

No. 05/2013/TT-BKHCHN

*Hanoi, February 20<sup>th</sup> 2013*

**CIRCULAR**

AMENDING THE CIRCULAR NO. 01/2007/TT-BKHCHN DATED FEBRUARY 14TH 2007, GUIDING THE IMPLEMENTATION OF THE GOVERNMENT'S DECREE NO. 103/2006/ND-CP, ELABORATING A NUMBER OF ARTICLES OF THE LAW ON INTELLECTUAL PROPERTY APPLICABLE TO INDUSTRIAL PROPERTY, AMENDED IN THE CIRCULAR NO. 13/2010/TT-BKHCHN DATED JULY 30TH 2010 AND THE CIRCULAR NO. 18/2011/TT-BKHCHN DATED JULY 22ND 2011

*Pursuant to the Government's Decree No. 28/2008/ND-CP dated March 14<sup>th</sup> 2008, defining the functions, tasks, powers and organizational structure of the Ministry of Science and Technology;*

*Pursuant to the Law on Intellectual property dated November 29<sup>th</sup> 2005 and the Law No. 36/2009/QH12 dated July 19<sup>th</sup> 2009 on the amendment of the Law on Intellectual property (hereinafter referred to as the Law on Intellectual property);*

*Pursuant to the Government's Decree No. 103/2006/ND-CP dated September 22<sup>nd</sup> 2006 of the Government, elaborating and guiding the implementation of a number of articles of the Law on Intellectual property applicable to industrial property, and the Decree No. 122/2010/ND-CP dated December 31<sup>st</sup> 2010, amending the Decree No. 103/2006/ND-CP;*

The Ministry of Science and Technology amends the Circular No. 01/2007/TT-BKHCHN dated February 14<sup>th</sup> 2007, guiding the implementation of the Government's Decree No. 103/2006/ND-CP, elaborating a number of articles of the Law on Intellectual property applicable to industrial property, amended in the Circular No. 13/2010/TT-BKHCHN dated July 30<sup>th</sup> 2010 and the Circular No. 18/2011/TT-BKHCHN dated July 22<sup>nd</sup> 2011 (hereinafter referred to as the Circular No. 01/2007/TT-BKHCHN) as follows:

**Article 1. Amending some regulations of the Circular No. 01/2007/TT-BKHCHN**

**1. Point 1.1. of the Circular No. 01/2007/TT-BKHCHN is amended as follows:**

“1.1. The industrial property rights arising or established on the bases prescribed in Clause 3 Article 6 of the Law on Intellectual property, Clauses 1, 2, 3, and 4 Article 6 of the Decree No. 103/2006/ND-CP, elaborating a number of articles of the Law on Intellectual property applicable to industrial property amended in the Decree No. 122/2010/ND-CP and specific provisions in this Point.”

**2. Point 7.1.b (iii) is amended, and Point 7.1.b (iv) is added to the Circular No. 01/2007/TT-BKHCHN as follows:**

“(iii) Geographical maps (if the registered trademark is to prove the geographical origin of products, or a collective mark or certification mark that contains the geographical name or other signs indicating the geographical origin of to local specialities);

(iv) The written approval for the trademark registration issued by the provincial People's Committee as prescribed in Point 37.7.a of this Circular (if the registered trademark is a collective mark or certification mark that contains the geographical name or other signs indicating the geographical origin of to local specialities).”

**3. Point 13.8. of the Circular No. 01/2007/TT-BKHCHN is amended as follows:**

**“13.8. Deadline for examining the sufficiency of the application**

a) The sufficiency of the application shall be examined within 01 month from the day on which the application is submitted as prescribed in Clause 1 Article 119 of the Law on Intellectual property.

b) Where the National Office of Intellectual Property issues a notice as prescribed in Point 13.6.a of this Circular, the period for the applicant to reply to that notice is not included in the time limit for sufficiency examination. This period is:

(i) The period from the date of issue of the notice to the day on which the applicant replies to the notice; or

(ii) the time limit written in the notice (including the extension), in case the applicant does not replay to the notice.

c) Where the applicant actively request the revision of the application, or reply to the notice issued by National Office of Intellectual Property as prescribed in Point 13.6.a of this Circular, the deadline for sufficiency examination shall be extended to more 10 days as prescribed in Clause 4 Article 119 of the Law on Intellectual property.

d) Before the deadline prescribed in Point 13.8.a, 13.8.b or 13.8.c above, National Office of Intellectual Property must finish examining the sufficiency of the application, and notify the applicant of the result as prescribed in Point 13.6 or 13.7 of this Circular.”

**4. Point 15.6.d is amended, Points 15.6.D and 15.6.e is added to the Circular No. 01/2007/TT-BKHCHN as follows:**

“d) Before issuing the notice of the intention to grant the patent as prescribed in Point 15.7.a (iii) of this Circular, the National Office of Intellectual Property shall check whether the application is the first to file as prescribed in Points 25.7, 35.9 and 39.10 of this Circular.

dd) The notification prescribed in Point 15.7.a (iii) shall be in the following cases:

(i) The application does not fall into the cases prescribed in Article 90 of the Law on Intellectual property;

(ii) The filing date or the priority date of the application is earliest among the patent applications in the cases prescribed in Clause 1 Article 90 of the Law on Intellectual property;

(iii) The filing date or the priority date of the application is earliest among the industrial design applications in the cases prescribed in Clause 1 Article 90 of the Law on Intellectual property;

(iv) The filing date or the priority date of the application is earliest among the trademark applications in the cases prescribed in Clause 2 Article 90 of the Law on Intellectual property;

(v) The application is made under an agreement as prescribed in Clause 3 Article 90 of the Law on Intellectual property.

e) The applications not falling in the cases prescribed in Point 15.6.dd of this Circular shall be dealt with as follows:

(i) The issuance of the patent is refused because the application is not the first to file; if the filing date or priority date is earliest, the patent shall be granted; or

(ii) The application is considered the first to file, and dealt with as prescribed in Point 15.6.dd; if the issuance of the patent to the applications of which the earlier filing date or priority date is refused or withdrawn, such applications are considered withdrawn.”

**5. Point 15.7.a (iii). of the Circular No. 01/2007/TT-BKHHCN is amended as follows:**

“(iii) If the objects in the application satisfy the protection conditions, or errors are rectified, or acceptable explanation is provided by the deadline prescribed in Points 15.7.a (i) and (ii) above, the National Office of Intellectual Property shall issue a notice of substantive examination, in particular:

- For the applications in the cases prescribed in Point 15.6.dd of this Circular: notify the intention to grant the patent and give the applicant 01 month from the notifying date to pay the fee for patent grant, fee for announcing the decision to grant the patent, fee for registration, and fee for invention validity maintenance in the first year. The applicant may request the extension of this deadline as prescribed in Point 9.2 of this Circular.

- The applications not falling into the cases in Point 15.6.dd of this Circular shall be dealt with in accordance with Point 15.6.e of this Circular.”

**6. Point 15.8. of the Circular No. 01/2007/TT-BKHHCN is amended as follows:**

**“15.8. Time limit for substantive examination**

a) The time limit for substantive examination is specified in Clause 2 Article 119 of the Law on Intellectual property.

b) Where the National Office of Intellectual Property issues a notice as prescribed in Point 15.7.a (i) and (ii) of this Circular, the period for the applicant to reply to the notice is not included in the time limit for substantive examination. This period is:

(i) The period from the date of issue of the notice to the day on which the applicant replies to the notice; or

(ii) the time limit written in the notice (including the extension), in case the applicant does not replay to the notice.

c) Where the applicant actively request the revision of the application, or reply to the notice issued by National Office of Intellectual Property as prescribed in Points 15.7.a (i) and (ii) of this Circular, the deadline for substantive examination shall be extended to match the deadline for request for application revision or explanation of the applicant as prescribed in Clause 4 Article 119 of the Law on Intellectual property, in particular:

(i) Within 06 months, applicable to inventions;

(ii) Within 03 months, applicable to trademarks;

(iii) Within 02 months and 10 days, applicable to industrial designs;

(iv) Within 02 months, applicable to geographical indications.”

**7. Point 25.7. of the Circular No. 01/2007/TT-BKHCHN is amended as follows:**

**“25.7. Inspecting the conformity to the first-to-file rule of inventions**

For the patent applications that satisfy the protection conditions, before issuing the notice of intention to grant the invention patent or utility patent as prescribed in Point 15.7.a (iii) of this Circular, National Office of Intellectual Property shall inspect the conformity to the first-to-file rule as prescribed in Clause 1 and Clause 3 Article 90 of the Law on Intellectual property, in accordance with the following provisions:

- a) To inspect the conformity to first-to-file rule, it is required to seek information in the following sources (not restricted to only these sources): all invention applications received by the National Office of Intellectual Property (up to the date of inspection) that have the same classification code as that of the objects in the examined application - up to the third level – and have earlier filing dates or priority dates (if the application is entitled to priority) than that of the examined application that have not been announced, or the announcement date is later than the filing date or the priority date (if the application is entitled to priority) of the examined application.
- b) The information collection is to identify the case in which many applications (including the examined application) register the same or similar inventions, and identify the application which has the earliest filing date or priority date.
- c) If there are many applications falling in the case prescribed in Point 25.1.b above, the invention patent or utility solution patent is only granted to the application that has the earliest filing date of priority date among the patentable applications.
- d) Among the applications prescribed in Point 25.7.b above, if there are many applications that have the same filing date of priority date, the invention patent or utility patent is granted to the invention of only one application among them under the agreement of all applicants; if an agreement cannot be reached, all applications shall be rejected.”

**8. Point 35.9. of the Circular No. 01/2007/TT-BKHCHN is amended as follows:**

**“35.9. Inspecting the conformity to the first-to-file rule of industrial designs**

For the industrial design applications that satisfy the protection conditions, before issuing the notice of intention to grant the industrial design patent as prescribed in Point 15.7.a (iii) of this Circular, National Office of Intellectual Property shall inspect the conformity to the first-to-file rule as prescribed in Clause 1 and Clause 3 Article 90 of the Law on Intellectual property, in accordance with the following provisions:

- a) To inspect the conformity to the first-to-file rule, it is required to seek information from the sources prescribed in Point 35.4.b (iv) of this Circular.
- b) The information collection is to identify the case in which many applications (including the examined application) register the same or similar industrial design of a part or a product, and identify the application which has the earliest filing date or priority date.
- c) If there are many applications falling in the case prescribed in Point 35.9.b above, the industrial design patent is only granted to the application that has the earliest filing date of priority date among the patentable applications.

c) Among the applications prescribed in Point 35.9.b, if there are many applications that have the same filing date of priority date, the industrial design patent is granted to the industrial design of only one application among them under the agreement of all applicants; if an agreement cannot be reached, all applications shall be rejected.

**9. Point 37.7. of the Circular No. 01/2007/TT-BKHCHN is amended as follows:**

**“37.7. Requirements of written permission for the registration of collective marks and certification marks that contain geographical names or other indicators of geographical origins of Vietnam’s local specialities**

a) The written permission for the registration of collective marks and certification marks that contain geographical names or other indicators of geographical origins of local specialities shall be issued by the following agencies:

(i) The provincial People’s Committee in charge of the geographical area corresponding to the geographical name or indicator of geographical origin of local specialities (if the geographical area is under the management of one local government);

(ii) All provincial People’s Committees in charge of the geographical area corresponding to the geographical names or indicators of geographical origins of local specialities (if the geographical area is under the management of multiple local governments).

b) The geographical map corresponding to the geographical name or indicator of geographical origin local specialities must sufficient information to identify that geographical area, and be certified by the competent agency stated in Point 37.7.a above.”

**10. Point 37.8. is added to the Circular No. 01/2007/TT-BKHCHN as follows:**

**“37.8. Criteria for identifying geographical names and indicators of geographical origins of products**

a) The indicators of geographical origins of products are the indicators used for local products that meant to indicate the geographical origins of the products (indicate that the products are originated from some locality).

The indicator of geographical origin of a product is usually a geographical name, but might be a symbol of the locality (images of typical objects of the locality such as a symbol, a map, a flag, a badge, an attraction, a distinctive construction, etc.) or any other sign.

A geographical name might be a current name or a past name, an official name or traditional name of a geographical area (according to the administrative boundary or geographical methods).

b) A geographical name, a local symbol used for a usual product (not a speciality) may or may not indicate its geographical origin, depending on the product and the use of geographical name and local symbol.

c) Geographical names or local symbols are meant to indicate the geographical origin products in the following cases:

(i) They are used for local specialities (special and well-known products because of certain characteristics, which are produced locally);

(ii) They are used for local plants, animals, and products thereof;

(iii) They are used for local products of mineral extraction (coal, iron, steel, aluminum, cement, stone, salt, timber, etc.);

(iv) They are used for the products from local develop industries;

(v) Other cases depend on the products and the use of geographical names and local symbols.

d) Geographical names and local symbols are not meant to indicate the geographical origin of products in the following cases:

(i) They are used as a usual trademark and widely recognized, which means they are considered to only indicate commercial origin, and does not indicate a geographical origin, e.g. Hanoi Beer, Sai Gon Beer;

(ii) The corresponding geographical area is not the place where the products are made, e.g. Arctic Cigarette, etc.

The geographical names and local symbols that are not meant to indicate geographical origin of products may be protected as a usual trademark without permission of local governments.

dd) The common geographical names and local symbols (such as names of provinces, cities, attractions) used for ordinary products of a locality (including the products of which the manufacture is at an advantage, but does not have a reputation or distinctive quality), used by local traders for their goods and services, and meant to indicate the origin (but are not eligible for being classified in to type (c) and type (d) above) shall not be protected.

However, a geographical name or local symbol may be used as a secondary constituent of an ordinary trademark of a corresponding local trader, as long as such geographical name is removed from protection, and exempt from obtaining permission of the local government.

#### **11. Point 39.10 of the Circular No. 01/2007/TT-BKHCN is amended as follows:**

##### **“39.10. Inspecting the conformity to the first-to-file rule of trademarks**

For the industrial design applications that satisfy the protection conditions, before issuing the notice of intention to grant the Certificate of trademark registration prescribed in Point 15.7.a (iii) of this Circular, National Office of Intellectual Property shall inspect the conformity to the first-to-file rule as prescribed in Clause 2 and Clause 3 Article 90 of the Law on Intellectual property, in accordance with the following provisions:

a) To inspect the conformity to the first-to-file rule, it is required to check all applications for trademark registration received by the National Office of Intellectual Property (up to the date of inspection) that have earlier filing dates or priority dates (if the application is entitled to priority) than that of the examined application.

b) The information collection is to identify the case in which many applications (including the examined application) register the same or confusingly similar trademark of the same or similar products or services, or many applications made by the same applicant register identical trademark of identical products or services; and identify the earliest filing date of priority date.

c) If there are many applications falling in the case prescribed in Point 39.10.b above, the Certificate of trademark registration is only granted to the trademark is the application that has the earliest filing date or priority date among the patentable applications.

d) Among the applications prescribed in Point 39.10.b above, if there are many applications that have the same filing date of priority date, the Certificate of trademark registration shall be granted to the trademark of only one application among them under the agreement of all applicants; if an agreement cannot be reached, all applications shall be rejected.”

**Article 2. Effect**

This Circular takes effect after 45 days from the day on which it is signed./.

**THE MINISTER**

**Nguyen Quan**