

Vietnam IP News Bulletin

Kenfox IP & Law Office

March 2019

AMENDING A TRADEMARK BEFORE AND AFTER REGISTRATION IN VIETNAM/ RECORDAL OF CHANGE FOR TRADEMARK OWNER'S NAME/ADDRESS IN VIETNAM

1. Please advise if we can amend our trademark before and after registration in Vietnam.

KENFOX: Article 97 of the Vietnam IP Law: [The owner of a protection title may request the State administrative body for industrial property rights to make amendments to the following information in such protection title, provided that the prescribed fees and charge are paid: (a) Changes of, and corrections of errors to the name and address of the author or the protection title owner;]

Article 17.1c & 20.1b of Circular No. 01/2007/TT-BKHHCN:

17.1 Amending applications: [*c. The amendment to an application must not expand the scope of protection (volume) disclosed in the description, for the application for invention registration, in the description and sets of photos/drawings, for the application for industrial design registration, in the trademark and in the list of goods and services, for the application for trademark registration, and must not change the nature of the object stated in the application. The adjustment expanding the scope of protection (volume) or changes the nature of the object shall not be accepted. The applicant shall file a new application and all procedures shall be carried out anew*].

20.1 Adjustments to information specified in the protection certificate and narrowing of the

scope of the protection: [*b. Request for narrowing of the protection scope. The protection certificate holder may request the Vietnam IP Office to narrow the protection scope as prescribed in Article 3, Article 97 of the Law on Intellectual Property in the following cases: (i) Request for adjustments to some details without any substantial change in the trademark specimen stated in the certificate of trademark registration; (ii) Request for exclusion of one or several goods or services or groups of goods or services on the list of goods and services specified in the certificate of trademark registration without any change in the trademark specimen*];

Generally, amending a trade mark before and after registration is acceptable, provided that such amendment does not extend the scope of the application as initially filed. In practice, in case the amendment affects the trademark samples, such an amendment will be subject to a strict examination by the Vietnam IP Office, and the Vietnam IP Office just accepts slight amendment of the trademark sample, which does not cause any substantial change thereto.

2. What are required documents for recordal of the trademark owner's name/address change in Vietnam? Important notes?

KENFOX: The following documents are required to record the trademark owner's name/address change in Vietnam:

- (i) 01 original Power of Attorney ("PoA") by the proprietor; Please note that the PoA is not required to be notarized.
- (ii) Original Trademark Registration Certificate(s);
- (iii) Notarized Statutory Statement.

Important note:

- It may take around 03-05 months to complete the change of name and/or address of the trademark holder in Vietnam.
- The change in respect of the company name/address is recorded for EACH trademark application/registration

3. Can an applicant amend its assertions/grounds in its appeal request in a course of appeal request procedure? If possible, by when and to what extent?

If the assertions/grounds in the appeal request amended by the applicant are considered as “new facts” that have not been submitted during the examination progress, which can change the appealed notice/decision, such amended assertions/grounds will not be accepted for examination by the examiner (*see Point 21.1.c(ii) of Circular No. 16/2016/TT-BKHHCN*). Thus, amended assertions/grounds should not be made to such an extent that they are considered being “new facts” added to the filed appeal.

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*Should your clients be interested in IP protection in the above-mentioned jurisdictions, please feel free to **contact us**.*