

**CIRCULAR No. 01/2007/TT-BKHCHN OF FEBRUARY 14, 2007, GUIDING THE
IMPLEMENTATION OF THE GOVERNMENT'S DECREE No. 103/2006/ND-CP OF
SEPTEMBER 22, 2006, DETAILING AND GUIDING THE IMPLEMENTATION OF A NUMBER
OF ARTICLES OF THE LAW ON INTELLECTUAL PROPERTY REGARDING INDUSTRIAL
PROPERTY**

Pursuant to the November 29, 2005 Law on Intellectual Property;

Pursuant to the Government's Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding the implementation of a number of articles of the Law on Intellectual Property regarding industrial property;

Pursuant to the Government's Decree No. 54/2003/ND-CP of May 16, 2003, defining the functions, tasks, powers and organizational structure of the Ministry of Science and Technology, and Decree No. 28/2004/ND-CP of January 16, 2004, amending and supplementing a number of articles of Decree No. 54/2003/ND-CP;

The Ministry of Science and Technology guides the implementation of the Government's Decree No. 103/2006/ND-CP of September 22, 2006, as follows:

Chapter I

PROCEDURES FOR ESTABLISHMENT OF INDUSTRIAL PROPERTY RIGHTS

**Section 1. GENERAL PROVISIONS ON PROCEDURES FOR ESTABLISHMENT OF
INDUSTRIAL PROPERTY RIGHTS**

1. Grounds for establishment of industrial property rights

1.1. Industrial property rights arise/are established on the grounds specified in Clause 3, Article 6 of the November 29, 2005 Law on Intellectual Property (hereinafter referred to as the Intellectual Property Law), Clauses 1, 2, 3 and 4, Article 6 of the Government's Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding the implementation of a number of articles of the Intellectual Property Law regarding industrial property (hereinafter referred to as the Decree on industrial property) and specific provisions of this Point.

1.2. Industrial property rights to inventions, layout designs of semi-conductor integrated circuits (hereinafter referred to as layout designs), industrial designs and marks shall be established under decisions of the National Office of Intellectual Property (NOIP) on the grant of protection titles to persons that register those objects. Persons who are granted protection titles by the NOIP are owners and enjoy the rights to industrial property objects within the protection coverage stated in and the validity duration of protection titles. Upon occurrence of a dispute, the owner of an industrial property object may use the protection title as evidence to prove his/her/its rights without having to invoke any other proofs.

1.3. Industrial property rights to geographical indications shall be established under decisions of the NOIP on the grant of certificates of registered geographical indications to organizations managing those geographical indications.

1.4. Industrial property rights to marks internationally registered under the Madrid Agreement and the Madrid Protocol (hereinafter referred to as internationally registered marks) shall be established under decisions on acceptance for protection or certificates of protection in Vietnam of internationally registered marks granted by the NOIP upon the request of mark proprietors. These decisions and certificates are as valid as protection titles granted to persons registering marks in Vietnam.

1.5. Industrial property rights to well-known marks shall be established on the basis of their actual public use that has made them well known, and for those marks the registration with the NOIP is not required. While exercising the rights to and upon the settlement of a dispute over a well-known mark, its proprietor shall evidence his/her/its rights with appropriate proofs specified in Article 75 of the Intellectual Property Law.

1.6. Industrial property rights to trade names shall be established on the basis of the lawful use of those trade names, and for those trade names the procedures for registration with the NOIP is not required. While exercising the rights to and upon the settlement of a dispute over, a trade name, the entity owning that trade name shall evidence his/her/its rights with proofs indicating the period of time, territory and field in which the trade name has been used by that entity.

1.7. Industrial property rights to business secrets shall be established on the basis of financial investment and intellectual labor or the results of other lawful activities aimed to find, create or acquire information constituting business secrets and keep confidential such information, and for those business secrets the registration with the NOIP is not required. While exercising the rights to and upon the settlement of a dispute over rights to a business secret, the entity owning that business secret shall evidence his/her/its rights with proofs indicating activities in which information constituting the business secret has been created, found or acquired as well as the measure to keep confidential such information.

1.8. The right to suppression of unfair competition shall be established on the actual situation of competitive practices, and for that right the registration with the NOIP is not required. While exercising the right to suppression of unfair competition, right holders shall evidence their right with proofs indicating business entities, fields, territories and periods of time related to competitive practices.

2. Owners of industrial property registration applications

2.1. Owners of industrial property registration applications (hereinafter referred to as application owners) are organizations or individuals that file applications for registration of inventions, layout designs, industrial designs, marks or geographical indications. As soon as invention, layout design, industrial design or mark protection titles are granted, application owners are recognized as protection title holders. As soon as geographical indication protection titles are granted, application owners are recognized as geographical indication registrants.

2.2. Application owners must satisfy the conditions for the right of industrial property registration provided for in Articles 86, 87 and 88 of the Intellectual Property Law and Articles 7, 8 and 9 of the Decree on industrial property. If those conditions are not satisfied, the industrial property registration shall be considered invalid.

3. Representatives of application owners

3.1. Application owners may themselves carry out or authorize their lawful representatives in Vietnam to carry out the procedures for industrial property registration with the NOIP according to the provisions of this Point and Point 4 of this Circular.

3.2. The following organizations or individuals may act as representatives of application owners:

a/ For organizations or individuals defined in Clause 1, Article 89 of the Intellectual Property Law:

(i) If application owners are individuals: Their representatives at law or mandated representatives, or industrial property representation service organizations under their mandate;

(ii) If application owners are organizations: Their representatives at law or staffs of organizations mandated by their representatives at law; industrial property representation service organizations (under their mandate); heads of their Vietnam-based representative offices or branches (for foreign organizations).

b/ For organizations or individuals defined in Clause 2, Article 89 of the Intellectual Property Law: industrial property representation service organizations (mandated by application owners).

3.3. When carrying out the procedures for industrial property registration, the NOIP may only contact application owners or their lawful representatives. Organizations or individuals that do not fall into the cases specified at Point 3.2 of this Circular shall be regarded as unlawful representatives of application owners.

4. Mandate of representatives to carry out industrial property registration procedures

4.1. The mandate of representatives and the carrying out by mandated representatives of procedures for industrial property registration (hereinafter referred to as mandate) must comply with the provisions on mandate in Part III of the Civil Code and the provisions of this Circular.

4.2. The mandate shall be established in writing (power of attorney) with the following principal contents:

a/ Names (full names) and full addresses of the mandator and the mandated party;

b/ Name (full name) and full address of the party undertaking to act as a surrogate mandated or sub-mandated party (if any);

c/ Scope of mandate and mandated work volume;

d/ Mandate duration (a power of attorney with an unspecified validity duration will cease to be valid only when the mandator declares the termination of the mandate);

e/ Date of signing of the power of attorney;

f/ Signature(s) (with full names, titles and seals, if any) of the lawful representative of the mandator (and of the party undertaking to act as a surrogate mandated or sub-mandated party, if any).

4.3. The date when a power of attorney takes legal effect in transactions with the NOIP is determined to be:

a/ The date the NOIP receives a valid power of attorney;

b/ The date the NOIP approves the valid surrogate mandate or sub-mandate;

c/ The date the NOIP receives a notice on change of the mandate scope, ahead-of-time termination of mandate, change of the address of the mandated party.

4.4. In case of surrogate mandate or sub-mandate, a power of attorney is considered valid when the party acting as a surrogate mandated or sub-mandated party commits to bear responsibility for all matters arising from prior transactions conducted by the mandator with the NOIP.

4.5. If the scope of mandate stated in a power of attorney covers many independent procedures and the original power of attorney has been submitted to the NOIP, the mandated party, when carrying out subsequent procedures, shall submit copies of the power of attorney and give an accurate indication of the serial number of the application containing that power of attorney.

5. Responsibilities of application owners and their representatives

5.1. Application owners and their representatives shall ensure the truthfulness of information and documents supplied to the NOIP in the course of industrial property registration according to the following regulations:

a/ All transaction documents must be certified with the signatures of application owners or their representatives, appended with certification seals of organizations (if any). If certification of a notary public or another competent agency is required, such certification must be obtained;

b/ All Vietnamese translations of foreign-language documents must be guaranteed by application owners or their representatives to be verbatim translations of the original documents.

5.2. Application owners are liable for all consequences and obligations arising from transactions conducted by their representatives with the NOIP.

5.3. Representatives of application owners are accountable to application owners for all consequences of the declaration or supply of untruthful information in transactions with the NOIP and pay compensations for any damage caused.

5.4. Application owners and their representatives are below collectively referred to as applicants, unless otherwise specifically provided for.

6. Handling of opinions of the third party before issuing decisions on the grant of protection titles

6.1. From the date an industrial property registration application is published in the Industrial Property Official Gazette to the date prior to the issuance of a decision on the grant of a protection title, any organization or individual may send to the NOIP its/his/her written opinions on the registration right, the right of priority, protection conditions and other issues related to the industrial property registration application according to the provisions of Article 112 of the Intellectual Property Law. Written opinions of the third party shall be regarded as an information source for reference in the course of processing an industrial property registration application.

6.2. Within one month after receiving written opinions of the third party, the NOIP shall notify such opinions to the applicant and set a time limit of one month from the date of notification for the applicant to give feedback in writing. After receiving the applicant's feedback, when necessary, the NOIP shall notify the feedback to the third party and set a time limit of one month from the date of notification for the third party to respond in writing to that feedback. The NOIP shall process opinions of applicants and third parties on the basis of proofs and arguments furnished by the parties and documents included in the applications.

6.3. When considering opinions of the third party groundless, the NOIP is not required to notify those opinions to the applicant but shall notify the third party of its refusal to consider the opinions, clearly stating the reason for refusal.

6.4. If opinions of the third party are related to the registration right, when finding it impossible to determine whether or not such opinions are grounded, the NOIP shall notify such to the third party so that the latter can file a petition with a court for handling. Within one month after the NOIP issues the notice, if the third party fails to notify the NOIP of the filing of a petition with a court for handling, the NOIP shall regard the third party as having withdrawn its opinions. If the

NOIP is notified by the third party within the above time limit, it shall suspend the application processing until the results of dispute settlement by the court are obtained. After the results of dispute settlement by the court are obtained, the application processing shall be resumed in accordance with those results.

6.5. When necessary and upon the request of both parties, the NOIP shall organize face-to-face meetings between the third party and the applicant to further clarify the matter challenged by an opposition.

6.6. The time limit for the applicant to respond to the opposition of the third party shall not be counted into the time limit for the NOIP to carry out relevant procedures according to regulations.

7. General requirements for industrial property registration applications

7.1. Minimum documents

The NOIP shall only receive an industrial property registration application (hereinafter referred to as the application) which, upon its filing, contains at least the documents listed at Points a, b and e, Clause 1, Article 100, and Clause 1, Article 108 of the Intellectual Property Law and specified as follows:

a/ For an application for registration of an invention, layout design, industrial design, mark or geographical indication, mandatory documents include:

- (i) Declaration for registration;
- (ii) Documents, specimen and information disclosing the industrial property object sought to be registered;

Particularly for an invention registration application, a description of the invention; for an industrial design registration application, a set of photos, a set of drawings and a description of the industrial design; for a mark registration application, the mark specimen and list of goods and services bearing the mark; for a geographical indication, a description of particular characteristics and quality of products bearing the geographical indication and a map of the geographical area subject to the geographical indication;

- (iii) Fee and charge receipts.

In case of absence of any of the above documents, the NOIP may refuse to accept the application.

b/ For an application for registration of a collective mark or certification mark, in addition to the documents specified at Point 7.1.a above, the application must also contain the following documents:

- (i) Rules on the use of the collective mark/certification mark;
- (ii) Explanation of particular characteristics and quality of the product bearing the mark (if the to-be-registered mark is a collective mark used for a product with unique characteristics or a mark for certification of the quality of a product or a mark for certification of geographical origin);
- (iii) Map showing the indicated territory (if the to-be-registered mark is a mark for certification of the geographical origin of a product).

7.2. Requirements for applications

a/ Applications must meet the general requirements specified in Articles 100 and 101 of the Intellectual Property Law and specific requirements for each type of industrial property object specified in Articles 102, 103, 104, 105 and 106 of the Intellectual Property Law and guided in detail at Points 23, 28, 33, 37 and 43 of this Circular.

b/ To ensure the technical requirements in the course of processing, an application must also satisfy the following formality requirements:

(i) Each application can request grant of one protection title which is of a type suitable to the industrial property object stated in the application;

(ii) All documents of the application must be in Vietnamese, except for documents that are allowed to be made in another language according to the provisions of Points 7.3 and 7.4 of this Circular;

(iii) All documents of the application must be presented in the portrait format (particularly, drawings, figures, charts and tables may be presented landscape) on A4 paper sheets (210 mm x 297 mm), of which the top, bottom, left and right margins are all 20 mm, except for accompanied documents originally not intended to be included in the application;

(iv) For documents that must be made according to pre-designed forms, those forms shall be used with all necessary information filled in appropriate sections;

(v) A document consisting of many pages must have page numbers in Arabic;

(vi) All documents must be typewritten or printed with a non-fading ink, clear and clean, and free from erasures and modifications; if detecting any negligible spelling error in a document submitted to the NOIP, the applicant may correct such error but shall append his/her signature of certification (and a seal, if any) at the corrected words;

(vii) Terms used in the application must be common ones (other than dialects, rare words, coined words). Symbols, units of measurement, electronic fonts and spelling rules used in the application must conform to Vietnam standards;

(viii) The application may be accompanied with carriers of electronic data of part or the entire content of its documents.

c/ The application must fully satisfy the requirements on quantities of documents, specimens, drawings and photos, and specific requirements for each type of application specified in this Circular.

d/ The declaration form and other documents of the application must contain fully mandatory and consistent information; the Vietnamese translations of the application's documents must be true to the original documents; the power of attorney must indicate the contents of work within the scope of mandate.

e/ The object(s) stated in the application must be accurately grouped and classified according to regulations.

f/ Documents that require certification of competent agencies (the agency that has first received the application, the notary public, People's Committee, etc.) must be affixed with those agencies' seals of certification.

7.3. The following documents may be made in languages other than Vietnamese but must be translated into Vietnamese:

a/ Power of attorney;

b/ Documents certifying the right of registration in case the applicant enjoys another person's right of registration (inheritance certificate; certificate of or agreement on transfer of the right to file an application, covering also the transfer of a filed application; job assignment contract or labor contract, etc.);

c/ Documents evidencing the grounds for enjoying the right of priority (certification by the application-receiving agency of copies of the initial application(s); the list of goods and services in the initial mark registration application; the paper on transfer of the right of priority in case the applicant enjoys that right from another person).

7.4. The following documents may be made in languages other than Vietnamese but must be translated into Vietnamese upon the request of the NOIP:

a/ Copies of the initial application to evidence the ground for enjoying the right of priority;

b/ Other documents annexed to the application.

8. Industrial property registration fees and charges

8.1. Applicants shall pay fees and charges according to the Ministry of Finance's regulations.

8.2. Collection of fees and charges

a/ When receiving an application or a request for any other procedures to be carried out, the NOIP shall ask the applicant to pay prescribed fees and charges and check fee and charge receipts included in the application.

b/ If fees and charges are not yet fully paid according to regulations, the NOIP shall issue a fee and charge collection notice to the applicant.

After the applicant has fully paid fees and charges, the NOIP shall issue two originals of each fee or charge receipt clearly indicating the fee or charge amount paid, of which one shall be enclosed with the application as an evidence of payment of fees and charges.

8.3. Refund of paid fee and charge amounts

a/ Paid fee and charge amounts shall be partially or wholly refunded upon the request of the applicant in the following cases:

(i) Fees and charges have been overpaid;

(ii) Jobs for which fees and charges have been paid are not performed due to non-occurrence of circumstances requiring these jobs.

b/ In case of acceptance of a request for fee and charge refund, the NOIP shall issue a fee and charge refund notice to the applicant, clearly stating the refunded amount and the mode of refund.

c/ In case of rejection of a request for fee and charge refund, the NOIP shall notify such to the applicant, clearly stating the reason for rejection.

9. Time limits

9.1. Time limits specified in the Intellectual Property Law, the Decree on industrial property and this Circular shall be counted according to the provisions of Chapter VIII, Part I of the Civil Code.

9.2. The time limit for applicants and concerned parties to submit, modify or add documents or give their opinions may be prolonged once for a period of time equal to the set time limit, if the

applicant submits a written request for prolongation before the date of expiration of the set time limit and pay a prescribed fee.

9.3. Applicants may request in writing the NOIP to carry out the procedures before the set deadline and shall pay a prescribed fee. In case the NOIP rejects such a request, it shall notify the applicant of the rejection, clearly stating the reason.

10. Forms of documents and protection titles

10.1. Forms of application documents are provided in the Appendices to this Circular (not printed herein). Applicants shall use these forms to compile documents of their applications for industrial property registration.

10.2. Forms of protection titles are provided in the Appendices to this Circular (not printed herein). The NOIP shall archive these forms of protection titles in order to check the legality of protection titles in use. Any change of a protection title form may only be made under a decision of the Minister of Science and Technology.

11. General procedures

All types of industrial property registration application shall be processed by the NOIP in the following order: receipt of applications; formality examination of applications; publication of valid applications; substantive (ex-officio) examination of applications (except for layout design registration applications, which are not subject to substantive examination); grant of or refusal to grant protection titles; official registration and publication of decisions on the grant of protection titles.

12. Filing and receipt of applications

12.1. Applications may be filed with the NOIP or at other application receipt places arranged by the NOIP. Applications may also be sent by post to the above places of application receipt.

12.2. Upon receipt of an application, the NOIP shall check the application's documents and compare them with those listed in the declaration before deciding whether or not to receive the application:

a/ If the application contains all the minimum documents specified at Point 7.1 of this Circular, the application-receiving officer shall accept the application, affix a seal to certify the filing date and the serial number of the application in the declaration form;

b/ If the application lacks any of the minimum documents specified at Point 7.1 of this Circular, the application-receiving officer shall reject the application or send a notice of the NOIP's rejection of the application to the applicant (if the application is sent by post). For the rejected application, the NOIP is not required to return the application's documents to the applicant, but shall refund the paid fee and charge amounts according to the fee and charge refund procedures specified at Point 8 of this Circular;

c/ In case of acceptance of the application, the NOIP shall hand over (send) to the applicant one declaration form bearing the seal of certification of the filing date, the serial number of the application and the result of the checking of the list of application documents, and the full name and signature of the application-receiving officer. This handed over (sent) declaration form is valid as an application receipt.

13. Formality examination of applications

13.1. Purposes and contents of formality examination of applications

Formality examination of applications means examination of observance of regulations on formalities applicable to applications, serving as a basis for concluding whether applications are valid or invalid.

Valid applications shall be further examined. Invalid applications shall be rejected (shall not be further examined).

13.2. Valid applications

An application is considered valid if it complies with the provisions of Point 7 of this Circular and does not fall into one of the following cases:

a/ The application is made in a language other than Vietnamese, unless otherwise specified at Points 7.3 and 7.4 of this Circular;

b/ The declaration form contains insufficient information on the author (for invention, industrial design or layout design registration applications), on the applicant or his/her representative, the signature and/or seal of the applicant or his/her representative; the mark registration application lacks the list of goods and services; the geographical indication registration application fails to list products bearing the geographical indication;

c/ There is a ground to confirm that the applicant does not have the right of registration;

d/ The application is filed in contravention of the provisions of Article 89 of the Intellectual Property Law;

e/ The application contains errors specified at Point 13.3 of this Circular, which affect its validity, and the applicant, after receiving a request of the NOIP, fails to amend or unsatisfactorily amends the application;

f/ There is a ground to immediately confirm that the object stated in the application is apparently ineligible for protection by the State according to the provisions of Articles 59, 64, 69, 73 and 80 of the Intellectual Property Law.

For an application that involves many objects and falls into the case specified at Points 13.2.a, 13.3.b and 13.3.c of this Circular, if it contains errors related to only one or some of the objects in that application, the application shall be considered partially invalid (corresponding to erroneous object(s)). For other objects, the application is still considered valid.

13.3. Correction of errors in applications at the stage of formality examination

If an application still contains the following errors, the NOIP shall notify them to the applicant for correction within one month from the date of notification:

a/ The application fails to satisfy the formality requirements specified at Point 7.2 of this Circular (containing an insufficient number of copies of any of mandatory documents; failing to satisfy the uniformity requirement; failing to satisfy the requirements on the presentation format; a mark registration application fails to clearly state the mark sought to be registered, lacks the mark description, inaccurately classifies goods and services, lacks translations of documents enjoying priority, when necessary; or information on the applicant in different documents is inconsistent or erased or not properly certified);

b/ The application filing fee and publication fee have not yet been fully paid;

c/ There is no power of attorney or the power of attorney is invalid (for applications filed through representatives).

13.4. Determination of filing date

The filing date is determined as follows:

a/ The filing date is the date an application is accepted by the NOIP indicated in the seal of receipt affixed on the declaration form according to the provisions of Point 12.2.a of this Circular;

b/ For an international application that designates or/and elects Vietnam, the filing date is the international filing date.

13.5. Determination of date of priority

a/ If an application does not contain a claim for priority or contains a claim for priority but that claim is not accepted by the NOIP, the application shall be regarded as having no date of priority.

b/ If an application contains a claim for priority, the date(s) of priority is (are) the date(s) stated in that claim and accepted by the NOIP.

c/ The determination of the date of priority according to the claim for priority shall be based on the first application(s) filed in Vietnam in accordance with the principles specified in Article 91 of the Intellectual Property Law and relevant provisions of Points b, c and e, Clause 1, Article 10 of the Decree on industrial property.

13.6. Notification of results of formality examination and acceptance of valid applications

a/ For an application falling into one of the cases specified at Point 13.2 of this Circular or containing errors specified at Point 13.3 of this Circular, the NOIP shall send to the applicant a notice on its intended rejection of the application. Such a notice must clearly state the name and address of the applicant; the name of the industrial property representation service organization (if the application is filed through that organization); the name of the object stated in the application; the filing date and the serial number of the application; errors and reasons for which the application is rejected; and set a time limit of one month from the date of notification for the applicant to give opinions or correct errors.

b/ For a valid application, the NOIP shall send to the applicant a notice on acceptance of valid application, clearly stating the name and address of the applicant, the name of the mandated representative (if any) and information on the object stated in the application, the filing date and the date of priority (in case a claim for priority is not accepted, the reason for non-acceptance must be clearly stated).

13.7. Rejection of applications

If the applicant to whom the NOIP has sent a notice on its intended rejection of the application according to the provisions of Point 13.6.a of this Circular fails to correct errors or unsatisfactorily corrects errors or makes no opposition or makes unreasonable opposition to the intended rejection within the set time limit, the NOIP shall send to the applicant a notice on its rejection of the application and, upon the applicant's request, refund the paid fee and charge amounts for jobs to be done after the formality examination.

13.8. Time limit for formality examination of applications

a/ The time limit for formality examination of an application is one month from the filing date.

b/ In the course of formality examination, if the applicant corrects or supplements documents on his/her own initiative or upon the request of the NOIP, the time limit for formality examination may be prolonged for a period of time during which documents are corrected or supplemented.

c/ Before the expiration of the time limit specified at Point 13.8.a above, the NOIP shall complete the formality examination of applications and send notices on examination results to applicants according to the provisions of Point 13.6 of this Circular.

14. Publication of valid applications

14.1. All applications accepted as valid shall be published by the NOIP in the Industrial Property Official Gazette. Applicants shall pay a fee for such publication.

14.2. Time limit for publication of applications

a/ Publication of invention registration applications:

i/ An invention registration application shall be published in the nineteenth month from the date of priority or the filing date in case the application has no date of priority or within two months after it is accepted as a valid application, whichever is later;

(ii) An invention registration application under the Patent Cooperation Treaty (hereinafter abbreviated to PCT) shall be published within two months from the date it is accepted as a valid application and enters the national phase;

(iii) An invention registration application containing a request for earlier publication shall be published within two months from the date the NOIP receives that request or the date it is accepted as a valid application, whichever is later.

b/ Publication of other applications: Layout design, industrial design, mark or geographical indication registration applications shall be published within two months from the date they are accepted as valid applications.

14.3. Contents of publication of applications

Information related to valid applications, including divisional applications published in the Industrial Property Official Gazette, includes information related to valid applications' formality as stated in notices on acceptance of valid applications, information related to valid applications (transfer of applications, division of applications, serial numbers of parent applications, etc.); invention abstracts accompanied with drawings (if any); sets of photos or drawings of industrial designs; specimens of marks and enclosed lists of goods and services; summaries of particular characteristics and names of products bearing geographical indications.

14.4. Access to information on published valid applications

Everyone may access detailed information on the nature of objects stated in the applications published in the Industrial Property Official Gazette or request the NOIP to supply such information and is liable to pay an information supply fee according to regulations.

15. Substantive examination of applications

15.1. Purpose and coverage of substantive examination

a/ The purpose of substantive examination of applications is to assess the protectability of objects stated in those applications under the protection conditions and corresponding protection coverage (volume).

b/ The procedures for substantive examination are not applicable to layout design registration applications.

15.2. Use of information search results

a/ In the course of substantive examination of invention/industrial design registration applications with claims for priority, the NOIP may use the results of information search and examination of those applications filed overseas.

b/ Applicants may supply (on their own initiative or upon the NOIP's request) the following documents for use in service of substantive examination of their applications:

(i) For an invention/industrial design registration application: Results of information search or examination of the application filed overseas for the object stated in the application; copies of the protection title granted on the basis of a similar application filed overseas; documents on technical conditions of the object stated in the invention registration application supplied by a competent foreign authority to the applicant and other documents;

(ii) For a mark or geographical indication registration application: Documents proving that the mark or geographical indication has been protected in a foreign country, including documents explaining the use of the mark or geographical indication and other documents.

15.3. Correction of errors, explanation of the contents of applications, supply of information

a/ The NOIP may request applicants to explain the contents of their applications, supply information pertaining to the nature of objects stated in the applications, if full disclosure of the nature of objects is necessary for substantive examination of the applications.

b/ All amendments or supplements to erroneous documents of applications shall be made by applicants themselves. The NOIP may only make those amendments or supplements when applicants so request in writing. Applicants shall pay a prescribed fee for such amendment and supplementation. Written requests for amendment or supplementation of applications shall be enclosed with relevant documents of applications and regarded as official documents of applications.

15.4. Ahead-of-time termination of substantive examination of applications

a/ In the following cases, the substantive examination of an application shall terminate ahead of time:

(i) The application fails to demonstrate the nature of the object: Documents related to the nature of the object, such as the description, the list of goods and services, etc., contain insufficient information, thus making it impossible to identify the nature of the object, or information on the nature of the object stated in an invention registration application is unclear or too concise or general that it is impossible to identify the object sought to be protected;

(ii) The object is incompatible with the type of protection title applied for or the object is ineligible for the State's protection according to regulations;

(iii) There is a ground to confirm that the object fails to satisfy one or several protection conditions, and it is therefore unnecessary to assess other conditions before conclusions can be made that the object fails to satisfy the protection conditions;

(iv) The applicant fails to fulfill the request for correction of errors or explanation of contents of the application or fails to supply necessary information upon the NOIP's request specified at Point 15.3 of this Circular;

(v) The applicant requests termination of the substantive examination of the application or declares to withdraw or cancel the application.

b/ Except for the cases specified at Point 15.4.a (v) above, the NOIP shall send to the applicant a notice on ahead-of-time termination of substantive examination, clearly stating the reason therefor and setting a time limit of two months from the date of notice for the applicant to give opinions.

15.5. Resumption of substantive examination of applications

a/ If applicants make written oppositions to notices on termination of substantive examination of applications within the time limit specified at Point 15.4.b of this Circular, the NOIP shall consider those oppositions.

b/ If oppositions are reasonable, the NOIP shall resume the substantive examination of applications, and the time for applicants to give their opinions shall not be counted in the time limit for substantive examination.

If oppositions are unreasonable, the NOIP shall officially terminate the substantive examination of applications and issue notices on its refusal to grant protection titles. Applicants may lodge complaints about those notices according to the procedures specified at Point 22 of this Circular.

15.6. Examination contents

a/ Substantive examination of an application covers the following contents:

(i) Assessment of compatibility of the object stated in the application with the type of protection title applied for;

(ii) Assessment of the object based on each protection condition;

(iii) Inspection of observance of the first-to-file rule.

b/ The assessment of the object based on the protection conditions shall be conducted for objects one after another (if the application contains many and still ensures the uniformity). For each object, the assessment shall be conducted based on each specific protection condition:

(i) For an invention registration application, the assessment shall be conducted with regard to the points stated in the (requested) protection coverage one after another;

(ii) For an industrial design registration application, the assessment shall be conducted for the design of each product (if the application is for a set of products); in case the application shows many variations of an industrial design, those variations shall be assessed one after another, starting from the basic variation (the first variation shown in the application);

(iii) For a mark registration application, the assessment shall be conducted with regard to each component of the mark for each goods or service on the list of goods and services.

c/ The substantive examination with regard to each object specified at Point 15.6.b (i), (ii) and (iii) above shall be completed when that object has been assessed based on all protection conditions and there are enough grounds to conclude whether or not the object satisfies the protection conditions, specifically:

(i) Any reason is found to conclude that the object fails to satisfy one/several/all protection conditions; or

(ii) No reason is found to conclude that the object fails to satisfy at least one protection condition.

d/ Before issuing a notice defined at Point 15.7.a of this Circular, the NOIP shall review the results of substantive examination of the application by checking relevant applications with earlier dates of priority received by it after the substantive examination starts.

15.7. Jobs to complete the substantive examination

a/ Notification of results of substantive examination of applications

On the date of expiration of the time limit for substantive examination of an application specified at Point 15.8 of this Circular at the latest, the NOIP shall send to the applicant one of the following notices:

(i) If the object stated in the application fails to satisfy the protection conditions, the NOIP shall issue a notice on its intended refusal to grant a protection title, clearly stating the reason(s) for refusal, possibly guiding the change of the protection coverage (volume) and setting a time limit of two months from the date of issuance of the notice for the applicant to give opinions and satisfy the requirements. The applicant may request prolongation of the above time limit according to the provisions of Point 9.2 of this Circular;

(ii) If the object stated in the application satisfies the protection conditions but the application still contains errors, the NOIP shall issue a notice on its intended refusal to grant a protection title, clearly pointing out errors in the application and setting a time limit of two months from the date of issuance of the notice for the applicant to justify or correct errors. The applicant may request prolongation of the above time limit according to the provisions of Point 9.2 of this Circular;

(iii) If the object stated in the application satisfies the protection conditions or the applicant satisfactorily corrects errors or makes reasonable justifications within the time limit specified at Points 15.7.a (i) and (ii) above, the NOIP shall issue a notice on its intended grant of a protection title, setting a time limit of one month from the date of issuance of the notice for the applicant to pay the fee for the grant of a protection title, the fee for notification of the protection title grant decision, the registration fee and the fee for maintenance of the first year's validity of invention patent. The applicant may request prolongation of the above time limit according to the provisions of Point 9.2 of this Circular.

b/ Upon the expiration of the time limit specified at Points 15.7.a (i) and (ii) above, if the applicant fails to correct errors or unsatisfactorily corrects errors, makes no opposition or an unreasonable opposition, the NOIP shall, within 15 days after the time limit expiration, issue a notice on its refusal to grant a protection title. The applicant may lodge a complaint about this notice according to the provisions of Point 22 of this Circular.

c/ If the applicant fails to pay the fee for the grant of a protection title, the fee for notification of the protection title grant decision or the registration fee within the time limit specified at Point 15.7.a (iii) above, the NOIP shall, within 15 days after the expiration of the corresponding time limit, issue a notice on its refusal to grant a protection title. Particularly for an invention registration application, if the applicant pays fully the fee for the grant of a protection title, the fee for notification of the protection title grant decision and the registration fee within the time limit specified at Point 15.7.a (iii) above but fails to pay the fee for maintenance of the first year's validity of invention patent or utility solution patent, such a protection title shall be granted but becomes invalidated right after the date of grant.

15.8. Time limits

a/ The time limit for substantive examination of applications is determined as follows:

(i) For an invention registration application, 12 months from the date of receipt of a request for substantive examination (if such request is made after the application is published) or from the date of publication of the application (if such request is made before the application is published);

(ii) For a utility solution, mark or geographical indication registration application, 6 months from the date of publication of the application.

b/ If the applicant, in the course of substantive examination, corrects or supplements documents or makes justifications on his/her own initiative or upon the request of the NOIP, the time limit for substantive examination may be prolonged for a period of time during which the applicant does so.

16. Re-examination of applications

16.1. Re-examination of an application challenged by an opposition after the issuance of a notice on intended grant/intended refusal to grant a protection title.

a/ The re-examination of an application according to the provisions of Clause 4, Article 117 of the Intellectual Property Law shall be conducted in the following cases:

(i) A written opinion is sent by the applicant to the NOIP during the period from the date of issuance of a notice on intended grant/intended refusal to grant a protection title to the date prior to the issuance of a decision on grant/an official notice on refusal to grant the relevant protection title; or a report is made by a third party, stating justifiable reason(s) for the absence of a reasonable condition or opportunity to express his/her/its opinions;

(ii) Opinions mentioned at Point 16.1.a (i) above are well-grounded and supported by proofs or references to reliable information sources;

(iii) Arguments or evidence to prove that opinions mentioned at Point 16.1.a (i) above are different from those previously furnished (if any), or though they are not different from the previously furnished ones but the NOIP has not yet replied according to the provisions of Point 6.2 of this Circular.

b/ The time limit for re-examination of applications is equal to two thirds of the time limit for examination specified at Point 15.8 of this Circular; for complicated cases involving many circumstances which need to be verified or requiring expert opinions, that time limit may be prolonged but must not exceed the time limit for examination.

c/ Contents and procedures for re-examination must comply with the relevant provisions of Points 15.6 and 15.7 of this Circular.

d/ The re-examination of an application shall be conducted only once.

16.2. The re-examination of an application upon the protection title holder's request for narrowing of the protection coverage

If a protection title holder requests narrowing of the coverage of the industrial property rights protection according to the provisions of Clause 3, Article 97 of the Intellectual Property Law, the NOIP shall re-examine that application according to the contents and procedures specified at Points 15.6 and 15.7 of this Circular, if the requester pays the prescribed fees and charges.

17. Amendment/supplementation/division/conversion/transfer of applications

17.1. Amendment and supplementation of applications

a/ Before the NOIP issues a notice on its rejection of an application, a notice on its refusal to grant a protection title or a decision on the grant of a protection title, the applicant may amend or supplement documents of the application on his/her own initiative or upon the request of the NOIP.

b/ In response to a request for amendment or supplementation of the following documents, the applicant shall submit amended or supplemented copies of documents enclosed with a detailed written explanation of the amended contents as compared with the initially submitted documents:

(i) Invention description or abstract, for an invention registration application;

(ii) Drawings, photos or description, for an industrial design registration application;

(iii) Mark specimen, list of goods and services bearing the mark, for a mark registration application;

(iv) Description of distinct characteristics, a map of the geographical area subject to the geographical indication, for a geographical indication registration application.

c/ The amendment and supplementation of an application must not expand the protection coverage (or increase the protection volume) beyond the contents disclosed in the description, for invention or industrial design registration applications, in the list of goods and services, for mark registration applications, and must not change the nature of the object stated in the application. If the amendment expands the protection coverage (increases the protection volume) or changes the nature of the object sought to be protected, the applicant shall file a new application and all procedures shall be carried out anew.

d/ The applicant may request correction of errors in the names and addresses of the applicant and the author.

e/ All requests for amendment and supplementation must be made in writing according to a set form (not printed herein). A request may be made for amendment of the same content related to many applications, provided that the requester pays a fee based on the number of to-be-amended applications.

f/ If the applicant amends or supplements the application's documents on his/her own initiative after the NOIP issues a notice on acceptance of valid application, the amendments or supplements shall be made according to the provisions of Points 13.2, 13.3 and 13.6 of this Circular. Amended and supplemented application contents shall be published in the Industrial Property Official Gazette according to the provisions of Point 14 of this Circular and applicants shall pay a prescribed fee for such publication.

g/ The amendment and supplementation of an application, including change of the mandated party, which is made by the applicant on his/her own initiative or upon the request of the NOIP, must be made in writing, clearly specifying the amended and supplemented contents, and enclosed with an amendment and supplementation fee receipt. Documents containing amendments and supplements to applications must comply with the relevant provisions of Points 7, 10 and 13 of this Circular.

17.2. Division of applications

a/ The applicant may divide, on his/her own initiative or upon the request of the NOIP, his/her application (division and transfer of one or several technical solutions in an invention registration application, one or several industrial designs in an industrial design registration application, one

or several components of a mark or part of the list of goods and services in a mark registration application to one or several new applications referred to as divisional applications).

b/ A divisional application must bear a new serial number and is entitled to the filing date or date(s) of priority (if any) of the parent application; and shall be published according to the provisions of Point 14 of this Circular after the issuance of the notice on acceptance of valid application.

c/ For each divisional application, the applicant shall pay a filing fee and all fees and charges for procedures carried out independently from the parent application but is exempted from the fee for claim for priority rights. Divisional applications are subject to formality examination and shall be further processed according to the procedures not yet completed for their parent applications. Divisional applications shall be re-published and applicants shall pay a publication fee if the division is effected after the NOIP issues notices on acceptance of valid applications for parent applications.

d/ Parent applications (after being divided) shall be further processed according to normal procedures and applicants shall pay an amendment and supplement fee.

17.3. Conversion of applications

a/ Before the NOIP issues a notice of its refusal to grant a protection title or a decision on the grant of a protection title, an invention registration applicant may convert the application for an invention patent into one for a utility solution patent or vice versa according to the provisions of Point e, Clause 1, Article 115 of the Intellectual Property Law, if the applicant pays a prescribed application conversion fee.

b/ After receiving a valid request for application conversion, the NOIP shall continue carrying out the procedures for processing the converted application according to relevant provisions but shall not carry out again the procedures already completed for the application before the conversion request is made.

c/ Requests for application conversion made after the time limit specified at Point 17.3.a above shall not be considered. Applicants may file new applications bearing the filing dates (dates of priority, if any) of parent applications.

17.4. Transfer of applications

Before the NOIP issues any of notices specified at Point 17.1.a of this Circular, an applicant may request the NOIP to record the transfer of his/her application to another person. Requests for recording of the transfer shall be made according to a set form (not printed herein) and relevant provisions of Point 17.1 of this Circular, and must contain documents proving that the transferee satisfies the requirement on the right of registration.

18. Refusal to grant, grant or re-grant of protection titles, grant of protection title duplicates

18.1. Refusal to grant protection titles

Applications for protection titles may be rejected if they fall into one of the cases specified in Clauses 1 and 2, Article 117 of the Intellectual Property Law. In these cases, the NOIP shall carry out the procedures for refusal to grant protection titles according to the provisions of Clauses 3 and 4, Article 117 of the Intellectual Property Law.

18.2. Grant of protection titles

a/ Within 10 days after applicants pay fully and on time the prescribed fees and charges, the NOIP shall carry out the procedures for grant of protection titles according to the provisions of Article 118 of the Intellectual Property Law.

b/ Upon receiving protection titles, if protection title holders detect errors therein, they may request the NOIP to correct the protection titles according to the provisions of Point 20.2 of this Circular.

c/ As from the date the NOIP issues decisions on grant of protection titles, the transfer of applications shall not be considered.

18.3. Grant of protection title duplicates and renewal of protection titles

a/ In case the industrial property rights are under co-ownership, a protection title shall only be granted to the first person named in the list of co-applicants. Other co-holders may request the NOIP to grant duplicates of the protection title but shall pay a fee therefor.

b/ In the following cases, an industrial property right holder who has been granted a protection title/duplicate of protection title may request the NOIP to renew the protection title/duplicate of protection title but shall pay a renewal fee.

(i) The protection title/duplicate of protection title is lost;

(ii) The protection title/duplicate of protection title is damaged, torn, stained or faded out that it can no longer be used.

c/ Request for grant of duplicates/renewal of protection titles

Unless it is already included in the registration declaration of an industrial property object, any request for grant of a duplicate/renewal of protection title must be made in writing and comprise the following documents:

(i) Written declaration for the grant of duplicate/renewal of protection title, made according to a set form (not printed herein);

(ii) One mark specimen; one set of photos of industrial design drawing identical to the mark specimen, and one set of photos of industrial design drawing in the original protection title;

(iii) Power of attorney (in case the request is filed through a representative);

(iv) Receipt of the fee for grant of a protection title or the fee for grant of a protection title duplicate.

d/ Handling of requests for grant of duplicates or renewal of protection titles

(i) Within one month after receiving an application, the NOIP shall consider a request for grant of protection title duplicate/renewal of protection title. If that request satisfies the above requirements, the NOIP shall issue a decision on the grant of a protection title duplicate/renewal of the protection title and record it in the section for registration of the protection title in the National Register of Industrial Property;

(ii) A protection title duplicate must contain all information of the original protection title. A renewed protection title/protection title duplicate must contain all information of the initially granted protection title/protection title duplicate and the indication "renewed," "duplicate" or "renewed duplicate";

(iii) If a request for renewal/grant of duplicates of a protection title fails to satisfy the requirements specified at Point 18.3.c above, the NOIP shall issue a notice on its refusal to grant duplicates/refusal to renew the protection title, clearly stating the reason(s) for the refusal.

19. The National Register of Industrial Property, publication of decisions on grant of protection titles

19.1. The National Register of Industrial Property

a/ The National Register of Industrial Property serves as an official and public database of the State, supplying all information on the legal status of established industrial property rights. The National Register of Industrial Property includes the following registers:

- (i) National Register of Inventions;
- (ii) National Register of Utility Solutions;
- (iii) National Register of Industrial Designs;
- (iv) National Register of Layout Designs of Semi-conductor Integrated Circuits;
- (v) National Register of Marks;
- (vi) National Register of Geographical Indications;
- (vii) National Register of Assignment of Industrial Property Rights;
- (viii) National Register of Industrial Property Representation.

b/ The national registers specified at Point 19.1.a (i), (ii), (iii), (iv), (v) and (vi) above contains various sections relevant to each protection title, and consists of:

- (i) Information on the protection title: serial number and date of grant; name of the protected object, protection coverage/volume and validity duration; name and address of the protection title holder/the registrant of the geographical indication, name and address of the author of the invention, layout design or industrial design;
- (ii) Information on the application for grant of the protection title (serial number, filing date, date of priority, name of the industrial property representation service organization, if any);
- (iii) All information on the amendment of the protection title, the validity status of the protection title (maintenance, prolongation, termination of validity, and invalidation); assignment of industrial property rights, licensing of the industrial property object; serial number, date of grant and grantees of duplicates or renewed protection title.

c/ The national register specified at Point 19.1.a (vii) above contains various sections relevant to each registered contract on assignment of industrial property rights, specifically as follows:

- (i) Information on the certificate of registration of the contract on assignment of industrial property rights (serial number and date of grant);
- (ii) Information on the registered contract (name, date and place of signing, names and addresses of the assignor and the assignee, the assigned object and scope of assignment);
- (iii) Information on changes related to the contract (amendments or supplements to, extension, termination and invalidation of the contract);
- (iv) Information on compulsory licensing, termination of compulsory licensing of the invention under decisions.

d/ The national register specified at Point 19.1.a (viii) above contains various sections relevant to each industrial property representation service organization, specifically as follows:

(i) Information on the industrial property representation service organization (full name, transaction name, address, recording or deletion of name, modification of information on the industrial property representation service organization);

(ii) Information about the list of industrial property representatives of the organization (full name, permanent residence address and serial number of the practice certificate of each representative on the list);

(iii) Information on changes in the list of industrial property representatives (grant, renewal or withdrawal of practice certificates, etc.).

e/ The national registers shall be made by the NOIP and archived in the printed or electronic form or in other media. Any person may refer to the electronic registers or request the NOIP to issue copies or extracts of the registers but shall pay a fee for copy issuance.

19.2. Publication of decisions on grant of protection titles

a/ All decisions on grant of protection titles, decisions on recognition of international registrations shall be published by the NOIP in the Industrial Property Official Gazette within two months from the date of their issuance and after applicants pay the prescribed publication fee.

b/ Information published according to the provisions of Point 19.2.a above includes information written in relevant decisions: invention abstract; set of industrial design photos or drawings; mark specimens and list of goods and services bearing the mark; geographical indication and products bearing the geographical indication.

20. Modification, change of holders of protection titles, narrowing of protection coverage, maintenance or extension of validity of protection titles

20.1. Recording of change in the name and address of the protection title holder, narrowing of the protection coverage and modification of the description of the nature/quality/reputation of the product bearing the geographical indication, the map of the geographical area subject to the geographical indication, and regulations on the use of collective or certification marks

a/ Requests for modification or change of holders of protection titles

The holder of a protection title may request the NOIP to record changes in that protection title in the following cases:

(i) Change in the name or address of the protection title holder;

(ii) Change of the protection title holder (transfer of ownership on the ground of inheritance, succession, merger, separation, split-up, joint venture, association or establishment of a new legal entity under the same owner, transformation of the business operation, or under a decision of a competent state agency).

The requester for recording of the change in the name, address of or change of the protection title holder shall pay the fee for protection title modification and the fee for publication of a decision on recording of modification of the protection title.

b/ Requests for narrowing of the protection coverage and modification of descriptions of the nature/quality/reputation of products bearing geographical indications, maps of geographical areas subject to geographical indications, regulations on the use of collective or certification marks

A request for narrowing of the protection coverage according to the provisions of Clause 3, Article 97 of the Intellectual Property Law may contain any of the following:

- (i) Request for modification of some details without any substantial change in the mark specimen stated in the certificate of registered mark;
- (ii) Request for exclusion of one or several goods or services or groups of goods or services from the list of goods or services specified in the certificate of registered mark without any change in the mark specimen;
- (iii) Request for reduction of one or several independent or dependent points within the (requested) protection coverage stated in the invention or utility solution patent;
- (iv) Request for exclusion of one or several industrial design variations, one or several products from the set of products stated in the industrial design patent; request for removal of one or several basic design features of the industrial design.

c/ Written requests for modification of protection titles

Depending on contents which need to be amended or supplemented as defined at Points 20.1.a and 20.1.b above and Point b, Clause 1, Article 97 of the Intellectual Property Law, a written request comprises the following documents:

- (i) Written declaration requesting modification of the protection title, clearly stating the request for recording of change in the name or address of the protection title holder, change of the protection title holder, request for narrowing of the protection coverage or modification of the description of the nature/quality/reputation of the product bearing the geographical indication, the map of the geographical area subject to the geographical indication, or regulations on the use of collective or certification marks, made according to a set form (not printed herein);
- (ii) Original protection title;
- (iii) Documents certifying the change of the name or address (the originals or notarized copies of the decision on rename or change of address; the business registration certificate that records the name or address change; other documents of legal validity evidencing the name or address change) in case the content requested to be modified is such name or address;
- (iv) Documents evidencing the transfer of ownership according to the provisions of Point 20.1.a (ii) above, for a request for change of the protection title holder (documents evidencing the inheritance, succession, merger, separation, joint venture, association, establishment of a new legal entity under the same owner, transformation of business operation, or under a decision of a competent state agency);
- (v) Documents explaining in detail the modified contents;
- (vi) Five modified mark specimens (for a request for modification of mark details); five sets of industrial design photos or drawings (for a request for industrial design modification); two descriptions of the nature/quality/reputation of the product bearing a geographical indication, the map of the geographical area subject to the modified geographical indication (for a request for geographical indication modification); or two regulations on the use of the modified collective or certification mark (for a request for collective or certification mark modification);
- (vii) Power of attorney (if the request is filed through a representative);

(viii) Receipts of the prescribed fee for modification of the protection title, the fee for examination of the content of the request for narrowing of the protection coverage, and the charge for publication of the modification decision and registration.

A written request for protection title modification may be made for many protection titles that have the same content requested to be modified, if the requester pays fees and charges for each protection title.

d/ Handling of requests for modification of protection titles

Within one month after receiving an application, the NOIP shall consider the request for modification of protection title. If the request is considered valid, the NOIP shall issue a decision on modification of the protection title, register and publish it in the Industrial Property Official Gazette. If the request is considered invalid, the NOIP shall send to the requester a notice on its intended refusal to accept the modification, clearly stating the reason for refusal and setting a time limit of one month from the date of notice issuance for the requester to correct errors or make an opposition. If within the set time limit the requester fails to correct errors or unsatisfactorily corrects errors, makes no opposition or an unreasonable opposition, the NOIP shall issue a notice on its rejection of the request for protection title modification.

20.2. Correction of errors in protection titles

a/ When an error is detected in a protection title, the NOIP shall revoke, on its own initiative or upon the request of the error-detecting person, the erroneous protection title and grant a new protection title.

b/ The protection title holder shall pay a protection title correction fee according to the provisions of Clause 1, Article 97 of the Intellectual Property Law if the error is caused due to its fault. If the error is caused due to the fault of the NOIP, the protection title holder is not required to pay the fee.

20.3. Maintenance of validity of invention protection titles

To have the validity of his/her invention protection title maintained, a protection title holder shall pay a validity maintenance fee within six months before the expiration of the validity term. The payment of the validity maintenance fee may be delayed for no more than six months after the expiration of the current validity term but the protection title holder shall pay the maintenance fee plus 10% for each month of delayed payment.

20.4. Extension of validity of protection titles

a/ The validity of invention patents, utility solution patents and certificates of registered layout designs shall not be extended. The validity of an industrial design patent may be extended at most twice for a period of five years each. The validity of a certificate of registered mark may be extended many times for a period of ten years each.

b/ To have the validity of an industrial design patent or certificate of registered mark extended, the patent or certificate holder shall, within six months before the date of expiration of the validity of the patent or certificate, file an application for extension to the NOIP.

The filing of the application for validity extension may be delayed for no more than six months after the expiration of the protection title's validity but the protection title holder shall pay an extension fee plus 10% for each month of delayed filing.

c/ Applications for validity extension

An application for extension of validity of a protection title comprises the following documents:

- (i) Written declaration to request extension of the protection title validity, made according to a set form (not printed herein);
- (ii) Original protection title (if the extension is requested to be recorded in the protection title);
- (iii) Power of attorney (if the application is filed through a representative);
- (iv) Receipts of the prescribed fees for extension, publication and registration of the decision on extension of the protection title's validity.

d/ Handling of applications for validity extension

The NOIP shall consider an application for validity extension within one month after the date of its receipt. If the application is error-free, the NOIP shall issue a decision on validity extension, record it in the protection title, register and publish it in the Industrial Property Official Gazette.

The NOIP shall issue a notice on its intended refusal to extend validity, clearly stating the reason for refusal and setting a time limit of one month from the date of notice issuance for the applicant to correct errors or make an opposition if the application for validity extension falls into one of the following cases:

- (i) It is invalid or filed in contravention of the prescribed procedures;
- (ii) The applicant is not the protection title holder.

If within the set time limit the applicant fails to correct errors or unsatisfactorily corrects errors, makes no opposition or an unreasonable opposition, the NOIP shall issue a notice on its refusal to extend validity.

21. Termination or invalidation of protection titles

21.1. Requests for termination or invalidation of protection titles

Requests for termination or invalidation of protection titles shall be handled according to the provisions of Articles 95 and 96 of the Intellectual Property Law and this Point.

21.2. Written requests for termination or invalidation of protection titles

a/ A written request may invoke the same reason for termination or invalidation of one or more than one protection titles, if the requester pays the prescribed fee for each protection title.

b/ A written request for termination or invalidation of a protection title comprises the following documents:

- (i) Written declaration to request termination or invalidation of the protection title, made according to a set form (not printed herein);
- (ii) Proofs (if any);
- (iii) Power of attorney (if the written request is filed through a representative);
- (iv) Written justification of the reason for request (clearly stating the serial number of the protection title, reason, legal grounds, contents of the request for termination or invalidation of part of or the entire protection title) and relevant documents specified at Points 7.2, 22.2 and 22.3 of this Circular;
- (v) Receipts of the prescribed fees and charges.

21.3. Handling of requests for termination or invalidation of protection titles

a/ In case a request for termination or invalidation of a protection title is made by a third party, the NOIP shall notify in writing the third party's opinions to the protection title holder, setting a time limit of two months from the date of notification for the protection title holder to respond. The NOIP may organize an exchange of opinions between the third party and the protection title holder.

b/ After considering opinions of the parties, the NOIP shall issue a decision on termination/invalidation of part of/the entire protection title or notify its refusal to terminate/ invalidate the protection title according to the provisions of Clause 4, Article 95 and Clause 4, Article 96 of the Intellectual Property Law.

c/ If disagreeing with the NOIP's decision on handling of the request for termination or invalidation of the protection title, the requester or an involved party may lodge a complaint about that decision or the relevant notice according to the procedures specified at Point 22 of this Circular.

d/ A decision on termination or invalidation of a protection title shall be published in the Industrial Property Official Gazette and recorded in the National Register of Industrial Property within two months from the date of its signing.

21.4. Termination or invalidation of international registrations of marks

a/ For a third party's application for termination or invalidation of an international registration of mark under the Madrid Agreement or the Madrid Protocol, the NOIP shall notify the content of the request for termination or invalidation to the proprietor through the International Bureau, setting a time limit of three months from the date of notification for the proprietor to respond.

b/ A decision on termination or invalidation of an international registration of mark shall be sent to the International Bureau for carrying out relevant procedures under the Madrid Agreement or the Madrid Protocol and published in the Industrial Property Official Gazette.

22. Complaints and settlement of complaints about the procedures for establishment of industrial property rights

22.1. Persons with the right to complain, complaint objects and statute of limitations for lodging complaints

Persons with the right to complain defined in Clauses 1, Article 14 may carry out, within the statute of limitations for lodging complaints specified in Clause 4, Article 14 of the Decree on industrial property, the procedures for complaining about official notices or decisions of the NOIP related to the procedures for establishment of industrial property rights.

22.2. Complaints

a/ Each complaint should mention one complained decision or notice. A complaint may mention two or more decisions or notices that have the same complained content and for the same complaining reason, if the complainant pays the prescribed complaint fee for each complained decision or notice.

b/ A complaint comprises the following documents:

- (i) Written declaration for complaining, made according to a set form (not printed herein);
- (ii) Written explanation of the complaint and proofs supporting the complaining reason (clearly stating the reason, legal grounds, complained contents, enclosed list of proofs, if any);
- (iii) Copy of the NOIP's complained decision or notice;

- (iv) Copy of the decision on settlement of the first-time complaint (for a second-time complaint);
- (v) Power of attorney (if the application is filed through a representative);
- (vi) Receipts of the prescribed fees and charges related to the complaint.

c/ Proofs include documents (evidence) or objects (exhibits) to prove or clarify the complaining reason. A proof must satisfy the following requirements:

- (i) It may be a document in a foreign language enclosed with its Vietnamese translation if the person competent to settle the complaint so requests;
- (ii) If it is a document made and signed by an individual or organization that has no lawful seal or a foreign individual or organization, the signature of that individual or organization must be certified by a notary public or a competent agency;
- (iii) If it is an information carrier (printed matter, video tape, etc.), the origin and date of distribution or publication of that carrier, or the origin or the date of publication of information stored in that carrier shall be clearly indicated on a case-by-case basis;
- (iv) An exhibit must be accompanied with a written description of its features that are directly related to the complained contents.

22.3. Responsibilities of complainants

A complainant shall ensure the truthfulness of supplied proofs and are liable for consequences of the supply of untruthful proofs.

22.4. Withdrawal of complaints

a/ At any time, a complainant may notify in writing the withdrawal of his/her complaint. If the withdrawal of a complaint is made by an industrial property representation service organization, the mandated withdrawal must be clearly stated in the power of attorney.

b/ A withdrawn application shall be regarded as having not been filed. The written complaint shall not be returned and the paid complaint fee and charge amounts shall not be refunded to the complainant.

22.5. Acceptance of complaints

a/ Within ten days after receiving a complaint, a person competent to settle complaints shall examine the complaint according to the formality requirements and notify in writing the complainant of whether the complaint is accepted or not, clearly stating the date of complaint acceptance or the reason for its refusal to accept the complaint.

b/ A complaint shall not be accepted if it falls into one of the following cases:

- (i) The complainant does not have the right to complain;
- (ii) The complaint is lodged after the expiration of the prescribed statute of limitations;
- (iii) The complaint fails to satisfy the requirements specified at Points 22.1 and 22.2 of this Circular.

22.6. Related parties

a/ For an accepted complaint, the person competent to settle complaints shall notify in writing the complained contents to persons with directly related rights and benefits (related parties), setting a time limit of one month from the date of notification for those parties to give their opinions.

b/ Related parties may supply information or proofs supporting their arguments within the time limit specified at Point 22.6.a above, and the persons competent to settle complaints shall consider those information or proofs while settling the complaint.

c/ Upon the expiration of the above time limit, if related parties give no opinions, the complaint shall be settled based on the complainant's opinions.

22.7. Decisions on complaint settlement

a/ Based on arguments and proofs of the complainant and related parties, the person competent to settle complaints shall issue a decision on complaint settlement within the time limit for complaint settlement provided for by the law on complaints.

b/ Before issuing a decision on complaint settlement, the person competent to settle complaints shall notify the complainant or a related party of the other party's arguments and proofs used in the settlement of the complaint, and complaint settlement conclusions.

c/ A decision on complaint settlement must have the contents defined by the law on complaints.

22.8. A decision on complaint settlement shall be published in the Industrial Property Official Gazette within two months from the date of its signing.

22.9. Validity of decisions on complaint settlement

Any procedure for establishment of industrial property rights that depends on the complaint settlement results shall only be carried out on the basis of:

a/ A decision on settlement of the first-time complaint, if upon the expiration of the statute of limitations for lodging second-time complaints the complainant does not lodge a second-time complaint, or if upon the expiration of the statute of limitations for institution of administrative lawsuits the complainant does not file an administrative lawsuit; or

b/ A decision on settlement of the second-time complaint if the complainant fails to file an administrative lawsuit within a set time limit, or under an effective court ruling if the complainant has filed an administrative lawsuit.

Section 2. PROCEDURES FOR REGISTRATION OF INVENTIONS

23. Requirements for invention registration applications

23.1. An invention registration application (application) must satisfy the general requirements specified at Points 7 and 10.1 of this Circular and the specific requirements of this Point.

23.2. An application must clearly indicate that the object sought to be protected is a product or process complying with the provisions of Clause 12, Article 4 of the Intellectual Property Law.

23.3. An application must ensure uniformity as specified in Clauses 1 and 2, Article 101 of the Intellectual Property Law, which is guided as follows:

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.

23.4. When there is a ground (information, proof) to challenge the truthfulness of information contained in an application, the NOIP may request the applicant to supply documents certifying such information within one month from the date of request notification, especially documents certifying the lawful right of registration in case the applicant enjoys the filing right of another person (certificate of inheritance right, certificate of or agreement on assignment of the filing right; contract on job assignment or labor contract, etc.); documents disclosing the test results of a drug on humans or animals stated in the description (when the object sought to be protected is a pharmaceutical for humans, animals or plants).

23.5. Requirements for declaration

The applicant shall submit two copies of a written declaration made according to a set form (not printed herein). In the section "International patent classification" in the written declaration, the applicant shall state the classification criteria of technical solutions sought to be protected according to the latest International Patent Classification (under the Strasbourg Agreement) published by the NOIP in the Industrial Property Official Gazette. If the applicant fails to classify or correctly classify, the NOIP shall conduct the classification and the applicant shall pay a classification service charge as prescribed.

23.6. Requirements for invention description

The applicant shall submit two copies of an invention description. An invention description must consist of the section of invention description and the invention protection coverage.

a/ The description section must completely disclose the nature of the technical solution sought to be registered. It must contain sufficient information based on which any person with average skill in the art can deduce the solution. It must clarify the novelty, inventive steps and susceptibility of industrial application of the technical solution (if the protection title applied for is an invention patent); clarify the novelty and susceptibility of industrial application of the technical solution (if the protection title applied for is a utility solution patent).

Person with average skill in the art means a person who has ordinary technical practice skills and is acquainted with publicly available general knowledge in the art.

b/ The description section must contain the following:

(i) Title of the invention, which briefly expresses the object or objects sought to be registered (hereinafter collectively referred to as the object). The title of the invention must be brief and must not be of a promoting or advertising nature;

(ii) Use field of the invention: The field in which the object is utilized or to which the object is relevant;

(iii) Technical state of the use field of the invention: The technical level in this field at the time of filing (known similar objects, if any);

(iv) Technical nature of the invention: The nature of the object, with signs (characteristics) featuring the object as well as those considered novel compared to those of known similar technical solutions clearly indicated;

(v) Brief description of accompanied drawings (if any);

(vi) Detailed description of invention realization variations;

(vii) Examples of invention realization;

(viii) Benefits (effects) expected to be achieved.

c/ The invention protection coverage (hereinafter referred to as the protection coverage or protection claim)

The protection coverage (claim) shall be used to determine the scope of industrial property rights to inventions. The protection coverage (claim) must be presented briefly and clearly in conformity with the description and drawings, making clear signs of novelty of the object sought to be protected (hereinafter referred to as the object), and comply with the following regulations:

d/ The protection coverage (claim) must be adequately demonstrated by the description, including prerequisite and sufficient substantial technical signs to identify the object, achieve the set objective and distinguish the object from a known object.

e/ Technical signs within the protection coverage (claim) must be clear, precise and recognizable in the art.

f/ The protection coverage (claim) should not invoke the description and drawings, except for invocation to parts that cannot be accurately described with words, such as nucleotide sequences and amino acid sequences, diffraction charts, workflow diagrams, etc.

g/ If the application contains drawings illustrating the protection claim, signs shown in the protection coverage (claim) may be accompanied with indication numbers put in brackets. Those indication numbers are not considered confining the protection coverage (claim).

h/ The protection coverage (claim) should (is not required to) be expressed in two sections: "Restriction" and "Distinction." The section "Restriction" covers the title of the object and signs of the object that are identical to those of the latest known object and is connected to the section "Distinction" by the phrase "distinguishable by" or "characterized by" or equivalent expressions. The section "Distinction" covers signs that distinguish the object from the latest known object and are combined with signs of the section "Restriction" to constitute the object sought to be protected.

i/ The protection coverage (claim) may include one or more than one points. A multi-point protection coverage (claim) may be used to present an object sought to be protected, with the first point (called independent point) and subsequent point(s) used to concretize the independent point (called dependent point(s)); or to present a group of objects sought to be protected, with several independent points, each presenting an object sought to be protected in the group. Such an independent point may have dependent point(s),

j/ Points of the protection coverage (claim) must be numbered with Arabic numerals, followed by a dot.

k/ A multi-point protection coverage (claim) used to present a group of objects must satisfy the following requirements: Independent points presenting different objects must not invoke other points of the protection coverage (claim), unless the invocation helps avoid total repetition of the content of another point; dependent points must immediately follow the independent point on which they are dependent.

23.7. Requirements for invention abstracts

An applicant shall submit two copies of an invention abstract. An invention abstract is used to concisely describe (with no more than 150 words) the nature of the invention. The abstract must disclose principal details of the nature of the technical solution for the informatory purpose. The abstract may contain typical drawings or formulas.

23.8. Additional provisions applicable to applications for registration of inventions concerning biotechnologies

a/ Apart from the general requirements for an invention description specified at Point 23.6 of this Circular, for an application for registration of an invention concerning genetic sequences or part of genetic sequences, the description section must contain a list of genetic sequences presented according to standard WIPO ST.25 section 2 (ii) (the standard of presentation of a list of nucleotide sequences and amino acid sequences in an invention registration application).

b/ The NOIP may request the applicant to submit electronic information carriers (floppy disks, optical disks, etc.) readable by common electronic devices on which nucleotide sequences and amino acid sequences identical to those on the list of sequences in the description section are recorded.

c/ Particularly, an invention for/concerning biological materials, which can neither be described nor adequately described so that any person with average knowledge of biotechnology can realize, shall be regarded as being fully disclosed only if it satisfies the following conditions:

(i) The biological material sample is deposited at a competent depositary office defined at Point 23.9 of this Circular no later than the filing date;

(ii) The description section clearly discloses necessary information on the characteristics of the biological material the applicant might obtain;

(iii) The written declaration clearly defines the biological material depositary office, the identification number of the deposited biological material granted by the depositary office, and documents certifying such information shall be submitted to the NOIP within 16 months from the date of priority or no later than the date of filing the request for early publication of application (if any), whichever is earlier, except for the cases specified at Point 23.9.d of this Circular.

d/ If the applicant is not the depositor of the biological material, the written declaration must clearly state the name and address of the depositor, and documents certifying the lawful use of the biological material shall be submitted to the NOIP within 16 months from the date of priority, or no later than the date of filing the request for early publication of application (if any), whichever is earlier, except for the cases specified at Point 23.9.d of this Circular.

23.9. Deposit of samples of biological materials

a/ The deposit of samples of biological materials aims to serve the substantive examination of applications for registration of inventions concerning those biological materials.

b/ Samples of a biological material must be submitted to a competent biological material depositary office no later than the date of filing the application for registration of an invention concerning that biological material.

c/ Competent biological material depositary office is an office in Vietnam or a foreign country designated or accredited by the Ministry of Science and Technology as having the biological material depositary function.

d/ The deposit of samples of biological materials and certification documents for international patent applications shall comply with the provisions of the Patent Cooperation Treaty (PCT).

e/ For samples of a biological material deposited at a foreign depositary office, the NOIP may request the applicant to additionally deposit samples of the biological material at a competent depositary office in Vietnam when it finds it necessary to clarify the nature of the object sought to be protected or to satisfy a third party's request for access to the object.

23.10. Additional provisions applicable to applications for registration of inventions concerning pharmaceuticals

Apart from the general requirements for an invention description specified at Point 23.6 of this Circular, for an application for registration of an invention concerning a pharmaceutical, the description section must state the results of clinical trials and pharmaceutical effects of the pharmaceutical, including at least the following information:

a/ Used substances/mixtures;

b/ Employed trial method (system);

c/ Trial results;

d/ Correlation between the result of the pharmaceutical effects obtained in the trials and the practical usage of the pharmaceutical in disease prevention, diagnosis and treatment.

23.11. Additional provisions applicable to applications for registration of inventions concerning gene source or traditional knowledge

Apart from the general requirements for invention registration applications specified at Points 23.1 thru 23.7 of this Circular, an application for registration of an invention concerning gene source or traditional knowledge must also contain documents explaining the origin of the gene source and/or traditional knowledge accessed by the inventor or the applicant, if the invention is directly based on that gene source and/or traditional knowledge. If the inventor or the applicant cannot identify the origin of the gene source and/or traditional knowledge, he/she shall so declare and bear responsibility for the truthfulness of his/her declaration.

24. Formality examination and publication of invention registration applications

The procedures for formality examination and publication of invention registration applications shall comply with the general procedures specified at Points 13 and 14 of this Circular.

25. Substantive examination of invention registration applications

25.1. Request for substantive examination of an invention registration application

a/ The applicant or any third party may request the NOIP to conduct the substantive examination of an invention registration application according to the provisions of Article 113 of the Intellectual Property Law and the following specific provisions:

(i) A request for substantive examination of an invention registration application must be made in writing according to a set form (not printed herein) and presented in the written declaration of the invention registration application (if the requester is the applicant and such request is made upon the filing of the application);

(ii) A request for substantive examination of an invention registration application must be filed within 42 months from the date of priority if the application contains a request for grant of an invention patent, or within 36 month from the date of priority if the application contains a request for grant of a utility solution patent. The time limit for filing a request for substantive examination may be prolonged for plausible reasons but must not exceed 6 months.

(iii) A requester for substantive examination of an invention registration application shall pay the prescribed search charge and substantive examination charge. If a request for substantive examination is filed later than the set time limit, the requester shall additionally pay a prolongation fee according to the provisions of Point 20.4.b of this Circular. If the substantive examination charge is not paid, the request for substantive examination filed with the NOIP shall be considered invalid and the NOIP will not conduct the substantive examination of the application.

b/ A request for substantive examination of an invention registration application filed after the application is published shall be published in the Industrial Property Official Gazette in the second month after it is received. If such a request is made by a third party, it shall be notified to the applicant.

A request for substantive examination of an invention registration application filed before the application is published shall be published together with the application.

c/ In case no request for substantive examination is filed within the time limit set at Point 25.1.a above, the application shall be regarded as having been withdrawn upon the expiration of the said time limit.

25.2. Order for carrying out the procedures for substantive examination

The substantive examination of an invention registration application shall be conducted according to the general order specified at Point 15 of this Circular and specific provisions of this Point.

25.3. Assessment of compatibility of the object stated in the application with the type of invention protection title

a/ The object stated in an invention registration application shall be considered incompatible with the type of invention protection title applied for by the applicant (invention patent/utility solution patent) if it is not a technical solution, particularly not a product or a process. The method of identifying technical solutions is provided at Point 25.3.b below.

b/ A technical solution - an object to be protected as an invention - is a collection of prerequisite and sufficient information on technical methods and/or technical devices to accomplish a given task (solve a given problem).

A technical solution may take one of the following forms:

(i) A product in the form of a tangible object (tool, machine, equipment, part, electric circuit, etc.) which is presented by a collection of information identifying a man-made product, characterized by signs (features) of its configuration, and functions (is utilized) as a device to meet a certain human need; or a product in the form of a material (material, component, food, pharmaceutical, etc.) which is presented by a collection of information identifying a man-made product, characterized by signs (features) of its presence, ratios and state of its elements, and functions (is utilized) as a device to meet a certain human need; or a product in the form of a biological material (gene, genetically modified plant/animal, etc.) which is presented by a collection of information on a product containing genetic information modified by human manipulations and capable of self-regeneration;

(ii) A process (technological process; diagnosing, forecasting, checking or treating method) which is presented by a collection of information identifying the method of performing a given process or job, characterized by signs (features) of the order, conditions, components, methods and devices for performing manipulations to achieve a certain objective.

c/ An object stated in an application shall not be considered a technical solution in the following cases:

- (i) It is merely an idea or a scheme that rather raises a question than offers solution(s) to a problem, gives no answer to the question “how” and/or “by what means”;
- (ii) Problem (task) raised for solution is not a technical problem and cannot be technically solved;
- (iii) Natural products other than those created by humans.

25.4. Assessment of susceptibility of industrial application according to the provisions of Article 62 of the Intellectual Property Law

a/ A technical solution stated in an application shall be considered “susceptible of utilization” if:

- (i) Information on the nature of the solution and instructions on necessary technical conditions are presented so clearly and adequately that any person with average knowledge in the art can create, produce, utilize, exploit or realize that solution;

The concept “person with average knowledge in the art” is understood according to the provisions of Point 23.6.a of this Circular.

- (ii) The creation, production, utilization, exploitation or realization of the above solution may be repeated with the same result identical to the result stated in the invention description.

b/ A technical solution shall be considered unsusceptible of industrial application in the following cases:

- (i) The nature of the object or instructions for realization of the object run counter to the basic scientific principles (for instance, non-compliance with the conservation of energy law);
- (ii) The object consists of elements or components which are not technically interrelated or cannot be interlinked (through connections, constraints, interdependence, etc.);
- (iii) The object contains an inherent contradiction;
- (iv) Instructions on the object can only be realized in a limited number of times (unrepeatable);
- (v) To be able to apply the solution, a person must have a special skill which cannot be passed down or guided to others;
- (vi) Results achieved at different times of realization are not the same;
- (vii) Achieved results are different from those stated in the application;
- (viii) The most important instructions to realize the solution are totally absent or insufficient;
- (ix) Other cases where there exist other justifiable reasons.

25.5. Assessment of novelty according to the provisions of Article 60 of the Intellectual Property Law

a/ Mandatory minimum information source

To assess the novelty of a technical solution stated in an application, information search shall be conducted at least from (but not confined to) the following mandatory sources:

- (i) All invention registration applications received by the NOIP with classification criteria the same as those of the object stated in the application currently under examination - considering

also division criteria (third-class criteria), and having publication dates earlier than the filing date or the date of priority of the application currently under examination;

(ii) Invention registration applications or invention protection titles published by other organizations or countries within 25 years before the filing date or the date of priority of the application currently under examination (if that application enjoys priority) stored in the patent database of the NOIP and other information sources defined by the NOIP, with the scope of search specified at Point 25.5.a (i) above.

When necessary and possible, the search may be extended to scientific presentations and reports on achievements of research programs and projects and other documents in the same technical field published and stored at the National Center for Scientific and Technological Information.

b/ Purposes of the search

The purpose of the information search is to find a technical solution with the nature similar or identical to that of the technical solution stated in the application.

At this point:

(i) Two technical solutions are considered identical when all their substantial signs (features) are identical or equivalent (interchangeable);

(ii) Two technical solutions are considered similar when most of their substantial signs (features) are identical or equivalent (interchangeable);

(iii) "Control technical solution" means a technical solution identical or most similar to the technical solution stated in the application;

(iv) "Control document" means a document describing the control technical solution or evidence proving that the control technical solution has been publicly disclosed.

c/ Search reports

Information search results must be shown in a search report which clearly states the field and scope of search, and search results within that scope (statistics on control technical solutions found, clear indication of identical signs, titles of control documents, numbers of pages and lines, origins of and dates of publication of those documents) and the full name of the report maker (search person).

d/ Method of assessing novelty of technical solutions

To assess the novelty of a technical solution stated in an application, a comparison must be made between substantial signs (features) of that technical solution and signs of a control technical solution found through the information search, in which:

(i) Substantial signs of the technical solution may be its characteristics in terms of function, utility, disposition, inter-connection, composition, etc., which constitute, together with other substantial signs, a prerequisite and sufficient combination to determine the nature (content) of the object;

(ii) Substantial signs of the technical solution stated in the application and protection titles are presented in the invention protection coverage (claim);

(iii) Substantial signs of technical solutions stated in other documents are expressed and noticed according to written descriptions or real forms of expression of those technical solutions.

e/ Conclusions on novelty of technical solutions

Corresponding to a point of the protection coverage (claim), the technical solution stated in the application shall be considered novel to the technical level worldwide if:

- (i) No control technical solution is found through the information search; or
- (ii) A control technical solution is found but the technical solution stated in the application has at least one substantial sign not found in the control technical solution (and such sign is called the distinctive substantial sign).

25.6. Assessment of inventive steps according to Article 61 of the Intellectual Property Law

a/ Mandatory minimum information source

To assess inventive steps of a technical solution, information search must be conducted at least from (but not confined to) the mandatory source defined at Point 25.5.a of this Circular.

b/ Assessment of inventive steps

The assessment of inventive steps of a technical solution stated in an application shall be conducted through assessing distinctive substantial sign(s) stated in the protection coverage (claim) before concluding:

- (i) Whether or not distinctive substantial sign(s) is/are regarded as having been disclosed in the mandatory minimum information source, and;
- (ii) Whether or not the combination of distinctive substantial signs is considered obvious to a person with average knowledge in the art.

Corresponding to a point of the protection coverage (claim), the technical solution shall be regarded as having inventive steps if the inclusion of a distinctive substantial sign in a combination of substantial signs of the technical solution is the result of inventive work and is not obvious to a person with average knowledge in the art.

c/ In the following cases (but not only in those cases), corresponding to a point of the protection coverage, a technical solution shall be regarded as having no inventive step:

- (i) The combination of distinctive substantial signs is obvious (any person with average knowledge in the art knows that to perform a given function or to achieve a set objective, it is a must to use that combination of signs and once that combination of signs is used the set objective can necessarily be achieved or the given function performed);
- (ii) The combination of distinctive substantial signs has been disclosed in the same or similar form in one/several known technical solutions in the mandatory minimum information source;
- (iii) The technical solution is a simple combination of known technical solutions and its function, objective and effect are also simple combinations of those of known technical solutions.

d/ At this point:

- (i) Two signs shall be considered the same if they have the same nature;
- (ii) Two signs shall be considered equivalent if they have similar natures, the same objective and basically similar ways to achieve the objective.

25.7. Inspection of observance of the first-to-file rule defined in Article 90 of the Intellectual Property Law

Before issuing a decision on the grant of a protection title, the NOIP shall inspect the observance of the first-to-file rule for invention registration applications already substantively examined and concluded as having satisfied the protection conditions according to the following provisions:

a/ Mandatory minimum information source

To inspect the observance of the first-to-file rule, the information search must be conducted at least from (but not confined to) the following mandatory sources:

All invention registration applications received by the NOIP (up to the date of inspection) with classification criteria the same as those of the object stated in the application currently under examination - taking into account the division criteria (third-class criteria) and with filing dates or dates of priority earlier than the filing date or date of priority of the application currently under examination (if that application enjoys priority) and not yet published, or with filing dates or dates of priority later than the filing date or date of priority of the application currently under examination (if that application enjoys priority);

b/ The purpose of the search is to find application(s) for registration of the same invention and identify the application with the earliest filing date or date of priority;

c/ If there are many applications for registration of the same invention, the protection title shall only be granted for the valid application with the earliest date of priority or filing date among applications satisfying the conditions for grant of protection title;

d/ If there are many applications for registration of the same invention satisfying the conditions for the grant of a protection title and having the same date of priority or earliest filing date, the protection title may only be granted for only one application among those applications as agreed upon by all applicants. If no agreement is reached, all applications shall be refused;

e/ If an invention registration applicant makes a claim for priority on the basis of an initial application for registration of the same invention already filed in Vietnam, the protection title may only be granted for the accepted invention registration application containing a claim for priority while the initial application filed in Vietnam shall be considered withdrawn.

25.8. Notification of substantive examination results

The notification of results of substantive examination of invention registration applications shall be carried out according to the general procedures specified at Point 15.7.a of this Circular.

26. Grant, registration and publication of invention patents, utility solution patents

The issuance of decisions on grant, registration or publication of invention patents or utility solution patents shall comply with the general procedures specified at Points 18 and 19 of this Circular.

27. Processing of international patent applications

27.1. Application-receiving agency

The agency competent to receive international patent applications in Vietnam is the NOIP.

The NOIP shall:

a/ Receive international applications originating in Vietnam;

b/ Collect the fee for sending international applications and notify applicants of the prescribed fees to be paid to the International Bureau and the International Search Office under the Patent Cooperation Treaty - PCT (hereinafter referred to as the Treaty);

c/ Check whether or not the fees are paid on time;

d/ Check and process international applications originating in Vietnam under the Treaty;

e/ Identify objects sought to be protected: If objects sought to be protected of applications are classified as national secrets, next steps shall not be performed and paid fees shall be refunded to applicants, except for the fees for sending and copying international applications;

f/ Send a copy (file copy) of an international application originating in Vietnam to the International Bureau and another copy (search copy) to the International Search Office;

g/ Send and receive mails to/from applicants and the International Bureaus.

27.2. Languages

International applications originating in Vietnam and filed to the NOIP must be in English. An application shall be made in three copies.

For applications with insufficient copies, the NOIP shall make additional copies and applicants shall pay the copying fee.

27.3. International search offices and international preliminary examination offices

For international applications originating in Vietnam, competent international search offices and international preliminary examination offices are patent offices, industrial property or intellectual property offices of Australia, Austria, the Russian Federation, Sweden, the Republic of Korea and the European Patent Office.

27.4. International applications designating Vietnam

a/ If an international application designates Vietnam, the NOIP is the designated office. In this case, in order to enter the national phase, the applicant shall submit, within 31 months from the date of priority, to the NOIP the following:

(i) Written declaration requesting invention registration, made according to a set form (not printed herein);

(ii) Copy of the international application (if the applicant requests the entry into the national phase before the date of publication of the international publication);

(iii) Vietnamese translation of the international application: The description, consisting of a description section, protection request, annotations for drawings and abstract (the published copy or initially filed original application, if the application has not yet been published, and modified copy and explanation of modified contents, if the international application has been modified under Article 19 of the Treaty);

(iv) National charges and fees.

b/ International applications filed with the NOIP within six months after the expiration of the time limit specified at Point 27.4.a above may be accepted on the condition that applicants pay the prescribed charges and fees.

27.5. International applications electing Vietnam

a/ If an international application elects Vietnam, the NOIP is the elected office. In this case, if the election of Vietnam is made within 19 months from the date of priority, in order to enter the national phase, the applicant shall submit, within 31 months from the date of priority, to the NOIP the following documents:

(i) Written declaration requesting invention registration, made according to a set form (not printed herein);

(ii) Vietnamese translation of the international application: The description, consisting of a description section, protection request, annotations for drawings and abstract (the published copy or initially filed original application, if the application has not yet been published, and modified copy and explanation of modified contents, if the international application has been modified under Article 19 and/or Article 34(2)(b) of the Treaty);

(iii) Vietnamese translations of annexes to the international preliminary examination report (when substantive examination of the application is requested);

(iv) National charges and fees.

b/ International applications filed with the NOIP within six months after the expiration of the time limit specified at Point 27.5.a above may be accepted on the condition that applicants pay the prescribed charges and fees.

27.6. Claims for priority

To enjoy the priority, an applicant shall reaffirm it in the written declaration, pay the charge for priority claim and submit, upon the NOIP's request, Vietnamese translations of necessary documents already submitted to the International Bureau as defined in Rule 17.1(a) of the Regulation on implementation of the Treaty.

For PCT applications, the handling of claims for priority shall comply with the Treaty and the Regulation on implementation of the Treaty.

27.7. Processing of international applications in the national phase

a/ Amendment and supplementation of documents in the national phase

In compliance with Rule 51bis of the Regulation implementation of the Treaty, an applicant shall submit the power of attorney and the paper on assignment of the right to file an application in the national phase (if any) within 34 months from the date of priority.

In compliance with Articles 28 and 41 of the Treaty and Rules 52.1(b) and 78.1(b) of the Regulation on implementation of the Treaty, an applicant may amend and supplement documents of the application in the national phase. Right at the time of entry into the national phase, the applicant may also amend and supplement the description. The above amendment and supplementation shall comply with the provisions of Article 17 of this Circular.

Amended and supplemented documents submitted by the applicant to the NOIP must be in Vietnamese.

b/ Time of beginning of the national phase

The time when the processing of an international application designating or electing Vietnam in the national phase starts is the first day of the thirty second month from the date of priority if the applicant files no written request for entry into the national phase earlier than the above time limits.

c/ Examination of international applications

After entering the national phase, an international application shall be put to formality examination and substantive examination according to the procedures applicable to ordinary invention registration applications. If the applicant requests in writing earlier examination of his/her application and pay the prescribed charge, the international application shall be examined earlier than the time limit specified at Point 27.7.b above in accordance with the provisions of Article 23(2) of the Treaty.

d/ International applications considered withdrawn

In addition to the cases where an international application is considered withdrawn specified in the Treaty and the Regulation on implementation of the Treaty, an international application designating or electing Vietnam shall be considered withdrawn if the national fees are not paid to the NOIP or there is no Vietnamese translation upon the expiration of the set time limit.

27.8. International registration charges and fees

a/ Applicants whose international applications enter the national phase shall pay the prescribed charges and fees for invention registration applications directly filed in Vietnam.

b/ Applicants whose international applications originate from Vietnam shall pay the charges and fees prescribed by the Regulation on implementation of the Treaty and the Ministry of Finance's Circular guiding the collection, remittance, management and use of industrial property charges and fees.

Section 3. PROCEDURES FOR REGISTRATION OF LAYOUT DESIGNS

28. Requirements for layout design registration applications

28.1. A layout design registration application (application) must satisfy the general requirements specified at Points 7 and 10 of this Circular and the specific requirements specified at this Point.

28.2. Documents, specimens and information presenting a layout design defined at Point 7.1.a (ii) of this Circular include:

(i) Four sets of photos or four sets of drawings of the layout design;

b/ Four specimens of the integrated circuit manufactured under the layout design, if that layout design has been commercially exploited;

c/ Description of the integrated circuit manufactured under the layout design, including information disclosing the nature of the layout design.

28.3. An application must ensure uniformity according to the provisions of Clause 1, Article 101 of the Intellectual Property Law, i.e., it requests protection of only one layout design of an integrated circuit.

28.4. When having grounds (information, proofs) to doubt the truthfulness of information in an application, the NOIP may request the applicant to submit within one month documents certifying such information, especially documents certifying the lawful right of registration, in case the applicant enjoys the right to file from another person (certificate of inheritance right, certificate or agreement on assignment of the right to file; contract on assignment of jobs or labor contract, etc.);

28.5. Requirements for written declarations

An applicant shall submit two copies of a written declaration, made according to a set form (not printed herein).

28.6. Requirements for sets of photos and drawings of layout designs

a/ General requirements: A set of photos or drawings of a layout design must adequately show the three-dimensional disposition of circuit elements and their inter-connections in a semi-conductor integrated circuit, based on which only one layout design can be deduced.

For the above purpose, a set of photos/drawings of a layout design must satisfy the conditions specified at Points 28.6.b, c and d below.

b/ Types of document:

A set of photos/drawings of a layout design must include at least one of the following three types of document:

- (i) Automated drawings of the layout design for each integrated circuit layer;
- (ii) Drawings or photos of photolithographic mask for the fabrication of each integrated circuit layer;
- (iii) Photos of each layout design layer incorporated in the integrated circuit;

c/ Form of documents: A set of photos/drawings of a layout design must be submitted in the paper form and may be annexed by carriers of the electronic data of part of or the entire set of photos/drawings.

d/ Presentation of documents:

- (i) A set of photos/drawings of a layout design must include (a combination of) separate photos/drawings for each layout design layer, annotated by the symbol of each layer, dimensions of the integrated circuit and the magnification;
- (ii) All photos/drawings of a layout design must be of the same scale. For paper documents: Each photo/drawing of the layout design must be at least 20 times larger than the original size of the integrated circuit and make basic circuit designs visible to bare eyes;
- (iii) Each photo/drawing of a layout design may be presented on an A4 paper sheet or a paper sheet of a larger size folded down to A4 size;
- (iv) Photos/drawings of a layout design must be clear and well defined.

28.7. Requirements for specimens of integrated circuits manufactured under layout designs

a/ A specimen to be submitted must be part of or the entire integrated circuit totally compatible with the layout design stated in the application. If an integrated circuit manufactured under a layout design constitutes an integral part of another product, such product shall be submitted together with a document precisely indicating the section of the integrated circuit manufactured under that layout design.

b/ For a layout design that is commercially exported anywhere in the world before the filing date, the applicant shall submit the commercially exploited specimen.

28.8. Requirements for descriptions of semi-conductor integrated circuits manufactured under layout designs

A description must contain the following detailed information on a semi-conductor integrated circuit manufactured under a layout design sought to be protected:

- a/ Appellation/sign: A combination of letters and/or numerals used to distinguish an integrated circuit from another when being circulated in the market;
- b/ Description of basic functions of the integrated circuit (for example: memory or logic function or other functions);
- c/ Description of the basic disposition of the integrated circuit (for example: bipolar, MOS, Bi-MOS or photo-electronic disposition or other dispositions);
- d/ Description of the technology for manufacture of the integrated circuit (for example: TTL or DTL or ECL or ITL or CMOS or NMOS or PMOS technology or other technologies);
- e/ Description of main features to distinguish the integrated circuit from other integrated circuits on the market at the time of filing the application or the time of first commercial exploitation in the world, whichever is earlier.

29. Confidentiality of information in layout design registration applications

An applicant may file a written request for information confidentiality together with a layout design registration application according to the following provisions:

29.1. Permitted maximum degree of confidentiality:

- a/ For a layout design not yet commercially exploited: 50% of each layer's surface;
- b/ For a commercially exploited layout design: two layers in each group of five layers in a top-down hierarchy.

29.2. To enjoy information confidentiality, an applicant shall file a written request for information confidentiality made under the NOIP's guidance and indicating documents and materials containing confidential information.

29.3. Documents containing confidential information must be put in separate packs and may be submitted in the following forms:

- a/ Microfilm or similar forms, for documents showing dimensions of the design on computer-aided drawings;
- b/ Electronic data;
- c/ Drawings or photos containing invisible sections, provided that features of the layout designs are basically visible.

29.4. The NOIP is obliged to keep confidential information upon the request of applicants in accordance with the provisions of Point 29.1 of this Circular.

30. Formality examination of layout design registration applications

30.1. The procedures for formality examination of layout design registration applications shall comply with the general provisions of Points 13.1, 13.2, 13.3, 13.4 and 13.8 of this Circular and specific procedures applicable to layout design registration applications specified at this Point.

30.2. Notification of results of formality examination

- a/ If an application falls into one of the cases specified at Point 13.2 of this Circular or still contains errors defined at Point 13.3 of this Circular, the NOIP shall carry out the procedures specified at Point 13.6.a of this Circular.
- b/ For a valid application, the NOIP shall send to the applicant a notice on acceptance of valid application, clearly stating the name and address of the applicant, the name of the

representative (if any) and information on the object stated in the application, the filing date, and concurrently declaring that the object stated in the application may be granted a certificate of registered layout design if no reasonable opposition is made by a third party to the registration of that layout design within three months after the layout design is published in the Industrial Property Official Gazette.

30.3. Refusal to accept applications

If an applicant, after receiving a NOIP notice on the results of formality examination, which points to errors and states the NOIP's intended refusal to accept the application according to the provisions of Point 13.6.a of this Circular, fails to correct errors or unsatisfactorily corrects errors or makes no opposition or an unreasonable opposition within a set time limit, the NOIP shall send to that applicant a notice on its refusal to accept the layout design registration application and, at the applicant's request, refund paid charges and fees for jobs to be performed after the formality examination.

31. Publication of layout design registration applications

31.1. A layout design registration application accepted as valid shall be published according to the general procedures specified at Point 14 of this Circular and this Point.

31.2. Access to detailed information on valid layout design registration applications

a/ After a layout design registration application is published in the Industrial Property Official Gazette, any person may access detailed information on the nature of the layout design stated in the published application, except for information kept confidential according to the provisions of Article 29 of this Circular.

b/ Only the agency competent to carry out procedures for invalidation of protection titles or procedures for administrative handling of infringements of rights to layout designs can access confidential information on layout designs.

32. Grant, registration and publication of decisions on grant of certificates of registered layout designs

32.1. Notification of intended grant of certificates of registered layout designs

If no opposition is made by a third party to the registration of a layout design within three months after the layout design is published in the Industrial Property Official Gazette or though an opposition is made, it is later proved unreasonable through handling, the NOIP shall notify its intended grant of a certificate of registered layout design for the object stated in the application. The time limit for the applicant to pay the fees for publication, registration and grant of a protection title is one month from the date of notification.

32.2. Grant, registration and publication of decisions on grant of certificates of registered layout designs

The procedures for grant, registration and publication of certificates of registered layout designs shall comply with the general procedures specified at Points 18.2 and 19 of this Circular.

32.3 Refusal to grant certificates of registered layout designs

If an opposition is made by a third party to the grant of a certificate of registered layout design within three months after the layout design is published in the Industrial Property Official Gazette and that opposition is proved reasonable, the NOIP shall carry out procedures for

refusal to grant a certificate of registered layout design according to the general procedures specified at Point 18.1 of this Circular.

Section 4. PROCEDURES FOR REGISTRATION OF INDUSTRIAL DESIGNS

33. Requirements for industrial design registration applications

33.1. Industrial design registration applications must satisfy the general requirements specified at Points 7 and 10.1 of this Circular and the specific requirements specified at this Point.

33.2. Industrial design registration applications must ensure uniformity according to the provisions of Clauses 1 and 3, Article 101 of the Intellectual Property Law and the following provisions.

An industrial design registration application is considered uniform if:

- a/ It requests protection of an industrial design of a product; or
- b/ It requests protection of industrial designs of more than one products in a set of products, of which each product has its own industrial design; or
- c/ It requests protection of an industrial design of a product accompanied with one or several variations of that industrial design.

33.3. Requests for information supply

a/ When there is a ground (information, proof) to doubt the truthfulness of information in an industrial design registration application, the NOIP may request the applicant to submit within one month documents certifying such information, especially documents certifying the lawful right of registration in case the applicant enjoys the right to file from another person (certificate of inheritance right, certificate or written agreement on assignment of the right to file; contract on job assignment or labor contract, etc.)

b/ The NOIP may also request the applicant to submit within one month documents certifying the lawful ownership or the lawful right to use trade indications (marks, geographical indications or trade names), protected industrial designs of other persons, if it has a ground to doubt that the industrial design stated in the application contains those objects.

33.4. Requirements for written declarations

An applicant shall submit two copies of a written declaration made according to a set form (not printed herein). Apart from sections that need to be filled in, the written declaration must state the criteria for classification of the industrial design sought to be protected in accordance with the International Industrial Design Classification (under the Locarno Agreement). If the applicant fails to classify or inaccurately classifies the industrial design, the NOIP shall carry out the classification for which the applicant shall pay a charge as prescribed.

33.5. Requirements for industrial design descriptions

An applicant shall submit one copy of the industrial design description that contains the following contents:

- a/ Name of the industrial design, which is the name of the product imbued with the industrial design, expressed in common words and phrases, not of the advertising nature, does not contain symbols, annotations and trade indications;
- b/ Field in which the industrial design is used, which is a specific field in which the product imbued with the industrial design is used, clearly stating the use purpose of the product;

c/ The most similar industrial design: To clearly state an industrial design which is least different from the industrial design of the same product stated in the application and widely known before the filing date or the date of priority (if the application contains a claim for priority), indicating the information source publicly disclosing the most similar industrial design;

d/ List of photos or drawings, which enumerates photos, three-dimensional drawings, shadows, cross-sections, etc., of the industrial design one after another according to the ordinal numbers of those photos or drawings;

e/ The section of description of the industrial design must satisfy the following provisions:

(i) It fully discloses the nature of the industrial design sought to be protected, adequately showing design features presenting the nature of the industrial design as well as new design features that are distinguishable from the most similar industrial design defined at Point 33.5.c above and consistent with those shown in the set of photos or drawings;

(ii) Design features of the industrial design sought to be protected must be presented one after another in the following order: Configuration and line features, correlation between configuration and/or line features, color features (if any);

(iii) For a product that have different usages (for example: a product with cover or foldable), its industrial design must be described in different states;

(iv) If an industrial design consists of many variations, distinctive characteristics of the basic variation (the first variation stated in the application) in comparison with those of remaining variations must be clearly indicated;

(v) If an industrial design is the design of a set of products, the design of each product in the set must be described.

f/ Coverage of protection (or claim for protection) of the industrial design must fully enumerate prerequisite and sufficient design features to identify the nature of the industrial design sought to be protected and the scope of industrial property rights to the industrial design, shown on photos or drawings stated in the application, and including new and distinctive design features as compared with known similar industrial designs.

33.6. Requirements for sets of photos or drawings of industrial designs

An applicant shall submit five sets of photos or five sets of drawings of an industrial design, sets of photos or drawings must fully present design features of the industrial design sought to be protected, based on which any person with average knowledge in the art can identify that industrial design, and follow the following guidance:

a/ Photos or drawings must be clear and well defined; drawings must be presented with unbroken lines; the background of a photo or drawing must be monochrome and contrast with the industrial design; a photo or drawing must show only the product imbued with the industrial design sought to be protected (not accompanied with another product).

b/ Photos or drawings must show the industrial design on the same scale. The size of the industrial design shown in photos or drawings must neither be smaller than 90 mm x 120 mm nor larger than 190 mm x 277 mm.

c/ Photos and drawings must show the industrial design viewed in the same direction and in the following order: three-dimensional picture of the industrial design, front, rear, right-side- left-side, top-down and down-top shadows of the industrial design; shown shadows must be frontispieces.

d/ For an industrial design with symmetrical shadows, its photos or drawings are not required to show more symmetrical shadows, provided that such is clearly stated in the list of photos and drawings in the description.

e/ For the industrial design of an expandable product (for instance: box, package), shadows of the industrial design may be replaced with photos or drawings of the industrial design in an expanded state.

f/ Depending on the complexity of an industrial design, more photos or three-dimensional drawings from other angles, cross-sections or magnified pictures of parts, pictures of knocked down components of the product, etc., may be required to clearly show new and distinctive design features of the industrial design sought to be protected.

g/ For a product that have different usages (for example: a product with cover or foldable), there must be photos or drawings of its industrial design in different states.

h/ For the industrial design of a part of a complete product, there must be more photos or drawings illustrating the position for fitting or use of such part on the complete product.

i/ For each variation of the industrial design, there must be a set of photos or drawings fully presenting it according to the provisions of this Point.

j/ For a set of products, there must be three-dimensional pictures of the whole set and a set of photos or drawings of each product in the set according to the provisions of this Point.

33.7. Design features of industrial designs

a/ Design features of an industrial design are elements presented in the form of lines, configurations, colors, position or size correlation, which constitute, in combination with other features (signs), a gathering necessary and sufficient for the formation of that industrial design.

b/ The following elements are not regarded as design features of an industrial design:

(i) Configurations and lines dictated by the technical functions of the product (for example: the flat shape of data-recording disks is dictated by the relative motion between disks and reading heads);

(ii) Elements whose presence in the combination of signs gives no aesthetic impression (impression of the shape of the product remains unchanged with or without those elements; for example: if a change in a familiar configuration or line is not impressive enough to be noticed, the changed configuration or line will therefore be taken as old one);

(iii) Materials used for manufacture of the product;

(iv) Signs affixed or stuck on the product merely for the purpose of informing or guiding the origin, features, composition, utility and usage of the product, for example: words in a goods label;

(v) Size of the product, except for change of size of patterns of a fabric sample or similar materials.

c/ Substantial and insubstantial design features

Substantial design features are design features that are easily noticeable/memorable, necessary and sufficient to identify an industrial design and distinguish it from another one used for the same type of product.

Any design features that fail to satisfy the above condition are referred to as insubstantial design features.

34. Formality examination and publication of industrial design registration applications

Procedures for formality examination and publication of industrial design registration applications shall comply with the general procedures specified at Points 13 and 14 of this Circular.

35. Substantive examination of industrial design registration applications

35.1. Assessment of similarity of industrial designs:

a/ Two industrial designs are considered identical when they are used for the same type of product and have the same gathering of substantial and insubstantial design features;

b/ Two industrial designs are considered similar when they are used for the same type of product and have several identical substantial design features;

c/ Two industrial designs are considered most similar when the number of their identical substantial design features is larger than that of all other similar industrial designs.

35.2. Order for carrying out procedures for substantive examination of industrial design registration applications

The substantive examination of industrial design registration applications (applications) shall be conducted according to the general order specified at Point 15 of this Circular and specific provisions of this Point.

35.3. Assessment of compatibility of objects stated in applications with the type of industrial design protection title

An object stated in an application shall be considered incompatible with the type of industrial design protection title when:

a/ The object is not the appearance of a product;

b/ The object stated in the application is:

(i) A product's appearance dictated by its technical characteristics;

(ii) A civil or industrial construction work's appearance;

(iii) Interior design (invisible part) of a product in use (exploitation of a product's utility by ordinary methods and by any consumer, excluding its maintenance, preservation or repair).

35.4. Information search

a/ Purpose of information search

The purpose of information search is to find in the mandatory minimum information source industrial designs identical or similar to the industrial design stated in the application.

b/ The mandatory minimum information source used in the substantive examination of an application consists of the following documents:

(i) Industrial design registration applications already received by the NOIP and having dates of publications earlier than the filing date or date of priority of the examined application (if it enjoys priority);

(ii) Industrial design registration applications and industrial design protection titles published by other organizations or countries within 25 years before the filing date or date of priority of the examined application (if it enjoys priority), which are archived in the NOIP's database on existing industrial designs;

(iii) Other information related to industrial designs collected and archived by the NOIP;

(iv) Industrial design registration applications received by the NOIP and having filing dates or dates of priority (if they enjoy priority) earlier than the filing date or date of priority of the examined application (used to inspect the observance of the first-to-file rule specified at Point 35.9 of this Circular).

c/ When necessary and possible, the search may be expanded beyond the mandatory minimum information source.

35.5. Search reports

Search results shall be presented in a search report that clearly states the searched field, search scope, search results within that scope (statistics on and clear indication of control industrial designs found, information sources and date of publication of information) and the full name of the report maker (search person).

At this point, a control industrial design means an industrial design identical or similar to the industrial design stated in the application and compared with the latter upon assessment of novelty and creativity.

35.6. Assessment of susceptibility of industrial application of industrial designs according to Article 67 of the Intellectual Property Law

a/ The industrial design stated in the application shall be considered susceptible of industrial application if any person with average knowledge in the art can, based on information on the industrial design supplied in the application, use that industrial design as a model to manufacture by an industrial or manual method a product with an appearance identical to that industrial design.

The concept "any person with average knowledge in the art" is understood according to the relevant provisions of Point 23.6.a of this Circular.

b/ In the following cases, the object stated in the application shall be considered insusceptible of industrial application:

(i) It is the shape of a product with an unfixed state of existence (products in gaseous or liquid form);

(ii) A product whose shape identical to the object stated in the application can only be created with special skills or it is impossible to repeatedly manufacture a product whose shape identical to the object stated in the application;

(iii) Cases where there exist other justifiable reasons.

35.7. Assessment of novelty of industrial designs according to the provisions of Article 65 of the Intellectual Property Law

a/ Method of assessment of novelty of industrial designs

To assess the novelty of an industrial design stated in an application, it is necessary to compare the gathering of substantial design features of that industrial design with that of an identical/the

most similar industrial design used as a control industrial design found through the information search.

b/ Conclusion on novelty of industrial designs

The industrial design stated in an application shall be considered novel if:

- (i) No control industrial design is found in the mandatory minimum information source; or
- (ii) Though a control industrial design is found in the mandatory minimum information source but the industrial design stated in the application has at least one substantial design feature not found in (not belonging to) the gathering of substantial design features of the control industrial design; or
- (iii) The control industrial design is the very industrial design stated in the application published/disclosed in the cases specified in Clauses 3 and 4, Article 65 of the Intellectual Property Law.

35.8. Assessment of creativity of industrial designs according to the provisions of Article 66 of the Intellectual Property Law

a/ Method of assessment of creativity of industrial designs

To assess the creativity of an industrial design stated in an application, it is necessary to compare the gathering of substantial design features of that industrial design with that of each identical or similar control industrial design found through the information search.

b/ Conclusion on creativity of industrial designs

In the following cases, the industrial design stated in an application shall be considered non-creative:

- (i) It is a simple combination of known design features (publicly disclosed design features are put together or assembled in such a simple way as replacement, interchange of positions, increase or decrease of quantity);
- (ii) It is a reproduction/imitation of part of or the whole inherent natural shape of a tree, fruit or animal, shapes of geometric figures (round, ellipse, triangle, square, rectangular, regular polygons and prisms, cross-sections of which are foregoing figures), which are widely known.
- (iii) It is a simple reproduction of the shape of a product or work well known or publicly known in Vietnam or worldwide;
- (iv) It is an imitation of an industrial design in another field, if such an imitation is widely known in reality (for example: toys imitating cars, motorcycles, etc.).

If not falling into the above cases, an industrial design is considered creative.

35.9. Inspection of the first-to-file rule according to the provisions of Article 90 of the Intellectual Property Law

a/ To inspect the first-to-file rule, it is necessary to search information from the mandatory source defined at Point 35.4.b (iv) of this Circular.

b/ The industrial design stated in the application shall be considered satisfying the first-to-file rule if no identical or substantially indistinguishable industrial design is found in applications that have satisfied the conditions for grant of industrial design patents found through information search.

c/ The industrial design of a component of a product stated in the application shall also be considered satisfying the first-to-file rule if no identical or substantially indistinguishable industrial design of a component of a product and/or a product is found in applications that have satisfied the conditions for grant of industrial design patents found through information search.

d/ When different applications for registration of identical or substantially indistinguishable industrial designs satisfy the conditions for grant of industrial design patents and have the same date of priority or the earliest filing date, the industrial design stated in the application is still considered satisfying the first-to-file rule defined in Clause 2, Article 90 of the Intellectual Property Law if all applicants reach an agreement on designation of the applicant in only one application among those applications to be granted an industrial design patent.

35.10. Notification of substantive examination results

The notification of results of substantive examination of industrial design registration applications shall comply with the general provisions of Point 15.7.a of this Circular.

36. Grant, registration and publication of industrial design patents

Procedures for issuance of decisions on grant, registration and publication of decisions on grant of industrial design patents shall comply with the general procedures specified in Points 18 and 19 of this Circular.

Section 5. PROCEDURES FOR REGISTRATION OF MARKS

37. Requirements for mark registration applications

37.1. Mark registration applications must satisfy the general requirements on application documents specified at Points 7 and 10.1 of this Circular and the specific requirements at this Point.

37.2. Applications must ensure uniformity defined in Clauses 1 and 4, Article 101 of the Intellectual Property Law. Each application may request registration of a mark used for one or more than one goods or services.

37.3. If doubting about the truthfulness of information supplied in an application, the NOIP may request the applicant to submit within one month the following documents in order to certify such information:

a/ Documents evidencing the status of the applicant:

(i) Business registration certificate, contract or another document certifying the applicant's goods production or service provision activities according to the provisions of Clause 1, Article 87 of the Intellectual Property Law;

(ii) Agreement on or written certification that a manufacturer does not use the mark and does not oppose the mark registration by a person conducting commercial activities for the manufacturer's product according to the provisions of Clause 2, Article 87 of the Intellectual Property Law;

(iii) Establishment decision or license, or organization charter certifying the function and competence to manage a collective mark or a mark of certification of the quality or geographical origin of goods or services according to the provisions of Clauses 3 and 4, Article 87 of the Intellectual Property Law;

(iv) Agreement, business registration certificate or documents related to the mark registration by co-proprietors according to the provisions of Clause 5, Article 87 of the Intellectual Property Law;

(v) Documents certifying that the applicant enjoys the right of mark registration from another person according to the provisions of Clause 6, Article 87 of the Intellectual Property Law;

(vi) Written agreement or consent of the mark proprietor certifying the right of mark registration in the name of a representative or agent according to the provisions of Clause 7, Article 87 of the Intellectual Property Law and Article 6septies of the Paris Convention for the Protection of Industrial Property Rights.

b/ Documents evidencing the status of the application owner's representative: the applicant's original power of attorney; documents certifying that the application owner's representative is the representative at law of the organization registering the mark or his/her mandated person; papers certifying that the applicant's mandated person satisfies the requirements for acting as the application owner's representative according to the provisions of Point 3 of this Circular.

c/ Documents evidencing the right to use/register a mark containing special symbols, for:

(i) Names, emblems, flags or armorial bearings of domestic or international agencies and organizations or certification, control or warranty hallmarks of international organizations as defined in Clauses 2 and 4, Article 73 of the Intellectual Property Law;

(ii) Names of characters or figures in publicly known works under copyright protection or trade names, trade indications, origin indications, prizes, medals or particular signs of a type of product, which may cause confusion, as defined in Clause 5, Article 73 of the Intellectual Property Law;

(iii) Signs covered by the protection of industrial property rights of other persons as defined at Point m, Clause 2, Article 74 of the Intellectual Property Law;

d/ Documents evidencing the right of priority;

e/ Information necessary for verification or affirmation of contents specified in the regulation on use of a collective mark or a certification mark or in other documents of the application.

37.4. Requirements for written declarations

An applicant shall submit two written declarations, made according to a set form (not printed herein), with the following attentions:

a/ The section of mark description in the application must clearly indicate the type of mark sought to be registered (common mark, collective mark, association mark, certification mark);

b/ If the mark sought to be registered is an association mark, the applicant shall clearly indicate associated elements being marks or goods or services according to the following provisions:

(i) If associated elements are marks (similar to another mark of the very applicant used for the same goods or service or used for similar goods or services), the applicant shall clearly indicate a mark considered substantial among those association marks (if any). If one or several of those marks have been registered or stated in the previously filed applications, the applicant shall clearly indicate the serial numbers of the protection titles and the previously filed applications.

(ii) If associated elements are goods or services (a mark used for similar or interrelated goods or services), the applicant shall clearly indicate a goods or service considered substantial among those goods or services (if any). If one of those goods or services has been previously

registered or stated in a previously filed application, the applicant shall clearly indicate the serial numbers of the protection title and previously filed application.

(iii) If the applicant fails to clearly indicate a substantial mark or a substantial goods or service, then all marks and all goods or services related to the mark stated in his/her application shall be considered independent from one another. The assessment of distinctiveness of the mark stated in the application may not exceptionally apply to association marks defined at Point e, Clause 2, Article 74 of the Intellectual Property Law, but must comply with general provisions on assessment of distinctiveness of Point 39 of this Circular.

c/ For a certification mark, the applicant shall clearly indicate in the written declaration the certification purpose, content and method (certify what: certification of quality, origin, geographical origin or combination thereof; certification content: specific conditions on the entity, goods or services; how to certify: order and procedures for grant of certification licenses, method of inspection and maintenance of the certification purpose and content).

d/ The declaration must contain the mark specimen and a written description of the mark according to the following provisions:

(i) If the mark consists of many elements, those elements and their combinations must be clearly indicated. If the mark contains configuration elements, contents and significance of those elements must be clearly defined;

(ii) If the protection is claimed for a colored mark, such a claim must be clearly stated and colors on the mark must be named;

(iii) If the mark contains letters, words or expressions in languages other than Vietnamese, their pronunciations (transliterated into Vietnamese) must be clearly annotated and their meanings (if any) must be translated into Vietnamese;

(iv) If the mark contains numerals other than Arabic and Roman numerals, those numerals must be transliterated into Arabic numerals.

e/ The section "List of goods and services bearing the mark" in the written declaration must be divided into groups in accordance with the International Classification of Goods and Services under the Nice Agreement published by the NOIP in the Industrial Property Official Gazette.

37.5. Requirements for mark specimens

In addition to the mark specimen attached to the written declaration, the application must be enclosed with 9 identical mark specimens that satisfy the following requirements:

a/ A mark specimen must be clearly presented with the dimensions of each element of the mark ranging between 8 mm and 80 mm, and the entire mark must be presented within a mark model of 80 mm x 80 mm in size in the written declaration;

b/ For a mark being a three-dimensional figure, the mark specimen must be accompanied with a photo or drawing showing the three-dimensional disposition and may be accompanied with a descriptive specimen in the projection form;

c/ For a mark involving a claim for protection of colors, the mark specimen must be presented with the very colors sought to be protected. If the protection of colors is not claimed, the mark specimen must be in black and white.

37.6. Requirements for regulations on use of collective marks and certification marks

A regulation on use of a collective mark and a regulation on use of a certification mark must have relevant contents specified in Clauses 4 and 5, Article 105 of the Intellectual Property Law and clarify the following matters:

- a/ Brief information on the mark, the mark proprietor and goods and services bearing the mark;
- b/ Conditions for the mark registrant to license the mark and conditions for termination of the right to use the mark;
- c/ Obligations of the mark user (assuring the particular quality and characteristics of a goods or service bearing the mark, submitting to the control of the mark registrant, paying the mark management charge, etc.);
- d/ Rights of the mark registrant (controlling compliance with the regulation on use of the mark, collecting the mark management charge, suspending the mark use right of a person who fails to satisfy the conditions specified in the mark use regulation, etc.);
- e/ Mechanism of licensing, control and inspection of use of the mark and assurance of the quality and reputation of goods and services bearing the mark);
- f/ Dispute settlement mechanism.

37.7. Requirements on documents certifying the permission for registration and use of marks certifying geographical origins

- a/ For a mark certifying a geographical origin, in addition to the mark use regulation and necessary documents evidencing the right of mark registration, the application must also be enclosed with the local administration's permission for the applicant to register a certification mark containing signs indicating a geographical origin (geographical name, symbol or map of the area or locality) for goods and services bearing the mark.
- b/ If the area or locality bearing the geographical origin indication cannot be identified based on the administrative boundaries and the local administration's permission mentioned at Point 37.7 above, the NOIP shall request the applicant to supply a geographical map clearly indicating the area or locality bearing the geographical origin indication of goods and services with the concerned local administration's certification.

38. Formality examination and publication of mark registration applications

Procedures for formality examination and publication of mark registration applications shall comply with the general procedures specified at Points 13 and 14 of this Circular.

39. Substantive examination of mark registration applications

39.1. The NOIP shall conduct the substantive examination of valid applications according to the general order specified at Point 15 of this Circular and specific provisions of this Point.

39.2. Assessment of conformity of objects stated in mark registration applications with requests for grant of certificates of registered marks

- a/ According to the provisions of Clause 1, Article 72 of the Intellectual Property Law, signs eligible for being registered as marks must be visible ones in the form of letters, numerals, words, pictures, images, including three-dimensional images or their combinations, presented in one or several given colors.
- b/ The following types of sign shall not be protected as marks:

(i) Signs that are merely colors and neither combined with character signs or figure signs nor presented in the form of character signs or figure signs;

(ii) Signs pertaining to objects not protectable as marks according to the provisions of Article 73 of the Intellectual Property Law;

(iii) Signs that are contrary to the public order or prejudicial to national security.

39.3. Assessment of distinctiveness of signs in the form of letters or numerals (hereinafter referred to as character signs) according to the provisions of Clause 2, Article 74 of the Intellectual Property Law.

Except for the exceptions specified at Point 39.5 of this Circular, the following character signs shall be considered indistinctive:

a/ Characters of languages that are imperceptible and unmemorable to the common knowledge of Vietnamese consumers (unreadable, incomprehensible and unmemorable), such as characters not of Latin origin: Arabic, Slavonic, Sanskrit, Chinese, Japanese, Korean or Thai characters, etc.; except when characters of these languages combine with other components to formulate a distinctive whole or are presented in a graphic form or other special forms;

b/ A Latin-origin character that consists of only one letter or consists of numerals only, or consists of two letters which cannot be pronounced as a word, even if it is accompanied with numerals, except when it is presented in a graphic form or other special forms;

c/ A combination of too many letters or words that is imperceptible and unmemorable, such as a sequence of too many characters not arranged according to a given order or rule, or a text or a paragraph;

d/ A Latin-origin character that is a meaningful word, the meaning of which has been so frequently and widely used in a relevant field in Vietnam that it loses its distinctiveness;

e/ A word or phrase that is used in Vietnam as the common name of the very related goods or service;

f/ A word or phrase that describes the very goods or service bearing the mark, such as a sign indicating time, location, geographical origin (except when the registered mark is a mark certifying the geographical origin of a goods or a collective mark), method of manufacture, type, quantity, quality and characteristics (except when the registered mark is a mark certifying the quality of a goods or service), composition, utility and value of a goods or service;

g/ A word or phrase that is liable to describe the legal status or business lines of the mark proprietor;

h/ A character sign that is identical or similar to any of objects covered by the protection of industrial property rights of other persons according to the provisions of Points e, f, g, h, i, j and k, Clause 2, Article 74 of the Intellectual Property Law;

i/ Character signs that cause misunderstanding or confusion or mislead consumers as to the origin, utility, quality, value or other characteristics such as ingredients, process of manufacture, materials or superiority of a goods or service according to the provisions of Clause 5, Article 73 of the Intellectual Property Law;

j/ Character signs that are identical or confusingly similar to real names, alias or pseudonyms of leaders, national heroes or personalities of Vietnam or foreign countries; identical or confusingly

similar to names of characters or figures in other persons' widely known works under copyright protection, unless it is so permitted by the owners of those works.

39.4. Assessment of distinctiveness of signs in the form of pictures or images (hereinafter referred to as figure signs) according to the provisions of Clause 2, Article 74 of the Intellectual Property Law

Except for the exceptions specified at Point 39.5 of this Circular, a figure sign shall be considered indistinctive if:

a/ It is a common figure or geometric figure, such as round, ellipse, triangle, quadrangle, etc., or a simple drawing; a picture or image used merely as a background or ornamental pattern of a product or a product package;

b/ It is a picture or image that is too tangled or complicated for consumers to easily perceive and memorize its details, i.e. a sign that consists of too many combined or overlapped images or lines;

c/ It is a widely used picture, image, emblem or symbol;

d/ It is a picture or image liable to describe the very goods or service bearing the mark; location and method of manufacture, geographical origin, type, quantity, quality, properties, composition, utility, value or other characteristics of the goods or service bearing the mark;

e/ It is identical to or not substantially distinguishable from protected industrial designs of other persons;

f/ It is identical or confusingly similar to images of leaders, national heroes or personalities of Vietnam or foreign countries; identical or confusingly similar to images of characters or figures in other persons' widely known works under copyright protection, unless it is so permitted by the owners of those works.

39.5. The following exceptions shall apply upon assessment of distinctiveness of character signs or figure signs:

a/ A sign that falls into the cases specified at Points 39.3.a, b, c, f and g and Points 39.4.a, b, c, d and e of this Circular has been used as a mark and widely known to consumers and that mark therefore become distinguishable from relevant goods and services.

b/ To be subject to the application of this exception, the applicant shall furnish evidence of the wide use of that mark (the time of beginning of the use, present scope and level of use, etc., in which, the mark shall be considered "in use" when the use is made in lawful production, business, commercial, advertising or marketing activities) and evidence of the mark's distinctiveness from the mark proprietor's relevant goods and services. In this case, that mark shall be recognized distinctive if it is presented in the form in which it has been uninterruptedly and widely used in the reality.

39.6. Assessment of distinctiveness of signs being combinations of character signs and figure signs (hereinafter referred to a combined signs)

A combined sign shall be considered distinctive when a character sign combines with a figure sign in a distinctive whole, specifically as follows:

a/ The character sign and the figure sign are all distinctive and combined into a distinctive whole;

b/ The strong component of the mark (the element that has a strong effect on the senses of consumers, attracts their attention to and gives an impression of the mark) is a distinctive character sign or figure sign, while other components are indistinctive or insignificantly distinctive.

c/ If the combined sign consists of indistinctive or insignificantly distinctive character signs and figure signs, but a unique combination of those signs gives a particular impression, that combined whole is still considered distinctive;

d/ The combined sign consists of indistinctive or insignificantly distinctive character and figure components but that combined whole has become distinctive through the use according to the provisions of Point 39.5 of this Circular.

39.7. Minimum information source

a/ To assess the ability of a sign stated in an application to cause confusion, the NOIP shall conduct the search in the following minimum information source:

(i) Mark registration applications filed with the NOIP with filing dates or dates of priority earlier than the filing date or date of priority of the application currently under examination and mark registration international applications designating Vietnam notified by the WIPO to the NOIP with filing dates or dates of priority earlier than the filing date or date of priority of the application currently under examination for identical or similar goods and services;

(ii) Marks already registered or recognized for protection still effective in Vietnam (including well-known marks), for identical, similar or relevant goods and services;

(iii) Registered marks that have ceased to be valid for more than five years, except for those invalidated for non-use defined at Point d, Clause 1, Article 95 of the Intellectual Property Law, for identical or similar goods and services;

(iv) Geographical indications currently protected in Vietnam;

(v) Indications to the geographical origin of goods and services; geographical names, quality or control hallmarks; national flags and emblems of nations; flags, names and emblems of Vietnamese and international agencies and organizations; names and images of leaders, national heroes, names and images of personalities of Vietnam and foreign countries, etc., collected and stored by the NOIP.

b/ When necessary, the search may be conducted in reference information sources other than the minimum information source defined at Point 39.7.a above, such as industrial design registration applications, trade names, etc.

39.8. Assessment of confusing similarity of signs sought to be registered to other marks

a/ To assess whether or not a sign sought to be registered and stated in an application is identical or confusingly similar to another mark (hereinafter referred to as control mark), it is necessary to compare the disposition, content and pronunciation (for character signs), significance and form of expression of the sign (for character signs and figure signs), and concurrently compare the goods and services bearing the sign with those bearing the control mark defined at this Point.

b/ Signs identical to control marks: A sign shall be considered identical to a control mark if it resembles the control mark in terms of disposition, content, significance and form of expression.

c/ A sign considered confusingly similar to a control mark if:

(i) It is similar to the control mark in terms of disposition or/and content or/and pronunciation or/and significance or/and form of expression in such a way that makes consumers misjudge these two objects as one or an object as a variation of the other or these two objects of the same origin;

(ii) It is merely a transliteration or translation of the control mark, in case the control mark is a well-known mark.

39.9. Assessment of similarity of goods and services

a/ Two goods or two services shall be considered identical (of the same type) if these two goods or services have the following characteristics:

(i) They have the same nature (composition, ingredients) and the same function and utility; or

(ii) They have similar natures and the same function and utility.

b/ Two goods or two services shall be considered similar if these two goods or services have the following characteristics:

(i) They are similar in nature; or

(ii) They are similar in function or utility; and

(iii) They are marketed in the same commercial channel (they are distributed by the same mode, or sold together or compete with each other in the same type of shop);

c/ A goods and a service shall be considered similar if they fall into one or several of the following cases:

(i) They have a correlation in nature (a goods or service or a material or component of a goods or service forms constitutes part of the other); or

(ii) They have a correlation in function (to accomplish the function of a goods or service, it is necessary to use the other, or they are usually used together); or

(iii) They have a close correlation in method of realization (a goods or service is the result of the use or exploitation of the other); or

39.10. Inspection of the first-to-file rule

Before issuing decisions on the grant of certificates of registered marks, the NOIP shall inspect the observance of the first-to-file rule defined in Article 90 of the Intellectual Property Law.

39.11. Conclusion on the ability of signs to be confused with control marks

A sign shall be considered identical or confusingly similar to a control mark used for identical or similar or relevant goods in the following cases:

(i) It is identical to the control mark and goods and services bearing it are identical or similar to goods and services bearing the control mark;

(ii) It is identical to the control mark and goods and services bearing it are identical to goods and services bearing the control mark of the same mark proprietor;

(iii) It is confusingly similar to the control mark and goods and services bearing it are identical or similar to goods and services bearing the control mark, except when the similarity of goods and services and the similarity of signs are unable to cause confusion when similar signs are used;

(iv) It is identical or similar to the control mark being a well-known mark and goods and services bearing it are neither identical nor similar to goods and services bearing the mark, but its use as

a mark may make consumers believe that there exists a relationship between goods and services bearing it and the proprietor of the well-known mark and make it possible to reduce the distinctiveness or damage the reputation of the well-known mark.

39.12. Assessment of the ability of signs to cause other confusions

The assessment of the ability of signs to cause other confusions shall comply with the provisions of Article 73 and Clause 2, Article 74 of the Intellectual Property Law and the following specific provisions.

a/ A sign shall be considered having caused confusion of origin of goods or services in the following cases:

(i) It is identical or similar to the name or emblem of a nation or territory (national flag, national emblem, name of the nation or a locality) or confusingly similar to the name or emblem of a nation or territory, causing a mislead that goods or services bearing the mark originate from that nation or territory;

(ii) It is identical or similar to a protected geographical indication, in case its use may mislead consumers as to the geographical origin of goods; it is identical to a geographical indication or contains a geographical indication or is translated or inscribed from a geographical indication protected for a wine or spirit, in case the sign sought to be registered as a mark for a wine or spirit does not originate in the geographical area subject to that geographical indication;

(iii) It is a word identical or similar to the trade name of another person, which has been lawfully used for the same type of goods or service, and able to make consumers believe that goods or services bearing it are manufactured or provided by the person having above trade name; it is an image identical or similar to the commercial logo of another person, which has been lawfully used for the same type of goods or service, and able to make consumers believe that goods or services bearing it are manufactured or provided by the person having the above commercial logo;

(iv) It is identical or similar to real names, alias, pseudonyms or images of leaders, national heroes or personalities of Vietnam or foreign countries; it is identical or similar to names or images of typical human characters or figures in widely known works, in case its use can make consumers believe that goods or services bearing it are manufactured or provided by owners of those works;

(v) It is identical to or not substantially distinguishable from industrial designs of other persons protected on the basis of industrial design registration applications with filing dates or dates of priority earlier than the filing date or date of priority of the mark registration application.

b/ In the following cases, a sign shall be considered able to cause confusion or mislead to the nature and value of goods and services:

(i) The sign is a word, picture, image or symbol that gives a misleading impression of properties or utilities of a goods or service, i.e., a sign identical or similar to a mark or another sign used so widely that it has been regarded as being associated with a function or utility of a given type of goods or service and thereby making consumers believe that goods and services bearing the sign also have such function or utility;

(ii) The sign is a word or image that gives a misleading impression of composition or ingredients of a goods or service, i.e., a description of another goods or service relevant to the goods or service bearing the sign gives a misleading impression that the goods or service bearing the sign is composed of or has the same nature as the described goods or service.

40. Grant, registration and publication of certificates of registered marks

Procedures for grant, registration and publication of certificates of registered marks shall comply with the general procedures specified at Points 18 and 19 of this Circular.

41. Processing of mark international registration applications originating in Vietnam and mark international registration applications designating Vietnam

41.1. Procedures for mark international registration applications originating in Vietnam

This Circular's provisions on procedures for processing mark registration applications also apply to the processing of mark international registration applications at the NOIP.

41.2. Right of international registration of marks is based on basic mark registrations in Vietnam

a/ Persons who are granted certificates of registered marks in Vietnam enjoy the right of international registration of those marks under the Madrid Agreement;

b/ Persons who have filed mark registration applications in Vietnam and persons who are granted certificates of registered marks in Vietnam enjoy the right of international registration of those marks under the Madrid Agreement.

41.3. Mark international registration applications originating in Vietnam

a/ A mark international registration application that designates a nation being a contracting party to the Madrid Agreement in which the protection is sought to be registered and does not designate any nation being a contracting party to the Madrid Protocol must be in French.

b/ A mark international registration application that designates at least one nation being a contracting party to the Madrid Protocol, and designates also a nation being a contracting party to the Madrid Agreement must be in English or French.

c/ An applicant shall submit a written declaration requesting international registration of a mark made according to a set form (not printed herein) and a mark international registration application made according to a form supplied free of charge by the NOIP. The applicant shall clearly indicate in the written declaration countries being contracting parties to the Madrid Agreement (which may concurrently be contracting parties to the Madrid Protocol) as well as those contracting to only the Madrid Protocol in which he/she seeks the protection of a mark. A mark international registration application must be made by accurately and fully filling information in sections reserved for the applicant and accompanied with mark specimens true to those already registered in Vietnam.

d/ An applicant should preliminarily calculate the total amount of fees and charges according to the fee tariff printed in the application form or may request the NOIP to notify the exact amount of fees and charges to be paid to the International Bureau. He/she shall pay those fees and charges directly to the International Bureau and additionally pay relevant fees and charges set by the NOIP.

e/ An applicant shall guarantee that information (especially his/her name and address, goods, services and classification thereof) supplied in a mark international registration application, including the language and translations thereof, are accurate and consistent with information stated in the relevant basic mark registration certificate or basic mark registration application. He/she shall pay amounts of fees due for the modification or supplementation of the mark international registration application containing inaccurate or inconsistent information under notices of the International Bureau.

f/ All mails and transactions related to a mark international registration application shall be communicated and conducted through the NOIP. The NOIP shall promptly notify requests of applicants to the International Bureau and vice versa under relevant treaties.

41.4. The agency receiving mark international registration application originating in Vietnam

a/ Mark international registration applications shall be filed with the International Bureau through the NOIP. The NOIP shall transfer mark international registration applications to the International Bureau within 30 days after receiving complete and valid application documents.

b/ The date the NOIP receives a mark international registration application shall be considered the date of filing a mark international registration application in case the International Bureau receives that application within two months from the date indicated in the NOIP's seal of application receipt. If the application is not completed by the applicant before it is sent to the International Bureau within the above time limit, the date of receipt of the application by the International Bureau shall be considered the date of filing the mark international registration application.

41.5. Supplementation, modification and transfer of mark international registration applications, mark international registrations originating in Vietnam

a/ After an application is filed with the International Bureau, all transactions between the applicant and the International Bureau related to the modification of the name and address, narrowing of the list of goods and services stated in the mark international registration application, mark international registration and extension of validity of mark international registration shall be established in writing according to a set form (not printed herein) and effected through the NOIP. The applicant shall pay prescribed fees and charges for those transactions.

b/ A mark proprietor shall request, through the NOIP (or directly request the International Bureau for international registrations of marks in nations acceding only to the Madrid Protocol), the International Bureau to record the transfer of the proprietorship under according to the international registration of mark and relevant treaties and pay prescribed fees and charges.

41.6. Processing of mark international registration applications designating Vietnam

a/ After receiving a notice of the International Bureau on a mark international registration application designating Vietnam, the NOIP shall conduct the substantive examination of the application according to the procedures applicable to mark registration application filed directly with the NOIP. Within 12 months after the International Bureau issues the notice, the NOIP shall make a conclusion on protectability of the mark.

b/ For a mark protectable under Vietnamese law, the NOIP shall issue a decision on protection of internationally registered mark, publish it in the Industrial Property Official Gazette, and record it in the national register of marks within one month from the date of its issuance. The protection coverage (volume) shall be certified according to the content of the request of the mark international registration application recorded by the World Intellectual Property Organization (WIPO) and certified by the NOIP.

c/ For a mark unprotectable or partially refused, the NOIP shall, before the expiration of the above 12-month time limit, notify in writing the International Bureau of the refusal for subsequent notification to the applicant, clearly stating the reason for the refusal and the refused contents.

d/ Within three months after the NOIP sends a notice on its refusal, the applicant may lodge a complaint about the NOIP's refusal. Procedures for lodging and settling complaints shall be

carried out as for mark registration applications filed directly with the NOIP. Results of complaint settlement shall be notified by the NOIP to the International Bureau and the applicant.

e/ As from the date a recognized mark international registration becomes valid in Vietnam, the NOIP shall, upon the request of the mark proprietor, grant a certificate of protection in Vietnam of internationally registered mark, if the requester pays the prescribed fee.

41.7. Extension of validity of mark international registrations originating in Vietnam

Within six months before the date of expiration of the valid duration of a mark international registration (20 years from the filing date of a mark international registration application for nations being contracting parties to the Madrid Agreement, including those concurrently contracting to the Madrid Protocol; 10 years from the filing date of a mark international registration application for nations contracting only to the Madrid Protocol), the applicant shall pay the fee for extension of validity of mark international registrations according to notices of the International Bureau.

41.8. Mark registration applications converted due to invalidation of mark international registrations

a/ If a mark international registration in Vietnam of a mark proprietor who is a national of a nation contracting only to the Madrid Protocol is invalidated under Article 9*quinquies* of the Madrid Protocol, such person may file a converted mark registration application made according to a set form (not printed herein) to the NOIP for registration of protection of the very mark for part of or the whole goods or services on the list of goods and services recorded in the invalidated mark international registration.

b/ A converted mark registration application shall be accepted if it satisfies the following conditions:

(i) It is filed within three months from the date of invalidation of the relevant mark international registration;

(ii) Goods or services stated in the converted mark registration application are on the list of goods and services stated in an ordinary mark international registration;

(iii) It satisfies all formality and substantive requirements according to Vietnamese law and the applicant pays fully the prescribed fees and charges.

c/ A converted mark registration application is allowed to bear the filing date or the date of priority of the relevant mark international registration application (if the mark international registration application enjoys the right of priority under treaties).

d/ The NOIP shall process applications for registration of converted marks as for ordinary marks.

42. Recognition of well-known marks

42.1. Well-known marks are protected by Vietnamese law in accordance with the provisions of Article 75 of the Intellectual Property Law and Article 6*bis* of the Paris Convention for the Protection of Industrial Property.

42.2. Rights to well known marks are protected and belong to proprietors of those marks without any registration procedures. Mark proprietors may use documents specified at Point 42.3 of this Circular to evidence their ownership of marks and prove that their marks satisfy the conditions for being considered well-known.

42.3. Documents evidencing the ownership and reputation of a mark include information on the scope, scale, level and continuity of the use of the mark, including an explanation of origin, history and time of continuous use of the mark; number of nations in which the mark has been registered or recognized as a well-known mark; list of goods and services bearing the mark; the territorial area in which the mark is circulated, turnover from products sold or services provided; quantity of goods and services bearing the mark manufactured or sold; property value of the mark, price of assignment or licensing of the mark and value of investment capital contributed in the form of the mark; investment in and expenses for advertising and marketing of the mark, including those for participation in national and international exhibitions; infringements, disputes and decisions or rulings of the court or competent agencies; surveyed number of consumers knowing the mark through sale, purchase, use, advertisement and marketing; rating and evaluation of reputation of the mark by national or international organizations or the mass media; prizes and medals awarded on the mark; results of examinations held by intellectual property examination organizations.

42.4. If a well-known mark is recognized according to civil procedures or under a recognition decision of the NOIP, that well-known mark shall be recorded in the list of well-known marks kept at the NOIP.

Section 6. PROCEDURES FOR REGISTRATION OF GEOGRAPHICAL INDICATIONS

43. Requirements for geographical indication registration applications

43.1. Geographical indication registration applications must satisfy the general requirements specified at Points 7 and 10.1 of this Circular and specific requirements of this Point.

43.2. Applications must ensure uniformity as required specified in Clause 1, Article 101 of the Intellectual Property Law. Each application may register only one geographical indication used for one product.

43.3. Application documents: Written application, made according to a set form (not printed herein); description of the nature/quality/reputation of the product; map of geographical area subject to the geographical indication (all made in two copies) and 10 specimens showing the presentation of the geographical indication to be used, of a size of between 20 mm x 20 mm and 80 mm x 80 mm (if the geographical indication does not consist of words).

43.4. Requirements for the description of the nature/quality/reputation of the product

a/ A description of the nature/quality/reputation of the product must have the following principal information:

(i) Enumeration of the given nature/quality of the product bearing the geographical indication dictated by geographical conditions - by means of sense, qualitative and quantitative indicators to physical, chemical and biological properties, which can be tested by technical devices or experts using a specified testing method; and/or

(ii) Reputation of the product bearing the geographical indication dictated by geographical conditions - determined through the widespread knowledge of interested consumers about that product, which can be tested; and

(iii) Geographical conditions liable to the nature/quality and reputation of the product bearing the geographical indication, including unique meteorological, hydrological, geological, topographic

and ecological elements and other natural conditions; unique elements being skills of producers, including also a traditional production process of the locality (which might cover one, several or all production stages, from production of materials, processing of materials to making of products, and even the stage of product packing if this stage has an effect on the nature/quality and reputation of the product) if that process is liable to create and maintain the nature/quality and reputation of the product bearing the geographical indication, which contain information that is clear and detailed enough to be tested (if the above information contains secrets or technical know-how not yet disclosed or widely known beyond the locality, the applicant may refuse to supply detailed information on those secrets or know-how without being assured of confidentiality of those information upon his/her request); and

(iv) Correlation between particular nature/quality and reputation of the product bearing the geographical indication defined at Points 43.4.a (i) and (ii) and geographical conditions defined at Point 43.4.a (iii) above.

b/ The description of the nature/quality/reputation of the product must be accompanied with documents proving that information on the nature/quality/reputation are grounded and true (results of examination, research, survey, etc.).

43.5. Requirements for maps of geographical areas subject to geographical indications

A map of a geographical area subject to a geographical indication must be adequately informative, based on which the geographical area where exist all natural conditions liable to the particular nature/quality and reputation of the product can be accurately identified. The map may be submitted together with documents describing the geographical area subject to the geographical indication.

44. Formality examination and publication of geographical indication registration applications

Procedures for formality examination and publication of geographical indication registration applications shall comply with the general procedures specified at Points 13 and 14 of this Circular.

45. Substantive examination of geographical indication registration applications

45.1. Order of carrying out procedures for substantive examination

The substantive examination of geographical indication registration applications shall be conducted according to the general order specified at Point 15 of this Circular and specific provisions of this Point.

45.2. Assessment of compatibility of objects stated in applications with certificates of registered geographical indications

An object stated in a geographical indication registration application shall be considered incompatible with the type of geographical indication protection title if it is not a visible sign used to indicate a product originating in a specific area, locality, territory or nation according to the provisions of Clause 22, Article 4 of the Intellectual Property Law.

45.3. Assessment of geographical indications based on protection conditions

a/ An object stated in an application shall be accepted for registration and recorded in the national register of geographical indications if it fully satisfies the conditions specified in Article 79 of the Intellectual Property Law and does not fall into the cases specified in Article 80 of the Intellectual Property Law. More specifically, all the following conditions must be satisfied:

(i) There exists a geographical area subject to the geographical indication stated in the application;

(ii) The product originates in the above geographical area;

(iii) The product has a given nature/quality and/or reputation dictated by geographical conditions of the above geographical area according to the provisions of Article 82 of the Intellectual Property Law;

b/ In the following cases, a geographical indication stated in an application is not registered:

(i) It has become a common name of goods in Vietnam;

(ii) It belongs to a foreign country and it is not protected or ceases to be protected or has fallen into disuse in that country;

(iii) It is identical or similar to a protected mark in Vietnam and its use can mislead as to the origin of a product;

(iv) It misleads consumers as to the true geographical origin of the product bearing it.

c/ Method of assessment of geographical indications based on the protection conditions

The assessment of a geographical indication based on the protection conditions specified at Points 45.3.a and b above shall be conducted based on information supplied by the applicant and information acquired from the following mandatory minimum information source:

(i) Marks currently protected in Vietnam for products identical or similar to the product bearing the geographical indication, with the dates on which the protection starts earlier than the filing date of the geographical indication registration application, including marks protected under treaties to which Vietnam is a contracting party;

(ii) Marks recognized by the NOIP as well known marks.

If a mark identical or similar to the geographical indication is found, the NOIP shall notify such to the mark proprietor for the latter to give opinions on the registration of the geographical indication within one month from the date of signing of the notice, clearly stating the mark proprietor's right of opposition to the registration of the geographical indication on the condition of sufficient grounds to prove that the geographical indication falls into the case specified in Clause 3, Article 80 of the Intellectual Property Law. Opinions of the mark proprietor shall be considered according to the provisions of Point 6 of this Circular on consideration of opinions of a third party.

A geographical indication that misleads consumers as to the true geographical origin of the product bearing that geographical indication when it is considered identical or indistinguishably similar to a sign known to Vietnamese consumers as an indication of geographical origin of a goods or service.

45.4. Notification of results of substantive examination

Results of substantive examination of geographical indication registration applications shall be notified according to the general provisions of Point 15.7 of this Circular.

46. Grant, registration and publication of certificates of registered geographical indications

Procedures for issuance of decisions on grant, registration and publication of certificates of registered geographical indications shall comply with the general provisions of Points 18 and 19 of this Circular.

Chapter II

PROCEDURES FOR REGISTRATION OF CONTRACTS ON ASSIGNMENT OF INDUSTRIAL PROPERTY RIGHTS AND PROCEDURES FOR MAKING DECISIONS ON COMPULSORY LICENSING OF PATENTS

Section 1. PROCEDURES FOR REGISTRATION OF CONTRACTS ON ASSIGNMENT OF INDUSTRIAL PROPERTY RIGHTS

47. Dossiers for registration of contracts on assignment of industrial property rights

47.1. A dossier for registration of a contract on transfer of industrial property rights comprises the following documents:

a/ Two copies of the written declaration for registration of the contract on transfer of industrial property rights, made according to a set form (not printed herein);

b/ Two originals or two valid copies of the contract; if the contract is made in a language other than Vietnamese, it must be enclosed with its Vietnamese translation; if the contract consists of many pages, each page must be appended with the parties' signatures for certification or every two adjoining pages must be appended with a seal on their inner edges;

c/ Original protection title;

d/ Written consent of co-owners to the transfer of industrial property rights, if those industrial property rights are under common ownership;

e/ Power of attorney (if the dossier is filed through a representative);

f/ Fee and charge receipts.

47.2. A dossier for registration of a contract on licensing of an industrial property object (industrial property licensing contract) comprises the following documents:

a/ Two copies of the written declaration on the industrial property licensing contract, made according to a set form (not printed herein);

b/ Two originals or two valid copies; if the contract is made in a language other than Vietnamese, it must be enclosed with its Vietnamese translation; if the contract consists of many pages, each page must be appended with the parties' signatures for certification or every two adjoining pages must be appended with a seal on their inner edges;

c/ Written consent of co-owners to the licensing of the industrial property object, if the relevant industrial property rights are under common ownership;

d/ Power of attorney (if the dossier is filed through a representative);

e/ Fee and charge receipts.

48. Procedures for processing of registration dossiers

48.1. If a dossier for registration of a contract on transfer of industrial property rights contains no error defined at Point 48.3 of this Circular, the NOIP shall carry out the following activities:

a/ To issue a decision on the grant of a certificate of registration of the contract on transfer of industrial property rights/licensing of an industrial property object;

b/ (For a contract on transfer of industrial property rights): To record in the protection title the new owner; in case of partial transfer of the list of goods and services bearing the protected mark, to grant a new certificate of registered mark to the transferee and confine the list of goods/services in the original protection title for the transferred part; or (for a contract on licensing of an industrial property object): To grant a certificate of registration of the contract on licensing of an industrial property object to the dossier-filing person; to append the registration seal on two originals or copies of the contract, of which one shall be handed to the dossier-filing person and the other kept by it.

c/ To record the assignment of industrial property rights in the national register of assignment of industrial property rights;

d/ To publish the decision on grant of a certificate of registration of the contract on assignment of industrial property rights in the Industrial Property Official Gazette within two months from the date of signing the decision.

48.2. If a dossier for registration of a contract on assignment of industrial property rights contains errors defined at Point 48.3 of this Circular, the NOIP shall carry out the following procedures:

a/ To issue a notice on its intended refusal of registration of the contract, clearly stating errors of the dossier and setting a time limit of one month from the date of signing of the notice for the dossier-filing person to correct the errors and make an opposition to the intended refusal of registration of the contract;

b/ To issue a notice on its refusal of registration of the contract if the dossier-filing person fails to correct or unsatisfactorily corrects the errors, makes no opposition or an unreasonable opposition to the intended refusal of registration of the contract within the set time limit.

48.3. A dossier for registration of a contract on assignment of industrial property rights shall be considered erroneous if it falls into one of the following cases:

a/ The written declaration is invalid;

b/ One of the documents on the list of required documents is absent;

c/ The power of attorney is invalid;

d/ The contract copies are not duly certified;

e/ The name and address of the assignor stated in the contract are not consistent with the relevant information in the protection title or the contract based on which the assigned rights arise, or in the power of attorney or written declaration; the name and address of the assignee stated in the contract are not consistent with those stated in the power of attorney or written declaration;

f/ The contract does not contain all signatures (and seals, if any) of the assignor and the assignee;

g/ The transferor is not the protection title holder;

h/ The term of protection of the concerned industrial property object has expired or there is a dispute over that object;

i/ The assignment contract lacks required contents specified in Article 140 or Clause 1, Article 144 of the Intellectual Property Law;

j/ The contract contains a content incompliant with the provisions on conditions for restriction of transfer of industrial property rights specified in Article 139 of the Intellectual Property Law or contains clauses on unreasonable restriction of rights of the industrial property object licensee specified in Clause 2, Article 144 of the Intellectual Property Law;

k/ There is a ground to confirm that the transfer of industrial property rights infringes upon industrial property rights of a third party.

48.4. The time limit for processing a dossier for registration of a contract on assignment of industrial property rights is two months (not including the time for the dossier-filing person to correct errors).

49. Recording of modification of contents, extension and ahead-of-time termination of validity of contracts on licensing of industrial property objects

49.1. The modification of contents, extension and ahead-of-time termination of validity of registered contracts on licensing of industrial property objects shall all be recorded by the NOIP according to the provisions of this Point.

49.2. A dossier requesting recording of modification of contents, extension or termination of a contract

a/ A dossier requesting recording of modification of contents, extension or ahead-of-time termination of validity of a contract on licensing of an industrial property object must be made in writing and comprise the following documents:

(i) Two copies of the written declaration requesting recording of modification of contents, extension or termination of validity of the contract on licensing of an industrial property object, made according to a set form (not printed herein);

(ii) The original certificate of registration of the contract on licensing of an industrial property object (in case of registration of modification of contents or extension of validity of the contract);

(iii) Documents evidencing the modification of the names and addresses of the contracting parties;

(iv) Agreements or documents on recording of specific contract clauses that need to be modified or supplemented, including the extension or ahead-of-time termination of validity of the contract;

(v) Power of attorney (if the request is filed through a representative);

(vi) Fee receipt.

b/ A dossier requesting extension of a contract must be filed at least one month before the expiration of the contract term stated in the certificate of registration of the contract on licensing of an industrial property object.

49.3. Within one month after receiving a dossier requesting recording of modification of contents, extension or termination of validity of a contract, the NOIP shall examine the dossier according to the following provisions:

a/ If the dossier is valid, the NOIP shall issue a decision on recording of modification of contents, extension or termination of validity of the contract on licensing of an industrial property object; record the modified contents, extension of validity of the contract on licensing of an industrial property object in a certificate of registration of the contract on licensing of an industrial property object; record the modified contents, extension or termination of validity of the contract on licensing of an industrial property object in the national register of assignment of

industrial property rights; publish the decision on recording of modification of contents, extension or termination of validity of the contract on licensing of an industrial property object in the Industrial Property Official Gazette within two months from the date of signing of the decision;

b/ If the dossier contains errors, the NOIP shall issue a notice on its intended refusal to record the modification of contents, extension or termination of validity of the contract on licensing of an industrial property object, clearly stating the dossier's errors and setting a time limit of one month from the date of issuance of the notice on its intended refusal for the dossier-filing person to correct the errors or make an opposition to the intended refusal of registration of the contract; issue a notice on its refusal to record the modification of contents, extension or termination of validity of the contract on licensing of an industrial property object if the dossier-filing person fails to correct or unsatisfactorily corrects the dossier's errors, makes no opposition or an unreasonable opposition within the set time limit.

Section 2. PROCEDURES FOR MAKING DECISIONS ON COMPULSORY LICENSING OF PATENTS

50. Dossiers for requesting issuance of decisions on compulsory licensing of patents

50.1. Organizations or individuals that are capable, obliged or have a need to use patents defined at Points a, b and c or are targeted by anti-competitive practices specified at Point d, Clause 1, Article 145 of the Intellectual Property Law may request competent persons defined in Clause 1, Article 147 of the Intellectual Property Law to issue decisions on compulsory licensing of patents to them according to the specific provisions of this Section.

50.2. A dossier for requesting issuance of a decision on compulsory licensing of a patent must comprise the following documents:

a/ Two copies of the written declaration for requesting compulsory licensing of a patent, made according to a set form (not printed herein);

b/ Documents proving that the request for issuance of a decision on compulsory licensing of a patent is reasonably grounded according to law, specifically:

(i) If the request for issuance of a decision on compulsory patent licensing is based on the provisions of Point a, Clause 1, Article 145 of the Intellectual Property Law, the dossier must contain documents proving that at the time of filing the application, there exists a practical demand for use of the patent for the public, non-commercial, defense, security, disease prevention and treatment or people's nutrition purpose or to meet other urgent needs of the society, but the patent holder fails to use the patent and the non-use of the patent will affect the achievement of the above purposes;

(ii) If the request for issuance of a decision on compulsory patent licensing is based on the provisions of Point b, Clause 1, Article 145 of the Intellectual Property Law, the dossier must contain documents proving that the patent holder fails to perform the obligation to use the patent specified in Clause 1, Article 136 and Clause 5, Article 142 of the Intellectual Property Law and by the time of filing of the dossier the time limit of four years from the date of filing the invention registration application and the time limit of three years from the date of grant of the patent have expired;

(iii) If the request for issuance of a decision on compulsory patent licensing is based on the provisions of Point c, Clause 1, Article 145 of the Intellectual Property Law, the dossier must contain documents proving that a person that needs to use the patent fails to reach agreement with the patent holder on signing a contract of patent licensing though he/she made every effort within a reasonable period to negotiate with the patent holder with a reasonable price and commercial terms, and clearly stating the demand for patent use, period of negotiation, specific price and commercial terms offered by the person that needs to use the patent;

(iv) If the request for issuance of a decision on compulsory patent licensing is based on the provisions of Point c, Clause 1, Article 145 of the Intellectual Property Law, the dossier must contain documents proving that the patent holder has committed acts regarded as prohibited anti-competitive practices defined by the competition law;

(v) For a request for issuance of a decision on compulsory patent licensing in the domain of semi-conductor technology, the dossier must contain documents proving that the use of the patent is for the public or non-commercial purpose only or produce documents proving that the patent holder has committed acts regarded as prohibited anti-competitive practices defined by the competition law;

c/ Power of attorney (if the dossier is filed through a representative);

d/ Fee receipt.

51. Procedures for processing dossiers for requesting issuance of decisions on compulsory patent licensing

51.1. Dossiers shall be filed according to the following provisions:

a/ Dossiers falling into the cases specified at Point b, c and d, Clause 1, Article 145 of the Intellectual Property Law shall be filed with the NOIP;

b/ Dossiers falling into the cases specified at Point a, Clause 1, Article 145 of the Intellectual Property Law shall be filed with the ministries or ministerial-level agencies in charge of patent management.

51.2. Examination of dossiers

For dossiers falling into the cases specified at Point 51.1.b of this Circular, the ministries and ministerial-level agencies shall designate an agency to receive and examine those dossiers.

Within two months after receiving a dossier, the NOIP or the dossier examination agency of the ministries or ministerial-level agencies (hereinafter referred to as the dossier examination agency) shall consider it according to the following provisions:

a/ If the dossier is valid: Within 15 days after receiving the dossier, the dossier examination agency shall issue a notice on request for patent licensing under a compulsory decision to the patent holder and request the latter to give written opinions within one month from the date of notice issuance; request concerned parties to overcome divergent opinions to negotiate again on the signing of a contract on patent licensing, when necessary; if no agreement is reached by the parties and when considering the patent holder's refusal to sign the contract on patent licensing unreasonable, report on the dossier consideration results and propose the Minister of Science and Technology and heads of ministerial-level agencies to issue a decision on compulsory patent licensing.

If the request falls into the cases specified at Point a, Clause 1, Article 145 of the Intellectual Property Law and the use of the patent is for public or non-commercial purposes, the ministries

or ministerial-level agencies may issue a decision on compulsory patent licensing without having to request the patent holder to make opinions and the concerned parties to negotiate.

b/ If a request for issuance of a decision on patent licensing is not reasonably grounded according to the provisions of Article 145 of the Intellectual Property Law, the dossier examination agency shall report on the dossier consideration results to and propose the Minister of Science and Technology, ministers or heads of ministerial-level agencies to issue a notice on intended refusal, clearly stating the reason for refusal and setting a time limit of one month from the date of notice issuance for the dossier-filing person to make opinions on the intended refusal.

The time limit for the dossier-filing person to correct the dossier's errors or make an opposition shall not be counted in the time limit for dossier consideration.

c/ For a dossier falling into the cases specified at Point a, Clause 1, Article 145 of the Intellectual Property Law, the dossier examination agency of the ministries or ministerial-level agencies shall copy and send copies of the dossier (through the NOIP) to the Ministry of Science and Technology for comments before submitting it to the ministers or heads of ministerial-level agencies for decision according to the provisions of Points a and b above. Within 15 days after receiving the dossier, the NOIP shall consider and report it to the Minister of Science and Technology for him/her to request in writing the ministers or heads of ministerial-level agencies to issue a decision on compulsory patent licensing or a notice on refusal.

51.3. Within 15 days after receiving a report of the NOIP on dossier consideration results, the Minister of Science and Technology shall consider and issue a decision on compulsory patent licensing, or send to the dossier-filing person a notice on its refusal of compulsory patent licensing, clearly stating the reason for refusal.

Within 15 days after receiving a written request of the Minister of Science and Technology, the ministers or heads of ministerial-level agencies shall consider and issue a decision on compulsory patent licensing, or send to the dossier-filing person a notice on its refusal of compulsory patent licensing, clearly stating the reason for refusal.

If disagreeing with the request of the Minister of Science and Technology, the ministers or heads of ministerial-level agencies shall notify the disagreement in writing, clearly stating the reason for disagreement.

51.4. Decisions on compulsory patent licensing shall be sent by the ministers or heads of ministerial-level agencies to patent licensees, patent holders and the NOIP.

The NOIP shall record those decisions in the national register on assignment of industrial property rights within one month and publish them in the Industrial Property Official Gazette within two months from the dates of their signing.

52. Requests for termination of patent licensing under compulsory decisions

52.1. The termination of patent licensing under compulsory decisions shall be decided by ministers or heads of ministerial-level agencies who have issued decisions on compulsory licensing.

52.2. A request for termination of patent licensing under a compulsory decision must comprise the following documents:

a/ Written request for termination of patent licensing under a compulsory decision;

b/ Documents proving that the grounds for patent licensing under a compulsory decision no longer exist and are unlikely to revive, and at the same time the termination of patent licensing will cause no damage to the patent licensee;

c/ Power of attorney (if the request is filed through a representative);

d/ Fee receipts.

52.3. Procedures for receiving and handling requests for termination of patent licensing under compulsory decisions and issuing termination decisions shall be carried out like procedures for receiving and processing dossiers for requesting patent licensing under compulsory decisions specified at Point 51 of this Circular.

Chapter III

INDUSTRIAL PROPERTY REPRESENTATION

Section 1. GRANT AND WITHDRAWAL OF INDUSTRIAL PROPERTY REPRESENTATION SERVICE PRACTICE CERTIFICATES

53. Grant of practice certificates

53.1. Conditions for grant of practice certificates

Only persons who fully satisfy the conditions specified in Clause 2, Article 155 of the Intellectual Property Law may be granted industrial property representation service practice certificates. To be granted certificates, those persons shall file dossiers of application with the NOIP according to the provisions of this Point.

53.2. Dossiers of application for practice certificates

a/ A dossier of application for an industrial property representation service practice certificate must comprise the following documents:

(i) Two copies of the written declaration for requesting grant of an industrial property representation service practice certificate (practice certificate), made according to a set form (not printed herein);

(ii) A copy of the notice on the pass of an examination of professional qualifications for industrial property representation organized by the NOIP;

(iii) Two 3 cm x 4 cm photos;

(iv) Fee receipt.

53.3. Processing of dossiers of application for practice certificates

For a valid dossier, the NOIP shall, within one month after receiving the dossier, base itself on the dossier consideration, issue a decision on grant of a practice certificate and grant a practice certificate to the dossier-filing person; record the grant of a practice certificate in the national register of industrial property representation; publish the grant of a practice certificate in the Industrial Property Official Gazette within two months from the date of decision signing; or notify errors in the dossier and set a time limit of one month for the dossier-filing person to correct the errors; or issue a notice on its refusal to grant a practice certificate, clearly stating the reason for

refusal, if the dossier-filing person fails to correct or unsatisfactorily corrects the errors or the dossier is invalid.

54. Withdrawal of practice certificates

If an industrial property representative commits a violation and is imposed with the sanction of withdrawal of practice certificate, the NOIP shall, based on a decision on withdrawal of industrial property representation service practice certificate, issued by a state agency competent to handle administrative violations, issue a decision on withdrawal of practice certificate; delete the name of the industrial property representative from the list of industrial property representatives of the industrial property representation service organization; publish the withdrawal of practice certificate in the Industrial Property Official Gazette within two months from the date of decision signing.

55. Renewal of practice certificates

The NOIP shall carry out procedures for renewal of industrial property representation service practice certificates upon written requests made according a set form by industrial property representatives in case their practice certificates are lost or irreparably damaged (torn, stained or faded).

Procedures for renewal of practice certificates shall be carried out like procedures for grant of practice certificates specified at Point 53.3 of this Circular.

Section 2. RECORDING, MODIFICATION AND DELETION OF NAMES OF INDUSTRIAL PROPERTY REPRESENTATION SERVICE ORGANIZATIONS

56. Recording of industrial property representation service organizations

56.1. To be officially licensed to exercise the right to represent applicants before the NOIP, an industrial property representation service organization shall carry out procedures for being recorded in the national register of industrial property representation specified at this Point.

56.2. A dossier of request for recording of an industrial property representation service organization in the national register of industrial property representation must comprise the following documents:

- a/ Two copies of the written declaration for requesting recording of an industrial property representation service organization, made according to a set form (not printed herein);
- b/ List of the organization's members possessing industrial property representation service practice certificates enclosed with copies of their employment decisions/labor contracts;
- c/ Copies of the organization's business registration certificate/operation registration certificate;
- d/ The organization's industrial property representation service charge tariff;
- e/ The organization head's written mandate of representation for one of the members on the list specified at Point 56.2.b above (when necessary);
- f/ Fee receipt.

56.3. Within one month after receiving a dossier of request for recording of an industrial property representation service organization, the NOIP shall consider it according to procedures similar to the procedures for grant of industrial property representation service practice certificates specified at Point 53.3 of this Circular.

57. Recording of modification of information on industrial property representation service organizations

57.1. An industrial property representation service organization may request the NOIP to record changes related to its name and address, and the names and addresses of the members on its list of industrial property representatives.

57.2. A dossier of request for recording of modification of information on an industrial property representation service organization must comprise the following documents:

a/ Two copies of the written declaration for requesting recording of modification of information on industrial property representation service organization, made according to a set form (not printed herein);

b/ Copies of the modified business registration certificate/operation registration certificate of the industrial property representation service organization (in case of change of the organization's name or address);

c/ Decision on employment or decision on termination of the labor contract of an industrial property representative being a member of the organization (in case of change of a member on the organization's list of industrial property representatives);

d/ Fee receipt.

57.3. Procedures for processing dossiers of request for modification of information on industrial property representation service organizations shall be carried out like the procedures specified at Point 53.3. of this Circular.

58. Deletion of names of industrial property representation service organizations

In the cases specified in Clause 2, Article 156 of the Intellectual Property Law, the NOIP shall issue decisions on deletion of names of industrial property representation service organizations; record the deletion of names of industrial property representation service organizations from the national register of industrial property representation; notify the deletion of names of industrial property representation service organizations to competent agencies that have granted business registration certificates or operation registration certificates to those organizations; and publish the deletion of names in the Industrial Property Official Gazette within two months from the dates of decision signing.

Section 3. EXAMINATION OF PROFESSIONAL QUALIFICATIONS FOR INDUSTRIAL PROPERTY REPRESENTATION

59. Examination of professional qualifications for industrial property representation

The examination of professional qualifications for industrial property representation (hereinafter referred to as the examination) according to the provisions of Article 28 of the Decree on industrial property shall be conducted according to the following specific provisions.

59.1. The Council for examination of professional qualifications for industrial property representation:

The Council for examination of professional qualifications for industrial property representation (hereinafter referred to as the Examination Council) shall be set up by the NOIP director to prepare examination questions and mark examination papers under the Regulation on

examination of professional qualifications for intellectual property representation promulgated by the NOIP director (hereinafter referred to as the examination regulation).

The Examination Council is composed of the chairman being the NOIP director, vice chairman, secretary and other members appointed by the chairman from the list of experts qualified for joining the Examination Council. The list of experts qualified for joining the Examination Council include experts who are knowledgeable of the law on establishment of industrial property rights and its practical enforcement from the NOIP and socio-professional organizations engaged in industrial property representation approved by the Minister of Science and Technology at the proposal of those agencies and organizations.

Decisions of the Council shall be adopted by votes of the Council's members, of which two thirds are votes for.

Remunerations for the Council's members shall be paid with the collected charge for examination of professional qualifications for industrial property representation under the Examination Regulation.

59.2. Registration for participation in examination:

a/ Only persons fully satisfying the conditions specified at Points a through e, Clause 2, Article 155 of the Intellectual Property Law are allowed to register for participation in examination according to the provisions of this Point.

b/ A dossier for registration for participation in examination filed with the NOIP must comprise the following documents:

(i) Two copies of the written declaration for registration for participation in examination, made according to a set form (not printed herein);

(ii) Copy of the university diploma;

(iii) Documents proving that the dossier-filing person has been trained in industrial property law or is experienced in this operation: Copies of certificates of graduation from training courses on industrial property law recognized by the Ministry of Science and Technology or certificate of the training establishment where the dossier-filing person has made his/her graduation or post-graduate dissertation on industrial property; written certification of a competent agency that the dossier-filing person has been personally engaged in the examination of industrial property registration applications at a national or international industrial property office for five or more consecutive years or in industrial property law-related activities defined at Point d, Clause 1, Article 155 of the Intellectual Property Law (including inspection, examination, procuracy, adjudication, legal affairs, consultancy on industrial property law; or scientific research (with title of industrial property researcher) or lecturing of industrial property);

(iv) Two 3 cm x 4 cm photos;

(v) Receipt of the examination fee.

59.3. For a valid dossier, the NOIP shall notify the dossier-filing person of his/her qualification for participation in the examination, and concurrently notify in detail the examination date, time, venue and schedule.

59.4. Examination contents and questions:

a/ Examination contents include:

(i) Vietnam's industrial property law and treaties to which Vietnam is a contracting party;

(ii) Professional operation of compilation, filing and pursuit of industrial property registration applications;

(iii) Professional operation of industrial property information search and exploitation;

(iv) Other contents, when necessary.

b/ Examination questions accompanied with answers and a score frame shall be prepared by the Examination Council, approved by the Examination Council's chairman and kept secret until the examination starts.

59.5. Organization of examination

a/ An examination shall be organized (irregularly) whenever there are five or more persons properly register for examination.

b/ Examination papers shall be marked by the Examination Council according to the approved answers and score frame.

c/ Examination results shall be notified by the NOIP to examinees. Examinees may request the NOIP to review examination papers and the Examination Council shall review examination papers according to the regulations of the NOIP director.

Examination results shall be valid for two years for the grant of industrial property representation service practice certificates.

Chapter IV

ASSURANCE OF INDUSTRIAL PROPERTY INFORMATION

60. Building and management of a national database on industrial property

60.1. The NOIP shall build and manage a national database on industrial property in order to meet in a timely, adequate and accurate manner all needs for industrial property information in service of research, application and development activities and other socio-economic activities.

60.2. The national database on industrial property consists of disclosed information specified below, which are collected in a selective and systematic manner to suit the search purpose:

a/ Industrial property registration applications;

b/ Granted protection titles and industrial property rights recognized for protection in Vietnam;

c/ Invention patents granted by countries/regions with the most advanced science and technology;

d/ Some other types of industrial property protection title, depending on information use purposes.

61. Access to and exploitation of industrial property information in the national database

61.1. All organizations and individuals may access and exploit information in the national database on industrial property after subscribing as information users with the NOIP.

61.2. Persons who wish to access and exploit industrial property information (information users) shall themselves search for information in the national database.

Information users may request the NOIP to search for information in the national database and shall pay the prescribed search charge.

62. Service of industrial property information search

62.1. When requesting the NOIP to search for industrial property information, an information user shall make a search request slip (according to a set form, not printed herein), clearly stating the search purpose and scope (field, type of data carrier, search time, country or region subject to the search, etc.).

62.2. Within one month after receiving a search request slip, the NOIP shall reply to the information user.

For a valid search request (with a valid search request slip defined at Point 62.1 of this Circular and a receipt of the search charge), the NOIP shall reply by sending a search report to the information user, clearly stating the results of information search made at the request of the information user.

For an invalid search request (with an invalid search request slip, unclear search purpose and scope, no payment of the search charge), the NOIP shall notify its refusal to fulfill the search request, clearly stating the reasons for refusal.

62.3. A search report contains only information found and indications to origins of such information. If no information is found in sources requested to be searched, the search report must also state that.

A search report must not contain comments or assessments of found information.

62.4. A search report must clearly state the full name of the person conducting the search and responsible for the search results.

63. Assurance of industrial property information in localities

63.1. Depending on their respective conditions and capability, state administration agencies in charge of industrial property (Science and Technology Services) in provinces or centrally run cities may set up and manage industrial property databases in order to assure industrial property information for research, application, development, production and business activities and protect industrial property rights in their respective localities.

63.2. State administration agencies in charge of industrial property in the provinces or centrally run cities shall and may conduct activities to assure industrial property information according to this Circular.

64. Issuance of copies of documents

64.1. All concerned organizations and individuals may request the NOIP to issue copies of documents distributed or archived by the NOIP, including certification of true copies of original or archived documents. Particularly for documents related to unpublished applications, only applicants may request issuance of copies. Persons requesting issuance of copies shall pay the prescribed charge.

64.2. A request for issuance of copies of documents comprises:

a/ Written request for issuance of copies of documents, made in two copies;

b/ Original documents distributed by the NOIP (if those documents are not archived at the NOIP);

c/ Receipt of the charge.

64.3. Within three working days after receiving a request for issuance of copies, the NOIP shall issue copies or issue a notice on its refusal, clearly stating the reason for refusal.

Chapter V

IMPLEMENTATION PROVISIONS

65. Regulation on carrying out of industrial property procedures

The NOIP shall promulgate a regulation on carrying out of industrial property procedures in compliance with the provisions of the Decree on industrial property and this Circular.

66. Transitional provisions

66.1. An invention registration application referred to in this Circular means both an invention patent application and a utility solution patent application referred to in previous regulations.

66.2. For an internationally registered mark already recognized for protection in Vietnam according to previous stipulations, the issue of the WIPO's Official Gazette or the NOIP's Industrial Property Official Gazette in which that internationally registered mark is published is valid as an evidence of rights to that mark.

66.3. Pending the promulgation of new charge and fee rates, the charge and fee rates mentioned in this Circular comply with the Ministry of Finance's Circular No. 132/2004/TT-BTC of December 30, 2004, guiding the collection, remittance, management and use of industrial property charges and fees.

66.4. Existing document forms will continue to be used until the NOIP complete technical conditions and officially announce the document forms specified in this Circular for application.

67. Implementation effect

67.1. This Circular replaces the following Circulars:

a/ The Ministry of Science, Technology and Environment's Circular No. 3055/TT-SHCN of December 31, 1996, guiding the implementation of the provisions on procedures for establishment of industrial property rights and some other procedures under the Government's Decree No. 63/CP of October 24, 1996, detailing industrial property;

b/ The Ministry of Science and Technology's Circular No. 29/2003/TT-BKHCN of November 5, 2003, guiding the implementation of the procedures for establishment of industrial property rights to industrial designs;

c/ The Ministry of Science and Technology's Circular No. 30/2003/TT-BKHCN of November 5, 2003, guiding the implementation of the procedures for establishment of industrial property rights to inventions/utility solutions.

67.2. This Circular takes effect 15 days after its publication in "CONG BAO."

Minister of Science and Technology
HOANG VAN PHONG