

No. 30-2003-TT-
BKHCN

Hanoi, 5 November 2003

CIRCULAR
PROVIDING GUIDELINES FOR IMPLEMENTATION OF PROCEDURES
FOR ESTABLISHMENT OF INDUSTRIAL PROPERTY RIGHTS WITH
RESPECT TO INVENTIONS AND UTILITY SOLUTIONS

Pursuant to Decree No. 54-2003-ND-CP of the Government dated 19 May 2003 on the functions, duties, powers and organizational structure of the Ministry of Science & Technology;

Pursuant to Decree No. 63-CP of the Government dated 24 October 1996 as amended by Decree No. 06-2001-ND-CP of the Government dated 1 February 2001 providing detailed regulations on industrial property;

The Ministry of Science & Technology hereby provides guidelines for conducting procedures on formulation, submission and examination of applications for certificates of protection with respect to inventions and utility solutions; and for procedures on issuance, amendment, extension, suspension and termination of validity of certificates of protection with respect to inventions and utility solutions:

CHAPTER I

General Provisions

1. Interpretation of terms:

1.1 In this Circular the following terms shall be construed as follows:

- (a) "Decree" refers to Decree No. 63-CP of the Government dated 24 October 1996 as amended by Decree No. 06-2001-ND-CP of the Government dated 1 February 2001 providing detailed regulations on industrial property;
- (b) "Application for invention" refers to applications for issuance of a patent for an invention ;
- (c) "Application for utility solution" refers to applications for issuance of a patent for a utility solution ;
- (d) "Application" refers to applications for an invention and applications for a utility solution;
- (dd) "International application" refers to applications for international registration in respect of an invention or utility solution filed pursuant to the

Patent Co-operation Treaty signed in Washington in 1970 and as amended in 1984 (hereinafter referred to as the PCT Treaty);

(e) "Applicant" means the organization or individual (hereinafter referred to as underwriter) in whose name the application is submitted;

(f) "Procedures for registration of an invention or utility solution" means procedures for establishment of industrial ownership of an invention or utility solution and other related procedures.

1.2 Other terms shall have the same meanings as in the Decree.

2. Certification of documents:

2.1 Certification of original documents:

During the process of conducting procedures for registration of an invention or utility solution, all original documents of a transaction must be certified by the underwriter who gave its name to such document in accordance with the following provisions:

(a) If the underwriter who gives his/her name to the document is an individual, the document must bear the full name and signature of such underwriter or of the authorized representative of such underwriter;

(b) If the underwriter who gives its name to the document is an organization required to use a seal, then the signature of the authorized representative of the underwriter must be sealed.

2.2 Certification of copies:

(a) All copy documents produced by any method of copying must be certified to be true copies of the original as stipulated in clause (b) below before they shall be permitted to be used as official documents when conducting procedures for registration of an invention or utility solution;

(b) A document shall be recognized as a true copy of the original where such copy is certified as a true copy by one of the following bodies: Public notary, people's committee or competent authority, underwriter (all the underwriters) of the original document or the proxy of the underwriter. If the copy consists of many pages, each page must be certified or the pages must be affixed with overlapping seals.

2.3 Certification of translations:

(a) All Vietnamese translations of documents must be certified to be correctly translated from the original as stipulated in clause (b) below before they shall be permitted to be used as official documents when conducting procedures for registration of an invention or utility solution;

(b) Certification of translations may be carried out by one of the following methods:

- Notarization;

- Certification by the underwriter (all the underwriters) or by the proxy of the underwriter of the original document;
- Recognition by the same body authorized to use the translation during the process of conducting the relevant procedures.

3. Persons conducting procedures for registration of an invention or utility solution in the name of the underwriter:

3.1 Only the persons stipulated in clauses 3.2 and 3.3 below shall be permitted to conduct procedures in the name of the underwriter for registration of an invention or utility solution with the National Office of Industrial Property and other competent bodies.

The National Office of Industrial Property and other competent bodies may only transact with the above mentioned persons and such transactions shall be deemed to be official transactions with underwriters.

3.2 Where underwriters are entitled to directly file applications and conduct the related procedures stipulated in articles 15.2 and 15.3(a) of the Decree, the following persons shall be permitted to conduct procedures in the name of the underwriter for registration of an invention or utility solution with the National Office of Industrial Property and other authorized bodies:

- (a) The individual or the legal representative of the individual (if the underwriter is an individual);
- (b) The legal representative of the underwriter; an individual who is a member of the underwriter and entrusted with representation by the legal representative of the underwriter; the head of the representative office or branch of the underwriter entrusted with representation by the legal representative of the underwriter (applicable to an underwriter which is a legal entity or to other underwriters);
- (c) The head of a representative office in Vietnam of a foreign underwriter entrusted with representation by that underwriter; the legal representative of an enterprise with one hundred (100) per cent foreign owned capital established in Vietnam of a foreign underwriter entrusted with representation by that underwriter;
- (d) Any person satisfying one of the conditions stated in clauses (a), (b) and (c) above who is one of the individuals or one of the legal entities or other underwriters if the underwriter consists of multiple individuals, legal entities or other underwriters and if that person is entrusted with representation by all individuals, legal entities or other underwriters.

3.3 Where underwriters are only entitled to file applications and conduct related procedures through an authorized industrial property representative service organization as stipulated in article 15.3(b) of the Decree, as well as where other underwriters conduct the above mentioned procedures through an authorized industrial property representative service organization, only the legal representative or the proxy pursuant to a power of attorney of the industrial property representative service organization which has power of attorney from the underwriter shall be permitted to carry out the work stipulated in clause 3.1 of this Circular.

4. Authorization for implementation of procedures for registration of an invention or utility solution:

4.1 The provision of authorization and the exercise of authorization to conduct procedures for registration of an invention or utility solution must comply with the provisions on civil contracts and on contracts of authorization in the Civil Code and with the provisions in this Circular.

4.2 Authorizations for implementation of procedures for registration of an invention or utility solution shall be made in writing (power of attorney) and shall include the following main particulars:

- (a) Full name and address of authorizing party;
- (b) Full name and address of authorized party;
- (c) Scope of authorization (tasks to be implemented by authorized party in the name of authorizing party);
- (d) Date on which power of attorney is granted;
- (dd) Signature and/or seal of the party granting the power of attorney;
- (e) Duration of authorization.

If a power of attorney does not specify any duration of authorization it shall be deemed to be valid for an indefinite term and its validity shall only be terminated when the authorizing party makes a declaration of termination of authorization.

4.3 The authorized party must be an individual entitled to implement the procedures for registration of an invention or utility solution as stipulated in clause 3.2 of this Circular, or an industrial property representative service organization.

4.4 The authorized party must submit the original power of attorney when conducting the procedures for registration of an invention or utility solution. All adjustments to the scope of authorization and early termination of authorization shall be notified in writing to the National Office of Industrial Property and other competent bodies, and shall only take effect as from the date the body receives such notice.

4.5 If the scope of authorization in a power of attorney includes tasks relating to a number of different procedures and the original power of attorney has already been submitted to the National Office of Industrial Property, then when carrying out subsequent procedures the authorized party must specify the number and date of the application file which contained the original power of attorney.

CHAPTER II

Applications and Dealing with Applications

Section I

Applications

5. Requirements on the form of applications:

5.1 Applications shall satisfy the following formal requirements:

- (a) All application documents must be prepared in Vietnamese, except for those which may be in other languages pursuant to clauses 5.2 and 5.3 of this Circular;
- (b) All application documents must be presented in portrait orientation (although pictures of drawings, diagrams and tables may be presented in landscape [i.e. A3] orientation) on single-sided paper of A4 size (210mm x 297mm) with twenty (20) millimetre wide margins from each of the four edges, except for supporting documents the originals of which are not included in the application.

Each page of the document describing the invention or utility solution (hereinafter referred to as the Description) regulated in clause 6.2(b) of this Circular may contain a maximum 450 words.
- (c) For documents required to be prepared in accordance with stipulated sample forms, it shall be mandatory to use such forms and to complete the appropriate items in the forms;
- (d) For documents consists of more than one page, each page shall be numbered consecutively using Arabic numbers;
- (e) Documents must be typed or printed clearly and neatly in non-fading ink without any erasure or correction;
- (f) Expressions [or terms] used in an application must be commonly used expressions; and all symbols, units of measurement and electronic fonts used in an Application must comply with Vietnamese standards;
- (g) An Application may enclose subsidiary data being an object containing an electronic file of some or all of the contents of the Application documents, presented in accordance with the regulations of the National Office of Industrial Property on the form of data.

5.2 The following documents may be prepared in languages other than Vietnamese but must be translated into Vietnamese:

- (a) Power of attorney;
- (b) Document certifying the lawful right to file an application if the applicant is the beneficiary of a right to file the application from another person (certificate of inheritance, certificate or agreement of transfer of right to file the application including transfer of an application already filed, contract for work assignment or labour agreement, and so forth);
- (c) Documents evidencing basis of entitlement to priority right (certification from the body which received the application in the case of a copy application

or first application; certificate of exhibition display, and so forth; certificate of transfer of priority right if such right was received from another person).

5.3 The following documents may be prepared in languages other than Vietnamese but must be translated into Vietnamese if the National Office of Industrial Property so requires:

- (a) Copy first application as evidence of the basis of entitlement to priority right;
- (b) Other documents which support the Application.

6. Requirements on the content of Applications:

6.1 An Application must ensure uniformity as stipulated in article 11.2 of the Decree. An Application shall be deemed to satisfy this requirement when it:

- (a) Requests protection of a single object; or
- (b) Requests protection of a group of objects which are related technically, expressing a single common creative intention and falling within the following circumstances:
 - One object is used in order to create (to produce, manufacture or compound) another object (for example, a material object or substance plus a method manufactures (compounds) a general material object or substance or one part of them);
 - One object is used in order to implement another object (for example a method plus a material object in order to implement such method in general or one stage of a method);
 - One object is used in order to use another object (for example a method plus a substance is used for such method; a method or a material object plus one part of it; use of a material object or substance in accordance with a new function plus a method of general use in accordance with such function);
 - Objects all belong to the same pattern with the same function in order to ensure the same result is achieved (plans to implement a technical solution).

6.2 Applications must include the following documents:

- (a) Declaration requesting issuance of a certificate of exclusive right to an invention or utility solution, prepared in accordance with the sample form in the appendix to this Circular;
- (b) Description, including Descriptive section, Request for protection, Drawings, diagrams, calculations and so forth (if necessary to clarify the nature of the technical solution stated in the Descriptive section);
- (c) Summary of the invention or utility solution (hereinafter referred to as the Summary);

(d) Power of attorney (if the application is filed by a representative);

(dd) Copy of first application or first applications or document certifying the exhibition display if the Application requests enjoyment of priority right in accordance with an international treaty;

(e) Voucher proving payment of application filing fee, application declaration fee and fee on request for enjoyment of priority right (if any such request), fee for examination of contents (if any such request) and fee for classification of invention or utility solution (if the Applicant has not made the classification).

6.3 The documents listed in clause 6.2 above shall be submitted at the same time. The following particular documents may be submitted within three months of the filing of an Application:

(a) The Vietnamese translation of the documents listed in clause 6.2(b) and (c) where the English version of such documents was included in the Application;

(b) The original of the document listed in clause 6.2(d), including the Vietnamese translation where a copy was included in the Application;

(c) The original of the document listed in clause 6.2(dd), including the Vietnamese translation, where the National Office of Industrial Property so requires.

6.4 If there are grounds (information or evidence) for doubting the reliability of information in the Application, the National Office of Industrial Property shall have the right to require the Applicant to file, within one month of the date of such requirement, documents verifying such information, and in particular documents verifying the lawful right to file an Application if the Applicant has received the right to file the Application from another person (certificate of right of inheritance, certificate or agreement of transfer of right to file the Application; contract for work assignment or labour agreement, and so forth); and results of the medicine [or drugs] listed in the Descriptive section tested on the human body, animals or plants (when the object to be protected is a pharmaceutical product used for people, animals or plants).

6.5 The Declaration shall specify the index for classification of the technical solution to be protected in accordance with the list of international classifications of inventions (in accordance with the Strasbourg Agreement). If the Applicant has not made a classification or has made an inaccurate classification then the National Office of Industrial Property shall make a classification and the Applicant shall pay a fee for classification services.

6.6 The Descriptive section in the Description must give a full disclosure of the nature of the technical solution which needs to be protected. The Descriptive section must contain complete information to the extent that, based on it, any person with average knowledge in the relevant technical field would be able to carry out that solution.

The Descriptive section must clarify the new characteristics and the degree of creativity (if the object to be protected is an invention) and the capability of applying the technical solution to be protected.

The Descriptive section shall include the following contents:

- (a) Name of the object to be protected (hereinafter referred to as the object) or of the main objects;
- (b) Field in which the technical solution is to be used or to which the technical solution is related;
- (c) Technical situation for the above field at the time of filing the application (similar objects already known), if any;
- (d) Nature of the object, including specifying the signs (special characteristics) which bring about the object and showing the new signs (special characteristics) in comparison with similar technical solutions which are already known;
- (dd) Brief description of drawings attached (if any);
- (e) Detailed description of plans for implementing the object;
- (f) Example of implementation of the object, if necessary;
- (g) Benefits (effectiveness) which can be achieved on use of the object, if any.

6.7 The Request for protection shall be used to determine the scope (quantity) of protection of an invention or utility solution. The Request for protection must be presented briefly and clearly in conformity with the descriptive section and drawings, and must comply with the following provisions:

- (a) The Descriptive section must illustrate the Request for protection in a complete way, that is it must express the request by providing a list of all the signs stated in the Descriptive section which are necessary and complete in order to be able to determine the object and in order to achieve the stated objective and in order to distinguish the object from other known objects.
- (b) The Request for protection shall not refer to the descriptive section and drawings, except where a reference is made to sections which cannot be accurately described in words such as nucleotide and amino acid sequence listings, refraction charts and status flowcharts.
- (c) The Request for protection must be written in one sentence and should (but it is not mandatory) be expressed in two sections: "restrictions section" and "differences section", in which:
 - The "restrictions section" shall include the name of the object and the signs which it has in common with the closest known object and shall be connected to the "differences section" by the expression "distinguishing points" or "points of special characteristics" or equivalent words;
 - The "differences section" shall include the signs differentiating the object from the closest known object and these signs shall be combined with the signs in the "restrictions section" to make up the object for which protection is sought.
- (d) The Request for protection may include one or a number of points, in

which a Request for protection which includes a number of points shall be used to:

- Present the object which needs to be protected with an initial point (referred to as the independent point), and a subsequent point (or points) used to supplement, clarify or develop the independent point (referred to as dependent points); or

- Present the group of objects which needs to be protected with a number of independent points, each independent point presenting an object which needs to be protected in that group, and each such independent point may also have its dependent points.

(e) Each point in the Request for protection shall be numbered consecutively using Arabic numbers, with a full stop at the end.

(f) A request for protection including a number of points used to present a group of objects must satisfy the following requirements:

- Independent points, presenting separate objects, may not refer to other points in the Request for protection, unless such reference permits avoidance of a complete repetition of the contents of another point;

- Dependent points must be presented immediately after the independent point on which they depend.

(g) If the Application contains drawings then signs in the Request for protection may be followed by numeric identifiers placed in brackets.

6.8 The Summary shall be used to announce briefly the nature of the invention or utility solution (not to exceed 150 application words). The summary must express the main contents of the technical solution for the purpose of information. The Summary may contain drawings and special formulae.

6.9 The Descriptive section, the Drawings, the Request for protection, the Summary and other documents in the Application must satisfy the detailed requirements with respect to form and contents in the regulations on applications and the order for conducting procedures for registration of an invention or utility solution issued by the Ministry of Science & Technology.

6.10 Requirements with respect to applications for an invention or utility solution concerning biotechnology:

(a) In addition to the general requirements applicable to the Descriptive section of an invention or utility solution stipulated in clause 6.6 above, in the case of any application for an invention or utility solution for a gene sequence or part of a gene sequence, the Descriptive section must contain a list of the gene sequence presented in accordance with the World Intellectual Property Organization standard ST.25 item 2(ii) (Standards for the presentation of nucleotide and amino acid sequence listings in patent applications).

(b) The National Office of Industrial Property may require an applicant to submit an electronic data file (such as a floppy disk or optical disk) in

computer readable form, on which is recorded the nucleotide and amino acid sequence listings which are identical with the sequence listing written in the Descriptive section.

(c) In the case of an invention or utility solution about (or relating to) biological materials which cannot be described or fully described to the extent that a person with average knowledge in the field of biotechnology would be able to carry out that invention or utility solution, then such invention or utility solution shall be deemed to have been fully disclosed if:

- Sample biological materials are filed and retained at the authorized archiving body pursuant to clause 6.11 of this Circular no later than the day on which the application is filed;

- The Descriptive section contains clear and essential information on the special characteristics of the biological materials which the Applicant may have ; and

- The declaration specifies the body retaining the biological materials, and the archiving symbol for the sample biological materials issued by the body where they are filed and retained, and data confirming this information is filed with the National Office of Industrial Property within a time-limit of 16 months from the priority date or no later than the date of filing a request for early announcement of the application (if any).

(d) If the Applicant is not the person filing biological materials for retention, the name and address of the latter person must be stated in the Declaration, and documents confirming lawful use of the biological materials must be filed with the National Office of Industrial Property within a time-limit of 16 months from the priority date or no later than the date of filing a request for early announcement of the application (if any).

6.11 Filing biological materials for retention:

(a) The objective of filing sample biological materials for retention is to service examination of the contents of an Application concerning biological materials.

(b) Sample biological materials must be filed with the authorized body for retention no later than the date of filing an Application concerning biological materials.

(c) The body (as appointed by the Ministry of Science & Technology) for receipt and retention of sample biological materials shall accept such samples from the Applicant and shall retain the samples in accordance with regulations issued by the Ministry of Science & Technology.

Section 2

Filing and Accepting Applications

7. Filing applications:

Applications may be filed at the National Office of Industrial Property or at any other locations for receipt of Applications established by the National Office of Industrial Property. Applications may also be sent by registered post to the above locations.

8. Accepting applications:

8.1 After receiving an Application, the National Office of Industrial Property shall carry out the following:

- (a) Check the list of documents stated in the Declaration;
- (b) Note any differences between the list of documents stated in the Declaration and the actual number of documents in the Application;
- (c) Carry out preliminary examination of the Application to make a conclusion on acceptance or rejection in accordance with clause 8.2 below, and if the Application is accepted then seal the Declaration with certification of the date of filing of the Application;
- (d) Issue the applicant with a receipt for the application sealed with certification of the date of filing of the Application, the number of the Application and the result of checking the list of documents, the receipt to bear the full name and signature of the staff member accepting the Application.

8.2 The National Office of Industrial Property shall not accept an Application which lacks one of the following mandatory documents:

- (a) Declaration containing information being the name and address of the applicant;
- (b) Description containing Request for protection;
- (c) Voucher proving payment of application filing fee.

8.3 In a case where an Application is not accepted, the National Office of Industrial Property shall, within a time-limit of 15 days from the date of receipt of the Application, notify the applicant in writing of the reasons therefore and fix a time-limit of 2 months from the date of the notice for the Applicant to rectify the deficiencies.

If the Applicant in fact files all the documents stipulated in clause 8.2 above within the stipulated 2 months, the Application shall be deemed accepted on the date all such documents are filed.

In a case where an Application is not accepted, the National Office of Industrial Property need not return the Application documents to the Applicant, but shall refund fees paid in accordance with the procedures on refund of fees set out in this Circular.

Section 3

Examination of Form of Applications

9. Objective and contents of examination of form:

Examination of the form of an Application means an inspection of compliance with the provisions on the form of an Application in order to reach a conclusion on whether or not the Application is deemed proper.

A proper Application shall be considered for acceptance and an improper Application shall be refused (not considered for acceptance).

10. Proper Application:

10.1 An Application shall be deemed proper if it does not fall within one of the following cases:

(a) The application is prepared in languages other than Vietnamese, except for the cases stipulated in clauses 5.2 and 5.3 of this Circular;

(b) There is insufficient information in the Declaration about the author, the applicant or the representative, or the applicant or representative has not signed and/or sealed [the Declaration];

(c) There are grounds for confirming that the applicant does not have the right to file an application;

(d) The Application is filed inconsistently with the provisions in article 15 of the Decree;

(dd) The Applicant fails, within the time-limit stipulated in clause 6.3 of this Circular, to submit the Vietnamese version of the Description and Summary which were prepared in English;

(e) The power of attorney is not filed within the time-limit stipulated in clause 6.3 of this Circular;

(f) The Application has the deficiencies stipulated in clause 11 below which affect its validity, and the Applicant fails to rectify or satisfactorily rectify the deficiencies despite a request from the National Office of Industrial Property to do so;

(g) There are grounds for immediate confirmation that the object stated in the Application is clearly an object not to be protected by the State as stipulated in article 787 of the Civil Code and in article 4.4 of the Decree.

10.2 With respect to an Application with a number of objects, if the Application falls within the cases stipulated in clauses 10.1(g), 11(a) and 11(d) of this Circular and the deficiencies do not relate to all the objects in the Application then it shall be deemed partially improper (applicable to the deficient objects) but proper with respect to the remaining objects.

11. Dealing with deficiencies of Applications at the stage of examination of form:

11.1 The following deficiencies of Applications may be corrected at the stage of examination of form:

- (a) An application which lacks uniformity;
- (b) An application which fails to satisfy the requirements on the form of presentation;
- (c) The information about the Applicant in different documents is inconsistent or has been erased or has not been correctly certified in accordance with the regulations;
- (d) The following fees have not been paid in full: application filing fee, fee for announcement of the application, and fee for classification of technical solution (if the National Office of Industrial Property makes the classification).

11.2 The National Office of Industrial Property shall notify the Applicant of the deficiencies stipulated in clause 11.2, which the Applicant must rectify within a time-limit of 2 months from the date of the notice.

12. Determination of the date of filing an application:

12.1 The date of filing an Application shall be the date on which the Application reached the National Office of Industrial Property as indicated by the receipt seal on the Declaration.

12.2 With respect to international applications appointing or selecting Vietnam and which satisfy the requirements stipulated in clauses 58 or 59, the date of filing the Application shall be the date on which the international application is filed.

13. Determination of priority date:

13.1 If an Application does not include a request for priority right, or if an Application contains a request for priority right but the National Office of Industrial Property does not approve the request, the priority date shall be the date of filing the Application.

13.2 If an Application includes a request for priority right, the priority date (or priority dates) shall be the date stated in the request and approved by the National Office of Industrial Property.

14. Notice of approval of Application:

If an Application is deemed proper, the National Office of Industrial Property shall send the applicant a notice approving the Application as proper. The notice shall specify the name and address of the Applicant, the name of the industrial property representative service organization (if the application is filed through such organization), the name of the object stated in the Application, the date of filing the application and the number of the application, and the priority date of the Application. The notice shall also specify reasons if a request for priority right is not approved.

15. Refusal to approve an Application:

If an Application is deemed improper, the National Office of Industrial Property shall send the applicant a notice of intention to refuse approval of the application. The notice shall specify the deficiencies which result in the Application being deemed improper, and shall fix a time-limit of 2 months

from the date of the notice for the Applicant to provide its opinion on the intention to refuse approval of the Application.

If the Applicant does not provide an opinion on the intention to refuse approval of the application or provides an unmeritorious opinion, the National Office of Industrial Property shall issue an official notice of refusal to approve the application and on the request of the Applicant shall refund the fee paid for examination of form.

16. Time-limit for examination of form of Applications:

16.1 The time-limit for examination of form shall be one month from the date of filing an application. In the case of an Application where additional documents as stipulated in clause 6.3 of this Circular are filed, the time-limit for examination of form shall be one month calculated from the date of filing such additional documents.

16.2 If during the course of examination of form of an Application the Applicant, either on its own initiative or at the request of the National Office of Industrial Property, amends or supplements documents, the time-limit for examination of form shall extend an extra 15 days. If an Application is amended or supplemented at the request of the National Office of Industrial Property, the period which was reserved for the Applicant to amend or supplement documents shall not be included in the time-limit for examination of form.

Section 4

Announcement of Applications

17. Announcement of proper Applications:

Any Application and any international Application which has been approved as proper shall be announced by the National Office of Industrial Property in the Official Industrial Property Gazette, and the Applicant must pay the fee for announcement of the Application.

18. Time-limit for announcement of Applications:

18.1 Applications shall be announced in the nineteenth month from the priority date, except for the cases stipulated in clauses 18.2, 18.3 and 18.4 below.

18.2 An Application which contains a request for early announcement shall be announced in the second month from the date the National Office of Industrial Property accepts such request or from the date the Application is approved as proper, whichever date is the later.

18.3 In the case of an Application which contains a request for examination of the filed contents prior to the date the Application is approved as proper, the Application shall be announced in the second month from the date the Application is approved as proper.

18.4 In the case of an Application which contains a request for examination of the filed contents after the date the Application is approved as proper but prior to the expiry of 18 months from the priority date, the Application shall be announced in the second month from the date the National Office of Industrial Property accepts such request.

18.5 An international Application shall be announced in the second month from the date it is approved as proper.

19. Contents of announcements of Applications:

The information relating to proper Applications to be announced in the Official Gazette shall comprise: all information about a proper Application set out in the Notice of approval of the application as proper, information about transfer of an Application, information about division of an Application and so forth, the Summary, and one or more drawings (if any).

20. Access to detailed information about proper Applications:

Any person may have access to information about the nature of objects stated in Applications, or may request the National Office of Industrial Property to supply such information and the person making the request shall pay a fee in accordance with the regulations.

Section 5

Examination of Contents of Applications

21. Request for examination of contents of inventions and utility solutions:

21.1 Within a time-limit of 42 months from the priority date of Applications in respect of inventions and 36 months from the priority date of Applications in respect of utility solutions, the Applicant or any third person may request the National Office of Industrial Property to conduct an examination of contents of the relevant invention or utility solution. If there is a proper reason, the time-limit for filing a request for examination of contents may be extended but by no more than 6 months.

Any person requesting an examination of contents of an invention or utility solution shall pay a fee for references and a fee for examination of contents in accordance with the regulations. If the request for examination of contents is filed later than the stipulated time-limit, the person making the request shall pay an additional extension fee (for late filing). If the fee for references and the fee for examination of contents are not paid, the request made to the National Office of Industrial Property to conduct an examination of contents shall be deemed invalid.

21.2 Requests for examination of contents of an invention or utility solution filed after the announcement of applications shall be announced in the Official Industrial Property Gazette in the second month from the date of receipt of such written request, and shall be notified to the Applicant.

Requests for examination of contents of an invention or utility solution filed prior to the announcement of applications shall be announced at the same time as the relevant Applications in accordance with clauses 18.3 and 18.4 above.

21.3 Except where an Applicant includes a Request for examination of contents in the Declaration, any Request for examination of contents of an invention or utility solution must be made in writing on the sample form in the appendix to this Circular, and must include a voucher proving payment of the fee for references and the fee for examination of contents.

21.4 If a Request for examination of contents is not filed within the time-limit stipulated in clause 21.1 of this Circular, the Application shall be deemed to have been withdrawn as at the expiry of such time-limit.

22. Purpose of examination of contents:

The purpose of examination of the contents of an Application shall be to evaluate the possibility of protection of the object stated in the Application in accordance with protection criteria and to determine the respective scope (quantity) of protection.

23. Use of results of information from references during the process of an examination of contents:

23.1 When conducting an examination of contents, the National Office of Industrial Property shall refer to information in the minimum information sources stipulated in clause 34.2 of this Circular in order to make comparisons and assess the object stated in an Application in accordance with protection criteria.

23.2 When conducting an examination of contents of an Application with priority right, the National Office of Industrial Property may use results of information from references and results of examination of the corresponding Application filed overseas. The applicant may provide the National Office of Industrial Property with the following information to assist an examination of contents:

- (a) Results of information from references or of examination of the Application filed overseas for the object stated in an Application;
- (b) Copy patent or other certificate of protection already issued on the basis of the Application filed overseas for the object stated in an Application;
- (c) Documents relevant to the technical status for the object stated in an Application and issued to the applicant by an overseas patent authority.

24. Consideration of the opinion of third parties:

During the process of conducting an examination of contents of an Application, the National Office of Industrial Property must consider the opinion of third parties (if any) which support or oppose the issuance of a Certificate of protection. The National Office of Industrial Property must notify any third party of whether or the third party's opinion is accepted, and must specify reasons if the opinion is not accepted.

25. Requests to correct formal deficiencies and to explain contents of Applications:

25.1 During the process of conducting an examination of contents of an Application, the National Office of Industrial Property shall have the right to require the applicant to explain contents of Application documents or to correct formal deficiencies of the Application. If the applicant fails to satisfy the request, the Application shall be deemed to have been withdrawn and consideration of the Application shall discontinue.

25.2 The National Office of Industrial Property shall not require the applicant to provide information beyond the scope of the nature of the object stated in the Application, and in

www.wincolaw.com

particular shall not require the provision of information which the applicant wishes to remain confidential.

25.3 Any amendment or addition to Application documents must be made by the applicant himself. The National Office of Industrial Property shall not be permitted to [itself] make the above-mentioned amendments or additions.

26. Suspension of examination of contents:

26.1 An examination of contents shall be suspended in the following circumstances:

(a) The application does not clearly express the nature of the object: the documents concerning the nature of the object such as the Description and Request for protection lack information to the extent that it is impossible to define the nature of the object, or the information about the nature of the object is unclear, inappropriate, non-specific or inconsistent to the extent that it is impossible to define the object;

(b) The object is inconsistent with the request for issuance of a patent for an invention or utility solution, or the object is an object which is not protected by the State as stipulated in article 787 of the Civil Code and in article 4.4 of the Decree;

(c) The applicant requests suspension of examination of contents or provides a declaration of withdrawal of the Application.

26.2 The National Office of Industrial Property must notify an Applicant of any suspension of examination of contents and the reasons for such suspension by conducting the same procedures which apply to notice of results of an examination of contents (unless it was the Applicant who requested the suspension).

27. Complaints about suspensions; re-establishment of an examination of contents:

27.1 An Applicant shall have the right to lodge a complaint about suspension of an examination of contents and the National Office of Industrial Property shall deal with the Applicant's complaint in accordance with the procedures in section 3 of Chapter 4 of this Circular.

27.2 If the result of resolution of an Applicant's complaint shows the complaint was justified, the National Office of Industrial Property shall re-establish the examination of contents and in such a case the National Office of Industrial Property shall not be permitted to extend the time-limit for the examination of contents.

28. Contents of and order for assessment of objects in accordance with protection criteria:

28.1 The contents of an assessment of an object in accordance with protection criteria shall be a determination of whether or not the object stated in the Application is consistent with the request for the issuance of a Patent for the invention or utility solution, and if consistent then the object shall be assessed pursuant to each protection criteria in turn.

28.2 The assessment in accordance with protection criteria shall be conducted for each object in turn (if the Application contains a number of objects and uniformity has been ensured), and

each object shall be assessed pursuant to each protection criteria in turn as stipulated in detail in Chapter 3 of this Circular.

An assessment shall be conducted of each point stated in the Request for protection.

28.3 The assessment of each object shall be terminated if:

(a) There are grounds for concluding an object does not satisfy one of the protection criteria, or

(b) There are no grounds for concluding an object does not satisfy any one of the protection criteria.

In case (a) the examination of contents shall terminate with the conclusion that the object does not satisfy the protection criteria, and in case (b) the examination of contents shall terminate with the conclusion that the object does satisfy the protection criteria.

29. Notice of results of examination of contents:

29.1 The National Office of Industrial Property must notify an Applicant and anyone requesting an examination of contents of an Application of the results of the said examination, specifying which object satisfies the protection criteria and which object fails to satisfy the protection criteria.

29.2 If an object stated in the Application is inconsistent with the request for the issuance of a Patent for an invention or utility solution, or if the object is consistent but fails to satisfy the protection criteria, the notice of results of the examination of contents shall specify an intention to refuse issuance of a Patent the reasons for refusal, and shall also fix a time-limit of 2 months from the date of the notice for the Applicant to provide its opinion. If the scope (quantity) of protection is too wide, the notice must also specify the reasons therefor and indicate an intention to narrow the scope (quantity) of protection.

29.3 If an object satisfies the protection criteria but the Application contains deficiencies then the notice of results of the examination of contents shall specify such deficiencies, fix a time-limit of 2 months from the date of the notice for the Applicant to provide its opinion or to rectify the deficiencies, and indicate an intention to refuse issuance of a Patent if the applicant fails to rectify the deficiencies to the extent required or fails to provide a legitimate reason opposing [such intention].

29.4 If an object satisfies the protection criteria, or if in the cases stipulated in clauses 29.2 and 29.3 above the Applicant has narrowed the scope (quantity) of protection so that the object now satisfies the protection criteria, or if the Applicant has rectified deficiencies and/or provided a legitimate reason opposing [the intention], then the notice of results of the examination of contents (or the second notice of results of the examination of contents in the cases stipulated in clauses 29.2 and 29.3 above) shall fix a time-limit within which the Applicant should pay the fee for announcement of a Patent, the registration fee and the fee for maintaining the validity of the Certificate for the first year. The above time-limit shall be 2 months from the date of the notice.

29.5 If within the fixed time-limit the Applicant fails to rectify deficiencies or fails to rectify the deficiencies to the extent required and/or fails to provide an opinion opposing [the

intention] or fails to provide a legitimate reason opposing [the intention], then the National Office of Industrial Property shall refuse to issue a Patent.

Where the notice of results of the examination of contents fixes a time-limit for payment of fees as prescribed in clause 29.4 above but the Applicant fails to pay within time the fee for announcement, the registration fee and the fee for issuance of a certificate of protection, then the National Office of Industrial Property shall refuse to issue a Certificate of protection. If the Applicant pays the fee for announcement, the registration fee and the fee for issuance of a Certificate of protection in time but fails to pay the fee for maintaining the validity of the Certificate for the first year, then a Certificate of protection shall be issued but its validity shall be suspended pursuant to article 28.2(b) of the Decree.

29.6 If an Application contains a number of objects only one of which falls within the category in clause 29.5 above, then the refusal to issue a Certificate of protection shall only apply to that one object and a Certificate of protection shall be issued for the remaining objects. In order to be issued with a Certificate of protection, the Applicant must amend the Description with respect to the remaining objects which satisfy the requirements stipulated in clause 6 above.

30. Time-limits for examination of contents:

30.1 The time-limit for examination of contents of an Application shall be twelve months from the date of receipt of a Request for examination of contents (if such Request is filed after the date of announcement of the Application) or from the date of announcement of the Application (if the Request is filed prior to the date of announcement of the Application).

30.2 If during the process of conducting the examination of contents of an Application the Applicant on its own initiative or at the request of the National Office of Industrial Property amends or supplements documents, the time-limit for examination of contents of an Application shall be extended by one month. If an application is amended or supplemented at the request of the National Office of Industrial Property, the period which was reserved for the Applicant to amend or supplement documents shall not be included in the time-limit for examination of contents.

30.3 Prior to the last day of the time-limit for examination of contents, the National Office of Industrial Property shall send notice of the results of the examination of contents to the Applicant and to the person who requested the examination of contents in accordance with clause 29 [i.e. 29.1] of this Circular.

Section 6

Amendment of Applications

31. Amendment, addition, division, assignment and conversion of Applications:

31.1 Prior to the National Office of Industrial Property providing notice of refusal to approve an Application or notice of refusal to issue a Certificate of protection or prior to the National Office of Industrial Property issuing a decision to issue a Certificate of protection, an applicant may amend or add to the Application documents either on its own initiative or at the request of the National Office of Industrial Property, including dividing the Application (by separating one or more of the technical solutions in the Application for an invention or utility solution and transferring it or them to one or more new Applications, referred to as a divided Application).

The applicant shall file a set of documents as amended (to replace the original version) together with an explanation of the amendments compared to the original version, and shall also pay a fee in accordance with the regulations.

31.2 Any amendment or addition to the Application documents may not extend the scope (quantity) of protection beyond the contents disclosed in the Descriptive section, may not change the nature of the object stated in the Application and must ensure uniformity of the Application. If amendments or additions extend the scope (quantity) of protection or change the nature of the object, then the Applicant must file a new Application and all procedures must be re-conducted from the beginning.

31.3 Divided Applications shall retain the original date of filing the Application and the original priority date. With respect to each divided Application, the application filing fee and all other fees shall be calculated as if no application filing fee was paid on the original Application and as if all procedures are carried out independently of the original Application. Divided Applications shall be dealt with the same as new Applications but shall not be announced if they were divided after announcement of the initial Application. The date of filing a request to divide an Application shall be deemed to be the date of amendment and addition to the initial Application for the purpose of calculating the time-limit for examination of contents of the initial Application. The initial Application (after it has been divided) shall continue to be dealt with in accordance with the usual procedures and the applicant must pay a fee for amendment and addition to an application.

31.4 An Applicant may request recognition of a change of the Applicant's name and address and a change of Applicant (assignment of Application or transfer of rights to the Application as a result of inheritance, merger or demerger of a legal entity, or pursuant to a court verdict and so forth). Any request for recognition of a change shall be made in writing and the Applicant must pay a fee in accordance with the regulations. One letter may request recognition of one item of change which concerns a number of Applications, on condition that the Applicant must pay a fee for each of the Applications.

31.5 In the case of conversion from Application for an invention to Application for utility solution and vice versa pursuant to article 13 of the Decree, procedures for the initial Application which have not yet been carried out shall continue to be conducted pursuant to the converted Application. The date of converting the Application shall be deemed to be the date of amendment and addition to the Application for the purpose of calculating the time-limit for examination of contents of the converted Application.

A request for conversion from Application for an invention to Application for utility solution pursuant to article 13.2 of the Decree shall only be approved when there has been a refusal to issue a Certificate of exclusive right on the ground that the technical solution is not creative.

CHAPTER III

Assessment of Objects in accordance with Protection Standards

32. Assessment of whether objects stated in Applications are consistent with the request for the issuance of a Certificate of exclusive right to the invention or utility solution:

32.1 An object stated in an Application shall be deemed inconsistent with the request for the issuance of a Patent Certificate for an invention or a Patent Certificate for a utility solution if such object is not a technical solution or is not the use of a technical solution.

32.2 Technical solutions - objects to be protected as an invention or utility solution:

(a) A technical solution - object to be protected under the title of invention or utility solution means a collection of the necessary and complete information about a technical model or technical means aimed at resolving a stipulated problem.

(b) A technical solution may and may only belong to one of the following patterns:

- A technical solution in the form of a material body (an instrument, a piece of machinery or equipment, an electronic component, an electrical circuit and so forth) expressed as a collection of information which establishes that a product has been created which has special characteristics by virtue of signs (special points) regarding its structure, and such product has a function (utility) such as a facility/means which satisfies a specific human need;

- A technical solution in the form of matter (materials, a substance, a foodstuff, a drug/pharmaceutical product and so forth) expressed as a collection of information which establishes that a product has been created which has special characteristics by virtue of signs (special points) regarding its presence, the proportion and state of its elements, and with a function (a utility) such as a facility/means which satisfies a specific human need;

- A technical solution in the form of biological materials (genes; genetically modified plants or animals and so forth) expressed as a collection of information about a product containing information [and] genetically modified by human act, with the ability to self-reproduce;

- A technical solution in the form of a process (an industrial process; a diagnostic method, a method of making forecasts, an inspection method, a processing method and so forth) expressed as a collection of information which fixes a means of carrying out a process, a specific item of work which has special characteristics by virtue of signs (special points) regarding its order, conditions, methods and means for implementing an operation aimed at achieving a specific goal.

(c) A technical solution which only differs from other technical solutions by virtue of its function (utility) or use objective may also be deemed to be a different technical solution.

(d) In the following circumstances, an object stated in an Application shall not be deemed to be a technical solution:

- The object stated in the Application is only an idea or intention which has been raised, it is not a means of resolving a problem and does not provide an answer to the questions "in what way?" and/or "by what means?".

- The problem raised for resolution is not a technical issue and cannot be resolved by technical models (for example all types of rules and laws, games, mathematical or physical specifications; methods and systems of organization, of management, training or coaching; language systems; methods of arrangement of information; sketches of territorial master planning; forms of

the external appearance of products which are only in the nature of aesthetics, and so forth).

- Natural products or products which are distributed naturally and which are not products which have been created by people.

33. Assessment of whether technical solutions are capable of being applied:

33.1 Pursuant to article 4.3 of the Decree, a technical solution shall be deemed capable of being applied if, on the basis of the information about the nature of the solution in the Description, it may be implemented and the results described in the Description may be obtained.

33.2 A technical solution stated in an Application shall be deemed "capable of being implemented" if:

(a) The information about the nature of the solution together with instructions and essential technical conditions is expressed clearly and fully to the degree that it permits a person with average knowledge in the relevant technical field to create, produce and/or to use, operate and/or carry out that solution.

(b) The creation, production, use, operation or carrying out a solution as mentioned above may be repetitive producing the same result and producing a result which is the same as that set out in the Description.

33.3 In the following circumstances a technical solution shall be deemed incapable of being applied:

(a) The nature of the object or the instructions aimed at implementation of the object are contrary to basic scientific principles (for example they are contrary to the principle of preservation of energy, and so forth);

(b) The object contains elements or components which have no technical relationship with each other or which are incapable of being related (by joining, binding, hinging on and so forth);

(c) The object contains internal contradictions;

(d) The instructions can only be applied to the object on a number of limited occasions (they cannot be implemented repetitively);

(dd) In order to implement the solution, the person implementing same must have special skills which are incapable of being transmitted or taught to another person;

(e) Inconsistent results are obtained on different occasions of implementing the solution;

(f) Results are obtained which are different from those stated in the Application;

(g) The most important instructions for implementing the solution are missing;

(h) With other legitimate reasons.

34. Assessment of the novelty of technical solutions:

34.1 A technical solution shall be deemed to be new if it satisfies the conditions set out in article 4.1 of the Decree.

34.2 Minimum mandatory information sources:

(a) In order to assess the novelty of a technical solution stated in an Application, reference must be made to at least the information in the following mandatory sources (without limiting the reference to such minimum sources):

- All other Applications accepted by the National Office of Industrial Property with the same classification index number as that of the object stated in the Application, calculated to the delaminating/layering stratification index number (third class index number) and which have a priority date earlier than the priority date of the Application, except for Applications which have not or will not be announced;

(b) In necessary and possible cases, reference is extended to scientific reports and to reports on the results of research programs and topics and so forth, within the same technical field which have been proclaimed and archived at the National Centre for Scientific and Technological Information.

34.3 Objective of references; report on references:

(a) The objective of referring to information shall be in order to find technical solutions with a similar or overlapping nature to the technical solution stated in the Application, in which:

- Two technical solutions overlap if all the basic signs (special characteristics) overlap or are equivalent to each other (can be replaced by each other);

- Two technical solutions are similar if the majority of the basic signs (special characteristics) overlap or are equivalent to each other (can be replaced by each other);

- "The confronting technical solution" means the nearest overlapping or similar technical solution to the technical solution stated in the Application.

(b) The result of a reference to information shall be expressed in a Reference Report specifying the field in which reference was made, the scope of the reference and the results found (statistics on the confronting solution found, details on overlapping signs and on information sources, the date on which any relevant information was announced), and the Report shall bear the full name of the person preparing it (the person who conducted the references).

34.4 Conclusion on the novelty of a technical solution:

(a) In order to assess the novelty of the technical solution stated in the Application, it shall be necessary to conduct a comparison of the basic signs

(special characteristics) of the technical solution with the basic signs of the confronting technical solution found during the course of reference to information, in which:

Basic signs of a technical solution means its special characteristics regarding function, utility, structure, interrelation, composition and so forth which together with other basic signs create a necessary and complete collection in order to determine the nature (contents) of the object (including its function and utility);

The basic signs of the technical solution stated in the Application [and] in Patents for inventions shall be expressed in the Request for protection of the invention or utility solution. The basic signs of the technical solution stated in the other documents shall be expressed and discovered pursuant to documents describing or presenting the actual appearance of such technical solution.

(b) The same as a point in the Request for protection, the technical solution stated in the Application shall be deemed to be new in comparison with the world technical level if:

- A confronting technical solution is not found during the course of reference to information; or
- A confronting technical solution is found but the technical solution stated in the Application has at least one basic sign which does not appear in the confronting technical solution (which sign shall be referred to as a distinct basic sign).

35. Assessment of the level of creativity of technical solutions:

35.1 The technical solution stated in an Application shall be deemed to be creative if it satisfies the conditions set out in article 4.2 of the Decree. An assessment of the level of creativity of the technical solution stated in an Application shall be conducted in accordance with the provisions in this clause.

35.2 Minimum mandatory information sources:

When assessing the level of creativity of a technical solution, reference must be made to at least the information in the minimum mandatory information sources (without limiting the reference to such minimum sources) stipulated in clause 34.2 of this Circular.

35.3 Assessment of the level of creativity:

(a) An assessment of the level of creativity of the technical solution stated in an Application shall be conducted by assessing the signs/distinct basic signs stated in the Request for protection in order to deliver a conclusion:

- Whether or not the signs/distinct basic signs are deemed to have been disclosed in the minimum mandatory information sources, and
- Whether or not the collection/distinct basic signs are deemed self-evident.

(b) Assessing in turn each point in the Request for protection, the technical solution shall be deemed to be creative if the inclusion of the distinct basic signs into the collection of basic signs of the technical solution is the result of a creative act and not a self-evident result of average knowledge in the relevant technical field.

(c) In the following circumstances (but not only in such circumstances) and assessing each point in the Request for protection, a technical solution shall be deemed not to be creative:

- If the collection of distinct basic signs is self-evident (any person with average knowledge in the relevant technical field would know that in order to implement the stated function or in order to achieve the stated objective it is necessary to use a collection of such signs, and vice versa that use of that collection of signs would of necessity achieve the objective or exercise the relevant function);
- If the collection of distinct basic signs has already been disclosed in an identical or equivalent form in one or some other technical solutions which is or are known from the minimum mandatory information sources;
- If the technical solution is a simple combination of known technical solutions with functions, objectives and effects which are also the simple combination of functions, objectives and effects of known technical solutions.

(d) In this clause:

- Two signs shall be deemed identical if they have the same nature;
- Two signs shall be deemed equivalent to each other if their nature is equivalent, if they have the same objective and the same way of achieving their basic objective.

36. Conclusion on whether technical solutions are capable of being protected; determination of scope (quantity) of protection:

If there is a reason for confirming that the technical solution stated in an Application fails to satisfy at least one of the protection standards, the technical solution shall be deemed incapable of being protected and the National Office of Industrial Property shall refuse to issue a Patent Certificate for an invention or utility solution. In the opposite case, the technical solution shall be deemed capable of being protected and the National Office of Industrial Property shall approve issuance of a Patent Certificate for an invention or utility solution with a scope (quantity) of protection corresponding to that fixed by the Request for protection.

CHAPTER IV

Issuance, Registration, Suspension, Rescission of Effectiveness of Certificates of Protection, and Complaints about Certificates of Protection

Section 1

Issuance and Re-issuance of Certificates of Protection and Copies of Certificates of Protection

37. Issuance of Certificates of protection:

37.1 Within a time-limit of 10 days from the date an Applicant pays all the fees stipulated in clause 29.4 on time, the National Office of Industrial Property shall conduct procedures for issuance of a Certificate of protection pursuant to articles 23 and 26 of the Decree.

If after being issued with a Certificate of protection the owner considers the Certificate contains an error, the owner shall have the right to request the National Office of Industrial Property to amend the Certificate. If the error was the fault of the owner, the owner shall pay a fee for amendment. If the error was the fault of the National Office of Industrial Property, the owner need not pay any fee. The above-mentioned amendment shall not change the nature, object or scope (quantity) of protection.

37.2 As from the date the National Office of Industrial Property issues a decision to issue a Certificate of protection, the applicant shall not be permitted to assign the Application to another person. If a contract of assignment of the Application has been signed between the applicant and another person but procedures have not yet been conducted at the National Office of Industrial Property, such contract must be converted to a contract of transfer of invention/utility solution rights pursuant to a new Certificate of protection which is recognized.

38. Right to request issuance and re-issuance of copies of Certificates of protection and right to request re-issuance of Certificates of protection:

38.1 If industrial property ownership is general ownership and the National Office of Industrial Property is unable to hand over Certificate/s of protection to the owners in common pursuant to article 26.3 of the Decree , the owners may file an application with the National Office of Industrial Property for issuance of a Copy certificate of protection on condition that they pay a fee for same.

38.2 In the following circumstances an industrial property owner who has been issued with a Certificate of protection (including a Copy certificate of protection) may file an application with the National Office of Industrial Property for re-issuance of a Certificate of protection or Copy certificate of protection on condition that the owner pays a fee for same:

(a) Where a Certificate of protection or Copy certificate of protection has been lost, on condition that a legitimate reason is provided;

(b) Where a Certificate of protection or Copy certificate of protection has been damaged (torn, smeared or faded to the extent it is no longer useable) on condition that the damaged certificate is handed in.

39. Application files requesting issuance or re-issuance of copies of Certificates of protection and requesting re-issuance of Certificates of protection:

An application file requesting issuance or re-issuance of a copy Certificate of protection or requesting re-issuance of a Certificate of protection shall comprise:

- (a) Declaration requesting issuance or re-issuance of a copy Certificate of protection or requesting re-issuance of a Certificate of protection (prepared in accordance with the sample form in the appendix to this Circular);
- (b) Written explanation of the reason why the Certificate or copy Certificate was lost or destroyed (in the case of a request for re-issuance of a Certificate or copy Certificate);
- (c) Power of attorney (if the application is filed by a representative);
- (d) Voucher proving payment of fee for issuance of a Certificate or copy Certificate.

40. Processing application files requesting issuance or re-issuance of copies of Certificates of protection and requesting re-issuance of Certificates of protection:

40.1 The National Office of Industrial Property shall consider application files requesting issuance or re-issuance of copies of Certificates of protection and requesting re-issuance of Certificates of protection within one month from the date of their receipt. Where a file satisfies the requirements set out in clause 39 of this Circular, the National Office of Industrial Property shall issue a decision to issue or re-issue a copy Certificate of protection or a decision to re-issue a Certificate of protection and record it in the relevant chapter on registration of the particular Certificate of protection in the National Register.

40.2 The contents of a copy Certificate of protection shall fully record all information from the corresponding Certificate of protection. The contents of a re-issued Certificate of protection or copy Certificate of protection shall fully record all information from the initially issued certificate and shall be marked "Copy document" or "Re-issued document".

40.3 If an application file fails to satisfy the requirements set out in clause 39 of this Circular, the National Office of Industrial Property shall issue a notice of refusal to issue a copy Certificate of protection or a notice of refusal to re-issue a Certificate of protection, specifying the reasons therefor.

Section 2

National Register, Announcement of Decisions to Issue Certificates of Protection

41. National register of inventions and utility solutions:

41.1 The national register (Register) of inventions and utility solutions shall be the official and publicly available database which records complete information on the legal status of industrial property rights applicable to inventions and utility solutions which have been certified by the State.

41.2 The Register of inventions and the Register of utility solutions shall include items relating to each Certificate of protection, each item to include:

- (a) Information on the Certificate of protection (number, date of issuance, name of object protected, scope (quantity) of protection, duration of effectiveness, name and address of the owner of the Certificate and full name of the author);

(b) Information on the Application requesting issuance of the Certificate of protection (number of Application, date of filing, priority date, and name of any industrial property representative service organization);

(c) All the information about amendments to the Certificate of protection, the status of its effectiveness (maintained effectiveness, suspended effectiveness, rescinded effectiveness, reinstated effectiveness); transfer of ownership of or of use right to the invention or utility solution; date of issuance or re-issuance of copy Certificate of protection or date of re-issuance of Certificate of protection and name of person issuing same.

41.3 The National Office of Industrial Property shall establish the Registers and shall archive material in paper, electronic or other forms. Any person may make reference to an electronic Register (if any) or request the National Office of Industrial Property to issue a copy of the Register (quoting items in the Register), and the applicant shall pay a fee for provision of a copy document.

42. Announcement of decisions to issue Certificates of protection:

Every Certificate of protection which is issued by the National Office of Industrial Property shall be announced in the Official Industrial Property Gazette within 2 months of the date of the Decision [on issuance]. The Applicant must pay a fee for the announcement.

The information to be announced shall be all the information in the Decision and the Summary, and one or a number of photos or drawings (if any).

Section 3

Complaints about Procedures for Issuance of Certificates of Protection

43. Who has the right to complain, the object of a complaint and the limitation period for lodging complaints:

43.1 The persons with the right to complain as prescribed in article 27.1 of the Decree within the limitation period prescribed in article 27.3 of the Decree shall have the right to conduct compliant procedures in respect of Notices of official refusal and Decisions by the National Office of Industrial Property concerning registration of inventions and utility solutions.

43.2 The limitation period for lodging first complaints as prescribed in article 27.3 of the Decree shall be applied consistently with article 31 of the Law on Complaints and Denunciations namely 90 days calculated from the date on which the person entitled to lodge a complaint receives or is aware of a Notice or Decision by the National Office of Industrial Property refusing to approve an Application or on issuance or refusal to issue a Certificates of Protection.

44. Complaint files:

44.1 General requests:

Complaint files must satisfy the formal requirements stipulated in clauses 5.1(a) to 5.1(e) inclusive of this Circular, and each complaint shall mention only the one Notice or Decision which is complained of. Each complaint file

www.wincolaw.com

may mention a number of Notices or Decisions if all the latter have the same contents and provide the same reason for the complaint, on condition that the complainant must pay a fee in accordance with the regulations for each Decision or Notice which is complained of.

44.2 Complaint files must include the following documents:

- (a) Declaration of complaint, prepared in accordance with the sample form in the appendix to this Circular;
- (b) Copy of the Decision or Notice which is complained of;
- (c) Copy of the Decision resolving the first complaint (in the case of a second complaint);
- (d) Evidence proving the reason for the complaint (if necessary);
- (dd) Power of attorney (if the application is filed by a representative);
- (e) Voucher proving payment of complaint fee.

44.3 Evidence means documents (evidence in writing) or objects (evidence in the form of objects) used to prove or clarify the reasons for the complaint.

Evidence must satisfy the following requirements:

- (a) Evidence in writing may be documents in a foreign language on condition that a Vietnamese translation is provided if the person authorized to resolve the complaint so requests;
- (b) Where evidence in writing is a document provided by an individual or organization without a seal or by a foreign individual or organization in the name of an underwriter, then the signature must be certified by the public notary or a competent authority;
- (c) Where evidence is in the form of an object (a publication, a video and so forth) then depending on each specific case the country of origin of the object or of the information contained in the object must be specified, and the date when the object or information contained in the object was published or announced must also be clarified;
- (d) In the case of evidence in the form of objects, there must also be a document describing special points directly related to the contents of the complaint.

45. Responsibilities of complainants:

Complainants must be honest when they provide evidence and they shall be responsible for the consequences of providing false evidence.

46. Withdrawal of complaints:

46.1 A complainant may provide notice of withdrawal of a complaint at any time at all. If notice of withdrawal of a complaint is provided by an industrial property representative service organization, the complainant must clearly specify such right to withdraw in a power of attorney.

46.2 A withdrawn complaint shall be deemed not to have been lodged. The complainant shall not be entitled to return of the compliant file nor to a refund of any fee paid.

47. Accepting jurisdiction over complaint files:

47.1 Within a time-limit of 10 days from the date of receipt of a complaint file, the person authorized to resolve the complaint shall check the file to ensure it complies with the formal requirements and then issue a notice to the complainant advising that jurisdiction has been accepted and the date of same, or advising that jurisdiction has not been accepted and the reasons therefor.

47.2 Jurisdiction shall not be accepted over complaint files in the following circumstances:

- (a) The complainant does not have the right to lodge a complaint;
- (b) The complaint was lodged outside the limitation period for lodging complaints;
- (c) The complaint file fails to satisfy the requirements stipulated in clause 46 of this Circular.

48. Related parties:

48.1 Where jurisdiction is accepted, the person authorized to resolve the complaint shall issue a notice on the contents of the complaint to persons with rights and interests which are directly effected ("related parties"), fixing a time-limit of 2 months from the date of the notice for such parties to provide their opinions.

48.2 Related parties shall have the right to provide information and evidence proving their arguments.

48.3 If a related party/ies has not provided an opinion at the expiry of the above-mentioned time-limit, the complaint shall be resolved on the basis of the complainant's opinion.

49. Decision on resolution of a complaint:

The person authorized to resolve the complaint shall rely on the arguments and evidence of the complainant and of related parties in order to issue a decision on resolution of the complaint within the time-limit stipulated in article 27.4 of the Decree.

Prior to issuing a decision on resolution of the complaint, the person authorized to resolve the complaint shall issue a notice to the complainant and related parties about the arguments and evidence of the complainant and of related parties which have been used to resolve the complaint and stating the decision it is proposed to issue, and fixing a time-limit of 2 months from the date of the notice for the said parties to provide their opinions.

The period reserved for the complainant and related parties to provide arguments and evidence at the request of the person authorized to resolve the complaint shall not be included in the time-limit for resolution of the complaint.

50. Effectiveness of decisions resolving complaints:

Any procedures concerning industrial property which depend on the result of resolution of a complaint shall only be conducted on the basis of:

- (a) A decision resolving a first complaint if the complainant does not lodge a second complaint or institute administrative procedures; or
- (b) A decision resolving a second complaint or a court decision if the complainant lodges a second complaint or institutes administrative procedures.

Section 4

Suspension and Rescission of Effectiveness of Certificates of Protection

51. Right to request suspension or rescission of effectiveness of Certificates of Protection:

At any time during the validity of a Certificate of protection, any person shall have the right to apply for suspension or rescission of validity of such Certificate pursuant to articles 28 and 29 of the Decree and in accordance with the order and procedures set out in this Section.

52. Application files for suspension or rescission of validity of Certificates of Protection:

52.1 Application files for suspension or rescission of validity of Certificates of Protection must satisfy the formal requirements stipulated in clauses 5.1(a) to 5.1(e) inclusive of this Circular.

52.2 Any one application file may request suspension or rescission of validity of a number of Certificates of Protection when the same reason applies to each, on condition that the applicant must pay a fee for each Certificate of Protection referred to.

52.3. Application files for suspension or rescission of validity of Certificates of Protection must include the following documents:

- (a) Declaration requesting suspension or rescission of validity of a Certificate of Protection, prepared in accordance with the sample form in the appendix to this Circular;
- (b) Evidence (if any);
- (c) Power of attorney (if the Application is filed by a representative);
- (d) Voucher proving payment of fee.

53. Dealing with application files for suspension or rescission of validity of Certificates of Protection:

53.1 Application files for suspension or rescission of validity of Certificates of Protection shall be dealt with in the same order as for resolution of complaints set out in clauses 47 to 50 inclusive of this Circular.

53.2 If an applicant or a related party disagrees with the conclusion of the National Office of Industrial Property on the request for suspension or rescission of validity of a Certificate of Protection, such applicant or related party shall have the right to make a complaint about the Decision or Notice in accordance with the procedures set out in clauses 47 to 50 inclusive of this Circular.

53.3 The contents of any suspension or rescission of validity of a Certificate of Protection shall be announced in the Official Industrial Property Gazette and shall be recorded in the national register of inventions and utility solutions.

53.4 If the applicant who requests suspension or rescission of validity of a Certificate of Protection is the owner of the Certificate, the National Office of Industrial Property shall consider whether or not the application affects the rights of third parties (whether or not there is a currently an effective licence contract in respect of the relevant object) and if so then the National Office of Industrial Property shall not deal with the request pursuant to the procedures set out in clauses 53.1 and 53.2 of this Circular.

CHAPTER V

International Applications in Respect of Inventions and Utility Solutions

54. Procedures at the National Office of Industrial Property:

The provisions on filing Applications and implementation of other related procedures at the National Office of Industrial Property as stipulated in articles 15.2 and 15.3 of the Decree and clause 3 of this Circular shall also be applied to the implementation of procedures at the National Office of Industrial Property for international applications in respect of inventions and utility solutions.

55. Body receiving Applications:

The body authorized to receive international applications in Vietnam shall be the National Office of Industrial Property.

The National Office of Industrial Property shall have the responsibility:

- (a) To receive international applications originating from Vietnam;
- (b) To collect fees and transfer the corresponding fees to the International Office and the International Reference Agency as stipulated in the Treaty;
- (c) To verify timely payment of specified fees;
- (d) To check and deal with international applications originating from Vietnam as stipulated in the Treaty;

(dd) To determine the object to be protected: if the object to be protected in an application is a national secret, the following procedures shall not be carried out and fees shall be refunded to the applicant;

(e) To send one set of international applications originating from Vietnam to the International Office and one copy (for reference) to the International Reference Agency;

(f) To send and receive correspondence from the applicant and the international agencies.

56. Languages:

International applications originating from Vietnam submitted to the National Office of Industrial Property shall be made in English or Russian.

57. International Reference Agency and International Preliminary Examination Agency:

For international applications originating from Vietnam, the competent International Reference Agencies and International Preliminary Examination Agencies shall be the Patent Agencies, the Industrial Property Offices or the Intellectual Property Offices of Australia, Austria, Russian Federation, Sweden and Korea and the European Patent Office.

58. International Applications appointing Vietnam:

If Vietnam is appointed in an international application, the National Office of Industrial Property shall be the appointed agency. In this case, in order to enter the National Stage, within thirty one (31) months from the priority date, the applicant must submit to the National Office of Industrial Property the following:

(a) Declaration for the issuance of the certificate of exclusive right in respect of the invention or utility solution, prepared in accordance with the sample form in the appendix to this Circular;

(b) Copy international Application (where the Applicant requests to enter the National Stage prior to the date of international announcement);

(c) Vietnamese translation of the international application (including the Description, Descriptive section, Request for protection, Notes to drawings and Summary (the document announced or the original already filed if the document has not yet been announced, the amended document and explanatory statement of the amendment if the Application was amended in accordance with article 19 of the PCT Treaty);

(d) The amended Description and Summary (if there are amendments as provided for in clause 58(c) above);

(dd) The national fees.

59. International Applications selecting Vietnam:

If Vietnam is selected in an application for international preliminary examination, the National Office of Industrial Property shall be the appointed agency. In this case, and if Vietnam is selected within 19 months from the priority date, then in order to enter the National Stage, within thirty one (31) months from the priority date, the applicant must submit to the National Office of Industrial Property the following:

(a) Declaration for the issuance of the certificate of exclusive right in respect of the invention or utility solution, prepared in accordance with the sample form in the appendix to this Circular;

(b) Vietnamese translation of the international application (including the Description, Descriptive section, Request for protection, Notes to drawings and Summary (the document announced or the original already filed if the document has not yet been announced, the amended document and explanatory statement of the amendment if the Application was amended in accordance with article 19 of the PCT Treaty);

(c) The amended Description and Summary (if there are amendments as provided for in clause 58(b) above);

(d) Vietnamese translation of the appendices to the report on international preliminary examination;

(dd) The national fees.

60. Request for entitlement to priority right:

In order to enjoy the priority right, the Applicant must reconfirm that [i.e. priority right] in the Declaration, pay a fee for application for entitlement to priority right on request by the National Office of Industrial Property, and file Vietnamese translations of the documents already filed with the International Office pursuant to Rule 17.1(a) of the Regulations on Implementation of the Treaty.

61. Amendment and supplementation of documents in the National Stage:

In accordance with Rule 51bis of the Regulations on Implementation of the PCT Treaty, applicants shall submit the power of attorney, the certificate of transfer of the right to file the applications in the International Stage (if any), and so forth, within thirty four (34) months from the priority date.

In accordance with articles 28 and 41 of the PCT Treaty and Rules 52.1(b) and 78.1(b) of the Regulations on Implementation of the Treaty, in the National Stage, the applicant may amend and supplement application documents as stipulated in clause 31 of this Circular. Also immediately into the National Stage, the applicant may amend and supplement the Description in conformity with clause 31 of this Circular.

The documents amended and supplemented which are submitted to the National Office of Industrial Property by the applicant shall be made in Vietnamese.

62. Time to begin the National Stage:

The time of dealing with international applications appointing Vietnam or selecting Vietnam in the National Stage shall begin on the first day of the thirty second month from the priority date, if the applicant does not provide a written request for the Application to be dealt with earlier than this period.

63. Examination of international applications:

International applications shall be examined with respect to form and content in accordance with the procedures stipulated for national applications.

64. International applications deemed to be withdrawn:

In addition to the cases of being deemed to be withdrawn as stipulated in the PCT Treaty and the Regulations on Implementation of the Treaty, international applications appointing or selecting Vietnam shall be deemed to be withdrawn where the national fee is not paid to the National Office of Industrial Property or where there is no Vietnamese translation after the expiry of the time periods stipulated in clauses 58 and 59 above.

65. Fees:

The applicant in international applications originating from Vietnam must pay the fees in accordance with the rates and the procedures specified in the Regulations on Implementation of the PCT Treaty and the regulations of the Ministry of Finance.

CHAPTER VI

Amendment of Certificates of Protection, Maintenance of Validity of Certificates of Protection

Section 1

Amendment of Certificates of Protection

66. Right to request amendment of Certificates of protection:

An owner of a Certificate of protection shall have the right to request the National Office of Industrial Property to record each change of the owner's name and address and any change in the owner of a Certificate of Protection (assignment of ownership as a result of inheritance, merger, separation or conversion of legal form of a business establishment pursuant to a court verdict and so forth). Any beneficiary of the owner's rights shall also have the right to request that changes concerning the owner of a Certificate of Protection be recorded.

The applicant for recording a change of the owner's name and address and any change in the owner of a Certificate of protection must pay a fee for amendment to the Certificate of protection.

67. Applications for amendment of Certificates of protection:

In order to amend the above-mentioned items, the owner of a Certificate of protection must file an application with the National Office of Industrial Property, the file to comprise:

- (a) Declaration requesting amendment to the Certificate of protection (prepared in accordance with the sample form in the appendix to this Circular);
- (b) Original Certificate of protection;
- (c) Documents verifying the change in ownership (certificate of inheritance, certificate of merger, separation or conversion of legal entity, court decision and so forth);
- (c) Voucher proving payment of fee for amendment of Certificate of protection;
- (d) Power of attorney (if the application is filed by a representative).

68. One application for amendment of a number of Certificates of protection:

One application may be made for amendment of a number of Certificates of protection and may be consolidated with the applications prescribed in clauses 31.1, 31.2 and 31.4 of this Circular if it concerns the same changes or amendments, on condition that the Applicant must pay a fee for each Certificate of protection or Application.

69. Dealing with applications for amendment of Certificates of protection:

The National Office of Industrial Property shall consider an application file requesting amendment of a Certificate of protection within one month from the date of its receipt. Where a file is considered proper, the National Office of Industrial Property shall make the change to the Certificate of protection and the register, and shall announce it in the Official Industrial Property Gazette. In the opposite case [where a file is considered improper], the National Office of Industrial Property shall send the applicant a notice of intention to refuse the change with reasons therefor, and shall fix a time-limit of 2 months from the date of the notice for the Applicant to rectify deficiencies or provide its opinion opposing such intention. If within such time-limit the applicant fails to rectify deficiencies or fails to rectify the deficiencies to the extent required and/or fails to provide an opinion opposing [the intention] or fails to provide a legitimate reason opposing [the intention], then the National Office of Industrial Property shall issue an official notice refusing the application.

Section 2

Maintenance of Validity of Certificates of Protection

70. Fee for maintenance of validity:

In order to maintain the validity of a Certificate of protection for an invention or utility solution, the owner of the certificate of protection shall pay fees for

www.wincolaw.com

the maintenance of validity within six months prior to expiry of the period of validity. The fees for maintenance of validity may be paid later than the time period stipulated above but not more than six months after expiry of the previous period of validity and the owner of the certificate of protection must pay an additional ten (10) per cent of the fees for each month of delay in payment.

71. Method for calculating a year of validity:

Each year of validity of a Certificate of protection shall commence from the date of expiry of the previous year of validity and shall expire on the last day of the final month of the following year. The first year of validity shall be calculated from the date of issuance of the Certificate of protection. However with respect to Certificates of protection issued on the basis of the 1981 Charter on Innovations and Inventions, the first year of validity shall commence from the priority date of the Application. If the last year of validity is less than 12 months, the fee for maintenance of validity shall be calculated on a monthly basis (namely a percentage of the annual fee, being the number of months in the last year of validity divided by 12).

72. Registration of maintenance of validity:

The National Office of Industrial Property shall record maintenance of validity in the Register, and maintenance of validity shall also be recorded on a Certificate of protection when the owner of the Certificate so requests.

73. Reinstatement of validity of Certificates of protection, reinstatement of legal consequences after a period of interruption of validity:

If the owner of a Certificate of protection fails to pay the fee stipulated in clause 70 of this Circular after 6 months from expiry of the period of validity but not more than 12 months after such period, and if validity of the Certificate of protection has not been suspended on the basis of a third party request, then the validity of the Certificate of protection may be reinstated on condition that the owner of the Certificate pays a fee for reinstating it and for maintaining its validity. Any person who used the invention or utility solution during the time when validity of the Certificate of protection was interrupted shall have the right to continue to use the invention or utility solution but shall not be permitted to extend the scope and quantity of use.

CHAPTER VII

Collection and Refund of Fees; Extending and Shortening time-limits

74. Collection of fees:

When the National Office of Industrial Property receives a file or Application or a request to conduct any other procedure, it must check the voucher proving payment of the fee.

If the Applicant has failed to pay the fee in full, the National Office of Industrial Property shall prepare a fee notification slip recording the rate and amount payable and send it to the Applicant. A fee payer shall be issued with

www.wincolaw.com

two counterfoil receipts for any fee paid, the receipts shall record the rate and amount paid, and when an Applicant submits a file or Application then the Applicant shall submit one counterfoil receipt as the voucher proving payment of the fee.

75. Refund of fees:

All fees paid shall be repaid in full or in part on the request of the payer in the following circumstances:

- (a) When the fee paid exceeded the stipulated amount;
- (b) In the circumstances stipulated in the second paragraph of article 32.2 of the Decree.

76. Form of refund of fees:

76.1 An Applicant for a refund of fees may choose one of two methods of refund:

- (a) Direct refund at the National Office of Industrial Property or via an agent for collection and distribution (post office, bank and so forth); or
- (b) Transfer the amount to be paid as the fee for another procedure.

If a fee is refunded via an agent for collection and distribution, the Applicant shall be liable for transmission costs. An Applicant for a refund of fees shall submit a Declaration requesting a refund of fees prepared in accordance with the sample form in the appendix to this Circular, and specifying which of the two methods of refund the Applicant chooses.

76.2 Where the National Office of Industrial Property approves a request for refund of fees, it shall send the Applicant a notice specifying the amount of the refund and the method of refund, which notice shall be signed by the Applicant on receipt of the refund. In the case where a request for refund of fees is not approved, the National Office of Industrial Property shall send the Applicant a notice specifying the reason therefore.

77. Extensions:

The time periods reserved for amending or supplementing documents as requested by the National Office of Industrial Property, for refutation of opinions and for opposing an intention expressed by the National Office of Industrial Property may be extended once for the same period as the original time-limit at the request of the person conducting the relevant procedure, on condition that such person must pay a fee for the extension (a fee for consideration of a file out of time).

78. Shortening time-limits:

Any person conducting procedures at the National Office of Industrial Property or at any other authorized body may make a request that such Office or body complete the procedures earlier than the stipulated time-limit, on condition that such person must pay a fee for consideration of a file earlier than the stipulated time-limit.

The National Office of Industrial Property or any other authorized body may agree or not agree to a request that such Office or body complete procedures earlier than a stipulated time-limit, depending on the capability of and conditions at such Office or body.

CHAPTER VIII

Final Provisions

79. Responsibilities of people carrying out civil service duties regarding industrial property:

79.1 Staff of the National Office of Industrial Property or any other authorized body including people working for the said Office or body pursuant to contract to whom jobs are assigned and who carry out the procedures set out in this Circular (hereinafter referred to as people carrying out civil service duties regarding industrial property) shall be obliged to comply with the laws relevant to the work they do.

79.2 People carrying out civil service duties regarding industrial property who breach the law shall be disciplined pursuant to Decree No. 97-1998-ND-CP of the Government dated 17 November 1998 on disciplinary penalties applicable to civil servants and the liability of civil servants for material damage.

79.3 People carrying out civil service duties regarding industrial property who breach the law and cause loss and damage to others shall pay compensation pursuant to Decree No. 47-CP of the Government dated 3 May 1997 on resolution of compensation for loss caused by civil servants and officers of legal bodies.

80. Complaints:

In addition to the right to complain about Decisions and Notices relevant to procedures for determination of rights, people carrying out civil service duties regarding industrial property as prescribed in this Circular shall also have the right to complain or institute proceedings about other Decisions and Notices made by the National Office of Industrial Property or other authorized bodies in accordance with the laws on complaints, denunciations and administrative proceedings.

The order and procedures for complaints and for resolution of complaints as stipulated in article 27 of the Decree and in clauses 47 to 50 inclusive of this Circular shall, with appropriate changes, apply to complaints about the above-mentioned Decisions and Notices.

81. Regulations on Applications and on order for conducting procedures for registration of inventions and utility solutions:

The Ministry of Science & Technology shall, in a separate document, issue Regulations on Applications and on order for conducting procedures for registration of inventions and utility solutions, which are consistent with the provisions in the Decree and in this Circular.

82. Effectiveness:

This Circular shall replace the provisions on procedures relating to establishment of industrial property rights with respect to inventions and utility solutions in Circular No. 3055-TT-SHCN of the Ministry of Science, Technology & Environment dated 31 December 1996.

This Circular shall be of full force and effect fifteen (15) days after the date of its proclamation in the Official Gazette.

**For the Minister
Ministry of Science &
Technology
Deputy Minister
BUI MANH HAI**