

WHAT ARE KEY CONSIDERATIONS FOR INDUSTRIAL DESIGN DIVISIONAL APPLICATION IN VIETNAM?

Industrial design (ID) protection holds significant importance in the business strategies of designers and manufacturers, as it has the potential to enhance the value of products showcasing unique designs and attract customers. In Vietnam, ID can be protected by filing an ID application with the Intellectual Property Office of Vietnam (IP VIETNAM). In case the ID application meets the protection criteria, it will be granted an industrial design patent. This grants the design patent holder exclusive ownership and usage rights over the granted design, and it also provides the design patent holder with rights to prevent copying or imitation without holder's permission. This article will delve into aspects pertaining to ID application in Vietnam, namely, the key consideration for ID divisional application in Vietnam.

1. ID divisional application: What purpose?

An ID divisional application is a type of application that enables the division or separation of one or multiple IDs from an original ID application into one or more new applications. This divisional application is typically filed when the applicant desires to separately protect ID of product in a set of products or when there are multiple IDs in the original application that fail to meet the uniformity requirements. By submitting an ID divisional application, these divided designs can be examined and protected individually, providing the applicants with comprehensive and flexible control over their [intellectual property rights](#).

2. ID divisional application: Contexts and reasons?

The division of an ID application may occur under two circumstances, namely, (i) the division is made to respond IP VIETNAM's office action; (ii) the applicant divides the application proactively.

(i) The division is made to respond IP VIETNAM's office action

According to Vietnam IP law, an ID application can be applied for an industrial design of a product accompanied with one or several embodiments, or an ID application can be applied for more than one products in a set of products, of which each product has its own industrial design. However, in some cases, such ID application does not meet uniformity requirements (Clauses 1 and 3 of Article 101 of IP Law and Point 33.2 of Circular 01/2007/TT-BKHCHN), then IP VIETNAM will require the applicant to choose one or several embodiments/products to continue pursuing and discard one or several other embodiments/products. Accordingly, the unselected embodiments/products will have to be removed from the ID application unless the applicant can argue and convince the examiner that they meet the criteria for protection. However, another possible way to protect these unselected embodiments/products is to divide them and file them as an ID divisional application.

(ii) The applicant divides the application proactively

When an initial ID application covers a set of products, but the applicant later desires to separate a specific product from the set and acquire an individual industrial design patent for that product, they can do so by utilizing a division procedure to file a new ID application. By taking this step, the applicant gains greater flexibility in their business operations, including the ability to assign either the entire set of products or a portion of it.

Alternatively, if the applicant finds that the different embodiments/products in the original application do not meet the requirements of unity, they can proactively file an ID divisional application for the non-unified embodiments/products in advance. By doing so, they can avoid receiving a notice of intended refusal from IP VIET NAM, which would result in a prolonged processing time for the application.

It should be noted that an [ID application](#) does not meet uniformity requirements if, first, IDs according to the embodiments in the application do not apply to the same type of product; second, IDs according to the embodiments in the application apply to the same type of product but do not have the same set of basic design features and third, the products bearing IDs in the application do not constitute a set of products.

The following division options may be pursued: (i) Dividing one or more embodiments and filing it/them as one or more new applications and (ii) Dividing one or more products within a set of products and filing it/them as one or more new applications.

3. ID divisional application: When?

A divisional application can be filed at any time as long as IP VIETNAM has not issued a Decision on rejection of a parent application, a Decision on grant or refusal of an industrial design patent. For a divisional application to be accepted, an applicant should note about two due dates as follows:

- (i) A divisional application must be filed BEFORE a Decision on rejection of an ID application, or a Decision on grant or refusal of an industrial design is issued; and
- (ii) A divisional application filed during an opposition is not accepted.

In order to file a divisional application in the event of an opposition, the opposition against the parent application must be successfully resolved. Only then is it possible to file an ID divisional application.

4. ID divisional application: What is its filing/application number?

A divisional application must bear a new application number and is entitled to the date of filing or date(s) of priority (if any) of the parent application; and shall be published on Industrial Gazette of Vietnam after IP VIETNAM issues a decision on acceptance of valid application.

5. Requirements To Be Met For an ID divisional application In Vietnam

There are four requirements that must be met for an ID divisional application in Vietnam. IP VIETNAM will deny the divisional application if neither of the requirements listed below is met.

- (i) The ID divisional application must be filed with an official letter that includes a request for division and specifies the application number of the parent ID application; the application request; the specification; the set of photos/drawings; the receipt of fees and the power of attorney;
- (ii) The claimed subject matter in the ID divisional application must be contained in the parent ID application;
- (iii) The claimed subject matter in the ID divisional application must be different from the claimed subject matter in the parent ID application after being divided;
- (iv) The ID divisional application must not expand the scope of protection beyond the content disclosed in the original application and must not alter the nature of the subject matter presented in the original ID application.

6. ID divisional application: How to process?

When filing an ID divisional application, it is treated as a separate and new application. Therefore, the applicant is required to pay the filing fee, as well as all fees and charges for procedures conducted independently from the parent application (except for the priority claim fee).

The ID divisional application shall undergo a formality examination and continues to progress through the remaining procedures that were not completed for its parent application.

The ID divisional application shall be published and the applicant needs to pay fees for publication if it is filed after IP VIETNAM issues a decision on acceptance of valid application for parent application.

The time limit for examination period of an ID divisional application is counted from the date of receipt of the ID divisional application.

7. The parent ID application after being divided: How to process?

The following actions for the parent ID application need to be taken:

Submit an official letter requesting an amendment and indicate the retained industrial design(s), and pay the fees for the amendment.

Revise the specification appropriately, which includes:

- Amending the name of ID (if necessary);
- Making necessary amendments to the parts such as “Field of use”, “Closest prior art” by removing the related parts of the divided subject matter) (if necessary);
- Making amendments to the list of photos/drawings by eliminating the related parts of the divided subject matter);
- Amending the description section by removing the related parts of the divided subject matter;
- Amending the claim section.

The parent application, after division and amendment, will undergo further processing in accordance with the application amendment procedure.

8. ID divisional application: What are some additional notes?

While division of an ID application is accepted in Vietnam, it is important to note that an applicant is not at his own discretion to separate embodiments (*does not have complete autonomy in separating embodiments*) from the parent application into new applications may be not accepted. Here are some additional notes that KENFOX IP & Law Office would like to provide:

When opting to divide a specific product from a set of products, it is necessary to ensure that ALL embodiments associated with the divided product are transferred into the corresponding divisional application.

If an application includes multiple embodiments of the same product, and these embodiments are not substantially different from each other, it is advised not to pursue division. Two IDs are considered not significantly different if they are intended for products of the same type and share the same set of basic design features, differing only in non-basic design features (minor characteristics).

If the application contains multiple embodiments of multiple products, and these products constitute a set of products, then division may not NOT NECESSARY. However, if the applicant wishes to do so, it is still acceptable by IP VIETNAM.

If the application includes multiple embodiments of multiple products, and these products do not form a set of products, division is NECESSARY. The following cases are not considered as product sets. First, the products are not used together or for a common purpose. Second, IDs of the products do not express a single common inventive idea. Third, parts of the same composite product. Fourth, embodiments of the same ID are not considered as a set of product.

If the application includes multiple embodiments of the same product, and these embodiments are significantly different from each other, division is NECESSARY. Two IDs are considered significantly different if either of the following conditions is met: (i) They are used for products of different types, or (ii) They are used for products of the same type but have at least one basic design feature that is significantly different.

In cases where the application includes multiple embodiments, with some exhibiting insignificant differences while others display significant differences, a viable approach is to divide these embodiments into distinct groups. Each group will consist of embodiments that are not significantly different from one another. Subsequently, a divisional application can be filed specifically for the group of embodiments that are significantly different from the other group(s).

Final thoughts

Remember, filing an ID divisional application can be a strategic approach to ensure adequate [protection for embodiments/products](#) that are significantly different, while preserving embodiments/products that are not significantly different in the parent application.

Filing a divisional application for an ID incurs additional fees and potential complexity in managing the industrial design family. However, in cases where the application has been published and division is required, if only the selected embodiments/products are retained without submitting a divisional

application for the unselected embodiments/products (where the unselected ones are simply removed from the parent application), those unselected embodiments/products may become available for public use. This public use can have negative effects on the applicant, such as introducing competition in the market and potentially reducing the applicant's revenue or profit. Furthermore, the applicant will not have a second opportunity to exclusively exploit the benefits of the removed embodiments/products or prevent others from using them.

In light of the foregoing, it is advisable that the applicant should consider filing a divisional application for the unselected IDs if they hold significant value or carry a high risk of infringement.

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