
Comparisons between old and new regulations under Circular No. 16/2016/TT-BKHCN (effective as of 15 January 2018) and Circular No. 01/2007/TT-BKHCN (latest revised in 2013)

One of the most notable statutes in 2018 is Circular No. 16/2016/TT-BKHCN (**Circular 16**), which was issued on 30 June 2016 by the Ministry of Science and Technology of the Government of Vietnam which amends and supplements a number of articles of Circular No. 01/2007/TT-BKHCN (**Circular 01**). The Circular 16 came into force on 15 June 2018. This Circular is issued in an effort to provide and specify important guidelines in implementing the Intellectual Property Law of Vietnam. The amended circular has made a significant impact on the IP practice in Vietnam as it modified almost 49 out of 67 points present in the currently followed Circular 01. The amendments in Circular 16 mostly applied on the examination procedures conducted by the Intellectual Property Office of Vietnam (**IP Viet Nam**) related to Patent, Trademarks, Designs and other IPR.

Contents	New regulations under Circular No. 16/2016/TT-BKHCN (“Circular 16”)	Old regulations under Circular No. 01/2007/TT-BKHCN (“Circular 01”)	Comments/Notes
<i>General Matters</i>	<p>Power of Attorney (PoA):</p> <p>Possible to submit the original PoA after filing, but required within 1 month from the filing date in Vietnam (except for PCT-derived application where the PoA can be submitted within 34 months from the earliest priority date as before).</p> <p>In case of appeal, PoA is required within 10 days from the date of filing the appeal</p>	<p>Power of Attorney (PoA):</p> <p>Possible to submit the original PoA after filing, and not required within 1 month from the filing date in Vietnam.</p>	<p>Under Circular 16 and current practice, late submission of PoA can be accepted only when the applicant submits verifiable evidence proving that he/she encountered some force majeure event or objective obstacle.</p> <p>The IP Office of Vietnam does no longer accept PoA with the date later than the date of filing in Vietnam except for the specific PoA which specifies specific application number.</p>
	<p>Authorization/entrustment to IP agent:</p> <p>Where the applicant assigns more than one IP agents to proceed with</p>	<p>Authorization/entrustment to IP agent:</p> <p>Not explicitly provided</p>	<p>Problematic if the main IP agent does not receive all Notices and office actions related to a mark.</p>

<p>different proceedings for one application, the NOIP will only contact the latest IP agent on record</p>		
<p>Deadlines for response to office actions:</p> <ul style="list-style-type: none"> ✓ 02 months for response to formality examination Notice. This deadline may be extended once for a 2-month period. ✓ 03 months for response to substantive examination Notice. This deadline may be extended once for a 3-month period. ✓ 03 months for paying the fee of grant (registration fee). Extendable for a similar period. 	<p>Deadlines for response to office actions:</p> <ul style="list-style-type: none"> ✓ 01 month for response to formality examination Notice. This deadline may be extended once for a 1-month period. ✓ 02 months for response to substantive examination Notice. This deadline may be extended once for a 2-month period. ✓ 01 month for paying the fee of grant (registration fee). Extendable for a similar period. 	<p>More practical timeframe for the applicant as compared to previous regulation</p>
<p>Withdrawal of Decisions on refusal <i>(Point 15.7):</i></p> <p>If the applicant uncovers/provides new details (facts) that may affect the</p>	<p>Withdrawal of Decisions on refusal: required to file an appeal</p>	<p>Remain unclear/controversial about in which context the details/facts are deemed new for the NOIP to consider withdrawing its refusal</p>

	examination result, but has not been considered in the examination, the NOIP may consider withdrawing the refusal decision after reviewing them and carrying out of the re-examination process		decision.
	<p>Force Majeure and objective obstacles (<i>Point 9.4 & 9.5</i>):</p> <p>The duration of Force Majeure Events and/or Objective Obstacles will be excluded from running of statutory time limit. To enjoy this exclusion, the IP owners must submit a request accompanied with reasonable and justifiable evidences</p>	<p>Force Majeure and objective obstacles: N/A</p>	<p>Force Majeure and objective obstacles were provided in the Civil Code and often referred as excuses for missing deadlines. This is the 1st time such regulation is codified.</p> <p>The IP Office of Vietnam will decide to accept the alleged Force Majeure and objective obstacles on case-by-case basis and the decision will depend much on the subjective opinions of the responsible examiner.</p>
	<p>Opposition settlement procedures:</p> <p>The IP Office of Vietnam is under</p>	<p>Opposition settlement procedures:</p> <p>The IP Office of Vietnam was only</p>	<p>The new regulation on opposition settlement is helpful in facilitating</p>

	<p>obligation, if the opposition is found reasonable, to inform the opposing party of the substantive examination result of the opposed mark.</p>	<p>required to notify the opposing party of the final opposition result, not the substantive examination result of the opposed mark.</p>	<p>the opposing party to follow up the opposition settlement.</p>
	<p>Appeals and appeal settlement (<i>Point 22.1(c)</i>)</p> <ul style="list-style-type: none"> • Exclusion from the subject of appeal (<i>Point 22.1</i>): The following contents are excluded from the subject of appeal: <ul style="list-style-type: none"> ✓ Requests for amendment or supplement of the subject application; ✓ New facts/details that have not been submitted during the examination progress, which can change the appealed notice/decision; ✓ In cases where the appellant is not the applicant, new facts that are not within the responsibility of the NOIP 	<p>Appeals and appeal settlement:</p> <p>The IP Office of Vietnam used to accept new facts/details submitted by the applicant to overcome the refusal decision.</p> <p>Independent advisory experts and advisory councils:</p> <p>N/A</p>	<p>Under current practice, the applicant should submit all possible arguments upon filing a response to the substantive examination notice. The most significant change is that in order to appeal against a decision/notification, the appellant must prove the illegitimacy of the appealed decision/notification. In an appeal proceeding, the NOIP only considers the legitimacy of the appealed decision/notification at the time it is issued. It is explicitly provided that amendments or new facts will not be accepted at the appeal stage. Meanwhile, in practice in the past, an appeal submitting new</p>

	<p>during the examination progress. In such cases, the appellant may file a request for additional examination</p> <ul style="list-style-type: none"> • Independent advisory experts and advisory councils: <p>In complicated case, the appeal settlement body of the IP Office of Vietnam may seek the opinions/consultation from independent advisory experts or set up a consultation council to provide advice on handling of appeals.</p>		<p>facts is accepted at the appeal stage</p>
	<p>Termination and invalidation of a granted protection title:</p> <p>Within 01 month from the date of receipt of the termination or invalidation request, the IP Office of Vietnam must send a Notice to the rights holder.</p>	<p>Termination and invalidation of a granted protection title:</p> <p>No regulation on time-limit for the IP Office of Vietnam to send a Notice to the rights holder after receipt of the termination or invalidation request</p>	

	<p>Font and size (<i>Point 7.2.b(iii)</i>)</p> <p>All application documents filed with the IP Office of Vietnam must be in 13-point or larger Times New Roman</p>	<p>Font and size:</p> <p>N/A</p>	<p>The provision under Circular 16 on font and size of the letters in documents filed with the IP Office of Vietnam is quite strict and specific</p>
<i>Patents</i>	<p>Time limit for entering the Vietnamese national phase of PCT applications (<i>Point 27.4 & 27.5</i>)</p> <p>The time limit for entering the national phase in Vietnam is strictly 31 months under both PCT Chapter I and Chapter II</p>	<p>Time limit for entering the Vietnamese national phase of PCT applications:</p> <p>PCT applications used to be allowed to enter national phases within 37 months by paying an extra fee.</p>	<p>Under amended Circular, a Vietnamese translation of the patent specification is required at the time of entry. Therefore, applicants need to pay more attention to sending filing instructions early, allowing time for translation of the specification into Vietnamese, to file applications by the 31-month deadline</p>
	<p>Deadline for requesting examination:</p> <p>The deadline to request for examination is 42 months from the priority/filing date and 36 months from the priority/filing date for</p>	<p>Deadline for requesting examination:</p>	<p>Late entry of PCT application into the Vietnam national phase is no longer available.</p> <p>Such events as “force majeure event” or “objective obstacles” are not common and consideration of</p>

<p>patent applications for utility solution (utility model). The deadline can be extended by 6 months only when the applicant provides sufficient evidence of some events such as “force majeure event” or “objective obstacles”.</p>		<p>the evidence may result in a conclusion that the evidence is not ample. Therefore, applicants are advised to consider the 42- or 36-month deadline to be a final deadline.</p>
<p>Features of function or purpose <i>(Point 25.5.d(i))</i></p> <p>All use-related claims, regardless of the claim wordings and of which technical fields, shall not be accepted by the IP Office of Vietnam.</p> <p>The function/utility of a subject-matter is not an essential feature, but may be only the purpose/result of that subject-matter.</p>	<p>Features of function or purpose:</p> <p>Features of function/utility can be the essential features of an invention. Hence, use inventions should not be objected to, because they are always based on features of function/utility which, as specified, can be the essential features of an invention (constituting an invention); and thus a use invention is a statutory invention</p>	<p>The amended provision consolidates the refusal of use inventions and is a disappointing point for applicants, especially foreign pharmaceutical applicants.</p>
<p>Amendment to specification <i>(Point 17.1.c)</i></p> <p>The word “description” was revised to “specification”, covering both the</p>	<p>Amendment to specification:</p> <p>Not allowed to expand protection coverage beyond the contents disclosed in the description.</p>	<p>Under old regulation, If the applicant wished to amend a claim, for example, the content of the claim amendment would have to be</p>

	<p>description and the original claims.</p> <p>Post-grant narrowing of the scope of protection of a patent includes removing one or more claims from the granted claim set <u>only</u></p>		<p>already disclosed in the description. It was not adequate for the content to be disclosed in the original claims. This could be deemed not to comply with other Vietnamese legal documents.</p>
	<p>Other regulations</p> <ul style="list-style-type: none"> ✓ New section “Objective of the invention” is required in the patent description. However, it may be expressed as a separate section before section “Summary of the invention”, or as a sub-section of section “Summary of the invention” ✓ Section “Examples” is no longer a must-have in the patent description ✓ Section “Achievable benefits/efficiency” is no longer a must-have in the patent description. In addition, it may be expressed as a separate 	<p>Relevant regulations:</p> <p>N/A</p>	

	<p>section, or as a sub-section of section “Summary of the invention”.</p> <p>✓ It is explicitly stipulated that the NOIP will not accept the patent application filed for an invention of a Vietnamese or an invention made in Vietnam if such an invention has been already first filed abroad, even when filed directly with the WIPO</p>		
<p><i>Designs</i></p>	<p>Definition of product (<i>Point 33.2.b</i>)</p> <p>“A product is understood as an object, device, equipment, means, or part for assembling or integrating these products, manufactured by industrial or handicraft methods, having a clear structure and function, circulated independently.” This definition is given to exclude intangible products such as “Graphical User Interface” since it is considered a product but</p>	<p>Definition of product</p>	<p>The new regulation provides a short and specific list of the products indicating the narrowed scope of patentable products, a disappointment from the applicants’ side.</p>

<p>cannot be considered a design and have also resulted in a narrow list of products that can be patentable.</p>		
<p>Specification in design applications (Point 17.1.c) It is stipulated that an amendment must not go beyond the specification and set of figures/photos.</p>	<p>Specification in design applications A specification is required which basically describes the appearance-forming features of the design in words, but this specification is not included in the granted certificate for the design, which results in few concerns on the validity of the specifications.</p>	<p>The new regulation makes the role of the specification more important. Thus, design specifications should be prepared with caution.</p>
<p>Amendment to granted patent (Point 20.1.b(iv)) A design application can comprise many embodiments (similar designs). It is provided that amendments has been restricted to deleting embodiments only (not possible to delete some non-essential appearance</p>	<p>Amendment to granted patent Amendments by deleting one or more embodiments and/or to exclude some non-essential appearance forming features are allowed.</p>	<p>The design owner may narrow the scope of design patent by removing one or several industrial design variations, one or several products from the set of products claimed in the design patent. Narrowing the design patent scope by removing one or several non-main design</p>

	forming features)		shaping features is not allowed any longer
	<p>Divisional design application:</p> <p>For divisional design application(s), fee for claiming priority under Paris Convention will be charged for the divisional design application which is filed due to failure of meeting the requirement of unity</p>	<p>Divisional design application:</p> <p>N/A</p>	
<i>Trademarks</i>	<p>Rights to challenge/object to disclaimer entries:</p> <p>The trademark applicant can challenge/object to disclaimer entries by the IP Office of Vietnam within 90 days of such entries.</p>	<p>Rights to challenge/object to disclaimer entries:</p> <p>Silent</p>	No comments
	<p>Response to office action regarding international application:</p> <p>If an International Registration is provisionally refused by the IP Office of Vietnam, the applicant will be</p>	<p>Response to office action regarding international application:</p> <p>If a Madrid application was provisionally refused, the application holder was given 90 days to file an</p>	Per new regulation, Madrid applicants are now treated the same as national applicants in overcoming refusals by the IP Office of Vietnam.

	<p>entitled to respond against such provisional refusal within three (03) months from the notification date under the same proceeding with that of national applications, i.e., lodging a response with the IP Office of Vietnam.</p> <p>If the response is not accepted, the IP Office of Vietnam will then issue a decision of refusal and the applicant can then appeal against such decision following the appeal proceedings</p>	<p>appeal to the Trial Board of the IP Office of Vietnam. The Trial Board, however, is not the division that conducts the substantive examination of Madrid applications and the Decision of the Trial Board is final at the IP Office of Vietnam level.</p>	<p>In case the IP Office of Vietnam decides to partially refuse a trademark under an international registration, it will issue a decision on protection of the mark only for the part that meets protection requirement</p>
	<p>Organizations entitled to register certification marks and collective marks (<i>Point 37.5a & 37.5b</i>)</p> <p>specified the type of organizations that are entitled to register collective marks; namely, organizations composed of two members or more,</p>	<p>Organizations entitled to register certification marks and collective marks</p> <p>did not clearly set out who can apply for registration of certification marks and collective marks</p>	

	<p>with each member having independent business activities, including cooperative coalitions, cooperatives, group companies, associations, and other organizations</p>		
	<p>Recognition of well-known marks <i>(Point 42.4)</i></p> <p>Per new regulation, it is only mentioned that when a well-known mark is recognized in the course of a decision on settlement of infringement of such well-known mark, or a decision on refusal of another mark, such well-known mark will be recorded in the list of well-known marks kept at the IP Office of Vietnam, for reference for registration/protection of IP rights</p>	<p>Recognition of well-known marks</p> <p>A mark could be recognized as well known according to civil procedures (i.e. by the Courts) or under a recognition decision of the IP Office of Vietnam, and that well-known mark would be recorded in the list of well-known marks kept at the IP Office of Vietnam</p>	<p>Per new regulation, it can be construed that there is no independent procedure for recognizing well-known trademarks in Vietnam but a mark can only be recognized as well-known through other proceedings such as enforcement or examination of a trademark that is identical/confusingly similar to such well-known mark.</p> <p>On a case-by-case basis, the IP Office of Vietnam issues decisions acknowledging marks are well-</p>

known when handling cases related to infringements, appeals, cancellations or oppositions. However, such acknowledgements are not considered as official decisions of recognition of well-known trademark status