

# Patents

**2.1 Types of Patents** Practically, there are three types of patent available under IP Law 50/2005, namely:

1. Patent for inventions;
2. Patent for utility solutions; and
3. Patent for industrial design. Inventions are technical solutions relating to a product or process aiming to solve a specific problem by utilizing the laws of nature. To be protected in the form of a patent for invention, an invention must be new, involve an inventive step, and be capable of industrial application. Although inventiveness is not required for an invention to be protected by a patent for utility solutions, an invention must still be something other than common general knowledge.

An industrial design covers the exterior shape of a product, represented in three dimensional forms, lines, colors or any combination thereof. An industrial design shall be protectable if it is new, creative, and capable of industrial application.

## **2.2 Patentability**

### **2.2.1 Inventions**

To be patentable, an invention shall meet the criteria of worldwide novelty and industrial applicability. In addition, an invention must involve an inventive step. These criteria are specifically defined as follows:

#### **(i) Novelty**

An invention shall be considered to be new if it was not publicly disclosed by means of use, written description or in any other way inside or outside the country, prior to the filing date or, where priority is claimed, the priority date of the patent application.

An invention shall not be considered as publicly disclosed if it is known to only a limited number of persons who are obliged to keep it secret. Further, an invention shall not be considered to lack novelty if: (i) the invention was unauthorizedly disclosed by another person without will and acceptance of the applicant; (ii) it was disclosed by the applicant in the form of a scientific report; and (iii) the invention was displayed at a national exhibition of Vietnam or an official or officially recognized international exhibition, provided that the patent application for such an invention is filed within 6 months from the date of disclosure.

### **(ii) Inventive Step**

An invention shall be considered as involving an inventive step if, having regards to technical solutions already disclosed to the public by means of use, written description or in any other way inside or outside Vietnam prior to the date of filing, or the priority date where priority is claimed, of the patent application, it constitutes an inventive progress and cannot be easily made by a person ordinarily skilled in the art.

### **(iii) Industrial Applicability of Inventions**

An invention shall be considered to be capable of industrial applicability if it can be applied to mass production or manufacture of the product or it is possible to repeatedly apply the process that is the subject matter of the invention to get stable results.

## **2.2.2 Industrial Designs**

To be patented an industrial design shall be new, creative and capable of industrial application.

### **(i) Novelty**

An industrial design will be considered to be new if it

substantially differs from industrial designs that are already disclosed to the public inside or outside Vietnam by means of use, written description or in any other way prior to the date of filing or the priority date, where priority is claimed, of the industrial design application.

For the novelty determination, two designs shall not be considered as substantially different from each other if they are different merely in design features that are not easily recognized and memorized and that cannot serve to distinguish the two designs as a whole.

An industrial design shall not be considered as publicly disclosed if it is known to only a limited number of persons who are obliged to keep it secret. Also, an industrial design shall not be considered as lacking novelty if: (i) the design was unauthorizedly disclosed by another person without permission of the applicant; (ii) it was disclosed by the applicant in the form of a scientific report; and (iii) the design was displayed at a national exhibition of Vietnam or an official or officially recognized international exhibition, provided that the patent application for such an industrial design is filed within 6 months from the date of disclosure.

#### **(ii) Creativity of Industrial Design**

An industrial design shall be considered to be creative if, having regards to the industrial designs already disclosed to the public inside or outside the country prior to the date of filing or the priority date where priority is claimed, of the industrial design application, it cannot be easily created by a person ordinarily skilled in the art.

#### **(iii) Industrial Applicability of Industrial Design**

An industrial design shall be considered to be capable of industrial application if it can serve as a template for mass production of the product having an exterior shape embodying such industrial design by industrial or handicraft methods.

## **2.3 Exclusions from Patentability**

For inventions, the following shall be exempted from protection under IP Law 50/2005:

1. discoveries, scientific theories, mathematical methods;
2. schemes, plans, rules and methods for performing mental acts, training domestic animals, playing games, doing business; computer programs;
3. presentations of information;
4. aesthetic solutions;
5. plant varieties, animal varieties;
6. essentially biological processes for the production of plants and animals except microbiological processes; and
7. preventative, diagnostic and therapeutic methods for treatment of the human or animal body.

For industrial designs, the following shall be excluded from protection:

1. the exterior shape of a product dictated merely by technical features thereof;
2. the exterior shape of a civil or an industrial construction work;
3. the exterior shape of a product that is invisible during the use of the product.

It is also explicitly stated under IP Law 50/2005 that inventions and industrial designs shall not be patented if they are contrary to social morality, public order, or detrimental to national defense and security.

## **2.4 Patent Term and Maintenance/Renewal**

Vietnamese patents become effective on the date of issuance and end 20 years computed from the filing date for inventions (subject to annuity payment), without any renewal term. The patent for utility solution enjoys the term of ten years from the filing date. The patent for industrial design is effective from the granting date, lasts for five years from the filing

date, and can be renewed for two further five year terms (subject to payment of renewal fee).

The patent owner of a Patent for Invention or Patent for Utility Solution is required to pay annuity fees in order to maintain its validity. In order to renew the validity of an Industrial Design Patent, its owner shall pay renewal fees.

Unless otherwise provided by laws, the following schedule of annuities is applied.

<b>Year</b>	<b>Amount of Annuity (USD)</b>
1st to 2nd year	16.7/independent claim/year
3rd to 4th year	26.7/independent claim/year
5th to 6th year	43.4/independent claim/year
7th to 8th year	66.7/independent claim/year
9th to 10th year	100/independent claim/year
11th to 13th year (for inventions only)	140/independent claim/year
14th to 16th year (for inventions only)	183.4/independent claim/year
17th to 20th year (for inventions only)	233.4/independent claim/year

Annuities are not required for pending patent application(s). The first annuity should be paid on the date of grant of patent while the payment of the succeeding annuities must be made within the six-month period prior to the anniversary of the grant date. A late payment of annuity is available within a grace period of six months counted from the due date of annuity, subject to an extra fee amounting to 10% of said annuity for each month overdue. No provision on the restoration of the validity of a patent is addressed in the IP laws and regulations.

## **2.5 Rights and Obligations of Patent Owners**

### **2.5.1 Patent Rights**

A patent owner shall be granted the right to use or allow others to use the patented invention or industrial design. The patentee also has the right to prevent others from using the patented invention or industrial design without his/her own authorization and to dispose thereof.

The use of an invention means carrying out the following acts: manufacturing the patented product; applying the patented process; exploiting the patented product or a product obtained by the patented process; circulating, advertising, offering for sale, stocking for circulation of and importing the above mentioned product.

The use of an industrial design means carrying out the following acts: manufacturing products with an appearance embodying the patented industrial design; and circulating, advertising, offering for sale, stocking for circulation of and importing the above mentioned products.

### **2.5.2 Obligations of the Patent Owners**

The patent owner has obligation to: (1) pay remuneration to the inventor(s); (2) pay the annuity or renewal fee for maintenance or renewal of the patent; and (3) use or license the patented invention or industrial design to another person upon decision of the State administrative authority (compulsory license).

For a patent for invention, the patent owner shall be under obligation to permit the owner of the dependent invention using his/her dominant (basic) invention, provided that the dependent invention has been proved to have made an important technical advance in comparison with the dominant invention and to have high economic value. In case the owner of the dominant invention fails, without legitimate grounds, to satisfy the request made by the owner of the dependent invention, the State competent authority may, without

permission of the owner of the dominant invention, grant a license to exploit the dominant invention to the owner of the dependent invention

## **2.6 Limitations to Patent Rights**

The patent rights as mentioned above shall be limited by prior user's rights, compulsory license, and other acts.

### **2.6.1 Prior User's Rights**

The exercise of the prior user's right to invention or industrial design shall not be considered as an infringement of rights of the owner of the patented invention or industrial design. Where a person who, before the publication date of an invention or industrial design application, was using or had made substantial preparation toward the using of an invention or industrial design independently created but identical with the invention or industrial design claimed in the application, the said prior user shall be entitled to continue the use after the patent is granted, within the extent and volume of use or substantial preparation toward the using already made. The prior user shall not be entitled to enlarge the extent and volume of use unless it is so permitted by the owner of the patented invention or industrial design. The prior user's right shall not be allowed to be transferred except for the case it is transferred together with the business establishment where the prior user's right is exercised.

### **2.6.2 Compulsory License**

The right to use an invention shall, without permission of the patentee, be granted to another entity or individual upon decision of the State competent authority if (i) the use of the invention is intended for the public interest, non-commercial purposes, national defense, security, prevention and treatment of disease, for people's nutrition, or meeting other urgent needs of society; (ii) the patentee fails to fulfill the obligation of using the invention after the

expiration of four years from the date of filing of the patent application and three years from the granting date of the patent for invention; (iii) the person who wants to use the invention fails, within a reasonable period of time for negotiation on reasonable considerations and commercial conditions, to reach an agreement with the patentee on a license to use such an invention; or (iv) the patentee is regarded as performing an act of anti-competition prohibited under the competition law and regulations.

The right to use the invention under the compulsory license granted by a decision of a State competent authority shall meet the following conditions:

- a. The right to use shall be non-exclusive;
- b. The right to use shall only be limited to such a scope and duration sufficient to attain the purpose for which the compulsory license was granted, and predominantly for the supply of the domestic market;
- c. The licensee of the compulsory license shall not assign the right to use the patented invention to another person, except where the assignment is made together with his/her business establishment and sub-license others to use the patented invention;
- d. The licensee of the compulsory license shall pay the patentee/licensor adequate remuneration, taking into account the economic value of the allowed use, in compliance with the remuneration frame provided for by the Government;
- e. The patentee of the dominant invention shall also be entitled to grant a license to use the dependent invention on reasonable terms and conditions; and
- f. The licensee of compulsory license to use the dominant invention shall not be entitled to assign such right, except with the assignment of the entire right to the dependent invention.

### **2.6.3 Other Cases**

The following shall be exempted from patent infringement:

1. Use of the invention or industrial design for personal needs or non-commercial purposes, or for the purposes of evaluations, analysis, research, teaching, testing, pilot production or for collecting data to carry out procedures to obtain a production license, import or product marketing permit;
2. Use of the invention or industrial design only for the purpose of maintaining the operation of a foreign vehicle in transit or only temporarily entering into the territory of Vietnam;
3. Use of the invention or industrial design by prior user;
4. Use of the invention by the licensee of a compulsory license authorized by the State competent authority.

## **2.7 Who May File and Where to File Patent Applications**

The right to file a patent application for invention or industrial design generally belongs to inventors who have created the invention or industrial design by his/her own efforts and expenses. In case an invention or industrial design is created by the inventors during the course of employment or hire, the entitlement to file patent applications for such invention or design shall belong to the entities or individuals who have invested finance and material facilities to the inventors through employing or hiring. In addition, persons entitled to file an application may assign that right to other organizations or individuals through written contract or inheritance in accordance with the law. The right to file patent applications for inventions/industrial designs made by using the State budget belongs to the State.

All applications must be lodged with the National Office of Intellectual Property (NOIP), which has been entrusted to be the State administrative authority under the jurisdiction of the Ministry of Science and Technology. Vietnamese entities and individuals, foreign individuals permanently residing in Vietnam, and foreign entities having an industrial or

commercial establishment in Vietnam may file patent applications directly or through an IP agency licensed to practice before the NOIP. Foreign individuals not permanently residing in Vietnam and foreign entities having no industrial or commercial establishment in Vietnam shall file applications for patent rights through a licensed IP agency. As of July 2006 there are forty three local IP agencies licensed to practice in Vietnam before the NOIP.

## **2.8 “First to File” Principle**

Vietnam adopts the “first to file” principle. Accordingly, a patent will be granted to the person who is the first to file patent application for invention or industrial design. If there are two or more patent applications filed for the same invention or industrial design, all of the applicants are now required to reach an agreement to proceed with one application only. Without such an agreement, all those applications shall be refused.

## **2.9 Priority**

Patent applicants for subsequent invention or industrial design application are allowed to claim priority derived from the first application for the same subject matter filed in Vietnam or a member country of an international treaty having provisions on priority rights, to which the Socialist Republic of Vietnam is a party, or a country having agreed with Vietnam to apply such provisions, provided that the applicant is a national of Vietnam or such a member country.

To enjoy the priority right under the Paris Convention, a subsequent patent application for invention must be filed within twelve months from the filing date of the first application. The corresponding time limit for filing a subsequent industrial design application is six months. If the subsequent application claims different priorities, the relevant date for computing the time limit shall be the date

of the earliest priority. It is also possible for the applicant to claim multiple priorities in a single subsequent application derived from different earlier filed applications, provided that the corresponding contents of such earlier applications and the application in question are explicitly indicated.

In the event a patent applicant for a subsequent application for an invention succeeds in claiming priority derived from the first application earlier filed in Vietnam for the same invention, the patent shall only be granted to the subsequent application. The early filed application (also called priority application) shall be deemed to have been withdrawn.

For PCT applications, the time limit for entering the national phase in Vietnam under both Chapter I and Chapter II of PCT is thirty one months, computed from the priority date. However, as of 9 May 2007, a late entry of six months counted from the expiration of thirty one month period is allowed, subject to a late entry fee.

## **2.10 Patent Applications**

All patent applications shall be made in the Vietnamese language, with certain exempt documents that can be filed in another language provided that appropriate Vietnamese translations thereof shall be submitted to the NOIP within a prescribed period of time.

Patent applications need to satisfy the unity requirement. An application for an invention shall be deemed to meet this requirement if it relates to one invention or a group of inventions so linked as to form a single general inventive concept. For industrial designs, the application shall be regarded as meeting the unity requirement if it claims a number of designs of a set of articles that consist of two or more articles which express a single general inventive concept and are used together or for a single purpose; or one design

accompanied by one or more other variants of that industrial design, which express a single general inventive concept and are not significantly different from the industrial design.

For documents required for filing of domestically filed applications for inventions, PCT applications (entering the national phase in Vietnam), and applications for industrial designs, please see Filing Requirements in Vietnam.

### **2.11 Conversion of Applications for Invention Patent into Applications for Utility Solution Patent**

The applicant is allowed to convert a patent application for invention into a patent application for utility solution and vice versa. The time limit for conversion is any time prior to any Notification either for Refusal or Grant of a patent is made.

### **2.12 Formality Examination**

All Vietnam patent applications, including PCT applications, shall be automatically examined as to form within the statutory period of one month from the filing date. If the formalities are met, a Notification of Acceptance as to form shall be issued to confirm the accorded filing date and assigned application number. The filing date may be (i) the actual date on which the State administrative authority (i.e., the NOIP) receive the application and stamp the receiving seal thereon; or (ii) the international filing date of the PCT application if national patent application is a PCT-derived application.

If the application is objected due to (i) certain defects in form, (ii) the subject matter of the invention being statutorily unpatentable, (iii) the applicant not being entitled to file application, or (iv) the application being filed in an improper manner, a Notification of the Defect(s) of the application shall be issued and the applicant shall be given a one-month period counted from the date of the

Notification in order to correct such defects. Such informalities shall not affect the filing date.

The applicant may, at any time prior to the Notification of Issuance of patent, make amendments or additions to the application, but not beyond the disclosure or so as to change the nature of the invention, or industrial design originally claimed; or a fresh application needing to be filed. The amendments may also be made to the name and address of the applicant, the change of the applicant as a result of the assignment of application or inheritance, merger, acquisition or division of legal entities or the like.

### **2.13 Publication of Patent Application**

All patent applications accepted to examination for patentability shall be published in the Official Industrial Property Gazette for the purpose of opposition. Applications for inventions shall be published in the 19th month from the filing date, or the priority date where priority is claimed; or in the second month from the date of acceptance as to form, whichever is later. Early publication is available at the applicant's request. An industrial design application shall be published within 2 months computed from the date on which the application is accepted as to form.

A PCT-derived application is usually published in the second month from the date of acceptance of the application.

### **2.14 Request for Substantive Examination of Patent Applications**

The published Vietnam patent applications for inventions shall not be automatically examined on their merits. The examination shall be carried out only upon request for examination from either the applicant or a third party, subject to payment of an appropriate fee. Such a request shall be submitted to the NOIP within forty two months for inventions, counted from the filing date or the date of priority if the priority is

claimed, or the application shall be deemed to have been withdrawn. The time limit for making request for substantive examination of a patent application for utility solution is 36 months.

There is no provision on the request for examination for industrial design application under Vietnam IP Law. Substantive examination is automatically conducted for applications for industrial designs.

## **2.15 Substantive Examination and Grant of Patent**

Substantive examination is conducted by the NOIP in order to determine whether the invention claimed therein is patentable.

The time limit for substantive examination for invention applications is 18 months, computed from the publication date of the application if a request for substantive examination is filed prior to the publication date or from the date of receipt of a request for substantive examination if such request is filed after the publication date. For design applications, the substantive examination shall be conducted within six months from the date of publication of the application.

The applicant may, any time before the Notification of Issuance is made, either at the applicant's discretion or at the request of the NOIP, make amendments to the patent application. However, the amendments are not allowed to go beyond the disclosure originally filed.

If the invention or design claimed in the patent application is rejected as being unpatentable, or if the application contains some deficiencies, the NOIP shall issue a "Notification of Result of Substantive Examination" notifying the applicant of its intention to refuse to grant the patent and the grounds therefor, and set a two month period for the applicant to respond or make necessary amendments and/or arguments, or rectify the deficiencies. Such a set period of

time can be extended once for another two months by filing a request for extension of time to the NOIP. If the applicant fails to timely respond within such a prescribed period of time without any request for extension, the NOIP shall officially reject the application by issuing a "Notification of Refusal of Granting Patent."

Upon receipt of the response from the applicant, the NOIP's examiner shall re-consider the patent application. The time limit for re-consideration shall be two thirds of the initial examination period. For complicated cases, the time limit for re-consideration may be prolonged but may not exceed the initial examination. Also, the consideration shall be conducted by the examiner only once.

If the patentability requirements are met, or the applicant has properly rectified the deficiencies or successfully rebutted the examiner's rejection(s), the NOIP shall issue a "Notification of Issuance" notifying the applicant of its intention to grant a patent, and shall set an one month period of time for the applicant to furnish the NOIP with the required fees for issuance, publication, registrar, and the first annuity. The NOIP shall publish the patent in the IP Gazette, Volume B and enter it into the National Register of Industrial Property (National Register).

## **2.16 Appeal/Opposition Proceedings**

At any time during the period from the publication to the issuance of a patent, the applicant or any third party whose rights and interests are directly related to the granting of a patent shall be entitled to file written opposition with the NOIP, opposing either the grant or refusal to grant a patent.

Any opposition/appeal must be made in writing and accompanied by the content to be opposed, argumentation, and/or evidence to support the opposition. The opposition/appeal on the first instance must be submitted to the NOIP within 90 days from the

date of receipt or awareness of the NOIP's notification relating to refusal or grant of a patent as referred to above. In the event the opposer does not agree with the NOIP's decision on the opposition, the opposer may appeal either to the MOST or the court (appeal of second instance).

## **2.17 Cancellation or Suspension of Patents**

At any time after a patent is granted, any party may file a written request with the NOIP to wholly or partially cancel such patent. The grounds for cancellation may be:

1. The patentee was not entitled to apply for the patent, nor assigned that right from the entitled person; or
2. The patented invention or industrial design did not meet the conditions for patentability at the time the patent was issued.

The patent shall be partly invalidated if the respective part of the subject matter failed to meet the conditions of protection.

The patent's validity may be suspended at the request of any party, based on the grounds that (a) the patentee fails to pay the prescribed annuity or renewal fee as prescribed; (b) the patentee declares a disclaimer of the rights conferred by the patent; or (c) the patent owner no longer exists, and there is no lawful successor.

## **2.18 Patent Infringements**

The following acts shall be considered to infringe the rights of the owner of an invention or industrial design:

1. Use of the patented invention, protected industrial design or another industrial design insufficiently different from it within the validity term of the patent without permission of the patent owner;
2. Use of the patented invention or industrial design without paying compensation in accordance with the provisions on the provisional right.

For enforcement of patent rights and remedies available,  
please see Enforcement of Intellectual Property Rights.