



GUIDANCE FOR INVENTION/UTILITY SOLUTION APPLICATIONS IN VIETNAM

Requisite Information

1. Applicant: full name, address and nationality;
2. Inventor: full name, address and nationality;
3. Priority data: filing number, date and country (if applicable);
4. International filing data: filing and publishing number (as to PCT patent applications).

Requisite Documents

1. Patent specification (including drawings, if any) in English;
2. Power of Attorney (neither notarization nor legalization is required):
 - Copy of duly signed Power of Attorney is accepted at the filing time but the original one must be filed within *01 month*;
 - For PCT-derived applications, original signed Power of Attorney can be filed within *34 months* from the priority date or the international filing date (in case of no priority claimed);
3. Certified copy of priority documents and the English translation thereof (as to applications claiming the priority of an earlier application under the Paris Convention);
4. PCT patent application documents, if applicable, especially international publication, amendments to the claims under PCT Article 19 and Article 34(2)(b), International Preliminary Examination Report (PCT/IPER/409), Notification of the Recording of a Change (PCT/IB/306), PCT Request (PCT/RO/101).

Important Notes

Differences between an invention and a utility solution:

- To be patentable in Vietnam, an invention must satisfy 3 criteria, namely, (i) novelty, (ii) inventive step and (iii) industrial applicability. Meanwhile, for a utility solution to be patentable in Vietnam, it must not be ordinary knowledge and must satisfy 2 criteria: (i) novelty and (ii) industrial applicability. Thus, there is no requirement on inventive steps for a utility solution to be patentable in Vietnam.

Kindly note that (i) while the novelty requirement is clear (absolute novelty, worldwide), the requirement of “not being ordinary knowledge” is not clarified in the legal documents and (ii) the term “utility solution” under Vietnamese law has the same meaning as commonly acceptable ones, namely “utility model”, “petty patent”, “innovation patent”, “small patent” or “minor patent” in other jurisdictions.

- Additionally, utility solutions and inventions differ in that (1) a request for examination of a utility solution must be filed within 36 months from the priority date, compared to 42 months for an invention, and (2) the duration of protection for a utility solution is only 10 years from the filing date of the relevant application, compared to 20 years for a invention.

Timeline for acquiring a patent in Vietnam:

- Patent applications shall be examined as to form within *1 month* from the filing date.
- The formally accepted applications shall be published for the purpose of opposition in the 19th month from the priority date (or the filing date in case of no priority claimed) or within *2 months* from the date of acceptance as to form whichever is later. PCT-derived applications shall be published within *2 months* from the date of acceptance as to form.
- The substantive examination shall be conducted within *18 months* from the date of publication of application or the filing date of a Request for Substantive Examination, whichever is later.
- In case the re-examination/re-consideration of the application is required, the time limit for such re-examination/re-consideration of the application shall be two thirds of initial examination.
- The time frame for obtaining patent in smooth cases is practically estimated to be approx. *36-42 months* computed from the priority date for national applications, or approx. *22-30 months* from the due date of entry into national phase for PCT-derived applications.
- Patent for Invention shall be valid for **20 years** from the filing date of the patent application, whereas the term for Patent for Utility Solution is **10 years**.
- Duration for a PCT application to enter Vietnam national phase is **31 months** from the priority date or the international filing date (*in case of no priority claimed*).

Request for substantive examination:

- The time limit for submission of a Request for Substantive Examination is *42 months* for inventions and *36 months* for utility solutions counted from the priority date or the filing date (in case of no priority claimed). A grace period of *6 months* may be accepted in case of any force majeure event or objective obstacle, subject to payment of appropriate fees.
- The cost for filing the Request for Substantive Examination is charged for each independent claim of patent specification.

Overall procedures for a patent application:

Formality Examination: A patent application is automatically examined as to form. The examination as to formality conditions must be completed within one month from the filing date. If the formalities are met, a Notice of Acceptance as to form will be issued.

If the application stands objected due to certain defects such as, the application contains unpatentable subject matters (*e.g. method of treatment of a disease on human/animal body*), or there is insufficient information on the applicant/inventor, the application does not meet physical requirements, the application does not satisfy the unity requirement, etc., the IP Office of Vietnam ("**IP Vietnam**") shall issue a Notice of Defects and set a time period of *02 months* for the applicant to correct such defects.

Publication of application: Pending patent applications shall be published for opposition purposes in the 19th month from the priority date or within *2 months* from the date of acceptance as to formality whichever is later. If a request for early publication is filed, the patent application shall be published within *2 months* from the date of filing such a request or from the date of acceptance as to formality, whichever is later. The national phase applications of PCT applications shall be published within *2 months* from the date of acceptance as to formality.

Provisional protection

From the date of publication of patent application, the applicant is entitled to notify any third party who starts using the invention claimed in such patent application of its pendency. If such a party

continues the use notwithstanding the actual notice, then when the patent is granted, the patentee is entitled to request such a party to pay a compensation equivalent to the payment for licensing of the invention for the period from the notification date to the date of issuance.

Request for Examination: Under Vietnam patent law and regulations, IP Vietnam shall not conduct the substantive examination for the published Vietnam patent applications without a request from either applicant or third party. The failure to submit a request for examination within the prescribed period of time (i.e. within *42 months* from the earliest priority date for an invention and *36 months* from the earliest priority date for a utility solution) shall make the application deemed to have been withdrawn.

The request for examination shall be published in the Official IP Gazette in the second month from the date of receiving the request if the request is filed after the publication of the pending patent application, or published together with the patent application if the request is filed before the publication of the patent application.

Substantive Examination: The substantive examination shall be conducted within *12 months* from the date of filing the request for examination or the publication date of the patent application, whichever is later. After the application has been examined for patentability, the applicant shall receive a Notice of Result of Substantive Examination. There are some scenarios as follows:

- If the patent application stands rejected for not to meet the patentability (*i.e. novelty, inventive step, and industrial applicability*), IP Vietnam shall provide the applicant with a *3-month* period in which to respond to the Office Action. Failure to respond timely to IP Vietnam's Notice will result in the application being abandoned.
- If the patent application meets requirements for protection but still has certain defects, IP Vietnam shall give the applicant a *3-month* period to correct the defects. Failure to timely correct the defects or the applicant's corrections are not satisfactory shall result in the abandonment of the application.
- If the patent application meets requirements for protection, the applicant shall be given *3 months* to pay the issuance fee, publication fee, and first annuity. Failure to do so will result in the application being abandoned.

Opposition: The current Vietnamese patent law and regulations provide for a pre-grant opposition procedure, which allows any third party to oppose the grant of a patent at any time between the date of publication of the pending patent application and the date on which the decision to grant a patent is made by filing an opposition with IP Vietnam. The opposition must be in writing and include grounds for the opposition.

Amendment to the application: An amendment can be made at any time before the patent has been issued under Article 115.3, Vietnam's IP Law. The amendment shall not extend beyond the disclosure contained in the applications as originally filed, nor shall it add new subject matters or alter the nature of the subject matters claimed.

Post-grant publication: Granted patents shall be published in the IP Gazette.

Expediting patent examination in Vietnam:

It is possible to submit a request for acceleration examination to IP Vietnam under Vietnam patent regulations (Rule 9.3 & 27.7.c, Annex A 01-SC, Circular 01/2007/TT-BKHCHN). However, in practice, IP Vietnam's examiners are rather reluctant in accepting such requests, except for exceptional cases, due to large backlog of pending patent applications at IP Vietnam.

In Vietnamese patent practice, substantive examination of Vietnamese applications usually relies on the results of substantive examination of the corresponding applications filed in the

countries/regions such as US, CA, JP, RU, UK, SE, AT, ES, CN, KR, DE, EPO and EAPO. Thus, in order to accelerate the substantive examination at IP Vietnam, applicants should submit the results of substantive examination of the corresponding applications filed in the above-mentioned countries/regions to enable IP Vietnam's examiner to expedite the grant of protection for the patent applications filed in Vietnam.

Duty of working of patent:

The working requirements are provided under the terms of Vietnam's IP Law as the patentee's obligations to use the (patented) invention. Specifically, the patentee has the obligation to produce/manufacture the patented product or use the patented process in order to meet the needs of national defense, national security, disease prevention and treatment, nutrition for people and to meet other urgent social needs (*Article 136.1, Vietnam's IP Law*).

Additionally, when addressing the compulsory license issue, it is provided that the right to use an invention shall be granted to another organization or individual pursuant to a decision of the State competent authority, without permission of the patentee, **if** the patentee fails to fulfill the obligation of using the invention after the expiration of *four years from the date of filing of the patent application* and *three years from the granting date of the patent for invention* (*Article 145.1b, Vietnam's IP Law*).

It is worth noting, however, that while failure to work (non-working) shall constitute a ground for compulsory license, as stated above, it shall not constitute a ground for patent invalidation.

Duty to indicate patent number on the product:

No provisions to require to indicate patent number on the product (effect/any penalties) are available in Vietnam patent law and regulations.

Initial ownership of employee's invention:

Employer unless clearly indicated otherwise.

Inventor's right to claim on compensation for assignment of employee's invention, and average amount of money:

Under Article 135, Vietnam's IP Law, unless otherwise agreed between the owner and the author of an invention, the owner is obligated to pay remuneration. The minimum rate of remuneration payable to the author by the owner of an invention shall be:

- a) 10% of benefits derived from the use of the invention by the owner;
- b) 15% of the sum of money received by the owner upon each payment of royalty for granting a license to use the invention.

Where an invention is created by more than one inventor, the remuneration rate shall be applicable to all of the co-inventors. The co-inventors shall agree among themselves on the allocation of such remuneration paid by the owner.

The duration of performing the obligation to pay remuneration to the inventor of an invention shall be the whole term of protection of such invention.

Checking status of patent applications:

Applicants may proactively check the status of their patent applications based on a digital library (namely, Industrial Property Digital Library (IP-Lib)).

Please access <http://iplib.noip.gov.vn/WebUI/WSearchPAT.php>

The IP-Lib is set up under a JICA's project to provide information on published patent applications and granted patents to public. That is, any one could access the source of information in the IP Vietnam's website. The system may allow public to do some searches including IPC, applicant name, etc. based on bibliographic data and some possible keyword searches in Vietnamese from the published "Title of Invention" and "Abstract" of the published applications. The shortage of the system is that some information of the filed applications may not be timely or fully updated. Therefore, the best way for applicants to check the status of their patent applications is through a professional IP agent in Vietnam.