

ASPEC Programme – an avenue to expedite patent granting in Vietnam and other ASEAN countries

1. What is ASEAN Patent Examination Co-operation (ASPEC) programme?

The ASEAN Patent Examination Cooperation (ASPEC) program is a regional patent cooperation program in Southeast Asia that allows patent applicants to request accelerated patent examination in participating ASEAN member states (“AMS”). It aims to improve the efficiency and quality of patent examination among participating ASEAN member state's intellectual property Offices (“AMS IP Offices”) by sharing search and examination (S&E) results.

Under the ASPEC program, patent applicants can submit a request for accelerated examination of a patent application in a participating AMS IP Office (“second IP Office”) based on a S&E reports issued by another participating AMS IP Office (“first IP Office”) on the corresponding application. The program aims to improve the efficiency and quality of patent examination in the region by facilitating the sharing of patent S&E results among participating AMS IP Offices. The ASPEC program is open to patent applications filed in any of the participating ASEAN member states, which include Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Vietnam.

2. What is PCT- ASPECT?

PCT-ASPEC refers to the Patent Cooperation Treaty (PCT) - ASEAN Patent Examination Cooperation (ASPEC) program. This is one of new features under ASPEC which has been introduced since 27 August 2019.

The PCT is an international treaty that enables patent applicants to file a single international patent application, which is then processed by a centralized authority (the World Intellectual Property Organization or WIPO) before being sent to individual national or regional patent offices for examination and granting. The PCT simplifies the patent filing process for applicants seeking protection in multiple countries or regions, by providing a standardized application procedure and a centralized S&E process.

The PCT-ASPEC program is a collaboration between WIPO and ASEAN member states, which enables PCT patent applicants to request accelerated examination of their patent applications in a participating AMS IP Office based on a S&E report issued by another participating AMS IP Office on the corresponding application. PCT-ASPEC thus provides an additional avenue for patent applicants to expedite the patent examination process in ASEAN countries, and to benefit from the expertise and resources of multiple participating countries.

3. What is ASPEC Acceleration for Industry 4.0 Infrastructure and Manufacturing (ASPEC AIM)?

Industry 4.0, also known as the Fourth Industrial Revolution, refers to the current trend of automation and data exchange in manufacturing technologies, including the use of advanced technologies such as artificial intelligence, robotics, the Internet of Things (IoT), and cloud computing. This is one of new features under ASPEC which has been introduced since 27 August 2019.

ASPEC Acceleration for Industry 4.0 Infrastructure and Manufacturing (ASPEC AIM) is a program that aims to provide accelerated patent examination services for patent applications related to Industry 4.0 infrastructure and manufacturing technologies in participating AMS IP Offices.

Under the ASPEC AIM program, patent applicants can request accelerated examination of their patent application in a participating AMS IP Office based on a S&E report issued by another participating AMS IP Office on the corresponding application. This can help to expedite the patent examination process and potentially reduce costs and administrative burdens for applicants seeking patent protection in ASEAN member states for their Industry 4.0 technologies.

ASPEC AIM program aims to expedite the patent examination process for inventions related to Industry 4.0 infrastructure and manufacturing. It also aims to help innovators and businesses to obtain patents faster, thus enabling them to protect their inventions and bring their products and services to the market more quickly.

The above two new features (*i.e. PCT-ASPECT and ASPEC AIM*) are part of ASPEC's ongoing efforts to enhance the regional patent system and support innovation and economic growth in the ASEAN region.

4. What documents should be prepared for filing an ASPEC request?

The specific documents for filing an ASPEC request may vary depending on each of the participating AMS IP Offices in which the request is being made. However, the following documents are typically prepared for filing an ASPEC request:

- (1) ASPEC request form: This is the official form used to request accelerated patent examination under the ASPEC program.
- (2) Search report: A copy of the search report issued by the participating AMS IP Office upon which the ASPEC request is based.
- (3) Written opinion or examination report: A copy of the written opinion or the examination report issued by the participating AMS IP Office upon which the ASPEC request is based.
- (4) Claims referred to in the written opinion or the examination report.
- (5) Claims correspondence table: A table that indicates how all claims in the patent application to be requested ASPEC sufficiently correspond to one or more of the claims indicated as allowable/patentable in the corresponding application.
- (6) Any preliminary amendments made to the application based on the written opinion or the examination report.
- (7) A copy of the patent granted by the participating AMS IP Office, if available.

5. What are required minimum documents for requesting ASPEC & ASPEC AIM?

The applicant is required to file a duly completed ASPEC Request Form in the second IP Office. (Note: The ASPEC Request Form is not required to be filed in the first IP Office).

The ASPEC Request Form shall be accompanied by the following documents:

- (i) a copy of the written opinion or the examination report (“minimum documents”) of a corresponding application from the first IP Office, and
- (ii) a copy of the claims referred to in the minimum documents submitted, with at least one claim determined by the first IP Office to be allowable/patentable.

At the time of filing ASPEC request, in addition to the above required minimum documents, the claim correspondence table should be further submitted to facilitate the examination process.

The submission by the applicant of the S&E results issued by an AMS for an unpublished application to another AMS Office is consent for the other AMS to use the S&E results. For unpublished applications, the S&E results issued by the IP Office of the Philippines in this regard constitute a waiver of confidentiality.

The applicant can submit more than 1 written opinion from participating AMS IP Office if the written opinions support the scope of the patent application.

For **ASPEC AIM request**, applicants should indicate that the request is for ASPEC AIM in the ASPEC form under Remarks. In addition, applicants are also required to email the monitoring authority (aspec@ipos.gov.sg) and respective ASPEC AIM focal point. Information that needs to be provided include:

- (i) Application no. from first IP Office;
- (ii) Desired second IP Office and application no. in the Second IP Office;
- (iii) Date of request;
- (iv) Reliance on written opinion or Examination report; and
- (v) Applicant.

For **ASPEC request** which relies on a written opinion or written opinions, applicants are required to email the monitoring authority (aspec@ipos.gov.sg) and respective ASPEC focal point. Information that needs to be provided include:

- (i) Application no. from first IP Office;
- (ii) Desired second IP Office and application no. in the Second IP Office;
- (iii) Date of request;
- (iv) Reliance on written opinion or written opinions; and
- (v) Applicant

6. What are required minimum documents for requesting PCT-ASPEC?

The documents required for requesting PCT-ASPEC are:

- (1) a copy of the written opinion/international preliminary examination report (“WO/ISA, WO/IPEA or IPER”) established by an ASEAN International Searching Authority/International Preliminary Examining Authority (ASEAN ISA/IPEA) (“minimum documents”) relating to a corresponding application from the first IP Office; and
- (2) a copy of the claims referred to in the minimum documents submitted, with at least one claim determined by the first IP Office to be allowable/patentable.

The duly completed ASPEC request form must be submitted together with the above documents. If the second ASEAN IP Office does not require the submission of an ASPEC Request Form, a cover letter indicating the request for PCT-ASPEC with the second IP Office should be submitted instead.

For **PCT-ASPEC request**, applicants should indicate that the request is for PCT-ASPEC in the ASPEC form under Remarks. In addition, applicants are required to email the monitoring authority (aspec@ipos.gov.sg) and respective PCT-ASPEC focal point, providing the following information:

- (i) PCT application no;
- (ii) Desired second IP Office and application no. in the second IP Office;
- (iii) Date of request; and
- (iv) Applicant.

It is possible to make a PCT-ASPEC request at the second IP Office even if the second IP Office is also an ASEAN ISA/IPEA.

It is also possible to make a PCT-ASPEC request and an ASPEC AIM request simultaneously at the second IP Office. There can be a written opinion/international preliminary examination report established by an ASEAN ISA/IPEA and the patent application contains at least one IPC code that matches with the IPC codes provided in Appendix 1. Please indicate that this is a PCT-ASPEC and ASPEC AIM request in the ASPEC form.

7. What are some key takeaways for ASPEC?

KENFOX provides below some key takeaways for ASPEC programme.

- All documents for the purposes of ASPEC must be in English. An English translation of documents submitted need not be verified by a translator or by the patent agent unless requested for by the AMS IP Office.
- ASPEC is only available for patent applications that have been filed in the first IP Office of an ASEAN Member State and have a corresponding application in the second IP Office of another ASEAN Member State.
- The purpose of ASPEC is to accelerate the examination of the corresponding application in the second IP Office by relying on the S&E results from the first IP Office.
- ASPEC is not a guarantee of patentability, and the second IP Office may still reject the application based on its own examination.
- Applicants should ensure that the claims in the corresponding application in the second IP Office sufficiently correspond to the claims in the first IP Office, and that at least one claim has been determined to be allowable/patentable in the first IP Office. Of note, a claim is considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claim in the application to be requested ASPEC is of the same or similar scope as a claim indicated as allowable/patentable in the corresponding application in the first IP Office.
- ASPEC can be requested for both published and unpublished applications.
- The submission of S&E results from an AMS IP Office for an unpublished application constitutes a waiver of confidentiality.

- For PCT-ASPEC requests, applicants should submit a copy of the written opinion/international preliminary examination report established by an ASEAN ISA/IPEA and a copy of the claims referred to in the minimum documents submitted, with at least one claim determined by the first IP Office to be allowable/patentable.
- ASPEC can be requested at any time before the final decision of grant or refusal in the second IP Office.
- An ASPEC request made on the ASEAN IP Portal may replace the need for a separate ASPEC Request Form in some AMS IP Offices.
- ASPEC acceleration will only begin once all required documents have been submitted to the second IP Office in conformity with the mandatory requirements for filing an ASPEC application.

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