

Patent rights in Viet Nam

ASEAN Intellectual Property Association (ASEAN IPA)

<http://www.aseanipa.org>

The patent rights as mentioned above shall be limited by prior user's rights, compulsory license, and other acts.

Prior user's rights

The exercise of the prior user's right to invention or industrial design shall not be considered as an infringement of rights of the owner of the patented invention or industrial design. Where a person who, before the filing date or priority date (if any) of an invention or industrial design application, was using or had made substantial preparation toward the using of an invention or industrial design independently created but identical with the invention or industrial design claimed in the application, the said prior user shall be entitled to continue the use after the patent is granted, within the extent and volume of use or substantial preparation toward the using already made. The prior user shall not be entitled to enlarge the extent and volume of use unless it is so permitted by the owner of the patented invention or industrial design. The prior user's right shall not be allowed to be transferred except for the case it is transferred together with the business establishment where the prior user's right is exercised.

Compulsory license

The right to use an invention shall, without permission of the patentee, be granted to another entity or individual upon decision of the State competent authority if (i) the use of the invention is intended for the public interest, non-commercial purposes, national defense, security, prevention and treatment of disease, for people's nutrition, or meeting other urgent needs of society; (ii) the patentee fails to fulfill the obligation of using the invention after the expiration of four years from the date of filing of the patent application and three years from the granting date of the patent for invention; (iii) the person who wants to use the invention fails, within a reasonable period of time for negotiation on reasonable considerations and commercial conditions, to reach an agreement with the patentee on a license to use such an invention; or (iv) the patentee is regarded as performing an act of anti-competition prohibited under the competition law and regulations.

The right to use the invention under the compulsory license granted by a decision of a State competent authority shall meet the following conditions:

- a. The right to use shall be non-exclusive;
- b. The right to use shall only be limited to such a scope and duration sufficient to attain the purpose for which the compulsory license was granted, and predominantly for the supply of the domestic market;

- c. The licensee of the compulsory license shall not assign the right to use the patented invention to another person, except where the assignment is made together with his/her business establishment and sub-license others to use the patented invention;
- d. The licensee of the compulsory license shall pay the patentee/licensor adequate remuneration, taking into account the economic value of the allowed use, in compliance with the remuneration frame provided for by the Government;
- e. The patentee of the dominant invention shall also be entitled to grant a license to use the dependent invention on reasonable terms and conditions; and
- f. The licensee of compulsory license to use the dominant invention shall not be entitled to assign such right, except with the assignment of the entire right to the dependent invention.

Other cases

The following shall be exempted from patent infringement:

1. Use of the invention or industrial design for personal needs or non-commercial purposes, or for the purposes of evaluations, analysis, research, teaching, testing, pilot production or for collecting data to carry out procedures to obtain a production license, import or product marketing permit;
2. Use of the invention or industrial design only for the purpose of maintaining the operation of a foreign vehicle in transit or only temporarily entering into the territory of Vietnam;

Who may file and where to file patent applications

The right to file a patent application for invention or industrial design generally belongs to inventors who have created the invention or industrial design by his/her own efforts and expenses. In case an invention or industrial design is created by the inventors during the course of employment or hire, the entitlement to file patent applications for such invention or design shall belong to the entities or individuals who have invested finance and material facilities to the inventors through employing or hiring, unless otherwise agreed by the parties (the employee invention). In this case, the employees shall enjoy some moral rights over the invented technology in addition to some remuneration. Moral rights of employee-inventor(s) are to be named as inventor in relevant patent letters as well as in any documents in which the invented technology is published or introduced. The remuneration for the employees is stipulated as 10% of benefits obtained from using the invention, and 15% of the sum amounted from each royalty for granting a license to use the invention, unless otherwise agreed by the parties.

IP assignment and licensing in Thailand

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The assignment, or license agreements, of IP objects must be made in writing, contain minimum requirements, and not be contrary to specific prescriptions in regard to the related rules. Most types of IP objects shall be registered with the related authorities in order to make them valid and enforceable in Thailand. The important rules and regulations in relation to the three main IP objects, i.e. 1) trademark, 2) patent, and 3) copyright, are as follows:

Trademark

Trademark Assignment – the assignment must be made in writing and registered with the Trademark Office, in order to make it valid and enforceable. The Trademark Office accepts the registration assignment for any pending and registered trademarks, and there is no specific deadline for registering the assignment in Thailand. An important rule relating to trademark assignment is prescribed under Section 50 of the Trademark Act, whereby all associated trademarks shall be transferred, or inherited, only as a whole. The assignment cannot be registered only for some associated trademarks, and partial assignment is not allowed. In addition, the cancellation of filed/registered license agreements relating to assigned trademarks is always a prerequisite, before the assignment is granted in Thailand.

Trademark Licensing – the license agreement and any sub-license agreement must be made in writing and registered with the Trademark Office, in order to make it valid and enforceable. To register a sub-license agreement, the main license agreement must also be registered. If the license agreement is subject to a renewal, such renewal must be re-registered in order to maintain its validity.

A registrable license agreement, according to Section 68 of the Trademark Act, shall at least provide the following: 1) conditions and terms of the agreement between the trademark proprietor and the person applying to be an authorized licensee, which must actually enable the former to control the quality of the goods manufactured by the latter; and 2) the goods on which the licensed trademark is to be used.

The license agreement can include all pending and registered trademarks in Thailand. However, the Trademark Office will only register the licenses of registered trademarks. The license agreement for pending trademarks can be registered, only after it is granted registration, and without the requirement to enter into a new license agreement. There is no deadline for registering a license agreement in Thailand. The main consequence of a non-registered license agreement is that it is non-enforceable under Thai law, and the use by a licensee

is not legitimate to defend against a non-use cancellation action.

Patent

Patent Assignment – the assignment must be made in writing and registered in compliance with the requirements, procedures and conditions as prescribed by the relevant Ministerial Regulations, in order to make it valid and enforceable. The Patent Office registers the assignment for any pending and registered patents, and there is no specific deadline for registering the patent assignment in Thailand. The application to register the assignment must be separately submitted with the Patent Office, together with the agreement which transfers the patent for each assigning patent.

Patent Licensing – the license agreement must be made in writing, and registered in compliance with the requirements, procedures and conditions as prescribed by the Ministerial Regulations, in order to make it valid and enforceable.

In granting a license, according to Section 39 of the Patent Act: 1) the patentee shall not impose upon the licensee any condition or restrictions, or any royalty term which unfairly limits competition. Conditions, restrictions or terms which tend to unfairly limit competition are prescribed in the Ministerial Regulation No. 25 (B.E. 2542), issued under the Patent Act B.E. 2522, and these include for example: a) prescribing the licensee to provide material, for use in the production, from the holder of the patent, or from the distributor, which the holder of the patent has prescribed or permitted, except where it can be proved that it has to be prescribed so that the product produced gives the result as stipulated under the patent, or it is a material which cannot be acquired from another source; b) prescribing conditions or restrictions of the licensee concerning the hire of persons for the production of the invention, except where it can be proved that such has to be prescribed, so that the product produced gives results which are in accordance with the patent; c) prescribing that the licensee sells, or distributes more than half of the product produced, to the holder of the patent; d) prescribing that the licensee limits the quantity of production, sale or distribution; e) prescribing that the licensee discloses the invention, which the licensee has improved, or to allow the patent holder to seek interest from the said invention without prescribing a suitable remuneration for the licensee; f) prescribing that the licensee exercise the rights under the patent to pay remuneration for the use of the invention according to the patent, after

the patent expires, etc.; and 2) the patentee shall not require the licensee to pay royalties for use of the patented invention after the patent has expired. Conditions, restrictions or terms concerning royalties, which are contrary to this provision, are null and void.

Copyright

Copyright Assignment – the copyright owner can assign the whole, or part, of his copyright to another person for a limited period of time, or for the entire term of copyright protection. An assignment of copyright, other than by inheritance, shall be made in writing and signed by the assignor and the assignee. There is no need to register such assignment with the Copyright Office. If the assignment contract does not specify a period of time, it shall be deemed that the assignment is for a period of 10 years.

The rights of a performer can also be assigned, wholly or in part, and can be assigned for a specified period of time, or for the duration of the term of protection. Where there is more than one performer, a performer is entitled to assign only that portion of the rights belonging to him. An assignment of a performance right, other than by inheritance, shall be made in writing, and signed by the assignor and the assignee. There is no need to register such assignment with the Copyright Office. Should there be no period of time specified in the assignment contract, it shall be deemed that the assignment is for a period of 3 years.

Copyright Licensing – the copyright owner can grant licenses to other persons to use the rights to reproduce or adapt, disseminate to the public, or rent the original or a copy of a computer program, audio-visual work, cinematographic work, and sound recording, with or without imposing any conditions, but any conditions specified shall not restrict fair competition.

The conditions which restrict fair competition are prescribed in the Ministerial Regulations (B.E. 2540), issued under the Copyright Act B.E. 2537, and include for example: a) prescribing that the licensee acquire materials for use in the production of a copied work so permitted, either wholly or partly, from the owner of the copyright, except where it is necessary to do so for the purpose of obtaining a copied work which is in accordance with the standards set by the owner of the copyright; b) prescribing conditions or restricting the rights of the licensee, in relation to the hiring of a person to produce a copied work, except where it is necessary to do so for the purpose of obtaining copied work which is in accordance with the standards prescribed by the owner of the copyright; c) prescribing considerations for the granting of permission to exercise the rights in a copyrighted work at an unfair rate, when compared to the rate prescribed by the owner of the copyright for other licensees who have been granted permission in the same period of time for the same copyrighted work; d) prescribing conditions or restricting the rights of the licensee in regard to research or study of the copyrighted work, for which permission has been granted; e) prescribing conditions which enable the licensor has the right to terminate the permission at will, and without reasonable cause, etc.

Fight Against Neglected Tropical Diseases, Malaria and TB

WIPO Re:Search catalyzes the development of new medicines and technologies in the fight against neglected tropical diseases (NTDs), malaria and tuberculosis. Through innovative research partnerships and R&D collaborations we make intellectual property (IP) available to researchers who need it.

WIPO Re:Search has launched a new five-year roadmap to guide its activities in the fight against neglected tropical diseases, malaria and tuberculosis. The World Intellectual Property Organization (WIPO) and its partner BIO Ventures for Global Health (BVGH) established the initiative in 2011 to boost the use of intellectual property in catalyzing innovation and product development for ailments affecting more than 1 billion people. WIPO Re:Search now includes 126 members in 35 countries and has established 112 collaborations across the globe. The new plan will guide the public-private consortium's activities through 2021 and includes new research, capacity building and outreach efforts.

WIPO Re:Search allows organizations to share their intellectual property, compounds, expertise, facilities and know-how royalty-free with qualified researchers worldwide. The new strategic plan seeks to ensure that WIPO Re:Search harnesses new research and development trends in global health, while contributing to the achievement of the United Nations Sustainable Development Goals. The IP, resources, and know-how available via WIPO Re:Search accelerate research into NTDs, malaria, and tuberculosis. In turn, this increases the chances of success and reduces development costs.

For more information, access:

<http://www.wipo.int/research/en/>