

Special Alert

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Decree 65 - A Comprehensive Guide for Implementation of the IP Law

The Law on Intellectual Property No. 50/2005/QH11 dated 29 November 2005 as amended in 2009 and 2019 was further amended in 2022 (collectively, the “**IP Law**”). Meanwhile, both Decree No. 103/2006/ND-CP dated 22 September 2006, guiding the implementation of a number of articles of the IP Law with respect to industrial property, and Decree No. 105/2006/ND-CP dated 22 September 2006, guiding the implementation of a number of articles of the IP Law with respect to the protection of intellectual property rights and state administration of intellectual property were amended only in 2010 (“**Decree 103**” and “**Decree 105**”, respectively). That means there have been some gaps between the regulations of the IP Law and the guidelines for their implementation under Decree 103 and Decree 105. Therefore, it is necessary to update Decree 103 and Decree 105 for to address these gaps and incorporate certain relevant practices. Accordingly, a comprehensive Decree, i.e. Decree No. 65/2023/ND-CP, providing details on several articles and measures for the implementation of the IP Law in respect of industrial property, protection of industrial property rights, plant variety rights, and state administration of intellectual property (“**Decree 65**”) was issued on 23 August 2023 to replace Decree 103 and a certain regulations of Decree 105.

Certain notable amendments under Decree 65 in comparison with Decree 103 and Decree 105 are discussed below.

Security control for inventions: Article 89a.1 of the IP Law and Article 14 of Decree 65 specify inventions subject to the security control procedure before filing abroad. These include technical inventions created in Vietnam with filing rights belonging to Vietnamese entities, in the fields of (i) weapons; (ii) explosive materials; (iii) military equipment; (iv) equipment and technologies used in intelligence, criminal investigation activity and (v) tools used in security and law enforcement that could impact national defense and security. Under the security control procedure, such inventions shall be filed first in Vietnam, and the security control procedure shall be performed before the

publication of the patent application for such inventions by the cooperation between the Intellectual Property Office of Vietnam and the Ministry of Defense and the Ministry of Public Security, in accordance with applicable regulations on protection of state secrets.

If an invention is determined as confidential in accordance with Article 4.12a of the IP Law, the filing and handling of the patent application documents and granted patent for such invention shall be subjected to provisions of Chapter IV, Section 3 of Decree 65, i.e. the patent application shall be made in hard copy, and all information and documents shall be kept confidential in accordance with the provisions on protection of state secrets.

Conversion of a part of a patent application to a utility solution application: Article 17.3 of Decree 65 clarifies the procedure for the conversion of a patent application to a relevant utility solution application or vice versa. Accordingly, in case where such conversion is performed for a part of a filed application, such application must be divided into relevant applications, wherein the part which will be converted shall be covered in a separated application.

Amendment to granted protection titles: Article 97.3 of the IP Law allows the amendment of the protection title, i.e narrowing the scope of protection, subject to the payment of prescribed fees. Circumstances of such amendments are specified in Article 29.3 of Decree 65 as follows:

- For trademark registration: removal of certain items of goods, services, or certain classes of goods/services included in the trademark registration; and/or removal of certain minor elements of the trademark representation, which are disclaimed for individual protection in the trademark registration and such removal does not cause the change in the distinctiveness of the protected trademark.
- For patent for invention/utility solution: removal of one or more independent or dependent claim(s) within the scope of protection.
- For patent for industrial design: removal of one or more embodiments of the design, or removal of one or more articles of the set of products included in the patent for industrial design.

Provision of hard protection title: as one of the efforts to catch up with the digital transformation and for environmental protection, protection titles shall be issued in electronic form, and the hard copies thereof shall be issued at the applicants' particular request.

Obligation of use of a registered trademark: as provided in Article 40.2 of Decree 65, the actual use of a trademark which is different from the registered one by or under the trademark owner, but the difference of the used trademark is insignificant and does not make change of the distinctiveness of such trademark, the actual use of the former shall be considered meeting the obligation of use of a registered trademark, i.e conducting acts as provided in Article 124.5 of the IP Law.

Decree 65 took effect immediately from the issuance date thereof, 23 August 2023, and replaces the entirety of Decree 103 and a part of Decree 105. It notably also includes some provisions regarding the procedures for establishing industrial property rights as guided in Circular No. 01/2007/TT-BKHCN dated 14 February 2007 and its related amendments.

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