



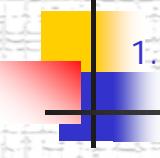
Strategies for Mobilizing Human and Financial Resources to Improve Patent Search and Examination Capability

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1 General introduction

□ **Brief history:**

- ✓ Vietnamese IP system Vietnam was established in 1981 by Decree No. 31/CP of the Government on Innovation, Technical Improvement, Manufacturing Rationalization and Invention dated January 23, 1981.
- ✓ This Decree also created the basis for the establishment of Patent Office, now is National Office of Intellectual Property of Vietnam (NOIP) July 29, 1982.
- ✓ At that time, inventions and utility solutions were protected in two forms including “Inventor Certificate” mainly for domestic inventors and “patent” for foreign entities.

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□ **IP administration Offices:**

- National Office of Intellectual Property - NOIP - (under the Ministry of Science and Technology): responsible for industrial property and for coordinating IP-related activities nationwide.
- Copyright Office of Vietnam (under the Ministry of Culture, Sports and Tourism): responsible for copyright and related rights.
- Plant Variety Office (under the Ministry of Agriculture and Rural Development): responsible for plant varieties.

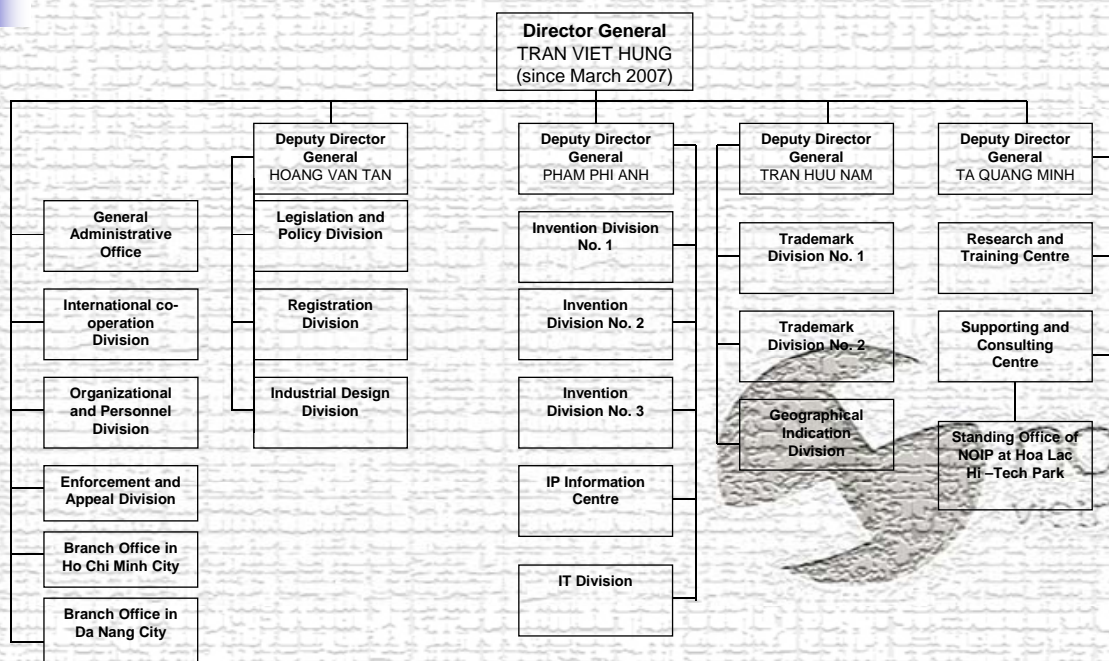
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□ National Office of Intellectual Property (NOIP):

- Main function: Establishment of IP rights to industrial property subject-matters (patents, utility solutions, industrial designs, trademarks, integrated circuits, geographical indication); participating in drafting IP law and implementing regulations; international co-operation and participating in trade negotiations in the field of IP.
- 285 staffs, 20 divisions, including two branch offices in Ho Chi Minh City and Da Nang City respectively, and a Standing Office in Hoa Lac High Tech Park.
- Financial Autonomy (since January, 2010).

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□ Organizational structure



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2. Brief review of the legislation relating to patent in Vietnam

- * IP Law 2005 (amended and supplemented in 2009): Art. 58-62: Patentability Criteria; Art. 86: Right to file a patent application; Art. 90: First-to-file principle; Art. 91: Priority; Art. 93: Patent term.
- * Decree No.103/2006/ND-CP (September 22, 2006) of the Government detailing and guiding the implementation of a number of articles of the IP Law regarding industrial property.
- * Decree No.105/2006/ND-CP dated September 22, 2006 of the Government detailing and guiding the implementation of a number of provisions of IP Law regarding IP rights protection and state management of IP.

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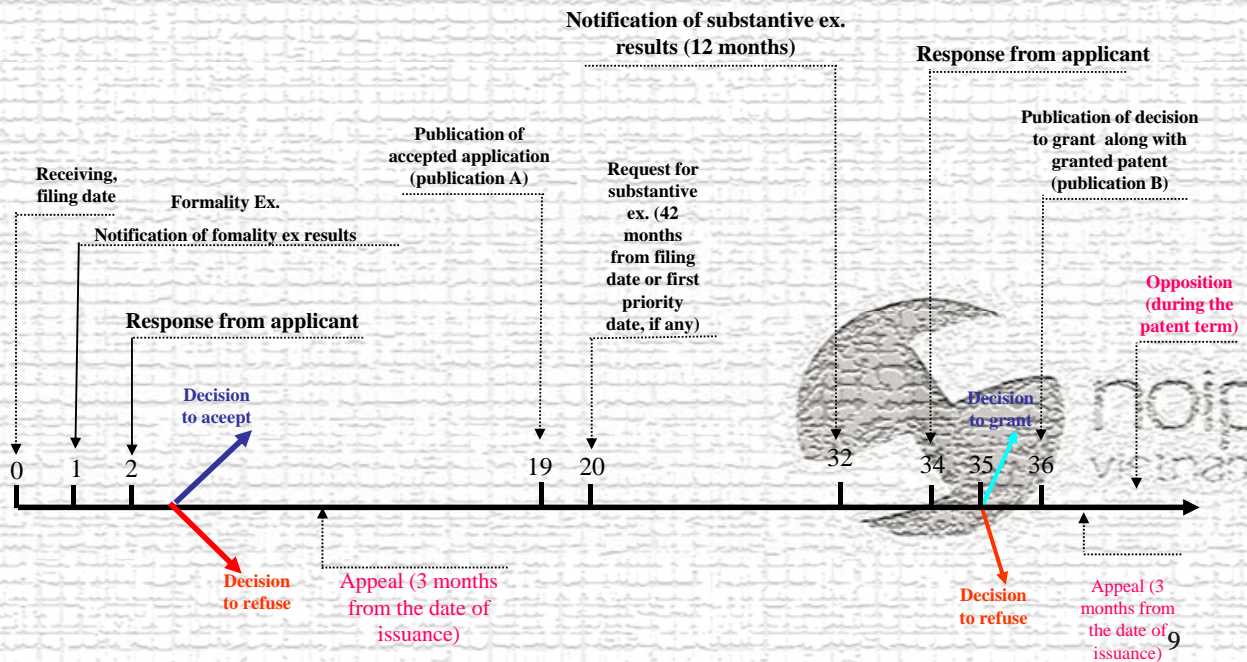
□ Brief review of the legislation relating to patent (cont.):

- * Circular No.01/2007/TT-BKHCN dated February 14, 2007 of the Minister of Science and Technology further details Decree No.103/ND-CP.
- * Joint Circular No. 01/2008/TTLT-TANDTC-VKSNDTC-BCA-BTP of 29 February 2008 of the Supreme People's Court, the Supreme People's Procuracy, Ministry of Public Security and Ministry of Justice providing guidance for penal liability for infringements of intellectual property rights.
- * Joint Circular No. 02/2008/TTLT-TANDTC-VKSNDTC-BVHTT&DL-BKH&CN-BTP of 03 April 2008 of the Supreme People's Court, the Supreme People's Procuracy, Ministry of Culture, Sport and Tourism, Ministry of Science and Technology, and Ministry of Justice providing guidance for application of some legal provisions in disputes settlement on intellectual property rights at courts.

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3. Patent search and examination activities in NOIP

Examination procedure



UNPATENTABLE SUBJECT-MATTERS

- Discoveries, scientific theories; mathematical methods.
- Schemes, plans, rules or methods for performing mental acts, training domestic animals, playing games, doing business; computer programs.
- Presentations of information.
- Solutions of aesthetic characteristics only.
- Plant varieties, animal varieties.
- Processes of essentially biological nature for the production of plants and animals other than microbiological processes.
- Method of prophylaxis, diagnosis and treatment for human being and/or animals.



□ PATENTABILITY CRITERIA

- Novelty (worldwide);
- Inventive step (not applied for utility solution);
- Industrial applicability.



□ OTHER REQUIREMENTS

- Unity of patent application;
- Sufficient disclosure (enablement requirement);
- Supportive requirement;
- Clarity.



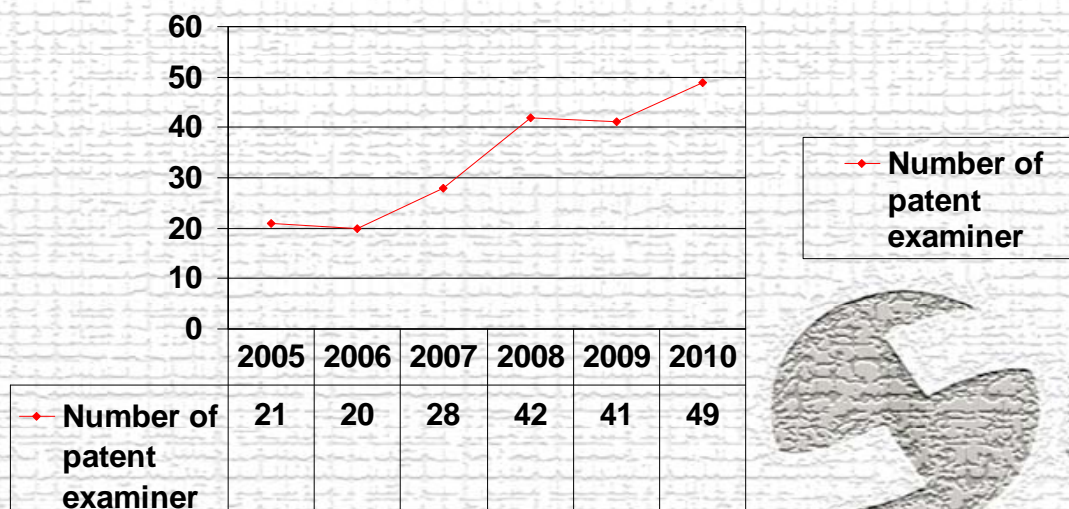
□ Human resource for examination

- Patent examiners: 49 in 3 patent examination divisions.
 - Invention Div. 1 (mechanic, physic and electronic): 22 patent examiners.
 - Invention Div. 2 (organic chemistry and pharmaceutical): 11 patent examiners.
 - Invention Div. 3: (biotech and chemical engineering): 16 patent examiners.
- Primary examiners: 36.
- Secondary examiners: 11.



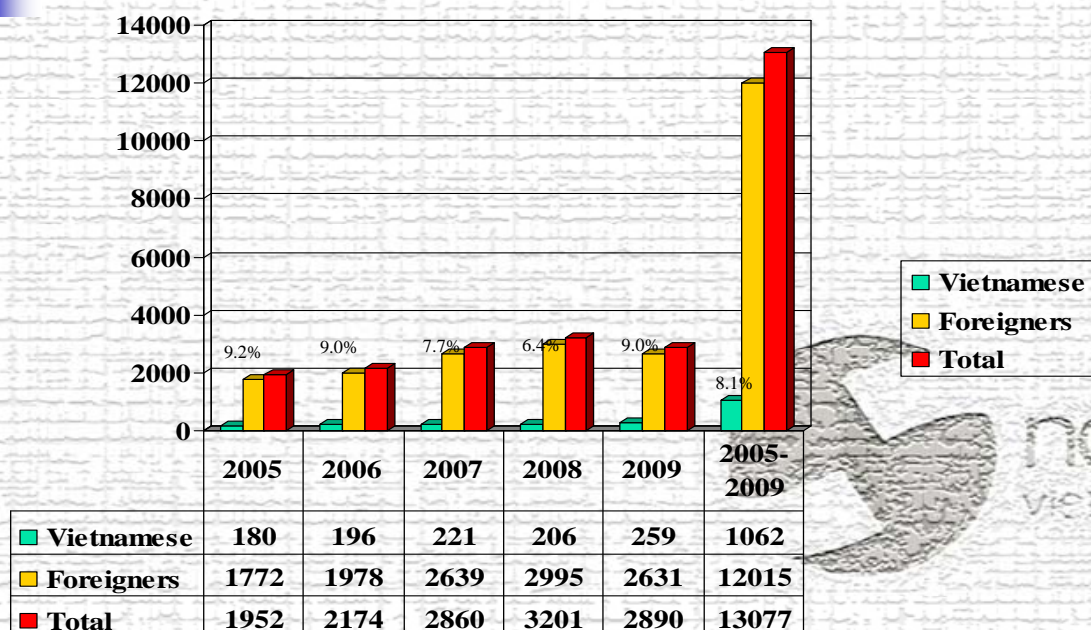
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□ Patent examiner recruitment



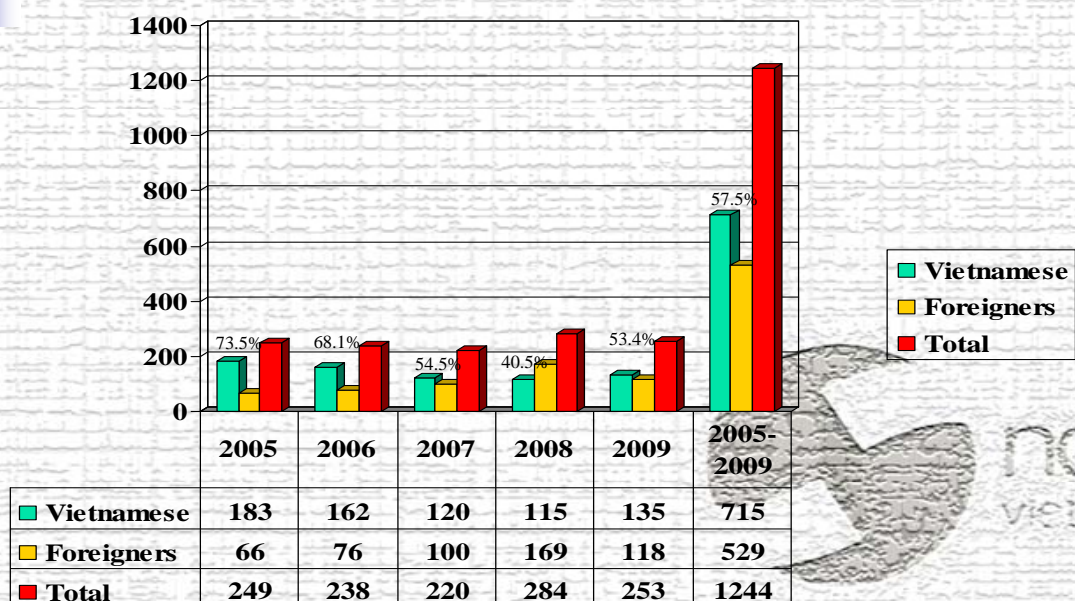
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□ PATENT FILINGS (2005-2009)



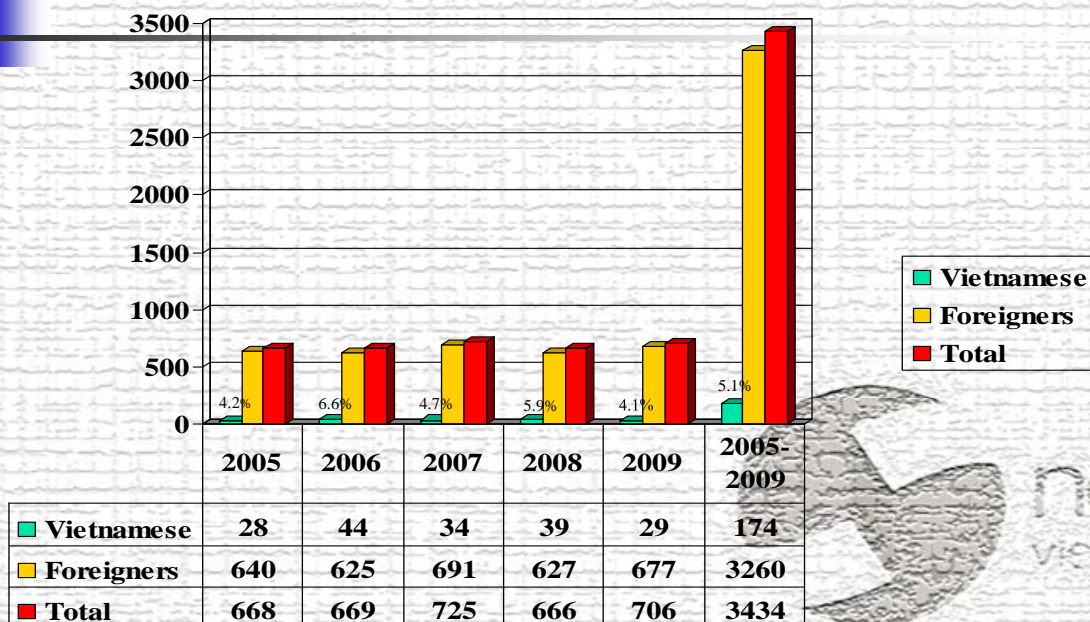
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□ UTILITY SOLUTION FILINGS (2005-2009)



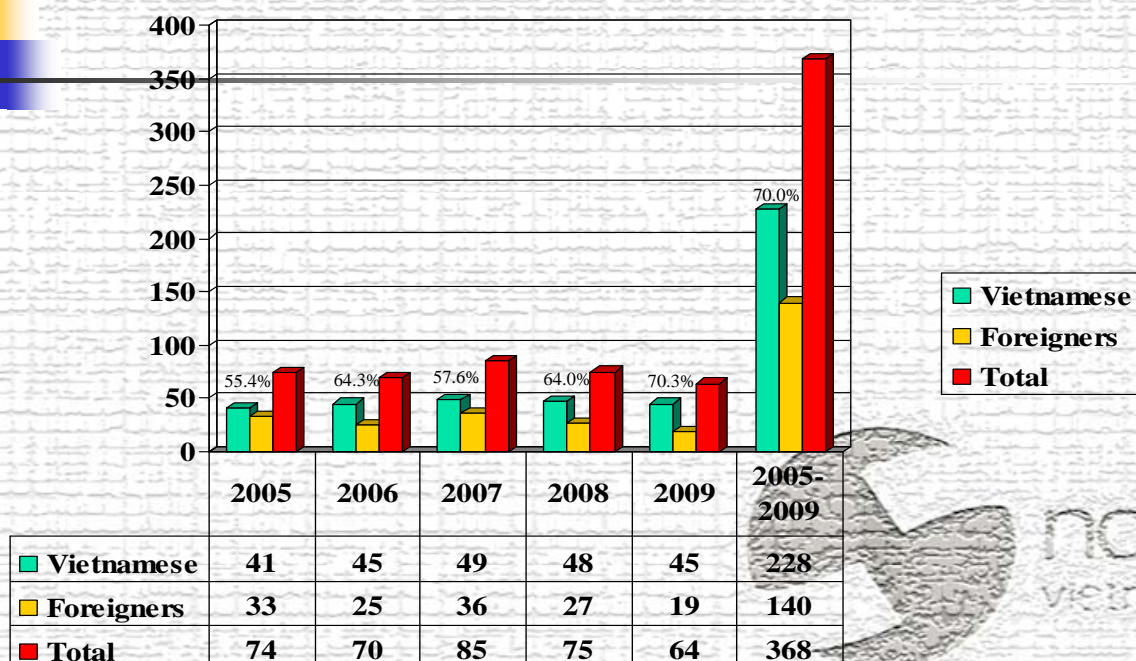
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□ PATENT GRANTS (2005-2009)



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□ UTILITY SOLUTION GRANTS (2005-2009)

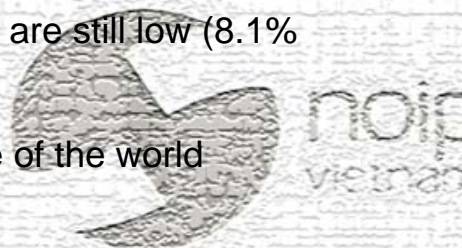


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□ Trend of filings:

- From 2005 to 2008, patent filings was significantly increasing, which seems to be derived from the growth of Vietnam's economy as well as the more international economic integration after joining the World Trade Organization (11 January 2007).
- The patent filings by national applicant are still low (8.1% among total filings).
- The filings decreased in 2009 because of the world economic recession.



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□ Search tools

- Patent literature: Mostly used are non-commercial search tools available on the internet (espacenet, WIPO patentscope, patentlens, JPO IPDL, google patents, USPTO database, SIPO database, etc.).
- Non-patent literature: Google search, NCBI Medline (only to free of charge documents), normal-library search, etc..



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□ WIPO Search Assistance

- * In some circumstances, the examiner can make a request for search assistance to WIPO's Patent Information Service (WPIS) for developing countries.
- * Such requests must be endorsed by NOIP.
- * Applied only for national non-PCT applications, e.g. applications by domestic applicants or applications having no corresponding applications in the EPO or USPTO.

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□ Search and examination based on foreign search and examination results

- * The search and examination of Vietnamese patent applications can be done based on the search and examination results of corresponding applications filed with foreign IP office where the search and substantive examination being carried out (item 15.2a), Circular No.01/2007/TT-BKHCHN).
- * The applicant can amend the claims, along with the description (if appropriate), in conformity with claims and description of corresponding patent granted in foreign country (where the search and substantive examination being carried out) for facilitating and accelerating the examination procedure (item 15.2b), Circular No.01/2007/TT-BKHCHN).

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4. Main challenges for search and examination activities in NOIP

- The lacking of professional and effective search tools may:
 - * slow down the search and examination procedure.
 - * adversely affect the quality of search and examination activities, especially with respect to domestic applications and foreign applications having no corresponding applications in big patent offices (e.g. EPO, USPTO, JPO, etc.).
 - * Result in unreliable patents which in turn can damage the original goals of patent protection accordingly.

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□ Lacking of human resource for search & examination

- * Currently there are 49 patent examiners in 3 patent examination divisions.
- * 36 of them (about 73%) are unexperienced patent examiners (recruited since 2007).
- * Difficulties in recruiting new patent examiners because of high requirements while the working conditions are not competitive and attractive sufficiently.
- * Lacking of trainers and professionals with high search and examination expertise and skills.

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□ **Lacking of specialization in search and examination:**

- Examiners have to carry out search and examination in various technical fields (e.g. examiners in pharmaceutical field have to concurrently conduct search and examination of applications in the field of petro-chemistry, detergent compositions, medical equipments, etc.).
- Examiners have to examine both patent applications and utility solution applications. (In Vietnam, utility solution applications must be examined substantially)



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□ **Lacking of comprehensive and systematic training programs:**

- Basic courses for new patent examiners are available but not highly comprehensive.
- Lacking of specific and comprehensive curriculums/programs for training patent examiners.
- Advanced course for patent examiners is not available.

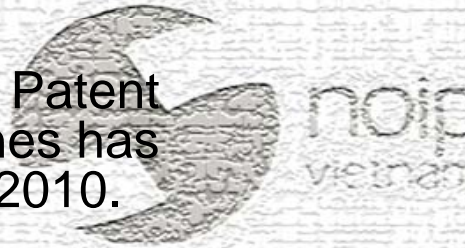


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5. Strategies and solutions to overcome the challenges

- Strengthening the legal framework relating to patent
 - * Revising the IP law in 2009 towards more clarity and comprehensiveness.
 - * Drafting new Guidelines for Patent Examination. Such Guidelines has come into force since April 2010.

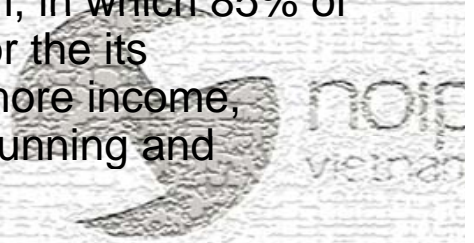


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□ **Modifying the office's financial mechanism:**

- * Before January 2010, NOIP is a Government Agency with dependent financial regime → low income, limited resource for development.
- * In January 2010, the financial regime had been changed to autonomous mechanism, in which 85% of the fee revenue returned to NOIP for the its maintenance and development → more income, more attraction, more resource for running and development.



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□ Developing human resource

- * Since the 3rd quarter of 2008, the office has enforced an examination target regime along with reasonable remuneration to patent examiners → in fact, the examination output of Invention Division 2 in 2009 was 37.3% higher than that of 2008.
- * Recruiting new patent examiners (10-15 new examiners intended in 2011).
- * Setting up the standard training program for training new examiners along with On-the-Job (OJT) training (under discussion).
- * Promoting international co-operation on human resource development and capacity building.

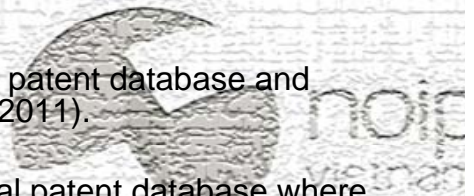


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□ Improving the IT systems:

- Two projects are being conducted by NOIP for further strengthening the IT framework of national IP system:
 - Project for enhancing the automation of IP administration (500,000 USD) (2008-2010)
 - ❖ Main goals: Modernizing and securing the automation of IP administration and improving the retrieval speed and capacity of the PC systems.
 - Project for the establishment of national patent database and searching center (400.000 USD) (2009-2011).
 - ❖ Main goals: Establishing the national patent database where the full-text of national patent publications (in Vietnamese) can be accessed through the internet and establishing the national searching center.



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□ Improving search system and skills

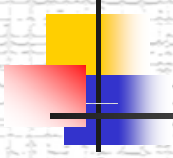
- * Patent database: The using of more effective search tools and databases such as Depatisnet of German Patent and Trade Mark Office (DPMA) and GPI of the European Patent Office (EPO) is under exploration and consideration.
- * Non-patent databases: Subscribed to the Vista database of the National Agency for Science and Technology Information where the patent examiners can search Vietnam's science and technology publications, Science@Direct database (not complete), ISIknowledge database, Springerlink database, American Chemistry Society (ACS) database, APS Journals, and others (in July 2010). In addition, the office is planning to register with WIPO to access aRDi (Access to Research for Development and Innovation) program for supporting domestic researchers and patent examiners as well (very good price: CHF 1100 per calendar year in case of Vietnam).
- * Setting up a regime for encouraging the patent examiner to do the search by themselves. In the future, the endorsement of WIPO search assistance request will be only given to the cases where effective search is impossible to be done by patent examiner (e.g. chemical compound structure search or gene sequence search).

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□ Other measures

- * Promoting work-sharing and international co-operation in patent search and examination through bilateral cooperation and multilateral co-operation (e.g. ASEAN Patent Examination Co-operation (ASPEC) project).
- * Out-sourcing of patent search and examination.

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Thank you for your attention!

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