Patent co-operation lessens local backlog

With Vietnam's recent and imminent free trade pacts, a great number of new businesses are seeking entry to the growing market. But first, they want to make sure that their intellectual property rights are safe – which makes for a torrent of work for the local patent office. Nguyen Nguyet Dzung and Nguyen Huong Giang of law firm Vision & Associates examine the early results of a co-operation between Japan and Vietnam to ease the backlog of patent applications.

On the basis of bilateral office agreements made in October 2015, on April 1, 2016, the National Office of Intellectual Property of Vietnam (NOIP) and the Japan Patent Office (JPO) commenced the Patent Prosecution Highway (PPH) pilot programme between the two offices. This is the very first PPH programme that the NOIP has joined so far, showing the willingness of the NOIP to use positive examination results issued by a partner jurisdiction to expedite examination of Vietnamese patent applications.

Although there are two expedited examination systems in Vietnam at present – the NOIP's standard expedited examination system stipulated in the Intellectual Property Law of Vietnam and the ASEAN Patent Examination Cooperation (ASPEC) programme between ASEAN jurisdictions – they have not been widely applied. A reason for the uncommon usage of the standard acceleration system is that the NOIP's examiners are often not willing to accept the acceleration request due to their great backlog of pending patent applications. As for the ASPEC programme, it has not been as effective as hoped since the NOIP's examiners are quite reluctant to rely on the examination results issued by the ASEAN patent offices.

This NOIP-JPO PPH pilot programme is expected to improve the current situation and shorten the substantive examination period for Vietnamese patent applications which have submitted corresponding Japanese applications.

Accordingly, applicants can now request expedited examination of their Vietnamese patent applications based on the Japanese

patents/allowances for corresponding Japanese applications by following a prescribed procedure and satisfying certain requirements under this PPH pilot programme. There are some important points the applicants should keep in mind when considering participation in this programme, particularly: (i) a request for substantive examination of the Vietnamese patent application must have been filed at NOIP either prior to or at the time of the PPH request, (ii) the first office action for the Vietnamese patent application has not yet been issued by the NOIP at the time the PPH request is filed, and (iii) the claims of the Vietnamese patent applications must be identical and/or equivalent to those determined to be patentable/allowable in the corresponding Japanese applications.

This PPH pilot programme will run for three years initially, from April 1, 2016 to March 31, 2019. However, the pilot programme may be extended after a joint NOIP-JPO review and assessment of the programme implementation. It is noted that this pilot programme is not applicable on the basis of the JPO utility model applications. In view of its handling capacity, the NOIP has agreed to accept 100 PPH requests per year at maximum in this three-year pilot period, and may refuse PPH requests which are filed thereafter. When the maximum acceptable volume of PPH requests is close to being reached, an ex-ante notice will be published by the NOIP on its website.

In the first year of the programme, the number of PPH requests at the NOIP reached 100 by August 24, 2016. After one year of operation, the PPH pilot programme has shown its remarkable effectiveness in the expedited examination of Vietnamese patent applications, with a substantial number of Vietnamese patents having been granted 9-12 months after their PPH requests. Given the huge backlog of pending cases, it has demonstrated the great efforts of NOIP’s examiners in seriously implementing the pilot programme.

For this second year dating from April 1, 2017, the number of PPH requests already reached the maximum of 100 requests by May 24, 2017. Thus, this second year of the programme was closed; and any other PPH requests which could not be duly filed have to wait for the third year, starting on April 1, 2018. In view of this situation, if applicants wish to take

advantage of this first-come, first-served programme, they should either have their PPH requests on hand or be well prepared to file them as soon as the NOIP resumes accepting them./.

Practice in construction of product-by-process claim in Vietnam

A product-by-process claim is understood worldwide as a patent claim in which a product claimed by defining the process by which the product is made, and this claim type is at present permitted in many jurisdictions. In Vietnam, such a product-by-process claim format is also permitted, however it is allowed under certain special circumstances only.

As stated in the Guidelines for Patent Examination issued by the National Office of Intellectual Property of Vietnam (hereinafter referred to as "the NOIP's Guidelines") dated 31 March 2010, in the case that a product whose structure is unknown at the time of application, such as a product having an extremely complex structure (e.g., polymer) or a product comprising various compounds (e.g., extract, fraction), such a product can be identified by its manufacturing process (e.g., a product X obtained by a process Y), provided that this technical feature is sufficient for the comparison and distinguishing of the claimed product with other products of the prior art (Point 5.7.2f). In the patent practice before the NOIP, when the NOIP's examiners consider that the product claimed in a product-by-process claim could be defined by its own characteristics (e.g., structure, composition, amount of each component, or the like), they will reject such a product-by-process claim drafting and request the applicant to define the claim by the characteristics of the product per se. For example, in one Office Action issued by the NOIP for a patent application, the NOIP's examiner in charge of the application

did raise an objection to one claim which was drafted as a product-by-process claim for the reason that the mixture claimed in this claim was defined by its composition and amount of each component contained therein, and it thus could not be expressed in the format of product-by-process claim.

With regard to the substantive examination of a product-by-process claim, the above-mentioned NOIP's Guidelines states that when assessing the novelty of this claim format, the NOIP's examiners have to consider whether the recited manufacturing process feature imparts a certain specific structure and/or component to the claimed product. If a person skilled in the art could conclude that this process necessarily produces a product whose structure and/or component is different from that of the products of the prior art, then said product-by-process claim meets the requirement of novelty. In contrast, if the claimed product made by the recited process has the same structure and/or component as the product of the prior art, then the product set forth in the product-by-process claim will be considered as lacking novelty even though it is made by a different process, unless the applicant can prove that the recited process will produce a product having different structure and/or component, or having different function through which a change on the structure and/or component of the claimed product could be perceived (Point 22.2.2.5 (3)). This implies that during the patentability assessment for this claim type in Vietnam, only the product per se is examined (i.e., product identity theory), taking into consideration the specific structure and/or component of the claimed product which is implied by the recited process.

The NOIP's Guidelines also gives a specific example relating to an invention on a glass which is made by process X, and in the prior art a process Y for making an identical glass is already disclosed (Point 22.2.2.5 (3)). This example shows that if the glasses made by these two processes have the same structure, shape, and/or material, then the invention is not new. In contrast, if process X comprises an incubating step at a specified temperature which has not yet been disclosed in the prior art, and thanks to this incubating temperature, the claimed glass made by process X has an increased resistance to cracking and breakage as compared to that made by process Y,

then the invention has novelty. This is because the increased resistance to cracking and breakage does imply that the claimed glass has a different inner and micro-structure thanks to the different manufacturing process as compared to the glass of the prior art.

As regards the infringement analysis of a product-by-process claim, there are no explicit provisions in relation to the technical scope and/or the enforcement of such a claim type provided for in the Intellectual Property Law of Vietnam and relevant legal regulations. Also, there have been no case laws, and thus no trial decisions, with respect to this issue in Vietnam up to date. Thus, if there is a case, the infringement assessment for this special form of claim seems to be based upon current Circular No. 11/2015/TT-BKHCN dated 26 June 2015 of the Ministry of Science and Technology detailing and guiding a number of articles of the government's Decree No. 99/2013/ND-CP dated 29 August 2013 on sanctioning of administrative violations in the field of industrial property, which provides that an accused product shall be regarded as "identical" or "equivalent" to a product protected by a claim if all essential technical features recited in the claim are present in the identical or equivalent form in the accused product, and shall be regarded as "not identical" or "not equivalent" if the accused product does not contain at least one essential technical feature recited in the claim, wherein two technical features shall be considered as a) "identical" if they have the same nature, the same purpose, the same manner of achieving purpose, and are in the same relationship with other features stated in the claim, and b) "equivalent" if they have the similar or interchangeable nature, the substantially identical purpose, and the substantially identical manner of achieving purpose (Rule 11). As such, it could be interpreted that in case of a product-by-process claim, an accused product seems to infringe a patented product-by-process claim which is defined by its manufacturing process feature only when it is made by a process having the same, similar or interchangeable nature, the same or substantially identical purpose, and the same or substantially identical manner of achieving the purpose to the process recited in the product-by-process claim at issue. That is to say, when assessing the possibility of infringement to a

product-by-process claim in Vietnam, it seems that the recited process may be considered as a limitation (i.e., process limitation theory).
To conclude, the product-by-process claim format is permitted in Vietnam in some exceptional cases. While the NOIP adopts the "product identity theory" when considering the patentability of this claim type as established in the NOIP's Guidelines, the current legal regulations indicate that the "process limitation theory" seems to be applied by the competent enforcement authorities in the infringement analysis when there is a case./.

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