Patent Divisional Application In Vietnam – What you need to know?

I. Overview of Patent Divisional Application in Vietnam

1. Definition:

A divisional patent application is not defined under the Vietnam IP Law. However, it's widely construed that a divisional patent application is a type of patent application which is divided from an original application (known as the parent application) when the original patent application does not meet unity requirements (*e.g. contains multiple inventions*), as stipulated in Article 101 of Vietnam IP Law.

2. Unlimited divisional application:

The Vietnam IP Law does not does not impose a limit on the quantity or number of divisional applications, so the parent patent application may be divided into two or more applications.

3. Multiple inventions through a single application:

Each industrial property registration application in Vietnam shall request the grant of only one protection title for a single industrial property object under the doctrine of unity requirement. In a broader sense, a patent application in Vietnam can not cover more than one invention. However, if a group of inventions that are technically linked to form a single common inventive concept, it is possible to request to grant protection for such a group of inventions in a single application. This exception is very similar to procedures for dealing with groups of inventions that are so interconnected that they form a single "inventive concept" that can be included in a single application under the European Patent Convention. In case of lack of unity of invention, the applicant may be required to either restrict the claims or divide the application (creating "divisional" applications). It is common practice, when filing under the PCT, to link groups of inventions in accordance with the European approach, and to divide the application as needed after entering the national phase.

4. Contexts and reasons to file a divisional application:

The division of a patent application may occur under two circumstances, namely, (i) the patent applicant divides the application proactively, (ii) the Intellectual Property Office of Vietnam requests the division (**IP VIETNAM**).

One may file a divisional patent application for the following reasons:

- To satisfy the requirement for office actions on unity of invention: When IP VIETNAM alleges that a patent application contains more than one invention, an office action will be issued. In Vietnam, a patent application must relate to a single invention. This is known as "unity of invention", with exception that a single patent application covering a group of inventions that are technically linked to form a single common inventive concept.

- To buy more time for arguments on patentability of the invention: When IP VIETNAM alleges that some claims in the invention does not meet requirements of patentability and in such a case, the applicant needs more time to prepare arguments to overcome the examiner's objection, a divisional application may be filed to continue arguing on patentability of the refused claims.

5. Filing number:

A divisional patent application must bear a new application number and is entitled to the date of filing or date(s) of priority (if any) of the parent application; and shall be published on Industrial Gazette of Vietnam after IP VIETNAM issues a decision on acceptance of valid application.

6. Fees:

The fees for filing a divisional application are similar to those for filing a new patent application, except that the fee for claiming priority (if a priority claim is made) is waived.

7. Processing the parent application (when being divided):

When filing a divisional application from a parent patent application, the parent application is considered to have been amended (through the divisional filing), and the relevant procedures for the parent application will be carried out. Specifically, when filing a divisional application, it is necessary to submit an official letter for the parent application, which includes a declaration of division and a detailed explanation for the divisional application. IP VIETNAM will review the official letter, and the information on the divisional request will then be updated on IP VIETNAM's website for the parent application. The fee for filing this official letter is the same as the fee for filing an amendment.

II. Timing To File A Patent Divisional Application In Vietnam

When to file a Patent Divisional Application under Vietnam IP Law?

A patent divisional application can be filed at any time as long as **IP VIETNAM** has not issued a Decision on rejection of a patent application, a Decision on grant or refusal of a patent. Remember two conclusions on the due date to file a patent divisional application in Vietnam:

(i) A divisional application must be filed BEFORE a Decision on rejection of a patent application, or a Decision on grant or refusal of a patent is issued; and

(ii) A divisional application filed during an appeal is not accepted.
In order to file a divisional application in the event of an appeal, the appeal against a refusal decision for the parent application must be successfully resolved and the parent application must be returned to the patent examination division of IP Vietnam for re-examination. Only then is it possible to file a divisional patent application.

Is it possible to file a divisional application after receiving a Notice of Allowance? What is the deadline?

A Notice of Allowance issued by IP VIETNAM is not a Decision on grant of a patent. As such, it is possible to file a division application upon receipt of the Notice of Allowance, provided that such a filing must be submitted to IP VIETNAM BEFORE a Decision on grant of a patent is issued.

As a matter of practice, IP VIETNAM issues Decisions on grant of patents for patent applications if they meet protection requirements, but do not always send those Decisions to applicants. Thus, the date of the Decision on grant of patents is only known after receipt of the original patents. In practice, IP VIETNAM issues Decisions on grant of patents within 2-3 months following the date of issuance of Notices on intention to grant patents. Thus, it is best to file a divisional application BEFORE or ON or WITHIN 1-2 weeks following the date of paying the granting fees to IP VIETNAM.

Assuming a patent application receives a Decision on the refusal of granting a patent for invention instead of a Notice of Allowance, is it possible to file a divisional application after receiving the Decision on the refusal of granting a patent for invention? What is the deadline?

No, it is NOT possible to file a divisional application after receipt of a Decision on refusal of grant of a patent.

Is it possible to file a divisional application when filing an appeal against the Decision on the refusal of granting a patent for invention? Alternatively, after the appeal is filed, is it possible to file a divisional application, and what is the deadline?

Statutorily, it is NOT possible to file a divisional application AFTER a Decision on rejection of a patent application, a Decision on grant or refusal of a patent is issued. In order to file a divisional application in case of an appeal, the appeal against a refusal Decision for the parent application must be firstly settled successfully and such a parent application must be then returned to the patent examination division of IP VIETNAM for re-examination, only at that time, it is possible to file a divisional application.

Is it possible to file a second-generation divisional application based on a first-generation divisional application? That is, is it possible to file serial divisional application, like serial continuation application in US? What is the deadline?

No explicit provisions are laid down in the IP Law of Vietnam on limitation of the number of divisional applications to be filed, provided that the filing of such application is made BEFORE Decision on rejection of a patent application, a Decision on grant or refusal of a patent is issued by IP VIETNAM.

III. Requirements To Be Met For A Divisional Patent Application In Vietnam

What are the requirements for filing a divisional patent application in Vietnam?

There are 4 requirements that must be met for a divisional patent application in Vietnam. IP VIETNAM will deny the divisional application if neither of the requirements listed below are met.

(i) The divisional patent application must be filed with the request indicating the number of the original patent application; the request; the specification; the abstract; the receipt of fees and the KF power of attorneys;
(ii) The claimed subject matter in the divisional patent application in Vietnam must be contained in the original patent application;
(iii) The claimed subject matter in the divisional patent application in Vietnam must be different from the claimed subject matter in the original patent application;
(iv) The divisional patent application must not expand the scope of protection beyond the content disclosed in the specification and must not alter the essence of the subject matter mentioned in the original patent application.

IV. Examination Of A Divisional Patent Application In Vietnam

A divisional patent application is a new application that is separate and independent from the parent application. Therefore, the divisional application procedure/examination is in principle independent from the parent application procedure/examination, and the divisional application is treated as a new application. A divisional patent application in Vietnam will be examined in two phases, i.e. formality examination and substantive examination:

1. Formality examination:

IP VIETNAM will conduct formality examination for a divisional application within one month of the date the divisional application was received, as indicated on the application receipt seal. Where applicable, a Notice of Deficiency or Notice of Formality Acceptance will be issued within 01 month.

2. Substantive examination:

The time limit for substantive examination of a divisional application is determined in the same manner as the time limit for substantive examination of an ordinary application, i.e. 18 (eighteen) months from the date of its publication if a request for substantive examination is filed prior to the date of application publication, or from the date of receipt of a request for substantive examination if such request is filed after the date of application publication.

3. Office actions:

The divisional application may have (but not limited to) the following defects (deficiencies or shortcomings) which must be communicated to the applicant:

(i) The technical solution of the divisional application was not contained in the parent application;
(ii) The divisional application still lacks information to such an extent that the claimed subject matter mentioned in the divisional application cannot be determined whether it was contained in the parent application or the technical solution divided from the parent application cannot be determined which one among the technical solutions mentioned in the parent application;
(iii) The divisional application expands the scope of protection beyond the content disclosed in the specification and altered the essence of the subject matter mentioned in the parent application;
(iv) The applicant of the divisional application does not have the right to division of the parent application.

4. Suggestions for overcoming rejection on the grounds that the divisional application's scope of protection exceeds that of the parent application:

If the applicant filed the divisional application but the claimed subject matter of the divisional application was not contained in the claim of the parent application, and there was no amendment, supplement for the parent application, the divisional application shall be accompanied with a description of the claimed subject matter and the altered content of the divisional application in comparison with the filed parent application in order to demonstrate that the claimed subject matter in the divisional application was contained in the parent application and the divisional application does not extend the scope of protection beyond the content disclosed in the specification and does not alter the essence of the subject matter mentioned in the parent application.

5. Modifications:

For the divisional application and/or the parent application, the specification (including drawings) of the application may be modified in accordance with the subject matter mentioned in the claim of the application by removing the content irrelevant to the subject matter(s) mentioned in the claim of the application.

Final thoughts

A divisional application will incur additional fees and costs and/or complexity in managing the patent family. Thus, when weighing the fees and costs with the benefits of a divisional application, it is advisable to file divisional applications when the patent's value or risk of infringement is high.

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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