

MARCH 2010 Vietnam: New design examination guidelines issued

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On December 8 2009, the National Office of Intellectual Property issued the long-awaited examination guidelines for industrial designs. The guidelines gave clarity to a number of issues that had been left unclear under the Law on Intellectual Property (IP Law) and its regulations.

Under the guidelines, designs of products which are not able to be circulated as independent products are not protectable in Vietnam. Accordingly, no protection can be sought for parts (1) which are inseparable from a product, or (2) which may be separated from the product only by destroying the product and spare parts for replacement are not produced. Similarly, a decorative surface part made on the immediate surface of a product in the form of patterns, lines, or by painting or drawing on the immediate product surface will not qualify for protection as an industrial design.

Under the IP Law and its regulations, the appearance of a product is not protectable as an industrial design if it is invisible in the course of use of the product. It was made clear in these guidelines that "use" of a product includes the production, circulation, exchange, trading or assembly of the product by any direct users. Maintenance, servicing and repairing of a product is not considered "use" of the product.

It is stated in the guidelines that colour per se is not regarded as a basic appearance feature. However, for some specific products, such as labels and packaging, for which surface decoration is significant, colours in a certain decoration composition that help bring a certain aesthetic effect to the product appearance may be considered as a basic appearance feature of the design.

Multi-embodiment designs are protectable if all embodiments share the same combination of basic appearance features. The guidelines define basic appearance features as appearance features which are easy to identify, memorable and can be used to distinguish the design from others overall.

It was made clear in the guidelines that one can seek protection for a design of a whole product even if the design contains a prior registered design of a component part of that product. This, however, does not mean that the owner of the whole product design can use its registered design without authorisation from the owner of the prior registered design. Under the enforcement regulations, such use without authorisation from the owner of the prior registered design would constitute infringement of that prior design.

The issuance of these guidelines brought clarity over many uncertainties that the IP owners, practitioners and examiners have experienced over the last three and a half years since the IP Law came into force on July 1 2006. Guidelines on examination of patent and trade mark applications are still being drafted and are expected to be released soon.



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