

Trademarks

3.1 Definition and Registrability

A trademark is defined as a sign used to distinguish the goods or services of one producer/service provider from those of another. The trademark may be presented in the form of letters, pictures or a combination thereof in one or several colors. To be registrable, a trademark must be distinctive and must not fall within the signs excluded from registrability.

A sign used as a trademark shall be deemed distinctive if the following conditions satisfied:

- (i) It is created from one or a number of elements that are prominent and easily recognized, or from elements that are, as a whole, prominent and easily recognized;
- (ii) It is not identical with or confusingly similar to another persons trademark currently protected in Vietnam;
- (iii) It is not identical with or confusingly similar to a trademark of another person claimed in prior-filed applications in Vietnam including those trademarks filed under the Madrid Agreement;
- (iv) It is not identical with or confusingly similar to a trademark of another person, the protection validity of which has expired or been suspended within the last 5 years, except where the validity was suspended on the basis of non-use;
- (v) It is not identical with or confusingly similar to a trademark of another person recognized as well-known in accordance with Article 6bis of the Paris Convention, or a trademark that has been widely used and recognized;
- (vi) It is not identical with or confusingly similar to a protected trade name or geographical indication;
- (vii) It is not identical with or confusingly similar to a patented industrial design or a prior-filed industrial design; or
- (viii) It is not identical with or confusingly similar to a symbol or character subject to another person's copyright, which has been widely known, unless permitted by such person.

The following signs shall be excluded from trademark protection:

- (i) Signs that do not possess distinctiveness, such as simple shapes and

geometric shapes, figures, capital letters, , and foreign letters of uncommon languages which does not derive from Latin (such as, Arabian, Chinese, Japanese, Korean, Thai, etc.) . Those signs can be however registered if they have been widely used and recognized;

(ii) Conventional signs, symbols, ordinary devices, and denominations of goods in any language that are used widely and popularly and known to many people;

(iii) Signs indicating time, place, manufacturing process, type, quantity, quality, nature, composition, utility or value that are descriptive of goods, services or origin thereof;

(iv) Signs likely to mislead or cause confusion or to deceive consumers as to the origin, nature, function, utility, quality or value of goods or services;

(v) Signs identical with or similar to official quality marks, control marks, warranty marks, etc. of Vietnam, foreign countries or international organizations;

(vi) Signs or names (including pictures, names, nicknames and pseudonyms), devices or symbols identical with or confusingly similar to national flags, national emblems, portraits of national leaders or heroes, public figures, geographical denominations, organizations of Vietnam and foreign countries, unless duly authorized; and

(vii) Signs that are contrary to law, social interests, public order and humanity.

3.2 Who May File and Where to File Trademark Applications

All individuals and entities involved in legal production and business activities are entitled to file applications for trademark registrations to be used for products or services they are manufacturing or providing or intend to manufacture or provide. Actual or prior use of a trademark is not required to seek trademark registration in Vietnam. So businesses including foreign ones can seek registrations of trademarks for future use in Vietnam, provided that a registered mark may not be discontinued for any five consecutive years. Otherwise, the trademark is vulnerable to cancellation.

Trademark applications can be filed with the NOIP in Hanoi or the NOIP's branch in Ho Chi Minh City. Vietnamese citizens and entities may file

trademark applications directly with the NOIP. Foreign citizens permanently residing in Vietnam or foreign entities having legal presence in Vietnam or real and effective production and business establishments in the country may also file applications directly with the NOIP. Other than these specified cases, all applications of foreign applications must be submitted through a licensed local IP agency like Vision & Associates.

3.3 “First to File” Principle

Like other industrial property objects, the “first to file” principle is also applied for trademark protection in Vietnam, accordingly the trademark registration will be granted to the person who first filed the trademark application.

However, the “first to file” principle shall not apply to cases of well-known marks under the Paris Convention or those which have been widely used and recognized. In such cases, the priority will be given to the person who can prove that his trademark has been well-known or been widely used and recognized, without subject to the “first to file” principle.

3.4 Priority

Priority can be claimed in accordance with the Paris Convention, based on an earlier application filed in a foreign country or an officially recognized international exhibition held in Vietnam or in a foreign country. Priority can be also claimed according to bilateral agreements or based on the reciprocity principle. To secure the priority right, the application must be filed within 6 months from the filing date of the first application filed abroad or the date of the exhibition as above mentioned.

3.5 Trademark Applications

Each application can be used for one trademark only. However, multi-class applications are possible in Vietnam, accordingly up to 45 classes of goods and services can be claimed under one application. The goods and/or services under the application must be classified according to the International Classification of Goods and Services under the Nice Agreement (currently the ninth edition is applicable).

The NOIP accepts a general power of attorney for trademark filings of one applicant. In case the power of attorney specifies particular marks of

the applicant, then separate power of attorney will be required for any subsequent marks of the applicant not specified in the original power of attorney. Neither notarization nor legalization is required regarding the Power of Attorney. The power of attorney is not required at filing , provided that the original copy is supplemented within 01 months from the filing date.

For documents required for trademark filing in Vietnam, please see Filing Requirements in Vietnam.

3.6 Examination

All trademark applications will be examined by the NOIP with respect to formality requirements, within 01 months from the filing date. If the application is found to satisfy the formality requirements, then it will be accepted as legitimate by the NOIP in a Notification of Acceptance which provides official filing date, official filing number, and priority date if any. In case the application does not meet the formality requirements, the NOIP will reject the application by a Notification of Refusal of Acceptance or request corrections or amendments, as the case may be.

Upon expiry of the formality check and where the application is accepted as legitimate, the application will be published in the IP Gazette within 2 months from the acceptance date and then, passed to substantive examination which takes place within a 06 month period from the date of publication of the application. The substantive examination is to consider whether the claimed trademark (i) possesses distinctiveness and (ii) is of those signs excluded from trademark protection. During this period, the applicant may make amendments to the application, however only minor changes to the trademark or goods and/or services claimed are acceptable. For example, the applicant can restrict the goods and/or services claimed but not expand them.

Trademark applications filed internationally under the Madrid Agreement shall be also subject to the substantive examination which lasts 12 months from the date of publication of the extension of protection to Vietnam by WIPO.

3.7 Grant of Certificate of Trademark Registration or Acceptance of Protection

If upon expiry of the substantive examination, the trademark is found to be registrable, the NOIP will grant Certificate of Trademark Registration for the trademark, and publish the Certificate in the IP Gazette, Volume B. Regarding the international trademarks filed under the Madrid Agreement, the NOIP will issue Decision of Acceptance of Protection for the trademark in question. The international registration of a trademark, accepted for protection in Vietnam by the NOIP, shall be effective from the date it is published in the IP Gazette, Volume B until the end of the 20-year term of the international registration.

Where the trademark is unregistrable, the NOIP will issue a Notification of Examination Result of Application notifying the applicant of the intended refusal of grant of the certificate and reasons therefore, or of the deficiencies or amendments which should be corrected or made. The applicant has 2 months to reply or make necessary amendments. If the applicant fails to reply or the response is not appropriate, the NOIP will officially issue a Notification of Refusal of Granting Certificate of Trademark Registration. To the contrary where the response is satisfactory, the Certificate of Trademark Registration or Decision of Acceptance of Protection will be granted as above mentioned.

3.8 Well-known Trademarks

Intellectual Property Law, which came into effect from July 1, 2006 has defined for a well-known mark, which states “well-known mark is a mark widely known throughout territory of Vietnam”. According to the IP Law, industrial property rights to well-known trademark is are established based on its use without subject to registration.

Also, according to the IP Law, statutory criteria for determining a well-known trademark are:

- (i). The number of the related consumers who are aware of the mark through purchase or use of the goods or services bearing the mark or through advertising;
- (ii). Territorial scope of circulation of the goods/services bearing the mark;
- (iii). Turn-over of the sale or supply of the goods or services bearing the mark or the volume of the goods sold or the services supplied;
- (iv). The period of continuous use of the mark;
- (v). Widespread goodwill of the goods/services bearing the mark;

- (vi). Number of the countries granting protection to the mark;
- (vii). Number of the countries recognizing the mark as well known;
- (viii). Value of assignment, licensing price, or the value of investment capital contribution in respect of the mark.

The laws also provides procedures for recognition of well-known marks. Accordingly, the well-known marks, which are recognized under civil procedures or by the NOIP's decision shall be recorded in the List of Well-known Marks kept at the NOIP.

3.9 Protection Term and Renewal

A certificate of trademark registration shall be effective from the granting date and last for 10 years from the filing date, and can be renewed for indefinitely for each consecutive 10-year term.

To renew the validity of a certificate, the trademark owner must apply for renewal and pay the renewal fee within 6 months before the expiry of the preceding validity term. Renewal request may be filed late within a 6-month grace period, subject to a fine of 10 percent of the renewal fee for each month overdue.

3.10 Rights and Obligations of Trademark Owners

A trademark owner shall be entitled to (i) exclusive use of the trademark, including the right to license the right to use the trademark, (ii) request any person infringing his trademark rights to cease from the infringement and ask for any damage suffered.

The trademark owner must use the trademark continuously and must not discontinue use of the trademark for any consecutive 5 years. Otherwise, the certificate of trademark registration shall be suspended at a third party's request.

3.11 Appeal/Opposition Proceedings

The applicant may lodge appeals/oppositions against the NOIP's rejection of acceptance of applications or of granting certificates. Any third party has the right to appeal or oppose the grant of a certificate of trademark registration, subject to a prescribed fee.

The appeal/opposition must be made in writing and submitted to the NOIP within 3 months from receipt of the NOIP's decision subject to the appeal/opposition. In case of a third party opposing the grant of a certificate of trademark registration, the opposition may be filed at any

time during the validity term of the certificate. The NOIP shall be obliged to reply to the appellant within 30 days from receipt of the opposition. In case of disagreement with the NOIP's response, the appellant may appeal further to the MOST or initiate a lawsuit against the NOIP at the administrative court under the People's Court System.

3.12 Cancellation and Suspension of Certificate of Trademark Registration

A certificate of trademark registration may be cancelled wholly or partly, by any third party's request, in the following cases:

- (i) The person who has been granted the certificate was not entitled to apply for the trademark registration, nor assigned the right to file the application from the entitled person; or
- (ii) The trademark under the certificate does not meet the protection criteria as stipulated.

The validity of the certificate of trademark registration may be also suspended on the following grounds:

- (i) The grantee submits a written request to the NOIP for abandonment of the certificate; or
 - (ii) The grantee fails to pay the renewal fee within the prescribed time limit; or
 - (iii) The trademark under the certificate has not been used for any consecutive 5 years without any justifiable reasons (non-use basis); or
- The grantee no longer exists or terminates the operations.

3.13 Trademark Infringements

The use of a registered trademark as described above shall be considered as a trademark infringement if it is conducted without the consent of the trademark owner. The current trademark laws make available administrative, civil or criminal remedies, where appropriate, for a trademark owner to enforce his rights in case of infringement. For details of enforcement of trademark rights and remedies available, please see Section 8 hereunder.