

IP Viet Nam Guidelines for Vietnam-Korea PPH Pilot Program

June 3, 2019

The Intellectual Property Office of Viet Nam (IP Viet Nam) recently signed an agreement with the Korean Intellectual Property Office (KIPO) for a Patent Prosecution Highway (PPH) Pilot Program commencing on June 1, 2019. The PPH will be implemented on a trial basis and will last for two years (until May 31, 2021). During the trial period, the number of requests under the PPH will be limited to 100 per year. Detailed guidelines on the procedures for filing PPH requests were made publicly available by IP Viet Nam on its website—please see the document “**IP Viet Nam Guidelines**” attached below.

NOTES ON IP VIET NAM GUIDELINES

For the benefit of our clients, we have additionally prepared the following notes, with numbers corresponding to the reference numbers in red on the IP Viet Nam Guidelines, to provide further advice and clarification where appropriate.

(1) Official fees

There is no separate official fee for submitting a PPH request. A request for substantive examination must be lodged either simultaneously with or prior to the PPH request, and the official fee for requesting examination is payable as normal. In addition, for participating in the PPH, claims are often amended to conform to KIPO claims, which requires payment of an official fee for the voluntary amendment.

(2) Limit on number of PPH requests

Based on our experience with the recent Vietnam-Japan PPH pilot program, we anticipate that the limit of 100 PPH requests will be reached in a very short time. Therefore, PPH requests should be filed sooner rather than later.

(3) Limitation on type of applications

Other than the ineligibility of utility model applications mentioned here, there is no further limitation on the type of applications eligible for the PPH, such as a limitation on the nationality of the applicant, the date of application, etc.

(4) Claim amendment

In Vietnam, voluntary amendments to a specification can be filed at any time during prosecution. Therefore, such amendments can be filed at the time of filing the PPH request to satisfy the requirement in Item 1(c) in the IP Viet Nam Guidelines.

In our experience, the best practice is to replace the current claims with those claims indicated as allowable by the KIPO. Unless it is absolutely necessary, it is not advised to amend the current claims in any way that results in the amended claims not being identical to such allowable claims, which will require the submission of a claim correspondence table as mentioned in Item 2(d) in the IP Viet Nam Guidelines.

This is because the Vietnamese examiners often rely on the examination results of the KIPO. If we replace the claims with the claims allowed by the KIPO, the application will be patented quickly. If we instead amend the claims and submit the claim correspondence table, the Vietnamese examiners will have to examine the differences between the two sets of claims. Because of IP Viet Nam's backlogs, the prosecution may be delayed in this case.

(5) Point of time when the examination begins

The determination of the point of time when the examination begins is based on the date of written communication, such as an office action, rather than the actual point of time at which the examiner starts the examination. Therefore, we can determine whether the examination of an application has begun by such written communication.

(6) Request for examination and publication of application

The deadline for lodging a request for examination is 42 months from the priority date. However, the examination in Vietnam will only start after the request for examination is lodged and the application has been published. Accordingly, the request for examination should be lodged as soon as possible.

Regarding early publication, for Vietnamese patent applications not based on PCT that have not yet been published, a request for early publication should be filed as soon as possible.

For Vietnamese national phase applications of PCT applications, the formalities examination only starts from the 32nd month from the earliest priority date, and the patent applications will be published right after they pass the formalities examination. Accordingly, in order for the patent applications to be published early, a request for early entry into the national phase should be filed as soon as possible and, subsequently, the patent applications should undergo formalities examination and be published earlier.

(7) Documents to be submitted

These documents will normally be submitted to IP Viet Nam by the applicant's representative (law firm). The representative will often file directly with IP Viet Nam. Certification of the documents is not required.

Only the non-patent literature mentioned in Item 2(c) and the claim correspondence table mentioned in Item 2(d) (if the current claims of the IP Viet Nam application are not identical to the allowed claims of the KIPO application) of the IP Viet Nam Guidelines are to be filed together with the PPH request.

(8) Copies of all office actions and their translations

IP Viet Nam will retrieve the documents via the K-PION (KIPO's dossier access system); however, IP Viet Nam may require further submissions. For example, if it is impossible for the examiner to understand the outline of the translated office action or claims due to a low-quality translation, IP Viet Nam may require us to resubmit a better translation. However, we believe that IP Viet Nam will rarely require further submissions.

(9) Copies of all claims and their translations

Although the documents will be retrieved via the K-PION, the claims are important and the examiners could request that a non-machine English translation be submitted together with the PPH request. To ensure the correct scope of protection, a non-machine English translation of the claims should always be submitted.

(10) Copies of references cited

Please note that non-patent literature must always be submitted.

(11) Accelerated period of time

The IP Viet Nam Guidelines do not indicate how examination is accelerated. The officer in charge of the PPH at IP Viet Nam informed us that the period of examination should be shortened to nine months from the filing date of the PPH request. For a non-PPH application, in principle, the period of time for examination is 18 months.

(12) Acceptance of PPH request

The officer in charge of the PPH at IP Viet Nam informed us that applicants will only be notified in the case of invalid requests, and will not provide any notification if the PPH request is considered valid.

TILLEKE & GIBBINS

Procedures to file a request to IP Viet Nam (Intellectual Property Office of Viet Nam) for Patent Prosecution Highway Pilot Program between IP Viet Nam and KIPO (Korean Intellectual Property Office)

PPH using the national work products from KIPO

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with IP Viet Nam and satisfies the following requirements under the IP Viet Nam-KIPO Patent Prosecution Highway (PPH) pilot program based on the KIPO application.

When filing a request for the PPH pilot program, an applicant must submit a request form to IP Viet Nam. (1)

The Offices may terminate the PPH pilot program for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

The PPH pilot program will be in effect for two (2) years commencing on June 1, 2019 and will end on May 31, 2021. The number of requests per year will not exceed one hundred (100) from each Office. However, the program may be extended after a joint IP Viet Nam-KIPO review and assessment of the program implementation. (2)

1. Requirements

(a) The IP Viet Nam application (including a PCT national phase application is)

(i) an application which validly claims priority under the Paris Convention to the KIPO application(s) (examples are provided in ANNEX I, Figure A, B, C, H, I and J), or

(ii) a PCT national phase application without priority claim filed at KIPO as receiving office (the application number begins with PCT/KR, hereafter referred to as PCT/KR application) (examples are provided in ANNEX I, Figure K), or

(iii) an application which validly claims priority under the Paris Convention to the PCT/KR application(s) referred to in (ii) above (examples are provided in ANNEX I, Figure L, M and N).

The IP Viet Nam application, which validly claims priority to multiple KIPO or direct PCT applications, or which is the divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

The PPH pilot program is not applicable on the basis of KIPO “utility model” applications. (3)

(b) At least one corresponding application exists in KIPO and has one or more claims that are determined to be patentable/allowable by KIPO.

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the KIPO application which forms the basis of the priority claim (e.g., a divisional application of the KIPO application or an application which claims domestic priority to the KIPO application (see Figure C in Annex I)), or a KIPO national phase application of a PCT application (see Figures J, K, L, M and N in Annex I).

Claims are “determined to be allowable/patentable” when the KIPO clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet.

(c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in KIPO.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in IP Viet Nam are of

the same or similar scope as the claims in KIPO, or the claims in IP Viet Nam are narrower in scope than the claims in KIPO. In this regard, a claim that is narrower in scope occurs when a KIPO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

A claim in IP Viet Nam which introduces a new/different category of claims to those claims indicated as allowable in KIPO is not considered to sufficiently correspond. For example, where the KIPO claims only contain claims to a process of manufacturing a product, then the claims in IP Viet Nam are not considered to sufficiently correspond if the IP Viet Nam claims introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the request for participation in the PPH pilot program being accepted shall not be allowed. (4)

(d) IP Viet Nam has not begun examination of the application at the time of request for the PPH (an example is provided in ANNEX I, Figure O). (5)

(e) The request for accelerated examination under the PPH must also be accompanied by, or preceded by a request for examination. (6)

2. Documents to be submitted (7)

Documents (a) to (d) below must be submitted by attaching to the PPH request.

(a) Copies of all office actions (which are relevant to substantial examination for patentability in KIPO) which were issued for the corresponding application by KIPO, and translations of them (Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations).

Either Vietnamese or English is acceptable as translation language. The applicant does not have to submit a copy of KIPO office actions and translations of them when those documents are provided via K-PION (<http://k-pion.kipo.go.kr/>) (KIPO's dossier access system) because the office actions and

their machine translations are available for the IP Viet Nam examiner via the K-PION. If they cannot be obtained by the IP Viet Nam examiner via the K-PION or due to low quality of the translations, the applicant may be notified and requested to provide the necessary documents, including higher quality translations. (8)

(b) Copies of all claims determined to be patentable/allowable by KIPO, and translations of them.

Either Vietnamese or English is acceptable as translation language. The applicant does not have to submit a copy of claims indicated to be allowable/patentable in KIPO, and translations thereof when the documents are provided via K-PION (<http://k-pion.kipo.go.kr/>) (KIPO's dossier access system) because they are available for the IP Viet Nam examiner via the K-PION. If they cannot be obtained by the IP Viet Nam examiner via the K-PION or due to low quality of the translations, the applicant may be notified and requested to provide the necessary documents, including higher quality translations. (9)

(c) Copies of references cited by the KIPO examiner

If the references are patent documents, the applicant doesn't have to submit them because IP Viet Nam usually possesses them. When IP Viet Nam does not possess the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted. The translations of the references are unnecessary. (10)

(d) Claim correspondence table

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the IP Viet Nam application sufficiently correspond to the patentable/allowable claims in the KIPO application.

When claims are just literal translation, the applicant can just write down that "they are the same" in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

When the applicant has already submitted above documents (a) to (d) to IP Viet Nam through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. Procedure for the accelerated examination under the PPH pilot program

The IP Viet Nam decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the IP Viet Nam decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH. (11)

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again, provided that there has not been any first office action at the time of request of the PPH again, and it will be calculated as a new request. (12)

4. PPH request form

Subject: Request for an accelerated examination under the PPH pilot program

Date of filing:

Application number:

Title of the invention:

Applicant:

This application is an application which corresponds to the KIPO application number _____, and the accelerated examination is requested under the PPH pilot program. For this purpose, the following documents are attached:

- Copies of all office actions (which are relevant to substantial examination for patentability in KIPO) which were issued for the corresponding application by KIPO and
- Translations of them

- Copies of all claims determined to be patentable/allowable by KIPO and
- Translations of them

- Copies of references cited by the KIPO examiner

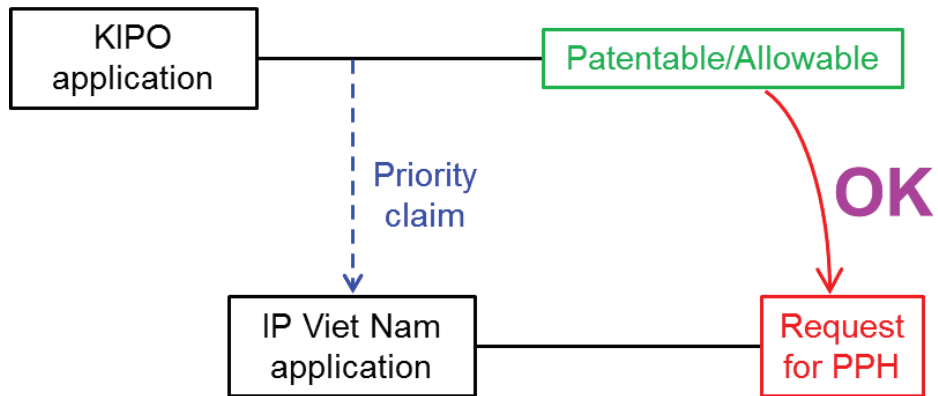
- Claim correspondence table

Claim correspondence table		
The claim in IP Viet Nam	The patentable claim in KIPO	Comments about the correspondence

(Documents to be omitted to submit)

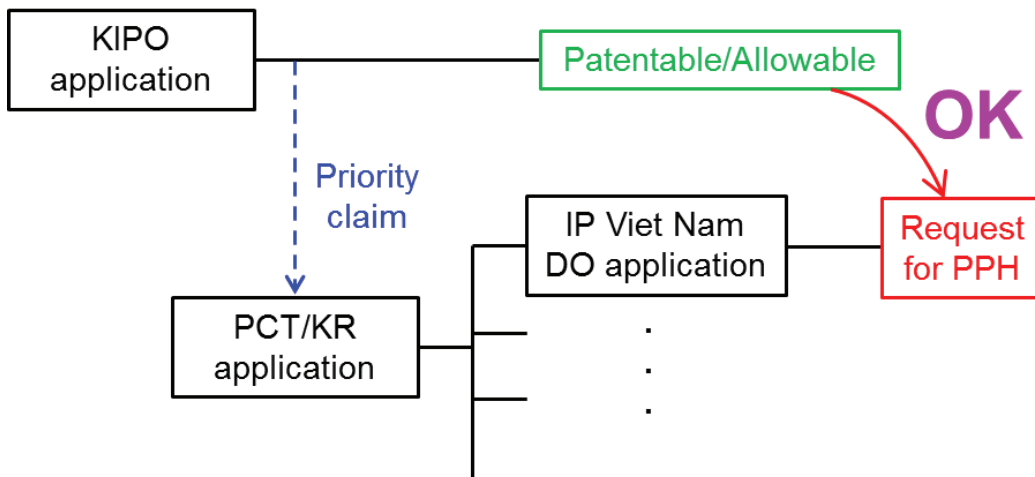
(A) A case meeting requirement (a) (I)

- Paris route -



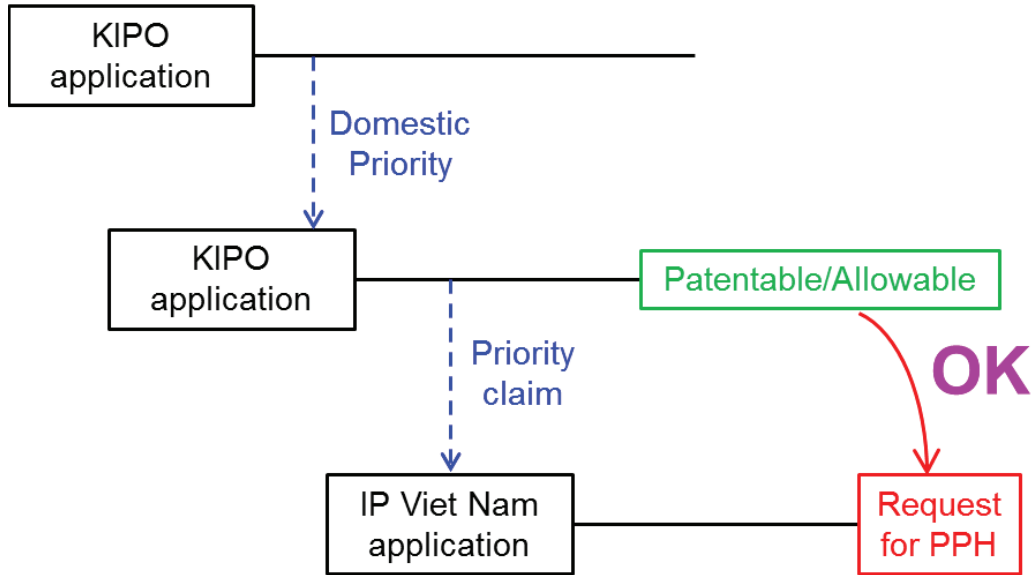
(B) A case meeting requirement (a) (I)

- PCT route -



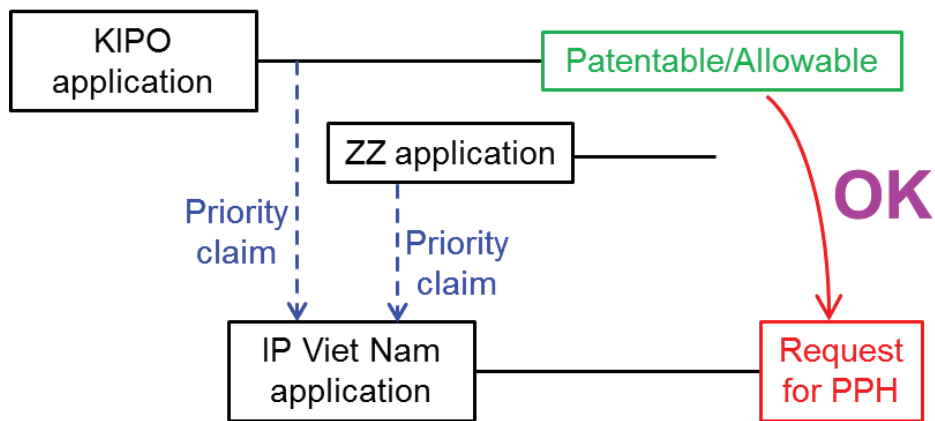
(C) A case meeting requirement (a) (I)

- Paris route, Domestic priority -



(H) A case meeting requirement (a) (I)

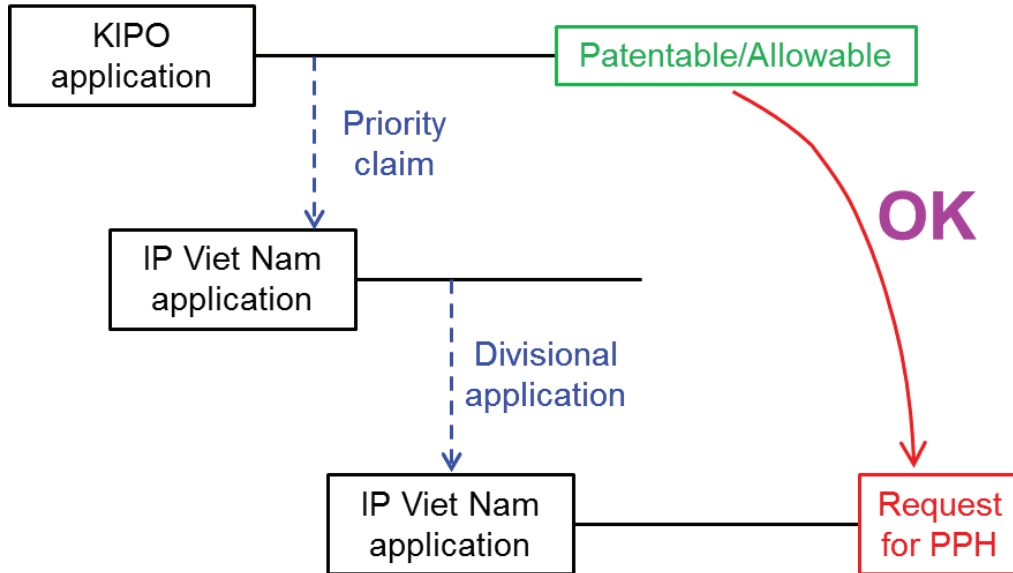
- Paris route & Complex priority -



ZZ : any office

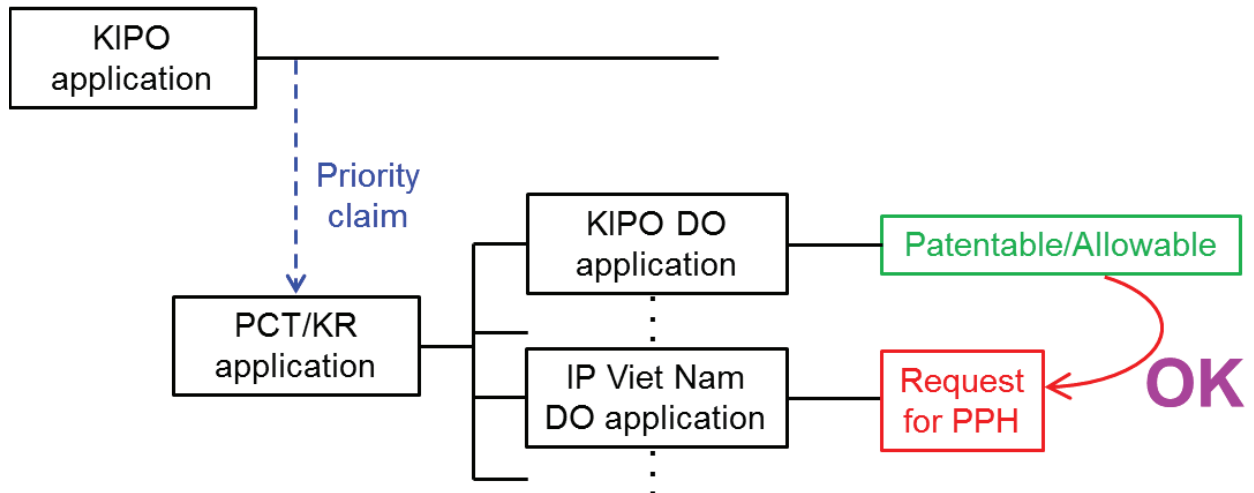
(I) A case meeting requirement (a) (I)

- Paris route & Divisional application -



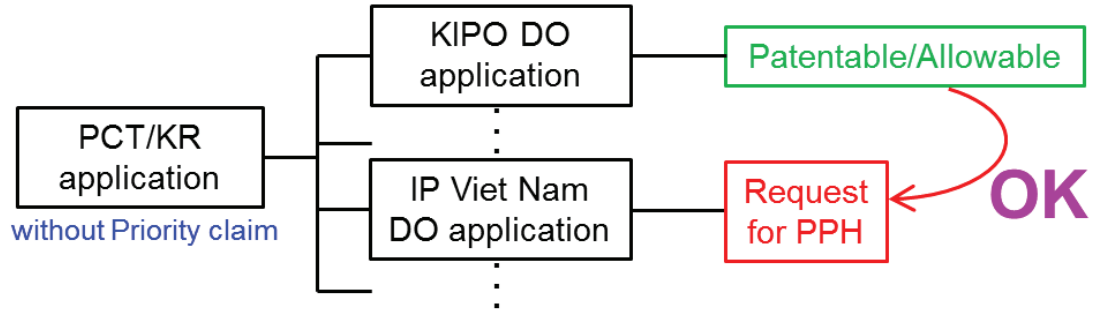
(J) A case meeting requirement (a) (I)

- PCT route -



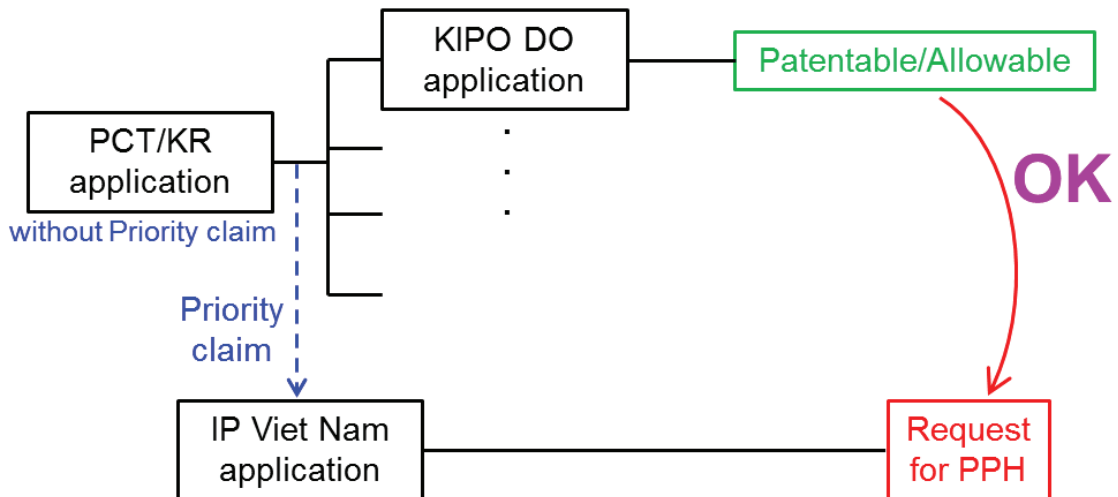
(K) A case meeting requirement (a) (II)

- Direct PCT route -



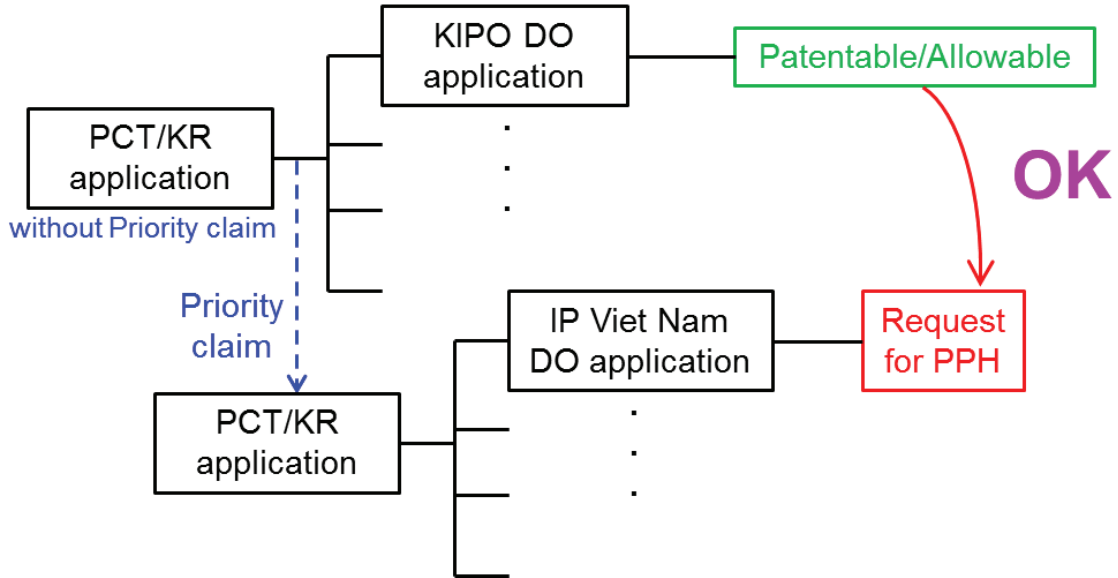
(L) A case meeting requirement (a) (III)

- Direct PCT & Paris route -



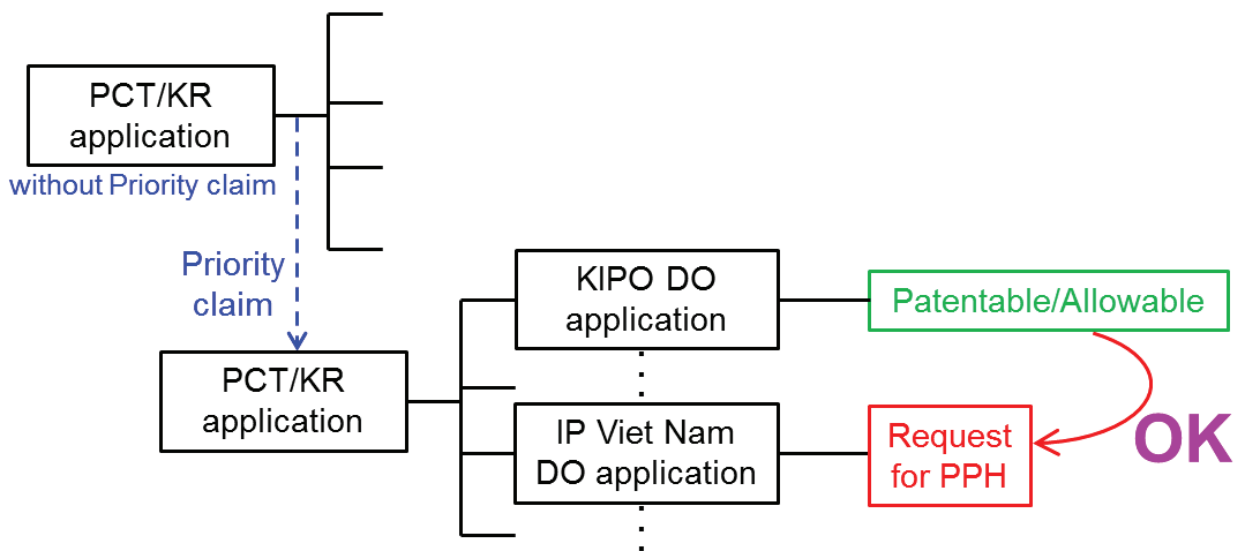
(M) A case meeting requirement (a) (III)

- Direct PCT & PCT route -



(N) A case meeting requirement (a) (III)

- Direct PCT & PCT route -



(O) A case not meeting requirement (d)

- Examination has begun before a request for PPH -

