

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./.