

No. 05/2013/TT-BKHCN

Hanoi, February 20<sup>th</sup> 2013

**CIRCULAR**

AMENDING THE CIRCULAR NO. 01/2007/TT-BKHCN DATED FEBRUARY 14TH 2007, GUIDING THE IMPLEMENTATION OF THE GOVERNMENT'S DECREE NO. 103/2006/ND-CP, ELABORATING A NUMBER OF ARTICLES OF THE INTELLECTUAL PROPERTY LAW APPLICABLE TO INDUSTRIAL PROPERTY, AMENDED IN THE CIRCULAR NO. 13/2010/TT-BKHCN DATED JULY 30TH 2010 AND THE CIRCULAR NO. 18/2011/TT-BKHCN DATED JULY 22ND 2011

*Pursuant to the Government's Decree No. 28/2008/ND-CP dated March 14<sup>th</sup> 2008, defining the functions, tasks, powers and organizational structure of the Ministry of Science and Technology;*

*Pursuant to the Intellectual Property Law dated November 29<sup>th</sup> 2005 and the Law No. 36/2009/QH12 dated July 19<sup>th</sup> 2009 on the amendment of the Intellectual Property Law (hereinafter referred to as the Intellectual Property Law);*

*Pursuant to the Government's Decree No. 103/2006/ND-CP dated September 22<sup>nd</sup> 2006 of the Government detailing and guiding the implementation of a number of articles of the Intellectual Property Law regarding industrial property, and the Decree No. 122/2010/ND-CP dated December 31<sup>st</sup> 2010, amending and supplementing a number of articles of the Decree No. 103/2006/ND-CP;*

*The Ministry of Science and Technology amends the Circular No. 01/2007/TT-BKHCN dated February 14<sup>th</sup> 2007 guiding the implementation of the Government's Decree No. 103/2006/ND-CP detailing a number of articles of the Intellectual Property Law regarding industrial property, amended and supplemented by the Circular No. 13/2010/TT-BKHCN dated July 30<sup>th</sup> 2010 and the Circular No. 18/2011/TT-BKHCN dated July 22<sup>nd</sup> 2011 (hereinafter referred to as the Circular No. 01/2007/TT-BKHCN) as follows:*

**Article 1. Amending some regulations of the Circular No. 01/2007/TT-BKHCN**

**1. Point 1.1. of the Circular No. 01/2007/TT-BKHCN is amended as follows:**

“1.1. The industrial property rights arising or established on the grounds specified in Clause 3 Article 6 of the Intellectual Property Law, Clauses 1, 2, 3, and 4 Article 6 of the Decree No. 103/2006/ND-CP detailing and guiding a number of articles of the Intellectual Property Law regarding industrial property, amended and supplemented by the Decree No. 122/2010/ND-CP and specific provisions in this Point.”

**2. Point 7.1.b (iii) is amended, and Point 7.1.b (iv) is added to the Circular No. 01/2007/TT-BKHCN as follows:**

“(iii) Geographical maps (if the to-be-registered mark is a mark for certification of the geographical origin of products, or a collective mark or certification mark that contains the geographical name or other signs indicating the geographical origin of to local specialities);

(iv) The written approval for the trademark registration issued by the provincial People’s Committee as prescribed in Point 37.7.a of this Circular (if the to-be-registered trademark is a collective mark or certification mark that contains the geographical name or other signs indicating the geographical origin of local specialities).”

**3. Point 13.8. of the Circular No. 01/2007/TT-BKHHCN is amended as follows:**

**“13.8. Time limit for formality examination of applications**

a) The time limit for formality examination of applications is 01 month from the filing date as prescribed in Clause 1 Article 119 of the Intellectual Property Law.

b) Where the Intellectual Property Office of Vietnam issues a notice as specified in Point 13.6.a of this Circular, the period of time for the applicant to response to that notice is not included in the time limit for formality examination. This period of time is understood as:

(i) The period from the date of issue of the notice to the day on which the applicant response to the notice; or

(ii) The time limit set in the notice (including the extension), in case the applicant does not response to the notice.

c) Where the applicant actively request the amendment or supplement of the application, or response to the notice issued by the Intellectual Property Office of Vietnam as prescribed in Point 13.6.a of this Circular, the time limit for the formality examination shall be extended to more 10 days as prescribed in Clause 4 Article 119 of the Intellectual Property Law.

d) Before the deadline prescribed in Point 13.8.a, 13.8.b or 13.8.c above, the Intellectual Property Office of Vietnam must finish examining the formality of the application, and notify the applicant of the result as prescribed in Point 13.6 or 13.7 of this Circular.”

**4. Point 15.6.d is amended, points 15.6.dd and 15.6.e is supplemented to the Circular No. 01/2007/TT-BKHHCN as follows:**

“d) Before issuing the notice of the intention to grant the protection title as prescribed in Point 15.7.a (iii) of this Circular, the Intellectual Property Office of Vietnam shall inspect the observance of the first-to-file rule as prescribed in Points 25.7, 35.9 and 39.10 of this Circular.

dd) The notification prescribed in Point 15.7.a (iii) shall be issued in the following cases:

(i) The application does not fall into the cases prescribed in Article 90 of the Intellectual Property Law;

(ii) The filing date or the priority date of the application is earliest among the patent applications in the case prescribed in Clause 1 Article 90 of the Intellectual Property Law;

(iii) The filing date or the priority date of the application is earliest among the industrial design applications in the case prescribed in Clause 1 Article 90 of the Intellectual Property Law;

(iv) The filing date or the priority date of the application is earliest among the trademark applications in the cases prescribed in Clause 2 Article 90 of the Intellectual Property Law;

(v) The application is made under an agreement as prescribed in Clause 3 Article 90 of the Intellectual Property Law.

e) The applications not falling in the cases prescribed in Point 15.6.dd of this Circular shall be processed as follows:

(i) The grant of the protection title is refused because the application does not satisfy the first-to-file rule, if the application with the earliest filing date or priority date is granted; or

(ii) The application is considered the first to file, and is processed as prescribed in Point 15.6.dd; if all applications which have the earlier filing date or priority date are refused to grant, or withdrawn, or considered to be withdrawn.”

**5. Point 15.7.a (iii). of the Circular No. 01/2007/TT-BKHHCN is amended as follows:**

“(iii) If the objects stated in the application satisfy the protection conditions, or the applicant satisfactorily corrects errors, or makes reasonable justifications within the time limit specified at Points 15.7.a (i) and (ii) above, the Intellectual Property Office of Vietnam shall issue a notice of substantive examination results, in particular:

- For the applications falling in the cases prescribed in Point 15.6.dd of this Circular: issue a notice on its intended grant of the protection title and give the applicant 01 month from the issuance date to pay the fee for the protection title grant, fee for notification of the protection title grant decision, fee for registration, and the fee for maintenance of the first year’s validity of invention patent. The applicant may request the extension of this time limit as prescribed in Point 9.2 of this Circular.

- The applications not falling into the cases in Point 15.6.dd of this Circular shall be processed in accordance with Point 15.6.e of this Circular.”

**6. Point 15.8. of the Circular No. 01/2007/TT-BKHHCN is amended as follows:**

**“15.8. Time limit for substantive examination**

a) The time limit for substantive examination is specified in Clause 2 Article 119 of the Intellectual Property Law.

b) Where the Intellectual Property Office of Vietnam issues a notice as prescribed in Point 15.7.a (i) and (ii) of this Circular, the period of time for the applicant to response to the notice is not included in the time limit for substantive examination. This period of time is understood as:

(i) The time from the date of issue of the notice to the day on which the applicant response to the notice; or

(ii) The time limit set in the notice (including the extension), in case the applicant does not response to the notice.

c) Where the applicant request the amendment, supplementation of the application on his/her initiative, or response to the notice issued by Intellectual Property Office of Vietnam as prescribed in Points 15.7.a (i) and (ii) of this Circular, the time limit for substantive examination shall be prolonged corresponding to the time limit for processing request of amendment, supplementation or explanation of the applicant as prescribed in Clause 4 Article 119 of the Intellectual Property Law, in particular:

(i) Within 06 months, for invention applications;

- (ii) Within 03 months, for trademark applications;
- (iii) Within 02 months and 10 days, for industrial design applications;
- (iv) Within 02 months, for geographical indication applications.”

**7. Point 25.7. of the Circular No. 01/2007/TT-BKHCN is amended as follows:**

**“25.7. Inspection of the first-to-file rule of inventions**

For the patent applications that satisfy the protection conditions, before issuing the notice of intention to grant the invention patent or utility solution as prescribed in Point 15.7.a (iii) of this Circular, Intellectual Property Office of Vietnam shall inspect the observance of the first-to-file rule as prescribed in Clause 1 and Clause 3 Article 90 of the Intellectual Property Law, in accordance with the following provisions:

- a) To inspect the observance of the first-to-file rule, information search shall be conducted at least from (but not confined to) the following mandatory sources: all invention applications received by the Intellectual Property Office of Vietnam (up to the date of inspection) with classification criteria the same as those of the object stated in the application currently under examination - considering also division criteria (third-class criteria) – and have earlier filing dates or priority dates than that of the application currently under examination (if the application is entitled to priority) that have not been published, or the publish date is later than the filing date or the priority date of the application currently under examination (if the application is entitled to priority).
- b) The conduction of information search is to find the case in which many applications (including the application currently under examination) register the same or similar inventions, and identify the application which has the earliest filing date or priority date.
- c) If there are many applications falling in the case prescribed in Point 25.1.b above, the invention patent or utility solution patent is only granted to the valid application that has the earliest filing date of priority date among the patentable applications.
- d) Among the applications falling in the case prescribed in Point 25.7.b above, if there are many applications that have the same filing date of priority date, the invention patent or utility solution patent is granted to the invention of only one application among those applications under the agreement of all applicants; if an agreement cannot be reached, all applications shall be refused.”

**8. Point 35.9. of the Circular No. 01/2007/TT-BKHCN is amended as follows:**

**“35.9. Inspection of the first-to-file rule of industrial designs**

For the industrial design applications that satisfy the protection conditions, before issuing the notice of intention to grant the industrial design certificate as prescribed in Point 15.7.a (iii) of this Circular, Intellectual Property Office of Vietnam shall inspect the observance to the first-to-file rule as prescribed in Clause 1 and Clause 3 Article 90 of the Intellectual Property Law, in accordance with the following provisions:

- a) To inspect the first-to-file rule, information search shall be conducted from the mandatory sources prescribed in Point 35.4.b (iv) of this Circular.
- b) The conduction of information search is to find the case in which many applications (including the application currently under examination) register the identical or substantially

indistinguishable industrial design of a part and/or a product, and identify the application which has the earliest filing date or priority date.

c) If there are many applications falling in the case prescribed in Point 35.9.b above, the industrial design patent is only granted to the application that has the earliest filing date of priority date among those applications that have satisfied the conditions for grant of industrial design patents.

d) Among the applications falling in the case prescribed in Point 35.9.b, if there are many applications that have the same filing date of priority date, the industrial design patent is granted to the industrial design of only one application among those applications under the agreement of all applicants; if an agreement cannot be reached, all applications shall be refused.

**9. Point 37.7. of the Circular No. 01/2007/TT-BKHCHN is amended as follows:**

**“37.7. Requirements of written permission for the registration of collective marks and certification marks that contain geographical names or other indicators of geographical origins of Vietnam’s local specialities**

a) The written permission for the registration of collective marks and certification marks that contain geographical names or other indicators of geographical origins of local specialities shall be issued by the following agencies:

(i) The provincial People’s Committee in charge of the geographical area corresponding to the geographical name or other indicators of geographical origin of local specialities (if the geographical area is under the management of one local government);

(ii) All provincial People’s Committees in charge of the geographical area corresponding to the geographical names or other indicators of geographical origins of local specialities (if the geographical area is under the management of multiple local governments).

b) The geographical map corresponding to the geographical name or other indicators of geographical origin of local specialities must represent sufficient information to identify that geographical area, and be certified by the competent agency stated in Point 37.7.a above.”

**10. Point 37.8. is added to the Circular No. 01/2007/TT-BKHCHN as follows:**

**“37.8. Criteria for identifying geographical names and other indicators of geographical origins of products**

a) The indicators of geographical origins of products are the indicators used for local products and meant to indicate the geographical origins of the products (indicate that the products are originated from the locality).

The indicator of geographical origin of a product is usually a geographical name, but might be a symbol of the locality (images of typical objects of the locality such as a symbol, a map, a flag, a badge, an attraction, a distinctive construction, etc.) or any other sign.

A geographical name might be a current name or a past name, an official name or traditional name of a geographical area (according to the administrative boundary or geographical methods).

b) A geographical name, a local symbol used for a usual product (not a speciality) may or may not indicate its geographical origin, depending on the product and the use of geographical name and local symbol.

c) Geographical names or local symbols are meant to indicate the geographical origin products in the following cases:

(i) They are used for local specialities (special products which have a reputation because of certain characteristics, are locally produced);

(ii) They are used for local plants, animals, and processed products thereof;

(iii) They are used for local products of mineral extraction (coal, iron, steel, aluminum, cement, stone, salt, timber, etc.);

(iv) They are used for the products from local develop industries;

(v) Other cases depend on the products and the use of geographical names and local symbols.

d) Geographical names and local symbols are not meant to indicate the geographical origin of products in the following cases:

(i) They are used as a usual trademark and widely recognized, which means they are considered to indicate commercial origin (distinctiveness), and does not indicate a geographical origin, e.g. Hanoi Beer, Sai Gon Beer;

(ii) The corresponding geographical area cannot be the place where the products are made, e.g. Arctic Cigarette, etc.

The geographical names and local symbols that are not meant to indicate geographical origin of products may be protected as a usual trademark without permission of local governments.

dd) The common geographical names and local symbols (such as names of provinces, cities, attractions) used for ordinary products of a locality (including the products of which the manufacture is at an advantage, but does not have a reputation or distinctive quality), used by local traders for their goods and services, and meant to indicate the manufactured location (but are not eligible for being classified in cases of (c) and (d) above) shall not be protected.

However, a geographical name or local symbol may be used as a secondary constituent of an ordinary trademark of a corresponding local trader without obtaining permission of the local government, as long as such geographical name is removed from the scope of protection (exemption).

## **11. Point 39.10 of the Circular No. 01/2007/TT-BKHCN is amended as follows:**

### **“39.10. Inspection the observance of the first-to-file rule of trademarks**

For the trademark applications that satisfy the protection conditions, before issuing the notice of intention to grant the certificate of registered trademark prescribed in Point 15.7.a (iii) of this Circular, Intellectual Property Office of Vietnam shall inspect the observance of the first-to-file rule as prescribed in Clause 2 and Clause 3 Article 90 of the Intellectual Property Law, in accordance with the following provisions:

a) To inspect the observance of the first-to-file rule, it is required to check all trademark applications received by the Intellectual Property Office of Vietnam (up to the date of inspection)

that have earlier filing dates or priority dates (if the application is entitled to priority) than those application currently under examination.

b) The check is to find the case in which many applications (including the applications currently under examination) filed by different applicants for the identical or confusingly similar trademark of the same or similar products or services, or many applications filed by the same applicant for identical trademark of identical products or services; and identify the earliest filing date or priority date.

c) If there are many applications falling in the case prescribed in Point 39.10.b above, the certificate of registered trademark is only granted to the trademark of the valid application that has the earliest filing date or priority date among those applications satisfy the protection conditions.

d) Among the applications prescribed in Point 39.10.b above, if there are many applications that have the same filing date or priority date, the certificate of registered trademark shall be granted to the trademark of only one application among those applications under the agreement of all applicants; if an agreement cannot be reached, all applications shall be refused.”

## **Article 2. Implementation effect**

This Circular takes effect after 45 days from the day on which it is signed./.

**THE MINISTER**

**Nguyen Quan**