

Three options to accelerate patent examination in Vietnam

The examination of a patent application's patentability in Vietnam is time-consuming. A typical examination would necessitate access to databases of prior art for novelty and inventiveness comparisons against what has already been disclosed or practiced. Despite recent advancements in conducting substantive examination for patent applications, the Intellectual Property Office of Vietnam (VNIPPO) tends to grant patents based on the grant of the corresponding patent from countries with more developed IP systems or examination results of the corresponding patent application from more established Patent Offices such as those of the United States, Japan, South Korea, and the European Patent Office.

In the absence of such foreign grants of corresponding patent applications, the patent application process is likely to be delayed for as long as at least 3 years or longer in Vietnam.

Hereunder are **three options to accelerate patent examinations in Vietnam**.

I. Accelerated examination by filing a request directly with VNIPPO

Statutorily, a patent/utility solution application shall be substantively examined only after being published on the official Industrial Gazette of Vietnam or after the date of requesting for the examination from the applicant, whichever is later. At that time, VNIPPO will assign an examiner to conduct substantive examination for the application.

Article 9.6 of Circular 01/2007/TT-BKHHCN, as amended by Circular No. 16/2016/TT-BKHHCN, which took effect from January 15, 2018, allows applicants to file a request for accelerated examination with VNIPPO, subject to payment of additional fees if the request is accepted. Despite the aforesaid, due to the backlog of patent application examination at VNIPPO, such an acceleration request is rarely accepted or granted on a case-by-case basis with prior approval of VNIPPO's relevant persons.

The most common justification recognized by VNIPPO for accelerated examination of a patent application is the applicant's intention to market the filed invention in Vietnam. VNIPPO may accept to expedite patent application examination if the applicant provides the following information and/or documents:

- ✓ Documents indicating that the applicant has invested and conducted business in Vietnam and wants to produce products related to the patent application in order to create jobs for Vietnamese citizens and contribute to the national economic development, etc.;
- ✓ Information about the counterpart (*an application is substantially similar to the present patent application*) which has been granted in some developed countries and jurisdiction such as China, Korea, Japan, the United States of America or by the European Patent Office, etc.

II. Accelerated examination by using the Patent Prosecution Highway (PPH)

1. What is the PPH?

The PPH is an initiative between certain national IP offices which provides a means of significantly accelerating the examination of a patent application in one IP office where examination work has already been conducted at another IP office. In other words, the PPH enables an application whose claims have been determined to be patentable in the office of first filing to undergo an accelerated examination in the office of second filing with a simple procedure upon a request from an applicant on the basis of bilateral office agreements. It also allows sharing information between involved IP offices.

Currently, there are two PPH pilot programs including:

- The VNIPPO-JPO PPH pilot program is the 3-year period program established between IPVN and JPO with 200 patent cases per year divided into 02 stages in which 100 cases will be received by IPVN from 1st April, and the next 100 cases will be received from 1st October. The latest PPH pilot period has been approved to be extended for 3 years from 01 April 2022 to 31 March 2025.
- The VNIPPO-KIPO PPH pilot program is the 2-year period program established between IPVN and KIPO with 100 patent cases per year. The latest PPH pilot period has been approved to be extended for 2 years from 01 April 2022 to 31 March 2025.

2. Some key notes

- The substantive examination stage would statutorily take around 18 months from the date on which a request for substantive examination is filed or from the date of the application publication, whichever comes later. By means of the PPH program, the duration for such substantive examination can be shortened to 9-12 months computed from the filing date of a PPH request.
- When filing a request for the PPH pilot program, applicants must submit a request form to VNIPO.
- The Offices may terminate the PPH pilot program if the volume of PPH request exceeds the prescribed number per year, or for any other reason. A prior notice will be published if the PPH pilot program is terminated.
- When the duration of the PPH pilot program is expired, the PPH pilot program may be extended after undergoing the review and assessment of the program implementation by the relevant Offices.
- The pilot program is not applicable on the basis of JPO 'utility model' applications.

3. What is the requirement for the PPH?

Generally, in order for a patent application to participate in the PPH program, the following requirements on the application need to be met:

a) The VNIPO application (including a PCT national phase application) is

(i) an application which validly claims priority under the Paris Convention to the JPO (or KIPO) application(s), or

(ii) a national phase application of a PCT application without priority claim filed at JPO (or KIPO) as receiving office (the application number begins with PCT/JP (or PCT/KR), hereafter referred to as PCT/JP (or PCT/KR) application), or

(iii) an application which validly claims priority under the Paris Convention to a PCT/JP (or PCT/KR) application(s) referred to in (ii) above.

The VNIPO application, which validly claims priority to multiple JPO (or KIPO) or direct PCT applications, or which is the divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

b) At least one corresponding application exists in JPO (or KIPO) and has one or more claims that are determined to be patentable/allowable by JPO (or KIPO)

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the JPO (or KIPO) application which forms the basis of the priority claim (e.g., a divisional application of the JPO (or KIPO) application or an application which claims domestic priority to the JPO (or KIPO) application, or an JPO (or KIPO) national phase application of a PCT application.

Claims are "determined to be allowable/patentable" and do not suffer from any deficiencies related to unity, clarity, support by description when the JPO (or KIPO) examiner clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet.

c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in JPO (or KIPO)

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in VNIPO are of the same or similar scope as the claims in JPO (or KIPO), or the claims in VNIPO are narrower in scope than the claims in JPO (or KIPO).

A claim in VNIPO which introduces a new/different category of claims to those claims indicated as allowable in JPO (or KIPO) is not considered to sufficiently correspond.

d) VNIPO has not begun examination of the application at the time of request for the PPH (an example is provided in ANNEX, figure M).

e) A "Request for Substantive Examination" must have been filed at VNIPO either at the time of the PPH request or previously

4. Procedure for the accelerated examination under the PPH program

VNIPO decides whether the application is eligible for accelerated examination under the PPH when it receives a request containing sufficient required documents. When VNIPO determines that the request is acceptable, a special status for accelerated examination under the PPH is assigned to the application.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given the opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again.

III. Accelerated examination by using the ASEAN Patent Examination Co-operation (ASPEC)

ASEAN Patent Examination Co-operation (ASPEC) is the first regional patent work-sharing programme among nine participating ASEAN Member States (AMS) IP Offices of Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Vietnam.

The purpose of this programme is to share search and examination results between the participating offices to allow applicants in participating countries to obtain corresponding patents faster and more efficiently. The programme will potentially reduce duplication on the search and examination work done, thereby saving time and effort. Additionally, search and examination work done on a corresponding application serves as a useful reference in producing quality reports.

As of 15 June 2021, as an alternative to the final S&E report, applicants may also use the written opinion (*a non-final assessment of novelty, inventive step, and industrial applicability*) established by the First IP Office to request ASPEC before the Second IP Office, provided that the Written Opinion acknowledges at least one allowable claim. The sole exception is the Thai IP Office, which continues to accept only final search and examination results in ASPEC requests. Applicants will no longer be required to address any objections raised by the First IP Office, wait for the final examination report to be issued, and then file an ASPEC request with the Second IP Office. Instead, they may file an earlier ASPEC request with the Second IP Office, accompanied by a Written Opinion from the First IP Office, even if not all of the claims are allowed.

By:

QUAN, Nguyen Vu
Partner & IP Attorney

NGA, Dao Thi Thuy
Senior Patent Associate

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com