (1999). In terms of the details of invention, the applicant must disclose information of the invention to the public, and explain the structure of the invention. The law provides that the details of invention must be so complete, precise, and clear as to make the ordinary persons with expertise of related field to follow the invention. The details must also specify the best method of invention known to the inventor. The condition to disclose the details of invention is the reciprocity measure in return for the absolute protection granted to the applicant under the law. The normal people should be able to know information and knowledge as to the invention as much as possible, in order to inspect and study the invention and use it as a basis for development of knowledge or for creating better invention after the period of protection under the Patent expires. The Patent claim determines the scope of

invention that requires protection. Section 36 bis recognizes that the rights of the Invention Patent holder are as stipulated in the Patent claim. To consider whether any person infringes the Patent or not, the Court will look in to the Patent claim. The contents of the Patent claim must therefore be precise and clear and not too wide. If the Patent claim is ambiguous the consideration of the scope of the invention under the Patent claim must consider the nature of invention specified in the details of invention, as mentioned in section 36 bis. Therefore, the details of invention and the Patent claim are important to the application for Patent. Scope of invention that receives protection as stipulated in the Patent claim must be consistent with the details of invention disclosed to the public. In other words, the scope of invention cannot be wider or beyond the details of invention disclosed to the public. Section 20 allows the applicant to amend the application for Patent according to the rules and methods determined by the Ministerial Regulations, provided that the amendment is not material to the invention. The phrase "material to the invention" means both details of the invention and the Patent claim, not only one of them. The words "adding of materiality" mean by themselves that the material parts are changed. Therefore, the deletion of phrase may be the adding of materiality. The deletion of the phrase "from about 5 to 100 m.g. per dose" from the original Patent claim changed materiality of the Patent claim. As a result the patent holder received more protection for the unlimited portion of dosage, which is beyond the scope stipulated in the original Patent claim, and the scope of invention is extended beyond those disclosed in the details of invention. The deletion of phrase "from about 5 to 100 m.g. per dose" is therefore prohibited by law. Even though the Defendant mentioned the similar case in Japan in which the same amendment of Patent claim was allowed, it was not apparent whether or not the Japanese Patent law has any provision prohibiting the materiality of the invention. It was also not apparent about the process or regulations as to the amendment under Japanese relevant law. The Japanese Patent case cannot be relied upon as a precedent to support the Defendant's case. The amendment made to the Patent claim in this case was therefore unlawful. Moreover, such amendment is contrary to section 20, which provides that the applicant wishing to amend the application for Patent must comply with the rules and procedures stipulated in the Ministerial Regulations. Clause 24 of the Ministerial Regulations No. 13 (1992) being in force at the time of amendment requires that the applicant submit the application to amend the application for Patent without changing any materiality therein before the advertisement of the application for Patent, except where the Director General otherwise approves. In the case of the Defendant, the application for amendment was submitted after the advertisement of the application for Patent without the approval from the Director General. Even though the witness for the Defendant confirmed that this was the usual case in practice, but the practice that is contrary to the provisions of law cannot be the right practice.

The next issue is whether the Plaintiffs are entitled to enforce the Defendant to register the amendment to the Patent claim, and to advertise the amended Patent claim in daily newspapers with its own cost. In the case of unlawful amendment of Patent claim, the Co-Defendant is under the duty to correct such errors. Even though Section VI of the Patent Act stipulates only the case of the return of Patent, the cancellation of Patent claim, and the revocation of the Patent, without any provision referring to the amendment of Patent claim, the cancellation of Patent claim or revocation of Patent even causes greater effects to the Patent than the amendment of the Patent claim. Where the Patent is revoked, the holder will no longer be protected by law. Where the

Patent claim is cancelled, the holder will only retain protection for the portion of Patent claim that is not cancelled. In the case of the Defendant, the Patent claim clause 1 and clause 2 are the main Patent claims; other clauses are subordinate. Without the above two clauses, it is not different from having no Patent claim. The amendment of Patent claim as requested by the Plaintiff therefore provides better result for the Defendant. Where the law does not prohibit the amendment, the Plaintiffs are therefore entitled to amend the Patent claim. In this case the Court summoned the Co-Defendant into the case, the Co-Defendant is also bound by the judgment. If the Defendant fails to register the amendment, the Co-Defendant shall amend the Patent claim of the Defendant in pursuant to the Court judgment. The application for Patent of Defendant appeared in clause 1 and clause 2 of the Patent claim the phrase "from about 5 to 100 m.g. per dose"; and the Co-Defendant advertised the application with such phrase in order for any interested parties may object the application. There was no objection made to the application with the phrase "from about 5 to 100 m.g. per dose". It must be understood that the public knew and accepted the scope of invention of the Defendant as stipulated in the advertisement. Therefore, the request of the Plaintiffs that the phrase "from about 5 to 100 m.g. per dose" be inserted to the Defendant's Patent is upheld. However, the Plaintiff's request that the Defendant advertise the amended Patent claim with its own cost does not have any support by any provisions of law. The Plaintiffs cannot force the Defendant to pay for the advertisement of the amended Patent claim.

For the problem of whether the right of the Patent holder is limited only within the scope stipulated in the Patent claim, or whether the details of invention must also be taken into account, this problem has been dealt with in the second issue above.

The Defendant and the Co-Defendant are required to implement the amendment of Invention Patent No. 7600, in the Patent claim clause 1 and 2 to the following effect: "Pharmaceutical formula of Dydeoxy Purine Nuecleocide adjusted to suit the oral treatment and … *(the remaining part contain specific pharmaceutical terms, which are not appropriate to translate)*. The Defendant is also required to pay court fees for the Plaintiffs, together with the lawyer fee of Baht 3,000. The fees as between the Plaintiffs and the Co-Defendant shall be born by each party. Other requests are dismissed.

Mrs. Kornkanya Suwanpanich

Mrs. Suwicha Nakwachara

Miss Auraphan Panaspattana