Amending Patent Specifications In Vietnam - Best Practices for Applicants

Even after a patent specification has been filed to the Intellectual Property Office of Vietnam (IP VIETNAM), it may be amended at the applicant's initiative (also known as voluntary amendment) or at IP VIETNAM's request. If an amendment or supplement to a patent application expands the scope of the subject matter disclosed or stated in the application or alters the nature of the claimed subject matter stated in the application, there is a risk that the patented product or process could be invalidated at the request of a third party. To mitigate such legal risks associated with patents, it is essential to have a thorough understanding of Vietnam's intellectual property laws concerning the amendment process during patent applications, particularly given the recent increase in patent infringement disputes in Vietnam.

1. A patent specification

A patent specification is a comprehensive document that details the technical aspects of an invention and must be submitted by the patent owner for the purpose of examining whether a protection title can be granted in Vietnam. This document provides a basis for assessing the patentability of the invention and determines the scope of the protection rights that can be granted.

In the event of a dispute, the owner of industrial property is entitled to rely solely on the protection title to assert their rights. IP VIETNAM will grant a patent/utility solution patent if the technical solution meets the requirements for protection. The patent/utility solution patent serves as a protection title that includes the patent holder's name and address, the protection period, and the patent specification.

Claims are a critical component of a patent specification as they establish the scope of the intellectual property rights granted for an invention, as stipulated in Point 23.6 of Circular No. 01/2007/TT-BKHCN (as amended).

2. When can the patent specification be amended in Vietnam?

In Vietnam, a patent specification can be amended at three stages: at the time of filing, in the process of pursuing a patent application and after grant of a patent.

***During filing**:* For international applications filed in Vietnam that enters the national phase, the applicant can amend the specification and submit this revised specification together with the patent application.

***During the patent application process**:* Before IP VIETNAM issues a decision to refuse to accept a patent application, a decision to refuse to grant a protection title or a decision to grant a protection title, the applicant may or at the request of IP VIETNAM file a request for an amendment to the patent application. There are three types of amendments: voluntary, in response to IP VIETNAM's notice of deficiencies, or to conform to a counterpart patent at the suggestion of the examiner.

- Voluntary amendment: The applicant can actively make amendments to the patent specification on issues such as correcting translation errors, correcting the content of the specification, conforming to the counterpart application, etc.

- Amendment in response to IP VIETNAM's notice of deficiencies: If the patent application has errors related to the specification or the subject matter in it, IP VIETNAM will issue a notice of deficiencies to the applicant specifying the shortcomings and granting them a two-month window to respond. The applicant can then make amendments to the specification to correct the identified deficiencies

- Amendment to conform the the counterpart patent at the suggestion of the examiner: If during the search and/or submission of documents by the applicant, the examiner determines that the technical requirements for considering the possibility of patentability in major overseas patent offices are relevant to the application filed in Vietnam, the examiner may suggest that the applicant amend their application to conform with the counterpart application within a set time limit of three

months. While this suggestion is not mandatory, if the applicant agrees to make the suggested amendments to conform with the counterpart patent, it may lead to a faster grant of the protection title for the patent application in Vietnam.

After IP VIETNAM grants a patent/utility solution patent*:* Statutorily, the owner of a protection title is allowed to amend the patent specification in a way that narrows the scope of patent protection, namely, deleting one or several claims that are independent or dependent. This typically involves removing one or more independent or dependent claims that fall within the scope of protection claimed in the protection title. Such amendments are commonly requested by the applicant when a third party seeks to invalidate the owner's patent, either because the claim does not meet the required standard of protection or because the invention was granted a protection title that goes beyond what was disclosed in the original patent specification

3. Will a patent application in Vietnam be granted protection by amending the Vietnamese application to conform to its counterpart application?

Not that an amendment to an invention under a counterpart application granted in any country will be accepted for protection of that invention in Vietnam. When the specification of a Vietnamese patent application is amended according to counterpart applications filed, the examination process in Vietnam is likely to be accelerated. However, this does not mean that IP VIETNAM will automatically recognize the granting result of a counterpart application for an application filed in Vietnam. Additionally, the foreign patent office-granted claims are only used as references when evaluating Vietnamese applications, and IP VIETNAM examiners may still issue notices of deficiencies if these claims contain content that does not meet Vietnamese invention examination regulations.

4. Selection of counterpart application for amendment

If an applicant has been granted multiple counterpart applications with varying scopes of protection in different countries, the examiner will select the most suitable counterpart patent coverage based on current regulations on patentability in Vietnam. The applicant will then be requested to amend their application under the selected patent. If any subject matter in the selected counterpart patent is not eligible for protection in Vietnam, it must be excluded from the amended protection claims either at the request of IP VIETNAM (as stated in the notice of amendment) or at the applicant's initiative.

5. What conditions must be met to amend the patent specification in Vietnam?

To amend a patent specification in Vietnam, the amendment must adhere to the core principle of not expanding the disclosed scope of protection or changing the nature of the claimed subject matter in the application. Additionally, the amendment must ensure consistency with the application.

If the request to amend is made after a notice of intent to grant a protection title has been issued, the application will be re-examined. Any additional or revised documents submitted by the applicant to IP VIETNAM must be in Vietnamese.

6. How will patent applications be handled, if the amendment broadens the coverage of protection?

If the amendment expands the scope (volume) of protection beyond the content disclosed in the specification or changes the nature of the object stated in the application, IP VIETNAM will issue a notice in one of the following categories:

- *Notice of refusal to accept an amendment request:* This notice will state the reasons for refusal and provide instructions for the applicant to submit a new application for the new subject matter, if the applicant fails to combine the amendment with a response to any notice from IP VIETNAM;

- *Notice of termination of substantive examination ahead of time:* This notice will clearly state the reason for termination and provide instructions for the applicant to submit a new application for a new subject matter if the amendment is made at the request of IP VIETNAM under Point

a.15.3Circular;

- *Notice of refusal to grant a protection title:* This notice will clearly state the reason for refusal and guide the applicant to file a new application for a new object if the amendment is combined with a written response to IP Vietnam's notice, as provided for in Points 15.4.a (i), (ii), (iii), 15.7.a (i) and 15.7.a (ii) Circular 01/2007/TT-BKHCN.

7. What are required documents for amending the patent application?

When requesting an amendment to a patent application in Vietnam, the applicant is required to submit a copy of the corresponding document that has been amended and supplemented, along with a detailed explanation of the changes made compared to the original submitted document.

If an international patent application designates Vietnam, the applicant is required to provide a Vietnamese translation of the application's specification, including the description, claims, drawings, and abstract. This applies to both the publication and original submitted versions, if the application has not been published. If the international application has been amended under Article 19 and/or Article 34(2)(b) of the Treaty, the applicant must also submit a revised version of the specification and an explanation of the amendment.

In case the applicant submits a voluntary amendment request or submits a specification of the amendment in response to IP VIETNAM's notice of deficiencies, an additional fee for amending the content of the application must be paid.

8. What is the process involving an amendment to a patent application in Vietnam?

After the applicant must submit a written request for amendment, along with the amended and supplemented documents and a detailed explanation of the changes made compared to the original documents, IP VIETNAM will conduct an examination of the application and will issue a notice based on the examination results. Notifications can be:

- *Notice of deficiencies:* If the revised specification includes content that does not meet the conditions for protection, IP VIETNAM will provide a notice indicating the reasons for the deficiency and setting a deadline for the applicant to rectify the shortcomings outlined in the notice; or

- *Notice of intent to grant a protection title:* If the applicant amends the application to make the subject matters stated in the application meet the protection conditions, or to correct the shortcomings satisfactorily, or to provide a satisfactory explanation within the prescribed time limit after IP VIETNAM issues a notice of deficiencies, the examiner will issue a notice of intention to grant a protection title; or

- *Notice of refusal to grant a protection title:* If the applicant fails to respond to the notice of deficiencies within the prescribed time frame, or if the applicant responds by amending the application or correcting shortcomings but the subject matters in the application do not meet the protection conditions or the errors are unsatisfactorily resolved, the examiner will issue a notice of refusal to grant the protection title.

Final thoughts

Amendments and supplements to patent applications, especially the patent specification, are permissible. However, it is important to note that broadening the scope of the subject matter or changing the nature of the registered object through amendments may render the patent invalid in whole or in part, as per Article 96 of the revised IP Law 2022, which took effect from January 1, 2023.

If you require the assistance of a professional intellectual property service provider to help guide your business in the right direction, please do not hesitate to contact KENFOX IP & Law Office today. Our team is dedicated to providing reliable and effective support to ensure the protection and success of your intellectual property.

KENFOX IP & LAW OFFICE is a leading intellectual property service provider in the Asian region, offering a wide range of IP services in Vietnam, Laos, Cambodia, Myanmar, and other countries. With a strong and rapid development in patent services, KENFOX has consistently been recognized as one of the top patent filing companies in Vietnam. In 2019, KENFOX was ranked among the Top 10 Patent Filing Companies by IP VIETNAM, and in both 2020 and 2021, KENFOX was listed among the top 20 patent filing companies in the country

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