



Vietnam IP News Bulletin

Kenfox IP & Law Office

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A LETTER OF CONSENT TO OVERCOME A REFUSAL AGAINST A TRADEMARK APPLICATION IN VIETNAM

1. Whether we can use a "letter of consent" to overcome a refusal against a trademark application in Vietnam?

KENFOX: Statutorily, Vietnam does not adopt consent letter regime to exclude the likelihood of confusion. Still, in practice, the examiners could accept such letter on case-by-case basis. Basically, in the presence of the consent letter, the examiners tend to afford registration to the applied mark if the mark and the cited marks are neither identical nor closely similar

2. Can the Vietnam IP Office's examiner has the power to reject/ignore a letter of consent in case the marks and the goods/services are identical or similar which may cause confusion?

KENFOX: As mentioned above, the examiners could accept such letter on case-by-case basis. Letter of consent is accepted in case the confusion is not likely to be happened. In a broader sense, if the two trademarks at issue are very similar (nearly identical) so that consumers always believe they are offered from the same source (same trademark owner), the letter of consent shall not be accepted. However, such letter of consent is highly likely to be accepted in case trademarks are considered similar (not very similar or nearly identical) and the goods/services bearing the mark are similar.

3. Whether the letter of consent must be notarized/legalized to be accepted in Vietnam?

KENFOX: As a matter of practice, the letter of consent must be notarized so that it may be treated as a legally valid document.

4. What remedies are available for overcoming conflicting citations in case a letter of consent is not accepted in Vietnam?

KENFOX: Per Article 74, 95 and 96 of the IP Law of Vietnam.

Subject to particular facts of each case, some below options may be taken into account to overcome the citation in case the letter of consent is not accepted:

- (i) Arguing on the dissimilarity between the mark at issue and the citations;*
- (ii) Taking 5-year non-use cancellation against the citations in case the citations are found non-used in Vietnam for the past 5 years;*
- (iii) Taking invalidation action against the citations in case there is evidence available on that the citations did not meet the protection requirements at the time of granting.*

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