

IP KNOWLEDGE EXTRACT



A Comprehensive Overview Of Enhancing Patent Opposition And Observation Mechanisms In Vietnam

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Overview

In Vietnam, the approach to patent opposition is distinct from that in many other countries. Once a patent has been granted, parties cannot challenge it through opposition. Instead, those who wish to contest the validity of a granted patent must submit an invalidation request to the Intellectual Property Office of Vietnam (IP Office of Vietnam).

However, individuals and organizations can express their concerns regarding pending patent applications. If they believe that a pending application may infringe upon their legitimate rights and interests or does not meet the patentability criteria, they have the right to challenge it. This challenge can be made through two avenues:

1. **Third-Party Observations:** Interested parties can submit their opinions along with supporting documents to the IP Office of Vietnam, advising against the grant of a patent for the application.
2. **Third-Party Oppositions:** They can also file a formal opposition to the granting of the patent.

The current provisions offer a structured approach for stakeholders to protect their interests prior to the granting of a patent. In the past, the primary method for challenging pending patent applications was through third-party observations. This process allowed individuals or entities to submit their opinions and relevant documentation to the IP Office of Vietnam under Article 112 of the Law on Intellectual Property.

During this observation process, the IP Office of Vietnam had the discretion to determine whether to share the third-party opinion with the applicant for their comments. If the IP Office of Vietnam deemed the opinion to be valid, it would be forwarded; if not, it would be dismissed without seeking feedback from the third party. For instance, if the opinion pertained to the eligibility to file the patent application, the IP Office of Vietnam typically chose to forward it to the applicant. However, if the opinion concerned patentability or other related issues, the IP Office of Vietnam could decide not to share it based on their assessment.

As a result, under the previous framework, third-party observations acted primarily as reference points, lacking the active engagement needed from the IP Office of Vietnam in the decision-making process.

The recent amendments to the intellectual property provisions, as outlined in the amended Law on Intellectual Property effective from January 1, 2023, along with Decree 65/2023/ND-CP implemented on August 23, 2023, and Circular 23/2023/TT-BKHCHN coming into effect on November 30, 2023, introduce significant enhancements to the intellectual property framework. A key change is the strengthening of the role of third parties in the patent application process.

The amended IP Law now establishes a formal mechanism that allows third parties to not only express their opinions concerning patent applications but also to file formal oppositions within a designated timeframe, as detailed in Article 112a of the amended law. This mechanism ensures fair protection for the legitimate rights of intellectual property holders. The IP Office of Vietnam is tasked with resolving these oppositions and communicating the outcomes to the relevant parties. This represents a substantial advancement in patent rights

protection, moving beyond the previous role of third-party observations as mere reference sources.

Both submitting third-party observations and filing a third-party opposition occur following the publication of a patent application in the Industrial Property Official Gazette, but there are important distinctions between the two processes.

Timeframe for Each Action:

- Third-Party Observation: This must be submitted to the IP Office of Vietnam after the patent application is published and before the patent is granted. There is no strict deadline beyond this timeframe.

- Third-Party Opposition: This action has a more defined deadline, requiring submission within nine months from the publication date of the patent application.

IP Office of Vietnam's Responsibilities:

- Third-Party Observation: The IP Office of Vietnam is not obligated to inform the third party of the outcome regarding their observations.

- Third-Party Opposition: In contrast, the IP Office of Vietnam is required to examine the opposition and must inform the third party of the results of that examination.

Understanding these differences is crucial for anyone involved in the patent application process.

Procedure For Opposition Under Article 112a Of The Revised Intellectual Property Law

It is essential to understand that third-party observations in the context of a patent application serve only as a reference and do not influence the examination process. The procedure for opposing a patent application operates independently from these observations.

According to Article 112a of the amended Intellectual Property (IP) Law and Circular 23/2023/TT-BKHCN, upon receipt of a third-party opposition, the IP Office of Vietnam must initiate a defined procedure similar to that of invalidation, termination, or appeal processes. The IP Office of Vietnam will forward the opposition to the patent applicant, who will then have a two-month period to provide their comments. If deemed necessary, the IP Office of Vietnam may also share the applicant's comments with the opposing party, allowing for an additional two-month period for further feedback. Moreover, the IP Office of Vietnam can facilitate direct discussions between both parties.

After evaluating the information, evidence, and arguments presented by both sides, the IP Office of Vietnam will make a decision regarding the opposition and will communicate the results along with the substantive examination findings of the patent application to the third party involved.

In cases where the third-party opposition is based on the right to file the patent application, the IP Office of Vietnam will recommend that the third party pursue their case in court, as per the Civil Procedure Code, unless it is clearly established that the patent applicant lacks the right to file the application under the amended IP Law. The third party will have two months to submit a copy of the court's acceptance notice to the IP Office of Vietnam. Upon receiving this





notice, the IP Office of Vietnam will suspend the examination of the patent application until the court delivers its verdict. Subsequently, the outcome of the patent application will be determined in accordance with the court's ruling. If the court acceptance notice is not provided to the IP Office of Vietnam within the two-month timeframe, the opposition will be regarded as withdrawn, and the application will continue through the usual examination process without any opposition.

The Differences Between Third-Party Observations and Oppositions in Vietnam's Patent System

Both observation and opposition mechanisms allow third parties to challenge pending patent applications. However, they differ significantly in structure and engagement. A third-party opposition provides a more formal and interactive framework, allowing direct participation from the involved parties, while a third-party observation is a less formal process.

In the IP Office of Vietnam framework, observations are treated as informational references during the examination of patent applications. This means that third parties who submit observations do not receive formal notifications regarding the results of the examination. Consequently, observations generally carry less persuasive weight compared to oppositions, which require payment of fees and follow a specific procedure that enables both parties to present their arguments and comments. Moreover, the IP Office of Vietnam is required to resolve opposition cases and communicate the outcome to the third party, in addition to providing the substantive examination results.

Both mechanisms play important roles in the Vietnamese patent prosecution framework. Observations serve as a flexible and cost-effective method for parties to raise potential conflicts during the early stages of examination, while oppositions offer a more structured platform for formally challenging patent applications. Engaging in an opposition allows third parties to safeguard their legitimate patent rights against potentially conflicting inventions.

The choice between submitting an observation or pursuing an opposition often hinges on practical considerations. For simpler cases, a third-party observation may suffice. However, when a definitive resolution is desired, pursuing an opposition is typically the more effective choice. It is also important to note that if the nine-month period following the publication date of the application has elapsed, only observations can be submitted.

Conclusion

Amending the legal framework for third-party opinions and oppositions has the potential to enhance the clarity and transparency of the Vietnamese patent system, ultimately strengthening the protection of intellectual property rights.

Recent changes to the provisions governing patent challenges in Vietnam present significant opportunities for third parties to engage actively in the patent examination process. These amendments aim to improve transparency and uphold the integrity of the patent system, benefiting both innovators and the public. It is essential for all stakeholders to strategically leverage these changes to safeguard their interests within the Vietnamese intellectual property landscape.

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