

## Interim guidance for handling IP-related applications under the Amended IP Law 2022

The [Amended Intellectual Property Law 2022](#) ("Amended IP Law 2022" or "the prevailing law") has been in effect since 1 January 2023, offering the expected benefits of of comprehensiveness and harmonization. This Amended IP Law 2022 promises to be a helpful tool for IPR holders and practitioners, with more than 100 amended and added articles covering a wide range of IP subject matters, including inventions, designs, trademarks and copyrights. As a matter of principle, following the amendments made to a law in Vietnam, pertinent sub-law documents such as government decrees and ministerial circulars need to be amended or replaced in order to provide sufficient regulations and guidelines for the effective implementation of the promulgated amendments.

The Intellectual Property Office of Vietnam (**IP VIETNAM**) has issued [Notice No. 1029/TB-SHTT dated 14 March 2023](#) in order to provide IPR holders with a clear understanding of IP-related applications and requests pending the revision and publication of relevant decrees and circulars. The Notice outlines the procedures of handling certain IP-related applications and requests following the implementation of the Amended IP Law 2022. KENFOX IP & Law Office would like to keep you informed of the key regulations outlined in IP VIETNAM's Notice 1029/TB-SHTT.

### 1. IP cases filed prior to 1 January 2023

#### 1.1. Industrial design applications

Under the amended IP Law 2022, a product or a part to be assembled into a complex product with the external appearance which is "**invisible in the course of exploitation of utilities**" is deemed ineligible for registration as industrial design and **its registration** is denied. IP VIETNAM will process industrial design applications (*for registration of a product that is part of a complex product*) according to the following procedures:

If a notice of the substantive examination result of the design application has been issued without considering the ground of "invisibility of the industrial design" related to the pending design, IP VIETNAM will issue another examination notice that includes this ground and provisionally refuses the applied-for design. The applicant will be given a prescribed time limit to respond.

If a notice of intention to grant a protection title has been issued, IP VIETNAM will issue a replacement notice to inform the applicant of the substantive examination results, which may involve rejecting the design due to its lack of visibility. The applicant will have the opportunity to submit a reasonable response within a specific time frame.

#### 1.2. Patent applications

The proceedings of patent applications shall be temporarily suspended until the issuance of the amended Decree if there are justifiable grounds that such patent applications have been filed abroad. This guidance from IP VIETNAM is made in conformity with the revised provisions under Article 89a of the amended IP law 2022 regarding security control over inventions seeking for protection overseas.

#### 1.3. Trademark applications

The regulation that reduces the validity period of cited expired marks from 5 years to 3 years (under Article 74.2h of the Amended IP Law 2022) is applicable in the examination of trademark applications with filing date before 1 January 2023, specifically:

- Where the cited mark registration has been invalidated for more than 3 years (under Article 74.2h), such expired mark shall no longer be considered an obstacle to the registration of the applied-for mark. IP VIETNAM will then deal with the issued refusal as follows:

- If a trademark is rejected solely by virtue of its similarity to a cited mark that has expired for more than 3 years, and the applicant fails to respond within the 3-month deadline, IP VIETNAM shall issue a Notice of intention to grant a protection title (for national applications) or issue a Decision on grant (for international trademark registrations designating Vietnam) to replace with the previous refusal. To this end, the trademark application is qualified for protection;
- If a trademark is rejected based on more than two grounds, including the refusal ground under Article 74.2h (*i.e. confusing similarity to a not-more-than-three-year expired mark*), and the applicant fails to respond within the 3-month deadline, IP VIETNAM will issue a Decision on refusal under the prevailing

law (if the cited mark has not expired for more than 3 years) or a Decision on refusal with just the other refusal ground (if the cited mark has already expired for more than 3 years).

- If a trademark is rejected based on more than two grounds, including the refusal ground under Article 74.2h (*i.e. confusing similarity to a not-more-than-three-year expired mark*), and the applicant has not responded because a 3-month response deadline is not over, IP VIETNAM will remove the refusal reason under Article 74.2h and continue to consider other grounds as raised in the refusal.

- Where a cited mark has expired less than 3 years, it is still regarded as a citation against a pending trademark. The trademark application will then be examined in accordance with the prevailing law.

- Where the trademark application is subject to a request for suspension of examination process because the cited mark is challenged with a non-use cancellation action under Article 96 of the prevailing IP Law, the examination of such trademark application is accepted to be suspended until it is found that the cited mark has been revoked or invalidated.

**Partial refusal:** Regarding the national trademark applications which meet the protection requirements for a part of the list of designated goods/services and have not yet been completely examined before 1 January 2023, IP VIETNAM will issue a notice of the substantive examination result informing the applicant of its intention to grant to the allowed goods/services as well as its refusal of the remaining goods/services which do not meet the protection criteria.

## 2. Industrial property registration applications with the filing date as of 1 January 2023 until the issuance of the relevant Decree.

Industrial property registration applications with the filing date as of 1 January 2023 until the issuance of the relevant Decree shall be received and examined in accordance with the provisions of the Amended IP Law 2022, and other sub-law documents (that is, Decree No. [103/2006/ND-CP](#), and [Circular No. 01/2007/TT-BKHCHN](#)). In case the provisions of the Decree and Circular are contrary to the those of the amended IP Law 2022, the provisions of the Law shall be applied.

### Our comments

The recent Notice from IP VIETNAM provides detailed guidance and adjustments for IP-related applications that fall within the transitional period before and after the Amended IP Law 2022. It clarifies that IP cases will be handled according to the **applicable** provisions of the Amended IP Law 2022, as well as the current Decree and Circular.

IP-related applications that were subject to the amended IP Law 2022 from 01 January 2023 until the issuance of Notice No. 1029/TB-SHTT on 14 March 2023, were suspended until the replacement or amendment of government decree. With the issuance of Notice, IP VIETNAM has provided timely guidance to reduce delays in the application procedures and ensure the legitimate interests of the applicants and IPR holders.

The amendments and supplements to the IP Law 2022 will have significant impact on the protection of IPR in Vietnam, qualitatively and quantitatively. However, the current lack of relevant decrees/circulars to guide the implementation of the amended law has caused some uncertainty. In this regard, Notice No. 1029/TB-SHTT issued by IP VIETNAM serves as a typical guideline for applicants/IPR holders as well as relevant competent authorities and parties during this transitional period.

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