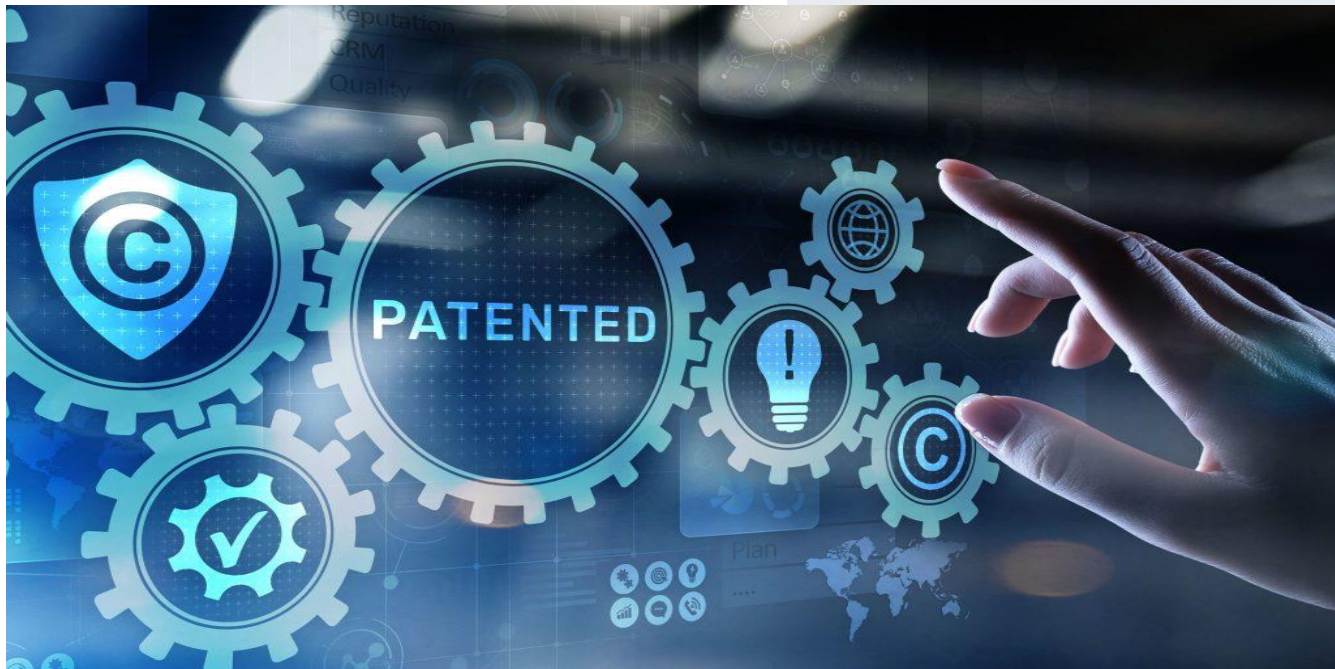


IP KNOWLEDGE EXTRACT



NAVIGATING DIVISIONAL PATENT APPLICATIONS IN VIETNAM: STRATEGIES AND INSIGHTS FOR ROBUST IP PROTECTION

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What's New

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Overview

Filing divisional applications can be a strategic maneuver to boost significantly the value of an intellectual property (IP) portfolio. This article offers specific insights into the process of filing divisional in Vietnam. It is designed to help applicants thoroughly understand the legal framework, make well-considered timing decisions, and ensure adherence to all requirements. By doing so, applicants can strengthen their patent protection and confidently navigate the intricacies of the Vietnamese patent divisional process.

Additionally, it is possible to file a divisional from a previously pending divisional application, even if the parent application has already been granted. This flexibility allows applicants to secure robust patent protection and navigate the complexities of the Vietnamese patent system effectively.

Requirement For Unity Of Invention

It's important to note that the requirement for unity of invention is similar to that of the Patent Cooperation Treaty ("PCT") and is outlined in Article 101 of the Law on Intellectual Property and Article 14 of Circular No. 23/2023/TT-BKHCN. In cases where an application includes multiple inventions that do not meet this criterion, the applicant may be asked to divide the application into separate filings. This ensures that each patent application maintains a clear and focused scope, facilitating a more efficient examination and granting process.

Time Of Filing

Voluntary divisions can be submitted to the Intellectual Property Office of Vietnam (IP Office) at any time before a decision on refusal or grant is issued. Following a response to an office action, the IP Office may issue a notice of allowance, a further office action, or a decision on refusal on a case-by-case basis, which may be unpredictable. In the case of a decision on the grant, it will be issued after the payment of grant fees in response to a notice of allowance, so it is recommended to file divisional at the time of payment.

In the event of an office action objecting to an application as not meeting the unity of invention requirement, the applicant may select one invention for the parent application and file divisions for the remaining inventions. Alternatively, the applicant may choose one invention for the parent application and file divisions later, as long as the parent application has not yet received a decision on refusal or grant.

Filing Fees

When filing a divisional application, the costs are the same as those for filing a regular application, except that there is no fee for claiming priority.

The Subject Matter Of A Divisional

When filing a divisional application, it's important to note that there are no specific limitations on the subject-matter that can be included. However, the divisional subject matters must be disclosed in the original specification of the parent application. This means that the original specification of the parent application must support the claims of a divisional application.

Double Patenting Cases

When it comes to patent applications for inventions or utility models that are the same or equivalent, the following rules apply:

(i) If the applications have different earliest priority dates, the application with the earlier priority date will be granted a patent.

(ii) If the applications have the same earliest priority date, the applicants must agree that only one application will be patented.

(iii) If the applications have the same earliest priority date and the same applicant, only one application will be patented.

The divisional and the parent applications fall under case (iii) above.

Overlap In Double Patenting Practice

It's essential to consider the overlap between the scopes of protection of two claims in patent examination. If the scopes overlap partially, the two inventions will not be considered identical or equivalent. For instance, if a claim of an application filed later recites a continuous number range not similar to a number range recited in a claim of another application, the two inventions will not be considered identical or equivalent.

It's worth noting that there are certain cases where an overlap in the scope of claims would not lead to a double patenting objection. However, the guidelines on this issue may be subject to different interpretations, leading to varying considerations by the Intellectual Property Office of Vietnam (IP Office). This is particularly relevant to divisional applications in Vietnam.

Conclusion

When filing patent divisions in Vietnam, it's essential to be aware of potential overlap-related issues. If an applicant files a divisional application for a part of an invention to obtain a patent for that specific part and then continues to pursue the parent application to secure a patent for the entire invention, including that part, they may encounter challenges in Vietnam.



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