

OUTSTANDING POINTS OF DECREE 65/2023/ND-CP ON PROCEDURES FOR ESTABLISHMENT OF INDUSTRIAL PROPERTY RIGHTS

HAI LONG

On August 23, 2023, the Government promulgated Decree 65/2023/ND-CP providing details for several provisions and measures for implementation of the Law on Intellectual Property on industrial property, protection of industrial property rights, rights to plant varieties, and state management of intellectual property (**Decree 65**). This Decree replaces Decree 103/2006/ND-CP providing details and guidelines for implementation of a number of articles of the Law on Intellectual Property on industrial property and a part of Decree 105/2006/ND-CP providing details and guidelines for implementation of some articles of the Law on Intellectual Property on protection of intellectual property rights and state management of intellectual property (amended and supplemented). Decree 65 takes effect from the date of signing with the following highlights on procedures for the establishment of industrial property rights (**IPR**):

First, amending and supplementing regulations related to registration application forms. Accordingly, the registration application forms for trademarks, inventions, industrial designs, and layout designs have been changed under the provisions in Appendix I, II, and IV of this Decree. In particular, Decree 65 has added the forms of "Application for confirmation of delayed registration of initial marketing authorization for pharmaceutical products" and "Declaration for requesting compensation due to delay in granting initial marketing authorization for pharmaceutical products manufactured under exclusive patent" so that a patent owner could request the competent state agency to consider compensation for any delay in granting marketing authorization for pharmaceutical products as prescribed in the Law on Intellectual Property 2005, amended and supplemented in 2022. Simultaneously, the trademark registration application form also recognizes sound trademark, a type of



non-traditional trademark first protected as a trademark under the Law on Intellectual Property 2005, amended and supplemented in 2022. Furthermore, Part IV Appendix I of Decree 65 also inherits previous regulations of Circular 16/2016/TT-BKHCN on specific requirements for some other documents needed when registering trademarks, inventions, and industrial designs such as invention description; invention abstract; industrial design description; trademark sample; etc.

Second, amending and supplementing the registration application form for IPR establishment. Decree 65 facilitates applicants to amend and supplement their application before the state management agency in charge of IPR issues a decision to refuse the application, a decision to grant or refuse to grant a protection certificate, accordingly:

- (i) An applicant may modify and supplement documents in its application provided that the modification and supplement do not expand the scope (volume) of protection recorded in the description and must not change the nature of the subject stated in the application.
- (ii) An applicant may change its name, address, country code; name, nationality, address of the author of the patent, layout design, industrial design; and modify the intellectual property representative.

The modification and supplement to the registration application form for IPR establishment is implemented under the procedures detailed in Clause 2, Article 16 of this Decree.

Third, splitting applications for IPR establishment. Clause 1, Article 17 of Decree 65 establishes a process allowing applicants to split the IPR application. Accordingly, before the state management agency in charge of IPR issues a decision to refuse an application, a decision to grant or refuse to grant a protection certificate, the applicant can split one or several technical solutions

in the invention application, one or several industrial designs in the industrial design application, part of the list of goods and services in the trademark application to one or more new applications (referred to as split applications). For each split application, the applicant must pay the application fee and any other fees and charges for the procedures to be conducted independently from those for the original application (except the procedures that have been implemented in the original application that are no longer needed to be performed in the split application) but do not have to pay the appraisal fee for requesting priority rights (except for cases of splitting industrial design application due to lack of uniformity). It is noted that when carrying out the procedure for splitting an industrial property registration application, the applicant must submit an explanation of the subject requested for protection and the content of changes compared to the original application.

Fourth, detailing the conditions for restricting the transfer of trademark rights under Clause 4, Article 139, Law on Intellectual Property 2005, amended and supplemented in 2022. Specifically, the transfer of trademarks is not accepted if it confuses the characteristics and origin of goods or services bearing the trademark in the following cases:

- The transferred trademark is identical or confusingly similar to another trademark protected under the Trademark Registration Certificate or international trademark registration owned by the transferor.
- A part of the goods and services bearing the transferred trademark is similar to the remaining goods and services in the list of goods and services owned by the transferor and the use of the trademark along with the goods or services of the transferee may confuse the commercial origin of the goods or services (in cases where the scope of transfer is part of the list of goods and services).
- The transferred trademark contains elements being signals that causes consumers to confuse or misunderstand the origin, quality, value, etc. of the goods and services within the scope of the transfer.

COMMENTS AND RECOMMENDATIONS

Decree 65 has amended and supplemented several significant contents in establishing IPS, thereby ensuring consistent application and effective enforcement of intellectual property regulations. The amendments of Decree 65 are also judged as bringing more flexibility and convenience for individuals and organizations to carry out procedures related to IPR establishment. Therefore, IPR holders should pay attention to updating the provisions of this Decree, for example, using registration application forms or identifying cases where applications for IPR establishment can be amended, cases where the transfer of trademark rights is restricted, etc. to ensure their rights and interests as well as to comply with the law when establishing IPR.