

NOTICE

On handling IP-related applications and requests under the amended IP Law 2022

Following Notice No. 333/TB-SHTT dated 03 February 2023 on processing applications at Intellectual Property Office of Viet Nam (IP VIETNAM) when the amended IP Law 2022 comes into force, IP VIETNAM hereby requests its affiliated units to proceed with handling the cases of suspension in Section 1.2 and Section 2 of Notice No. 333/TB-SHTT as follows:

1. For the IP cases with the filing date before 1 January 2023 in Section 1.2 of Notice No. 333/TB-SHTT

1.1. The industrial design registration application (for product that is part of a complex product filed from 1 August 2020)

- a) For the industrial design registration applications which IP VIETNAM has not issued a Notice of the substantive examination result yet, the application will continue to be processed under the amended IP Law 2022;
- b) For the industrial design being not visible during the exploitation of utilities of the complex product:
 - i. 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.
 - ii. 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, and give the applicant a prescribed time limit for reasonable response.

Pursuant to the transitional provisions at Point a, Clause 3, Article 4 of the amended IP Law 2022

1.2. Patent applications

IP VIETNAM continues to temporarily suspend the processing of the patent applications until the issuance of the relevant Decree guiding the implementation of the IP Law (Replacement Decree) if there are clear grounds that the invention was filed abroad.

Pursuant to the transitional provisions at Point c, Clause 3, Article 4 of the amended IP Law 2022.

1.3. The trademark applications with relation to points e and h, Clause 2, Article 74 of the amended IP Law 2022

1.3.1 For the trademark registration directly filed in Vietnam

- a) Where the applicant requests to temporarily suspend the application examination process under Point b, Clause 3, Article 117 of the amended IP Law 2022, IP VIETNAM accepts such requests and defer the application examination until receipt of the results on termination or cancellation of the cited mark.
- b) Where IP VIETNAM has issued a Notice of refusal with the reason specified at Point h, Clause 2, Article 74 and the applicant does not respond within 3 months from the issuing date of the Notice:
 - i. If the refusal is merely based on Point h, Clause 2, Article 74, IP VIETNAM continues to handle the application according to the prevailing IP law (if the cited mark has expired for less than 3 years) or issues

a subsequent Notice of its intention to grant a trademark certificate in replace of the former Notice (if the cited mark has expired for more than 3 years);

ii. If the refusal are based on more than one grounds including Point h, Clause 2, Article 74, IP VIETNAM will issue a decision to refuse the trademark according to the prevailing IP law (if the cited mark has expired for less than 3 years) or issue a Decision on trademark refusal based on other grounds (if the cited mark has expired for more than 3 years);

c) Where IP VIETNAM has issued a Notice of the substantive examination result informing the application of its refusal based on many grounds including the reason under Point h, Clause 2, Article 74, and still within 03 months for the applicant to respond:

i. If the applicant has not responded yet, IP VIETNAM continues to handle the application according to the prevailing IP law (if the cited mark has expired for less than 3 years) or issue a subsequent Notice of the substantive examination result, which removes the reason under Point h, Clause 2, Article 74 and is consistent with the examination results (if the cited mark has expired for more than 3 years);

ii. If the applicant has filed a response, IP VIETNAM will consider the response and handle the cases in accordance with the prevailing law.

1.3.2 For international registration of trademarks with the designation of Vietnam

a) Where the applicant requests to temporarily suspend the application examination process under Point b, Clause 3, Article 117 of the amended IP Law 2022, IP VIETNAM accepts such request and defer the application examination until receipt of the results on termination or cancellation of the cited mark.

b) Where IP VIETNAM has issued a provisional refusal indicating the ground under Point b, Clause 2, Article 74:

i. If the refusal is merely based on Point h, Clause 2, Article 74:, IP VIETNAM continue to handle the application according to the prevailing IP law (if the cited mark has expired for less than 3 years) or issue a decision on grant (if the cited mark has expired for more than 3 years);

iii. If the refusal is based on more than one grounds including Point h, Clause 2, Article 74, IP VIETNAM continues to handle the application according to the prevailing IP law (if the cited mark has expired less than 3 years), or continue to handle the application according to the prevailing IP law after the cited mark has been removed (if the cited mark has expired for more than 3 years);

Pursuant to the transitional provisions at Point b, Clause 3, Article 4 of the amended IP Law 2022

1.4. Trademark registration application (directly filed in Vietnam) without Notice of the substantive examination result

For trademark registration applications that meet the requirements to be granted a protection title for part of the list of goods/services, IP VIETNAM will issue a Notice of the substantive examination result, which instructs applicants to perform necessary actions to have the allowable goods/services granted or to provide arguments on the refused goods/services.

Pursuant to the transitional provisions at point d, clause 3, Article 4 of the amended IP Law 2022.

2. For IP cases with the filing date from 1 January 2023 until the issuance date of the relevant Decree (the case mentioned in Section 2 of Notice No. 333/TB-SHTT)

For IP cases filed from 1 January 2023 until the date of issuance of the pertinent Decree shall be received and examined in accordance with the provisions of the IP Law as amended and supplemented according to the Law amending and supplementing a number of articles of the IP Law dated 19 June 2009; Law amending and supplementing a number of articles of the Law on Insurance Business; IP Law dated 14 June 2019 and Law amending and supplementing a number of articles of IP Law dated 16 June 2022 (*IP Law 2022*); Government Decree No. 103/2006/ND-CP dated 22 September 2006 detailing and guiding the implementation of a number of articles of the IP Law, as amended and supplemented according to Decree No. 122/2010/ND-CP dated 31 December 2010 (*Decree No. 103/2006/ND-CP*); Circular No. 01/2007/TT-BKHHCN dated 14 February 2007 guiding the implementation of Decree 103/2006/ND-CP guiding the implementation of the IP Law, amended and supplemented according to Circular No. 13/2010/TT-BKHHCN dated 30 July 2010; Circular No. 18/2011/TT-BKHHCN dated 22 July 2011, Circular No. 05/2013/TT-BKHHCN dated 20 February 2013; and Circular No. 16/2016/TT-BKHHCN dated 30 June 2016 (Circular No. 01/2007/TT-BKHCM). In case, the provisions of Decree No. 103/2006/ND-CP or Circular No. 01/2007/TT-BKHHCN is contrary to those of the amended IP Law 2022, the provisions of the Law shall be applied.

3. The units under IP VIETNAM shall coordinate with the Legislation and Policy Division to amend the necessary templates and forms in conformity with the contents mentioned in items 1 and 2 hereinabove. The Information Technology Center is entitled to make modifications to the corresponding templates and forms in the WIPO IPAS system.

If there are any problems raising in the implementation process, please promptly report to the Legislation and Policy Division for submission to the Director General for consideration and decision.