

5 questions to assess whether your product infringes patents in Vietnam

You are a patent holder who suspects that a competitor's product is being manufactured in violation of your patent rights. In a different context, you wish to bring a product to market but are unsure whether it infringes on a protected patent in Vietnam. Of course, regardless of what context, whether you are a patent owner or a manufacturer of an unpatented product, the simplest way to determine patent infringement is to file a patent infringement assessment with the Vietnam Intellectual Property Research Institute (or "VIPRI" for short). However, this assessment will cost a considerable amount of money, so it is critical to comprehend the fundamental principles and laws for evaluating patent infringement in Vietnam before submitting a request for patent infringement assessment with the VIPRI.

1. How can the likelihood of patent infringement in Vietnam be determined?

In order to determine the likelihood of infringing on another's invention in Vietnam, you are required to compare the patented invention with the product intended for commercialization in order to determine the identity or equivalence between the two. Based on this comparison, you can determine whether your product poses a high or low risk of infringing on the presently protected invention.

2. On what basis should the possibility of patent infringement in Vietnam be compared and evaluated?

The scope of patent protection, which is determined by the claims of the Patent or Utility Solution Patent, serves as the basis for comparing and assessing the likelihood of patent infringement. The claims of a patent are usually shown immediately after the patent specification, and are the core of any invention because they are used to define the scope of industrial property rights to the invention. If your product falls into the scope of a patented invention, patent infringement will occur and vice versa.

The Vietnamese enforcement agency will look into and assess the identity or equivalence of the protected invention and the suspected infringing product/process based on the scope of protection or claims of the patent specification.

Therefore, in order to determine the likelihood of patent infringement in Vietnam, it is required to thoroughly examine the patent's claims in order to ascertain the scope of protection afforded to the patented invention. Please note that, the structure of a patent claim typically includes one or more claims in the form of an **independent claim** and a **dependent claim**. Each claim shall demonstrate the technical nature of a claimed subject matter, including basic technical features that form necessary and sufficient collective to identify the claimed subject matter, to achieve the intended purposes, to distinguish the claimed subject matter from the known ones

- (i) **An independent claim** shall include all of the basic technical features (characteristics) that form a necessary and sufficient collective to identify the claimed subject matter, to achieve the intended purposes, to distinguish the claimed subject matter with the known ones.
- (ii) **A dependent claim** is a claim that refers back to another claim or claims before it, containing all of the features (characteristics) of the claims from which it depends and adding further features (characteristics) to develop the claimed subject matter into a specific variant. Dependent claims that share one or more additional features (characteristics) may be appropriately grouped into one dependent claim, which refers to one or more independent and dependent claims from which it depends.

3. How do you compare between the patented invention with your product?

To determine whether your product is identical or equivalent to a protected invention, you must compare it to the protected invention. The principle of comparison is provided in Article 11, Circular 11/2015/TT-BKHCN, which stipulates that: A product/product part/process in question shall be regarded as identical or similar to a protected product/product part/process in a certain (*independent and dependent*) point of the protection request in an invention patent/utility solution patent if **all basic technical specifications (features)** stated in that point can be found in the product/product part/process in question in the identical or similar form.

What are basic technical features?

Basic technical features are **all** of the technical features (characteristics) that are influential to the nature of the technical solutions and without them the claimed technical solutions cannot be assembled and cannot achieve their intended purposes or solve the referenced problems.

Where can you find the *basic technical features* of a patented invention in the patent specification? They are shown **in the scope (claim) of patent protection**. Basic technical features are its characteristics in terms of function, utility, disposition, inter-connection, composition, etc., which constitute, together with other basic features, a prerequisite and sufficient combination to determine the nature (content) of the object.

Whether or not there is an element of patent infringement?

The most crucial aspect of assessing whether an infringement has occurred is determining whether the subject matter under consideration has an infringing element. Article 8, Decree 105/2006/ND-CP stipulates that: An infringing element of an invention may take one of the following forms: **(i)** Product or part (component) of a product that is identical or equivalent to a product or part (component) of a product being protected as an invention; **(ii)** Process that is identical or equivalent to a process being protected as an invention, and **(iii)** A product or part (component) of the product produced through a process that is **identical** or **equivalent** to a process being protected as an invention.

Moreover, in order to determine the degree of identity or equivalence between the suspected product and the patented invention, it is necessary to rely on Article 11 of Circular 11 issued by the Ministry of Science & Technology in 2015, specifically:

- (a) *Two technical features are regarded identical if they have the same nature, utility and method of utilization and share the same connection with other features stated in the claim;*
- (b) *Two technical features are regarded similar if they have similar or interchangeable natures and basically the same utility and method of utilization.*

Therefore, it is possible to conclude that the suspected product is deemed “**identical**” to the patented invention if **all** their basic features are identical or equivalent (or interchangeable).

The suspected product is deemed “**equivalent**” to the patented invention if **most of** their substantial features are identical or equivalent (or interchangeable). Please note that two signs shall be considered equivalent if they have similar natures, the same objective and basically similar ways to achieve the objective.

When comparing the scope of the claim between the product under consideration and the patented invention, you need to find “*all basic technical feature) mentioned in the claim*” of the invention as compared to “*all basic technical features*” in your product. If your product contains “*all of the basic technical signs (features) mentioned in the claim*” of the invention, your product will be deemed **infringing elements of patent rights**.

Based on an assessment of whether your product is an infringing element of patent rights, you can determine for yourself whether the commercialization of your product constitutes an infringement of the rights to the protected invention and, subsequently, take business-appropriate actions.

4. When a patent infringement does not occur?

The question you or the manufacturer is often interested in is that if a suspected product does not contain one of the “*basic technical features mentioned in the claim*” of the invention, whether such product is considered an infringing element of the patent? Article 11.2 Circular 11/2015/TT-BKHCN provides that “*If a product/product part/process in question **does not contain at least** one basic technical specification (feature) stated in a certain point of the protection request, it shall be **regarded as neither identical nor similar** to any product/product part/process protected under that point.*” This means that, if your product does not contain “*at least one essential feature (feature) mentioned in the claim*” of the invention, your product is not considered an infringing element of the invention.

Therefore, it is conceivable that, if the product does not contain at least one basic technical feature in any patent claim, there is no patent infringement.

5. What is the formula to determine patent infringement in Vietnam?

The approach of determining the likelihood of patent infringement can be generalized based on the following formula, where a, b, c, d and e are the basic technical features, A is the protected invention, and B is the suspected product:

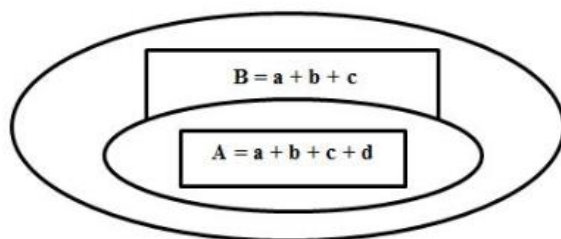


Fig. 1: B is NOT infringing A

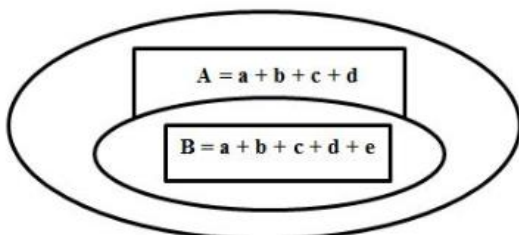


Fig. 2: B is infringing A (literally)

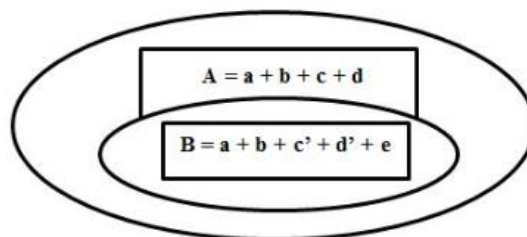


Fig. 3: B is infringing A (equivalently)

Figure 1: B DOES NOT INFRINGE A. The protected invention (A) includes 04 basic technical features (that is, a; b; c and d). The suspected infringing product (B) has only 03 features (that is, a, b and c). In this case, product B is not an infringing element of the rights to the protected invention A.

Reason: Product B does not contain all four basic technical features of Invention A.

Figure 2: B INFRINGES A (LITERAL INFRINGEMENT). The protected invention (A) includes 04 basic technical features (that is, a; b; c and d). The suspected infringing product (B) includes 05 characteristics (a; b; c; d and e). In this case, product B is an infringing element of the rights to the protected invention A.

Reason: Despite the addition of the "e" sign, since product B already contains all four basic technical features of Invention A, product B is an infringing element of the rights to the protected invention A.

Figure 3: B INFRINGES A (EQUIVALENT INFRINGEMENT). The protected invention (A) includes 04 basic technical characteristics (that is, a; b; c and d). The suspected infringing product (B) consists of five characteristics (a; b; c'; d' and e). In this case, product B is an infringing element of the rights to the protected invention A.

Reason: Despite the addition of sign "e", since signs c' and d' are similar to signs c and d of the protected invention, product B is an infringing element of the rights to the protected inventions A.

A bottom line:

Determining the likelihood of patent infringement is a complex process, but it is governed by clear principles. Patent owners or related parties can independently analyze the risk of patent infringement by comparing the intended manufactured product to the patented invention. This will be the initial basis for determining the next steps: whether to continue or cease manufacturing, or how to reduce the risk of damages in the event of a patent dispute.

Please select a professional IP service provider to work with if you want your business to grow in the proper direction.

KENFOX IP & LAW OFFICE, one of the professional IP service providers with the strongest and fastest growth in patent services, offers a comprehensive range of IP services in Vietnam, Laos, Cambodia, Myanmar, and other Asian nations. KENFOX entered the list of the top ten patent filing companies at IP Vietnam in 2019. In 2020 and 2021, KENFOX ranked among Vietnam's top 20 patent filing firms.

KENFOX is proud to be consistently voted "Boutique Trademark Law Firm of the Year in Vietnam" by major international organizations in 2021-2022 by Global Law Experts and "Laos IP Firm of the Year for the 2021 Asia IP Awards" by Asia IP.

Contact KENFOX IP & Law Office immediately if you need a professional intellectual property services firm to assist you in developing your business in the proper direction.

By Nguyen Vu QUAN
Partner & IP Attorney

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