

## Patent in Vietnam - Late national phase entry or revive the PCT application?

### 1. Is it possible to submit patent applications first and then submit the Vietnamese translation of the patent specification later? The involved fees for late submission?

Legal grounds:

- *Article 100, 102 and 108 of Vietnamese Intellectual Property Law in 2005, revised in 2009 and 2019.*
- *Point 7.1(a) of Circular No. 01/2007/TT-BKHCN revised and supplemented by Circular No. 16/2016/TT-BKHCN.*
- *Point 9.4 and 9.5 of Circular No. 16/2016/TT-BKHCN.*
- *Rule 4.3.1.1 of Vietnam Examination Regulations For Patent Applications.*

Under Vietnam patent regulations, the Vietnamese translation of the patent specification is one of the minimum documents which is required at the time of filing the patent application. In other words, it is statutorily impossible to submit the patent application first and then submit the Vietnamese translation of the patent specification later. In case of absence of any of the minimum documents, the Intellectual Property Office of Vietnam ("IP VIETNAM") may refuse to accept the patent application.

In practice, the late submission of the Vietnamese translation may be accepted, subject to the approval by the competent leader of IP VIETNAM, especially on the ground that the late submission results from a Force Majeure event. In such cases, applicants may submit an official letter to IP VIETNAM for late submission of the Vietnamese translation of the patent specification, together with proof of the Force Majeure occurrence.

The fee for obtaining such an approval would vary from case to case.

### 2. If the PCT case missed the 31 months priority deadline, can it be revived? If yes, please tell us the official fee and your attorney fee for revive; The grounds for revive is Due Care or unintentional? How about the deadline for requesting the revive?

Legal grounds:

- *Point 27.4 of Circular No. 01/2007/TT-BKHCN revised and supplemented by Circular No. 16/2016/TT-BKHCN.*
- *Point 9.4 and 9.5 of Circular No. 01/2007/TT-BKHCN revised and supplemented by Circular No. 16/2016/TT-BKHCN.*

Earlier, PCT applications were allowed to enter the Vietnamese national phase within 6 months after the 31 months deadline, with a late entry fee. However, since 15 January 2018 when Circular No. 16/2016/TT-BKHCN came into effect, the regulation on a 6-month grace period (after a 31-month deadline) previously applicable for late nationalization in Vietnam of PCT patent applications has been repealed. It means that PCT patent applications can now be nationalized in Vietnam only within 31 months, instead of 37 months as ever before, from the priority date.

At present, any late nationalization of PCT patent applications in Vietnam shall be strictly subject to prior written approval of IP VIETNAM. In order to increase the likelihood of IP VIETNAM's approval, the applicant must provide sufficient evidence that such failure to timely nationalize their PCT patent applications in Vietnam has resulted from a Force Majeure event which might include, but not be limited to, war, riots, fire, flood, hurricane, typhoon, earthquake, lightning, explosion, strikes, lockouts, slowdowns, prolonged shortage of energy supplies, and acts of state or governmental action prohibiting or impeding the applicant from timely nationalizing their PCT patent applications in Vietnam.

Indeed, the successful rate for reviving a late PCT patent application shall depend much on the persuasiveness of the evidence you can provide.

The fee for obtaining the approval from IP VIETNAM would also vary from case to case.

**Legal grounds:****Article 100 of Vietnamese IP Law:**

Article 100: *General requirements applicable to applications for registration of industrial property*

1. An industrial property registration application shall contain the following documents:
  - (a) Declaration for registration, made on the stipulated form;
  - (b) Documents, samples and information identifying the industrial property object registered for protection as specified in articles 102 to 106 inclusive of this Law;
  - (c) Power of attorney, if the application is filed through a representative;
  - (d) Documents evidencing the registration right, if such right is acquired by the applicant from another person;
  - (dd) Documents evidencing the priority right, if such right is claimed;
  - (e) Receipt for payment of fees and charges.
2. Industrial property registration applications and source documents of transactions between an applicant and the State administrative body for industrial property rights shall be made in Vietnamese, except for the following documents which may be made in another language but shall be translated into Vietnamese at the request of the State administrative body for industrial property rights:
  - (a) Power of attorney;
  - (b) Documents evidencing the registration right;
  - (c) Documents evidencing the priority right;
  - (d) Other documents supporting the application.
3. Documents evidencing the priority right in an industrial property registration application shall include:
  - (a) A copy of the first application(s) certified by the receiving office;
  - (b) Deed of assignment of priority right if such right is acquired from another person.

**Article 102 of Vietnamese IP Law:**

Article 102: *Requirements on applications for registration of inventions*

1. Documents identifying an invention registered for protection in an application for invention registration shall include a description of the invention and an abstract of the invention. The invention description shall contain a descriptive section and the scope of protection of the invention.
2. The description of an invention must satisfy the following conditions:
  - (a) Fully and clearly disclose the nature of the invention to the extent that such invention may be realized by a person with average knowledge in the art;
  - (b) Briefly explain accompanying drawings, if it is required to further clarify the nature of the invention;
  - (c) Clarify the novelty, inventive step and susceptibility of industrial application of the invention.
3. The scope of protection of an invention shall be expressed in the form of a combination of technical specifications which are necessary and sufficient to identify the scope of the rights to such invention, compatible with the description of invention and drawings.
4. An abstract of an invention must disclose principal features of the nature of such invention.

**Article 108 of Vietnamese IP Law:**

Article 108: *Receipt of applications for registration of industrial property, and filing dates*

1. An application for registration of industrial property shall only be received by the competent State administrative body for industrial property rights if the application consists of at least the following documents and information:

- (a) A declaration for registration of an invention, industrial design, layout design, mark or geographical indication, which includes sufficient information to identify the applicant and in the case of a mark a sample of the mark and a list of goods or services bearing the mark;
  - (b) Description, including the scope of protection, in the case of an application for registration of an invention; a set of photos and drawings and a description in the case of an application for registration of an industrial design; and a description of peculiar characteristics of a product bearing a geographical indication, in the case of an application for registration of a geographical indication;
  - (c) Receipt for payment of filing fee.
2. The filing date shall be the date on which the application is received by the competent State administrative body for industrial property rights, or the international filing date in the case of an application filed pursuant to an international treaty.

**Point 7.1(a) of Circular No. 01/2007/TT-BKHCHN revised and supplemented by Circular No. 16/2016/TT-BKHCHN**

**7.1. Minimum documents**

The NOIP shall only receive an industrial property registration application (hereinafter referred to as the application) which, upon its filing, contains at least the documents listed at Points a, b and e, Clause 1, Article 100, and Clause 1, Article 108 of the Intellectual Property Law and specified as follows:

a/ For an application for registration of an invention, layout design, industrial design, mark or geographical indication, mandatory documents include:

- (i) Declaration for registration;
- (ii) Documents, specimen and information disclosing the industrial property object sought to be registered; Particularly for an invention registration application, a description of the invention; for an industrial design registration application, a set of photos, a set of drawings and a description of the industrial design; for a mark registration application, the mark specimen and list of goods and services bearing the mark; for a geographical indication, a description of particular characteristics and quality of products bearing the geographical indication and a map of the geographical area subject to the geographical indication;
- (iii) Fee and charge receipts.

In case of absence of any of the above documents, the NOIP may refuse to accept the application.

**Point 9.4 and 9.5 of Circular No. 16/2016/TT-BKHCHN**

9.4 The aforementioned time limit excludes the period over which a force majeure event or objective obstacles makes an organization or individual fail to exercise their rights and fulfill their obligations if such organization or individual makes a request and provides legitimate evidence. If such a request is granted, the NOIP shall revoke the rejection decision.

9.5 The force majeure event is an event (such as natural disasters or conflicts) that occurs objectively and remains unforeseeable and irremediable despite every necessary measure has been taken within permitted capacity.

Objective obstacles are the obstacles caused by objective circumstances rendering persons with rights and obligations unable to know that their legitimate rights and interests are infringed upon or to exercise their rights or perform their obligations.

**Rule 4.3.1.1 of Vietnam Examination Regulations For Patent Applications**

4.3.1.1 The following documents shall be submitted to the National Office of Intellectual Property to comply with the requirements set forth in Article 100, Article 102 and Article 108 of the Intellectual Property Law at the time of filing:

- a) Application form;
- b) Specification (including description, claims and drawings (if applicable));
- c) Abstract;

- d) Power of Attorney, when an Application is filed through a representative (for International Application, according to Point 27.7 of the Circular, the deadline to submit the Power of Attorney is within 34 months from the priority date);
- e) Documents attesting to the right to register, in case applicant inherits such right from another person;
- f) Documents attesting to priority right, in case priority is claimed, including:
  - Copies of the priority application certified by the receiving office;
  - Assignment of priority right form when such right is inherited from another person.
- g) Receipt of fees paid.

**Point 27.4 of Circular No. 01/2007/TT-BKHCN revised and supplemented by Circular No. 16/2016/TT-BKHCN**

27.4. International applications designating Vietnam

- a) If an international application designates Vietnam, the NOIP is the designated office. In this case, in order to enter the national phase, the applicant shall submit, within 31 months from the date of priority, to the NOIP the following:
  - (i) Written declaration requesting invention registration, made according to a set form (not printed herein);
  - (ii) Copy of the international application (if the applicant requests the entry into the national phase before the date of publication of the international publication);
  - (iii) Vietnamese translation of the international application: The description, consisting of a description section, protection request, annotations for drawings and abstract (the published copy or initially filed original application, if the application has not yet been published, and modified copy and explanation of modified contents, if the international application has been modified under Article 19 of the Treaty);
  - (iv) National charges and fees.
- b) International applications filed with the NOIP within six months after the expiration of the time limit specified at Point 27.4.a above may be accepted on the condition that applicants pay the prescribed charges and fees.