

LEGAL DOCUMENTS

MINISTRY OF SCIENCE AND TECHNOLOGY

Circular No. 05/2013/TT-BKHCN of February 20, 2013, amending and supplementing a number of articles of Circular No. 01/2007/TT-BKHCN of February 14, 2007, guiding the implementation of the Government's Decree No. 103/2006/ND-CP detailing a number of articles of the Law on Intellectual Property concerning industrial property, which was amended and supplemented in Circular No. 13/2010/TT-BKHCN of July 30, 2010, and Circular No. 18/2011/TT-BKHCN of July 22, 2011

Pursuant to the Government's Decree No. 28/2008/ND-CP of March 14, 2008, defining the functions, tasks, powers and organizational structure of the Ministry of Science and Technology;

Pursuant to the November 29, 2005 Law on Intellectual Property, and July 19, 2009 Law No. 36/2009/QH12 Amending and Supplementing a Number of Articles of the Law on Intellectual Property (below referred to as the Law on Intellectual Property);

Pursuant to the Government's Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding a number of articles of the Law on Intellectual Property concerning industrial property, and Decree No. 122/2010/

ND-CP of December 31, 2010, amending and supplementing a number of articles of Decree No. 103/2006/ND-CP;

The Minister of Science and Technology amends and supplements a number of provisions of Circular No. 01/2007/TT-BKHCN of February 14, 2007, guiding the implementation of the Government's Decree No. 103/2006/ND-CP detailing a number of articles of the Law on Intellectual Property concerning industrial property, which was amended and supplemented in Circular No. 13/2010/TT-BKHCN of July 30, 2010, and Circular No. 18/2011/TT-BKHCN of July 22, 2011, (below referred to as Circular No. 01/2007/TT-BKHCN), as follows:

Article 1. To amend and supplement some provisions of Circular No. 01/2007/TT-BKHCN

1. To amend Point 1.1 of Circular No. 01/2007/TT-BKHCN as follows:

“1.1. The industrial property rights arising from or established on the bases prescribed in Clause 3, Article 6 of the Law on Intellectual property, Clauses 1, 2, 3, and 4, Article 6 of Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding the implementation of a number of articles of the Law on Intellectual Property concerning industrial property, which was amended and supplemented in Decree No. 122/2010/ND-CP, and specified at this Point.”

2. To amend Point 7.1.b (iii) of and add Point 7.1.b (iv) to Circular No. 01/2007/TT-BKHCN as follows:

“(iii) Geographical maps (if the registered mark certifies the geographical origin of products, or is a collective mark or certification mark that contains the geographical name or other signs indicating the geographical origin of local specialties);

(iv) The written approval of the mark registration issued by the provincial-level People’s Committee as prescribed at Point 37.7.a of this Circular (if the registered mark is a collective mark or certification mark that contains the geographical name or other signs indicating the geographical origin of local specialties).”

3. To amend and supplement Point 13.8 of Circular No. 01/2007/TT-BKHCHN as follows:

“13.8. Time limits for appraising the form of applications

a/ The time limit for appraising the form of an application is 1 month counting from the date the application is filed under Clause 1, Article 119 of the Law on Intellectual Property.

b/ If the National Office of Intellectual Property issues a notice as prescribed at Point 13.6.a of this Circular, the period for the applicant to respond to that notice is not included in the time limit for form appraisal. This period is understood as:

(i) The period from the date of issue of the notice to the date the applicant responds to the notice; or

(ii) The time limit stated in the notice (including the extension as prescribed), in case

the applicant does not respond to the notice.

c/ In case the applicant takes the initiative in requesting revision of the application, or responds to the notice issued by the National Office of Intellectual Property as prescribed at Point 13.6.a of this Circular, the time limit for form appraisal may be extended for 10 days as prescribed in Clause 4, Article 119 of the Law on Intellectual Property.

d/ Before the time limit prescribed at Point 13.8.a, 13.8.b or 13.8.c above expires, the National Office of Intellectual Property shall finish the appraisal of the application form, and notify the applicant of the result as prescribed at Point 13.6 or 13.7 of this Circular.”

4. To amend Point 15.6.d of and add Points 15.6.dd and 15.6.e to Circular No. 01/2007/TT-BKHCHN as follows:

“d/ Before issuing the notice of the intention to grant the protection title as prescribed at Point 15.7.a (iii) of this Circular, the National Office of Intellectual Property shall check the first-to-file rule as prescribed at Points 25.7, 35.9 and 39.10 of this Circular.

dd/ The notification prescribed at Point 15.7.a (iii) of this Circular is applied to the following applications:

(i) The application which does not fall into the cases prescribed in Article 90 of the Law on Intellectual Property;

(ii) The application with the earliest filing date or priority date among the patent applications in the cases prescribed in Clause 1, Article 90 of the Law on Intellectual Property;

(iii) The application with the earliest filing date or priority date among the industrial design applications in the cases prescribed in Clause 1, Article 90 of the Law on Intellectual property:

(iv) The application with the earliest filing date or priority date among the mark applications in the cases prescribed in Clause 2, Article 90 of the Law on Intellectual Property:

(v) The application which is made under an agreement as prescribed in Clause 3, Article 90 of the Law on Intellectual Property.

e/ The applications not falling into the cases prescribed at Point 15.6.dd of this Circular are handled as follows:

(i) The issuance of a protection title is refused because of failure to abide by the first-to-file rule, if the application that has the earliest filing date or priority date has been granted a protection title; or,

(ii) The application is considered to have the earliest filing date or priority date and will be handled as prescribed at Point 15.6.dd above; if the issuance of a protection title is refused for all applications that have earlier filing dates or priority dates or these applications are withdrawn or are considered withdrawn.”

5. To amend and supplement Point 15.7.a (iii) of Circular No. 01/2007/TT-BKHCHN as follows:

“(iii) If the object stated in the application satisfies the protection conditions, or errors are satisfactorily corrected or plausible explanations are provided by the applicant by the deadline

specified at Points 15.7.a (i) and (ii) above, the National Office of Intellectual Property shall issue a notice of the result of appraisal of the application form, which:

- For applications falling into the cases specified at Point 15.6.dd of this Circular: notifies the intention to grant a protection title and gives the applicant 1 month from the issuing date of the notice to pay a fee for the protection title grant, a fee for announcing the decision to grant the protection title, a fee for registration and a fee for maintenance of the patent validity in the first year. The applicant may request extension of this time limit as prescribed at Point 9.2 of this Circular.

- For applications not falling into the cases specified at Point 15.6.dd of this Circular: notifies the further processing of the application as prescribed at Point 15.6.e of this Circular.”

6. To amend and supplement Point 15.8 of Circular No. 01/2007/TT-BKHCHN as follows:

“15.8. Time limit for substantive appraisal of applications

a/ The time limit for substantive appraisal of applications is specified in Clause 2, Article 119 of the Law on Intellectual Property.

b/ If the National Office of Intellectual Property issues a notice as prescribed at Points 15.7.a (i) and (ii) of this Circular, the period for the applicant to respond to the notice is not included in the time limit for substantive appraisal. This period is understood as:

(i) The period from the date of issue of the

notice to the date the applicant responds to the notice; or,

(ii) The time limit stated in the notice (including the extension as prescribed), in case the applicant does not respond to the notice.

c/ In case the applicant takes the initiative in requesting revision of the application, or responds to the notice issued by the National Office of Intellectual Property as prescribed at Points 15.7.a (i) and (ii) of this Circular, the time limit for substantive appraisal may be extended to correspond to time limit for handling requests for application revision or explanation made by the applicants as prescribed in Clause 4, Article 119 of the Law on Intellectual Property, as follows:

(i) For 6 months at most, applicable to inventions;

(ii) For 3 months at most, applicable to marks;

(iii) For 2 months and 10 days at most, applicable to industrial designs;

(iv) For 2 months at most, applicable to geographical indications.”

7. To amend and supplement Point 25.7 of Circular No. 01/2007/TT-BKHCN as follows:

“25.7. Checking the first-to-file rule with regard to inventions

For invention registration applications that have been confirmed to satisfy the protection conditions, before issuing a notice of intention to grant an invention patent or utility solution patent as prescribed at Point 15.7.a (iii) of this

Circular, the National Office of Intellectual Property shall check the conformity with the first-to-file rule as prescribed in Clauses 1 and 3, Article 90 of the Law on Intellectual Property according to the following provisions:

a/ To check the first-to-file rule, it shall refer to information at least from the following compulsory sources (but not restricted to only these sources): All invention registration applications already received by the National Office of Intellectual Property (as of the date of checking) that have the same classification code as that of the object in the appraised application - up to the third level - and have earlier filing dates or priority dates (if the application is entitled to priority) than that of the appraised application but have not been announced, or have the announcement date later than the filing date or priority date (if the application is entitled to priority) of the appraised application.

b/ The reference aims to identify the case in which many applications (including the appraised application) register the identical or similar inventions, and identify the application which has the earliest filing date or priority date.

c/ If there are many applications falling in the case specified at Point 25.7.b above, the invention patent or utility solution patent is only granted to the valid application that has the earliest filing date of priority date among the applications satisfying all conditions for protection title grant.

d/ Among the applications mentioned at Point 25.7.b above, if there are many

applications that have the same earliest filing date or priority date, the invention patent or utility solution patent is granted to the invention of only one of these applications under the agreement of all applicants; if such agreement cannot be reached, all applications will be rejected.”

8. To amend and supplement Point 35.9 of Circular No. 01/2007/TT-BKHCN as follows:

“35.9. Checking the first-to-file rule with regard to industrial designs

For industrial design registration applications that have been confirmed to satisfy the protection conditions, before issuing a notice of intention to grant the industrial design patent as prescribed at Point 15.7.a (iii) of this Circular, the National Office of Intellectual Property shall check the conformity with the first-to-file rule as prescribed in Clauses 1 and 3, Article 90 of the Law on Intellectual Property according to the following provisions:

a/ To check the first-to-file rule, it shall refer to information from the compulsory sources specified at Point 35.4.b (iv) of this Circular.

b/ The information reference aims to identify the case in which many applications (including the appraised application) register the identical or confusingly similar industrial designs of a part of a product and/or a product, and identify the application which has the earliest filing date or priority date.

c/ If there are many applications falling into the case prescribed at Point 35.9.b above, the industrial design patent is only granted to the

valid application that has the earliest filing date or priority date among the applications that satisfy all conditions for protection title grant.

d/ Among the applications mentioned at Point 35.9.b, if there are many applications that have the same earliest filing date or priority date, the industrial design patent is granted to the industrial design of only one of these applications under the agreement of all applicants; if such agreement cannot be reached, all applications will be rejected.”

9. To amend and supplement Point 37.7 of Circular No. 01/2007/TT-BKHCN as follows:

“37.7. Requirements of written permission for the registration of collective marks and certification marks that contain geographical names or other indicators of geographical origins of Vietnam’s local specialties

a/ The written permission for the registration of collective marks and certification marks that contain geographical names or other indicators of geographical origins of local specialties may be issued by the following competent agencies:

(i) The provincial-level People’s Committee of the locality of the geographical area corresponding to the geographical name or other indicators of the geographical origin of local specialties (if the geographical area belongs to only one locality);

(ii) All provincial-level People’s Committees of the localities of the geographical area corresponding to the geographical name or indicators of the geographical origin of local

specialties (if the geographical area belongs to more than one locality).

b/ The geographical map corresponding to the geographical name or other indicators of the geographical origin of local specialties must express sufficient information to enable the accurate identification of that geographical area, and be certified by a competent agency specified at Point 37.7.a above.”

10. To add Point 37.8 to Circular No. 01/2007/TT-BKHCHN as follows:

“37.8. Criteria for identifying geographical names and other indicators of geographical origin of products

a/ Indicators of geographical origin of products are indicators used for local products that is meant to indicate the geographical origin of the products (indicating that the products are originated from the indicated locality).

The indicator of geographical origin of a product is usually a geographical name, but may be a symbol of the locality (images of typical objects of the locality such as a symbol, a map, a flag, a badge, a famous scenic place, a special construction, etc.) or any other sign.

A geographical name may be a current name or a past name, an official name or traditional name of a geographical area (according to the administrative boundary or geographical methods).

b/ A geographical name or a local symbol used for an ordinary product (not a specialty) may or may not be meant to indicate the geographical origin of the product, depending on the product and the actual use of the

geographical name and local symbol.

c/ Geographical names or local symbols is meant to indicate the geographical origin of products in the following cases:

(i) They are used for local specialties (special and well-known products because of certain characteristics, which are produced locally);

(ii) They are used for local plants or livestock and products thereof;

(iii) They are used for products made of local natural raw materials (coal, iron, steel, aluminum, cement, stone, salt, timber, etc.);

(iv) They are used for products of local industries;

(v) Other cases which depend on products and the actual use of geographical names and local symbols for these products.

d/ Geographical names and local symbols are not meant to indicate the geographical origin of products in the following cases:

(i) They are used as ordinary marks and widely recognized, which means that they indicate only the commercial origin (the possibility to distinguish) and no longer indicate the geographical origin, e.g., Hanoi beer or Sai Gon beer;

(ii) The corresponding geographical area cannot be the place where the products are made, e.g., Arctic Cigarette, etc.

The geographical names and local symbols that are no longer meant to indicate the geographical origin of products may be protected as ordinary marks without requiring

permission of local administrations.

dd/ The common geographical names and local symbols (such as names of provinces, cities, attractions) used for ordinary products of a locality (including the products of which the manufacture is at an advantage, but does not have a reputation or distinctive quality), used by local traders for their goods and services, and meant to indicate the origin (but are not eligible for being classified into type (c) and type (d) above) are not protectable.

However, a geographical name or local symbol may be used as a secondary constituent of an ordinary mark of a corresponding local trader, as long as such geographical name is removed from protection, and exempt from obtaining permission of the local government.

11. To amend and supplement Point 39.10 of Circular No. 01/2007/TT-BKHCN as follows:

“39.10. Checking the first-to-file rule with regard to marks

For mark registration applications that have been confirmed to satisfy the protection conditions, before issuing the notice of intention to grant the certificate of mark registration prescribed at Point 15.7.a (iii) of this Circular, the National Office of Intellectual Property shall check the conformity with the first-to-file rule as prescribed in Clauses 2 and 3, Article 90 of the Law on Intellectual Property, in accordance with the following provisions:

a/ To check the conformity with the first-to-file rule, it shall check all applications for mark

registration received by the National Office of Intellectual Property (up to the checking date) that have earlier filing dates or priority dates (if the application is entitled to priority) than that of the appraised application.

b/ The information reference aims to identify the case in which many applications (including the appraised application) register the identical or confusingly similar marks of identical or similar products or services, or many applications made by the same applicant register identical marks of identical products or services; and identify the earliest filing date of priority date.

c/ If there are many applications falling in the case prescribed at Point 39.10.b above, the certificate of mark registration is only granted to the mark in the valid application that has the earliest filing date or priority date among the applications that satisfy all conditions for protection title grant.

d/ Among the applications prescribed at Point 39.10.b above, if there are many applications that have the same filing date of priority date, the certificate of mark registration is granted to the mark of only one application among them under the agreement of all applicants; if such agreement cannot be reached, all applications will be rejected.”

Article 2. Effect

This Circular takes effect 45 days from the date of its signing.-

Minister of Science and Technology
NGUYEN QUAN