

Examination of applications for registration of the invention under EU regulations - Experience for Viet Nam

Ngo Minh Tin*, Tran Thi Thu Thao



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ABSTRACT

In this article, from the perspective of analyzing European Union law and Vietnamese law on patent registration as well as the practical examination of patent applications in the European Union and Vietnam in which proposes experience for Vietnam in the process of completing, amending, and supplementing legal regulations related to the process and methods of examining patent applications to save time on granting patents as well as protect industrial rights of the applicant. As a matter of practice, the long process of examining industrial property applications in general and patents, in particular, has caused difficulties for the rights holder in the process of intellectual property exploitation while the cycle of development of alternative technology or, in other words, the life cycle of technology is getting shorter and shorter. In this regard, the right holders only have a few years even a couple of months from the application date to start the process of commercial exploitation so that the right holders are unable to recover the expense of the investment for developing inventions. Besides, the number of patent applications is increasing along with economic development and national start-up campaigns. Therefore, in the context of shortening patent examination and other industrial property, in general, are now significantly necessary. Furthermore, within the scope of the article, the authors have compared the regulations of the European Patent Convention regarding the patent application examination, despite the similar steps of filing compared to Vietnam's regulations, the European Patent Convention still has some significant regulations to shorten the examination. As the result, based on reference to EU regulations, the authors propose a number of solutions to overcome the situations leading to the prolongation of the patent granting time and effectively protecting the interests of the applicant in Vietnam.

Key words: European Patent Convention, patent, European Patent, Intellectual Property

Faculty of Law, University of Economics and Law, VNUHCM, Viet Nam

Correspondence

Ngo Minh Tin, Faculty of Law, University of Economics and Law, VNUHCM, Viet Nam

Email: tinm@uel.edu.vn

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INTRODUCTION

Patents are technical solutions in a product or process intended to solve a problem by applying natural laws^{1,2a}. In a nutshell, patents are novel artificial technical solutions to a technical issue, capable of application and mass production³. Patents are not usually already existed in nature but must be through research and investment to apply the laws of nature to create products or processes to solve a problem in life and business. Patents, like other intellectual properties, take an essential role in the business activities of enterprises⁴. Seeing that, along with the development of the knowledge economy based on the achievements of science and technology being oriented and built by the Vietnamese Party and State, enterprises, in general, have been more proactive in protecting intellectual property, especially patents⁵. In contrast with the established patent rights, the current application examination in many countries is quite long, taking

^aSee more in Article 4, Paris Convention on the protection of Industrial Property

about 20-60 months under normal conditions⁶. In cases where the application needs to be revised or responded to the office for actions or opposition, the timeframe for the examination can be much longer^b. The lengthy examination of patent applications comes for many objective and subjective reasons. The examiners have to examine multi-criteria with a massive volume of citations on all documents in the world that the examiners can access; the examining work requires specialized expertise and is relatively complex,... Ignoring the objective reasons, the process of national examination is complicated, the capacity of the examiners is limited, and the support from technology is not inefficient is also the main reason leading to the prolonged examination of patent applications in less developed countries, including Vietnam. The current lengthy patent examination process has caused many difficulties for the right holders in trad-

^bIn Vietnam, applicants have two months to respond to the notice on formality examination, three months for substantive examination, 20 - 30 days for correspondence to appeal applications and response. On average, applicants take from one to four months for every opposition.

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ing, producing, and protecting their rights. With the present regulation on a time limit for examining, when receiving the patent registration certificate for mass production, then the patent might lose its creative cycle. The patent protection is 20 years from the application date^c, which is another problem for the applicant when the examination is prolonged. Because the patent registration certificate is valid from the registration date and sometimes, the timeframe for the examination can be up to nearly ten years. As in the case of utility solution application No. 2-2010-00201 of VNU-HCM⁷, the owner has only less than one month to get the exclusive exploitation rights after getting the patent in September 2020^d, meanwhile, other subjects have had access to this idea since the application was published in 2010. The applicant only has the right to warn without any exclusivity. From the above practice of patent examination, in this article, the authors will refer to the European Union patent application examination process by the European Patent Office (EPO). Based on analysis, evaluation, and comparison of legal regulations of the European Union (EU), there are some lessons learned for Vietnam in shortening the examination time for a patent application effectively.

THEORETICAL BASIS

The topic applies the perspective of the Balance of interests theory and the Fair use Theory as the central theoretical basis for the research process. In addition, in this article, the author also applies the Lex natural law Theory as a theoretical foundation to orient human creative freedom.

The project is expected to analyze two main contents in the order of first and last, including Examination of applications for registration of the invention under the EU Patent Convention and Experience for Viet Nam.

APPLICATION EXAMINATION FOR REGISTRATION OF THE INVENTION UNDER THE EU PATENT CONVENTION

Patents and other industrial properties, in general, are protected on the principle of territoriality, which means that they are only protected in countries/territories (hereinafter referred to as countries)

^cTen years for the patent granted utility models registration certificate.

^dSee utility models registration certificate “Hệ thống truy vấn video hướng ngữ nghĩa dựa trên công nghệ nhận dạng tiếng nói” No. 2-0002326 issued on 25/6/2020 of Duong Anh Duc and Vu Hai Quan, VNU-HCM.

that receive applications and granting certificates that have the responsibility to protect that trademark. To earn protection from many countries, in principle, the applicant shall submit the application to the countries that desire the protection^e. However, up to now, there have not been any regional or international patent certificates recognized, despite several agreements guiding the application and examination for members like North Africa, and Africa within the framework of international cooperation. In the EU, to create the facilitation for the citizens of member countries to establish rights for their types of intellectual property, namely patents, the EU issued the European Patent Convention (EPC) in 1973 and officially entered into force in 1977⁸ to regulate these issues.

European Patent can be seen as a more accessible, money-saving alternative solution to earn protection in the contracting state of EPC. The EPC is an international treaty whose aim was to create a law system common to the Contracting States for patents^f. EPC seeks protection in designated countries at the filing stage, securing it by a single patent European application. The EPO is responsible for the examination of patent applications, which is established by EPC^g. The task of the Organization shall be to grant patents certificates called European Patent^h issued under EPC and affects as registered in a single country⁹.

As a result, patent applications to be protected in the designated countries will only have to go through a general examination process, examined for patentability according to a common standard. European patent applications will go through almost similar steps as those in Vietnam, which are as follows: formality examination, search and opinion report, publication of patent applications and reports, substantive examination and grant of patents, and publication of patents for objections by third parties (if any).

(1) Formality examination

An applicant may file a European Application in two waysⁱ. Firstly, the applicant may file directly with the EPO headquarter in Munich or affiliation in The Hague, Berlin, Vienna, Brussels⁶; or secondly, the applicant may file with the national IP Office, which shall have the same effect as if it had been filed directly with EPO. However, the IP office of contracting states must transfer the applications to EPO within a time limit or they will be deemed withdrawn^j.

^eCan apply through the PCT system

^fArticle 1, European Patent Convention

^gArticle 4, European Patent Convention

^hPara 1, Article 2, European Patent Convention

ⁱArticle 75, European Patent Convention

^jArticle 77, European Patent Convention

Similar to Vietnam Regulations, EPO will examine the application number and application date after receiving the necessary documents and registration fee. After 18 months from the application date or priority date (if any) or the date that the applicant requires, EPO will publish the patent application. The examination includes a formality examination and substantive examination, a translation, inventor's information, representative's information, and a fee that has been paid or not along with this formality examination. EPO will conduct a search report in Europe, listing all available and appropriate documents to assess the novelty and creativity. The search report will be based on the claims, with due regard to the description and any drawings^k. When finished, the EPO will send the search report to the applicant and any copy of citations and opinions on the patent and application meeting the requirements.

(2) Application and Search report's publication in Gazette

Regarding the time limit of publication, similar to other countries, including Vietnam, the EU grants the applicant the right to choose between requesting an early publication or automatic publication from the end of the 18th month following the application date or priority date^l. Since the publication date, European patent applications have had provisional protection in contracting designated states^{m,n}. However, the publication at this stage only has the purpose of exposing the patent to the public without letting a third party oppose the patent application. Meanwhile, in Vietnam, the applicant has to wait till the patent grant registration certificate, which is time-consuming; with this provision, the applicant in EU has the provisional protection after the patent publication^o.

(3) Substantive Examination

In contrast to the publication procedure, the substantive examination is not automatic, and the applicant has to submit the substantive requirement within six months from the publication date of the application and the search report. Subject to certain exceptions, applicants must also respond to the search opinion within the above-mentioned period and decide whether to pursue their application by filing the request for examination^{p,q}. Moreover, when the substantive requirement is submitted, the EPO will invite

the applicant to confirm the pursuit of the application, unless the applicant has withdrawn. Once the examination request has been made, the EPO will access, based on the search report and the applicant's response, whether the European patent application and the invention it relates to meet the requirements of the EPC and whether the invention is patentable or not. European patents shall be granted for any inventions, in all fields of technology, provided that they are novel, involve an inventive step, and are susceptible to industrial application^r. And these are also the contents that the examining division of the EPO will examine whether the invention is officially protected or not. In general, the appraisal criteria under the Vietnamese and EU laws are similar and consistent with international commitments. However, compared to the EU, Vietnamese law allows the applicant to have quite a lot of time to file a substantive examination request^s. According to the author, the length of this period is not necessary and needs to be adjusted because there are possibilities that the applicant is trying to delay the introduction of the patent into the market, or that the patent is not essential enough, thereby slowing down the general development of science and technology.

In addition, the time limit for third parties to have a sentiment or object to the grant of a patent is also a significant difference between the patent registration procedure in the EU and Vietnam. Accordingly, the Vietnam Intellectual Property Law stipulates that the time limit for a third party to have any point of view on the grant of patent protection is counted from the publication date in the Industrial Property Official Gazette to before the date of issuance of the decision on grant of protection^t. Pursuant to this provision, from the publication date in the gazette until the decision on granting protection is made, any third party may file an opposition to the grant of a patent. In practice, the extended examination will lead to the extension of the time limit for the third party to file an opposition until a decision on granting a patent is made, which will create advantages for the third party to prepare the documents to file an opposition. In addition, if an opposition is filed during the examination period, the substantive examination will be further extended for the examiner has to review the third party's objections and the responses submitted by the parties. That causes many disadvantages to the enforcement of the rights of the applicant. Unlike Vietnam, to save time and ensure the applicant's rights, the

^kArticle 92, European Patent Convention

^lArticle 93, European Patent Convention

^mArticle 67, European Patent Convention

ⁿThis is considered a prominent regulation of the EPC that has overcome many problems related to the lengthy application examination time for the above mentioned patent.

^oThe applicant can have early publication.

^pArticle 70, European Patent Convention

^qVietnam regulates 36 and 48 months respectively for utility models and patents.

^rPara 1, Article 52, European Patent Convention

^s36 months for the utility models and 42 months for the patents.

^tArticle 112, Intellectual Property Law 2005 amend and supplement in 2009, 2019

third party only has nine months to file an opposition against the grant of a patent. This period is counted from the date of the mention of the European patent grant and published in the European Patent Bulletin^u. Consequently, if the time limit expires, or if no third parties file an objection or the objection without legal grounds or any other reasonable reason, the patent will remain in effect. However, if the third party's opposition is well-founded and fair, the EPO will cancel the patent^v.

This provision has contributed significantly to protecting patent applicants against unreasonable obstacles of competitors in their efforts to delay the granting of a patent and shortening the patent procedure. Indeed, this regulation has reduced the examination time to only two-thirds compared to the old appraisal method. Following this method, the examiners will complete the patent examination within the time limit specified in the law without being influenced by the opinions of the third parties in the examination process. The third parties must wait until the result of the substantive examination that the invention is protected or not before filing the opposition against the patent application. In addition, this provision also helps prevent the filing of opposition at the substantive examination stage because filing at this stage may not be necessary since the patent is protected or not will depend on many factors. At the publication stage, the examiners advised the applicant whether to pursue or not, and the possibility of patent protection in which the opposition filed at this stage may not be necessary.

EXPERIENCE FOR VIET NAM

Despite substantial investment in technology supporting as well as strengthening examiners' capacity, due to the rapid increase in the number of patent applications every year⁷ and the number of applications that have not yet been reviewed from previous years, the Intellectual property office of Vietnam (IPVN) has a constant backlog and delays in returning examination results compared to time limit regulations. The main reason usually comes from examining whether the invention meets the requirements for protection and giving a relatively long time for the parties to object and respond to the opposition to the grant of a patent registration certificate. The postponement leads to the violation of Vietnam's commitments to international treaties and causes severe damage to the applicants, thereby reducing the confidence of foreign investors for fear of their IP rights being violated upon

their transfer and investment in Vietnam⁸. Indeed, although the IP Law stipulates an expedited examination period of about 22 months from the date of filing the application^w, this timeframe is rarely met. Due to a large number of unresolved applications in recent years, in particular, in 2020, there were 125,689 applications of all kinds (up 4.1% compared to 2019) with 76,720 applications establishing industrial rights in terms of patent/utility models, industrial designs, national and international trademarks applications¹⁰ and had 8368 applications for patents/utility models, an increase of about 3.1% compared to 2019¹¹ with this number of applications, the actual examination time for a patent application in Vietnam is quite long, with some applications taking up to 110 months^x.

To overcome some situations leading to the prolongation of the patent granting time and effectively protect the interests of the applicant, based on reference to EU regulations, the author proposes a number of solutions as follows:

First, adjust the submission deadline for the substantive examination. Accordingly, experience from the EU shows that the prolongation of the time for submitting the substantive examination requirement creates conditions inadvertently for applicants to deliberately delay launching patents into business production and hinder the process development of science and technology. Therefore, instead of 42 months, we only need to prescribe six months like the EU. With this regulation, the current examination procedure will be reduced by 36 months compared to the current one. Second, adjust the timing and duration of the application for third-party objections. As analyzed above, the current Vietnamese law allows a third party to have the right to oppose a patent application from the moment it is published. As a result, many competitors take advantage of the regulation to prolong the examination and exploit the applicant's patent as the examination period will be interrupted for settlement once the opposition is presented. While the application has only just been published and is in the process of evaluation, it is unlikely that the patent will be granted protection. Consequently, the third party's opposition at this stage is unnecessary and wastes the parties' resources. From the assessment practice in the EU, Vietnam should consider the regulation that only allows third parties to object from the stage of patent granting protection publication^y. This regulation will

^wIf the application is eligible, there is a requirement for early publication and substantive examination right after the application is submitted.

^xUtility models registration certificate "Hệ thống truy vấn video hướng ngữ nghĩa dựa trên công nghệ nhận dạng tiếng nói" No. 2-0002326 issued on 25/6/2020 of authors Duong Anh Duc and Vu Hai Quan, VNU-HCM.

^yGazette B

^uArticle 99, European Patent Convention

^vArticle 101, European Patent Convention

help shorten the examination time and prevent parties from wasting unnecessary resources.

Third, supplement the provisions on granting provisional exclusive rights. Indeed, the purpose of patent protection is to strike a balance the interests between innovators and society's access to new patents. If a patent is created by an entity that has neither the potential for development nor the intention to develop when earning the exclusive rights, the community cannot access the patent, and the original purpose of the patent law is still not available to achieve. To avoid using patents to limit competition, quickly bring technology to life, and evade the situation when patent protection is outdated, it is thought that we should accept the provisional granting mechanism as follows: EU regulations on patents and industrial designs. This regulation will help the patent to be exploited earlier while ensuring fairness for all parties. In case the application is not granted, society will still have access. Fourth, upgrade the material facilities and equipment used to examine that patent application. In addition, with the rapid growth of science and technology, human intelligence is being exponentially created and approached in such a way that the examiner cannot look up referenced sources traditionally. Thus, we need to swiftly apply artificial intelligence (AI) technology to examine work to avoid backwardness and poor efficiency. This change will shorten the examination time and improve the reliability of the results. Fifth, privatization of examining activities. Following the general trend of the innovation process, to increase the privatization of services and decrease the burden on state management activities, many countries worldwide have allowed private patent examinations. Accordingly, parties have the right to use publicly recognized and licensed personal due diligence services as a basis for patent applications. This regulation will help reduce the burden on state examiners and improve the patent's effectiveness after it is granted.

CONCLUSION

Overall, the examination of patent applications in Vietnam is identical to other countries in terms of procedure. Current Vietnamese legal regulations meet most of Vietnam's commitments in international treaties. However, the examination of patent applications in Vietnam is currently taking a long time, leading to visible damage to the applicant, society, and the economy's development. Due to the strict regulations on the invention's novelty, there were many cases where patents were not protected, and the exclusive exploitation period expired.

Based on analysis and comparison with EU legal regulations on examination time as well as process and operation of EPO, the authors have proposed some suitable solutions to shorten the time of patent examination as well as improve the quality of application examination in the context of strong international integration. Vietnam should learn from experience to be able to protect inventions in a comprehensive and timely manner such as: first, adjust the application examination time; second, adjust the timing and duration of opposition to third-party applications; third, supplement provisions on granting provisional exclusive rights; forth, upgrade the material facilities, equipment to support for examination of patent applications; fifth, privatize appraisal activities.

LIST OF ABBREVIATIONS

EPC: European Patent Convention

EU: European Union

EPO: European Patent Office

CONFLICT OF INTEREST

The authors hereby declare that there is no conflict of interest in the publication of this article.

AUTHORS' CONTRIBUTION

The authors share responsibility for the work presented; wherein the first author is primarily responsible for the entire content of the article.

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Thẩm định đơn đăng ký sáng chế theo EU – Kinh nghiệm cho Việt Nam

Ngô Minh Tín*, Trần Thi Thu Thảo



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TÓM TẮT

Trong bài viết này, dưới góc độ phân tích pháp luật Liên minh châu Âu và pháp luật Việt Nam về đăng ký sáng chế cũng như thực tiễn thẩm định đơn đăng ký sáng chế tại Liên minh châu Âu và Việt Nam, từ đó đề xuất kinh nghiệm cho Việt Nam trong quá trình hoàn thiện, sửa đổi, bổ sung các quy định pháp luật và các quy định liên quan đến quy trình và phương pháp thẩm định đơn đăng ký sáng chế nhằm tiết kiệm thời gian cấp văn bằng bảo hộ sáng chế cũng như bảo vệ quyền sở hữu công nghiệp của người nộp đơn. Thực tế, quá trình thẩm định đơn đăng ký sở hữu công nghiệp nói chung và sáng chế nói riêng kéo dài đã gây khó khăn cho chủ thể quyền trong quá trình khai thác tài sản trí tuệ trong khi chu kỳ phát triển của công nghệ hay nói cách khác là vòng đời của công nghệ ngày càng ngắn đi. Do đó, việc chậm trễ trong việc thẩm định đơn cấp văn bằng bảo hộ sáng chế khiến chủ sở hữu quyền chỉ có vài năm thậm chí vài tháng kể từ ngày nộp đơn để có thể bắt đầu quá trình khai thác thương mại mà chủ sở hữu quyền không có khả năng thu hồi chi phí đầu tư vào phát triển sáng chế. Bên cạnh đó, số lượng đơn đăng ký sáng chế ngày càng tăng cùng với sự phát triển kinh tế và các chiến dịch khởi nghiệp quốc gia. Vì vậy, trong bối cảnh rút ngắn thời gian thẩm định bằng sáng chế và quá trình thẩm định các tài sản sở hữu công nghiệp khác nói chung hiện nay là rất cần thiết. Trong phạm vi bài báo, tác giả đã so sánh các quy định của Công ước Châu Âu về sáng chế liên quan đến việc thẩm định đơn đăng ký sáng chế, mặc dù các bước nộp hồ sơ tương tự so với quy định của Việt Nam, tuy nhiên Công ước về Sáng chế Châu Âu vẫn có một số quy định đáng kể để rút ngắn thời gian thẩm định. Do vậy, trên cơ sở tham khảo các quy định của EU, nhóm tác giả đề xuất một số giải pháp khắc phục tình trạng kéo dài thời gian cấp văn bằng bảo hộ sáng chế và bảo vệ hiệu quả quyền lợi của người nộp đơn tại Việt Nam.

Từ khóa: Công ước Châu Âu về sáng chế, sáng chế, sáng chế Châu Âu, Sở hữu trí tuệ

Khoa Luật, Trường Đại học Kinh tế - Luật, ĐHQG-HCM, Việt Nam

Liên hệ

Ngô Minh Tín, Khoa Luật, Trường Đại học Kinh tế - Luật, ĐHQG-HCM, Việt Nam

Email: tinnm@uel.edu.vn

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