

Critical Changes To Vietnam's Patents, Trademarks, And Industrial Designs Under Circular No. 16/2016/TT-BKHCN You Need To Know

A new circular from the Ministry of Science and Technology, Circular No. 16/2016/TT-BKHCN ("Circular 16"), which became effective on January 15, 2018, modifies and supplements several articles of Circular No. 01/2007/TT-BKHCN, detailing and guiding the implementation of the Law on Intellectual Property regarding industrial property. The following is a summary of significant modifications to Vietnam's patent, industrial design, and trademark procedures made pursuant to Circular 16 in order to provide you with a better insight thereof.

1. Patent

Six (6) important amendments to the patent sector are outlined in Circular 16 as follows:

- (i) **Use-related claims:** The Intellectual Property Office of Vietnam (**IP VIETNAM**) will not accept any use-related claims in an invention filed for a patent in Vietnam, regardless of claim wording or technical field.
- (ii) **Late entry:** Late entry of PCT applications into the national phase of Vietnam is no longer permitted.
- (iii) **Late request of substantive examination:** A late request for substantive examination is not permitted, unless the applicant experiences a verifiable event of force majeure (natural disasters, sabotage by an enemy, etc.) or objective obstacle (sickness, business trips, studying far away, etc.).
- (iv) **Vietnamese invention or a Vietnamese-made invention:** It is expressly stated that IP VIETNAM will not accept a patent application for a Vietnamese invention or a Vietnamese-made invention that has already been filed abroad, even if it was filed directly with the WIPO.
- (v) **Patent post-grant narrowing:** Post-grant restriction of a patent's scope of protection is limited to the removal of one or more claims from the granted claim set.
- (vi) **New provisions of patent specifications:** The "**Objective of the Invention**" section must be included in the patent specification. It may also be expressed as a separate section preceding the "Summary of the invention" section, or as a subsection of that section. The section "**Examples**" is no longer a must-have in the patent specification. The section "**Achievable benefits/ efficiency**" is no longer a must-have in the patent description. In addition, it may be expressed as a separate section, or as a subsection of section "Summary of the invention".

2. Industrial Design

Two (2) noteworthy modifications to the industrial design sector are detailed in Circular 16 as follows:

- (i) **Divisional design application:** The fee for claiming priority under the Paris Convention will be charged for divisional design applications that are filed due to the failure to meet the requirement of unity.
- (ii) **Narrowing the scope of design patent:** The design owner may limit the scope of the design patent by removing one or more industrial design variations or one or more products from the set of claimed products. No longer is it permissible to limit the scope of a design patent by omitting one or more non-essential design elements.

3. Trademark

Four (4) significant modifications to the trademark sector are detailed in Circular 16:

- (i) **Certification and Collective marks:** It is specified which organizations are eligible to register certification marks and collective marks in Vietnam.
- (ii) **Well-known marks:** When a well-known trademark is recognized in a decision on settlement of infringement of the well-known trademark or a decision on refusal of another mark based on the well-known trademark, the well-known trademark will be added to IP VIETNAM's list of well-known marks. With this provision, it is clear that there is no independent procedure for recognizing well-known

trademarks in Vietnam. Instead, a mark can only be recognized as well-known through other proceedings, such as the enforcement or examination of a trademark that is identical or confusingly similar to a well-known mark.

- (iii) **Disclaimer:** In the event of a disclaimer, IP VIETNAM must state explicitly the intention and reason for such a disclaimer, and the applicant has three (03) months from the date of notification to state its opinion regarding such a disclaimer.
- (iv) **Time limit and procedures to deal with IR designating Vietnam:** If an International Registration designating Vietnam is provisionally refused by IP VIETNAM, the applicant may file a response within three (03) months from the date of IP VIETNAM's notification, using the same procedure as national applications, i.e. filing a response with IP VIETNAM. If the response is not accepted, IP VIETNAM will issue a decision of refusal, against which the applicant may file an appeal during the appeal proceedings.
- (v) **Partial refusal:** In the event that IP VIETNAM decides to partially refuse a trademark under an international registration, it will only decide the mark's protection for the portion that meets the protection requirements.

4. General rules

Nine (9) notable revisions to the general provisions are detailed in Circular 16:

We provide hereunder 9 notable changes in the general rules found in Circular 16.

- (i) **Power of Attorney (PoA):** In Vietnam, a PoA may be submitted after filing, but is required within one month of the filing date (except for PCT-derived application where PoA can be submitted within 34 months from the earliest priority date as before). In the event of an appeal, a Power of Attorney is required within 10 days of the appeal's filing date.
- (ii) **More than one IP agents for one IP application:** If the applicant empowers multiple IP agents to handle different proceedings for a single application, IP VIETNAM will contact only the most recently recorded IP agent.
- (iii) **Time limit for responding to IP VIETNAM's formality examination Notice:** Since January 15, 2018, the deadline for responding to IP VIETNAM's Notices during the formality examination stage has been extended from one month to two.
- (iv) **Time limit for responding substantive examination Notice:** As of January 15, 2018, the time limit for responding to IP VIETNAM's Notification during substantive examination has been increased from two months to three.
- (v) **Time limits for responding to IP VIETNAM's Notifications on Intention to grant:** Time limits for responding to IP VIETNAM's Notices of Intention to Grant have been increased from one month to three months as of January 15, 2018.
- (vi) **Restoring examination process:** IP VIETNAM may consider rescinding a refusal decision and resuming the examination process if the applicant can identify or provide new factors (that were not considered during the examination process) that may have influenced the examination results.
- (vii) **Third party's observation proceeding:** In an observation proceeding involving a third party, the third party will also be informed of the application's substantive examination result.
- (viii) **Appealing against IP VIETNAM's Decisions/Notices:** Circular 16 contains detailed provisions on the eligibility of appellants, decisions subject to appeal, the statutory limitation of appeal, appeal settlers, appeal requirements, appeal settlement timeframe, etc. The most noteworthy is that in order to appeal a decision/notification, the appellant must demonstrate the illegitimacy of the appealed decision/notification. In an appeal proceeding, IP VIETNAM evaluates the legitimacy of the appealed decision/notification only at the time it is issued. It is expressly stated that amendments or new evidence will not be accepted during the appeals process. In the past, an appeal containing new evidence (new

fact) was accepted during the appeals process. In the past, an appeal containing new evidence was accepted during the appeals process.

- (ix) **Cancellation/invalidation proceedings:** IP VIETNAM is requested to inform the IP holder of the cancellation/invalidation request within one (01) month from the requesting date.

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