

PCT Applications Designating or Selecting Vietnam: Common Mistakes and How to Avoid Them?

Many patent applicants mistakenly believe that having their Patent Cooperation Treaty (PCT) applications formally accepted and published by WIPO guarantees the safety of patent protection in Vietnam. However, this is far from the truth. Numerous PCT applications designating or selecting protection in Vietnam have been met with preliminary rejection notices or even outright refusals from the Vietnam Intellectual Property Office (VNIPO). These legal setbacks stem from a failure to recognize potential rejection risks, non-compliance with Vietnamese IP laws, and inadequate strategies for rectifying errors.

KENFOX IP & Law Office, with 15 years of experience in advising and handling numerous PCT applications, analyzes and identifies common errors in PCT applications that often lead to rejection risks in Vietnam and additionally, proposing effective solutions to help overcome these obstacles.

1. PCT applications designating or selecting protection in vietnam rejected: Why?

In Vietnam, all patent applications undergo two examination stages: formality examination and substantive examination (Articles 109 and 114 of the IP Law). For PCT applications, formality examination is conducted by the International Application Receiving Authority of WIPO, and the application is published only after formal acceptance. Consequently, upon entering the national phase in Vietnam, PCT applicants are only required to submit the minimum required documents as per regulations. VNIPO will generally accept all information published on WIPO regarding the relevant application, such as the applicant's name and address, inventor's name, [priority application information](#), and amendments made during the international phase. But why are many PCT applications designated or elected for protection in Vietnam still rejected?

Differences in IP regulations: Each country has its own IP legal system, with specific regulations and requirements for patent protection. Consequently, patent registration rules may vary between countries, even among those participating in the PCT. Therefore, acceptance of a patent application by WIPO in terms of formality does not mean that it will automatically be accepted in Vietnam. VNIPO may reject a PCT application if it violates Vietnamese IP regulations, even if the application has been accepted by WIPO.

Errors and omissions in patent specification: The patent specification is a crucial component of a patent application, enabling VNIPO to comprehend the invention's nature and assess its patentability. Errors and omissions in patent specifications are prevalent reasons for PCT application rejections in Vietnam. Specifically:

Formality errors:

Several formal deficiencies can also jeopardize the acceptance of a PCT application in Vietnam. These include:

- (i) Omission of mandatory headings: The absence of essential headings like " Background technical" and "Summary" renders the patent description illogical, difficult to comprehend, and hinders the evaluation process by the examining authority.
- (ii) Non-compliance with claim format: Failure to adhere to [Vietnamese patent specification](#) regulations regarding independent claim presentation can lead to a cluttered, unorganized, and unclear description of the protected subject matter. Each independent claim should be presented as a single, concise sentence.
- (iii) Ambiguous claims: Unclear claims that fail to explicitly define the protected subject matter hinder VNIPO's understanding of the invention and may result in a denial of protection.
- (iv) Indistinction between independent and dependent Claims: Omission of clear indicators distinguishing independent and dependent claims creates confusion regarding the scope of protection sought by the applicant and can lead to misinterpretations of the invention's protected range.
- (v) Inaccurate invention title: A title that inadequately reflects the protected subject matter can cause misunderstandings about the invention's essence. The title should accurately and concisely convey the core features of the invention.

Content-related errors:

PCT applications designating or selecting protection in Vietnam are often rejected due to the following content-related errors:

- (i) Lack of technical features in claims: Claims that merely describe the functional characteristics and effects of the invention without identifying the underlying technical features hinder VNIPO's assessment of novelty, inventiveness, and patentability.

- (ii) Unfavorable International Preliminary Examination Report (IPER): An unfavorable IPER concluding that the invention lacks novelty and inventive step compared to prior art poses a significant challenge to obtaining protection in Vietnam. VNIPO may rely on this conclusion as grounds for [rejection](#) during the substantive examination stage.

2. Addressing PCT application errors: What are effective approaches?

Facing the risk of rejection can discourage applicants, raise concerns about the likelihood of acceptance, and lead to significant costs and time spent rectifying errors. However, abandoning the pursuit of patent protection in Vietnam is not the optimal solution. While errors in PCT applications can pose significant challenges, they do not signal the end of an applicant's hopes for patent protection in Vietnam. Instead of giving up, applicants should proactively adopt effective strategies to address these shortcomings and enhance their chances of application acceptance.

[i] Thoroughly analyze the rejection notice:

- Understand the specific reasons for rejection: Carefully review the rejection notice to comprehend the precise grounds for rejection, including any formal errors, content-related shortcomings, and assessments from the IPER (*if applicable*).
- Identify areas for amendment and supplementation: Determine the specific aspects of the application that require modification or additional information to comply with Vietnamese IP law.

[ii] Addressing formality issues:

- Ensure all mandatory formality sections are included according to Vietnamese regulations, including the title, description, abstract, and drawings (*if applicable*).
- Organize the layout logically and present it clearly and understandably to facilitate the review process.

[iii] Enhancing patent application content:

- Selecting an appropriate subject matter of protection: Precisely identify the invention that the applicant seeks to protect, ensuring its novelty and patentability under Vietnamese law.
- Clarifying essential technical features: Analyze and determine the invention's core technical features, accurately and comprehensively describing them in [the application's specifications and claims](#).
- Revising the claims: Rewrite the claims in a clear, concise, and precise manner, fully encompassing the subject matter of protection, essential technical features, and clearly distinguishing between independent and dependent claims.
- Countering IPER: Based on the revised claims, construct well-structured and logical arguments to counter any assessments regarding novelty and inventive step raised in the IPER.

Final thoughts

PCT applications designating or selecting Vietnam often encounter a multitude of potential “pitfalls”, ranging from formalities errors like missing titles or non-compliant formatting to content-related issues such as unclear claims, insufficient technical features, or inconsistencies with the IPER report. These shortcomings can expose PCT applications to a high risk of rejection during the Vietnamese national phase.

However, a rejection is not the end of the road; it presents an opportunity for applicants to refine their applications, address the identified errors, and increase their chances of securing patent protection in Vietnam.

[Patent protection regulations](#) are inherently complex. Therefore, to minimize the risk of rejection for PCT applications designating or electing Vietnam, in addition to having a deep understanding of the technical field of the invention, applicants should also consider collaborating with a reputable IP agent to receive professional support during the patent protection process in Vietnam. IP agents have a team of experienced lawyers and experts who are well-versed in both Vietnamese and international IP laws. They can help applicants effectively address complex issues, save time and costs, and increase the chances of successful patent protection in Vietnam.

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