

## Overcoming refusal of patent applications in Vietnam – What strategies?

The initial "**patent**" application faced a denial, leading to the most likely course of action being an amendment of the set of claims to secure a "**utility solution**" patent. Faced with the second refusal notice from the Intellectual Property Office of Vietnam (**IP VIETNAM**), many applicants tend to opt for the straightforward route of converting their applications from "**invention**" to "**utility solution**". This choice is often made under the belief that obtaining any kind of patent is preferable to facing a final rejection. However, with a well-thought-out strategy, applicants can still pursue their patent applications without the need to convert them into utility solution applications. This conversion, in itself, comes with the downside of reducing the protection validity to 10 years, while the application examination process in Vietnam typically already consumes 5-7 years. In the case of the patent application for "A method for making a shoe sole" represented by KENFOX, the applicant successfully navigated through IP VIETNAM's second refusal notice. This achievement has delivered substantial benefits to the client, a Taiwanese company, as it positions them favorably to develop their business plans in the dynamic and potentially lucrative Vietnamese market.

### A patent application in Vietnam: 2-time refusal of protection

The client's patent application related to the manufacturing method of shoe soles was filed with IP VIETNAM in December 2016. This was a non-conventional patent application and did not claim priority. Four years later, IP VIETNAM issued the first notice of substantive examination, referencing a total of 5 documents, comprising 3 American patents and 2 Chinese patents. The examination revealed that the invention failed to meet the novelty criteria. This was primarily because the majority of the claims contained features that were already disclosed in existing technical solutions. The only exception was a single dependent claim within the set, which was considered novel. However, this dependent claim was ultimately deemed to be a combination of known solutions, thus failing to meet the requirement of inventiveness.

After reviewing the applicant's first response, in October 2022, IP VIETNAM continued to issue a second refusal notice, maintaining the rejection decision originally outlined in the results of the first substantive examination.

### Invention or Utility Solution: What decision to take?

A viable approach to address IP VIETNAM's second refusal notice at this juncture involves making specific amendments to the set of claims and subsequently converting the patent application into a utility solution application. By doing so, it becomes highly likely that the application will be granted a "utility solution" Patent. This option is favored by many applicants because obtaining a Patent in any form is preferable to facing outright denial.

However, the grant of a Patent in this scenario, if approved, would hold primarily symbolic value for the client. The patent application was filed in December 2016, and the examination process has stretched over a lengthy 7-year period. If a "[utility solution](#)" patent was to be granted in 2023, the patent holder would have a mere 3 years remaining to bring their invention to commercial fruition. This shortened validity period (as compared to being granted an invention Patent) significantly diminishes the potential for successful commercial exploitation of the invention, as it becomes challenging for the patent holder to recoup their capital and investment resources within such a brief timeframe. Compounding this challenge is the fact that the application has already faced two rejections, with the cited documents against it being relatively formidable. Consequently, the risk of an official rejection of the application has escalated. Should the applicant choose to persist with the original patent application without accepting the conversion to a utility solution, they run the risk of ultimately having no recourse or protection for their invention.

Invention relates to complex technical fields, requiring a profound depth of technical knowledge and experience, as well as meticulous evaluation and consideration. Consequently, the patent owner is confronted with a challenging decision: they must decide whether to opt for a safer route that seeks the grant of a "utility solution patent" or persevere until the end to establish that their technical solution indeed meets the stringent criteria for protection as an "invention", rather than a "utility solution". This

choice hinges on a careful assessment of the potential advantages, risks, and long-term objectives associated with both avenues.

### Light at the end of the tunnel

KENFOX's legal and technical teams, in collaboration with the applicant, have conducted a comprehensive review of the referenced technical solutions to assess their content, context, and relevance concerning the applied-for invention. Based on this analysis, two primary objectives have been accomplished: **(i)** Identification of distinct technical features, and **(ii)** Determination of a cohesive set of technical features and their functional interplay.

After making a comparison table of technical features, detailed analysis of the basic aspects, constitutive and functional features among the inventions was carefully reviewed. Based on that, an option of modification of the set of claims to overcome the rejection of novelty was quickly found. However, a crucial question remains: How can we substantiate that, with the amended set of claims, the technical solution within the application meets the requirement of inventiveness?

Upon conducting further technical analysis and evaluation, a pivotal conclusion has emerged: the modified solution within the application has the capacity to yield superior results compared to the cumulative effects of known technical solutions. In simpler terms, this invention satisfies the requirement of inventiveness. To substantiate this claim, KENFOX has meticulously furnished comprehensive technical explanations. These elucidate the functional synergy between the technical features present in the patent application, highlighting a synergistic effect that surpasses the mere sum of individual technical effects observed in corresponding elements of established technical solutions. Consequently, the invention represents a creative leap forward and is not easily created by individuals possessing average knowledge within the relevant technical field.

Upon carefully reviewing the amendments and analytical arguments presented by KENFOX in the second response, IP VIETNAM has determined that these revisions and arguments are compelling and well-founded. Consequently, IP VIETNAM has agreed to grant protection to the patent application.

### Practical lessons

During the examination of a patent application, the examiner conducts a comparative analysis between the essential technical features of the applied-for invention and those found in known solutions and prior art. This scrutiny is aimed at determining whether the applied-for invention qualifies as novel and non-obvious. If the basic technical features of the applied-for invention have already been described or disclosed in known technical solutions, such invention may be deemed lacking in novelty and/or inventive step. To overcome such denials, the applicant should be able to show the fundamental technical distinctions in the patent application from the reference documents and demonstrate the functional interaction between the technical features in the invention that helps to produce a combined technical effect superior to the sum of the individual technical effects revealed in previous technical solutions.

When faced with a temporary refusal from IP VIETNAM regarding the novelty and inventiveness of an invention, it is important to establish a strategic approach to enhance the likelihood of a successful outcome. KENFOX provides the following strategies to assist patent applicants in effectively addressing IP VIETNAM's rejection based on their patent application not meeting the requirements of novelty and inventiveness:

#### 1. Carefully review reference documents

To effectively counter the reference documents, applicants should delve deep into understanding how manufacturers in the industry have been producing and applying technology. This is to determine:

**Technical differences:** To successfully argue that the applied-for invention is distinct from the cited inventions, the applicant needs to pinpoint specific technical differences or innovative aspects in their invention. This requires a deep understanding of how the technology is currently applied in the industry and how the applied invention deviates from those existing practices. A clear explanation of these differences will strengthen the case for patentability.

**Non-obviousness:** One of the key criteria for granting a patent is that the invention must be non-obvious to a person skilled in the relevant field. By comparing the sum of the individual technical effects of each technical solution of the manufacturers in the relevant industry with the technical effect achieved by the group of the technical features of the invention, the applicant can determine whether the invention is simply a combination or agglomeration of known devices or processes to function in their usual way, or is a combination of known technical solutions in a way that is not obvious. Based on this principle along with an understanding of industry practice will help the applicant navigate how to find the signs that prove that the invention involves innovative step beyond what is already known.

**Claim scope:** Patent claims define the extent of protection granted to an invention. By gaining a deep understanding of the industry's manufacturing processes and technological applications, applicants can craft more precise patent claims and devise strategies to establish the broadest conceivable scope of protection. This not only reduces the risk of overlap with other established technical solutions but also heightens the likelihood of securing protection while minimizing the potential for patent infringement. However, if, during the evaluation process, it is determined that the patent application lacks novelty and inventive step when compared to reference documents, the applicant has the option to adjust the scope of protection in a suitable manner to address the concerns raised by the reference documents.

**Evidentiary support:** If necessary, the applicant has the option to gather supplementary supporting evidence to bolster their assertions. This can include test results, experiments, simulations, or expert opinions, which can be used to reinforce the argument that the invention seeking registration aligns with the requisite standards for protection.

**Market impact:** To convince the patent office of the commercial significance of the applied invention, the applicant should show how their invention will bring a positive impact to the industry and market. This includes explaining how the applied invention's novel features can lead to cost savings, improved efficiency, enhanced performance, or other benefits. A clear understanding of industry practices helps the applicant articulate these advantages effectively.

**Expert opinions:** In some cases, expert opinions might be necessary to support the arguments for patentability. Experts with knowledge of the industry's manufacturing and technological landscape can provide insights into the significance of the applied invention's differences from the cited inventions.

## 2. Amend the claims and submit justifiable substantiating arguments

When faced with IP VIETNAM's refusal of an invention for registration due to concerns regarding its novelty, the applicant must seek a strategic solution to overcome this obstacle. In the case of the aforementioned patent application, a recommended approach is to incorporate the technical features from the dependent claim that have been recognized as novel into the independent claim. In many other scenarios, options such as narrowing or modifying the claim set by introducing different technical features can also be considered.

However, it is crucial to note that when making amendments to a patent application, the changes must adhere to certain fundamental principles. Amendments should not broaden the scope or extent of protection beyond what is originally disclosed in the description (specification), and they must not alter the fundamental nature of the subject matter presented in the application.

In scenarios where the patent application satisfies the novelty requirement but falls short of meeting the inventive step criterion, the applicant can surmount the inventive step rejection by demonstrating that a set of fundamental technical features within the invention stems from creative innovation and does not represent common knowledge in the relevant technical field. Vietnam adopts the "*synergistic effect*" for the assessment of non-obviousness of the invention. Specifically, the invention claimed must normally be considered as a whole. Where a claim consists of combination of features, it is not correct to argue that the separate features of the combination taken themselves are known or obvious and that therefore the whole subject matter claimed is obvious. However, where the claim is merely an aggregation or juxtaposition of features and not a true combination, it is not enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step. A set of technical features is regarded as a combination of features if the functional interaction between the features achieves a combined technical effect which is different from, e.g., greater than, the sum of the individual features. In other words, if the interactions of the individual features produce a synergistic effect, it may be concluded that the invention involves an inventive step.

Indeed, in the course of pursuing a patent application, the evaluation of the subject matter sought for protection begins with an assessment of its novelty. If the subject matter is determined to be new, the next consideration is whether it exhibits an inventive step. Conversely, if the subject matter is found not to be novel, it will consequently be deemed lacking in inventive step. Therefore, when faced with refusals related to both novelty and inventive step, the applicant should prioritize overcoming the novelty refusal initially. Once the novelty issue has been resolved and the subject matter is established as novel, the applicant can then proceed to address the inventive step aspect of the invention that requires registration. This sequential approach ensures that the patent application is systematically addressed, with each hurdle being tackled in the appropriate order.

### Final thoughts

Stepping back, accepting the patent application rejection and agreeing to follow the recommendations outlined in the substantive examination notice issued by IP VIETNAM, without making any concerted effort to find out feasible solutions for the client's invention to be protected as it is, would result in the loss (forfeiture) of the advantages and entitlements rightfully belonging to the patent holder that the patent owner should have enjoyed. However, this endeavor requires IP attorneys, in addition to in-depth IP knowledge, rich practical experience and thorough understanding of Vietnam's IP laws, must also possess extensive knowledge and a profound understanding of the technical intricacies, technology, production processes, and the distinctiveness inherent to the invention. Successfully overturning the notice of refusal of the applied-for patent in the above case not only paves the way for novel business prospects but also ensures the safety and efficiency of investment and commercialization of the patent owner's invention in Vietnam, and at the same time establish the indispensable legal basis for preventing and addressing acts of patent infringement in Vietnam.

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