

Restoration of priority rights for patent applications in Vietnam

– What you need to know

A Chinese patent with 12 months priority deadline passed, but the patent applicant still wants to patent his invention in Vietnam. Is it possible to request for a restoration of priority right in the international patent application and then enter into Vietnam under PCT route?

1. What is the “priority date” of a patent application?

Paris Convention for the Protection of Industrial Property (*Paris Convention*) is an international treaty that provides, among other advantages, a right of priority among patent applications. Under the Paris Convention, on the basis of a **regular first** application filed in **one** of the member states, the applicant may, within a certain period of time (**12 months for patents**), apply for protection in **any of the other** member states. These subsequent applications will be regarded as if they had been filed on the same day as the first application. In other words, they will have priority (“**right of priority**”) over applications filed by others during the said period of time for the same invention. Moreover, these subsequent applications, being based on the first application, will not be affected by any event that takes place in the interval, such as the publication of an invention. For example, if a patent application on the same invention is filed in Vietnam no later than 12 months after the initial patent application was filed in China, the Vietnamese application will not be invalidated by the publication of that invention in a journal within those 12 months.

One of the great practical advantages of this provision is that applicants seeking protection in several countries are not required to present all of their applications at the same time but have 12 months to decide in which countries they wish to seek protection, and to organize with due care the steps necessary for securing protection.

Under the Agreement on Trade-Related Aspects of Intellectual Property Rights (**TRIPS**), applicants may also enjoy the right of priority in members of the World Trade Organization (WTO) that are not signatories of the Paris Convention.

The same right of priority under the Paris Convention can be claimed not only among Contracting States and members of the WTO but also when the applicant subsequently files an international application under the Patent Cooperation Treaty (**PCT**). The PCT is a special agreement under Article 19 of the Paris Convention.

In light of the foregoing, the **priority date** of a patent refers to the date on which the first application for a certain invention was filed and from this date the novelty of invention was established. In particular, when a patent application is filed in one country for the first time, the filing date for that initial application is called the **priority date**. When the subsequent applications are filed, any event occurred between the filing of the first application and the filing of said subsequent applications shall not have any effect on the subsequent applications.

Applicants from Paris Convention member states and from WTO members can claim priority under the Paris Convention if they file their subsequent patent applications in those territories within 12 months of the filing date of the first application for the same invention. This enables subsequent applications filed within the priority period to have priority over other applications for the same invention filed by others after the priority date.

Such priority based on the first application can also be claimed under the PCT when an international patent application is subsequently filed. It is critical that foreign patent applications be filed within the priority period or under the PCT by that time – filing under the PCT will give at least an additional 18 months to decide whether to enter the national phase in any PCT member country.

After the expiration of the priority period, and until the patent is first published by the patent office (generally 18 months after the priority date), it is still possible to apply for protection for the same invention in other countries, but priority from the earlier application cannot be claimed. **Once the invention has been disclosed or published, patent protection may not be attainable in foreign countries** due to loss of novelty.

Fig. 1: Life cycle of a patent

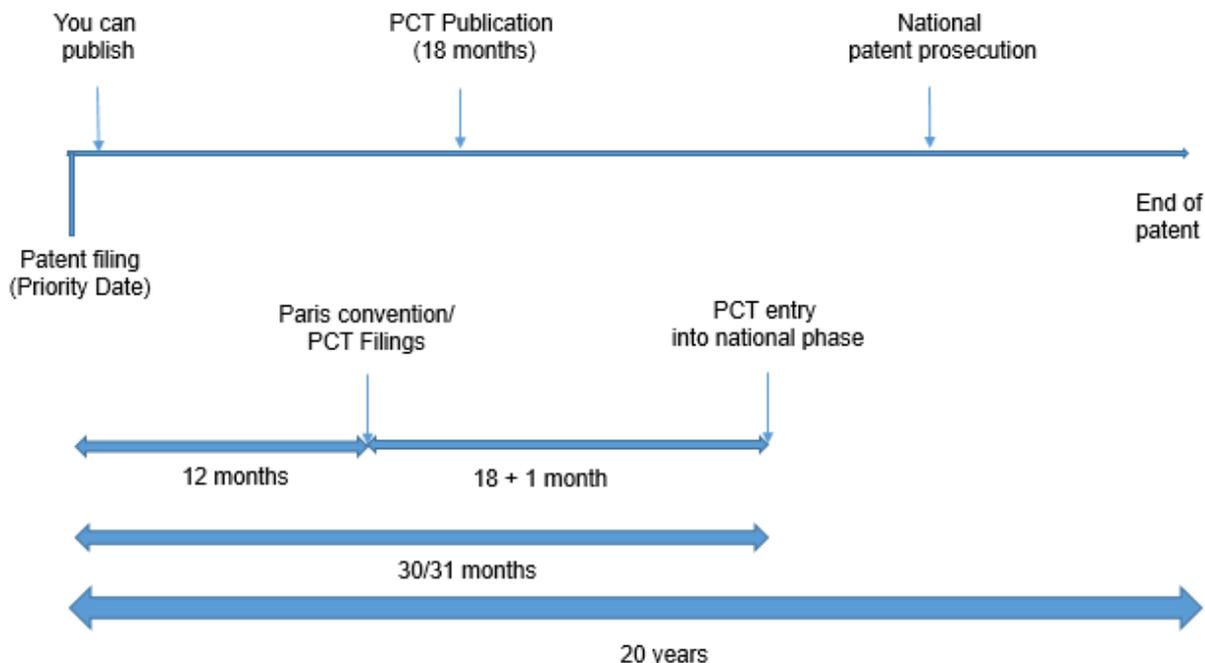
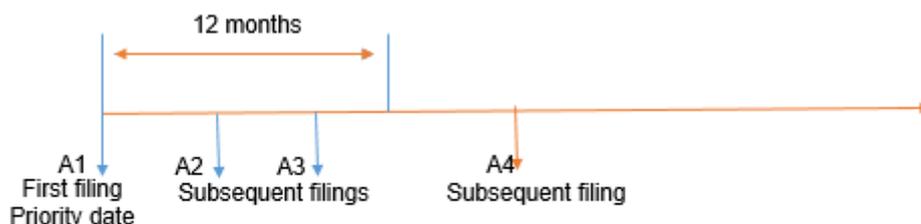


Fig. 2: Priority date



A1 is first filing. A2, A3 and A4 are subsequent filings based on the first filing.
 A2 and A3 enjoy "the priority date" upon A1.
 A4 does not enjoy "the priority date" upon A1.

2. What does restoration of priority right for patent application mean?

Among the industrial property subject matters such as patents (including utility solutions), industrial designs and trademarks which adopt priority right claimed over the firstly filed application, restoration of right of priority is subject to patents only and is the procedure set out under PCT Regulations.

Rule 26bis.3 and Rule 49ter of the PCT Regulation provides that where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office or the designating Office shall, on the request of the applicant, restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied. As such, member countries acting as a Receiving Office or as a Designated Office are allowed to provide restoration of a priority claim up to two months beyond the 12-month Paris Convention deadline for international patent applications.

In light of the foregoing, it can be understood that restoration of the priority claim is the act or process of restoring/returning (still acknowledging) the convention priority right after expiry of the priority period to its owners under the international application by a Receiving Office or a Designated Office.

The restoration of the priority right is not an extension of the Convention priority period but a time-limited procedure that advantageously enables the applicant to still enjoy the priority date in his PCT application for subsequent entry into national phases due to non-observance of the one-year time limit provided that a request for restoration is duly made within two months from the expiration date along with justifiable reasons and evidence.

Fig. 3: Restoration of priority rights



3. If one firstly files PCT (12+2 month by reviving priority in WIPO), then use this PCT entering into Vietnam, can this PCT be acceptable? Will there be any extra fee and extra evidence or documents we need to provide?

Provisions enabling restoration of the priority right in certain cases where the applicant failed to file the international application within the 12-month priority period are available in the PCT to which Vietnam and China are signatories (<https://www.wipo.int/pct/en/texts/restoration.html>). One can make a request for restoration of the right of priority pursuant to **Rule 26 bis.3 PCT** at the Receiving Office (<https://www.wipo.int/pct/en/texts/rules/r26bis.html>) and/or under **Rule 49 ter.2 PCT** at the individual Designated Office (<https://www.wipo.int/pct/en/texts/rules/r49ter.html>) based on either of two grounds, one is that the international application was not filed within the 12 month convention period either in spite of “due care” required by the circumstances having been taken, or another is that the failure to file in time was “unintentional”. That being said, restoration of the priority right may be decided by either the Receiving Office (i.e., located in a country where applicant is a resident or national) or the Designated Office (i.e., located in a country designated under the international application). You can refer to PCT Receiving Office Guidelines as in force from July 1, 2022 via link https://www.wipo.int/pct/en/texts/ro/ro166a_166t.html to get more details in this regard.

It should be emphasized that a request for restoration of the right of priority must be made within two months from the date of the expiration of the priority.

For the situation where a Receiving Office allows a request for restoration of the right of priority under Rule 26 bis.3 PCT due to one of the two above-mentioned criteria, Designated Offices that apply the same criterion should accept the positive decision of the Receiving Office when the PCT application is brought into the national phase under Rule 49 ter.1 PCT (<https://www.wipo.int/pct/en/texts/rules/r49ter.html>).

Accordingly, as a contracting party of PCT, IP Vietnam shall tend to accept the priority right acquired in the late-filed valid PCT application. In this matter, the procedure for PCT application when entered into Vietnam national phase shall be treated as the procedure for a normal national patent application in which the applicant will then enjoy the priority date as attained in the PCT application and subject to the incurred fees for claiming priority (official fee of US\$6.70 per priority application) in addition to the filing fees, but no fee for the revival of the priority. Any evidence for the revival (such as a written request by the applicant and a written acceptance by WIPO) shall be submitted to IP Vietnam upon its request.

Mindful of the above, it is to be highly noted that if IP Vietnam, as a Designated Office, has reasonable doubts in connection with the decision issued by the Receiving Office to restore a right of priority under Rule 26 bis.3 PCT, IP Vietnam may review the Decision under Rule 49 ter.1 (d) PCT (<https://www.wipo.int/pct/en/texts/rules/r49ter.html>) in which case IP Vietnam shall notify the applicant, indicate reasons for the doubts and give the applicant an opportunity to respond within a prescribed time limit.

Fortunately, this procedure appears to be relatively rare since our practice has not recorded any precedent similar case according to our unofficial discussion with local IP examiners.

4. How to make a request for restoration of the right of priority?

A request for restoration of the right of priority can be made at the time of filing the international application, or later, provided that it is within two months from the date of the expiration of the priority period (under PCT Rule 26bis.3(e)). Of note, the international application when filed must claim the priority/priorities of the earlier application(s).

There are two ways of initiating the restoration request. The restoration of the right of priority can be requested at the time of filing, directly on the request form (PCT/RO/101) (with the option under Box No. VI thereof), in the ePCT-Filing system or in the PCT-SAFE software. Alternatively, a separate request for restoration of the right of priority may be filed, by way of a letter to the receiving Office, within the time limit as prescribed under PCT Rule 26bis.3(e).

Although it is possible to request restoration during the national phase before any Designated Offices in respect of which PCT Rule 49ter.2 applies under the applicable national law, in general it is preferable that, whenever possible, applicants should request the restoration of the right of priority before the Receiving Office in the international phase. This is the simplest and the most cost-effective way, and in many cases will have effect before the Designated Offices in the national phase.

5. What is the process for requesting restorations of priority?

The process for requesting restorations of priority is provided under PCT Rule 26bis3 with the following highlights:

- (i) Restoration is subject to priority application(s) which was/were filed between 12 and 14 months before the international filing date;
- (ii) A request for restoration must be filed no later than 14 months from the filing date of the priority application;
- (iii) In support of the request to be filed within the time limit, a declaration or other evidence should be accompanied.
- (iv) Consideration of the request and its relevant evidence will be at the discretion of the IP Office from the Receiving Office or Designated Office where the criteria will be applied in accordance to the requested Office.
- (v) Successful requests will be advertised on the pamphlet and will include the details of the accepted criteria under new PCT Rule 48.2(a)(xi), (b)(vii) and (b)(viii). In addition, the International Bureau will publish Form PCT/RO/159 (Notification of Decision on request to restore right of Priority) (https://www.wipo.int/export/sites/www/pct/en/forms/ro/editable/ed_ro159.pdf) which will contain the decision of the Receiving Office and the criteria (i.e. "due care" or "unintentional") applied by that office.

6. What documents must be included in a request for restoration of priority right?

In addition to a request for restoration, the following information must be provided, either in the same document as the request for restoration or in a separate document, as long as it is filed within two months from the date of the expiration of the priority:

- an indication (e.g., on a cover sheet) of the international application number and international filing date (if known), the name(s) of the applicant(s) and agent, and the title of the invention;
- details of the earlier application, the priority of which is being claimed, if they are not apparent from the request form;
- the reasons for the failure to file the international application within the priority period (PCT Rule 26bis.3(b)(ii) ("statement of reasons"));

Statement of reasons

The manner in which a statement of reasons is prepared may depend on the criterion applied by the Receiving Office to requests for restoration of the right of priority, i.e., in determining whether the failure to file the international application within the priority period:

- occurred in spite of *due care* required by the circumstances having been taken; or
- was *unintentional*.

What to submit in order to meet the “due care” criterion?

In order to meet the “due care” criterion, the statement should describe in detail the facts and circumstances that led to the late filing, as well as any remedial or alternative steps taken to attempt a timely filing of the international application. The factual circumstances which may be taken into account on case-by-case basis by each Receiving Office are, for example, lack of knowledge/financing by the applicant; human error by the applicant or Agent himself; miscommunication between the applicant and the agent; human error by the agent or applicant’s staff; docketing system error; postal services difficulties; and force majeure.

What to submit in order to meet the “unintentionality” criterion?

The requirements to be met under the “unintentionality” criterion are typically **less stringent**, and for many Offices it may suffice to provide a statement indicating that the failure to comply with the priority period did not occur intentionally (if that is indeed the case). Nonetheless, some Offices that apply this criterion may require that the statement be submitted in the form of a declaration and that it includes the reasons for the failure, supported by evidence if necessary. Specifically, to satisfy this criterion, the applicant should demonstrate that he did not deliberately refrain from filing the international application within the priority period and that he had a continuing underlying intention to file the international application within the priority period.

If the Receiving Office finds the statement of reasons insufficient to determine whether the applicant satisfies the applicable criteria, the Receiving Office may invite the applicant to submit further information by way of a revised statement within a reasonable time limit. The Receiving Office explains in detail, by text in the Annex to that Form, why it finds the statement insufficient. In this notification, the Receiving Office may also require the applicant to submit a declaration or other evidence in support of the statement of reasons.

7. In Vietnam

The prevailing Law on Intellectual Property of Vietnam and its by-law (subordinate legal) documents relating to the IP field do not contain provisions for restoration of priority rights for industrial property registration applications in Vietnam. However, as far as we know, this current situation may be overcome such that the priority right of the patent application can be revived if there is enough persuasive evidence tendered that such failure to timely file the present application claiming the priority in Vietnam has resulted from a force majeure event which might include, but not be limited to, pandemic, 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 client from timely filing the application and claiming the priority.

Restoring or reviving the priority claim to have the PCT application entered into national phase shall be highly subject to the prior approval of the Intellectual Property Office of Vietnam (IP Vietnam), where it shall take the case into careful consideration based on the fact that the revival may adversely affect the rights and interests of other applicants or another third party. Strength/convincence of the evidence proving a failure to file the patent application within 12 months to restore/revive the priority rights therefore are critical in whether your request of revival/restoration of the priority right is accepted or not.

With no specific legislation on restoration of priority rights laid down in domestic law, IP Vietnam as the Designated Office normally follows the PCT rules and accepts the PCT application entered into national phase with acknowledging all the information as internationally published, including the priority date. In other words, if request for restoration of the effect of the priority claim on entry into the Vietnam national phase is accepted by the Receiving Office (country of origin) and then the late-filed valid international application when entered into Vietnam shall be treated as a domestic application in conformity with the local requirements.

It is important to bear in mind that not every country will recognize a restored priority claim. The applicant who wishes to take the priority restoration procedures under PCT route should study to thoroughly understand the national law before taking any subsequent action or consult an IP agent in the domestic nation for detailed advice and suitable measures.

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