

Patent refusal in Vietnam: Reasons & Suggestions for Applicants

Filing a patent application is a significant step towards protecting your intellectual property. However, the journey doesn't end with submission; patent applicants often encounter substantive office actions, crucial points where the patent office reviews the application in detail. Understanding these office actions is vital for a successful patent approval process. In Vietnam, the Intellectual Property Office of Vietnam (IP VIETNAM) handles these proceedings. This article aims to shed light on substantive office actions for patent applications in Vietnam and offer insights on how to navigate through them effectively.

1. Substantive Examination Stage

The substantive examination, as stipulated in Rule 15.6 of Circular No. 01/2007/TT-BKHCN, represents a meticulous evaluation process that profoundly influences the fate of a patent application in Vietnam. This examination, conducted by a seasoned examiner, delves into three fundamental aspects (*i.e.*, (i) assessment of compatibility of the subject matter stated in the patent application with the type of protection title applied for; (ii) assessment of the subject matter based on each protection condition; and (iii) Inspection of observance of the first-to-file principle), each revealing crucial insights/ conditions into the patent's viability and potential for protection.

Once your patent application passes the formality examination stage in Vietnam, it enters the substantive examination stage. This pivotal stage involves a thorough evaluation by the examiner, focusing on the patentability criteria of your application. During this assessment, the examiner might issue an intended patent refusal (known as an Office Action (**OA**)) in writing, presenting their findings and recommendations. This stage presents an opportunity for the patent owner to gain deeper insights into the strengths and weaknesses of their patent application. It allows them to prepare compelling arguments and gather essential evidence to safeguard the applied-for invention effectively

This critical phase unfolds in various possible scenarios, each holding specific significance for applicants:

(i) Notice of providing information/ to a corresponding patent: To issue this notice, the examiner assesses whether the Vietnamese patent application has a corresponding family patent application filed abroad and if the foreign family application has been granted a patent. If a family patent exists and the background art aligns with the patentability criteria for the Vietnamese application, the examiner issues a notice. This notice includes details about the family patent and recommends that the applicant amend the Vietnamese patent application in accordance with the identified family patent.

(ii) Notice of results of substantive examination: In this notice, the results of the substantive examination are provided, encompassing assessments of protection standards for various aspects such as novelty, inventiveness, industrial applicability, and/or unity of the invention. Additionally, any other shortcomings in the application, such as those related to the description or examination fee, are highlighted by the examiner for the applicant to address. Often, apart from detailing refusals and other application deficiencies, the examiner may also recommend that the applicant amend the Vietnamese patent application based on the family patent or make other suggestions to overcome these shortcomings. These suggestions aim to enhance the applicant's chances of securing patent protection.

(iii) Notice of intention to grant a patent: If, following the substantive examination process, the patent application is found to meet the required protection standards, the applicant will receive a Notice of Intent to Grant a Patent. This notice includes a confirmation that the patent application satisfies the protection standards, accompanied by a detailed list of fees that must be paid for the application to be officially granted a patent.

2. Timeframe for Substantive Office Action

Timeline: A substantive Office Action is issued within 18 months from the date of requesting substantive examination or the publication date, whichever is later. This sets a clear timeframe for applicants to anticipate the examination process.

Response deadline: Upon receiving the notice of intended refusal (Office Action), the applicant has a specific period of 03 months to draft and submit a response. Timely and thorough responses are essential to keep the application process on track.

Extension option: If more time is needed to prepare a comprehensive response, applicants can request a 03-month extension in writing. This flexibility allows applicants to address complex issues thoroughly, ensuring a well-prepared reply.

Quality of response: The response submitted by the applicant must be not only timely but also satisfactory. Providing a response that does not adequately address the concerns raised in the substantive Office Action could lead to complications, including the issuance of a refusal decision.

Expiration: Failing to respond within the specified timeframe or providing an unsatisfactory response can result in IP VIETNAM issuing a decision of refusal. This decision effectively halts the substantive examination process, highlighting the importance of a well-prepared and timely response to avoid application rejection.

3. Common Patent Rejections in Vietnam

In Vietnam's patent practice, an Office Action typically centers around three key areas, each of paramount importance:

(1) Assessment on Novelty and Inventive Step

One of the primary lies in the meticulous evaluation of the novelty and inventive step of the patent application. Novelty and inventive step evaluations are pivotal in determining a patent's fate. Examiners at IP VIETNAM often refer to International Preliminary Reports on Patentability (IPRPs) generated during the international phase for PCT applications. In another way, they may also consider examination results from corresponding foreign applications. However, it's important to note that these examination results don't always determine the final outcome of a patent application filed in Vietnam. Furthermore, if no IPRPs or the examination results of corresponding applications exist, or the Vietnamese examiners find that such results are not suitable for the Vietnamese patent applications, they will independently conduct substantive examinations based on the cited documents found during substantive examination.

Novelty plays a leading role in the appraisal of patent applications. If the claimed subject matter is identical or substantially similar to the prior art, it will be rejected for lack of novelty. To overcome this, applicants can implement necessary modifications and present compelling arguments and evidence. These efforts aim to demonstrate that the patent application incorporates fundamental technical elements distinct from those previously disclosed in the state of the art

Concerning the inventive step, if the application lacks novelty, the inventive step of the application will not be evaluated. However, if the patent application proves to be novel, the examiner will assess its inventive step. This assessment involves determining whether (i) the distinctive basic technical features are considered to have been disclosed in the required minimum information source, and (ii) the combination of distinctive substantial signs is obvious to any person with average knowledge in the art. When a patent application is concluded to lack inventive step, the applicant can overcome this challenge by demonstrating the non-obvious nature of the subject matter intended for protection. This can be achieved by establishing the **surprising technical advantage and** unexpected technical effect of the invention sought for patent. Providing evidence in these areas strengthens the argument that the patent application represents an innovative step that cannot be easily created by a person with ordinary skill in the relevant art.

Here are several common strategies employed in response to notices of intended refusal concerning issues of novelty and/or inventive step:

Strong arguments: Present compelling arguments emphasizing the novelty and/or inventive step of the claimed subject matter.

Claim amendment: Amend the claim to ensure the claimed subject matter is both novel and inventive. Additionally, in the response, applicants should present detailed amendments and explanations

emphasizing the novelty and/or inventive step of the modified claim. Providing a clear and persuasive rationale for such amendments enhances the patentability of the invention

International alignment: Amend the set of protection requirements of Vietnamese patent applications to align with family patents granted abroad, especially in countries with advanced IP legal systems such as Europe, Japan, and the United States. Consider amendments based on patents granted in China, Australia, Russia, Korea, EAPO, Germany, and other relevant countries as well.

Overcoming a patent registration rejection in Vietnam based on inventiveness and novelty grounds is undoubtedly challenging. For detailed insights and effective strategies to navigate patent refusals in Vietnam, refer to our comprehensive article titled "[Overcoming refusal of patent applications in Vietnam – What strategies?](#)".

(ii) Amendments according to family patents

When receiving notices suggesting that the applicant amend the application to align to a family patent, the applicant should consider accepting the examiner's suggestions for amendments to speed up the examination process. This approach is frequently regarded as the quickest path to securing a patent promptly. In addition, when making such amendments, the applicant should ensure the removal of elements that are not protectable, such as those pertaining to use, methods for treating diseases, computer programs, and similar subjects.

(iii) Assessment on unity of invention

Evaluating the unity of invention is another crucial aspect during substantive examination. Per Article 23.3 of Circular No. 01/2006/TT-BKHCN as revised, an application is considered uniform if: **a)** It requests protection of only one object; or, **b)** It requests protection of a group of technically interrelated objects that demonstrate the sole inventive idea and fall into the following cases: **(i)** An object is used to create (produce, manufacture or prepare) another object; **(ii)** An object is used to accomplish another object; **(iii)** An object is used to utilize another object; **(iv)** Objects are of the same type and have the same function to secure the achievement of the same result.

Accordingly, it's evident that unity of invention examination is only required for patent applications that include a request to protect multiple claimed subject matters, i.e., applications with numerous independent claims. When a patent application faces objections regarding the lack of unity, there are several strategic approaches to resolve this issue:

Claim deletion: One common solution is to delete certain claims that are causing the lack of unity objection. By removing specific claims, the application can potentially align more closely with the requirement of a single inventive concept.

Filing a divisional patent application: For cases where the application involves multiple inventions, particularly if they can be independently protected, filing a divisional patent application is a viable strategy. This approach allows separate inventions to be pursued in distinct applications, each with its own unique inventive concept. For more details, see our article titled "[Patent Divisional Application In Vietnam – What you need to know?](#)"

Providing arguments: Provide arguments and evidence to respond to the examiner's opinion if the applicant does not agree with the examiner's conclusion on unity. In the argument, the applicant needs to highlight the technical connection and unique common creative intention between the objects requesting protection to prove the unity of the patent application.

Amendment: Amending the claims to ensure they are all aligned with the same central inventive concept is another effective strategy. Adjusting the wording and scope of claims to emphasize their interrelatedness can address the lack of unity objection.

Final thoughts

Resolving patent rejections in Vietnam requires a strategic finesse that often extends beyond the realm of technical expertise alone. In addition to mastering technical intricacies, patent owners should possess a comprehensive understanding of drafting [patent specifications](#) in a standardized manner and be well-

versed in patent legislation. Seeking advice from seasoned IP experts and attorneys is invaluable. Coordinating with these professionals not only provides essential guidance but also enhances the effectiveness of patent applications in overcoming rejections, thereby paving the way for successful patent approvals in the Vietnamese market.

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