

## VIETNAM

## Examining the NOIP's approach to post-grant correction of patents

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In Vietnam, granted patents can be amended in certain circumstances under provisions found in the Law on Intellectual Property (IP Law). For example, Article 97 of the IP Law gives a patent owner the right to request correction of errors made by the National Office of Intellectual Property (NOIP) in a granted patent.

The law is silent regarding correction of errors made by other parties, such as the patent owner itself, or its local patent agent. However, to ensure the accuracy of a patent, common sense dictates that correctable errors should not be limited to those made by the NOIP, but should extend to any other obvious errors.

In practice, a patent owner can request the NOIP to correct obvious errors that are not clearly the fault of the NOIP. However, there is no definition in Vietnamese legal documents of what constitutes an "obvious error". A recent case involving a European pharmaceutical company brought this issue to the forefront.

### Post-grant correction rejected

The company in question holds a Vietnamese patent that was granted nearly a decade ago for a compound for the treatment of a medical condition. The company is now battling infringing generic products in the Vietnam market, but faced a temporary setback when it discovered, in the course of litigation, that its patent had an error in the chemical formula (structural formula) of the compound, although the compound name was written correctly.

It is worth noting that the patent originated from a foreign priority document,

which was enclosed with the Vietnamese application, in which the correct structural formula and compound name were shown. It is likely that the error was introduced during the translation of the patent specification into Vietnamese by a local patent agent.

As a result of this error, the company recognised that enforcement efforts could be hindered, as generic producers could argue that they were not technically infringing the patent, because the compound in their products was not the same as the patented compound, based on the (erroneous) structural formula in a claim of the granted patent.

The company thus proactively petitioned for a correction of the granted patent, reasoning that the error in the structural formula was obvious and should have been readily apparent to a person having ordinary skill in the art. The examiner in charge of the patent certainly should have had the capacity to discover the error before granting the patent, having reviewed the priority document and the corresponding patents issued previously by other patent offices, which all showed the correct structural formula. The NOIP, however, refused to correct the patent, claiming that the error was not obvious.

### What makes an error obvious?

The NOIP's refusal notice referred to some concepts of obvious errors in the case law of the Boards of Appeal of the European Patent Office (EPO), and also stated that the NOIP considers these concepts to be appropriate. Specifically, the NOIP cited point 4.2 in the case law, that for a correction to be made, it must be established that: "It is obvious that an error is in fact present in the document filed with the EPO, the incorrect information having to be *objectively recognizable* [emphasized in the NOIP's notice] by the skilled person using common general knowledge."

The NOIP argued that if the patent owner did not notice the error within the two-year patent examination period, let alone for nearly 10 years thereafter, it could hardly be considered "obvious". In addition, the same error appeared in

other applications and patents of the company related to the compound.

While the patent application in question referred to the correct description in the EP patent, the incorrect structural formula consistently appeared throughout the summary, description, and claims of the Vietnamese application itself, and the NOIP further asserted that it had no obligation to consider other documents, referring to point 4.2.1 of case law: "On the other hand, documents, even if they were filed together with the European patent application, such as priority documents and the abstract may not be used."

### Outlook

The arguments in the NOIP's refusal notice signal that the NOIP intends to follow the EPO's practice regarding obvious errors and their corrections (although it is debatable whether the EPO would have come to the same conclusion in a similar situation). Historically, however, the NOIP's practice has not always been consistent, and it is unclear to what extent patent correction will be allowed in the future.

To ensure their patent rights in Vietnam, practitioners and applicants are advised to review their applications very carefully, and rely only on reputable, experienced IP agents, with the most accurate translation capacity, for patent prosecution, to avoid unexpected consequences.