

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Mr. Dinh Huu Phi
Director General
Intellectual Property Office of Viet Nam (IP Viet Nam)
386 Nguyen Trai St., Thanh Xuan Dist.,
Ha Noi, Viet Nam

Dear Mr. Phi,

Re: JIPA Comments on the amendment to Vietnam Intellectual Property Law

We, the Japan Intellectual Property Association "JIPA", are a private user organization with about 970 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property system of other countries and make recommendations for more effective implementation of the systems.

Having learned the amendment to Vietnam Intellectual Property Law on your website, we would like to offer our opinions as follows.

Your consideration on our opinions would be greatly appreciated.

Sincerely yours,

Hiroya OKUMURA
Vice President

Makoto FUKUOKA
Managing Director

Koji SAITO
Managing Director

Tatsuya MORI
Managing Director

Japan Intellectual Property Association

Opinion on Vietnam Intellectual Property Law Amendment (1)

1. Article 128 (drugs) and Article 128a (medicine and pesticides)

It can be read as the handling of data protection relating to regulatory approval rather than IP, but the difference between Article 128 (2) 5 years and Article 128a (2) 10 years is unclear. Is Article 128a subject to pharmaceuticals and pesticides, and Article 128 other than that? We would like to request clear guidance.

Also, does the use of confidential information specified in these two paragraphs correspond to so-called data protection in other countries? If the application is not made as confidential information and there is no patent protection, does it mean that the generic manufacturer can immediately apply for regulatory affairs without clinical trials? We hope that you will provide clear guidance and operate in global harmonization.

Further, these provisions should be retroactive, and a system should be established so that data can be protected even for drugs that have been approved and applied for approval.

2. Article 131a

We think it is a provision regarding the extension of patent protection in the event of a delay in regulatory examination, but this is stipulated within 12 months from the date when the drug was approved. When is the deadline for filing a patent if it is registered later than the drug approval? Also, are there any restrictions on the applicable patents, such as substance patents only or not? Please give clear guidance on this as well.

It is desirable to adopt Plan 2, and the patent term extension should be up to five years rather than up to two years.

3. Articles 145 and 146

The compulsory license should be operated under strict rules, and consideration should be given to avoid disadvantages to the patentee.

Opinion on Vietnam Intellectual Property Law Amendment (2)

1. Article 4 (13)

The amendment bill defines that a design is the appearance of a finished product or a "part" incorporated into a finished product.

This indication could be interpreted that only "spare parts and components" that can be completely separated from the finished product are protected by design law. We are afraid that there is a risk that the imitation of characteristic parts which cannot be completely separated from the finished product could be out of scope of the design protection.

Therefore, we would like to request that it should be clarified that the "part" should include both separable parts and inseparable parts from the finished product.

We welcome the inclusion of shapes, patterns, colors, or combinations thereof in the definition of the outer shape. There are many imitation products that are unique only in patterns and colors, and many users wanted to revise this clause to take measures against these imitation products.

The explanation of the appearance indicates that it should be "visually observed while the finished product is used"

However, there is the case that spare parts/ components which do not comply with the above situation can be traded independently. Therefore, we would like to request such spare parts/ components should be treated and protected in the same way as the finished product.

2. Article 103

We agree to option 1.

We would like to request that the indication of "the shape features of the design" in the specifications should be optional, as the other countries currently request to the applicants when needed.

If the submission of both "the shape features of the design" and "the scope of design protection" is mandatory, as it is suggested in option 2, we suppose that it would be the unique procedure, compared with that of other countries and this would add the further burden to applicants. From international harmonization point of view, we do not agree to option 2.

3. Article 110

Thank you very much for your suggestions for option 1.

We would highly appreciate if you could give the applicant a preparation period from the time of application to the time when the product is announced to the market.

Regarding the extension period, your country is one of the contracting parties of the Hague system, and please consider introducing a system similar to the extension period of the Hague system.

For reference, the deferment of publication for a period of up to 30 months has been stipulated, and standard publication period has been changed from 6 months to 12 months.

Also, please consider introducing an immediate publication after filing at the moment.

In major countries, design applications are open to the public after registration. We also hope that it will be released after registration in Vietnam.

Opinion on Vietnam Intellectual Property Law Amendment (3)

1. Article 96

Thank you very much for adding Article 96 a) as an item for invalidation.

However, we are concerned that the term “bad faith” in the Article 96 a) is unclear. So, we would like to specify the terms and conditions in Article 96 a) that the trademark shall be invalid if the trademark is identical with, or similar to, a trademark which is well known among consumers in Vietnam or other countries for the goods or services pertaining to a business of another person, if such trademark is registered for unfair purposes referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes.

2. Article 74(2)

We propose to add the following exception that 96 h) is not applied:

If the trademark was invalidated due to Article 96 a), a trademark filed by a fair owner or an authorized user shall be registered without any terms and conditions.

Opinion on Vietnam Intellectual Property Law Amendment (4)

1. Article 211

(1) 1st option

In this amendment, Article 211, Paragraph 1 (a) and Paragraph 3 will be deleted. This means that all IP rights infringements are not subject to administrative sanctions. This results in a flood of counterfeit products. Most counterfeit products are inferior and are very likely to jeopardize consumer safety. Therefore, from the viewpoint of protecting your people, we request that you maintain the current law without amending this clause.

(2) 2nd option

a) First option

In Article 211, Paragraph 1 (a) of this amendment, the design is not subject to administrative sanctions. However, there are many counterfeit products in Vietnam that infringe on design rights. Many counterfeit products that only infringe on design rights are defective and are very likely to jeopardize consumer safety. In Vietnam, VIPRI has established a system to judge the similarity of designs, and it is not so difficult to take administrative sanctions for infringement of design rights. Therefore, from the viewpoint of protecting your people, we request that you maintain the current law without amending this clause.

b) Second option

In Article 211, Paragraph 1 (a) of this amendment, not only designs but also trademarks are not subject to administrative sanctions. The most common counterfeit products are trademark infringing products. Excluding a trademark from administrative sanctions strongly encourages the flood of counterfeit goods. This is totally unacceptable from the point of view of consumer protection. Therefore, from the viewpoint of protecting your people, we request that you maintain the current law without amending this clause.

2. Article 216, Paragraph 1 (a)

(1) 1st option

In this amendment, only trademark infringement and forgery of geographical indications are subject to suspension of customs clearance procedures. However, many counterfeit products that infringe design rights already exist in Vietnam, threatening the safety of consumers. Therefore, from the viewpoint of protecting your people, we request that you maintain the current law without amending this clause.

(EOD)