

IP  
ALERT

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## Author

**Linda Wang**  
Partner  
ZICO IP  
linda.wang@zicolaw.com



## Key Changes to Procedures for Establishing Intellectual Property Rights in Vietnam

On 30 June 2016, Circular No. 16/2016/TT-BKHCN (“[Circular No. 16](#)”) was passed by the Vietnamese Ministry of Science & Technology to amend and supplement a number of provisions contained in Circular No. 01/2007/TT-BTC dated 14 February 2007 (“[Circular No. 1](#)”). Circular No. 16 took effect on [15 January 2018](#) and together with Circular No. 1 provide for important stipulations concerning the prosecution and registration of IP rights in Vietnam. We highlight below some of the key changes:

### 1. General

#### 1.1 Deadline to respond to office actions

The time to respond to the National Office of Intellectual Property (NOIP) regarding formality examination is extended from one to two months, from the date of the office action. And, with respect to action concerning substantive examination, response time is extended from two to three months. The deadlines may be extended once for the same period, thus, giving a maximum time to respond of four and six months, respectively.

Late submissions beyond the deadline may only be excused if the NOIP approves the applicant’s submission, supported by evidence that the delay was due to a force majeure event or an “objective obstacle”.

#### 1.2 Refusal and appeals

Circular No. 16 now permits an applicant to submit new facts and evidence to try to overcome a refusal by the NOIP after substantive examination. The NOIP may, after considering the new facts and evidence (that were not available for consideration during the substantive examination), withdraw the refusal. Thus, an applicant now has an additional avenue to persuade the NOIP to accept the application (if there is relevant new evidence to produce) before taking up appeal proceedings. New facts and evidence are however not allowed at the appeal stage.

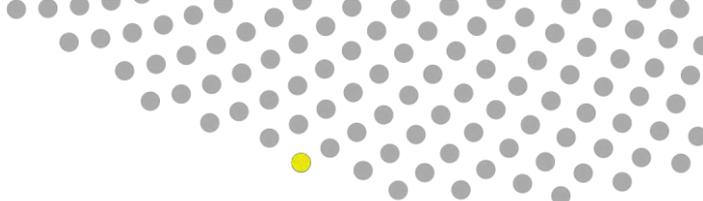
#### 1.3 Withdrawal of applications

The new provision disallows a reinstatement or revival of an application that has been withdrawn by the applicant. Thus, careful consideration should be given before requesting withdrawal. Instead, the applicant should consider if the application may be allowed to lapse.

#### 1.4 Notifications by NOIP

Unlike previously when the right holder will receive no notification, the NOIP is now obliged to notify the right holder of a request for invalidation or termination of its rights, within one month of NOIP’s receipt of the request.

An opponent will now also be notified by the NOIP of the results of the opposition. There is however no obligation on the NOIP to notify the opponent further of steps that may be taken in the proceedings, for example, an appeal against the NOIP’s decision on the opposition.



## 2. Patents

### Deadline for entry to national phase of PCT applications

PCT applicants must now enter national phase in Vietnam strictly within 31- months' time limit under both Chapters I and II. The previous provision allowing a 6-months grace period (with payment of extra fees) is now removed. The specification in Vietnamese must also be filed at the time of entry, thus, sufficient time for translation preparation should be allocated to ensure timely filing.

Request for examination must be made within 42 months from the priority date (or, the filing date if there is no priority claimed) and 36 months from the priority date if it is a utility model application. Although an extension of this deadline is possible it will be permitted only if the extension is necessary due to a "force majeure event" or an "objective obstacle".

## 3. Trade Marks

### 3.1 Right to object to disclaimers imposed

Circular No. 16 now expressly provides that objection against disclaimers imposed by the NOIP on the trade mark may be filed by an applicant within 3 months of notification of the disclaimer. This settles the previous uncertainty as to if and how objections may be filed.

### 3.2 Responses to provisional refusals of international applications

Prior to the amendment, a Madrid application applicant may only appeal against the NOIP's provisional refusal within 3 months of such notification. Applicants for international applications may now, similar to a national application, file a response against the provisional refusal within 3 months of the refusal date and then, within 3 months, appeal against any subsequent decision of refusal by the NOIP. A Madrid applicant now has as good an opportunity if not slightly better, as an applicant of a national application, to try to overcome a refusal.

## 4. Designs

### 4.1 Definition of product

A product is now defined as "an object, device, equipment, means, or part for assembling or integrating these products, manufactured by industrial or handicraft methods, having a clear structure and function, circulated independently."

This new definition has the effect of narrowing the scope of what is eligible for design protection, by excluding intangible products such as GUI (graphic user interface).

If you have any questions, please free to contact the [ZICO IP team](#).

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