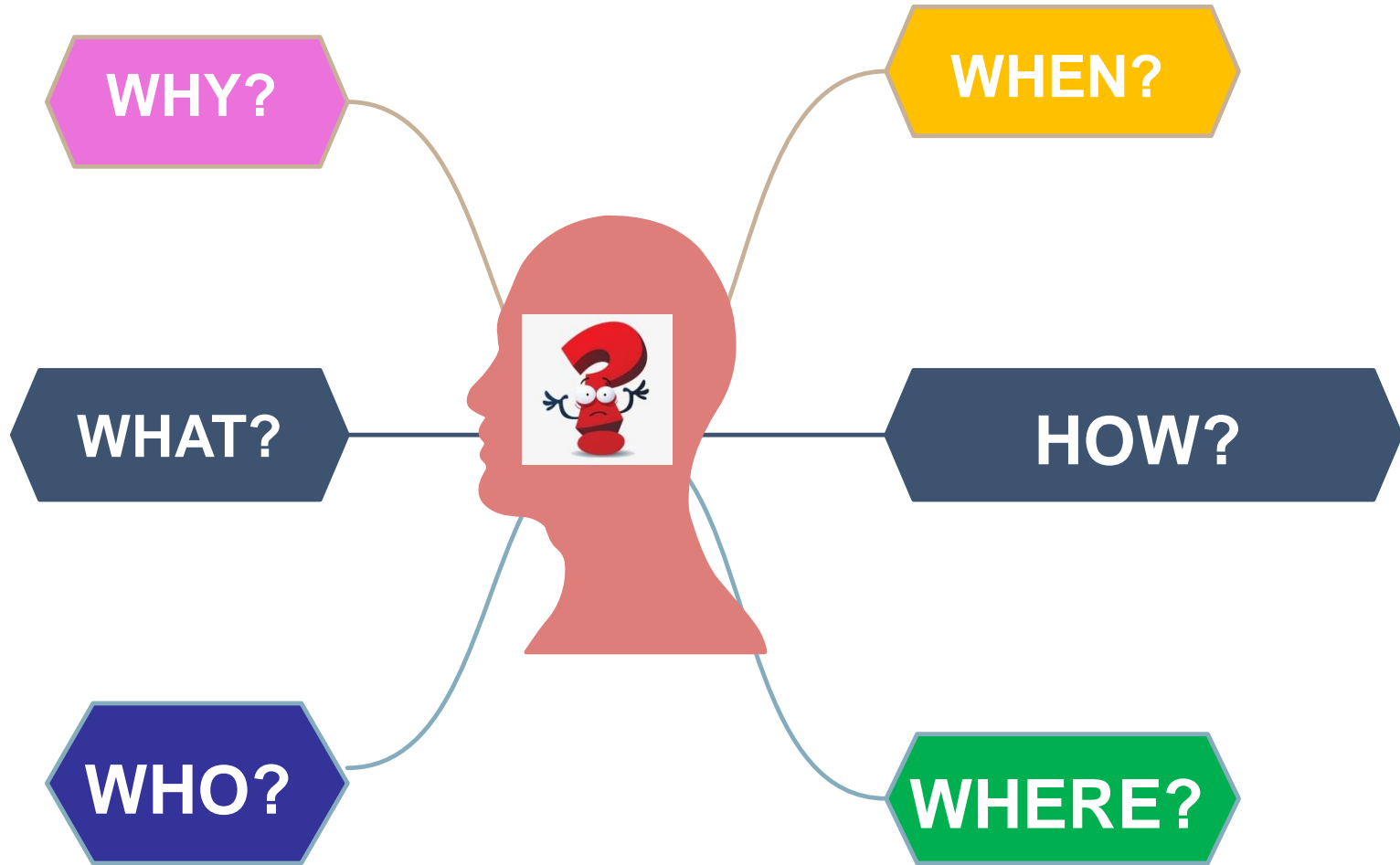




# TRADEMARK REGISTRATION IN VIETNAM REGISTRATION AND PRACTICES

PhD. Ha Nguyet Thu  
National Office of Intellectual Property of Vietnam (NOIP)

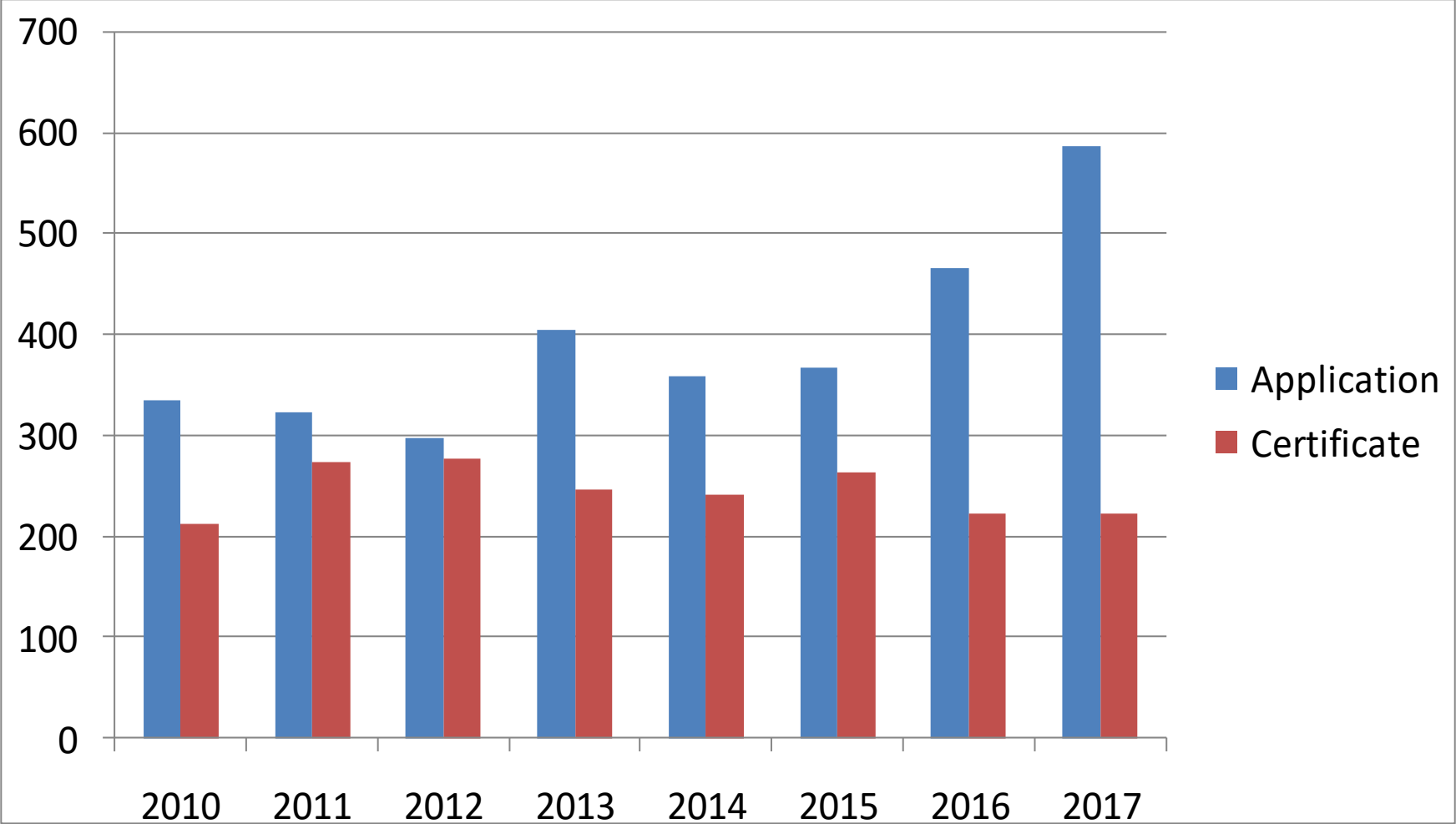
Taiwan, 30 August, 2018





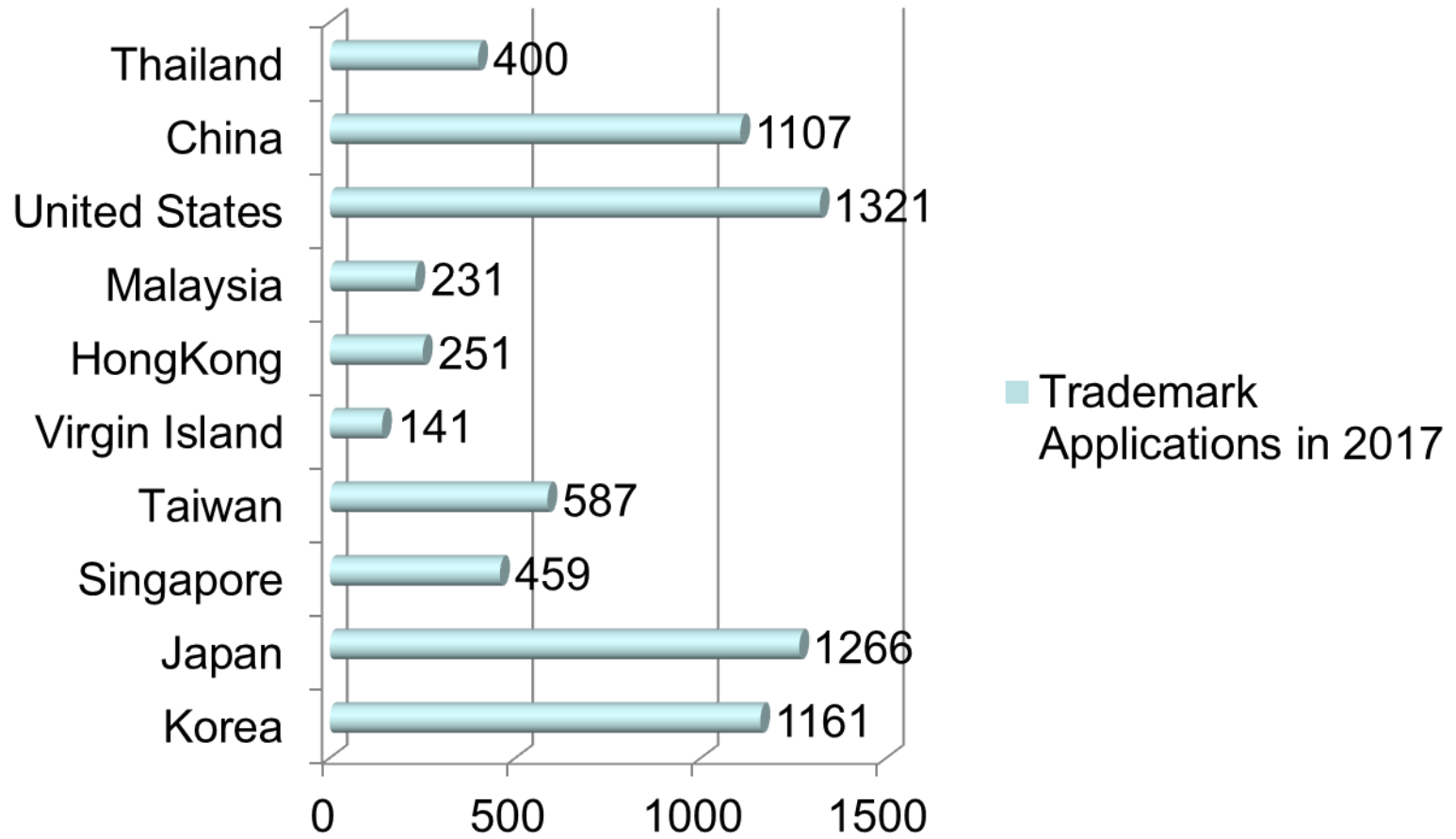
- **1<sup>st</sup>** wave of investment in Vietnam since 1980s, spanning most of the province and covering many industries and economic sector.
- **2.531 FDI projects (\$30.69 billion)**, ranking **4<sup>th</sup>** among 116 economies investing in Vietnam (December 2017)

# STATISTIC OF TRADEMARK APPLICATIONS AND CERTIFICATES OWNED BY CHINESE TAIPEI



# TRADEMARK APPLICATIONS of TOP TEN ECONOMIES DIRECT INVESTMENT IN VIETNAM 2017

## Trademark Applications



# CONTENT



**TRADEMARK – IMPORTANT ASSET FOR INVESTOR**



**BASIC OF TRADEMARK PROTECTION IN VIETNAM**



**REMARKS**



**TRADEMARK – IMPORTANT ASSET FOR INVESTOR**  
**(Why protect?)**

# 1. TRADEMARK – IMPORTANT ASSET FOR INVESTOR

**Forbes**

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**WORLD'S MOST VALUABLE BRANDS 2017**

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	2016		2017	
\$154.1 Bln	1	Apple	1	\$170 Bln
\$82.5 Bln	2	Google	2	\$101.8 Bln
\$75.2 Bln	3	Microsoft	3	\$87 Bln
\$52.6 Bln	5	Facebook	4	\$73.5 Bln
\$58.5 Bln	4	Coca-Cola	5	\$56.4 Bln
\$35.2 Bln	12	Amazon	6	\$54.1 Bln
\$39.5 Bln	8	Disney	7	\$43.9 Bln
\$42.1 Bln	6	Toyota	8	\$41.1 Bln
\$39.1 Bln	9	McDonald's	9	\$40.3 Bln
\$36.1 Bln	11	Samsung	10	\$38.2 Bln

**(Why protect?)**

- ✓ Brand - the most valuable asset of businessman
- ✓ The longer existence the more valuable
- ✓ Best way to protect trademark owners from infringing domestically and overseas

Source: Forbes – The World's Most Valuable Brands 2017 Ranking



# “BUY BACK TIME”

THE BEST BUSINESS IN ASIA 2016

128 billion USD (media)

**184 billion USD (The Asset)**



**14 years**



## **BASIC OF TRADEMARK PROTECTION IN VIETNAM**

## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### DEFINITION

*Mark* means **any sign** used to **distinguish** goods or services of different organizations or individuals

*(Art.4.16 IP Law)*

### GENERAL CONDITIONS FOR MARKS ELIGIBLE FOR PROTECTION

A mark shall be protected when it satisfies the following conditions:

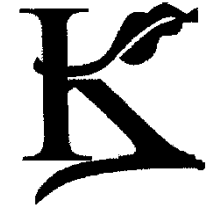
1. Visible sign (not including unconventional trademark)
2. Distinctiveness

*(Art.74.1 IP Law)*

# 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

## COMMON FORMS OF TRADEMARK

-Letters (in “fancy” font)



-Words or phrase (in plain font or “fancy” font)

**JUST DO IT**



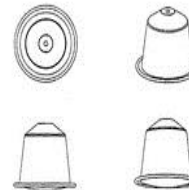
-Drawings



-Images



-3D (holograms)



Or a combination thereof, represented in one or more colors



## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### COMMON FORMS OF TRADEMARK

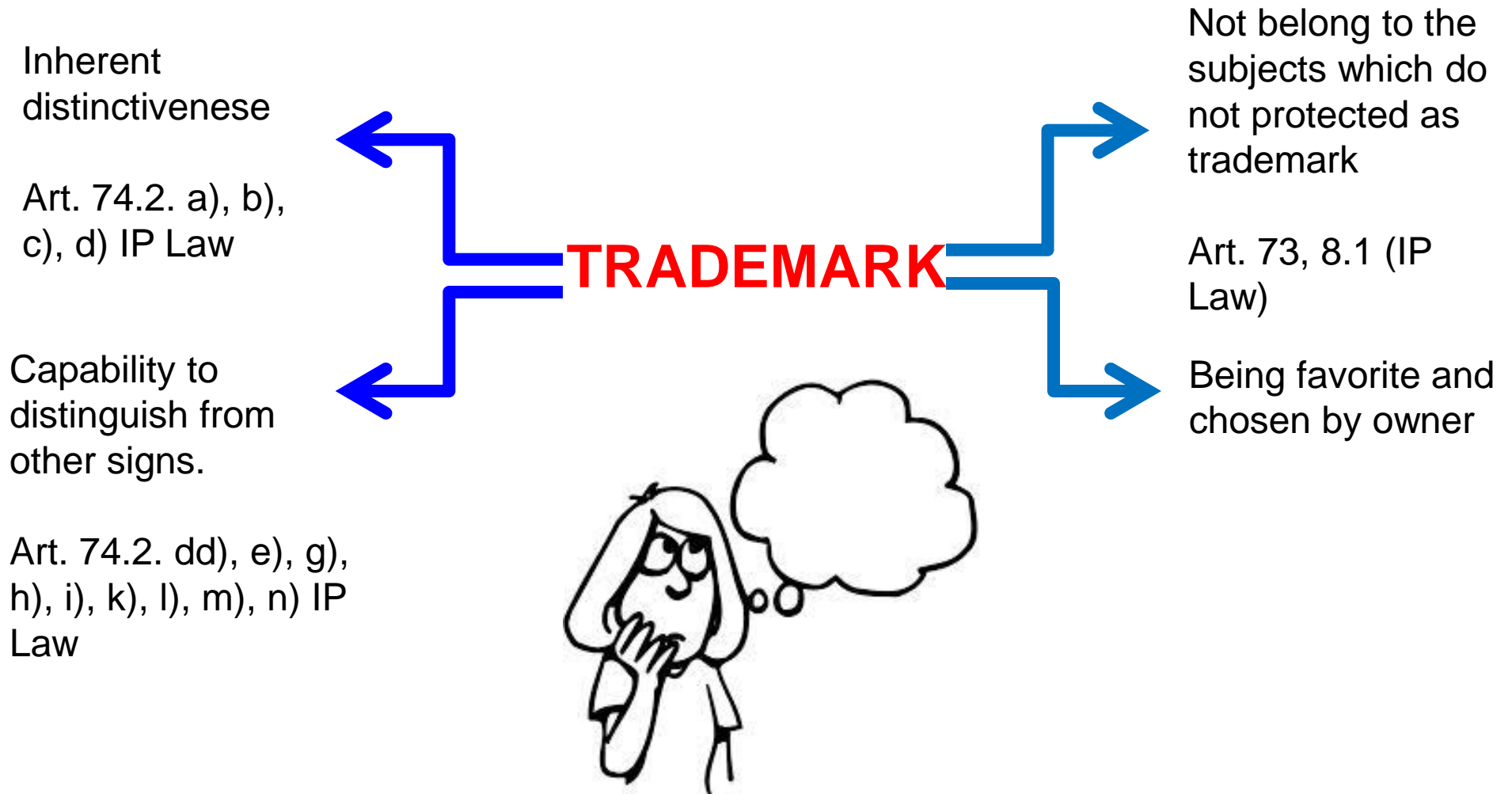
#### -Trademark

-**Collective mark** (used to distinguish goods or services of members from those of non-members of an organization which is the owner of such mark)

-**Certificate mark** (means a mark which is authorized by its owner to be used by another organization or individual, for the purpose of certifying the origin, raw materials, materials, mode of manufacture of goods or manner of provision of services, quality, accuracy, safety or other characteristics of goods or services bearing the mark)

# 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

## HOW TO CHOOSE AN APPROPRIATE SIGN TO BE A TRADEMARK



## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

**Inherent distinctiveness** Art. 74.2. a), b), c), d) IP Law

- Simple shapes/geometric figures/numerals, letters or scripts of uncommon languages
- Conventional signs or symbols, pictures or common names in any language of goods
- Signs which is descriptive of goods
- Signs describing the legal status and business field of business entities;

**Exception:**  
signs have  
acquired  
distinctiveness  
through use



## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Capability to distinguish from other signs

(Art. 74.2. dd), e), g), h), i), k), l), m), n) IP Law)



**TM application**  
**4-2011-17292**



SHANGTSAN

**TM registration**  
**221051**



## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Capability to distinguish from other signs

(Art. 74.2. dd), e), g), h), i), k), l), m), n) IP Law)

#### Signs can not be protected as trademark if



- Indicating the **geographical origin** of goods or services\*
- Conflicting with **registered trademark** of another person
- Conflicting with **unregistered trademark of another person's mark which has been widely used and recognized** for similar or identical goods or services before the filing date or the priority date
- Conflicting with registered trademark of **another person's mark**, the registration certificate of which has been **invalidated for no more than 5 years**
- Conflicting with unregistered/registered trademark of another person's mark which is recognized as a **well-known mark**

## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Capability to distinguish from other signs

(Art. 74.2. dd), e), g), h), i), k), l), m), n) IP Law)

#### Signs can not be protected as trademark if

- conflicting with **trade name** currently in use if the use of such signs may cause confusion to consumers as to the origin of goods or services;
- conflicting with a **geographical indication** being protected if the use of such signs may mislead consumers as to the geographical origin of goods;
- conflicting with **another person's industrial design** which has been protected on the basis of an industrial design registration application with the filing date or priority date earlier than that of the mark registration application.
- conflicting with **another person's copyright work**

## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

**Not belong to the subjects which do not protected as trademark**

Art. 73, 8.1 (IP Law)

**Signs can not be protected as trademark if**

... objects which are contrary to national laws, social morality and public order or harmful to national defence and security.

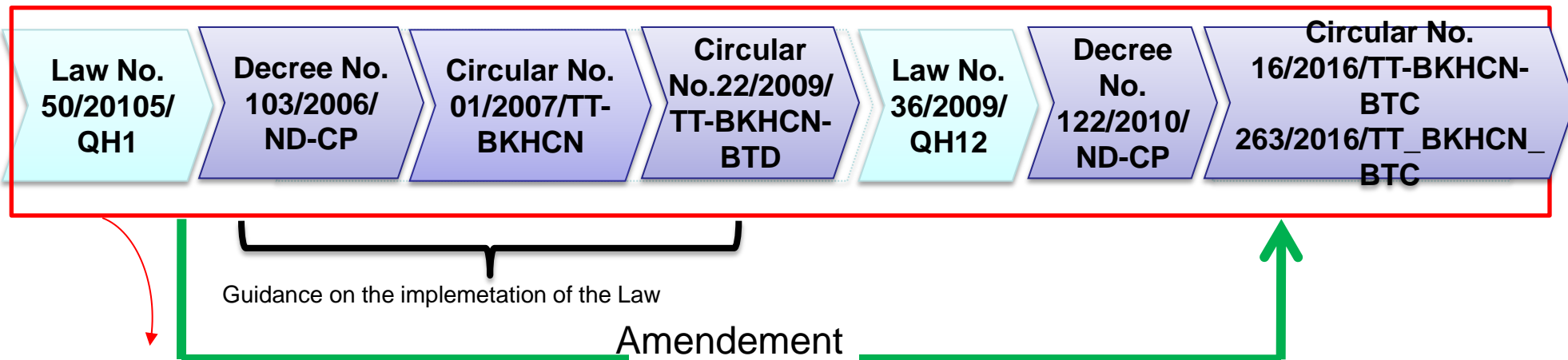
- Signs identical with or confusingly similar to national flags or national emblems or emblems, flags, armorial bearings... of Vietnam or other country ...real names, alias, pseudonyms or images of leaders, national heroes or famous personalities of Vietnam or foreign countries;

- Signs which cause misleading or confusion or deceive consumers as to the origin, properties, intended utilities, quality, value or other characteristics of goods or services...



# 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

## LEGISLATIVE DOCUMENTS



Links

NOIP website:

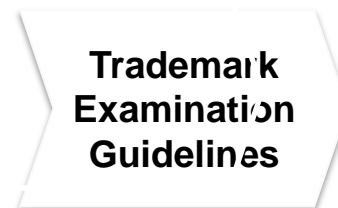
[Law No. 50/2005/QH11 - Vietnamese version](#)

[Law No. 50/2005/QH11 - English version](#)

....

WIPO website:

[All legislative documents - English version](#)



2005

2006

2007

2009

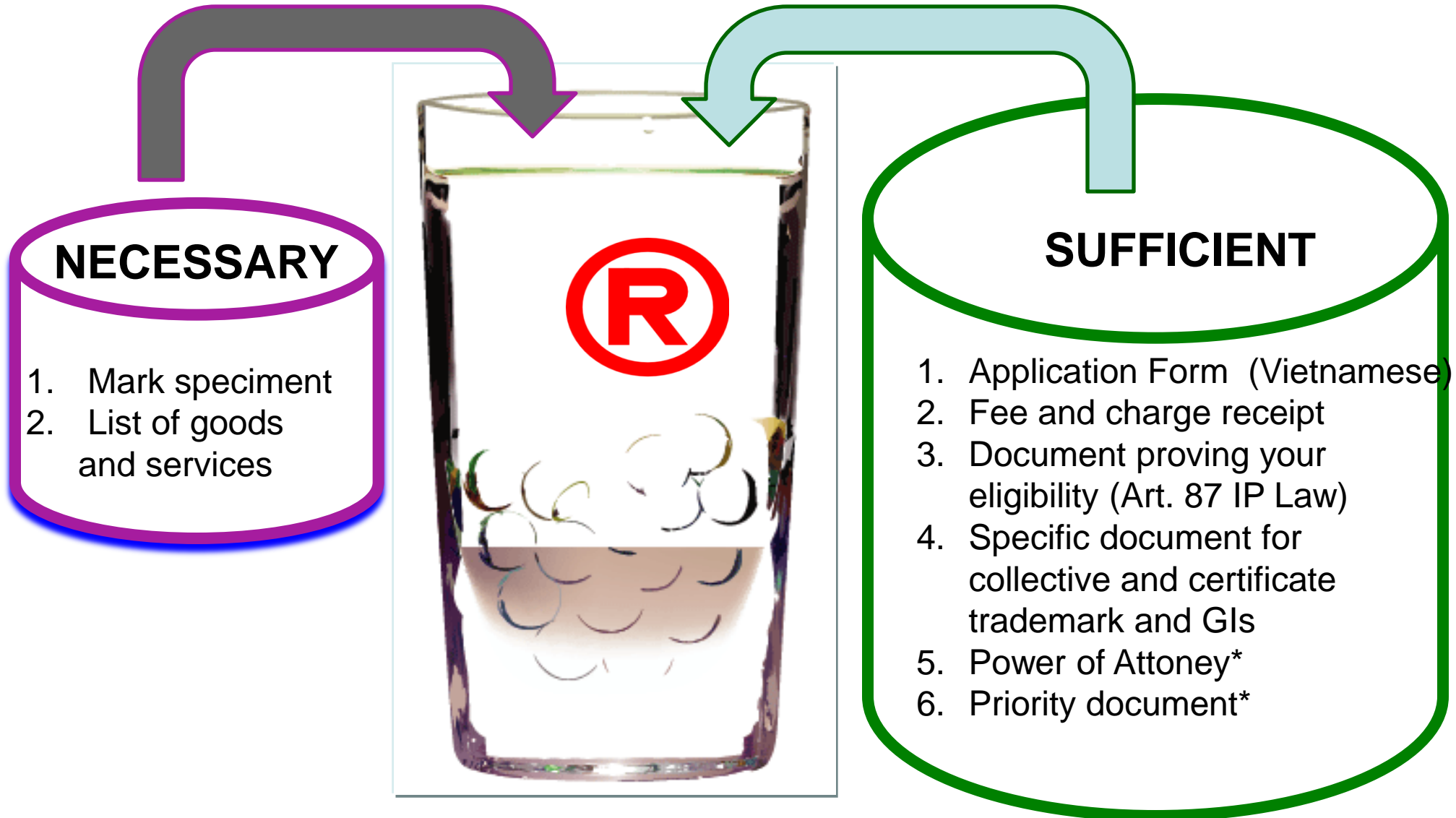
2010

2016



# 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

## NECESSARY AND SUFFICIENT CONDITIONS



## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Representation of a mark

- Clear (including color)
- Marks contain foreign must provide transliteration and translation

The image shows the Chinese characters '皇冠' (Huang Guan) in a bold, stylized font. The character '皇' (Huang) is on the left and '冠' (Guan) is on the right. Below the characters, the words 'TUNG YUAN' are written in a bold, sans-serif font.  
**TUNG YUAN**

The image shows the Japanese characters 'サロンプア' (Saronpasu) in a bold, stylized font. The characters are 'サ' (Sa), 'ロ' (Ro), 'ン' (N), and 'パ' (Pa).  
**サロンプア**

## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### **List of goods/services**

- Must be clear to specify the goods and services
- Multiple classes in one application is accepted
- NICE classification: Not member of Nice Agreement but follow it



## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Power of Attorney

- Can be in English but must translate in to Vietnamese
- Can reauthorize (more than one time) with the application's owner consent

### Registration Rules

- "First to file"
- Priority



## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Grounds for establishment of industrial property rights

- Registration system
- Exception: wellknown trademark (Industrial property rights to well-known marks shall be established on the basis of their actual public use that has made them well known, )



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### Grounds for establishment of industrial property rights

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## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

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### *Term and scope of protection*

- *Term of protection*: 10 years. This term may be extended successively every ten year via application for renewal

- ***Scope of protection***

+ In the whole territory of Vietnam

+ According to the contents of the protection title

Trademark owner

Trademark specimen

List of goods and services

Disclaimer

Time of protection



**Certificate No: 213100**

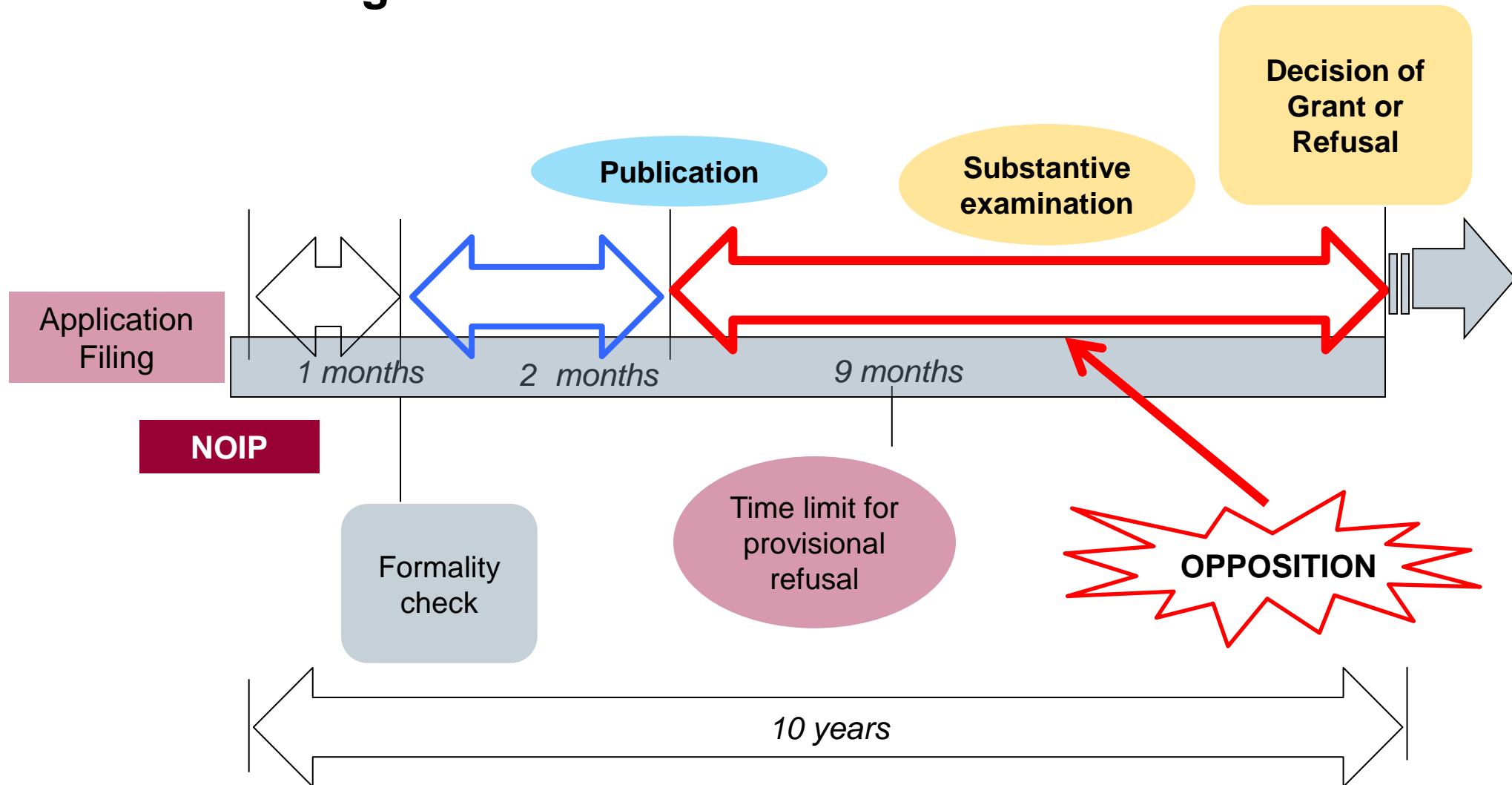
No claim is made to the exclusive right to use "made in Taiwan", Taiwan map" apart from the mark as shown.

## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

<b>Fees and Charges</b>	<b>VND</b>
First class (no more than 6 products or services )	1.000.000
From the second class	730.000
The seventh products or service and more (each class)	150.000
Certificate fee	120.000
From the second class (each class)	100.000
Classification fee (no more than 6 products or services )	100.000
From the seventh product or service (each product or service)	20.000
Opposition fee	550.000
Amendment application fee	160.000
Transfer application fee	160.000
Using protection title fee (1 class/10 years)	700.000

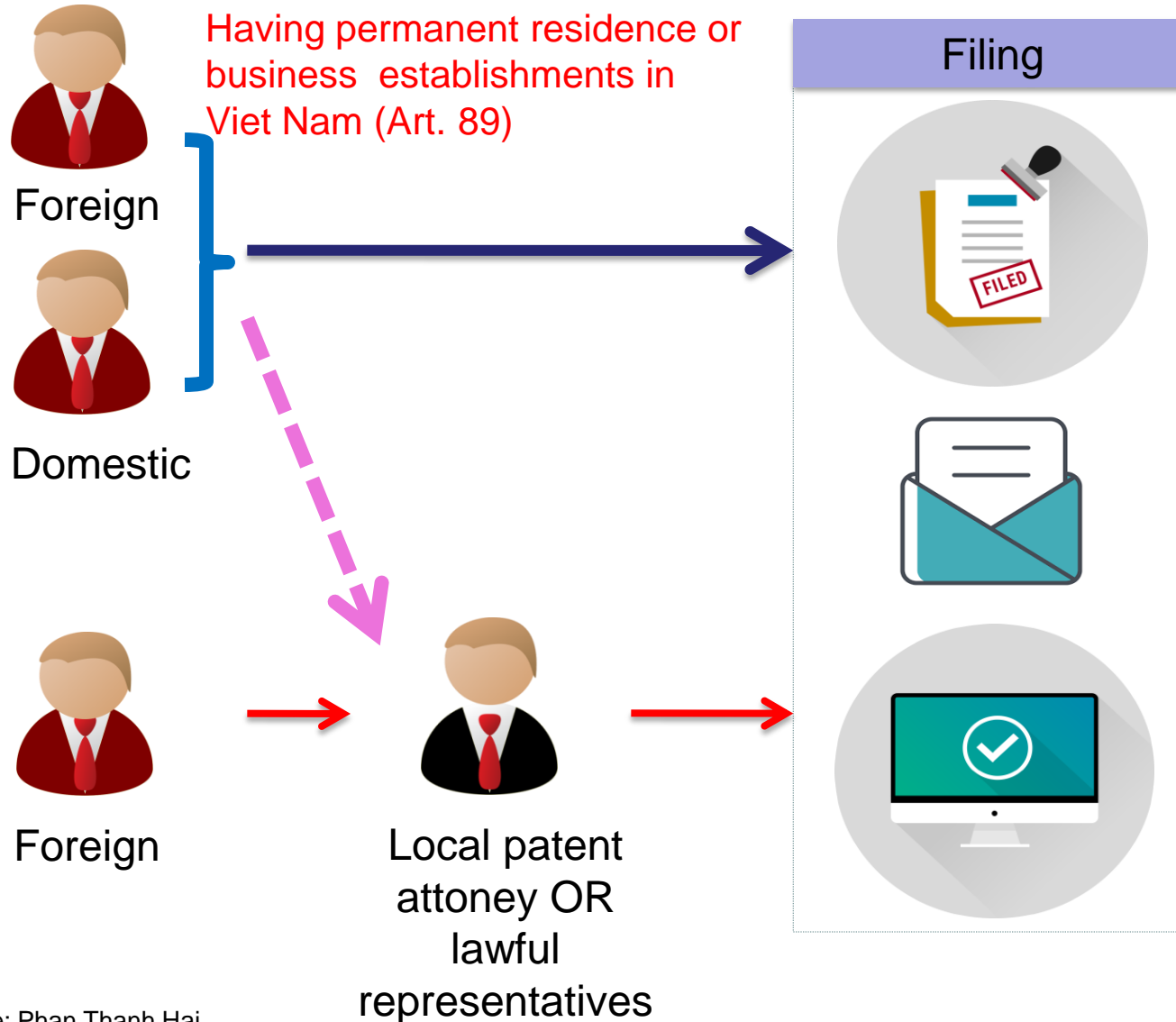
# 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

## Trademark Registration Route

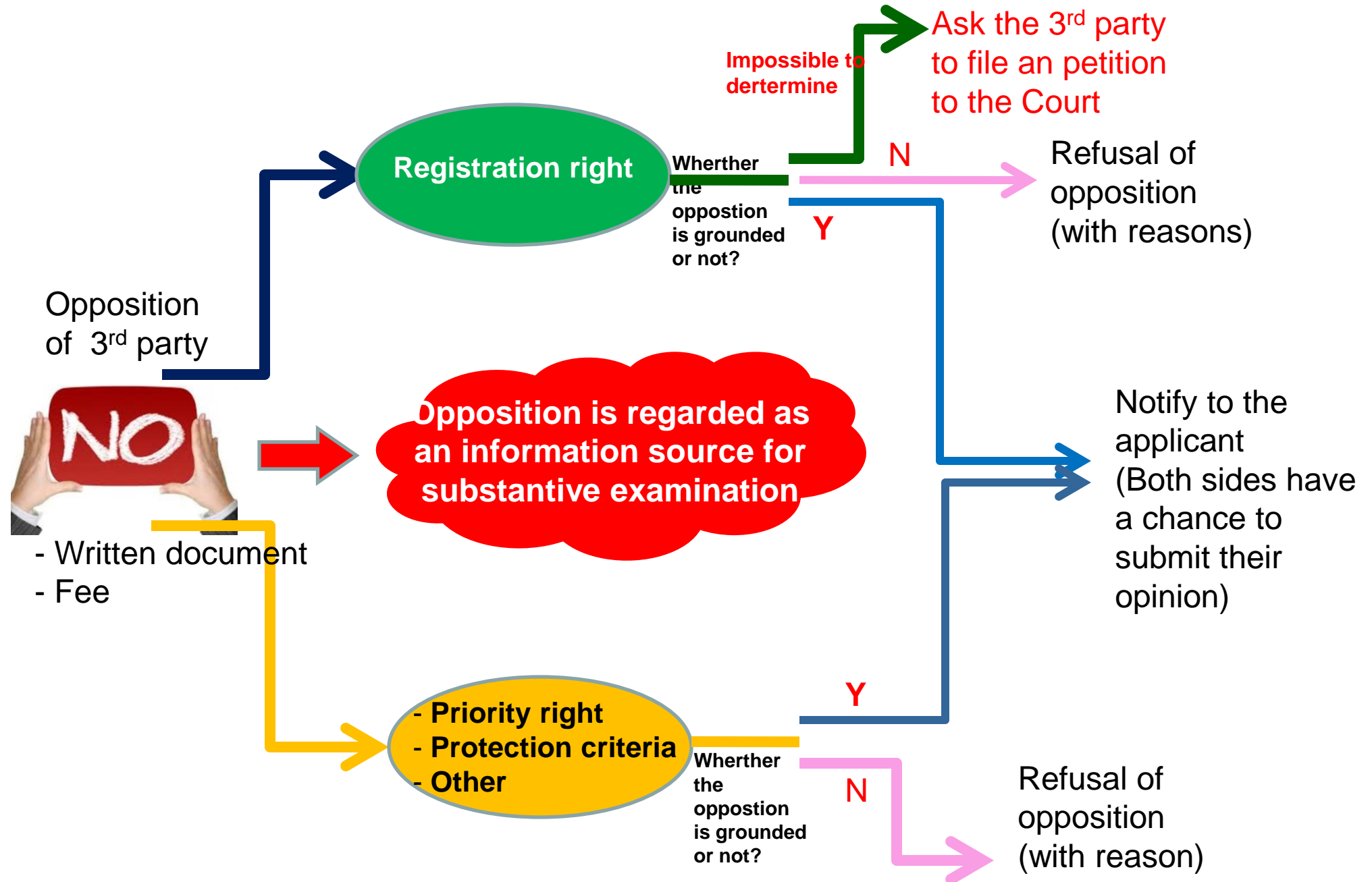


# 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

## MODES OF FILING TRADEMARK REGISTRATION



# OPPOSITION (Art.112 IP Law )





## **2. BASIC OF TRADEMARK PROTECTION IN VIETNAM**

### **Withdrawal of industrial property registration applications**

- When: Before final decision is issued (refusal or grant)
- Who: By applicant or through his representative (authorization document is required)
- How: written document
- Result: be considered having never been filed (exception of priority right claims)

## **2. BASIC OF TRADEMARK PROTECTION IN VIETNAM**

### **Amendment, supplementation of application**

- When: Before final decision is issued (refusal or grant)
- Conditions: must not expand the scope of the subject matter already disclosed or stated in such application and must not change the nature of the subject matter subject to registration stated in the application and must ensure the uniformity of the application.
- Fees and charges are required.

***Art. 115 IP Law***

## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Division of application

- Who: applicant by his-self or examiner's request
- When: Before final decision is issued (refusal or grant)
- How: written document
- Result: the filing date of the divided application shall be determined to be the filing date of the original application.

*Art. 115 IP Law*

## 2. BASIC OF TRADEMARK PROTECTION IN VIETNAM

### Invalidation of protection titles

- Who can apply for invalidation: any person
- Type of invalidation: entire or partial
- Reason for invalidation:
  - ✓ The registration applicant has neither had nor been assigned the right to register a mark;
  - ✓ The subject matter of industrial property fails to satisfy the protection conditions at the time the protection title is granted.
  - ✓ A protection title shall be partly invalidated when that part fails to satisfy the protection conditions.
- For marks, 5 years from the grant date, except where the protection title has been granted due to the applicant's dishonesty.
- Fees and charge are required

# HEAD QUARTER, BRANCHES AND STAFFS



Place	Number
Ha Noi	321
Da Nang	04
Ho Chi Minh	10
Total	335





## REMARKS

**ReMark**

# WHY TO FILE TRADEMARK APPLICATION

## TRADEMARK REGISTRATION

- Is it prohibited?
- Why?
- When?

**NOT REQUIRE  
BUT  
NECESSARY  
AND  
THE SOONER, THE BETTER**

- Legal safety.
- Best way to protect trademark owners from infringing domestically and overseas.

Trung Tam Huan Luyen Day Nghe  
Dai Loan

台灣職業訓練中心  
TAIWAN VOCATIONAL  
TRAINING CENTER





龍爵士

LONG

JUE

SHI

龍爵士

LONG JUE SHI



NOIP website: <http://www.noip.gov.vn/>



# MESSAGE



**DARE 2B** **DIFFERENT IN**  
**Bussiness-**

THANK YOU

