

# Vietnam's preparation on legal issues for accession to the Hague Agreement



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# Vietnam's preparation

- Analyse the conflicts between Vietnam's regulations regarding design protection and the Hague system
- Consider declarations of a number of Contracting Parties in order to determine the common trend of design protection in the world
- Analyse, establish and propose the fee system for international applications designating Vietnam
- Propose the declarations of Vietnam to the IB when acceding the Hague Agreement as well as the possibility of amending a number of domestic provisions to comply with the Hague system and the trend of design protection in the world
- Analyse the challenges the design protection system of Vietnam will face when acceding the Hague Agreement and assess the current competence of the domestic system, thereby proposing the necessary tasks and IT system to be prepared for the receive and processing of international applications originating from or designating Vietnam
- Analyse and propose the effective methods and contents of promotion for the system of international registration of industrial designs so as to raise the awareness among the public about this system

# Vietnam's preparation

- Regarding legal issues, the preparation is only confined to putting forward possible solutions and proposals regarding declarations of Vietnam when acceding to the Geneva Act of the Hague Agreement as well as the possibility of amending a number of domestic provisions to comply with the Hague system.
- These proposals must be approved by levels of authority before implementation.

# Legal issues

- Photos and drawings
- Description
- Claim
- Indications concerning the identity of the creator
- Indirect filing
- Self-designation
- Deferment of publication
- Confidential copy
- Period for notification of refusal
- Partial design
- Multiple applications

# Photos and drawings

## The Hague system

1.1



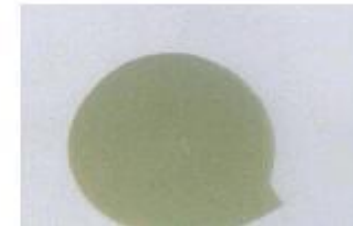
1.2



1.3



## Vietnam's regulations



## **The Hague system**

- Full directional views are not required.
- Contracting parties may make a declaration to notify certain specified views that are required and the circumstances in which they are required (Rule 9(3)(a)).
- Maximum number of views can be required: 1 view for 2D designs, 6 views for 3D designs (Rule 9).

## **Vietnam's regulations**

- 7 views are required for 3D designs (perspective view and 6 directional views).
- Additional views such as perspective views from other directions, sectional views and enlarged views, etc. may be required for complicated designs.

## **Possible solutions**

- Amend the regulations to comply with the Hague system
- Declare under Rule 9(3)(a) to require 6 directional views for 3D designs
- Declare under Rule 9(3)(a) to require perspective view for 3D designs

## **Proposal**

- Declare under Rule 9(3)(a) to require perspective view for 3D designs

## **The Hague system**

- A contracting party may make a declaration to require an international application to contain a description regarding the **representations** of the design or **characteristic features** of the design (Article 5(2)(b)(ii)).
- If the description exceeds 100 words, an additional fee is required.

## **Vietnam's regulations**

- A design application must include a description in which all features expressing the nature of the design must be fully disclosed (IP Law, Article 103.2).
- The description must also include the list of views.
- There is no word limit.

## **Possible solutions**

- Amend the regulations to comply with the Hague system
- Declare under Article 5(2)(b)(ii) to require an international application to contain a list of views
- Declare under Article 5(2)(b)(ii) to require an international application to contain a description regarding characteristic features of the design

## **Proposal**

- Declare under Article 5(2) to require an international application to contain a list of views



## **The Hague system**

- A contracting party may make a declaration to require an international application to contain a claim (Article 5(2)(b)(iii)).

## **Vietnam's regulations**

- A design application must include a claim (IP Law, Article 103.3).

## **Possible solutions**

- Amend the regulations to comply with the Hague system, do not require an international application to contain a claim
- Declare under Article 5(2)(b)(iii) to require an international application to contain a claim

## **Proposal**

- **Make no declaration**, not requiring an international application to contain a claim



## **The Hague system**

- A contracting party may make a declaration to require an international application to include indications concerning the identity of the creator of the design (Article 5(2)(b)(i)).

## **Vietnam's regulations**

- A design application shall be considered invalid if the application form does not include full prescribed information about the designer.

## **Possible solutions**

- Make a declaration to require an international application to include information about the full name, domicile and nationality of the creator
- Make no declaration

## **Proposal**

- Make a declaration to require an international application to include information about the full name, domicile and nationality of the creator

## **The Hague system**

- An international application may be filed either directly with the IB or through the Office of the applicant's Contracting Party (Article 4(1)(a)).
- However, any Contracting Party may declare that international applications may not be filed through its Office (Article 4(1)(b)).

## **Benefits of indirect filing to applicants in Vietnam**

- NOIP may provide support and consultation to applicants in preparing application documents in foreign languages.
- It makes more convenient for applicants to pay fees to the IB.

## **Proposal**

- Make no declaration under Article 4(1)(b)
- Allow applicants in Vietnam to file international applications through NOIP

## **The Hague system**

- Any examining Contracting Party may make a declaration that where it is the applicant's Contracting Party, the designation of that Contracting Party in an international registration shall have no effect (Article 14(3)(a)).

## **Benefits of self-designation to applicants in Vietnam**

- To make it convenient for applicants in Vietnam when they want to file applications with both NOIP and other Contracting Parties
- To offer applicants in Vietnam an additional effective way to file design applications and enable them to get outstanding benefits from the Hague system concerning the international deposit of industrial designs

## **Proposal**

- Make no declaration under Article 14(3)(a)
- Allow applicants in Vietnam to choose Vietnam as a designated Contracting Party in an international application

## **The Hague system**

- The deferment of publication for a period up to 30 months is allowed (Article 11, Rule 16).
- A Contracting Party may make a declaration which allow the deferment of publication for a shorter period (Article 11(1)(a)).
- A Contracting Party may declare that the deferment of publication is not allowed (Article 11(1)(b)).

## **Vietnam's regulations**

- An industrial design application shall be published within 2 months as from the date such application is accepted as being valid (IP Law, Article 110.3).

## **Advantages of publication deferment prohibition**

- The design can be disclosed to the public early, preventing duplication of creative ideas.
- The third party can submit oppositions if any.
- Prevent the extension of time in examination of applications filed later

## **Disadvantages of publication deferment prohibition**

- Adversely impact on the business strategy of the applicant
- Adversely impact on the attraction of newly launched products

## **Proposal**

- Make a declaration that the deferment of publication is not allowed

## **The Hague system**

- A Contracting Party may notify the IB that its Office wishes to receive confidential copies of the international registration immediately after the international registration has been completed (Article 10(5)).

## **Benefits of the confidential copy**

- NOIP does not have to wait for 6 months before it can receive information about the international registration designating Vietnam.
- The design can be conducted substantive examination immediately after registration, thereby reducing time pressure for NOIP to issue the first action.

## **Proposal**

- Notify the IB that Vietnam wishes to receive confidential copies of the international registrations designating Vietnam

## **The Hague system**

- The period for notification of refusal is 6 months from the publication of the international registration (Rule 18(1)(a)).
- Examining Contracting Parties can declare that this period is extended to 12 months (Rule 18(1)(b))

## **Vietnam's regulations**

- A design application is accepted as being valid within 1 month from the filing date.
- The application is published within 2 months from the date of acceptance as being valid.
- The period for issuing the first action is 7 months from the publication date.

## **Possible solutions**

- Make no declaration, so the period for notification of refusal is 6 months from the publication date
- Make a declaration that the period of 6 months is replaced with 12 months

## **Đề xuất**

- Make a declaration that the period of 6 months is replaced with 12 months from the publication date of the international registration

## **The Hague system**

- Not clearly provide protection for Partial Design
- Matters which are shown in the reproduction of the design but for which protection is not sought may be indicated by means of dotted or broken lines and/or by descriptions (Rule 9(2)(b), Section 403(1)).

## **Vietnam's regulations**

- Vietnam's regulations do not provide protection for Partial Design.
- The representation is not allowed to indicate the design by dotted or broken lines.

## **Obstacles to accept protection for partial design at the moment**

- There are no provisions regarding protection for partial designs at the moment.
- It is required to amend regulations on definition of industrial design, scope of protection, requirements of the reproduction, description, conditions of protection.
- The partial design protection system is new and more complicated than the system of protection for the whole design; therefore it takes time to establish and perfect the new system.

## **Proposal**

- No amendment in the regulations yet, NOIP shall refuse partial designs with the reason that the subject matters claimed do not fulfill the definition of industrial design.



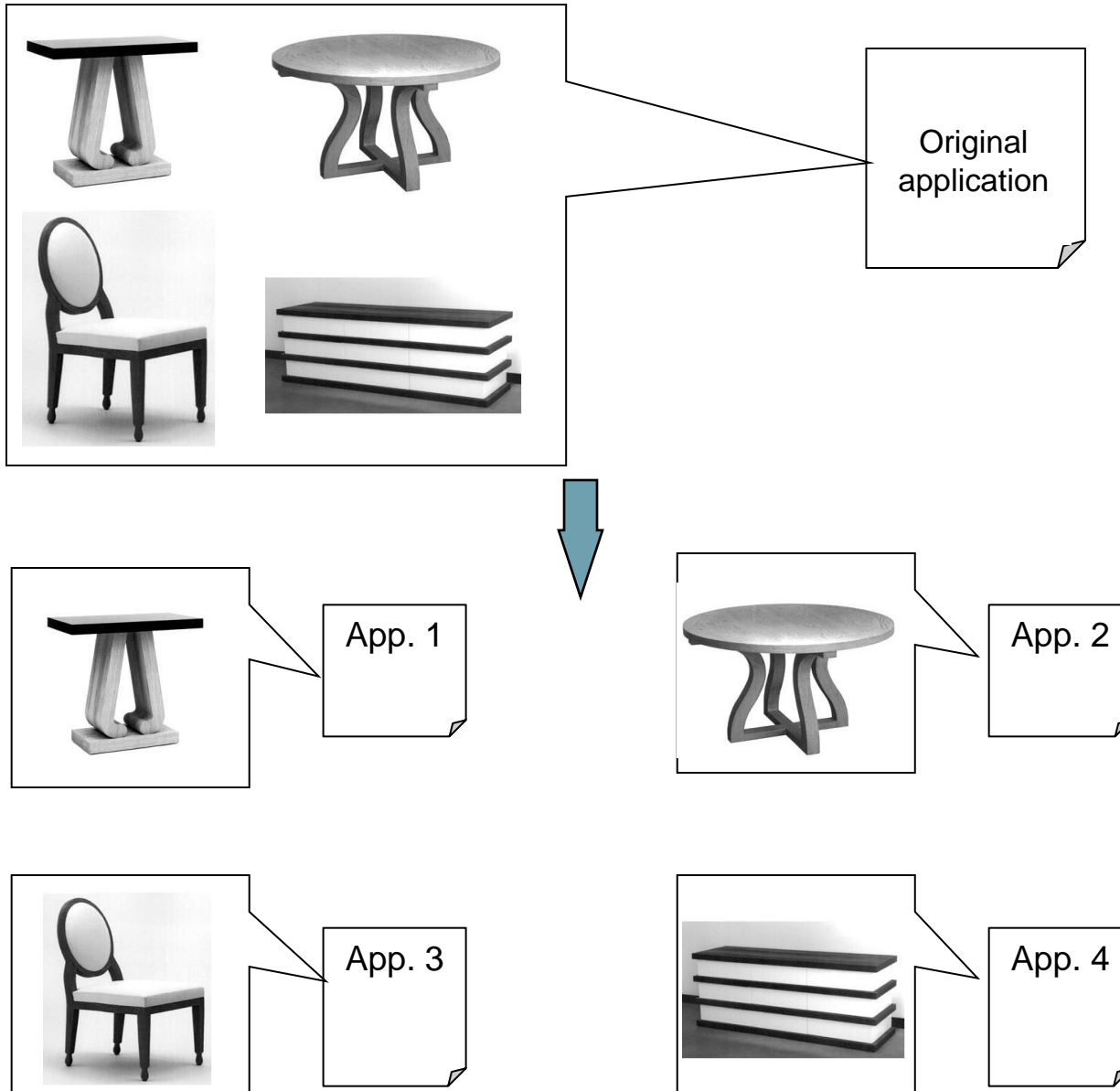
## **The Hague system**

- An international application may include two or more industrial designs (Article 5(4)).
- This helps to reduce registration procedures.
- This is an attractive feature of the Hague Agreement applicants.
- This provision seems to be suitable for non-examining Contracting Parties.
- However, this provision is not suitable for examining Contracting Parties, posing difficulties to examination since each design must be conducted prior search and examination independently.
- Geneva Act 1999 allows Contracting Parties to make a declaration that they do not accept multiple applications, thereby refusing the effect of international registrations with multiple designs.

## **Vietnam's regulations**

- A design application can request the grant of protection for only one industrial design.
- If a design application does not fulfill the requirement of unity of design, NOIP will issue the notification of refusal. The applicant can exclude one or more designs from the application or split these designs into independent applications.

# Multiple application



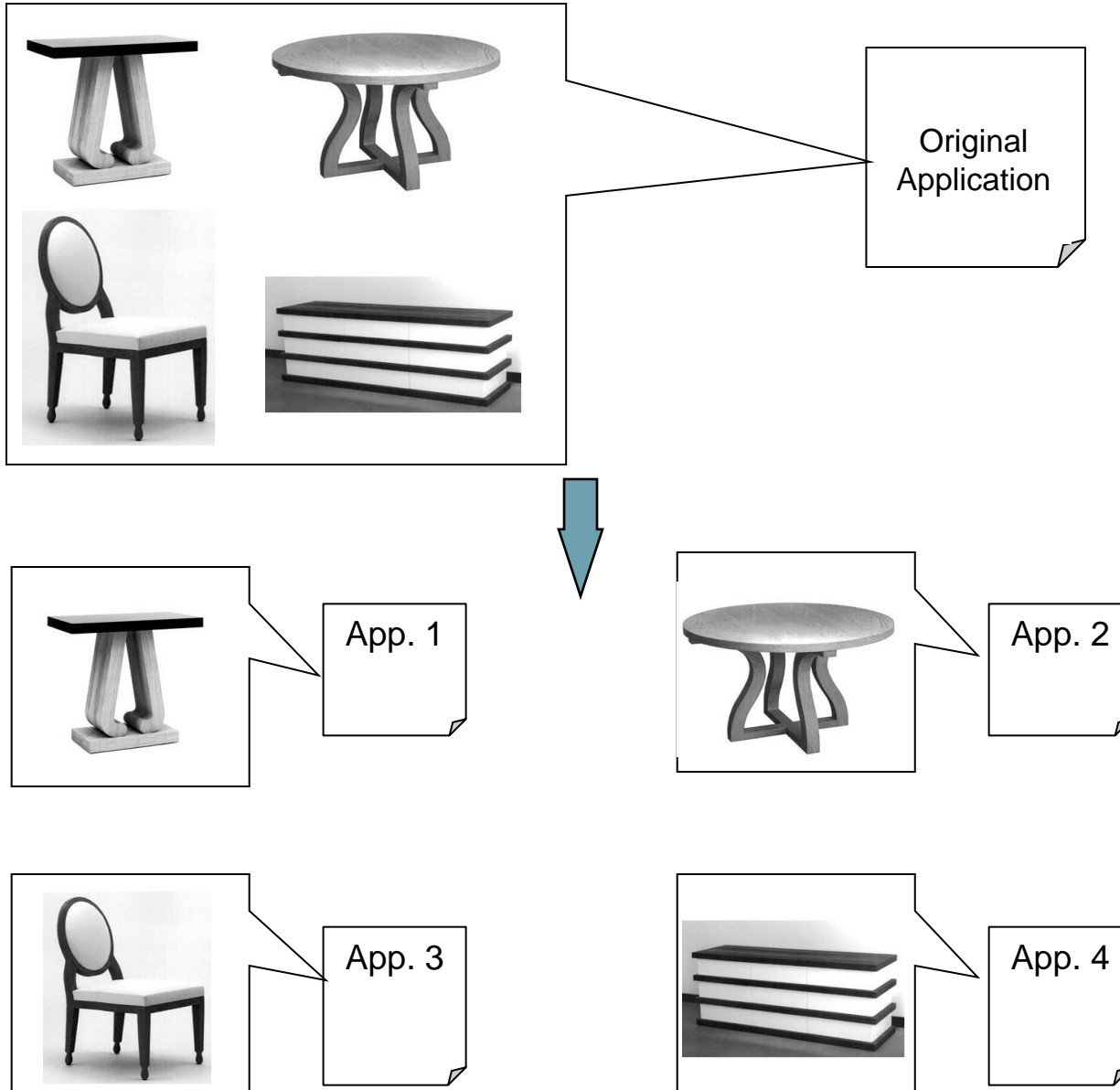
## **Possible solution 1:**

- Vietnam will make a declaration to the IB that Vietnam may refuse the effect of international registrations with multiple designs.

-NOIP will issue the notification of refusal.

- The applicant can exclude one or more designs from the application or split these designs into independent applications.

# Multiple application



## **Possible solution 2:**

- Vietnam by default considers an international registration with multiple designs as multiple applications, each of which is corresponding to one of the designs in the original application.
- This means that NOIP shall split the designs in the international registration into independent applications.
- These applications shall be conducted substantive examination independently and the notification of grant or refusal for each application shall be issued at independent point of time as domestic applications.

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