

VIETNAM
EXAMINATION REGULATION FOR PATENT APPLICATIONS

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CHAPTER I

GENERAL PROVISIONS

Article 1. Content of the Regulation

This Regulation provides guidance on procedures of prosecution of patent Application including formal examination, substantive examination and other requirements on administrative management thereof.

Article 2. Interpretation of terms

In this Regulation, the following terms shall be construed as follows:

1. "Intellectual Property Law" means Law no. 50/2005/QH11, amended and supplemented in compliance with Law no. 36/2009/QH12.
2. "Decree" means Decree no. 103/2006/NĐ-CP dated September 22nd, 2006 of the government on regulating provisions of the Intellectual Property Law concerning industrial rights.
3. "Circular" means Circular no. 01/2007/TT-BKHCH dated February 14th, 2007 of the Ministry of Science and Technology on interpreting Decree no. 103/2006/NĐ-CP dated September 22nd, 2006 of the government on regulating a number of provisions of the Intellectual Property Law concerning industrial rights.
4. "Treaty" means Patent Cooperation Treaty (PCT)
5. "Application" means an application for patent protection, including an application filed under the Treaty designating Vietnam during national phase.
6. "IPAS system" means managing system concerning industrial rights of the National Office of Intellectual Property.
7. Other terms, phrases as construed in the Intellectual Property Law, Decree and Circular.

CHAPTER II FORMAL EXAMINATION

Article 3. Purposes and scope of formal examination

3.1 Purposes of formal examination

As regulated in Point 13 of the Circular, the purposes of formal examination is to review an Application and determine whether it is legitimate and in compliance with the regulations on formality thereof.

3.2 Objectives of formal examination

Main objectives of formal examination shall include the following tasks:

- a) Check whether documents included with an Application comply with the Intellectual Property Law and other legal documents.
- b) Check whether documents included with an Application are submitted within a given time limit as regulated in the Intellectual Property Law and other legal documents.
- c) Check whether the applicant has paid the required fees, and whether the paid fees comply with the Intellectual Property Law and other legal documents.

3.3 Scope of formal examination

Scope of formal examination shall include the following tasks:

- a) Check the formality of documents included with an Application;
- b) Preliminarily check the contents of documents included with an Application;
- c) Determine the legitimacy of an Application; in circumstances where the Application is legitimate, determine the proper filing date and priority date (when applicable).

3.4 Formal examination shall be performed and recorded on the IPAS system.

Article 4. Examination of documents included in an Application as to formality

4.1 Objectives of examination of documents included with an Application as to formality

Examination of documents included in an Application as to formality shall include the following tasks:

- a) Check the listing of documents included with an Application;
- b) Check whether the documents comply with the regulations

concerning the submission deadlines thereof;

c) Check whether the documents comply with the regulations concerning the formality thereof.

4.2 Check the listing of documents included with an Application.

4.2.1 Procedures for checking documents included with an Application shall be performed by comparing the listing of documents the applicant indicates on item number 9 of the Application and of any amendment, supplement forms (when applicable) with any physical documents included with the Application and checking whether the requirements on submission of mandatory documents are met in compliance with Article 100 of the Intellectual Property Law and Point 7.1 of the Circular.

4.2.2 An Application with the following errors shall be deemed not to meet the requirements on mandatory documents:

a) There are inconsistencies in the amount and nature of the documents as indicated on the Application and as in fact included with the Application;

b) Any of the mandatory documents are either not included or incomplete.

4.3 Check whether documents included with an Application comply with the regulations concerning the submission deadlines thereof.

4.3.1 Check whether documents included with an Application comply with the regulations concerning the submission deadlines thereof by comparing the submission date of the documents with the regulations of the Intellectual Property Law and other Law regulating documents. In particular:

4.3.1.1 The following documents shall be submitted to the National Office of Intellectual Property to comply with the requirements set forth in Article 100, Article 102 and Article 108 of the Intellectual Property Law at the time of filing:

a) Application form;

b) Specification (including description, claims and drawings (if applicable));

c) Abstract;

d) Power of Attorney, when an Application is filed through a

representative (for International Application, according to Point 27.7 of the Circular, the deadline to submit the Power of Attorney is within 34 months from the priority date);

e) Documents attesting to the right to register, in case applicant inherits such right from another person;

f) Documents attesting to priority right, in case priority is claimed, including:

- Copies of the priority application certified by the receiving office;

- Assignment of priority right form when such right is inherited from another person.

g) Receipt of fees paid.

4.3.1.2 Other supplemental documents to an Application, at the request of the National Office of Intellectual Property as regulated at Point 23.4 of the Circular, shall be submitted within 01 month from the date of the notification thereof. The deadline to submit the documents of this Point may be extended for an additional 01 month, provided that applicant submits a request for extension of time before the initial deadline and pay a fee accordingly.

4.3.2 An Application with the following errors shall be deemed not to meet the requirements on submission deadline of its documents:

4.3.2.1 Any of the documents specified at points 4.3.1.1. a, b, f above

4.3.2.2 Any of the documents specified at points 4.3.1.1. c, d, e above

4.3.2.3 Any other supplemental documents not submitted within the allotted period specified at point 4.3.1.2.

Article 5. Preliminary review of the contents of documents included with an Application

5.1 Procedures for the preliminary review of the contents of documents included with an Application shall include the following tasks:

a) Identify the applicant and inventor(s);

b) Examine the right to register of the applicant;

c) Examine the mode of filing the Application for establishment of

- industrial property rights;
- d) Examine the Power of Attorney;
- e) Preliminarily examine the disclosure of subject matters;
- f) Examine the legitimacy of subject matters;
- g) Preliminarily examine the unity of the Application;
- h) Examine the priority claim;
- i) Examine the international patent classification code
- j) Examine the payment of fees.

5.2 Grounds for preliminary examination of the content of the documents included with an Application

Grounds for the preliminary examination of the contents of documents included with an Application are regulated in Article 59, Article 86, Article 89, Article 100, Article 101 and Article 102 of the Intellectual Property Law and Points 23.2, 23.3, 23.6, 23.7, 23.8, 23.10, 23.11 of the Circular.

The preliminary examination of the contents of documents included with an Application mainly involves the steps of checking the information on the Application, the specification, the abstract, and other documents.

5.3 Identify the applicant and inventor

5.3.1 Information on the applicant and inventor is listed on an indicated section on the Application or on the request for assignment of the rights to register.

5.3.2 An applicant may not be identified due to the following errors:

- a) The applicant's information is incomplete or inconsistent (missing address, incomplete address, inconsistencies between the addresses of the applicant as on the Application, Power of Attorney and other documents), and not in compliance with the requirements set forth in Point 7.2.d of the Circular;
- b) Signature of the applicant is absent from the Application, or the signature has been erased, amended, or not accompanied by a seal (in case signees are legal representatives of Vietnamese legal entities) or the certification mark of the applicant is not consistent with the information of the applicant, thus not in compliance with the requirements set forth in Points 7.2.b (iv) and 7.2.d of the Circular;

c) Information, including the addresses and nationalities of the inventor is absent, and not in compliance with Point 7.2.d of the Circular.

5.4 Examine the legitimate right to register of the applicant

5.4.1 An applicant's right to register is legitimate in the following cases:

- a) The applicant is also the inventor;
- b) The applicant is a legal entity: in this case, the inventor shall be considered as being tasked by the applicant to create the applied-for invention, when there are not any other agreement documents included with the Application;
- c) There are documents attesting to the legitimate rights to register in circumstances where the applicant inherits such right from another person (certificate of inheritance, certificate of or an agreement on assigning the rights to file, including assignment of already filed Application; work contract or employment contract, etc.).

5.4.2 An applicant shall not be considered to have the rights to register in the following circumstances:

- a) The applicant is an individual, who is not the inventor;
- b) The applicant is a legal entity, but not the legal entity as indicated on the priority Application when priority is claimed; In these circumstances, the applicant shall submit supplemental documents attesting to the legitimate rights to register. For example: certificate of or an agreement on assigning the rights to file, including assignment of an already filed Application (when the applicant inherits such rights from another person); work contract or employment contract (when the applicant is an employer who commissions the creation of the invention).

5.5 Examine the mode of filing an Application

5.5.1 In the following circumstances, modes of filing an Application shall be in compliance with Article 89 of the Intellectual Property Law:

- a) The Application is filed through a lawful representative in Vietnam;
- b) The Application is filed directly by the applicant, who is a

Vietnamese individual and organization, a foreign individual permanently residing in Vietnam, or a foreign individual and organization having a businesses or production establishment in Vietnam.

5.5.2 In the following circumstances, the mode of filing an Application shall not be in compliance with Article 89 of the Intellectual Property Law:

- a) The Application is filed directly by the applicant who is a foreign individual not permanently residing in Vietnam, foreign organization or individual who does not have any businesses or manufactures in Vietnam;
- b) The Application is filed through an organization or individual who is not a lawful representative.

5.5.3 The following organizations and individuals are considered lawful representatives:

- a) Industrial property representative service organizations;
- b) Representative offices and branches based in Vietnam, or companies with 100% foreign capital founded in Vietnam of the applicant who is a foreign organization or individual;
- c) Representatives at law of the applicant, provided that the representation is not a business activity (not for profit).

5.6 Examine the Power of Attorney when an Application is filed through a representative.

5.6.1 A Power of Attorney shall comply with the requirements set forth in Point 4.2 and 7.2 of the Circular. In particular, the Power of Attorney shall include:

- a) Name (full name) and full address of the grantor and attorney-in-fact;
- b) Scope of the Power of Attorney;
- c) Volume of work;
- d) Duration of the Power of Attorney
- e) Date of signing the Power of Attorney;
- f) Signature of the applicant (with full name, title and seal, if any) of either:
 - individual, if the applicant is only an individual; or
 - lawful head, if the applicant is a company or organization; or
 - all applicants, when there is more than one applicant.

A Power of Attorney shall be original. In circumstances where the scope of authorization stated in a Power of Attorney covers more than one independent procedure and the original Power of Attorney has been submitted to the National Office of Intellectual Property, the attorney-in-fact, when authorizing subsequent procedures, shall submit a copy of the submitted Power of Attorney and provide an accurate indication of the serial number of the Application with which the original Power of Attorney was filed.

5.6.2 An Application is incomplete when found in the following circumstances:

- a) Absence of a Power of Attorney from the applicant to a representative branch or office or any documents attesting to the authorized capacity of the representative branch or office, thus not in compliance with Points 4.2 and 7.2.a of the Circular;
- b) Absence of an original Power of Attorney or copy of an original Power of Attorney when the original has been submitted to the National Office of Intellectual Property, thus not in compliance with Points 4.2, 7.2.a and 13.3.c of the Circular;
- c) The Power of Attorney does not include all of the required information as set forth in Point 4.2 of the Circular;
- d) A copy of the Power of Attorneys which have been submitted to the National Office of Intellectual Property is not valid when the scope of the Power of Attorney does not include the authorization to register patent, thus not in compliance with Point 7.2.d of the Circular.

5.7 Preliminarily examine the disclosure of subject matters

5.7.1 Preliminary examination of whether a claimed subject matter is fully disclosed shall be performed for the specification and the abstract to evaluate the completeness of the basic information regarding the claimed matters. The specification is one of the required documents at filing. The specification includes a detailed description, a set of claims, a set of drawings, diagrams or calculation sheets (if needed to further clarify the nature of the technical solutions described in the description). The specification and the abstract shall conform to the requirements as set forth in Points 23.6 and 23.7 of the Circular and specified in Points 5.7.2 to 5.7.5 of this Article.

5.7.2 Detailed description

The detailed description shall fully disclose the nature of the technical solutions sought to be registered in compliance with the requirements set forth in Point 23.6.a of the Circular. The description shall contain sufficient information based on which any person with average skill in the art can deduce the solutions; clarify the novelty, inventive steps and susceptibility to industrial application of the technical solutions (when the protection title is an invention patent); clarify novelty and susceptibility to industrial application of the technical solutions (when the protection title is a utility solution patent). The description may not include any drawings, however it may include chemical, mathematical formulas and charts, ... The wordings in the description shall be consistent, concise and shall not cite any of the claims such as "as described in point ... of the claims" without any accompanying information. As set forth in Point 23.6.a of the Circular, the description shall include the following contents:

a) Title of invention

The title of invention shall be indicated on the first line of the first page and shall be identical to the title of the invention as indicated on the Application. The title shall be used to identify the subject matter (or matters) listed in an Application. The title shall comply with the requirements set forth in Point 23.6.b (i) of the Circular, in particular:

The title shall concisely and fully express the types, functions or uses of the subject matters. The title shall be consistent with the nature of the subject matters that are fully described in the description and shall fully reflect all of the main contents of the claims. The title shall not be business names, any signs or abbreviations of the invention.

The title shall not promote or advertise in nature and shall not include adjectives such as "new", "optimal", "best" or any indefinite terms, any signs that are not appropriate with the nature of the invention. In general, to identify the types of the claimed inventions, the titles shall start with terms such as "process", "method", "apparatus", "preparation", "composition", ... and followed by a phrase that describes the functions of the inventions such as "cleaning", "waste treatment", "weed exterminating", ... Beginning terms such as "solution", "technology", "improvement", ... do not describe the types of the claimed inventions.

When the subject matter is a chemical compound or biological

material, the title shall comply with the naming requirements to the respective chemical, biological fields.

b) Field of invention (field of the art)

In accordance with the requirements set forth in Point 23.6.b (ii) of the Circular, in particular, the field of an invention shall be indicated, in which the invention is used or related. In circumstances where the invention is used in or related to more than one fields, the applicant shall indicate all of the fields. The field shall correspond with the international patent classification.

c) State of the art of the invention

Applicant shall briefly present any known technical solutions that have same or similar purposes or solve a same or similar technical problems with the inventions described in an Application; and also at the same time shall clearly reference the documents that describe said technical solutions, in a way that enable anyone who is interested in the field can conveniently locate these solutions. On the basis of these known technical solutions, the applicant shall indicate one or more technical solutions which are closely similar in nature or technologically related to the applied-for invention by summarizing the nature, problems and limitations of the known technical solutions. These problems and limitations shall be presented in a precise, objective and not exaggerated way. The status of the related known technical solutions shall be clearly indicated, even when the applicant has no access to it.

d) Technical nature of invention

Technical nature of invention are methods required to achieve the purposes of an invention. Applicant shall fully describe the technical nature to sufficiently identify the nature of the solution.

The technical nature of an invention shall be described with an introduction of the main objectives that the invention aims to achieve or the problems to solve. The objectives or problems shall be presented in a detailed, objective, not of advertising nature and shall aim to solve the known problems or limitations of the closest technical solutions, which are described with the state of the art of the invention.

Applicant shall fully describe in detail the features (characteristics) of the technical solutions (basic technical features). Basic technical features are all of the technical features (characteristics) that are influential to the nature of the technical solutions and without them the claimed technical solutions

cannot be assembled and cannot achieve their intended purposes or solve the referenced problems. In particular, comparison between novel features of the inventions and known technical solutions, which are described with the state of the art of the invention, shall be clearly described. Possible features (characteristics) of the patent eligible subject matters are listed below:

- Possible features (characteristics) of products in the forms of tangible objects such as tools, structure, machine, device, components, electrical circuit, etc. (referred to hereafter as structure):

- (i) Components, groups of components and their functions;
- (ii) shapes of the components or groups of the components;
- (iii) materials of the components or groups of the components;
- (iv) dimensions of the components or groups of the components;
- (v) relative positions between the components or groups of the components;
- (vi) connections between the components or groups of the components;
- (vii) methods of production of the components or groups of the components.

- Possible features (characteristics) of products in the forms of materials such as materials, foodstuff, pharmaceuticals, etc. (referred to hereafter as materials):

For materials that are obtained from mechanical processes:

- (i) names of the components of the materials,
- (ii) qualities of the components of the materials,
- (iii) quantity of the components of the materials;
- (iv) mechanical processes of the components from which the materials are obtained.

For materials that are obtained from physicochemical processes:

- (i) names of the components of the materials,
- (ii) qualities of the components of the materials,
- (iii) quantity of the components of the materials;
- (iv) physicochemical processes of the components from which the materials are obtained;
- (v) physical structures or chemical properties to identify the materials.

For materials that are obtained from chemical methods:

- (i) structural formulas of the materials;
- (ii) structural formulas of the functional groups (when applicable);
- (iii) functions of the functional groups (when applicable);
- (iv) physical and chemical properties to identify the substances;

(v) for polymer substances: the general composition of the polymer substances; the composition of one or more polymer chains; end circuit groups; branched circuit groups; chemical composition and spatial composition; molecular mass;

(vi) physicochemical properties and sensory perceptions, etc. to identify the substances.

For materials that are obtained from biotransformation:

(i) physicochemical properties, sensory perception of the substances;

(ii) biological properties;

(iii) stability;

(iv) nutritional properties;

(v) pathways.

Possible features of pharmaceutical include pharmaceutical, pharmacological effects of the constituent elements and structure, test methods of the pharmacological effects in vitro and in vivo, relation between test results and pharmacological effects of the pharmaceuticals in reality, directions, contraindications, dosage, toxicity, how to use, side effects, interactions, method of production, types, characteristics of drug release in the body (quick release, sustained release, slow release, programmed release), etc.

- Possible features (characteristics) of products in the forms of biological materials:

For substances that are obtained from genetic technology (gene, protein, vector, recombinant vector, etc.):

(i) structural properties (amino acid sequences, nucleotide sequences, molecular mass, etc.);

(ii) functions;

(iii) biophysical and biochemical properties;

(iv) sources;

(v) acquisition methods.

For micro-organism:

(i) characteristic purebred morphology;

(ii) biophysical and biochemical properties of the micro-organism;

(iii) gene classification properties and chemical composition;

(iv) nuclear cell characteristics;

(v) marking traits (genetics, immunity, physiology, biochemistry);

(vi) biotechnological features (names and properties of useful substances produced by the respective microorganisms, activity, fertility), utility (function) of microorganisms if not production

microorganisms;

(vii) stable (sustained) properties that are useful when cultured for long periods of time,

(viii) toxicity, antigen structure, immunogenicity, characteristics such as carcinogenicity, antibiotic sensitivity, antagonistic properties (of microorganisms with medical and veterinary functions);

(ix) characteristics of parental microorganisms (couplers), hybridization principles (for hybrid microorganisms).

For separate animal and plant cell varieties:

(i) genealogy of the breed;

(ii) number of implants at time of making the description;

(iii) standard culture conditions;

(iv) properties of the breed;

(v) development characteristics (dynamics);

(vi) culture properties in animal bodies (for hybrids);

(vii) cytogenetic characteristics (cytology);

(viii) cell morphological characteristics;

(ix) data on the nature of the species (for animal cells including hybrids);

(x) methods of morphological derivation (for plant cells);

(xi) carcinogenicity (for animal cells including hybrids);

(xii) immune cell genetics, biochemistry and physiology marking traits;

(xiii) data on infection (by protozoa, fungi, bacteria, mycoplasma, virus ...);

(xiv) characteristics of biotechnology: names and properties of beneficial substances produced by cells, the level of activity (reproductive power), functions of varieties that are not production varieties;

(xv) information on stability to maintain useful properties when cultured for long periods, ...;

(xvi) methods of frozen storage.

For transgenic plants or animals, characteristic features are genes with specific functions introduced from outside to any plants or animals through transformation processes to give that plant or animals the functions of the genes (for example, the characteristic features of drought-resistant transgenic plants is that genes that are resistant to drought are introduced from the outside, ...).

- Possible features (characteristics) of processes (technological processes, diagnosis methods, forecast, analysis, handling,

manufacture, production, etc.):

- (i) procedures;
- (ii) order of the procedures;
- (iii) technical conditions (temperature, pressure, duration, catalyst agents, etc.) for the purpose of the procedures;
- (iv) apparatuses, devices to perform the procedures.

e) Brief description of drawings:

When there are drawings included in the detailed description to illustrate the nature of an invention, applicant shall separately list and briefly describe the technical types of drawing and names of the illustrated subjects. For example:

"Figure 1 is the top view of the structure ...;

Figure 2 is the cross section through line A-A on Figure 1."

f) Detailed description of embodiments of invention

Applicant shall describe one or more embodiments of a claimed invention so that any person of ordinary skills in the art can achieve the intended purposes or make use of the invention.

- Detailed description of embodiments of structural type inventions:

A structure shall be described by components and connections (static state) based on the symbols on the drawings. Symbols indicating the component/group of components, connection that form the structure shall be made consistent with the symbols on the drawings and shall immediately follow the name of the components and shall not be put inside brackets. Connecting features shall be fully described to include all of the technical characteristics of the structure in complete states. When needed, a description of an embodiment may include technological features that are used to produce the components or groups of components of the structure.

After the structure at static state has been described, operation of the structure or method of using the structure shall be described by showing each step of the operation, or the interactivity between the components, groups of components of the structure.

Frameworks and functions of a structure shall be fully described, unless these details are obvious. In some technical fields (such as computers), description of the function would be more appropriate than description of the structure.

- Detailed description of embodiments of inventions relating to composition of matter:

For a specific chemical compound with definite compositional formulas, compositional formulas, any known testing methods thereof, physical and chemical constants, processes from which the compound

is obtained shall be fully described. Functions and uses of the compound shall also be proven and listed in detail. For a compound with biological activities, quantitative characteristic indexes of the activities, of toxicity, and when necessary - selectivity of effects and other indexes shall be fully described.

For medicine used on human and animals, any discovered features, effects from using the medicines, cause of sickness, method of production, test result of toxicity and effect of the medicines, quantity, how to use the medicine and, if any, any side effects shall be described.

For a chemical compound obtained from biological materials, methods of biosynthesis which involve the material, data of the biological materials in case information on the deposit of the material is required.

For a group of chemical compounds with general compositional formulas, obtainability of all the compounds shall be described by providing general charts of the methods to obtain and examples of obtaining a specific compound of the groups. When the group contains compounds with chemically different radicals, sufficient examples to the acquisition of these compounds shall be provided.

For an obtained compound, general structure that has been proven with known methods, physical and chemical constants, proofs and confirmation of intended functionalities of compounds with chemically different radicals shall be described.

For a novel compound that are biologically active, biological activities and toxicity indexes, and in some circumstances, selectivity of effects and other indexes shall be described.

For substances (extract) obtained from medicinal materials (medicinal mixture) by extraction processes, pharmacological activities (functions) of the medicinal material (or each medicinal ingredient in the medicinal mixture) and the pharmacological activities (functions) of the substance (extract) obtained; specific composition of the medicinal mixture that produces the extract, conditions (temperature, pressure, catalyst agents, etc.) to obtain the substances (extract); physicochemical methods to identify the substances (extracts) (for example, spectrum photo of the substance (extract) obtained, submitted as supplementary documents with an Application); extractable active ingredients; directions of use; production methods of medicine from the extracts; test results of toxicity shall be described.

For an intermediate compound, processing methods of this compound

into final product or to a new substance with specific functions or specific biologically active properties shall be described.

For a mixed compound (solution, alloy, glass, concrete, ...), examples showing qualitative composition, i.e. constituent elements of the mixture, properties and ratio, properties of the mixed finished products must be clearly stated. An example of the process for preparing the mixture shall be described. When the mixture contains a new constituent element, process for preparing the new constituent element shall be described.

For a product with indefinite or complex structure (such as polymer) or product which is a mixture of many different constituent elements (such as extracts or fractions), the product may be identified by its preparation processes (for example, product X obtained from process Y), by physical and chemical parameters or by its properties, given that these features are sufficient to compare and contrast the product with other known products.

- Detailed description of embodiments of inventions relating to biological material:

The term "biological material" means any materials that contain genetic information and can self-regenerate or regenerate in the biological system.

For a biological material invention, catalog data and sources of the biological materials, data on qualitative and quantitative compositions of the culture medium, culture conditions (temperature, pH level, O₂ consumption/volumetric unit, illumination, ...), culture time, characteristics of biosynthesis of useful products (with purposes), product performance, activity level, fertility of strains and detecting methods thereof shall be described. Separation and refining methods of useful product (for primary producer of new useful products, such as antibiotic, enzyme, monoclonal antibodies, ...) should be described.

Complete information about the identification of properties of a biological material shall be described in cases the biological material is already available in public, or the biological material is known to a person having ordinary skill in the art, such as bread yeast or *Bacillus natto* available on the market, standard strains that can be preserved, or biological materials that are deposited at a competent depositary office and already available to the public. Inherent abilities of the biological material shall be described when the material is deposited to confirm the availability of the material. When the information is not available or incomplete, the

material shall be fully described so as to enable a person having ordinary skill in the art to implement the solution in compliance to Article. 62 of the Intellectual Property Law and Point 25.4.a of the Circular.

Besides the circumstances as regulated in Point 23.8.c of the Circular, when a biological material is not readily available to the public and cannot be described in an Application, any appropriate information on the properties of the biological material (if available to the applicant) shall be listed in order for a person having ordinary skill in the art to implement the solution.

Appropriate information is information related to classification of the biological material and the substantial differences from the known biological materials, including information on the biochemical characteristics, morphology and classification of the biological material.

When information on the biological material described on an Application is known to a person having ordinary skill in the art as of the filing date, the information shall be considered known to the applicant and the applicant shall confirm this fact. This information may be shown by tests according to appropriate standard document. For example, to determine the characteristics of bacteria, the appropriate standard documents are R.E. Buchanan, N.E. Gibbons: Bergey's Manual of Determinative Bacteriology. On this basis, detailed and appropriate information on every morphological and physiological characteristics to identify and regenerate biological materials, for example suitable environment, especially when the environment is transformed, need to be described.

When a deposited biological material cannot self-duplicate but needed to be duplicated in the biological system (for example virus, macrophage bacteria, plasmid, vector or free DNA or RNA), the information above is also needed for the biological system. For example, when different biological materials are needed like host cell or supporting viruses that cannot be fully described or not readily available, then they need to be deposited and identified. In addition, manufacturing processes of these biological materials in the biological system need to be described.

For an invention related to gene, nucleotide sequences of the gene, amino acids sequences of protein modified by the gene, any modifications in the nucleotide sequences, combination of amino acid with the function of the gene, any functions and physicochemical properties, manufacturing process of the gene shall be described.

The specification shall include a gene sequence section, namely nucleotide sequence or amino acid sequence, at the end in compliance to Point 23.8.a of the Circular (examiners could provide applicants with the requirements WIPO ST.25 or guide them to the relating information on the website: www.noip.gov.vn).

- Detailed description of implementation methods of inventions relating to processes:

Sequences of performing a process (tasks or steps), specific conditions (temperature, pressure, time, ...), structures, substances, and any biological materials used in the process shall be described. When a process is characterized by use of mediums (structures, substances, and biological materials) that have been known before the priority date of its Application, it is sufficient to mention only the names of the mediums. When new mediums are used, they shall be described in detail and in drawings (when needed).

For a process of obtaining a new group (or a series) of chemical compounds indicated by a general structural formula, example of at least the specific preparation of a compound by the process shall be described. When the group includes compounds with chemically different radicals, there need to be sufficient number of examples to demonstrate the obtainability of these compounds. For preparation of compounds that constitute a group (series), structural formulas proven by known methods and by physical and chemical properties shall be described. Information on the functions or any biological activities of the new compounds also needs to be described.

For a process of obtaining polymer compounds that do not have any definite formulas, necessary data are required to identify them, information on the primary reagents to obtain the compounds, information attesting to the achievability of the intended effect of the compounds such as information on the properties of the new use shall be described.

For a process of obtaining mixture that does not have any definite composition and structure with functions or bioavailability, examples relating to the process, order and condition to perform the process, necessary information on identifying the mixture, information attesting to the achievability of the intended effect of the mixture such as information on the properties of the new use shall be described.

For a process of obtaining products that are made of or contain materials of indefinite structure, information to identify the materials and products, data on the properties of the materials,

data on the technological characteristics of the constituent elements and/or the products shall be described.

g) Example of invention implementation:

The purposes of examples of invention implementation are to prove the industrial applicability and achievability of the intended purposes of an invention. Descriptions of the example are generally necessary for process and composition of matter inventions that involve specific technical conditions (temperature, pressure, duration, catalyst agents, ...) during the manufacturing process. For examples of invention implementation, one or more embodiments of the invention in specific forms shall be provided. When an invention is characterized by quantitative features, specific values of these features shall be indicated. When the feature is non-quantitative, definite statuses of the feature shall be indicated. After showing the features in definite states as above, specific results relating to the functions, purposes of the object shall be indicated.

For an invention relating to pharmaceutical, applicant shall describe its industrial applicability by showing test results of the effects of the substance/mixture used in the pharmaceutical.

Basically, the example shall demonstrate the following information:

- (i) tested substance/mixture;
- (ii) testing methods;
- (iii) test subject;
- (iv) test results;
- (v) correlation between the test results and an Application of the pharmaceutical in preventing, diagnosing and treating of diseases in reality. The amount of tested substance/mixture shall be sufficient to represent the substance/mixture described in an Application.

Industrial applicability of an invention relating to biological material may be proven by showing a location where the material can be obtained. Obtainability of the material may be proven by showing an obtaining method or providing documents on the deposit in compliance to the requirements in Point 23.8.c of the Circular, in which the deposit date shall be prior to the priority date of an Application.

h) Outstanding efficiency (effect) expected to be achieved
Applicant shall clearly and objectively address the outstanding efficiency of an invention in comparison to relevant known technical solutions.

Outstanding efficiency is direct efficiency obtained from technical

features of an invention, or efficiency as a result of the combination of these technical features.

Outstanding efficiency is an important criterion to determine whether an invention may demonstrate "outstanding progress" or not. Normally, outstanding efficiency may be expressed in the forms of productivity, quality, accuracy and efficiency enhancement, energy and material saving, simplifying or facilitating the handling, operation, management and use, or environmental pollution prevention, ...

Outstanding efficiency may be described by analyzing the structural features of the invention together with theoretical explanations or demonstration based on experimental data, and cannot rely solely on the applicant's declaration that the invention has achieved some forms of outstanding efficiency.

However, in any case, an invention shall be compared and contrasted with any relevant known technical solutions when explaining the outstanding efficiency of the invention.

In some specific cases, outstanding efficiency of an invention in mechanical or electronic field may be explained by analyzing structural features and operating manners of the invention. For an invention in chemical field, in most cases, explanations of outstanding efficiency based on experimental data would be more appropriate.

For matters whose measurements may not be obtained at the present time and assessment of these matters shall be based on human senses such as smell and taste, outstanding efficiency may be explained by statistical results from experiments.

When description of outstanding efficiency is based on experimental data, applicant shall provide necessary conditions and methods to implement the experiment.

5.7.3 Claim

5.7.3.1 Scope of an invention shall be determined by the content of the claim and this content is used to consider the patentability of the subject matter. The claim shall comply with the requirements set forth in Point 23.6.c-m of the Circular and with the following requirements.

5.7.3.2 General requirements on the claim

a) Each claim shall only mention one subject matter being claimed of

either product (structure, device, chemical composition, pharmaceutical, cosmetic, foodstuff, ...) or process (manufacturing process, modulation process, communication methods, treatment method, ...) and shall be written into a sentence.

b) Each claim shall demonstrate the technical nature of a claimed subject matter, including basic technical features that form necessary and sufficient collective to identify the claimed subject matter, to achieve the intended purposes, to distinguish the claimed subject matter from the known ones and shall not include languages that indicate commercial advantages (for example: "getting rich" or "aesthetically", ...). Purposes of the invention may be included in the claim when they support the identification of the claimed subject matter. Basic technical features may include not only technical features of structure, presence, ratio, status of the elements, sequences, conditions, ... but also functional features as long as any person of ordinary skill in the relevant art under normal condition may perform the functions without having to implement further inventive measures.

c) Features (characteristics) of a claimed subject matter shall be precise, and the languages used in the claim shall be consistent with those used in the detailed description, and shall be clear and widely acceptable in the relevant technical field so that a person of ordinary skill in the art may identify the claimed subject matter. Relativity terms such as "thick", "thin", "narrow", "tall", "short", ... may not be used unless these terms are accepted in specific fields, for example "high frequency" in amplifiers. Terms such as "for the best", "for example", "for instances", "in particular", "basically", "generally", "similarly", ... may not be used when inclusion of these terms would render the features (characteristics) of the claimed subject matter indefinite and inaccurate. Terms such as "about", "approximately" when used with specific value (for example "about 200°C", "approximately 300") may also not be used when such use may not help to identify the novelty and inventive steps of the invention compared to known technical solutions.

d) A claim may include mathematical formulas or chemical formulas but may not include drawings except in the circumstances as set forth in Point 23.6.g of the Circular. The claim may include charts when necessary.

5.7.3.3 Claim structure

a) The claim may include one or more claims, which include a single or a group of claimed subject matters. Each claimed subject matter is addressed by an independent claim and, when necessary, one or more dependent claims.

b) Independent claim and dependent claim

(i) An independent claim shall include all of the basic technical features (characteristics) that form a necessary and sufficient collective to identify the claimed subject matter, to achieve the intended purposes, to distinguish the claimed subject matter with the known ones.

(ii) A dependent claim is a claim that refer back to another claim or claims before it, containing all of the features

(characteristics) of the claims from which it depends and adding further features (characteristics) to develop the claimed subject matter into a specific variant. Dependent claims that share one or more additional features (characteristics) may be appropriately grouped into one dependent claim, which refers to one or more independent and dependent claims from which it depends.

c) Single claim

Single claim form is used to address a claimed subject matter with only one independent claim.

d) Multiple claims

(i) Multiple claim form is used to address one or more claimed subject matter (a group of matters to ensure unity).

(ii) When multiple claims are used to address a claimed subject matter, the claims shall include one independent claim and one or more dependent claims.

(iii) When multiple claim form is used to address a group of one or more claimed subject matters and these matters ensure unity in compliance with the requirements set forth in Point 23.3 of the Circular, the claim shall include multiple independent claims, each independent claim shall address one subject matter and each independent claim may have one or more dependent claims depending on it, in which:

- An independent claim (for each subject matter) may not refer to other independent claims, except when the reference allows the independent claim to be addressed without repeating all of the content of other independent claims (for example: "A device operating in compliance with the process of claim 1 ..."; "A method of making the substance of claim 1 ...");

- To an appropriate extent, all dependent claims that depend on a

same independent claim shall be grouped together following the corresponding independent claim to clearly identify and understand their meanings in a group of relating claims.

5.7.3.4 Principles of single claim

a) Independent claim

(i) An independent claim starts with the name of a claimed subject matter, followed by a description of the basic technical features (characteristics), that form a necessary and sufficient collective to identify the claimed subject matter, to achieve the intended purposes, to distinguish the claimed subject matter with the known ones.

(ii) When appropriate, an independent claim shall be presented in two parts in compliance to the requirements as set forth in Point 23.6 (i) of the Circular.

(iii) An independent claim shall not be presented in two parts when the subject matter is:

- A new chemical compound or a group of new chemical compounds;
- Industrial microbiological strain, plant and animal cell culture method;
- Without a comparable known matter;
- A combination of known features that establish the inventive steps;
- Changes (not additions) of a known chemical process, for example not using a particular substance in the process or replacing the substance with a different substance;
- A complex system comprising interconnecting parts, in which the inventive steps are established by changes of these parts or of the interconnectivity between them.

b) Dependent claim

A dependent claim starts with name of the claimed subject matter of the independent claim it depends on, followed by the order number of one or more claims it depends on, the word "wherein" or any other equivalent words, and one or more additional claimed features (characteristics).

Because a dependent claim does not inherently define all of the characteristic features of the claimed subject matter, phrases such as "distinguishable by" or "characterized by" may be used but not necessary. In cases where an independent claim is addressed in two parts, the dependent claim may add further details that are not specified in the Restriction or Distinction parts.

5.7.4 Drawings

The specification may include one or more drawings to illustrate the invention. Drawing types may include perspective views, 3D projection views, cross sections, details drawings, charts, diagrams, schemas, graphs when necessary to clarify the nature of the invention. In cases where the drawing cannot fully illustrate the invention, black and white photos may be used. The drawing shall satisfy the following requirements:

- a) Comply with the requirements on technical drawings;
- b) Drawn in black lines on one side of white plain A4 sheet. The lines shall be clear, consistent and not colored. The lines shall be drawn with the assistance of drawing tools except in cases where the tools are not applicable such as irregular diagram and structure.
- c) The drawing may only include measurements when such measurements are necessary to identify the nature of the solution addressed in the description.
- d) The scales and resolutions of the drawing shall be suitable so that the details on the drawing is visibly clear when scanned at 2/3 of the original size.
- e) The drawing may not include letters except when it is necessary to clarify the drawing, single words or a few brief words such as "water", "vapor", "close", "open", "cross section at A-A" are acceptable and shall be arranged so that they shall not obscure the lines of the drawing. Numbers, words, and other symbols shall face the same way as the drawing they are on. Indicating lines connecting the symbols with the details may be straight lines or curves and shall be as shortest and clearest as possible.
- g) Symbols that are not mentioned in the description may not be used on the drawing and vice versa. Each detail shall correspond to a symbol on all of the drawings and anywhere in the content of an Application. However, when the description includes a number of embodiments of the invention, each embodiment refers to one or more specific drawings, and when each embodiment includes details whose functions are basically similar and have been addressed in the description, these details may be indicated by numbers that start with the ordinal number of the embodiment or drawing to which they correspond, and followed by the respective number of each detail as used across all embodiments, for example a common detail "12" may be indicated with the number "112" for the first embodiment and "212" for the second.

- h) All drawings shall be grouped together on separate sheets dedicated only for drawings and may not be included with the specification, claim or abstract. Drawing pages shall not be framed.
- i) When one or more drawings are needed to illustrate the abstract, then the drawing used shall represent the invention in its fullest and shall be selected from the list of drawings included in the Application. Entirely new and different drawings made specifically for the abstract are not acceptable.
- k) To a certain extent, all drawings shall be arranged in an upright position on the page. When a drawing's length is longer than its height, then it may be positioned sideways with the top of the drawing at the left side of the sheet.
- l) Multiple drawings may be included on a page. In this case, the drawings shall be positioned with the tops facing the same direction.
- m) Where figures on two or more sheets form in effect a single complete figure, the figure on the several sheets shall be so arranged that the complete figure may be assembled without concealing any part of any of the figures appearing on the various sheets. In other word, figures on a particular page do not include any parts of figures on another page.
- n) Drawing pages shall also be numbered in Arabic numerals. Numbering may either be in succession to the pages of the specification and claims or restarted from the first page with the number 1 to the end.
- p) Separate drawings shall be numbered consecutively in Arabic numerals. Drawing numbers shall follow the words "Figure" or its abbreviation "Fig." (for example: Figure 1 or Fig.1). Drawings shall be numbered even when they are the only drawing in their respective Application.

5.7.5 Abstract

An abstract shall comply with the requirements set forth in Point 23.7 of the Circular. In particular, the abstract shall be short (no more than 150 words) and summarize the nature of the invention as disclosed in the description, claim and drawing. The abstract shall disclose the main features of the nature of the invention and shall not include languages that indicate advertising nature.

Where an invention is a substance, the abstract may include the most characteristic formula of the substances.

An abstract may be illustrated by the most characteristic drawing.

5.7.6 A subject matter is not fully disclosed in the following cases:

- a) When the subject matter described in the specification is different from the subject matter referred to in the claim, and/or the abstract;
- b) When the specification does not contain sufficient information on the nature of the subject matter (in other word, the specification does not fully describe the subject matter);
- c) When the claim does not have sufficient information on the nature of the claimed subject matter (in other word, the claim does not define the subject matter for which protection is sought)
- d) There are inconsistencies in the expression of the subject matter in relevant documents, however not to the extent that these subject matters described in different documents are themselves different.
- e) The description lacks some information, or the expression does not comply with the requirements on description;
- f) The claim does not comply with the requirements on claim;
- g) The abstract does not comply with the requirements on abstract;
- h) Absence of drawings, charts, ... when it is obvious that these documents are necessary to illustrate the nature of the claimed subject matters.

5.8 Evaluating the eligibility of a subject matter

5.8.1 Assessment of a subject matter in compliance to Clause 1 of Article 8 of the Intellectual Property Law

According to Clause 1 of Article 8 of the Intellectual Property Law, the policy of the government on Intellectual Property is to recognize and protect the Intellectual Property rights of organization and individual on the basis of harmonizing the benefits of the right holders and of the public. Subject matters which are contrary to the morality of society and public order, or dangerous to national defenses and securities are not protectable. This means Patent or Utility Solution certificates shall not be issued for inventions whose disclosure, uses or exploits that violate the laws or are contrary to the morality of society and public order, or dangerous to national defenses and securities. Interpretations of the laws, morality of society and public order are broad and are subjected to changes over time and regions. Sometimes, certain regulations may be supplemented or discarded due to introduction of

new laws or amendments and nullification of existing laws. Examiners shall take great consideration in this regard when assessing subject matters.

5.8.1.1 Inventions that violate the regulations of the Government

Any means and tools used to conduct gambling, drug paraphernalia, devices to make counterfeit money, receipts, official documents, identifications, seals, relics are not protectable for violating the regulations.

When an invention does not violate the regulations, however its misuse could eventually violate the regulations of the government, the invention may still be protectable. For example: poison, anesthetic, sedative, tonic for medical use, recreational playing cards and chess boards.

5.8.1.2 Inventions that are contrary to the morality of society and public order

The term "morality of society" refers to ethical standards and behavioral rules that have been generally accepted by the public. Their interpretations are based on certain cultural backgrounds, subjected to changes over time and civilization, and differentiated by regions.

When disclosure and exploitation of an invention are contrary to the morality of society then the invention shall not be protected. For example: fake or replacement genitalia that are not for medical use, mating methods between human and animal, processes of changing the genetic uniformity of human embryo or mutated humans as results of the processes, cloning processes of human or human clone, use of human embryos for industrial and commercial purposes, processes of transforming animals' genetic uniformity that is potentially painful to them while not gaining any significant medical benefits for both human and animals.

The term "harmful to public order" means exploitation and use of inventions will cause harm to the public or society or disrupt public order of the government.

When exploitations and uses of an invention may cause injury or harm to human, or cause damage to property, for example anti-theft devices or processes that cause the thief to go blind, the invention shall not be protected.

If the exploitation or use of an invention can cause serious environmental pollution, seriously waste energy or resources,

destroy ecological balance, or affect public health, the invention will not be protected.

When an Application contains words or images that mention important political events of the government, preach religious beliefs, hurt the feelings of people or an ethnic group, or show support of superstition, the invention shall not be protected.

When an invention is capable of causing harm to the public when being misused or having negative effects, however, possesses certain positive effects, for example medicines with side effects on human, shall not be refused protection on basis of potentially causing harm to the public.

5.8.1.3 Inventions that are dangerous to national defenses and securities

Nuclear transformation methods and substances obtained from these methods are related to national interests in economy, national defenses, scientific research and public security and may not be monopolized by individual or organization. Therefore, they are not protectable.

Nuclear transformation methods are processes in which one or more atomic nuclei form one or more new atomic nuclei by atomic decay or fusion, for example magnetic trap and atomic trap methods to perform nuclear fusion and nuclear decay reactions. These methods are not protectable. However, particle acceleration methods to increase the particle's energy to perform nuclear modification (for example, method of electronic acceleration by waves, method of electronic acceleration by standing waves, electronic collision method, cyclic electronic acceleration method, ...) are not nuclear transformation methods, and therefore are protectable.

Devices and means, and the parts thereof for use in nuclear transformation methods are protectable.

Substances obtained from nuclear transformation methods are primarily radioactive isotopes that are made or manufactured by accelerators, or any types of nuclear reactor. These radioactive isotopes are not protectable.

However, devices and tools used in the creation of radioactive isotopes are protectable subject matters.

5.8.1.4 A subject matter seeking protection under circumstances as set forth in Clause 1 of Article 8 of the Intellectual Property Law and specified from Point 5.8.1.1 to 5.8.1.3 above may not be

protected. When all or part of a subject matter in an Application belong to the circumstances above, for example when an Application containing subject matters such as "drug manufacturing device", "gambling device", the examiner shall issue a notification to a intended refusal citing the reasons and requesting the applicant to either traverse the refusal or remove the relevant portions within a given time limit. When the applicant denies that the subject matter falls within the circumstances as set forth in Clause 1 of Article 8 of the Intellectual Property Law or when the applicant refuses to remove the relevant portion of the invention without any legitimate reasons, the examiner shall refuse acceptance of the Application.

5.8.2 Assessing a subject matter in compliance to Article 59 of the Intellectual Property Law

Assessment of whether a claimed subject matter is not protectable by patent in compliance with Article 59 of the Intellectual Property Law shall be performed with the following criteria:

5.8.2.1 Discovery

Discovery is the detection of an object, a phenomenon, a property, ... that is already present in nature but not yet recognized before. For example, the discovery of a new characteristic of a known material or substance is not protectable by patent because the discovery of the characteristic does not have any technical solution. However, an Application for practical applications of the characteristic may be protectable by patent. Discovery of a known material that is resistant to mechanical impact is not protectable by patent, however railway sleepers made of this material is a subject matter protectable by patent. The discovery of photosensitive properties of silver halide under the light is not protectable by patent, however photographic film and film production process based on this discovery are subject matters protectable by patent.

5.8.2.2 Scientific theory

Scientific theory has broader term than discovery, and other applicable principles. For example, physical theory of semiconductor is not protectable by patent. However, semiconductor devices and manufacturing process of these devices may be protectable by patent.

5.8.2.3 Mathematical method

Mathematical methods are specific example of purely abstract methods

and are not protectable by patent. For example, a method of quick division calculation is not protectable by patent, however a calculator made to perform this method may be protectable. A mathematical method for use in the making of electric filters is not protectable by patent, however the electric filters made from this method may be protectable.

5.8.2.4 Chart, plan, rule and method of mental activity, animal training, game manual and business

Mental activity is the thinking of human. They derive from human thought and produce abstract results through inference, analysis and evaluation, or, through human thought produce results by indirectly affecting nature. Rules and methods for mental activities are those that govern thinking, expression, evaluation and memory. Because they do not use technical means or apply the laws of nature, solve any technical problems, create any new technical efficiency, they do not constitute any technical solutions. Therefore, rules and methods instructing people how to perform this type of activity are not protectable by patent.

To determine whether a claimed subject matter including rules and methods on mental activities in an Application may be protectable, the examiner shall follow the following guidelines:

- When the claimed subject matter only refers to rules and methods relating to mental activities then they are not protectable by patent.
- When the claimed subject matter, apart from the name of the subject matter, is defined mainly by rules and methods relating to mental activities, then it is only related to these rules and methods of mental activities, and therefore is not protectable by patent.

Examples of these types of claimed subject matter include: methods of patent examination as to substance; methods and systems of managing an organization, managing a production, managing business or financial activities, ...; traffic rules, competitive rules and plans; methods of thinking, deduction and calculation; methods of book classification, methods of dictionary compilation, methods of information searching, methods of patent classification; methods and rules of calendar compilation; user manuals of devices and tools; grammar of languages, coding rules of characters; computer languages, rules of computer usage; quick calculation methods and shortened formulas; mathematical theories and conversion methods;

methods of psychological testing; methods of teaching, presenting, educating; methods of animal training; rules and methods of playing games or entertaining; statistical and calculation methods, ...; music book, cooking book or chess book; methods of maintaining health and wellness; methods of health examination, methods of census; ...

However, when all of the content of a claimed subject matter includes not only rules and methods relating to mental activities but also description of a device or technical process to perform at least some parts of the rules and methods with specific technical features, the claimed subject matter, when examined as a whole, is not merely rules or methods relating to mental activities and shall not be refused protection in compliance with Article 59 of the Intellectual Property Law.

5.8.2.5 Computer program

An invention relating to computer program is "an invention performed by a computer", this term refers to a subject matter that is related to computers, computer networks or any programmable devices that one or more technical features of the claimed subject matter are performed by the program(s).

Although a computer program belongs to a subject matter not protectable by patent, when a claimed subject matter includes technical features and is truly a technical solution, in order to solve a technical problem through technical means to achieve technical efficiency, then the claimed subject matter may be protectable by patent. For example, methods of data processing performed by computer programs that in theory may be performed equivalently by special circuits, and performing the programs always results in physical effects, for example electrical circuits, such conventional physical effects themselves are not enough to render the programs technical. However, if a computer program, when run on a computer, creates technical efficiency other than conventional physical effects, the program may be protectable by patent. Non-conventional technical efficiencies may have been known in the state of the art. These technical efficiencies may be present, for example, in the control of an industrial process, in the data processing representing physical entities or in the performance of the functions of the computer or its interface under influence of the program, and may, for example, affect the efficiency or safety of the process, the management of computer resources or data transmission speed. Therefore, a computer program may be protectable

by patent if the program, when run on computer, may create technical efficiencies other than conventional interactions between the program and the computer.

However, even when a computer program may be protectable by patent in the cases above, subject matters referred to in the claims that are named by terms such as "computer program", "computer software", "computer software/program product", or "program carrying signals", and other equivalent terms are not acceptable. Computer programs may be protectable under subject matters, for example, methods of operating a conventional device, programmed devices to perform functions, program storing medium to perform functions.

5.8.2.6 Information presentation method

An information presentation method that is only identifiable by the content of the information is not protectable by patent. This applies to presentation of information (for example, by audio signal, spoken words, visual indicators, books identified by their topics, cassettes identified by the recorded music) and devices and processes of presenting information (for example, indicator set or recording devices that are only identifiable by the indicated or recorded information). However, when a presentation of information contains new technical features then the objects that carry the information or the devices and processes that present the information may be protectable by patent. An arrangement or manner of presenting, not related to the content of the information, is a technical feature that may be protectable. For example: telegraph equipment, communication systems using a common code to present characters (pulse code modulation), measuring devices designed to create a special form of graph that represents measurable information; music tapes having special groove format to allow stereo recording.

5.8.2.7 Aesthetic solution

Aesthetic solution involve items (for example, a painting or a sculpture) do not have any technical feature and are perceived purely based on subjectivity. However, if these items contain technical features, for example: tire tread, they may be protectable by patent. A solution, even a product or a process, is not protectable where it only results in aesthetic efficiency. For example, an invention for the aesthetic efficiency of the content, arrangement or word font of a book is not protectable by patent.

However, when aesthetic efficiency is obtained by technical means or structures, the aesthetic efficiency itself is not protectable, but the medium used to obtain the efficiency may be protectable by patent. For example, a piece of fabric made to look attractive due to a layered structure that has never been used for this purpose, in this case, the fabric with the specific structure may be protectable by patent. Similarly, a book defined by the technical features of stitches or perfect bindings may be protectable by patent, even when these features also have aesthetic efficiency. In addition, a process used to create aesthetic items may be considered to have technical improvement and may be protectable by patent. For example: diamond may have nice forms, which are created by new technical processes. In this case, the manufacturing process of diamond may be protectable by patent. Similarly, a new printing technology used to make special arrangement with aesthetic efficiency may be protectable by patent.

5.8.2.8 Plant and animal variety, production process for plant and animal that is essentially biological in nature, not microbiological According to Article 59 of the Intellectual Property Law, plant and animal varieties are not protectable by patent.

However, an invention relating to plant and animal may be protectable by patent when technical features of the invention are not limited by the specific plant or animal variety.

A process used to create new plant and animal varieties may be protectable. A production process is a process not of biological nature and does not include plant and animal creation via processes of biological nature.

Whether a process is considered a "process of biological nature" depends on the level of technical intervention by humans during the operation of the process. When technical intervention by human is the controlling or deciding factor for getting results or efficiency from the process, the process is not of biological nature. For example, a method of feeding high-yield dairy cows by irradiation and a method of creating clean pork due to improved farming methods are protectable by patent.

An invention relating to microorganisms is one that refers to the creation of chemical substances (antibiotics) or decomposition of a substance by microorganisms such as bacteria, mold, and viruses. Microorganisms and microbiological processes are protectable by patent when they do not belong to the subject matters referred to in

Clause 1 of Article 8 of the Intellectual Property Law.

5.8.2.9 Method of medical prevention, diagnosis, and healing for humans and animals

a) Method of diagnosis

A method of diagnosis to identify and determine the causes or sources of disease performed directly on live human or animal bodies is not protectable by patent.

However, tools and devices used to perform the method of diagnosis or substances and materials used in the method are protectable by patent.

A method of diagnosis includes the following two features:

- (i) It is performed directly on live human or animal bodies; and
- (ii) Its immediate purposes is to diagnose the illnesses or health status.

When an invention, as described in the specification, is performed on in vitro specimens, but its immediate purposes is to obtain diagnosis results of the illness or health status for subject matters of the same type, the invention is not protectable by patent.

When a process includes diagnosis steps or experiment steps (when there are not any diagnosis steps), and results of diagnosis or health status that may be achieved immediately based on diagnostic information or the results of experiment obtained in accordance with known medical knowledge in this field of the art and disclosed information in an Application, the process shall be considered to have feature (ii) as stated above.

Examples of diagnosis methods not protectable by patent:

Methods of blood pressure measurement, methods of pulse diagnosis, methods of health diagnostic, methods of diagnosis by X-ray, methods of diagnosis by supersonic, methods of stomach and intestines diagnosis by X-ray, methods of endoscopic diagnosis, methods of diagnosis by isotopic markers and methods of infrared diagnosis without interfering with the body, methods of risks assessment of infected illnesses, methods of predicting therapeutic effects on illnesses, methods of diagnosis through gene screening.

Examples of methods that are not diagnosis methods:

- (i) Methods of pathological anatomy performed on human and animal corpses;
- (ii) Methods whose immediate purpose is to obtain information from live human or animal bodies for intermediate results instead of

diagnosis results or health statuses, or methods of processing such information (for example, physical and physiological parameters);
(iii) Methods whose immediate purpose is to process or experiment on body tissues, body fluids or feces that have been extracted from human or animal bodies to obtain information for intermediate results instead of diagnosis results or health statuses, or methods of processing such information.

For points (ii) and (iii) above, only when diagnosis results and health statuses may not be obtained immediately based on the information obtained in compliance with known medical knowledge in the field of art and information disclosed in an Application, the information shall be considered intermediate results.

b) Method of treating illness

A method of treating illness is a process used to prevent, alleviate or eliminate the etiology or the foci so that human or animal bodies may recover or achieve health or relieve the pain.

A method of treating illness includes the steps that meet a curative purpose or are of a curative nature, steps of prevention and immunomodulation.

For a method that may meet both healing and non-healing purposes, when not fully described that the methods are for non-healing purposes, the method is not protectable by patent.

However, instruments or devices performing therapeutic methods or substances or materials for use in these methods are protectable by patent.

Examples of methods of treating illness:

(i) Surgical treatments, therapeutic methods with pharmacological and psychological therapy;

(ii) Methods of acupuncture, anesthesia, massage, qigong, hypnosis, healing bath, air bath, sunbathing and care for therapeutic purposes;

(iii) Methods of stimulating or irradiating a human or animal body with electric, magnetic, sound, light or thermal radiation, ... for therapeutic purposes;

(iv) Methods of creating wrap films, freezing, or thermodynamic power for therapeutic purposes;

(v) Immunological methods to prevent disease;

(vi) Complementary methods to enable surgery and pharmacotherapy, for example methods of processing cells, tissues or organs to be returned to their host bodies of the same type, methods of hemodialysis, methods of anesthetic dose test, methods of consuming

medicines, methods of injection, methods of using medication outside of the body.

(vii) Methods of fertilization, contraception, increasing sperm count, extracellular fertilization, embryo transfer for the purpose of curing diseases;

(viii) Methods of cosmetic surgery, stretching the limbs, reducing weight, increasing height, for healing purposes;

(ix) Methods of treatments for human or animal wounds, such as antiseptic or bandage treatments;

(x) Other methods, such as artificial respiration and oxygen therapy for therapeutic purposes.

Curing methods using drugs are not protectable by patent, however the drugs themselves may be protectable by patent.

Examples of methods that are not curing methods and are not exempted from patentability:

(i) Methods of making artificial limbs or prosthetic parts, and measurement methods for such artificial limbs or prosthetic parts. For example, methods of making dentures, including making dental mold in patient's mouth and making dentures outside of oral cavity. Although the ultimate goal is to cure diseases, the purpose of the method itself is to make proper dentures.

(ii) Methods of breeding animals by treating animals with non-surgical methods to alter their development characteristics, such as methods of applying electronic stimulation to live lambs to increase their growth rate, meat quality or wool production;

(iii) Methods of animal slaughter except humans;

(iv) Methods of handling human or animal carcasses, such as anatomical, make-up, sterilization, or sampling methods;

(v) Methods that are of cosmetic nature only, that is, methods that are of cosmetic nature only that do not interfere with the human body or do not form wounds, which include methods of deodorizing, protecting, decorating or beautifying for non-therapeutic purposes, performed directly on a portion of visible body parts such as skin, hair, nails, and outside of teeth.

(vi) Methods that make people or animals that are not sick comfortable or satisfied, or methods that provide oxygen, negative oxygen ions or moisture in special conditions, for example to avoid or protect against toxic gases.

(vii) Methods of killing bacteria, viruses, lice, or fleas on human or animal bodies (on skin or hair, except for wounds and infected areas).

c) Method of surgery

A surgical method includes procedures that involve creating wounds or interfering with the body such as incision, cutting, stitching, and tattooing performed on live human or animal bodies with the help of instruments. The method is not protectable by patent. However, when a surgical method is performed on human or animal corpses then it may be protectable by patent unless it violates Clause 1 of Article 8 of the Intellectual Property Law.

Surgical methods are divided into two types, one for therapeutic purposes and the other for non-therapeutic purposes.

(i) Surgical methods for therapeutic purposes are therapeutic treatments and are not protectable by patent according to Article 59 of the Intellectual Property Law.

(ii) Surgical methods for non-therapeutic purposes do not have practical applicability because these methods are performed on live human and animal bodies and do not have industrial applicability. For example, methods of cosmetic surgery, methods of removing foreign material from the stomach of live cattle by surgery, supportive methods for diagnosis, such as surgical procedures performed prior to coronary angiography, ...

5.8.2.10 A subject matter sought to be registered under the circumstances set forth in Article 59 of the Intellectual Property Law and specified from points 5.8.2.1 to 5.8.2.9 above is not protectable by patent. When all of the contents of an Application belong to a circumstance of Article 59 of the Intellectual Property Law, for example: "methods of discovering new asteroids", "diagnostic methods for human diseases", the examiner shall issue a Notice on rejecting the Application as to formality, specify the reasons thereof and allow the applicant to respond within a given time limit. When the applicant's response fails to prove that the claimed subject matter does not belong to the circumstances, the examiner shall issue a Decision on rejecting the Application. When a portion of an Application belongs to the circumstances and is inseparable from the remainder of the Application, the examiner may decide on this part later during the substantive examination.

5.8.3 Examination of a subject matter in compliance with Clause 12 of Article 4 of the Intellectual Property Law

5.8.3.1 According to Clause 12 of Article 4 of the Intellectual Property Law, an invention is a technical solution in the form of either a product or process.

5.8.3.2 A subject matter does not meet the requirements of Clause 12 of Article 4 of the Intellectual Property Law in the following circumstances:

a) The subject matter referred to in an Application is not a technical solution in compliance with Point 25.3.c of the Circular, particularly:

(i) The subject matter referred to in an Application is only an idea or scheme, reference to a problem without offering any solutions to the problem nor answering the question "how to" and/or "by what means";

(ii) The problems (missions) set to solve are not technical problems and may not be solved by technical means;

(iii) Natural products, instead of human creations.

b) The subject matter referred to in an Application is not a technical solution in the form of either a product or a process

5.8.3.3 During the formal examination, when the content of an Application describes technical features of an "invention", the examiner shall not have to examine whether the features are really technical solutions or whether the technical solutions may be performed. Nonetheless, an Application only describes technical parameters, benefits or effects without describing any technical solutions or technical contents, the examiner shall issue a notice on rejecting the Application as to formality, specify the reasons thereof and allow the applicant to respond within a given time limit. When the applicant fails to respond within the given time limit, the examiner shall issue a decision on rejecting the Application. When the applicant's response does not address the issues, the examiner shall issue a Decision on rejecting the Application.

5.9 Preliminary examination of the unity of an Application

5.9.1 Unity of an Application with more than one independent claim needs to be examined in compliance to Article 101 of the Intellectual Property Law and Point 23.3. of the Circular.

5.9.2 An application does not meet the requirements on unity of Article 101 of the Intellectual Property Law and Point 23.3. of the Circular when it includes more than one independent claim and the subject matter described by these claims is not technically related to form a single creative idea.

5.10 Examination of a request for priority claims

5.10.1 Priority right of an Application is recorded and the priority date of the Application is determined by Point 13.5 of the Circular when the following requirements are met:

- a) Priority claims are indicated on the corresponding section of the Application;
- b) Basis for priority claim shall meet the requirements set forth in Clause 1 of Article 91 of the Intellectual Property Law, Point 10 of the Decree;
- c) Copy of the priority Application with certification from the receiving Office of the priority Application (original Application);
- d) Vietnamese translation of the certified document from the receiving Office of the priority Application, usually the first page of the copy of the priority Application, which is filed within the time limit given.

5.10.2 Priority right of an Application is not acceptable when it does not meet one of the requirements mentioned from item 5.10.1.b to 5.10.1.d.

- a) Basis for priority claim of the Application does not fully meet the requirements set forth in Clause 1 of Article 91 of the Intellectual Property Law, Point 10 of the Decree;
- b) Copy of the priority Application with certification from the receiving Office of the priority Application (original Application) is absent;
- c) There is no Vietnamese translation of the document attesting to the basis for priority claim as required at Point 7.3.c of the Circular, to identify the information of the applicant in the priority Application is absent.

5.11 Examination of International Patent Classification number

5.11.1 Examiner shall examine whether applicant correctly classifies the claimed technical solutions in compliance with the most recent

edition of the International Patent Classification (Strasbourg Agreement) published by the National Office of Intellectual Property on the Official Industrial Property Gazette.

5.11.2 The International Patent Classification section shall not be acceptable when:

- The applicant does not classify the invention;
- The classification number does not match the nature of the subject matter mentioned in the Application.

In the circumstances above, the examiner shall issue a notice requesting the applicant to amend the Application. When the applicant does not amend the Application, the examiner shall classify the invention and the applicant shall have to pay a fee for the service in compliance with Point 23.5 of the Circular.

5.12 Examination of fees

5.12.1 To examine the fees, the examiner needs to compare the payment receipt submitted with an Application with section 8 "Fees" indicating the fees and receipt number (when the fees are paid via post office or bank transfer) on the Application and the number of pages, claims, drawings that need to be disclosed and other documents that have fees imposed.

An Application shall satisfy the requirements on fees when the following fees have been paid : application fee, publication fee, priority claim fee (when there is a request for priority claim), classification fee (in case the National Office of Intellectual Property classifies the invention for applicants), substantive search fee, substantive examination fee -as regulated at Points 8.1 and 8.2 of the Circular (when the applicant requests for substantive examination at filing). For divisional Application, the applicant shall pay Application fee and other fees except priority claim fee as regulated at Point 17.2.c of the Circular.

5.12.2 An Application shall be deemed not to meet the fee requirements when at least one of the application fee, publication fee, priority claim fee (when there is a request for priority claim), classification fee (in case the National Office of Intellectual Property classifies the invention for applicants), substantive search fee, substantive examination fee - as regulated at Points 13.3.b, 17.2.c and 23.5 of the Circular (when applicants

request for substantive examination at filing) is absent or not fully paid.

When application fee, publication fee and classification fee (if performed by the National Office of Intellectual Property) are not fully paid, an Application shall not be accepted and the examiner shall issue a notice to the applicant. When the applicant fails to complete the payment within the time limit, the Application shall be refused acceptance. When the fees for requesting priority claim or the fees for other requests during the formal examination are absent, the examiner shall issue a notice to the applicant. When the applicant fails to complete any payments within the time limit, the respective requests shall not be performed.

Article 6. Errors that render Application unacceptable as to formality

An Application with one of the errors as regulated at 4.3.2.1, 4.4.2.a, 5.5.2, 5.8.1.4, 5.8.2.10, 5.8.3.2.

Article 7. Errors that render Application unacceptable as to formality and that applicants shall fulfill in order for an Application to be acceptable

An Application with one of the errors as regulated at 4.2.2, 4.3.2.2, 4.3.2.3, 4.3.2.3, from 4.4.2.b to 4.4.2.d, 5.3.2, 5.4.2, 5.6.2, 5.7.6, 5.9.2, 5.10.2, 5.11.2; 5.12.2.

Article 8. Notice of provisional rejection of Application

8.1 A Decisions on an Application being not accepted as to formality shall be indicated on a notice on intended refusal to accept an Application, which is published on IPAS system.

8.2 When an Application has at least one of the errors as listed at Article 6 above, the Application shall not be accepted as to formality. The applicant shall be notified of the errors in the Application and shall be given a time limit of 01 month counted from the issuance date of the notification to respond to the decision. The applicant shall be notified of the final refusal to accept the Application as to formality when the time limit has passed and the applicants do not respond to the decision of the National Office of Intellectual Property or the responses are not substantial. The notification shall follow Notice form 224 on the IPAS system.

8.3 When an Application have at least one of the errors as listed at Article 7 above, an Application shall not be accepted as to formality. The applicant shall be notified of the errors in the Application and shall be given a time limit of 01 month counted from the issuance date of the notification to respond to the decision. The applicant shall be warned of the provisional refusal to accept the Application as to formality when the time limit has passed, and the applicant does not amend the Application, or the amendments are not satisfactory.

The notification shall follow Notice form 225 on the IPAS system.

8.4 The time limit for an applicant to submit its response to the decision on an Application as mentioned at items 8.2 and 8.3 above may be extended once as regulated at Point 9.2 of the Circular. A request for extension of time to submit responses shall be filed with the payment receipt for the request before the deadline. A request for extension of time to submit responses shall not be accepted when the required fee is not paid, or even when the fee is paid but the request is filed after the deadline indicated in the Notice of the National Office of Intellectual Property.

Article 9. Decisions on refusal of Application as to formality

9.1 A formal conclusion of the finding that an Application is not acceptable as to formality shall be indicated on "Decisions on refusal of Application as to formality" made in the IPAS system (notification form 223 of the IPAS system).

9.2 When an Application belongs to one of the circumstances of Article 8.2 of this Regulation and after the deadline has passed (even when Article 8.4 is applicable when appropriate), the applicant does not respond to the conclusions of the National Office of Intellectual Property or the responses are not substantial, the examiner shall issue "Decisions on refusal of Application as to formality" with the reasons that the Application contains errors as indicated in Article 6 of this Regulation.

9.3 When an Application belongs to one of the circumstances of Article 8.3 of this Regulation, and after the deadline has passed (even when Article 8.4 is applicable when appropriate), the applicant does not correct errors or corrections are not satisfactory, the examiner shall issue "Decisions on refusal

Application as to formality" with the reasons that the Application contains errors as indicated in Article 7 of this Regulation.

Article 10. Determination of filing dates

10.1 Filing date is the date on which an Application arrives at the National Office of Intellectual Property as regulated at Point 13.4 of the Circular.

10.2 In circumstances where the Application does not guarantee unity and applicants divide the Application within the time limit as regulated at Point 8.3 of this Regulation (or Point 8.4 of this Regulation when appropriate) or in circumstances where applicants voluntarily divide the Application, the filing dates of the initial Application and the divided Application are determined in compliance with Point 10.1 above.

10.3 For international Application, the filing date is determined in compliance with Point 13.4.b of the Circular.

Article 11. Determination of priority dates

Priority date is determined in compliance with Point 13.5 of the Circular and specified as follows:

11.1 When a priority claim is not requested, an Application shall be deemed not to have priority date.

11.2 When a priority claim is requested but no documents attesting to the priority right (documents mentioned at Point 7.2.g, 7.3.c and 7.4 of the Circular) or the documents are not legitimate, the request shall not be accepted and the Application shall be deemed not to have priority date.

11.3 When a priority claim is requested and there are legitimate documents attesting to the priority rights, the request shall be accepted, and the priority date of an Application shall be date on which the requests state.

11.4 When multiple different priority claims are requested, determination and acceptance of the priority rights corresponding to each priority date shall follow the rules of points 11.2 and 11.3 above.

Article 12. Decision on acceptance of Application as to formality

12.1 Conclusion on acceptability of an Application is indicated on "Decision on acceptance of Application as to formality" made on the IPAS system (notification form 221). Priority date and application date of accepted Application are determined in compliance with Article 10 and 11 of this Regulation.

12.2 An Application is accepted as to formality in the following circumstances:

12.2.1 An Application does not have any errors as mentioned in Article 6 and 7 of this Regulation.

12.2.2 An Application belongs to the circumstances mentioned in Article 6 of this Regulation, and within the time limit, the applicant submits a substantial response to the National Office of Intellectual Property.

12.2.3 The Application belongs to the circumstances mentioned in Article 7 of this Regulation, and the applicant substantially corrects the errors within the time limit, the Application shall be accepted.

Article 13. Duration of formal examination

13.1 The duration of a formal examination shall be 01 month from the filing date as regulated in Point 13.8 of the Circular.

13.2 Each time an applicant amends the submitted documents or adds documents to an Application during a formal examination, either voluntarily or under request from the National Office of Intellectual Property, the duration of the examination shall be extended for an additional one month from the receiving date of the added, amended documents.

13.3 At the latest of 3 working days before the deadline regulated in points 13.1 and 13.2 above, either one of the notices on intended refusal to accept an Application, a Decision on acceptance of Application as to formality or a Decisions on refusal of Application as to formality shall be completed and submitted to the Head of the Department for approval before sending to the applicant.

Article 14. Application processing after the conclusion of a formal examinations

14.1 For an accepted Application, before issuing a Decision on acceptance of the Application as to formality, the examiner shall check and when necessary amend information of the Application on the IPAS system to match what is indicated on the Application.

14.2 An accepted Application shall be published on the Official Industrial Property Gazette as regulated in Point 14 of the Circular. Published abstracts and drawings need to be fully and correctly recorded on the IPAS system to facilitate the publication.

14.3 A refused Application as to formality shall be archived as regulated.

Article 15. Checking requests for substantive examination during a formal examination

15.1 According to Point 25.1 of the Circular, an applicant may request for substantive examination of an Application at filing by ticking box number 6 on Application or filling out 03-YCTD form as regulated in Appendix B of the Circular. The regulation also applies to divisional Application, regardless of whether substantive examination has been requested for the base Application or not.

15.2 A request for substantive examination shall only be recorded to have been submitted when the applicant have paid the fees for the search and the examination.

CHAPTER III SUBSTANTIVE EXAMINATION

Article 16. Purpose and extent of substantive examination process

16.1 The purpose of substantive examination is to judge whether the patent right shall be granted to an invention as claimed in a patent application, especially whether the application meets the requirement on patentability, and to define the scope of protection in accordance with the provisions of Point 15.1.a of the Circular.

16.2 Patent applications are examined in accordance with Point 15.6.a, b(i), c and d of the Circular.

Article 17. Application to be substantively examined

17.1 An Application shall be subject to examination when a request for examination has been filed in accordance with Point 25.1 of the Circular, and the application has been published in accordance with Point 14 of the Circular.

17.2 Fee shall be refunded when the request for examination is withdrawn.

17.2.1 If the request for examination has been filed before the publication date but the application or the request for examination is withdrawn before the publication or the date on which the application is rejected in accordance with Point 13.7 Circular, the search fee for the purpose of substantive examination and the examination fee shall be refunded in full to the applicant (except for the transfer fee via post office, if any).

17.2.2 If the request for examination has been filed after the publication date but the application or the request for examination is withdrawn before the request has been transferred to the examination department, the search fee for the purpose of substantive examination and the examination fee shall be refunded in full to the applicant (except for the transfer fee via post office, if any) except for the late filing fee, if any, as prescribed in Point 25.1.a(iii) of the Circular.

Article 18. Order of substantive examination

18.1 Order of examination

The substantive examination shall be conducted in the order as

prescribed in Point 15.5.a, b(i), c and d of the Circular

18.2 Assessment of conformity of the subject matter of an Application with the kind of protection

18.2.1 The basis for assessment of conformity of the subject matter in an Application with the kind of protection that is sought for (Patent for invention/Patent for utility solution) is provided in Point 25.3 of the Circular.

18.2.2 Contents of assessment

a) Determine whether the subject matter in an Application is a technical solution by considering if the combination of the technical features of the subject matter recited in each claim can provide technical ways and/or technical means for solving the defined problem so as to achieve the objective of the invention.

b) Determine whether the subject matter in an Application is a product or process according to the combination of the technical features recited in each claim as provided in Point 25.3.b(i), (ii) of the Circular.

c) Determine whether the subject matter in an Application is contrary to the social morality, public order, detrimental to national defense, state security, which is not protected by the State as provided in Clause 1, Article 8 of the Intellectual Property Law (see Article 5.8.1 of this Regulation), or is not protected as inventions as provided in Article 59 of Law on IP (see Article 5.8.2 of this Regulation), if for some reasons this question has not been decided during the formal examination process.

18.2.3 An invention which is in conformity with the kind of protection being sought for and is not excluded under Article 8.1 and Article 59 of the Intellectual Property Law, shall be examined as to the requirements on patentability (industrial applicability, novelty, inventive step) in accordance with Article 58 of the Intellectual Property Law. Otherwise, the examination shall be terminated beforehand as provided in Point 15.4.a(ii) of the Circular.

18.3 Examination on the requirements of patentability

The examiner shall carry out the following steps of the examination process on each of the requirements on patentability:

- Analyze the technical solution;
- Invite the applicant to explain the content of the documents in the application, to correct any formality errors (if not corrected during the formal examination), to clarify the nature of, or to submit any supporting documents etc. (if required) in accordance with Point 15.3 of the Circular;
- Verify the patent classification index of the invention according to the latest version of the International Patent Classification;
- Search for the state of the art;
- Examine the priority claim (when necessary) according to Article 19 of this Regulation;
- Examine the unity of the Application;
- Examine the patentability (industrial applicability, novelty, inventive step) for each of the claimed subject matters (when Applications containing several subject matters that satisfy the requirement on unity), as recited respectively in each claim, in accordance with Points 25.4, 25.5 and 25.6 of the Circular and Article 21, 22 and 23 of this Regulation.

18.4 In accordance with the results of each of the steps above, an appropriate notification shall be issued to the applicant or the third-party requesting examination.

18.5 Examination of the first- to- file principle

In case a claimed subject matter fulfills all the requirements for obtaining protection, the examiner shall check whether the first-to-file principle is satisfied in accordance with Article 24 of this Regulation.

18.6 Prepare Notification to grant or Notification to refuse to grant or Notification of suspension of substantive examination or that the Application is deemed to be withdrawn.

Article 19. Verification of right of priority

19.1 Circumstances where verification of right of priority is required

Whether it is necessary to verify the right of priority shall be decided by the examiner after searching. Where the dates of publication of all the reference documents are earlier than the priority date, no verification of the right of priority is necessary. Such verification is needed only when one of the

following events occurs:

- 1) The disclosure of a reference document is identical with or closely related to the subject matter of the Application, and the date of publication of the reference document is between the date of filing and the priority date;
- 2) The disclosure of an Application filed by any entity or individual with the National Office of Intellectual Property is identical with, or equivalent to, the subject matter of an Application under examination. Moreover, the date of filing of the prior Application is between the date of filing and the priority date of the later Application, and the date of publication of the prior Application is on or later than the date of filing of the Application under examination; or
- 3) The disclosure of an Application filed by any entity or individual is identical with, or equivalent to, the subject matter of an Application under examination. Moreover, the priority date of the prior Application is between the filing date and the priority date of the Application under examination and the date of publication of the prior Application is on or later than the date of filing of the Application under examination.

As for the circumstances described in item 3), the verification of the right of priority of the Application under examination shall be conducted first. If its claim of right of priority is not valid, the claim of the right of priority of the Application which is filed by any entity or individual shall also be verified.

19.2 Content of verification of right of priority

At this stage of verification of right of priority, the examiner shall determine whether the Application which serves as a basis for claiming the priority right is the first Application which discloses the subject matter under examination.

19.2.1 Determination of the first Application

The Application serving as the basis for claiming right of priority must be the first Application which discloses the subject matter under examination.

For example, the right of priority for an Application A is claimed on the basis of another earlier Application B of the same applicant, and in the course of searching for Application A, the examiner finds a patent document, namely, another Application (Application C) of the same applicant, which is published between the date of filing

and the priority date of Application A. The subject matter of Application A has been disclosed in Application C and the date of filing of Application C is earlier than the priority date of A, i.e., earlier than the date of filing of Application B. In this case, although the date of filing of Application B is earlier than that of Application A, it is not the first Application of that applicant which disclosed the identical subject matter as that of Application A. Thus, Application A is not entitled to the priority date which is the filing date of Application B. In other words, the priority claim of Application A is not valid.

In case after having filed the first Application, the applicant files the second Application for the same subject matter, the second Application will be considered as the first Application, which may serve as a basis for claiming a right of priority, if, at the time of filing the second Application, the first Application has been withdrawn or refused, without having been published and without leaving any rights outstanding, and if it has not yet served, and will not serve, as a basis for claiming a right of priority.

Therefore, a divisional Application may not be considered as the first Application because at the time of filing the divisional Application, the first Application is still under examination. The same is true for a continuation-in-part Application (CIP) filed with USPTO, although the CIP may have a newly added subject matter. However, the CIP may be the first Application for the additional subject matter. Furthermore, the second Application may not be considered as the first Application by imposing restriction on the claims of the second Application to the part which is not claimed in the first Application.

For example:

01.07.1989	01.01.1990	01.06.1990	01.12.1990
Filing P1	Filing P2 (CIP)	Publication D	Filing EP
A+B	A+B	A+B	Claim 1: A+B
	A+B+C		Claim2: A+B+C

Wherein:

P1 is the earliest Application filed with U.S. Patent and Trademark Office by the applicant, which discloses an invention containing features A+B,

P2 is the CIP Application of P1, P2 describes inventions containing

A+B and A+B+C, D is a cited reference document, which discloses subject matter containing features A+B; and EP is an Application filed with EPO, claiming priority from P2. The priority claim on the basis of P2 for the subject matter of Claim 1 of EP Application is not valid as P1, but not P2, is the first Application which discloses this subject matter and P1 has left outstanding rights in that P2 is CIP Application thereof. This is not altered by withdrawal, refusal or non-publication of P1. Therefore, the novelty of Claim 1 of the EP Application is destroyed by the disclosure of the reference document D. However, the subject matter of Claim 2, the priority date of which is the filing date of P2, which is earlier than the publication date of D, may be granted.

19.2.2 Determination of disclosure of the first Application

19.2.2.1 The priority right shall be considered valid if the claimed subject matter of the Application claiming priority rights falls within the disclosure of the first Application.

The disclosure of the first Application is determined on the basis of the whole Application, not limited to the claims of the first Application, taking into account equivalent, interchangeable, or indirectly disclosed features.

The claimed subject matter of the Application claiming the priority right is considered to be within the disclosure of the first Application if one skilled in the art can obtain this subject matter directly and clearly from the first Application.

Where the features of the claimed subject matter in the Application claiming the priority right is not identical with the corresponding features in the first Application but these features are equivalent and interchangeable, then the claimed subject matter of the Application claiming the priority right falls within the disclosure of the first Application. Thus, the priority right is valid.

However, in cases where one or more features of the subject matter are described in the first Application only in a general and unclear way, or just a suggestion, if the features are described in detail in the subject matter of the Application claiming the priority right and one skilled in the art cannot obtain the features directly and clearly from the first Application, then the priority right is not valid.

19.2.2.2 Typical cases where the subject matter of an Application claiming priority right is not considered to be within the disclosure of the first Application:

a) Where the subject matter of the Application claiming priority right includes the features which were not disclosed in the first Application. For example, the cases where this subject matter is a combined invention that combines the structural elements disclosed in the first Application with the newly added structural elements; or the subject matter is a selection invention that selects a more specific concept from the generic concept disclosed in the first Application.

b) Where the parts beyond the scope of matters disclosed in the first Application are included in the Application claiming priority right by disclosing the matters that were not disclosed in the first Application (for example, where modes for carrying out the invention are added etc.) or deleting the matters described in the first Application (partial deletion).

c) Where the subject matter of the Application claiming priority right becomes possible to be carried out by changes in common general technical knowledge etc...

19.2.2.3 Examples of determination of disclosure of the first Application:

Example 1

The first Application discloses and claims structure of a new type of light. The second Application, claiming priority from the first Application, describes and claims structure of the same type of light as that of the first Application, and further claims various Applications of that type of light. However, some said Applications are not clearly disclosed in the first Applications. Thus, the corresponding claims are not entitled to the right of priority.

The claims of the Application claiming priority right, which is under examination	Disclosure of the first Application	The priority claim is valid?
A bicycle comprises the light according to claim 1.	"The light can be used in the vehicles such as bicycle".	Yes: The combination of the light and bicycle has been

		directly mentioned
A bicycle comprises the light according to claim 1, the light is energized by a dynamo.	"The light can be used in the vehicles such as bicycle. Of course, a power supply is present on the vehicle".	No: Although the light and the vehicle are mentioned, but the dynamo is not. "The power supply" may be of various types (for example, a battery) and thus "dynamo" cannot be assumed from the first Application.
A bicycle comprises the light according to claim 1, the light is detachably mountable to the vehicle.	The light can be mounted in the vehicles such as bicycle, for example by using the bolts and nuts for fastening the light to the vehicle.	Yes: The combination of the light and vehicle has been directly mentioned. The feature "bolt and nut" indirectly discloses the detachable mount.
A bicycle comprises the light according to claim 1, the light is electrically connected to a dynamo serving as a power supply.	"The light can be used in the vehicles such as bicycle. In the bicycle, the light can be energized by a dynamo".	Yes: The bicycle, light and dynamo are mentioned in cooperation with each other. From the feature "energized by a dynamo", a person skilled in the art can presume that the light and the dynamo are connected with each other.
A vehicle comprises the light according to claim 1.	"The light can be used in the vehicles such as bicycle."	Yes: The combination of the light and the vehicle has been directly mentioned.
A motorcycle comprises the light according to claim 1.	"The light can be used in the vehicles such as bicycle".	No: Although the motorcycle is obviously a "vehicle such as bicycle",

		this information is not directly and clearly originated from the first Application.
A lighting system comprises three lamps according to claim 1.	"The lamps can be mounted in a device such as chip lamp for increasing the light capacity".	No: the first Application does not directly and clearly disclose three lamps.
A lighting system comprises three lamps according to claim 1.	"The lamps can be mounted in a device such as a chip lamp for increasing the light capacity. In a preferred embodiment, the lamps are arranged in a triangular shape".	Yes: "triangular arrangement" directly discloses three lamps. No: Although "triangular arrangement" directly suggests the use of three lamps, but it does not mean that another arrangement of three lamps is also disclosed.
A lamp according to claim 1 is electrically connected to a switch.	"When the lamp is energized..."	Yes: The term "energized" implies the use of a switch.

Example 2

The features disclosed in the first Application are combined with the features which were not disclosed in the first Application.

The claims of the Application claiming priority right, which is under examination	Disclosure of the first Application	The priority claim is valid?
A damping structure that combines low and	A damping structure that combines low and upper layers by a	No. The feature "control means" was not disclosed in the

upper layers of the structure by a damping system <u>and sets up the control means to control the combination.</u>	damping system.	first Application.
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Example 3

A newly added mode for carrying out is not within the disclosure of the first Application.

Disclosure of the first Application	Disclosure of the Application claiming priority	Determination of priority
A light scanning system containing mirror angle adjustability, and only adjusting the mirror angle by a screw is disclosed as a mode for carrying out the invention	A light scanning system containing mirror angle adjustability. <u>A light scanning system that automatically adjusts the mirror angle with a piezoelectric element</u> is newly added as a mode for carrying out the invention.	The part corresponding to the light scanning system that automatically adjusts the mirror angle with a piezoelectric element is not within the disclosure of the first Application. Hence, the priority claim to this part is not valid.

Example 4

The subject matter becomes possible to be carried out by changes in common general technical knowledge.

Disclosure of the first Application	The Application claiming priority right	Determination of priority right
The claimed subject-matter is a genetically modified plant, and Examples are carried out only	The disclosure of the Application is the same as that of the first Application. However, the	Although the disclosure of the Application claiming priority right is the same as the disclosure of the first Application, the parts

<p>on dicotyledonous plants. From the whole description and common general technical knowledge, there is no ground to say that a genetically modified plant could be produced with respect to monocotyledons.</p>	<p>technical improvement in gene recombination after the filing date of the first Application enabled the gene recombination of monocotyledons, if it is possible for dicotyledonous plants, which becomes common general technical knowledge now. Therefore, the invention relating to the genetically modified plant may also be applicable with respect to monocotyledons.</p>	<p>of the later Application which become possible to be carried out by changes in common general technical knowledge are not within the scope of the disclosure of the first Application. Therefore, only the subject-matter relating to the gene modification of dicotyledonous plants may enjoy the right of priority, while the subject-matter relating to the gene modification of monocotyledons cannot enjoy the right of priority.</p>
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19.2.3 Verification of right of priority of independent and dependent claims

A dependent claim may enjoy the benefit of the right of priority while its corresponding independent claim may not, and vice versa. For example, if the first Application disclosed a specific form, a broader claim for a species encompassing that form may not be entitled to the right of priority, whereas a dependent claim relating to this specific form may claim priority right.

If a claim depends on multiple other claims, such a claim may have multiple priorities. For example, claim 3 depending on claim 1 or claim 2, which have different priority dates, may have two priority dates.

19.2.4 Verification of partial priority

In addition to the disclosure of the first Application, the improvement or perfection which is made to the invention of the first Application may be introduced to the Application claiming

priority right. In this case, the later Application may include the subject matters which were disclosed in the first Application and some newly added subject matters. Under such circumstances, the priority right shall be verified for the subject matters which were disclosed in the first Application.

Example 1

A part of the subject matters was disclosed in the first Application.

Disclosure of the first Application	Disclosure of the Application claiming priority right	Determination of priority
Corrosion-resisting steel containing chrome.	One subject-matter is corrosion-resisting steel containing chrome. Another subject-matter is corrosion-resisting steel containing chrome and aluminum.	The subject-matter corrosion-resisting steel containing chrome is disclosed in the first Application, therefore priority claim thereof is valid. However, priority claim of the subject-matter corrosion-resisting steel containing chrome and aluminum is not valid.

Example 2

Only a part of alternatives of the Application claiming priority is described in the first Application

Disclosure of the first Application	Disclosure of the Application claiming priority right	Determination of priority
The claimed subject-matter contains a condition that the carbon number of alcohol is 1-5. The only Example is	The claimed subject-matter contains a condition that the carbon number of alcohol is 1-10.	There is a single claimed subject-matter, however, the priority claim is valid only for the condition that the carbon number of alcohol is 1-5. The condition that the

disclosed, wherein the carbon number of alcohol is 1-5.		carbon number of alcohol is 6-10 is not disclosed in the first Application. Therefore, the priority claim with regard to this condition is not valid.
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19.2.5 Verification of multiple priorities

Where multiple priorities on the basis of two or more earlier Applications are claimed by an Application, which meets the requirement on unity of invention, in verifying the right of priority, the examiner shall check whether various subject matters included in the claims of the Application claiming priority right have been disclosed respectively in the earlier Applications. It shall be noted that where different technical features are disclosed respectively in the earlier Applications and the claims of the Application claiming priority right are the combination of these features, the claim to multiple priorities is not valid.

Example 1

Where the subject matters are disclosed respectively in the earlier Applications

Disclosure of the earlier Applications	Disclosure of the Application claiming priority right	Determination of priority
The corrosion-resisting steel containing chrome is disclosed in the first Application A. The corrosion-resisting steel containing chrome and aluminum is disclosed in the first Application B.	One subject-matter relating to a corrosion-resisting steel containing chrome claims priority from both first Applications A and B. Another subject-matter relating to a corrosion-resisting steel containing chrome and aluminum also claims priority from both first	The subject-matter relating to a corrosion-resisting steel containing chrome enjoys the right of priority from the first Application A. The subject-matter relating to a corrosion-resisting steel containing chrome and aluminum enjoys the right of priority from the first Application

	Applications A and B.	B.
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Example 2

Where alternatives of a subject-matter are disclosed in the earlier Applications

Disclosure of the earlier Applications	Disclosure of the Application claiming priority right	Determination of priority
<p>The condition that the carbon number of alcohol is 1-5, is disclosed in the first Application A.</p> <p>The condition that the carbon number of alcohol is 6-10, is disclosed in the first Application B.</p>	<p>The subject-matter contains the condition that the carbon number of alcohol is 1-10, and claims priority from both Applications A and B.</p>	<p>Since the subject-matter has alternatives, determination of priority is made for each of the alternatives.</p> <p>Therefore, with regard to the condition that the carbon number of alcohol is 1-5, the priority claim based on the first Application A is valid, while with regard to the condition that the carbon number of alcohol is 6-10, the priority claim based on the first Application B is valid.</p>

Example 3

Where subject matter is not within disclosure of the earlier Applications

Disclosure of the earlier Applications	Disclosure of the Application claiming priority right	Determination of priority
<p>Application A disclosed a house equipped with</p>	<p>The subject matter relating to a house equipped with a</p>	<p>The subject matter has not been disclosed in A or B,</p>

<p>temperature sensor and a system for closing/opening door curtain for closing/opening door curtain in response to the signals from the temperature sensor.</p> <p>Application B disclosed a house equipped with humidity sensor and a system for closing/opening ventilation door</p>	<p>temperature sensor and a system for closing/opening ventilation door in response to the signals from the temperature sensor.</p>	<p>hence the priority claim is not valid</p>
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Article 20. Unity of invention

20.1 General concept of unity

The examination of the unity of invention Application is based on regulations in paragraph 1 and 2 of Article 101 of the Intellectual Property Law and Point 23.3 of the Circular, in which the Application meets the requirements of unity if it relates to one invention only or a group of inventions so linked as to form a single general inventive concept. In the case of the Application relates to a group of invention, the claims may contain a plurality of independent claims in the same category (mechanism, device, compound, intermediate compound, pharmaceutical composition or process) provided these claims must relate to a product technically inter-related or relate to different technical solutions for solving the same technical problem, and combination of these technical solutions in one claim is not allowed. Normally, different independent claims belong to different categories (for example, a compound, a pharmaceutical composition comprising the compound, a process to produce the compound, and intermediate compound to prepare this compound).

20.2 Special technical feature

Determination of unity of invention is to determine whether or not there is a technical relationship among the invention as claimed in different claims, in particular, whether there is the same or

equivalent special technical feature(s) among the subject matter of those claims. The expression "special technical feature" means the particular feature or features that define the contribution that the claimed invention considered as a whole makes over the prior art or, in other words, the features which make the invention have novelty and inventive step. Once the special technical features have been identified, one must determine whether or not there is a technical relationship between the inventions as claimed in different claims, and, furthermore, whether or not this relationship involves these special technical features. If these conditions are satisfied, the Application shall fulfill the requirement on unity of invention. It is not necessary that the special technical feature(s) in each claim must be the same, but may be the equivalent technical features, for example, in one claim the special technical feature which provides resilience is a metal spring, whereas in another claim it is a "block of rubber."

An Application may contain a group of inventions (a group of subject matter) which is so linked as to form a single general inventive concept (Point 23.3b of the Circular). In particular, in the following instances, the Application is considered as fulfilling the requirement on unity of invention:

- (i) An independent claim for a product and an independent claim for a process specially adapted for the manufacture of said product; or
- (ii) An independent claim for a process and an independent claim for an apparatus or means specifically designed for carrying out said process; or
- (iii) An independent claim for a product and an independent claim for a process specially adapted for the manufacture of said product and an independent claim for an apparatus or means specifically designed for carrying out said process.

In (i) above, the process is specially adapted for the manufacture of the product if the claimed process results in the claimed product, thereby defines a technical relationship, which forms a single general inventive concept. A manufacturing process and its product may not be regarded as lacking unity simply by virtue of the fact that the manufacturing process is not restricted to the manufacture of the claimed product. In (ii) and (iii) above, the apparatus or means is specifically designed for carrying out process if the apparatus or means is suitable for carrying out process and thereby defines a technical relationship, which forms a single general inventive concept between the above process and apparatus or

means. It is not sufficient for unity that the apparatus or means is merely capable of being used for carrying out the process. However, the following group of inventions is considered not meeting the requirement on unity of invention for not belonging to a single general inventive concept: an independent claim for a process specially adapted for the manufacture of a known product, for example, a novel and inventive method for manufacture of a known electrostatic paint, and an independent claim for a process comprising a step of use of said product, for example, a novel and inventive method of electrostatic painting, which comprises the step of use of the said known electrostatic paint. The first invention among the two above inventions belongs to the inventive concept relating to the novel and inventive process for manufacture of the known product (with the special technical feature characterizing a process of manufacture), whereas the second invention belongs to the inventive concept relating to the novel and inventive method comprising use of the known product (with the special technical feature characterizing a method of use of a product). In this case, the Application does not meet the requirement on unity as it claims a group of inventions not belonging to a single general inventive concept.

20.3 Unity of intermediate and final products

Requirement on unity of invention shall be met in the context of an intermediate and a final product where:

- (i) The intermediate and final product have the same essential structural element, i.e. their basic chemical structures are the same or their chemical structures are technically closely inter-related, the intermediate product incorporates an essential structural element into the final product, and
 - (ii) The intermediate and final product are technically inter-related, i.e. the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.
- The Application shall meet the requirement on unity if it comes to the requirement of protection of different intermediate products used in different processes for the preparation of the final product provided that they have the same essential structural element. The intermediate product X and the final product Y lack unity if there is at least one intermediate product Z which is not new in the process for the preparation of final product Y from the intermediate

product X.

Where different intermediates for different structural parts of the final product are claimed, unity shall not be regarded as being present between the intermediates.

If the intermediate and final products are families of compounds (for example, compounds having a common chemical formula), the unity shall be regarded as being present between the intermediate product and the final product if each intermediate compound shall correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products, so the two families need not be absolutely congruent.

20.4 Alternatives

Alternative forms of an invention may be claimed either in a plurality of independent claims or in a single claim. In the latter case, the unity of invention shall be examined as stated in that single claim.

Markush group

Where a single claim defines (chemical or non-chemical) alternatives, i.e. a so-called "Markush grouping", unity of invention shall be considered to be present if the alternatives are of a similar nature.

When the Markush group is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where:

- All alternatives have a common property or activity, and
- A common structure is present, i.e. a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

"Significant structural element is shared by all of the alternatives" means that the compounds share a common chemical structure which occupies a large portion of their structures, or, in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component, or a combination of individual components linked together. The alternatives belong to a "recognized class of chemical compounds" if there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. that each

member could be substituted one for the other, with the expectation that the same intended result would be achieved. If it can be shown that at least one Markush alternative is not novel, unity of invention shall be reconsidered.

20.5 Assessment of unity of invention during formal examination and substantive examination

During the formal examination process, the Application shall be considered as lacking unity if the claimed inventions obviously do not have any common technical features and the question of unity can be decided without taking the prior art into consideration, which shall be performed during substantive examination (*A priori lack of unity*). For example, during formal examination, an Application obviously fails to meet the requirement on unity if the independent claims contain features A+B and C+D, respectively, wherein A+B are different from C+D.

On the other hand, if the conclusion of unity can be made only after considering the prior art, thereby to evaluate whether the general technical feature of the claimed inventions is a distinct technical feature, then the question of unity of invention shall be decided during substantive examination (*A posteriori lack of unity*). For example, in case an Application has the independent claims containing features A+X and A+Y, respectively, the Application fulfills the requirement on unity of invention if the general technical feature "A" is a distinct technical feature; otherwise, if the feature A is not a distinct technical feature, the Application does not meet the requirement on unity.

20.6 Unity of independent claims and dependent claims

During the formal examination process, there is no need to evaluate the unity between a dependent claim and the independent claim on which it depends, or between the dependent claims which depend on the same independent claim, as they all contain the general technical feature, which is presented in the independent claim. For example, if Claim 1 recites a specifically shaped turbine blade, and Claim 2 recites the "turbine blade according to Claim 1, wherein the blade is made from alloy Z", the general technical feature of the dependent and independent claims is "specifically shaped turbine blade."

However, during substantive examination process, if the independent claim fails to meet the requirement on novelty and/or inventive

step, the unity between its dependent claims shall be thoroughly considered. In such a case, the "special technical feature" of a dependent claim may not exist in the form of the same or equivalent feature in the other dependent claims.

20.7 The typical examples of assessment of unity of invention

a) Unity of independent claims in different categories

(i) Example 1:

Claim 1: A method of preparing compound X.

Claim 2: A compound X.

Claim 3: A method of killing insects comprises the use of compound X.

Situation 1: the compound X has novelty and involves an inventive step, the unity exists between claims 1-3.

Situation 2: the compound X lacks novelty or inventive step, then there is not the same or equivalent special technical feature in claims 1-3, and thus they do not have unity.

(ii) Example 2

Claim 1: A process of making product X, comprising step A and step B.

Claim 2: An apparatus specifically designed for carrying out step A.

Claim 3: An apparatus specifically designed for carrying out step B. wherein the process of claim 1 has novelty and involves an inventive step.

Conclusion: unity is present between claim 1 and claim 2, or between claim 1 and claim 3 since there are the same special technical features, which are respectively step A or step B (the specifically designed apparatus for carrying out either step A or step B is considered as specifically designed for performing the claimed process of manufacture in general). Since there is not the same or equivalent special technical feature in claim 2 and claim 3, there is no unity between them.

(iii) Example 3

Claim 1: A compound X1 (belonging to family of compound having a general formula X)

Claim 2: A method of killing insects comprises using compound having a general formula X.

wherein some of compounds X are not new, but their insecticidal activity was not known; a compound X1 has novelty and involves an inventive step, and this compound X1 also has insecticidal activity like the compound X.

Conclusion: Claim 1 and 2 have unity because there is the same special technical feature of insect killing activity of compound X.

b) Unity of independent claims of the same category

(i) Example 1

Claim 1: A multiple-pin plug characterized in that the pins have a hexagonal cross-section around diameter (d).

Claim 2: A socket having multiple holes to contact with the plug-in claim 1, characterized in that the holes have a hexagonal cross-section around diameter (d).

wherein prior art document disclosed a plug with round cross-section pins and a socket with round cross-section holes.

Conclusion: Claims 1 and 2 have unity because there are the equivalent special technical features: a hexagonal cross-section of pins and a hexagonal cross-section of holes.

(ii) Example 2

Claim 1: A conveyer belt characterized by feature A;

Claim 2: A conveyer belt characterized by feature B;

Claim 3: A conveyer belt characterized by features A + B.

wherein; there is no conveyer belt characterized by the feature A or B disclosed in the prior art.

Conclusion: claim 1 and claim 3 or claim 2 and claim 3 have unity because they contain the same or corresponding technical features A or B. However, claim 1 and claim 2 do not contain any same or corresponding technical feature, and thus do not have unity.

(iii) Example 3

Claim 1: A compound A.

Claim 2: A pharmaceutical composition comprising a compound A and a pharmaceutically acceptable carrier.

wherein compound A has novelty and involves an inventive step.

Conclusion: Claim 1 and claim 2 have unity because they have in common the same special technical feature "compound A".

(iv) Example 4

Claim 1: Protein X.

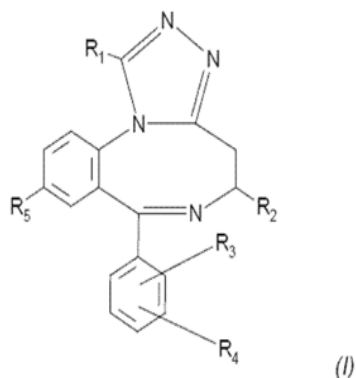
Claim 2: DNA sequence encoding protein X.

wherein protein X has novelty and involves an inventive step.

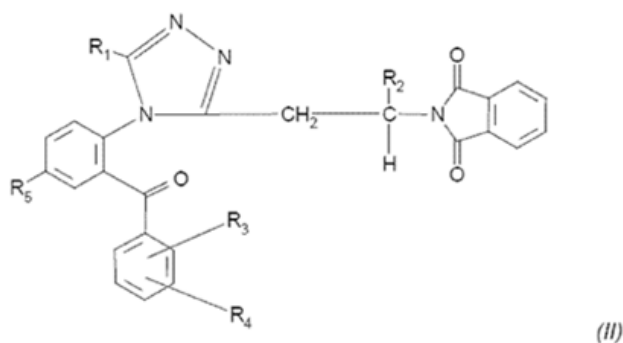
Conclusion: It is known that expression of the DNA sequence in a host results in the production of protein, structure of which is determined by the DNA sequence. The protein and the DNA sequence exhibit equivalent special technical features. Therefore, there is unity between claim 1 and claim 2.

(v) Example 5: Unity between intermediate and final product

Claim 1. A compound having formula (I):



Claim 2. An intermediate compound having formula (II):



wherein the compound of claim 1 and the intermediate compound of claim 2 have novelty and involve an inventive step.

Conclusion: Compound (II) is used to prepare compound (I) by a ring forming reaction. Although structures of compound (I) (final product) and compound (II) (intermediate product) are significantly different, but in fact that compound (II) is ring-opened precursor of compound (I). Both compounds contain an essential structure, which is two phenyl rings and one triazole ring, which are linked in the same way and it is a special technical feature. Therefore, the structures of the compounds are technically closely inter-related. In this case, unity exists between the intermediate product and the final product.

(vi) Example 6: Unity between alternatives of invention - Markush group

Claim 1: A herbicide composition including: (A) 2,4-D[(2,4-dichlorophenoxy)acetic acid; and (B) a second herbicide compound

selected from the following compounds: cupric sulfate, sodium chloride, ammonium sulfamate, sodium trichloroacetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid, diphenamide (amide compound), ioxynil (nitrile compound), dinoseb (phenol compound), trifluraline (amine compound), EPTC (thiocarbamate compound) and simazine (triazine compound); and an inert carrier and dilute.

wherein compound (A) and all the compounds in group (B) are known herbicides. However, mixture of compound A and any compound in group B is new and involves an inventive step (since it has synergistic action).

Conclusion: Any herbicide composition according to any embodiment of claim 1 contains compound A. The special technical features for each above herbicide composition and herbicide composition comprising the known compound A are features of presence respectively of each of group B: cupric sulfate, sodium chloride, ammonium sulfamate, sodium trichloro acetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid, diphenamide (amide compound), ioxynil (nitrile compound), dinoseb (phenol compound), trifluraline (amine compound), EPTC (thiocarbamate compound) or simazine (heterocyclic compound).

In this case, because the compounds in group B cannot be regarded as the compounds of the same class in the relevant technology of this invention, the claim does not involve an inventive step. In fact, the compounds in group B belong to various herbicide groups:

- (1) An inorganic herbicide: cupric sulfate, sodium chloride, ammonium sulfamate;
- (2) A herbicide of organic salt and carboxylic acid: sodium trichloro acetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid;
- (3) An amide herbicide: diphenamide;
- (4) A nitrile herbicide: ioxynil;
- (5) A phenol herbicide: dinoseb;
- (6) An amine herbicide: trifluraline;
- (7) A thiocarbamate herbicide: EPTC;
- (8) A heterocyclic herbicide: simazine.

However, in this case, it shall be noted that, unity can be existed if there are the other same technical features between herbicides in embodiments in the claim. For example, the special technical feature can be synergistic action between compound A and any of group B (for example, the synergistic action in killing a species of grass, or this action resulted from mixing components with certain

proportions, etc.).

Article 21: Industrial Applicability

21.1 Requirement on industrial applicability

The requirement on industrial applicability is provided in Article 62 of the Intellectual Property Law and Point 25.4 of the Circular. The claimed invention shall be considered as susceptible to industrial Application if:

- A subject matter of invention must be made or used in an industry. The "industry" herein is interpreted in broad sense, including the industries of manufacturing industry, agriculture, forestry, fishery, animal husbandry, communication and transportation, culture and sports, articles of daily use, and medical equipment etc.;
- The information of nature of subject matter and indications of necessary technical conditions must be presented clearly and sufficiently to allow the person skilled in the art to perform the invention; and
- The manufacture and application must be carried repeatedly, and achieve stable results, which are the same as disclosed in the invention.

21.2 Examination of industrial applicability

The determination as to whether an invention is susceptible to industrial application shall be made before the examination on novelty and inventive step.

The examiner shall base the examination on the entire technical contents disclosed in the description (including the drawings) and claims, rather than merely the contents described in the claims. The examiner shall note that industrial applicability is irrelevant to how the invention was created or whether it has been implemented. In the other words, the fact that it is very difficult to make or use an invention is not relevant to its industrial applicability. In the following, some typical situations in which the subject matter does not have industrial applicability are described.

1) Invention contrary to the law of nature

An invention that is contrary to the laws of nature and scientific principles obviously does not possess industrial applicability. Examples of such inventions include perpetual motion machines; a method of plating copper with iron, comprising the steps of immersing a piece of copper in an aqueous solution containing iron ions, thereby forming an iron layer on said piece of copper; etc.

2) Practically inapplicable inventions

The subject-matter which cannot be practically implemented is not considered as industrially applicable even if it works in theory. For example, a method for preventing an increase in ultraviolet rays associated with the destruction of the ozone layer by covering the whole earth's surface with an ultraviolet ray-absorbing plastic film.

3) Inventions having inherent contradictions

The inventions, having inherent contradictions or comprising elements, components, which do not have technical relationships or cannot be combined with each other (connected to, tied with, dependent on, etc.) to obtain the results that the invention aimed to achieve, cannot be carried out, and thus are not applicable. For example, flying device operates by "flapping wings".

4) There are not any instructions to implement such an invention.

In the event that the application has absolutely no or lack of important instructions, a person skilled in the art cannot carry out the invention, therefore the invention shall not be considered as susceptible to industrial Application. For example, as shown in the Application that a compound can be used in treatment of a functional disorder (not mentioned clearly) or a compound has a useful biological property but not mentioned its practical Application, in this case, the invention shall be considered as lack of important instructions to implement and therefore the invention shall not be considered as susceptible to industrial Application.

5) Non-reproducibility

An invention is not susceptible to industrial application when it can be implemented by limited times or the achieved results are not the same. The examiner shall note that the invention is considered as non-reproducible where even all the necessary technical conditions for implementing the invention are fulfilled, a person skilled in the art is still unable to repeat the results which the invention is aimed to achieve. Therefore, for an invention concerning a product, low rate of finished products and non-reproducibility are substantially different. The former indicates the situation where the product can be made repeatedly but the rate of finished products is low due to the failure of satisfying some technical conditions (such as the environmental cleanliness, temperature, etc.) in the course of manufacture.

6) Personal skill is required to carry out the invention

An invention is not susceptible to industrial application if beside

the knowledge in the relevant technical field and common technical knowledge, in order to perform the invention, a skilled person shall have special personal skill, which cannot be imparted to, or shared with, the others. For example, a method of throwing a split-fingered fast ball characterized in the way of holding the ball in fingers and throwing the same. (This subject-matter may be refused on the ground that it is not a technical solution).

7) Product utilizing unique natural conditions

An invention possessing industrial applicability shall not be a unique product confined by natural conditions. Therefore, a unique product that is made by utilizing specific natural conditions and can never be moved does not possess industrial applicability. The natural conditions which are unique and cannot be moved, can be a particular waterfall or section of river, etc. but may not include the other natural resources, for example mineral, which can be mined and moved. Therefore, the hydroelectric station exploiting Silver Waterfall does not have industrial applicability but the process of manufacturing mineral water from the source in Hoa Binh province does. It shall be noted that the components of the above product utilizing unique natural conditions shall not be regarded as not possessing industrial applicability just because said product does not possess industrial applicability. For example, a bridge across Red River is not susceptible to industrial Application as it utilizing the unique natural conditions. However, the beam system of the bridge can meet the requirement on industrial applicability.

8) Methods of surgery on human or animal body for non-treatment purposes

Methods of surgery include those for treatment purposes and those for non-treatment purposes. Methods of surgery for treatment purposes are part of the unpatentable subject matters as described in Article 5.3.4, Chapter II of this Regulation. Methods of surgery for non-treatment purposes do not have industrial Application because these methods are practiced on the living human or animal body and cannot be used industrially. Examples of this kind include methods of surgery for cosmetic purposes, methods of extracting bezoars from the living cattle body by surgery, and methods of surgery for assisting diagnosis, such as the method of surgery adopted before coronary arteriography.

9) Methods of measuring physiological parameters of human or animal body under extreme conditions

Measuring the physiological parameters of a human or animal body

under extreme conditions requires the subject to be placed under such conditions, raising a threat to the life of the human being or animal. Moreover, the extreme conditions which different human beings or animals can endure are different, and for each subject the specific extreme condition shall be determined by an experienced professional according to the situation of the subject. Therefore, such methods cannot be used industrially and do not possess industrial Application. For example, the following methods are regarded as not possessing industrial Application: the method of measuring the ability of cold resistance of a human or animal by gradually decreasing the body temperature of the human or animal; the method of non-invasive examination for measuring the metabolic function of coronary artery by decreasing oxygen partial pressure of the inhaling air to increase the load of the coronary artery step by step and observing the compensation reaction of the coronary artery according to the dynamic change in the artery blood pressure.

10) No effective results (Point 25.4.b (ix) of the Circular 01)
The technical solution of an invention that is obviously of no utility or deviates from the needs of society, even detrimental to environment, human health, wasting energy or natural resource, does not have industrial applicability.

Article 22. Assessment of Novelty

22.1 Concept of novelty

According to Article 60 of the Intellectual Property Law and Point 25.5 of the Circular, novelty means that before the filing date or the priority date, in case the Application is entitled to the priority right, neither any identical invention has been publicly disclosed in domestic as well as foreign publications, used or widely known in any form at home as well as abroad, nor any other Application for patent protection of an identical invention has been filed with the National Office of Intellectual Property and published earlier than the filing date or priority date of the Application under examination.

It shall be noted that the disclosures herein do not have any limitations on the geographical location, territory or the language of presentation, but are limited only to the date of disclosure.

22.1.1 Prior art

Prior art means technical solutions which are identical or similar to the claimed invention, which have been publicly disclosed in

domestic or foreign publications, used or widely known in any form inside or outside the country, before the filing date (or the priority date, if applicable), and at least include known technical solutions disclosed in the mandatory minimum information source according to Point 25.5.a of the Circular.

It shall be noted that technical solutions that are in a state of confidentiality but disclosed (even by the person responsible for keeping them confidential) are also considered to be prior art. In determining the prior art, consideration must be given to the temporal demarcation and means of disclosure of known technical solutions.

22.1.1.1 Temporal demarcation

When assessing an invention, the temporal demarcation of the prior art is the filing date/ priority date of the Application being examined. That is, all technical solutions disclosed before the filing date/ priority date of the Application being examined are considered to be within the scope of the prior art. However, documents that are disclosed on the filing date/ priority date are not considered to be within the scope of the prior art.

22.1.1.2 Means of disclosure

Means of disclosure of known technical solutions includes disclosure through written descriptions, disclosures in the form of use, and disclosure in other ways.

22.1.1.2.1 Disclosure through written descriptions

The written descriptions mentioned in the Intellectual Property Law means paper documents that are printed or typed (regardless of language, the number of published documents, including the number of readings, how to obtain them, or their lifetime), such as patent documents, scientific and technical literature and books, and scientific dissertations, specialized documents, manuals, technical handbooks, minutes, conference papers, seminars or officially published scientific papers, newspapers, magazines, sample books, product catalogue, brochures, etc. The above documents may provide or contain other evidence to substantiate the date of publication or disclosure of the content of the materials.

Documents that fall under "Internal circulation" and require confidentiality will not be considered publicly disclosed.

In addition to paper documents, the written descriptions may be

stored in electronic and optical media, such as microfilm, negatives, optical discs, floppy disks, and hard drives etc. They may also be documents on the Internet or other types of online data. The time of publication or disclosure is calculated from the date of printing/ depositing of the above documents. In case of having indications about month/quarter/year of printing/depositing them, the time of disclosure shall be counted from the last day of that month/quarter/year. For minutes, conferences, seminars or scientific reports, the time shall be counted from the date of publication of such documents.

If the examiner is in doubt about the time of publication or disclosure of a material, the information of the publication or disclosure date may be requested from publisher/provider of the material.

22.1.1.2.2 Disclosure in the form of use

Disclosure in the form of use means the use of a technical solution to make it available to or accessible by general public.

Ways of disclosing in the form of use include manufacturing, using, trading, importing, exchanging, performing, exhibiting or similar ways that could expose that technical solution to the whole society. A technical solution is considered to be publicly disclosed if its use is made in the above-mentioned ways and everyone in society can know its content if they want it, regardless of the fact does everyone in society really know about that solution or not. However, if a product is on display but does not give any explanation as to the technical content of the product, and therefore the ordinary skilled person in the relevant field cannot know the structure. or the function or components of that product, such display is not considered as disclosure in the form of use.

A product-type technical solution is considered to be publicly disclosed in the form of use even if, in order to know its structure and function, it is necessary to damage the product.

Display of information-carrying objects such as posters, drawings, photos, samples, etc. on display shelves at an exhibition or in a store that can be read by the public is also considered publicly disclosed in the form of use. Video tapes, video discs or similar information carriers are considered as means of publicly disclosing technical solutions in the form of use.

The date on which the public can access the product or process that is similar to the product or process being examined in the above

manner will be considered as the date of disclosure in the form of use.

22.1.1.2.3 Disclosure by other means

The disclosure by other means mainly refers to the disclosure in the form of presentations and performances. Examples of these formats include talks, reports, discussions, seminars, broadcasts, television and film screenings, making the content of the technical solution available to the society. Sound recordings or similar information objects are considered to be means of disclosure. For the content of the talks, reports or discussions at the symposium, the date of implementation will be considered the date of public disclosure. For the content of broadcasts, television or film screenings that can be obtained by anyone in society, the date of the broadcast or television will be considered as the date of public disclosure.

22.1.2 Reference documents

A reference document is a document describing the identical or most similar technical solution (reference solution) with the technical solution stated in the Application, which is used to assess the novelty, including patent documents and other documents.

The cited reference document may be one or more documents. The cited content may be the whole content of each document or only a part of its content.

Reference documents are technical documents that exist objectively. When a reference document is used to assess the novelty and inventiveness of an invention, examiners must rely on the technical content disclosed in that document. The above technical content includes not only the technical content which is clearly disclosed in that document but also the implied technical content that can be drawn directly and clearly from those disclosed in that document by a person having ordinary skill in the art. However, it is not permitted to expand or narrow the content of such documents at will. In case the reference document comprises drawings, such drawings may also be cited. However, when citing drawings, examiners need to be aware that only technical features that can be obtained directly and clearly from the drawings belong to the content of the disclosure, and the content which must be inferred from the drawings and their dimensions and correlation measured from the drawings without any explanation are not considered to be disclosed content.

22.2 Examination of novelty

The determination of whether an invention has novelty needs to be made only after its industrial applicability has been confirmed.

22.2.1 Principles of examination of novelty

The following principles shall be complied with during the examination of novelty.

1) Identical technical solutions (inventions)

Comparing the Application being examined with the relevant contents of the prior art (including the Applications for invention filed previously with the National Office of Intellectual Property and published before the filing date/priority date of the Application being examined) if their technical fields, technical problems to be solved, technical solutions, and their expected effects are substantially the same, they shall be regarded as identical inventions. It shall be noted that, in determining the novelty of an invention, the examiner shall first of all determine whether the technical solution of the invention being examined is substantially the same as that of the reference document. If the technical solution defined in a claim of the invention under examination and the technical solution disclosed in the reference document are substantially the same, and the person skilled in the art from the solutions can conclude that both of them can be applied to the same technical field, solve the same technical problem, and have the same expected effects, then they can be regarded as identical inventions.

2) Separate comparison

When determining novelty, the examiner shall compare each claim of the Application separately with the relevant technical contents disclosed in each item of the prior art, rather than with a combination of the contents disclosed in several items of the prior art or with a combination of several technical solutions disclosed in one reference document. That is, the principle of separate comparison shall be applied in the determination of novelty of an invention, which is different from the approach to the determination of inventive step of an invention (see Article 23 of this Regulation).

22.2.2 Criterion for examination

Article 60 of the Intellectual Property Law shall serve as the criterion for judging whether an invention possesses novelty.

Several circumstances that often arise in the judgment of novelty are provided here to facilitate the understanding of this criterion.

22.2.2.1 Invention with identical contents

Where the claimed invention is completely identical with the technical contents disclosed in a reference document, or there are only simple changes in wording between them, the invention being claimed does not possess novelty. Furthermore, the meaning of "identical contents" shall be construed as including the technical content directly and unambiguously derivable from the reference document. For example, a claim of an invention Application is "a core of a motor rotor made of Nd-Fe-B permanent magnet alloy having a tetragonal crystal structure and a main phase of $\text{Nd}_2\text{F}_{14}\text{B}$ intermetallic compound". If a reference document discloses "a core of a motor rotor made of Nd-Fe-B magnet", the claim will lose novelty, since it is well known to a person skilled in the art that the so-called "Nd-Fe-B magnet" means the Nd-Fe-B permanent magnet alloy having a main phase of $\text{Nd}_2\text{F}_{14}\text{B}$ intermetallic compound and a tetragonal crystal structure.

22.2.2.2 Specific terms and generic terms

In comparing an invention being claimed with a prior art, if both state a technical feature of the same nature but different in that: in the claimed invention the technical feature is expressed by a generic term while in the prior art it is expressed by a specific term, then the disclosure of this technical feature by a specific term in the prior art shall take away the novelty of the feature expressed by a generic term in the claimed invention. For example, a product "made of copper" stated in the prior art shall take away the novelty of an invention for the same product "made of metal". However, such a disclosure of a product made of copper in the prior art shall not take away the novelty of an invention for the same product being made of another specific metal, such as tin. In contrast, the disclosure of a subject matter by a generic term in the prior art does not take away the novelty of an invention for that subject matter which is expressed by a specific term. For example, the product disclosed in the prior art as "made of metal" will not take away the novelty of an invention for the same product "made of copper". In another example, if the sole difference between the claimed invention and the prior art is that "chlorine" is used in the invention other than "halogen", or another specific halogen

such as "fluorine", in the prior art, then the disclosure of "halogen" or "fluorine" in the prior art does not take away the novelty of the invention using "chlorine".

22.2.2.3 Direct substitution of customary means

If the difference between the claimed invention and a reference document is merely a direct substitution of customary means employed in the art, the invention does not possess novelty. For example, if a reference document disclosed a device using screw fastening, and the claimed invention only replaces the screw fastening with bolt fastening, the invention does not possess novelty.

22.2.2.4 Numerical value and numerical range

If the claimed invention has a technical feature defined by numerical values or a continuous numerical range, such as the dimensions of a component, temperature, pressure, and the content of components in a composition, while all other technical features are identical with those in the reference document, then the determination of novelty shall be conducted according to the following rules:

1) Where the values or numerical range disclosed in the reference document fall entirely within the range of the above-defined technical feature, the reference document deprives the claimed invention of novelty.

Example 1:

The Application claims a copper-based shape memory alloy, comprising 10-35% (weight) zinc, 2-8% (weight) aluminum, and copper as the remainder. If the reference document discloses a copper-based shape memory alloy comprising 20% (weight) zinc and 5% (weight) aluminum, it takes away the novelty of said claim.

Example 2:

The Application claims a resistor containing carbon particles of the size from 30 to 60 μm . If the reference document discloses a resistor of the same type with carbon particles of the size from 40 to 50 μm , it takes away the novelty of the claimed invention.

2) Where the numerical range disclosed in the reference document and the numerical range of the invention being examined partially overlap with each other or have at least a common end point, the

reference document deprives the claimed invention of novelty (including the case where the numerical range of the invention being examined is just "close" to the numerical range of the reference document).

Example 1:

The Application claims a resistor containing carbon particles of the size from 30 to 60 μm as mentioned above, if the reference document discloses a resistor of the same type with carbon particles of the size from 40 to 70 μm , it deprives the claimed invention of novelty because there is an overlapping range of particle size from 40 to 60 μm .

However, in the above example, if the claim contains disclaimer, it still possess novelty. In this case, the overlapping range is disclaimed as follows: "A resistor containing carbon particles of the size from 30 to 60 μm , but excluding those from 40 to 60 μm ".

Example 2:

In case the Application claims a resistor containing carbon particles of the size from 30 to 60 μm as mentioned above, if the reference document discloses a resistor of the same type with carbon particles of the size from 60 to 80 μm , it deprives the claimed invention of novelty because both ranges have a common end point 60 μm .

Example 3:

In case the Application claims a resistor containing carbon particles of the size from about 30 to about 60 μm , if the reference document discloses a resistor of the same type with carbon particles of the size from 60 to 80 μm , it deprives the claimed invention of novelty because the value "about 60 μm " according to the invention is considered as coinciding with "60 μm " in the reference document.

3) The two end points of the numerical range disclosed in the reference document take away the novelty of the invention in which the above-defined technical feature has discrete numerical values including one of said two end points, but does not take away the novelty of the invention in which the above-defined technical feature is a numerical value at any point between said two end points.

Example:

The Application claims a process for making titanium dioxide photocatalyst, wherein the drying temperature is 40°C, 58°C, 75°C, or 100°C. If the reference document disclosed a process for making titanium dioxide photocatalyst wherein the drying temperature is 40 - 100°C, it takes away the novelty of said claim in the case that the drying temperature is 40°C or 100°C, but does not take away the novelty of said claim in the case that the drying temperature is 58°C or 75°C.

4) The numerical range of the claimed invention is "close" to a particular value disclosed in the reference document, for example, the drying temperature according to invention is from 90 to 100°C, while that in the reference document is 105°C. In this case, the numerical range of the invention possesses novelty if: a) the numerical range of the invention is "sufficiently far away" from the known particular value, b) the numerical range of the invention is "narrower" than the known particular value, and c) the numerical range of the invention brings about an effect that would make the claimed invention "special".

5) Where the numerical values or numerical range of the invention being claimed fall within the range disclosed in the reference document and do not have any common end point with it, the reference document does not take away the novelty of the claimed invention.

Example 1:

The Application claims a piston ring for internal combustion engine, wherein the diameter of the piston ring is 95 mm. If the reference document disclosed a piston ring of 70-105 mm in diameter used in internal combustion engine, it does not take away the novelty of said claim.

Example 2:

The Application claims an ethylene-propylene copolymer, wherein the polymerization degree is 100-200. If the reference document disclosed an ethylene-propylene copolymer in which the polymerization degree is 40-500, it does not take away the novelty of said claim.

22.2.2.5 Product claims including features of performance, parameters, use, or manufacturing process

For examination of novelty of the product claims including features of performance, parameters, use, or manufacturing process, the

following rules shall be followed:

1) Product claims including features of performance or parameters

For this kind of claims, the examiner shall consider whether the feature of performance or parameters in the claim implies that the presently claimed product has a certain particular structure and/or composition. If the feature of performance or parameters implies that the claimed product has a structure and/or composition distinct from that of the product disclosed in the prior art document, the claim has novelty. On the other hand, if the person skilled in the art, from the performance or parameters, cannot distinguish the claimed product from that disclosed in the prior art document, it can be presumed that the claimed product is identical with the product in the prior art document and the claim does not accordingly have novelty, unless the applicant can prove that the claimed product is distinct from the product in the prior art document in structure and/or composition.

For example, a claim is to a compound A in a crystalline state defined by a variety of parameters including X-diffraction data, and the prior art document also disclosed a compound A in a crystalline state. If the crystalline state of the both cannot be distinguished from each other based on the disclosure of the prior art document, it can be presumed that the claimed compound is identical with the one in the prior art document and accordingly the claim does not have novelty as compared with the prior art document, unless the applicant can, based on the Application or the prior art, prove that the claimed compound is actually distinct in crystalline state from that disclosed in the prior art document.

2) Product claims including feature of particular use

For this kind of claims, the examiner shall consider whether the stated use in a claim implies that the claimed product has a certain particular structure and/or composition. If the use does not imply any change in the structure and/or composition of the product, the claimed product defined by such a use does not have novelty as compared with the product in the prior art document. However, if the use implies that the claimed product has a certain particular structure and/or composition, that is, the use indicates that the structure and/or composition of the product has changed, then the use must be considered as a definitive feature of the new structure and/or composition of the product.

For example, where a statement in a claim reading as "a hook for crane" shall be construed as "a hook" in size and strength which are

particularly suitable for crane, the claimed hook is therefore distinct in structure from "a hook for fishing (a fishhook)" which has a similar shape but is used for fishing, that is, the claimed invention is different in size and strength from the hook for fishing. Therefore, they shall be considered as different products. Whereas a hook including technical features with size and strength, in addition to all the other features as described in the claim, suitable for crane, will be novelty destroying to the presently claimed "hook for crane" regardless of whether the former is used for crane or not.

Similarly, a claim to a substance or compound for a particular use shall generally be construed as meaning such a substance or compound which is in fact suitable for the stated use; a known product which prima facie is the same in composition as the substance or compound defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty. Whereas the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it would deprive the claim of novelty. One exception to this provision is however a claim to a compound or composition for use in a method for prevention, diagnosis, or treatment of disease. Although the method for prevention, diagnosis, or treatment of disease practiced on the human and animal body are excluded from patentability according to Article 59 of the Law on IP, but the apparatuses and compounds for use in the treatment of disease can be patentable.

3) Product claims including features of manufacturing process
For this kind of claims, the examiner shall consider whether the feature of manufacturing process results in a certain particular structure and/or composition of the product. If the person skilled in the art can conclude that the process will necessarily result in a product having a particular structure and/or composition different from that of the product in the prior art document, the claim has novelty. On the other hand, if the claimed product, as compared with the product in the prior art document, has the same structure and composition despite the different manufacturing process, the claim does not have novelty, unless the applicant can prove that the process results in a product having a different structure and/or composition, or having a different performance thereby indicating that its structure and/or composition has changed.
For example, a claim is to a glass cup made by process X, and a

prior art document disclosed a glass cup made by process Y. If the glass cups made by either of those processes has the same structure, shape, and constituent material, the claim does not have novelty. On the other hand, if the process X comprises a step of annealing at a particular temperature not disclosed in the prior art document, which considerably increases the breaking resistance of the glass cup so made as compared with that in the prior art document. Therefore, it indicates the claimed glass cup has a different microstructure due to the different manufacturing process and has an internal structure different from that in the prior document. Therefore, the claim has novelty.

22.2.3 Examination of novelty of the Application claiming priority Under Article 91 of the Intellectual Property Law and Article 10 of the Decree, an applicant may claim priority on the basis of the first Application, which has been filed in Vietnam or in a country that is a member of Paris Convention, a member of WTO or a member of an international treaty having provisions on priority right to which Vietnam is a party or a country having agreed with Vietnam to apply such provisions, provided that the conditions in Article 91 and Article 10 are satisfied.

22.2.3.1 Definition of invention for the same subject-matter

An invention for the same subject matter means an invention of which the technical field, technical problem to be solved, technical solution, and prospective effect are the same as those of the first Application, respectively. It shall be noted that the term "same" herein does not mean that the wording or manner of description is exactly the same.

The examiner shall note that it is not necessary for the said technical solution to be contained in the claims of the first Application.

22.2.3.2 Right of foreign priority

In addition to the provisions of Article 91 of the Intellectual Property Law and Article 10 of the Decree, a patent Application may claim the priority right from the first-filed foreign Application if the following conditions are satisfied:

- 1) The first Application is an Application for invention, utility solution, utility model or equivalent kind of protection within the meanings of patent law of the foreign country where the first

Application has been filed;

2) The first Application has not claimed priority right from any previous Application;

3) The entitlement of an invention to a priority right has no relevance with the final examination result in the country where the first foreign Application has been filed.

22.2.3.3 Right of domestic priority

In addition to the provisions of Article 91 of the Intellectual Property Law and Article 10 of the Decree, a patent Application may claim the priority right from the first Application filed in Vietnam if the following conditions are satisfied:

1) The first Application is a patent Application for invention;

2) The first Application has not claimed priority right from any previous Application;

3) The first Application has not yet been granted a patent for invention or patent for utility solution if it includes the same claimed subject matter as that of the subsequent Application;

4) The first Application is not a divisional Application from a previous Application filed under Point 17.2 of the Circular.

In examination of a patent Application claiming priority right it is worth noting that in case the first Application has been granted a patent, the subsequent Application may be granted if its claimed subject matter is distinct from that of the first Application.

22.2.3.4 The subsequent Application is considered as the first Application

A subsequent Application for the same invention and/or the same claimed subject matter as that of the first Application, and having been filed in the same country member of Paris Convention or WTO, shall be considered as the first Application serving as a basis for claiming a right of priority if at the filing date of the subsequent Application:

The previous Application has been withdrawn, abandoned or refused without having been published or without leaving any rights outstanding, and

The previous Application has not yet served as a basis for claiming priority rights.

The above condition shall be checked only if there is a ground proving existence of a previous Application. If there is a ground proving existence of the previous Application, and the priority

claim shall have effect on determination of the prior art of the Application under examination, the applicant must submit a document established by a competent authority (as usual, the National Office of Intellectual Property) to prove that the previous Application does not leave any outstanding rights with respect to the claimed subject matter of the Application under examination.

22.2.3.5 Effect of priority claim

A subsequent Application claiming priority from a previous Application having been filed in a foreign country or in Vietnam (the first Application) shall be treated as if it had been filed on the date of filing of the first Application. Consequently, the subsequent filing within the priority period (12 months), that is, the period between the date of filing of the first Application and that of the subsequent Application, shall not be affected by another filing by any person for the same subject matter, or the publication or exploitation of the invention, accomplished at any time during the priority period.

Furthermore, during the priority period, any person may file a patent Application for the same subject matter. Because of the effect of priority claim, no patent shall be granted to such an Application. That is to say, due to the existence of the first Application having been filed in a foreign country or in Vietnam, the patent Application for the same subject matter filed by any other person within the period from the date of filing of the first Application and that of the subsequent Application cannot be granted for a patent right because of lack of novelty.

22.2.3.6 Claiming multiple priorities

In accordance with Item 2, Article 91 of the Intellectual Property Law, an applicant may claim one or more priorities in one Application on the basis of multiple previous Applications, provided that he can show the correspondence between the content of the previous Applications and that of the Application under examination. Where multiple priorities are claimed, the priority period for the Application shall be calculated from the earliest priority date. Any patent Application claiming multiple priorities shall meet the requirement on unity as provided for in Item 2, Article 101 of the Intellectual Property Law and Point 23.3 of the Circular. It is worth noting of the following:

- 1) The first foreign Applications serving as bases of the multiple

priorities might be filed in different countries or intergovernmental organizations.

For example, a subsequent Application sets forth two technical solutions A and B, wherein solution A was described in an Application first filed in France, solution B was described in an Application first filed in Germany, and both the Applications were filed within twelve months before the filing date of the subsequent Application claiming priorities from the two above patent Applications. Under such circumstance, the subsequent Application may enjoy multiple priorities, i. e., solution A may enjoy the priority date of the French Application and solution B may enjoy the priority date of the German Application.

2) If the technical solution described in the subsequent Application is a combination of different technical features described respectively in two or more first filed Applications, the subsequent Application cannot enjoy a right of priority. For example, the technical solution described in the subsequent Application is a combination of technical feature C described in one first filed Application and technical feature D described in another first filed Application, and the technical solution containing both features C and D has never been described in the two first filed Applications, the subsequent Application cannot enjoy the right of priority.

3) The Application claiming right of priority may, in addition to the technical solutions described in the Application serving as the basis of the right of priority, contain one or more new technical solutions as well.

For example, in a subsequent Application, in addition to the technical solution described in the first Application, a new technical solution which further improves or perfects said solution has also been described, such as by adding a dependent claim which reflects a new embodiment, or by adding an independent claim meeting the requirements of unity. Under such circumstance, the examiner shall not deny the right of priority just on the ground that the technical solution added in the claims of the subsequent Application was not described in the first Application, but acknowledge the right of priority for the invention on the same subject matter as in the first filed Application, taking the filing date of the first filed Application (i. e., the priority date) as the filing date, and for other inventions, take the filing date of the subsequent Application filed as the filing date.

4) If the subsequent Application describes technical solution A and

embodiments a1, a2 and a3, wherein only embodiment a1 has been described in the first Application, then in the subsequent Application only embodiment a1 may enjoy the priority, while technical solution A and embodiments a2 and a3 cannot enjoy the priority.

5) If the subsequent Application describes technical solution A and embodiments a1 and a2, wherein technical solution A and embodiment a1 have been described in the first Application, then in the subsequent Application technical solution A and embodiment a1 may enjoy the priority, while embodiment a2 cannot enjoy the priority. It shall be noted that the above paragraph refers to the situation where the scope of protection for technical solution A cannot be fully supported by only embodiment a1 and thus the applicant may supplement embodiment a2 to support solution A. However, if embodiment a2 forms part of the prior art when the subsequent Application is filed, then it shall be rejected and the scope of protection for technical solution A shall be limited to the extent that can be supported by only embodiment a1.

6) If, after a first subsequent Application was filed following the first filed Application, the applicant filed a second subsequent Application, and the first filed Application describes only technical solution A1, the first subsequent Application describes technical solutions A1 and A2, wherein A1 enjoys the priority of the first filed Application, and the second subsequent Application describes technical solutions A1, A2 and A3, then, in the second subsequent Application, technical solution A2 may enjoy the priority of the first subsequent Application, and technical solution A1 cannot claim the priority of the first subsequent Application since the latter has already enjoyed a right of priority, but it may nevertheless claim the priority of the first filed Application.

22.2.4 Grace period for non-prejudicial disclosures

According to item 3 of Article 60 of the Intellectual Property Law an invention is not deemed to lose its novelty where, within 6 months before the date of filing, one of the following events occurred:

- 1) Where it was disclosed by any person without the consent of the applicant;
- 2) Where it was first made public as a scientific report;
- 3) Where it was first exhibited at a Vietnamese national or official, or recognized as official, international exhibition.

Within 6 months before the filing date (so called the "grace period") if an invention is disclosed by any of the above three events, the relevant disclosure does not form part of the prior art to said Application.

The effect of grace period is different from the effect of priority. The invention which was disclosed by the above events does not lose its novelty if the Application for this invention is filed within the grace period. Nevertheless, it does not mean the date of disclosure of the invention is regarded as the priority date of the Application. Therefore, if any third person makes an identical invention independently during the period from the date of disclosure to the date of filing and files a patent Application earlier than the Application by the applicant, then, according to the principle of first-to-file provided in Article 90 of the Intellectual Property Law, the applicant cannot get the patent right. On the other hand, the Application by the third person does not have novelty and cannot be granted patent right, due to the above disclosure of the invention.

If, within 6 months from the date on which any of the above events occurred and before the applicant files the Application, the invention was disclosed once again, provided that the second disclosure does not belong to any of the prescribed events, the later disclosure will take away the novelty of the Application. If the later disclosure also falls into any of the three prescribed events, the Application does not lose novelty because of this later disclosure, but the grace period shall be calculated from the date of the first disclosure.

For example, the inventor of a new toy presented a report of his new product at a scientific committee of toy industry on 1/3/2007. While visiting an International exhibition of toy industry on 1/6/2007, he found that the toy was exposed by a foreign toy manufacturer. If the patent Application for the toy is filed after 1/6/2007, and even before 1/9/2007, the invention will lose its novelty.

In order to enjoy grace period, the applicant shall submit relevant documents to prove the date on which the event occurs and the contents of the disclosure. If such documents have not been submitted upon filing, the examiner shall request the applicant submit the documents within 2 months from the date of request. Where the applicant fails to submit the requested documents, the Application cannot enjoy the grace period of novelty as provided for in Item 3, Article 60 of the Intellectual Property Law.

Article 23. Assessment of inventive step

23.1 Principles of examination of inventive step

23.1.1 Examination of inventive step is conducted respectively for each invention (as recited in each claim) in accordance with Point 25.6 of the Circular.

23.1.2 An invention is considered as involving an inventive step if, having regard to the state of the art, it constitutes an inventive progress and cannot be easily created by a person with ordinary skill in the relevant art (Article 61 of the Intellectual Property Law), wherein the requirement "not easily created by a person with ordinary skill in the relevant art" or "not obvious to a person with ordinary skill in the relevant art" (see Points 25.6.b and 25.6.c of the Circular) is essential.

23.1.3 An invention which does not possess novelty, evidently does not involve an inventive step. The determination as to whether or not an invention involves an inventive step shall be considered only when the invention (claim) has novelty.

23.2 Well-known technical solutions

Well-known technical solutions are the technical solutions which fall within the prior art as defined in Article 22.1.1 of this Regulation.

In case the Application claims priority right, the priority date shall have the effect of the filing date if the invention as recited in one examined claim has been disclosed in the scope equivalent to the priority Application with the corresponding filing date. In order to ensure that this requirement is met, the examiner shall compare the content of the examined Application with the priority Application(s). This process is required only when the search reveals a document(s) having been published after the priority date but before the filing date of the Application under examination, and the document(s) may prejudice the novelty/inventive step of the later. Such a document is called intermediate document.

23.3 Person with ordinary skill in the relevant technical field (Point 23.6.a of the Circular)

The person with ordinary skill in the relevant technical field

refers to a person who have routine experimental skill and is aware of all the common technical knowledge in the relevant technical field at the relevant date (Point 23.6.a of the Circular). He is also presumed to have had access to all the documentation and information in the prior art, and to have had at his disposal the means and capacity for routine work and experimentation which are normal for the field of technology in question. If the technical problem to be solved prompts the person with ordinary skill in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. Assessment of whether an invention involves an inventive step must therefore be based on that specialist's knowledge and ability. There may be instances, where it is more appropriate to consider a person with ordinary skill in the relevant technical field as a group of persons, e.g. a research or production team, rather than a single person. This approach may be applied in assessment of inventive step of an invention in the advanced technologies, such as computer system or smart phone, and in highly specialized processes such as manufacture of integrated circuit or production of complex substances at industrial scale.

23.4 Obviousness (Points 25.6b and 25.6c of the Circular)

Where the invention mentioned in one claim is considered obvious to the person skilled in the art if having regard to the art known, before the filing or priority date valid for that claim, it is considered as not involving an inventive step (Points 25.6b and 25.6c of the Circular). The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art. In particular, the invention is considered to be made in the obvious way by a person skilled in the art without involving the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, any published document can be understood in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person skilled in the art at the day before the filing or priority date valid for the claimed invention.

23.5 Set and combination of features

The invention claimed must normally be considered as a whole. Where a claim consists of combination of features, it is not correct to

argue that the separate features of the combination taken themselves are known or obvious and that therefore the whole subject matter claimed is obvious. However, where the claim is merely an aggregation or juxtaposition of features and not a true combination, it is not enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step. A set of technical features is regarded as a combination of features if the functional interaction between the features achieves a combined technical effect which is different from, e.g. greater than, the sum of the individual features. In other words, the interactions of the individual features must produce a synergistic effect. If no such synergistic effect exists, it may be concluded that the invention is a mere aggregation of features and therefore the invention does not involve an inventive step.

For example, an individual transistor has a technical effect which is essentially that of an electronic switch. However, transistors are connected together to form a microprocessor capable of synergistic interaction to achieve technical effect, such as data processing, and the technical effect is superior to and above the sum of their respective individual technical effects.

23.6 Assess an inventive step based on the way the invention was made

The invention is considered to be obviously made by the person skilled in the art if it were made in a way in which the person skilled in the art could make. There are various ways in which the skilled person may arrive at an invention. An invention may, for example, be based on the following:

i) Proposal of a solution to solve a yet unrecognized problem (the solution being obvious once the problem is clearly stated)

Example: Appropriate tests by the applicant revealed that the effect of a known chemical formulation was no longer satisfactory after prolonged storage, the claimed solution being retrospectively trivial and in itself obvious.

ii) The devising of a solution to a known problem

Example: the problem of permanently marking farm animal such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution consists in applying the discovery that the hide can be permanently depigmented by freezing ("Freeze- branding") to mark the animals with less pain. This invention is considered to be made obviously by the person skilled

in the art by using the new discovery, therefore the invention does not meet the criteria of inventive step.

iii) The arrival at an insight into the cause of an observed phenomenon

Example: The agreeable flavor of butter is found to be caused by minute quantities of a particular compound. The invention, which proposed a method for flavoring a margarine by adding this compound to it, is considered to be obviously made by a person skilled in the art where he knows the cause, so the invention does not meet the criteria of inventive step.

23.7 Assess inventive step according to problem-and-solution approach

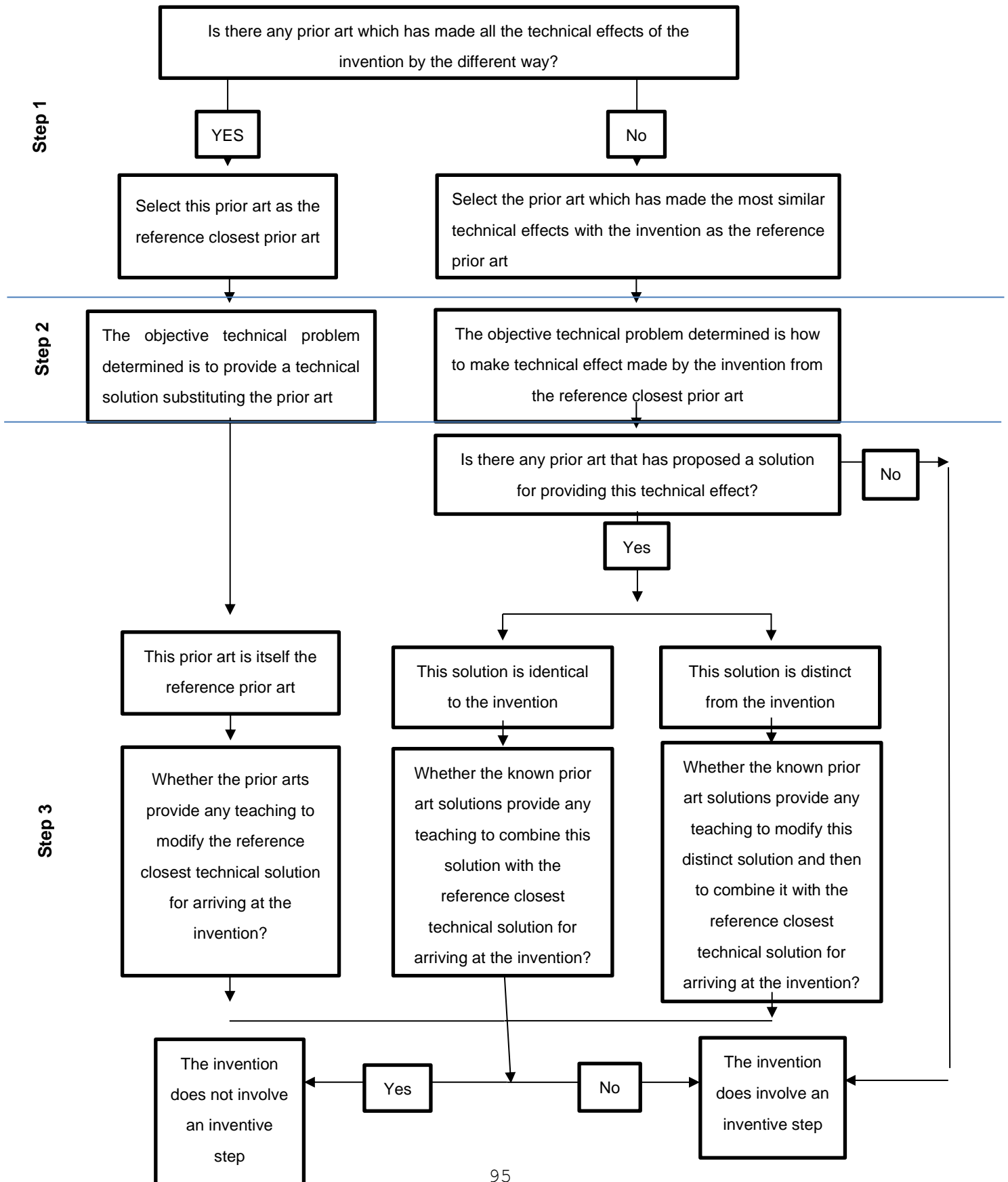
23.7.1 In the problem-and-solution approach, there are three main stages:

(i) Determining the "closest prior art" which is that having the similar purpose and technical effect as the invention or at least belongs to the same or closely related technical field as the claimed invention;

(ii) Establishing the "objective technical problem" to be solved based on the difference (the distinguishing technical feature(s) of the invention) in terms of features between the invention and the closest prior art;

(iii) Considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

Flowchart for assessing inventive step by the problem-and-solution approach



23.7.2 Determination of closest prior art

In the stage 1, it is necessary to determine the closest prior art. The closest prior art is that combination of feature, disclosed in one single reference, which constitutes the most promising starting point for an obvious development leading to the invention. In selecting the closest prior art, the first consideration is that it shall be directed to a similar purpose or technical effect as the invention or at least belongs to the same or closely related technical field as invention. In practice, the closest prior art is generally equivalent to the invention and has a similar usage as invention and requires the minimal variations in structure and function to arrive at the claimed invention.

The closest prior art must be assessed from the skilled person's skills and knowledge on the day before the filing or priority date valid for claimed invention mentioned in one claim.

In identifying the closest prior art, account shall be taken of what the applicant himself acknowledges in his description and claims to be known. Any such acknowledgement of known art shall be regarded by the examiner as being correct unless the examiner demonstrates the contrary.

For the invention of process-type, the closest prior art is normally process that is similar to the invention with the final product is the same or similar.

For the invention of product-type, the closest prior art is often the product having a similar usage and purpose due to its technical effect almost similar or similar to that of the invention. In addition, this product often has the most number of technical features similar to the invention (may be determined by a table for analyzing the features). For example, if the invention relating to an improved table then the closest prior art is a table having the similar use. It is preferable, this table has as many as possible the number of the structural features similar to the invention. However, for the invention in certain chemical fields, the closest prior art has less a structural similarity to the invention than other fields. This is because the most structurally similar known technical solution to the invention does not have a similar technical effect as the invention; in particular, the structural modification of one compound may alter totally it's use. For example, the modification of one compound used as a weed killer it has not any more the weed killer effect, instead it has an insect

killer effect, therefore it may be used as an insecticide. Accordingly, the closest prior art must be an insecticide. Although similar in structure that weed killer cannot be considered as the closet prior art for this insect killer, on the other hand, it cannot be considered as the reference closest prior art because it does not belong to the technical field of the invention. In determining the reference closest prior art, it may be used the table for analyzing the technical features of the invention and the corresponding features of the reference prior art, from this find out the reference closest prior art who has the technical effects similar to that of the claimed invention and belongs to the same or a closely related technical field as the claimed invention and finally has in common most technical features with the claimed invention.

23.7.3 Identification of the objective technical problem

In the second stage, the examiner shall identify the technical problem to be solved. To do this, the examiner studies solutions disclosed in the Application and that of the closest prior art and finds out the difference in terms of features (either structural or functional) between the invention and the closest prior art (also called "distinguished feature(s)") of the invention, and then identifies the technical problem.

Feature, which cannot be seen to make any contribution, either independently or in combination with other features, to the technical character of an invention are not relevant for assessing inventive step. Such a situation can occur for instance in the case there is at least one feature only contributes to the solution of a non-technical problem, for instance a problem in a field excluded from patentability.

Where the claim refers to aim to be achieved in a non-technical field, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem to be solved, in particular it is used as a limit to be met.

In the context of the problem-and-solution approach, the technical problem means the aim and task of modifying the closest prior art to provide the technical effects that the invention provides over the closest prior art. The technical problem thus defined often referred to as the "objective technical problem".

The objective technical problem derived in this way may not be what the applicant presented as "the problem" in his Application. The

latter may require reformulation, since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the Application was filed. The extent to which such reformulation of the technical problem is possible has to be assessed on the merit of each particular case. As a matter of principle, any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the Application as filed. It is also possible to rely on new effect submitted subsequently during the proceedings by the applicant, provided that the skilled person would recognize these effects as implied by or related to the technical problem initially suggested.

The expression "technical problem" shall be interpreted broadly, it does not necessarily imply that the technical solution is a technical improvement over the prior art. Thus, the problem could be simply to provide an alternative to a known device or process providing the same or similar effects which is more cost-effective.

23.7.4 Assessing the obviousness of the invention for the skilled person

In the third stage, the question to be answered is whether there is any teaching in the prior art as a whole that would have prompted the skilled person, faced with the objective technical problem, to modify the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claim, and thus achieving what the invention states. In other words, the point is that whether the skilled person could be able to solve the objective technical problem or modify the prior art to create the invention. This process shall be carried out based on the prior art before the filing or priority date valid for the claim.

23.7.5 Examples of the implementing the problem-and-solution approach for assessing inventive step

a) Example 1

(i) Situation

The invention relates to a medicine in form of a syringe containing lipoic acid (an oxidizable agent) and an inert gas as a stabilizing agent for lipoic acid.

Document D1 relates to a medicine in form of a syringe containing

lipoic acid and cysteine (a reducer) as a stabilizing agent for lipoic acid.

Document D2 relates to the using inert gas or reducer or both, as a stabilizing agent for oxidizable agent.

(ii) Assessing inventive step according to the problem-and-solution approach

Stage 1: Determining the "reference closest prior art": Among the technical solutions mentioned in document D1 and D2, the solution mentioned in D1 is considered as the reference closest prior art because it has the same technical effect with the invention - stabilizing lipoic acid.

Stage 2: Establishing the "objective technical problem" to be solved: By using the problem-and-solution shown in the flowchart, the objective technical problem determined is to provide a solution alternative to the prior art.

Stage 3: Assessing inventive step of the invention for the skilled person in the art: The invention is different from the reference closest prior art mentioned in the document D1 in the use of the inert gas instead of the cysteine reducer. The invention mentioned in the document D2 has referred to the using an inert gas or a reducer as a stabilizing agent for oxidizable agents. Thus, this solution provided teaching about that an inert gas may be used instead of a reducer as a stabilizing agent for the oxidizable agent (lipoic acid). From this teaching, a skilled person in the art may modify the closest solution mentioned in the document D1 from the using a reducer into the using an inert gas to derive the invention. In this case, the invention is considered to be obvious for a skilled in the art and therefore does not have an invention step.

b) Example 2

(i) Situation

The invention relates to a mobile phone having two feedback sensors that are provided in the opposite corners at the diagonal of a touch screen. The technical effect of the invention is to help the user to simply use a mobile phone by the thumb to sense the feedback sensors.

Document D1 relates to a mobile phone having a feedback sensor in every corner of the touch screen.

Document D2 in certain embodiments relates to a touch screen wherein:

- The screen may have one, two (arranged in the opposite corners of the diagonal) and four feedback sensors;

- Every embodiment disclosed as optimal depending on the user's need with the different advantages and disadvantages;
- The document also mentioned the teaching of the process of signaling from the touch screen for use in the device using the touch screen.

(ii) Assessing inventive step according to the problem-and-solution approach

Stage 1: Determining the "reference closest prior art" (see the table below)

Table for analyzing the technical features

The invention	D1 (Mobile phone)	D2 (Screen)
Mobile device	Yes	No
Phone	Yes	No
Screen	Yes	Yes
Feedback sensor	Yes	Yes
Have exactly two feedback sensors	No	Yes
Two feedback sensors provided in the opposite corners at the diagonal	No	Yes

Conclusion: Two reference prior arts mentioned in document D1 and D2 have four technical features in common with the invention, respectively, but the prior art mentioned in document D1 is considered as the closest one due it belongs to the same technical field as the invention.

Stage 2: Establishing the "objective technical problem" to be solved: The reference closest prior art does not provide the technical effect of the invention. The difference between the invention and the reference closest art mentioned in the document D1 is that there are only two, instead of four, feedback sensors. Here, technical problem determined is that how to arrive the technical effect of the invention from the reference closest art.

Stage 3: Assessing inventive step of the invention for the skilled person in the art: The document D2 proposed a solution to provide the technical effect similar to that of the invention. In particular, the solution mentioned in the document D2 pointed out

that the number of feedback sensors may be regulated depending on the user's need, wherein the use of two feedback sensors is an obvious option if the user would desire to use with two thumbs. This solution also provided the teaching for the use of this screen in order to supply a signal to the other devices by using a touch screen. By doing this, the skilled person in the art may combine the solution mentioned in the document D2 with the reference closest art mentioned in the document D1 to arrive the invention. Thus, the invention is considered to be obvious for the skilled person in the art and does not have inventive step.

23.8 Factors to be considered in combining prior art documents

It is permissible to combine the disclosure of one or more documents, parts of documents or other types of the prior art (e.g. a public prior use) with reference closest prior art. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be the sign of the presence of an inventive step.

In determining whether it would be obvious to combine two or more distinct disclosures, the examiner shall also have regard in particular to the following factors:

(i) Whether the content of the reference technical solutions (e.g. disclosure in the reference document) is likely or unlikely to be combined by the person skilled in the art, when faced with the problem solved by the invention. For example, if two disclosures considered as a whole could not in practice be readily combined because of inherent incompatibility in disclosed features essential to the invention, the combining of these disclosures shall not normally be regarded as obvious.

(ii) Whether the disclosures, e.g. documents, come from similar, neighboring or remote technical filed.

(iii) The combining of two or more parts of the document would be obvious if there is a reasonable basis for the skilled person to associate these parts with one another. It would normally be obvious to combine a prior art document with a well - known textbook or standard dictionary. It is also obvious to combine the technical solution mentioned in one or more reference documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents, one of which contains a clear reference to the other. In determining whether it is obvious to combine one solution mentioned in the reference document with the

form of use, the similar approach is used.

23.9 Assessing inventive step based on the relevant factors

23.9.1 Invention based on the disadvantageous, non-functional modification, arbitrary choice

If the invention is the result of foreseeable disadvantageous modification of the reference closest prior art, which the skilled person could clearly predict and correctly assess, and if this predictable disadvantageous modification is not accompanied by an unexpected technical advantage, then the claimed invention does not involve an inventive step. In other words, a mere foreseeable worsening of the prior art does not involve an inventive step. However, if this worsening is accompanied by an unexpected technical advantage, an inventive step might be present.

Similar assessments apply to the case where an invention is merely the result of an arbitrary non-functional modification of a prior art device or a mere arbitrary choice from a group of possible solutions.

23.9.2 "Ex post facto" analysis, surprising technical advantage

It shall be noted that in many cases an invention which at first sight appears obvious might in fact involve an inventive step. Once a new technical solution has been formed, it can often be shown theoretically how it might be arrived, at starting from something known, by a series of apparently easy steps. In this case, the examiner shall carefully carry out the ex post facto analysis of this kind. He shall bear in mind that the reference technical solutions found in the search themselves are known knowledge of what matter constitutes the alleged invention. In all cases, he shall attempt to visualize the overall state of the art confronting the skilled person before the invention made by the applicant and he shall understand the essence of the invention and other relevant factors. He also shall take into account all that is known concerning the background of the invention and give fair weight to arguments or evidence submitted by applicant. For example, if an invention is shown to be of considerable technical value, and particularly if it provides a new and surprising technical advantage and which can convincingly be related to one or more of the features included in the claim defining the invention, then the invention is considered to involve inventive step.

23.9.3 Unexpected technical effect and bonus effect of the invention

An unexpected technical effect may be regarded as a factor conferring an inventive step of the invention. However, if, having regard to the state of the art, it would already have been obvious for a skilled person to arrive at something falling within the terms of a claim, the unexpected effect is merely a bonus effect which does not confer inventiveness on the invention.

23.9.4 Long-felt need, commercial success

Where the invention solves a technical problem which people in the art have been attempting to solve for a long time, or otherwise fulfills a long-felt need, this invention may be regarded as involving an inventive step.

Commercial success alone is not to be regarded as indicative of inventive step.

However, evidence of immediate commercial success when coupled with evidence of a long-felt want is appropriate to convince the examiner that this success is created on the basis of technical indication of the invention and not from other influences (e.g. selling techniques or advertising).

23.10 Considering the arguments and evidence submitted by the applicant

The relevant arguments and evidence to be considered by the examiner for assessing inventive step may either be taken from the originally filed patent Application or submitted by the applicant during the subsequent proceedings.

Care must be taken, however, whenever new effects in support of inventive step are referred to. Such new effects can only be taken into account if they are implied by or at least related to the technical problem initially suggested in the originally filed Application.

- Example of such a new effect:

The invention as filed relates to a pharmaceutical composition having a specific activity. At first sight, having regard to the relevant prior art, it would appear that there is a lack of inventive step. Subsequently, the applicant submits new evidence which shows that the claimed composition exhibits an unexpected advantage in terms of low toxicity. In this case, it is allowable to reformulate the technical problem by including the effect of

toxicity, since pharmaceutical activity and toxicity are related in the sense that the skilled person would always contemplate the two aspects together.

The reformulation of the technical problem may or may not give rise to amendment or insertion of the statement of the technical problem in the specification. Any such amendment is only allowable if the new technical effect may be readily deduced by the skilled person based on the initially filed Application. In the above example of a pharmaceutical composition, neither the reformulated problem nor the information on toxicity could be introduced into the specification.

23.11 Assessing inventive step of selection inventions

The subject matter of selection inventions differs from the reference closest prior art in that it represents selected sub-sets or subranges. If this selection is connected to a particular technical effect and if no hints exist leading the skilled person to the selection, then an inventive step is accepted (this technical effect occurring within the selected range may also be the same effect as attained with the broader known range, but to an unexpected degree). In assessing inventive step of selection inventions, the main task of the examiner is to consider whether the skilled person is able to make the selection in the hope of solving the underlying technical problem or in expectation of some improvement or advantage. If the answer is negative, then the claimed matter involves an inventive step.

23.12 Assessing inventive step of the invention mentioned in dependent claims and in claims of different categories

If the invention mentioned in an independent claim is new and non-obvious, then the invention mentioned in dependent claims thereon naturally is new and nonobvious, except in situations where the subject matter of a dependent claim has a later effective priority date than the independent claim. If it exists, intermediate documents are to be considered (see Article 23.2), if any. Similarly, if a claim to a product is new and non-obvious, then a process which inevitably results in the manufacture of that product is naturally new and nonobvious. In particular, analogy processes, i.e. processes which themselves would otherwise not involve an inventive step, are nevertheless patentable insofar as they provide a novel and inventive product. It shall, however, be noted that in cases where the product and process claimed have different effective

priority dates, a separation examination as to novelty and inventive step may still be necessary if intermediate documents is present (see Article 23.2).

23.13 Typical examples of assessing inventive step

This point gives examples of circumstances where an invention may be regarded as obvious or where it may involve an inventive step, therefrom a conclusion of inventiveness may be drawn. It is to be noted that these examples are only for illustrative purposes and that the applicable principle of assessing inventiveness in each case is always to assess whether it was obvious to the person skilled in the art. Examiners shall avoid attempting to fit a particular case into one of these examples if it is not clearly applicable. Also, the circumstances as mentioned in these examples are not exhaustive in practice.

23.13.1 Inventions involving the Application of known means

a) Inventions involving the Application of known means in an obvious way and in respect of which an inventive step is therefore to be ruled out

(i) The teaching of a prior document is incomplete and at least one of the possible ways which would naturally or readily occur to the skilled person results in invention;

Example: The invention relates to a building structure made from aluminum. A prior document discloses the similar structure and says that it may be made of light-weight material but fails to mention the use of aluminum.

(ii) The invention differs from the known art merely in the use of well-known equivalent means (mechanical, electrical or chemical);

Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric one.

(iii) The invention consists merely in a new use of well-known material employing the known properties of that material;

Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

(iv) The invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use ("analogous substitution");

Example: An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of particular newly developed adhesive known to be suitable for polymer-metal bonding.

(v) The invention consists merely in a new use of know technique in a closely analogous situation ("analogous use").

Example: The invention resides in the Application of a pulse control technique to the electric motor driving the auxiliary mechanism of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

b) Inventions involving the Application of known means in a non-obvious way and in respect of which an inventive step is therefore to be recognized

(i) The invention is a known working method or means when used for a different purpose involves a new, surprising effect;

Example: It is known that high-frequency power can be used in inductive butt welding. It shall therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect. However, if high-frequency power is used for the continuous conductive butt welding of coiled strip but without removing (such scale removal normally being necessary during conductive welding in order to avoid arcing between the welding contact and the strip), there is the unexpected additional effect that scale removal is found to be unnecessary because at high-frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric. In that case, an inventive step would exist.

(ii) The invention is a new use of a known device or material involves overcoming technical difficulties not resolvable by routine techniques.

Example: The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons, but practical difficulties not encountered in the known Applications needed to be overcome in applying the device to a gas holder.

23.13.2 The invention is an obvious combination of known technical solutions.

a) The invention which is a combination of the known technical solutions in an obvious way does not involve an inventive step. The invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and does not create any non-obvious working inter-relationship.

Example: Machine for producing sausages consisting of a known mincing machine and a known filling machine disposed side by side is regarded as obvious to the skilled person and therefore does not involve an inventive step.

b) The invention which is a combination of known technical solutions together in a non-obvious way is regarded as involving an inventive step.

In this case, the combined technical solutions mutually support each other in their effects to such an extent that a new technical result is achieved. It is not important whether each individual solution is fully or partly known by itself. However, if the combination of solutions is a bonus effect, the combination might lack an inventive step.

Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquillizer (sedative). The invention is created by the finding that through the addition of the tranquillizer, which intrinsically appeared to have no painkilling effect, the analgesic effect of the painkiller was intensified in a way which could not have been predicted from the known properties of the active substances. In this case, the invention is recognized as involving an inventive step.

23.13.3 The invention consists in choosing from known technical solutions

a) The invention consists merely in obvious choosing from a number of known embodiments and/or technical solutions and in respect of which an inventive step is therefore to be ruled out

(i) The invention consists merely in choosing from equivalent suitable technical solutions;

Example: The invention relates to a known chemical process in which it is known to supply to heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

(ii) The invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of

possibilities, and it is clear that these parameters could be arrived at by routine trial and error;

Example: The invention relates to a process for carrying out a known reaction and is characterized by specified rate of flow of an inert gas and it may be determined by the skilled person by using the routine trial and error.

(iii) The invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art;

Example: The invention is characterized by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterizing feature can be derived merely by extrapolation on straight line graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) The invention which consists merely in selecting particular chemical compounds or compositions (including alloys) from a broad field is regarded as not involving an inventive step.

Example: The prior art includes disclosure of a chemical compound characterized by a specified structure including substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broad-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxyl, although for particular reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or particular group of radical from amongst those referred to as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior art document therefore the invention is new). The resulting compounds:

- are neither described nor shown to possess any advantageous properties not possessed by the prior art; or
- are described as possessing advantageous properties compared with the compounds specifically disclosed in the prior art document, but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he may make this selection.

Therefore, the invention is regarded as not involving an inventive step since mere selecting particular chemical compositions from the broad field.

b) The invention which consists in non-obvious selection among a number of known embodiments/technical solutions is regarded as

involving an inventive step

(i) The invention resides in special selection in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection produces unexpected effects in the operation or the properties of the resulting product;

Example: In a process where substance A and substance B are transformed at high temperature into substance C. In general, it was known that there is constantly increased yield of substance C as the temperature increases in the range between 50 and 130°C. According to the invention, it is now found that in the temperature range from 63 to 65°C (previously had not been explored) the yield of substance C was considerably higher than expected.

(ii) The invention consists in selecting chemical compounds or compositions (including alloy) having unexpected advantages.

Example: In the example of a substituted chemical compound given at (iv) under 23.13.3 a) above, the invention again resides in the selection of the substituted radical "R" from the total field of embodiments defined in the prior disclosure. In this case, however, the invention is regarded as involving an inventive step because it not only has chosen a particular range of possible embodiments but has shown to possess advantageous properties, while there are no indications which would lead the person skilled in the art to this particular selection by which the advantageous properties have been achieved.

23.13.4 The inventions overcoming a technical prejudice

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the solution proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternating to the known way of overcoming a real or imagined technical obstacle.

Example: Drinks containing carbon dioxide are, after being sterilized, bottled while hot in sterilized bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

Article 24. The first-to-file principle

The purpose of the Article 90 of the Intellectual Property Law on the first-to-file principle is to ensure that where two or more Applications are filed by several parties to register the same invention, the protection tittle may only be granted with respect to the valid Application with the earliest date of priority or filing date among the valid Applications in order to prevent the conflict of the patent rights, i.e. for one invention there is no more one patent right valid at the same time.

"The same invention" according to Article 90 of Intellectual Property Law means two or more Applications which have the same claim. After substantive examination as to whether the Application has met the substantive requirements specified in Article 58 of Intellectual Property Law, if the Application has met all the requirements, the examiner shall carry out a check of the first-to-file principle (Article 90 of Intellectual Property Law) according to Point 25.7 of the Circular to ensure that the patent only be granted with respect to the valid Application with the earliest priority/filing date with the following notes.

(1) Protection scope of the invention must be defined by the terminology and concepts used in claim and specification together with drawings accompanied are used for supporting the claim. In order to determine whether two inventions identical to each other or not, the examiner shall compare the content of the claims of each Application with other rather than to compare claims of one Application with the whole content of the other Application. In determining whether the Applications are identical or not, if the protection scope in one Application claim is identical to that of other Application, it is possible to conclude that they are identical.

In the case the disclosure contents of the two Application are identical but the scope of the invention mentioned in the claims are different, the conclusion may be drawn that the inventions are different. For example, where the disclosure content of each Application relates to the same product and the same process for production thereof, but the claims of one relates to the product and other one relates to the production process of this product, the conclusion is that the Applications are different.

It is also noted that, where the scope of the claims for the inventions are partly coincided these inventions shall be regarded as not identical. For example, the claims of the later filed

Application contains one technical feature defined by a continuous number range, if this range is not exactly the same as this one mentioned in the early filed Application, then the two Applications must be regarded as not identical.

(2) Where during proceeding of the examination the examiner noted that there are two or more Applications having the identical filing/priority date filed by the different applicants for claiming the same invention and they have satisfied all the conditions for granting a patent specified in the Article 58 of Intellectual Property Law, the examiner shall send a communication to the applicants to compromise between them to choose who will be the applicant or become the co-applicants for single Application. When no answer in the prescribed time is received, the Applications are regarded as being drawn. During compromising, if there is no compromise achieved, or the compromise achieved but does not satisfy the requirement then all the Applications are regarded as refused for granting a patent.

(3) During searching or in any situation, if the examiner has found or known the existence of one Application for the same invention whose the filing/priority date is earlier than that of the pending Application then the examiner may apply the first-to-file principle without any more substantive examination thereof.

Article 25. Amendments, correction of errors during the substantive examination

25.1 According to the requirement on the Point 15.3 of the Circular, the examiner may request the applicant to correct the errors of the Application, including the explanation disclosure's content, to provide the information regarding to the essence of the subject matter. The errors in this stage may be predominantly certain substantive errors of the Application but they may be formality ones, if any, so that the amendment, the correction of errors and/or the explanation provide the above information ensuring that the claimed subject matter is sufficiently and clearly disclosed, including the information contained in the specification and satisfy the consistency of invention.

The examiner only takes into consideration the amendment, supplement made by the applicant if the applicant requests in writing and pay fee prescribed for such amendment, supplement.

The errors which the examiner may require the applicant to correct or explain or include information, but are not limited to, are as follows:

- Lack of consistency of invention;
- The information of the prior art is not well-grounded;
- The subject matter defined by insufficient technical features so that the purpose of the invention is not achieved;
- Content/technical terms/technical features are not clear and/or may be understood in different ways;
- The inconsistent use of the name of details/terms in the documents of the Application as well as in the same document of the Application;
- The use of the same reference number for indicating the different details;
- There is not reference mark in the figures as mentioned in the specification or vice-versa;
- Lack of translation of the priority document as required;
- Lack of the detailed explanation of the amended content as prescribed in Point 17.1.b of the Circular;
- Formality errors remained uncorrected in the documents of the Application.

The examiner must pay attention to the stipulations as set in Point 7.2.b(vi) of the Circular. Accordingly, the applicant only may correct trivial errors of spelling-type contained in the documents filed with National Office of Intellectual Property and they must be accompanied with the visa (and with the seal, if any) of the applicant.

In the communication sent to the applicant for requesting the correction of errors of the Application (communication form 240 in IPAS system) according to the stipulations prescribed in Point 15.3 of the Circular, the examiner must set a 2-month time limit for the applicant to fulfill the requirement. If in excess of the time limit the applicant does not correct the errors in the Application, the explanation of the contents or provides the information or fulfills the requirement as prescribed, the Application shall be treated according to the stipulation under Article 28 of this Regulation.

25.2 In the case via the search and/or via the submitting document made by the applicant according to the stipulations under Point 15.2 of the Circular, the examiner finds out that a pending Application for patent may be granted based on the foreign patent granted to the

family Application (family patent), the examiner shall send to the applicant a communication informing him/her that a patent may be granted provided the applicant makes amendment of the Application based on that patent (communication form 242 in the IPAS system) in the 2-month time limit. If within the set time limit, there is no response from the applicant the Application is deemed to be as withdrawn and is not pended any more (communication form 283 in the IPAS System). If during this time limit the applicant's answer is that he/she is not willing to amend the Application and/or take the initiative to amend, the Application then is continuously pended according to the routine procedure.

Protection titles or patents granted by the following foreign intellectual property offices may be considered as a basis for amending the Application in order to obtain a patent: The International Searching and Preliminary Examining Authorities under PCT; Patent, Industrial property or Intellectual property office of the United State of America (USPTO), Canada, Japan, Russia, United Kingdom, Sweden, Austria, Spain, Australia, China, South Korea, Germany, the European patent office (EPO), Eurasian patent office (EAPO).

If at the same time there are different family patents available in different countries and they have the different protection scopes, the examiner must determine the protection scope of which family patent is most suitable and/or satisfies the existing stipulations on patentability according to the Vietnam legal documents concerning to intellectual property in order to request the applicant to amend the Application based on that patent. In the case that family patent has one or some subject matters which do not meet Vietnam protection conditions then in amending, these subject matters shall be deleted from the amended claims according to the National Office of Intellectual Property (mentioned in the communication regarding to the amendment) or on the initiative of the applicant.

Article 26. Examination of amendments, supplements

According to the stipulations under Point 17 of the Circular, the applicant may take the initiative or at the request of the examiner to amend, supplement the Application. In compliance with the stipulations under Points 15.3 and 17 of the Circular, the amendment and supplement must be made in writing, including:

- A request for amending the Application (form 01-SDD);
- New pages or substituted pages for any amendment, correction,

- replacing, supplementing of the Application; and
- Detailed specification for the content replaced in which the content subjected to the replacing, supplement shall be indicated; and
 - Fee for the amendment of the Application content.

If the applicant failed to submit the detailed specification, the examiner must send a communication informing the applicant to submit in the prescribed 2-month time limit.

In examining the amended, supplemented documents, in addition to these documents, the examiner shall pay attention to the substituted pages due to amendment must meet the requirements prescribed in Point 7.2 of the Circular relating to the formality such as the page numbering and stipulations prescribed in Point 23.6 of the Circular relating to the consecutive claim numbering. It is noted that the claims shall be numbered consecutively in Arabic numerals followed by a dot. For the added pages they may be serially numbered 1, 2, 3, 3A, 3B, 4, for example. If there are pages deleted, the applicant must renumber the pages so that the pages are serially numbered.

Article 27. Conclusion on the patentability and the protection scope

27.1 For the case of the request for substantive examination filed by the applicant him/herself

According to Point 15.7 of the Circular, depending on the result of substantive examination, on the expiry day of substantive examination specified at Point 15.8 of the Circular, at the latest, the examiner must send to the applicant one of the following communications:

27.1.1 Communication about intended refusal to grant patent due to the subject matter does not fulfill the protection requirements
If the subject matter or the subject matters (in the case the group of inventions met the requirement on unity of invention) does not fulfill one of the protection requirements prescribed in Article 58 Intellectual Property Law (see examination of the protection conditions prescribed in Articles 21, 22 and 23 of this Regulation) the examiner must send to the applicant a communication about intended refusal to grant a patent with the reason that the technical solution of the Application does not fulfill protection conditions with the appended arguments (communication form 243 in the IPAS System).

If there is one or some subject matters of the Application does not

fulfill one or some conditions of the protection conditions but the other subject matters fulfill the protection conditions, the examiner sends to the applicant a communication about intended refusal with the reason that the technical solution partly does not fulfill the protection requirements with the appended arguments (communication form 243 in the IPAS System).

27.1.2 Communication about intended refusal to grant a patent in the case the subject matter of the Application fulfill the protection conditions, but the Application still has errors

If the subject matter/subject matters of the Application fulfill the protection conditions but the Application still has errors, the examiner must send to the applicant a communication about intended refusal to grant a patent with stating the errors of the application (communication form 243 in the IPAS System, item "other conclusion").

27.1.3 Communication about the intention to grant a patent

If the subject matter/subject matters of the Application fulfill the protection conditions, the examiner must send to the applicant a communication informing the intention to grant a patent (communication form 251 in the IPAS System).

If the applicant amended the Application (according to the stipulations prescribed in Article 26 of this Regulation) so that the subject matter/subject matters become to fulfill the protection conditions or corrected the errors as required or submitted the well-grounded explanation in the time limit prescribed (2 months) counted from the signing date of the communication mentioned in points 27.1.1 and 27.1.2 above, the examiner must send to the applicant a communication about intended grant a patent (communication form 252 in the IPAS system).

27.1.4 Communication about refusal to grant a patent]

If at the end of the 2-month time limit prescribed counted from the signing date of the communication (communication form 243) in the cases mentioned in the points 27.1.1 and 27.1.2 above the applicant failed to respond, the examiner must send to the applicant a communication about the refusal to grant a patent (communication form 256 in the IPAS system).

If in the 2-month time limit counted from the signing date of the communication (communication form 243) mentioned in Article 27.1.1

and 27.1.2 above, the applicant has amended or corrected the errors but the subject matter/subject matters of the Application still do not fulfill the conditions or the errors have not been corrected as required, the examiner must send to the applicant a communication about the refusal to grant a patent (communication form 258 in the IPAS system).

27.2 For the case the request for substantive examination filed by the third party

27.2.1 In the case the substantive examination carried out by the request filed by the third party, at the end of the time limit of substantive examination prescribed in Point 15.8 of the Circular, at the latest the examiner must send to the third party only a communication informing about whether the Application interested by him fulfill the protection conditions prescribed in Article 58 of the Intellectual Property Law. In the case subject matter(s) do not fulfill the protection conditions, the reason for that shall be indicated.

27.2.2 In the case the Application has defects or lacks information or the information is not clear so that the examiner cannot carry out the substantive examination, the examiner must send to the third party a communication informing him/her about that National Office of Intellectual Property could not carry out the substantive examination of the Application interested by him for the above mentioned reason. If later on the applicant files the request for substantive examination and makes amendment of the Application, overcomes the defects, clarifies the necessary information, etc. and the examination thereof is carried out in the routine procedure the conclusion on whether the protection conditions is fulfilled shall be sent to the third party.

27.2.3 Communication sent to the third party is made outside the IPAS system.

Article 28. Termination of substantive examination before the time limit

According to the stipulation prescribed in Point 15.4 of the Circular, the substantive examination is terminated before the time limit in the following cases:

(1) The Application does not clearly disclose the essence of the

claimed invention (Point 15.4.a (i) of the Circular) when the information of the claimed subject matter (the purpose of the solution, the features constituting the subject matter) are not sufficient, clear, too brief, too general to the extent that it is not possible to determine the claimed subject matter, not sufficient to achieve the purpose and distinguish the claimed subject matter from the prior art. For example, the claimed subject matter is formed by association with the equipment, device that does not exist in reality; the claimed subject matter is a finished product but it is described with its components are separately without their connections; there are more than one subject matter in one claim.

(2) The claimed subject matter is not conforming with the protection title or the claimed subject matter belongs to the objects which are not protected according to the stipulations prescribed in Articles 8.1 and 59 of the Intellectual Property Law (Point 15.4.a (ii) of the Circular) (see Articles 5.8.1. and 5.8.2 of this Regulation for more details).

(3) The claimed subject matter does not fulfill at least one protection condition (lack of novelty, not susceptible to industrial Application, trivial knowledge only, for example: the claimed subject matter is a process for protecting the steel structure by coating an anticorrosive paint on the surface thereof) (Point 15.4.a (iii) of the Circular). In the communication sent to the applicant, it is enough for the examiner to indicate only one protection condition which is not fulfilled (e.g. susceptible to industrial Application) without any further examination of other protection conditions such as novelty and inventive step.

(4) The applicant does not respond to the communication about the correction of errors, explanation of the content of the Application or does not submit the necessary information as required by the National Office of Intellectual Property or the response of the applicant does not fulfill the requirements (see Article 25 of this Regulation, Point 15.4.a (iv) of the Circular).

(5) The applicant has requested the termination of the substantive examination of the application or declared withdrawing or renouncing the application (Point 15.4.a (v) Circular).

In the cases mentioned in (1) to (4) above, the examiner sends to

the applicant a communication about termination of substantive examination before the time limit according to the stipulations prescribed in Point 15.4.b of the Circular (communication form 267 in the IPAS system). For the case mentioned in (5), the examiner closes out the file with the form 282 in the IPAS system (communication about withdrawal of the Application).

The further processing of the Application for which there has been a communication about termination of substantive examination is stipulated in Point 15.5 of the Circular.

Article 29. Examination of the third parties' opinions

First, according to the stipulation prescribed in Point 6 of the Circular, the examiner must examine the third parties' opinion under following conditions:

- Whether the opinion submitted in the time period from the publication date of the Application published in the industrial property official Gazette until prior to the date of decision on the grant of a patent;
- Whether the opinion submitted during the substantive examination time in respect of the Application;
- Whether the opinion is an opinion in relation to the grant of a patent in respect of the Application such as the right to file patent Application, the right to the priority, the protection conditions (novelty, inventive step, susceptibility to industrial Application) and other related issues (the suitability of the object to be protected with the State's policy on intellectual property, including civil disputes relating to the applicant); and
- Whether the opinion is given in written form and accompanied by material or the cited source of information used for proving.

If the third parties' opinion does not fulfill the above mentioned conditions at the same time the examiner shall send to the third party a communication about that his/her opinion is not able to be dealt with or does not belong to the type to be dealt with or not yet the time to process, with the reason indicated.

If the opinion of the third person satisfies the above conditions at the same time, the examiner should send a notice to the applicant according to the provisions of Point 6.2 of the Circular.

If the third party's opinion fulfill the protection conditions at the time but there is a reason to immediately affirm that the third party's opinion is unfounded (for example: the third party's opinion is that the claimed subject matter lacks novelty, but the

information source for proving was disclosed later than the priority date of the Application), the examiner does not need to send a communication to the applicant but must send to the third party a communication about the refusal to examine his/her opinion, with the reason indicated as required by the stipulation prescribed in Point 6.3 of the Circular.

In the case the third party's opinion relates to the right to file patent Application and fulfill the above protection conditions at the same time, if the examiner cannot determine whether the third party's opinion is grounded the examiner sends to the third party a communication in order he/she initiates a lawsuit as prescribed in Point 6.4 of the Circular.

In the case the third party's opinion relates to the protection conditions (novelty, inventive step, susceptibility to industrial Application), the examiner uses the opinion as an information source for the substantive examination of this Application and may communicate with him/her about his/her opinion, if necessary. If a patent is granted to the subject matter of this Application, the examiner shall send a communication to the third party informing about this and instructs the opposing procedure so that the third party may oppose the granting of a patent.

Whether or not the third party's opinion is used as a ground for refusing to grant a patent to the relevant Application after refusal determination, the examiner has to send to the third party a communication in written form about this.

Article 30. Processing of the Application after termination of substantive examination before the time limit

After the examiner sent to the applicant a communication about the termination of substantive examination before time limit

(communication form 267 in the IPAS system) according to the stipulations prescribed in Point 15.4.b of the Circular, if:

- The applicant has no response in written form over 2-month time limit as prescribed in Point 15.4.b of the Circular the Application is refused to grant a patent (communication form 256 in the IPAS system);
- Within 2-month time limit above mentioned, if the applicant sent a response in written form, the examiner shall examine the response according to the stipulations prescribed in Point 15.5 of the Circular (see Article 31 relating to the resumption of substantive examination below).

Article 31. Resumption of substantive examination

According to the stipulations prescribed in Point 15.5 of the Circular, the resumption of substantive examination is carried out based on the applicant's opinion when, within the 2-month time limit, the applicant submitted a document of opposition against the communication about the termination of the substantive examination before the time limit according to Article 28 above.

If the applicant's opinion is well-grounded, the substantive examination of the Application shall be carried out in the routine procedure.

If the applicant's opinion is not well grounded, the Application shall be refused to grant a patent (communication form 256 in the IPAS system).

Article 32. Re-examination of the Application

32.1 Re-examination of the Application due to the opposition in written form of the applicant or of the third party submitted to the National Office of Intellectual Property within the time period from the date of the communication about intended grant/refusal to grant a patent to prior the date of decision to grant/refuse to grant a patent is carried out according to the stipulation prescribed in Point 16.1 of the Circular.

32.2 After receiving the applicant's opposition opinion in written form, the examiner must examine whether the applicant's opinion is well-grounded.

32.2.1 If it is clear that the applicant's opinion is not well grounded, the examiner must make a decision to refuse to grant a patent (communication form 258 in the IPAS system) as prescribed in Article 27.1.4 of this Regulation.

32.2.2 If the applicant's opinion is well-grounded, within 8 months counted from the date of receiving the opposition opinion, the examiner re-examines the Application according to the stipulations prescribed in Chapter III (Articles 14 -16) of this Regulation.

32.2.3 If simultaneously with the opposition opinion the applicant requested to amend the Application, the examiner must examine the amendment according to Article 33 of this Regulation and if the

amendment is accepted, the examiner must re-examine the Application according to the stipulations proscribed in Chapter III (Articles 14 -16) of this Regulation.

32.3 After receiving the third party's opposition opinion in written form, the examiner must process the opinion according to the stipulations prescribed in Article 29 of this Regulation, if the opinion is well-grounded, within 8 month time counted from the date of receiving the opposition opinion, the examiner must re-examine the Application according to the stipulation prescribed in Chapter III (Articles 14 - 16) of this Regulation.

Article 33. Examination of request for amendment

33.1 Examination of the request for amendment includes the following contents:

(1) Examination of the amendment, supplemented documents according to Article 25 of this Regulation;

(2) Examination of the contents of the request for amendment according to the stipulations prescribed in Point 17.1.c of the Circular, according to which the amendments or supplements shall not expand and must not go beyond the scope of the subject matter disclosed in the Application and must not change the substance of the subject matter claimed for registration in the Application. For example, the subject matter claimed of the original Application is "a driving chain system for a motorbike" with the content disclosed in the specification as a driving system having a driving chain and the essence of the subject matter disclosed in the Application is the use of a chain for driving. If the amendment or supplement of the Application makes that in addition to the subject matter claimed above mentioned, the Application has an additional subject matter claiming "a driving gear system for a motorbike" then the amendment or supplement expanded the scope of the subject matter disclosed in the original Application (which did not mention to a driving gear) and changed (altered) the essence (driving essence) of the subject matter disclosed in the Application.

If the amendment expanded the protection scope of the subject matter in the specification or change the essence of the subject matter disclosed in the Application the examiner sends to the applicant a communication according to the following cases:

- A communication regarding refusal of the request for amendment

(form is not available), with the reason indicated and guiding the applicant to file a new Application for the new subject matter if the applicant, on his own initiative, made an amendment without combination with the response to any communication of National Office of Intellectual Property;

- A communication regarding termination of substantive examination before the time limit (communication form 267 in the IPAS system), with the reason indicated and guiding the applicant to file a new Application for the new subject matter if the amendment made based on the request of National Office of Intellectual Property according to the stipulation prescribed in Point 15.3 of the Circular;

- A communication regarding refusal to grant a patent (communication form 256 in the IPAS system), with the reason indicated and guiding the applicant to file a new Application for the new subject matter if the amendment made in combination with the opinion in written form in reply to the communication of National Office of Intellectual Property according to the stipulations prescribed in Points 15.4.a (i), (ii), (iii), 15.7.a (i) and 15.7.a (ii) of the Circular.

33.2 Amendment of claim(s)

The amendment of the claim(s) mainly relates to the changes in the protection scope of the independent claim(s) made via the supplement or the alternation of the technical features of the independent claim(s) or the alternation of the subject matter or the name of the subject matter of the independent claim(s) and its corresponding technical features; the supplement or deletion of one or more claims; the amendment of the independent claim in order to limit it in comparison with the closest reference prior art; the amendment of the reference part of the dependent claim in order to readjust the reference relationship or the amendment of the charactering part of the dependent claim in order to the define the protection scope. For the above-mentioned amendments, if the subject matter of the amended claims has disclosed clearly in the specification as originally filed and does not change the essence of the subject matter disclosed in the Application then they are admitted.

Admissible claim amendments include:

(1) The supplement of one or more technical features to the independent claim in order to more clearly define the claim to overcome the defects of the original claim such as lack of novelty or of inventive step, lack of the necessary technical features is

necessary to define the subject matter, to achieve the purpose and to distinguish that subject matter with the closest reference prior art. It is admissible if the subject matter mentioned in the independent claim has these additional technical features which have been already disclosed in the original specification.

(2) Change one or more technical features of the independent claim in order to overcome the defects of the original claim such as unclear disclosure of the protection scope, lack of novelty or of inventive step. If the changed feature(s) in the amended claim are those which have been already disclosed in the original specification and the introduction of the changed feature(s) does not change the other technical feature(s) composing the claimed subject matter, such the amendment is admitted.

For the amendment of the number range of the claim containing a technical feature defined by the number range, it is admissible if the amendment relates to the two end value of the amended claim have been disclosed in the original specification and/or the original claim and the amended number range does not change the other technical feature(s) composing the claimed subject matter, such the amendment is admitted. For example, the temperature in the original claim ranging from 20 to 90°C. If the specific temperature of 40°C, 60°C and 80°C between 20 to 90°C have been disclosed in the original specification and/or claim then the amendment of the above mentioned number range into the temperature ranging from 60 to 80°C or ranging from 60 to 90°C in the amended claims is admitted.

(3) Addition of the independent claim where the technical solution defined has been disclosed in the original specification of the Application.

(4) Deletion of one or more claims in order to overcome the defects such as lack of consistency of invention between the first original claim and other independent claims, lack of shortness of the claims due to repetition of the same thing in the claims or the claims are not fully supported by the description.

(5) Limiting the independent claim due to the closest reference prior art.

(6) Amendment of the reference portion of the dependent claim in

order to overcome the defect of reference so that the initially disclosed embodiment becomes more accurate.

(7) Amendment of the characterizing portion of the dependent claim in order to clearly define the scope of the protection of the dependent claim so that the particular or the initially disclosed embodiment becomes more accurate. It is acceptable if the amendment does not extend the scope of the content disclosed in the specification and does not change the essence of the subject matter disclosed in the initial Application.

(8) Deletion of the non-technical features (such as the advertising, commercial information) from the claim.

The above-mentioned cases are the acceptable cases. However, the examiner, after such amendments have been made, shall continue to examine whether amended claims meet the other conditions or requirements of the Intellectual Property Law and the Circular. For the amendments made in response to the communication relating to the intended refuse to grant a patent, the examiner must examine whether the amended claim overcomes the defects mentioned in the communication, whether the amendment adds the other defects. For the amendment made by the applicant on his/her own initiative, the examiner shall examine whether there is any defect which does not meet the conditions or requirement on Intellectual Property Law and Circular.

33.3 Amendment of specification and abstract

There are two types of amendment relating to the specification: amendment of the defects of the specification itself due to not meeting the conditions or requirements of the Intellectual Property Law and the Circular, and the amendment made in compliance with the amended claim.

The acceptable amendments of specification and abstract include:

(1) Amendment of title of the invention made in order to name the claimed subject matter briefly and correctly. If the subject matter of the independent claim is product, process and device, they must be presented in the title of the invention.

(2) Amendment of the technical field to which the invention relates. The technical field to which the invention relates mentioned in "background art" is mentioned according to the field indicated in

the International Patent Classification (IPC). In order to help the public and the examiner clearly understand the invention and the related arts, the applicant is allowed to amend the technical field of the invention in compliance with the related corresponding field according to the most detailed index of IPC.

(3) Partial amendment of the background art in compliance with the claimed subject matter. If the claim is two portions according to Point 23.6 of the Circular, the content relating to the prior art mentioned in the limiting portion must be presented in "background art" of the specification and the documents presenting the prior art must be cited. If via the search, the examiner found any reference document having the technical essence closer than cited one by the applicant in the initial specification, then the applicant is allowed to amend the specification by adding the information relating to and to cite the document(s). At the same time, the contents described not relating to the prior art must be removed. It shall be noted that indeed, the amendment introduced into the specification the content not mentioned in the initial claim and specification. However, the amendments only relate to the prior art not to the invention itself and the added contents are the technical solution(s) known by the public before the filing date, therefore they are accepted.

(4) Amendment of the content relating to the benefit (effect) of the invention in the specification. This amendment is accepted only when the initial specification clearly described the technical features but did not clearly mention to their benefit (effect) and it may be directly and readily determined by the skilled person of the art from the initial specification of the Application.

(5) Addition of the subject matter mentioned only in the initial claim (including the "process" and "device") to the initial specification (including only "device") is not considered as expanding the scope of the protection.

(6) Amendment of "brief description of drawings". If in the specification there are drawings, but it lacks "brief description of drawings" then the amendment made by adding description of this is accepted. If the "brief description of drawings" is not clear then the amendment of this according to the content of the Application

may be accepted.

(7) Amendment of one or more drawings. This amendment relates to the removal of the unnecessary words, terms and notes in the drawings which later on may be introduced to the specification; amendment of the reference signs in the drawings in compliance with the reference signs in the specification; for the purpose of providing the clear enough structure of some parts of the drawings, the amendment of the enlarged drawing to these parts is accepted if the brief description of drawings is clear; the amendment made so that the drawings are numbered in Arabic numerals. It is acceptable if the addition of the drawings of the prior art, or the replacement of the drawings of the prior art already existed in the initial drawings by another one of the solutions having the closest technical essence.

(8) Amendment of the abstract. The amendment relates to the amendment of the abstract for indicating the title of the invention and the technical field to which the invention pertains; showing clearly the technical problems to be solved, the gist of the solution of that problem through the invention and the principle uses; removing the commercial advertising information; replacing the selected drawing for publication together with the abstract in order to best characterize the invention by the technical features of the invention.

(9) Correction of the obvious errors which the skilled person of the art may appreciate such as grammar, words, or spelling mistakes.

33.4 Non-acceptable amendments, additions

In principle, the amendment, the addition of the documents of the Application is considered not compliant with the stipulations prescribed in Article 17.1.c in the following cases:

- The claimed subject matter of the amended Application is not contained in the initial Application;
- The claimed subject matter of the amended Application contains the technical feature(s) which were not fully supported by the initial Application;
- The essence of the subject matter mentioned in the amended Application is different from the one of the subject matters mentioned in the initial Application;
- The information which the skilled person of the art found in the

amended Application is different from the one contained in the initial Application and this information cannot be readily and directly determined from the information in the initial Application.

33.4.1 Non-acceptable additions

The following additions are not acceptable:

(1) Introduction into the claims and/or specification of the technical features which cannot be directly and readily determined from the initial specification (including the drawings) and/or the initial claims.

(2) Addition of the information which cannot be directly and readily determined from the initial specification (including the drawings) and/or the initial claim in order to clearly disclose the invention or fully disclose the claims.

(3) The added content is the technical features relating to the size parameters obtained by using the size parameter shown in the drawings.

(4) The added parts/components which are not mentioned in the initial documents of the Application result in the special effects which are not contained in the initial Application.

(5) Addition of the effects (benefits) which the skilled person in the corresponding art cannot determine from the initial Application.

33.4.2 Non-acceptable modifications

The following modifications are not accepted:

(1) Modification of the technical feature of the claim which was not disclosed or cannot be directly and readily determined from the initial Application.

Example 1:

The subject matter of the initial claim was a brake for bicycle and the applicant modified the claim into a brake for vehicle. If the technical solution determined by the modified claim cannot be directly determined from the initial specification then this modification is not accepted.

Example 2:

Replacement of the name of the component or of the part having specific characteristic by the name "means + functional terms" that

cannot be directly determined from the initial specification of the Application. This modification is not accepted.

(2) Introduction of the new content (matter) by modifying the undeterminable contents into the determinable and specific contents. For example, the Application relates to the synthesis of a macromolecule compound. The initial specification only mentioned about the polymerization reaction carried out at "high temperature". If the applicant recognized that, in the reference document provided by the examiner, the similar reaction was carried out at temperature of 40°C and the applicant modified "high temperature" into "temperature higher than 40°C".

Although "temperature higher than 40°C" belongs to the range "high temperature", but the skilled person in the corresponding art cannot conclude that "high temperature" means "the temperature higher than 40°C" from the initial specification of the Application. Therefore, this modification is the introduction of new matter into the Application.

(3) Combination of the separate features of the initial Application into the new feature while the relation between them was not disclosed in the initial Application.

(4) Modification of some feature in the specification to make the technical features different from the technical feature mentioned in the initial specification.

Example 1:

The invention relates to a laminate and the specification of the Application relates to the different embodiments of the laminated structure. The laminate according to one of the embodiments has an outer layer made from polyethylene. If the applicant altered or modified the outer layer into the layer made from polypropylene, then this alteration is not accepted because after alteration this laminate is totally different from the laminate described in the initial specification.

Example 2:

The temperature determined in the initial specification was 10°C or 300°C, later on it was modified into the range of 10°C - 300°C. If this range cannot be readily and directly determined from the contents described in the initial specification of the Application, then this alteration is not accepted.

Example 3:

In the initial specification, the specific component of the composition was indicated as 5% or in the range 45 - 60%, later on it was altered into the range of 5 - 60%. If the range of this component cannot be readily and directly determined from what described in the initial specification of the Application, then this alteration is not accepted.

33.4.3 Non-acceptable removals

The removal of one technical feature from the claim in which this feature is necessary for the claimed subject matter to achieve the proposed purpose and/or the removal of this feature altering other feature(s).

33.5 Division of Application

Divided Application shall be filed in the time limit and according to the stipulation prescribed in Article 115 of the Intellectual Property Law and in Point 17.2 of the Circular.

Divided Application must meet the following requirements:

(1) Divided Application must be filed with the request indicating the number of the initial Application; the request; the specification; the abstract; the receipt of fees and the power of attorneys (if the Application is filed through a representative).

(2) The claimed subject matter in the divided Application must be contained in the initial Application.

(3) The claimed subject matter in the divided Application must be different from the claimed subject matter in the initial Application after division.

(4) The divided Application must not expand the scope of protection beyond the content disclosed in the specification and must not change the essence of the subject matter mentioned in the initial Application.

33.5.1 Publication of divided Application

Divided Application shall be published according to the stipulation prescribed in Point 17.2 of the Circular.

33.5.2 Examination of the divided Application

(1) The time limit for formal examination of a divided Application is 01 month counted from the date the National Office of Intellectual Property receives the divided Application indicated in the seal of application receipt affixed on the request.

(2) The time limit for substantive examination of divided Application is determined as the time limit for substantive examination of the ordinary Application.

(3) The divided Application may have (but not limited to) the following defects which must be communicated to the applicant:

(i) The technical solution of the divided Application was not contained in the initial Application;

(ii) The divided Application still lacks information to such an extent that the claimed subject matter mentioned in the divided Application cannot be determined whether it was contained in the initial Application or the technical solution divided from the initial Application cannot be determined which one among the technical solutions mentioned in the initial Application;

(iii) The divided Application expands the scope of protection beyond the content disclosed in the specification and altered the essence of the subject matter mentioned in the initial Application;

(iv) The applicant of the divided Application does not have the right to division of initial Application.

(4) If the applicant filed the divided Application but the claimed subject matter of the divided Application was not contained in the claim of the initial Application, and there was no amendment, supplement for the initial Application, the divided Application shall be accompanied with a description of the claimed subject matter and the altered content of the divided in comparison with the filed initial Application in order to show that the claimed subject matter in the divided was contained in the initial Application and the divided Application does not extend the scope of protection beyond the content disclosed in the specification and does not alter the essence of the subject matter mentioned in the initial Application.

(5) For the divided Application and/or the initial Application, the specification (including drawings) of the Application may be modified in accordance with the subject matter mentioned in the

claim of the Application by removing the content irrelevant to the subject matter(s) mentioned in the claim of the Application.

33.6 Conversion of Application

A converted Application is filed in the time limit and according to the stipulation prescribed in Article 115 of the Intellectual Property Law and Point 17.3 of the Circular.

In order to convert the Application, in any case, the applicant must file the converted Application which contains the document requesting conversion of the Application which indicating the number of the initial Application, the request, the specification, the abstract, the receipt of fees (if necessary) and the power of attorney (if the Application is filed through a representative). The divided Application is numbered by a new number and with the filing date of the initial Application or with the priority date(s) of that of the initial Application (if any).

The initial Application (after conversion) is considered as being withdrawn at the time of filing of the request for conversion.

If the request for conversion is filed at the time when initial Application has been accepted as being valid but has not been published, the converted shall be published instead of the initial Application.

In the case the Application with request for an invention patent does not meet the inventive step requirement and with request for conversion into an invention patent for utility solution patent, in order to be granted a patent for utility solution, the solution mentioned in the converted Application must meet the criteria other than common knowledge as stipulated in Article 58 of the Intellectual Property Law and mentioned in Article 28 of this Regulation.

In order to covert one or some claimed subject matters contained in the initial Application, firstly the initial Application must be divided into divided Application(s) then the initial Application (after division) or divided Application(s) (having the claimed subject matter to be converted) are converted.

CHAPTER IV Processing of International Application

Article 34. Processing of international Application with the designation or the election of Vietnam entered to the National phase

34.1 Processing

Processing of international Application with the designation or the election of Vietnam entered to the National phase is carried out according to the stipulations prescribed in Points 27.4, 27.5, 27.6, 27.7, 27.8, 13.4.b and 14.2.a (ii) of the Circular (it is noted that the time limit for election of Vietnam as mentioned in Point 27.5.a of the Circular has been amended by the Treaty is 22 months instead of 19 months) and the other stipulations prescribed for an ordinary national Application.

34.2 Kinds of Protection

The international Application entered to the national phase may be protected as a patent for invention or a patent for utility solution depending on the request of the applicant.

34.3 Examination of validity of the international Application entered to the national phase

34.3.1 If the international Application entered to the national phase without designation of Vietnam or the applicant was not designated for Vietnam the Application is invalid in Vietnam.

34.3.2 If during the international phase there was a notification of withdrawal of the international Application, a notification of the international Application be treated as being withdrawn, a notification of withdrawal of designation of Vietnam the Application is invalid in Vietnam.

34.3.3 If the international Application is not valid or invalid in Vietnam, the examiner must issue a communication of intended formal invalidity (communication form of intended formal invalidity no 225 in the IPAS system) with the reason indicated.

34.4 Examination of identity of the information in the request of the international Application entered to the national phase with the information in the other documents of the Application
The examiner must examine the name, the address of the applicant and

of the inventors, IPC index, the information relating to priority in the request with the information of the international Application, if the identity does not exist without notification of the recorded amendment in the international phase or without assignment of the right, inheritance certification or request for amendment of the applicant the examiner must issue a communication of intended formal invalidity (communication form of intended formal invalidity no 225 in the IPAS system) with the reason indicated so that the applicant has opinion or amends.

34.5 Examination of translation

The examiner must examine whether there are enough numbers of translations of the international publication of the international Application, the amended version, the explanatory document for the amendment according to Article 19 and/or Article 34(2) (b) of the Treaty, the annexes of the international preliminary examination report (if the international Application with election of Vietnam and with the demand for international preliminary examination) and must examine the identity of the Vietnamese translations of them. If the defects exist, the examiner must issue a communication of intended formal invalidity (communication form of intended formal invalidity in the IPAS system) with the reason indicated so that the applicant has opinion or amends.

34.6 Specification and abstract for substantive examination

34.6.1 If the international Application entered the national phase without amendment of the specification, the abstract in the international phase and the national phase, the Vietnamese specification and abstract of the international Application shall be used for the specification and abstract for substantive examination.

34.6.2 If the international Application entered into the national phase has one or some times of amendment of the specification, the abstract in the international phase but there is not any amendment of the specification, the abstract in the national phase, the Vietnamese translation of international publication in combination with the last corresponding parts amended shall be used for the specification and the abstract for substantive examination if the applicant otherwise stated.

34.6.3 If the international Application entered into the national phase has one or sometimes of amendment of the specification, the abstract in the national phase, the specification and the abstract for substantive examination is the last amended specification and abstract.

34.7 Early processing

In the case the international Application has a request for early entering into the national phase on the demand of the applicant while the Application has not been internationally published the applicant must file the copied request and the copied specification, the original abstract initially filed of the international Application with the certification of the receiving office with the National Office of Intellectual Property. The examiner must examine the identity of the information in the request with the information of the international Application and examine the identity of the Vietnamese translation of the original specification, the abstract initially filed.

34.8 The time limit for processing

34.8.1 The time limit of formal examination for the international Application entered into the national phase with the power of attorney and/or the assignment of the right in the international phase (if any) filed within 31 months counted from the priority date is 01 month counted from the first day of the 32nd month counted from the priority date.

34.8.2 The time limit of formal examination of the internal Application entered into the national phase with the power of attorney and/or the assignment of the right in the international phase (if any) filed after 31 months and within 34 months counted from the priority date is 01 month counted from the filing date of that document.

34.8.3 The time limit of formal examination of the internal Application entered into the national phase without the power of attorney and/or the assignment of the right in the international phase (if any) filed within 34 months counted from the priority date is 01 month counted from the first day of the 35th month counted from the priority date.

34.8.4 The time limit of substantive examination for the international Application entered into the national phase is the same as for the ordinary national Application.

CHAPTER V ADMINISTRATIVE REGULATIONS

Article 35. Delivery, receipt and management of records and documents

35.1 When receiving files from the Registration Department, clerical staffs shall check all the types of document included in an Application according to the listing on the Application form. When any documents are missing, clerical staffs shall report to the responsible staffs from the Registration Department. When the documents included with an Application are affixed with the Application number, this number shall match the Applications number on the file cover. When documents received from the Registration Department are part of an existing Application file, then these documents must have receipt stamps with specific Application number.

35.2 When delivering Applications files and documents to examiners from the Patent Department or to the staffs from the Registration Department, clerical staffs shall require the receiving person to sign their receipt.

35.3 Cleric staffs are responsible for handling files, documents in accordance with the regulations of the National Office of Intellectual Property from receiving from the professional departments to handing to the relevant individuals in the unit and vice versa.

Article 36. Duties and responsibilities of examiners

36.1 Perform all tasks and take responsibility for the results related to formal examination, patent classification (when applicable), search and substantive examination of an assigned Application in accordance with the contents of this Regulation. When necessary, the examiner may request the Information Center of the National Office of Intellectual Property to conduct searches and acquire foreign information related to a pending Application, and in this case the examiner may base entirely on the information to proceed with the examination of the Application.

36.2 Draft notifications relating to the results of examination of an Application.

36.3 Communicate directly with an applicant during the examination

process.

36.4 Review and process opinions from a third party relating to a pending Application in accordance with Article 29 of this Regulation.

36.5 Examine an Application in accordance with the provisions of processing Applications after the issuance of a notification about termination of the substantive examination before the time limit (Article 30), resumption of substantive examination (Article 31) and re-examination of the Application (Article 32).

36.6 Handle the complaints of an applicant relating to a pending Application and examine the legality status thereof (if necessary).

36.7 Take responsibility before the Head of the Department (or any authorized personnel) for the results of the assigned task.

36.8 Take responsibility to complete files for publication, acceptance or refusal of registration in accordance with the regulations of the National Office of Intellectual Property and of the relevant Department.

36.9 Manage assigned files in accordance with the regulations of the National Office of Intellectual Property. Keep all information relating to an Application confidential in accordance with Article 111 of the Intellectual Property Law and the guidelines of the Director of the National Office of Intellectual Property number 2095/SHTT-TCCB dated October 23, 2008.

Article 37. Duties and responsibilities of leaders

37.1 Check the examination results (including patent classification and search results), complaint handling result, examination result of legality status, communicating notifications, ... before submitting to the Head of the Department for approval.

37.2 Take responsibility to keep all information relating to an Application confidential until this information is approved for publication.

37.3 Monitor and ensure that the tasks being performed by examiners

in the group are met in a timely manner.

37.4 Take responsibility before the Head of the Department for the task results of the examiners in the group.

Article 38. Duties and responsibilities of Head of the Department (or authorized person)

38.1 Assign Applications to examiners, sign approval on communication documents with applicants or relevant third parties on behalf of Director of the Office.

38.2 Take responsibility to control, remind, and possibly to take administrative measures when necessary to ensure the quality and progress of the Application process. Applications may be transferred from one examiner to another when necessary.

38.3 Take responsibility to keep all information relating to an Application confidential until this information is approved for publication.

38.4 Take responsibility before the Director of the Office (or any authorized personnel) for the finalized results of the tasks from the Department to the examination of an Application as well as to the appeal of an Application.

Article 39. Responsibilities to coordinate between units of the National Office of Intellectual Property

39.1 Every individual and unit of the National Office of Intellectual Property shall take responsibility to coordinate the works, perform the assigned tasks, comply with the regulations on time limit, ensure the quality of the works, ensure the necessary equipment and technical infrastructure to provide the best possible working condition.

39.2 Mobilization and coordination of the works between the units of the National Office of Intellectual Property shall comply with the rules of the Work Regulations of the National Office of Intellectual Property, issued in compliance with Decision no. 1758/QĐ-SHTT dated October 27, 2008 of the Director of the National Office of Intellectual Property.

CHAPTER VI TERMS OF ENFORCEMENT

Article 40 Enforcement effect

40.1 This Regulation shall replace the interim Regulation on formal examination and publication of Application number 1111/PCQL dated December 16, 1998 of the Patent Department and the Regulation on examination of patent and utility solution number 380/XNSC data October 10, 1992 of the Office of Industrial Property.

40.2 This Regulation shall be in effect as of the signing date thereof. All pending Application shall be proceeded in accordance with this Regulation.