



Vietnam IP News Bulletin

Kenfox IP & Law Office

March 2019

TRADEMARK ASSIGNMENT RECORDAL IN VIETNAM

1. Could you tell us whether it is possible to assign pending trademark applications whose condition is general assignment of rights in Vietnam?

KENFOX: Article 115.1d, the Law on Intellectual Property of Vietnam 2005, revised in 2009 ("IP Law 2005"): *"An applicant shall have the following rights before the competent State administrative body for industrial property rights notifies a refusal or decides to grant a protection title: [...] (d) To request the recording of change of the applicant as a result of application transfer under a contract, bequest or inheritance, or under a decision of a competent agency."*

Article 17.4 of Circular No. 01/2007/TT-BKHCN provides that *"Before the Vietnam IP Office issues any of notices specified at Point 17.1.a of this Circular, an applicant may request the Vietnam IP Office to record the transfer/assignment of his/her application to another person. Requests for recording of the transfer/assignment shall be made according to a set form (not printed herein) and relevant provisions of Point 17.1 of this Circular, and must contain documents proving that the transferee satisfies the requirement on the right of registration."*

We understand that your question implies an assignment of the whole (not part of) applications. If our understanding is correct, please be advised that under the laws of Vietnam, assignment of the whole pending applications is possible. Nevertheless, kindly note that in the assignment document, particulars of the pending applications to be assigned must be explicitly stated.

Otherwise, the assignment document is not acceptable for recording the assignment in Vietnam.

To record assignment of a pending trademark application, the agreement/contract on such assignment must comprises certain provisions legally required (e.g. full name & address of the assignor and assignee, grounds for assignment, assignment price, rights and obligations of the assignor and the assignee)

2. Whether it is possible to assign pending trademark applications whose condition is limited assignment of rights in Vietnam?

KENFOX: Per Article 115.1d, the Law on Intellectual Property of Vietnam 2005, revised in 2009 ("IP Law 2005"): *"An applicant shall have the following rights before the competent State administrative body for industrial property rights notifies a refusal or decides to grant a protection title: [...] (d) To request the recording of change of the applicant as a result of application transfer under a contract, bequest or inheritance, or under a decision of a competent agency."*

Article 17.4 of Circular No. 01/2007/TT-BKHCN provides that *"Before the Vietnam IP Office issues any of notices specified at Point 17.1.a of this Circular, an applicant may request the Vietnam IP Office to record the transfer/assignment of his/her application to another person. Requests for recording of the transfer/assignment shall be made according to a set form (not printed herein) and relevant provisions of Point 17.1 of this Circular, and must be contain documents proving that the transferee satisfies the requirement on the right of registration."*

We understand that your question concerns a partial assignment of the pending applications (e.g. assignment of one or two classes in a multi-class application) in Vietnam. If our understanding is correct, please be advised that under the laws of Vietnam, assignment of part of the pending applications is possible. However, please note that in the assignment document, particulars of the pending applications to be assigned, and the classes of goods/ services subject to the assignment must be explicitly stated. Otherwise, the assignment document is not acceptable for recording the assignment.

Prior to assignment of part of the pending applications, first of all, the applications must undergo

division procedure of the application (divide the application into different applications) and then, trademark assignment will be accepted for recordal.

3. Could you tell us if it is possible to assign trademark registrations whose condition is general assignment of rights in Vietnam?

KENFOX: Article 138, 139 and 140 of Vietnam IP Law.

We understand that your question implies an assignment of the whole (not part of) trademark registrations. If our understanding is correct, please be advised that under the laws of Vietnam, assignment of the whole trademark registrations is possible. Nevertheless, kindly note that in the assignment document, particulars of the trademark registrations to be assigned must be explicitly stated. Otherwise, the assignment document is not acceptable for recording the assignment in Vietnam. In addition, it is noteworthy that per Article 139.4 of the IP Law 2005, the assignment over trademarks shall not cause any confusion as to characteristics and origins of the goods/ services under the assigned trademarks. Practically, this requirement is applicable for assignment of registered trademarks only, not pending applications.

To record assignment of a pending trademark application, the agreement/contract on such assignment must comprises certain provisions legally required (e.g. full name & address of the assignor and assignee, grounds for assignment, assignment price, rights and obligations of the assignor and the assignee)

4: Is it possible to assign trademark registrations whose condition is limited assignment of rights in Vietnam?

KENFOX: We understand that your question concerns a partial assignment of the trademark registrations (e.g. assignment of one or two class in a trademark registration). If our understanding is correct, please be advised that under the laws of Vietnam, assignment of part of trademark registrations is possible. Nevertheless, kindly note that in the assignment document, particulars of the trademark registrations to be assigned , and classes of goods/ services subject to the assignment must be explicitly stated. Otherwise, the assignment document is not acceptable for recording the assignment. In addition, we note that under Article 139.4 of the IP Law 2005,

the assignment over trademarks shall not cause any confusion as to characteristics and origins of the goods/ services under the assigned trademarks. Practically, this requirement is applicable for assignment of registered trademarks only, not pending applications.

5. Whether partial assignment of a specific class is available to assist trademark registrations in Vietnam?

KENFOX: Yes, partial trademark assignment is possible in Vietnam. Partial assignment of a specific class is available/possible to assist trademark registration in case a pending application is refused for protection due to a conflicting class of goods/service in a prior trademark registration.

6. Is partial assignment of specific goods and/or services available in Vietnam to assist trademark registrations?

KENFOX: Yes, partial trademark assignment is possible in Vietnam. Partial assignment of specific goods/services is available/possible to assist trademark registration in case a pending application is refused for protection due to a number of conflicting goods/services in a prior trademark registration.

7. Can the Vietnam IP Office's examiner reject assignment of similar marks used on similar goods/services and request to assign the marks owned by the same owner?

KENFOX: Article 139.4 of the IP Law of Vietnam on restrictions on assignment of industrial property rights provides that "*The assignment of the rights to marks must not cause confusion as to properties or origins of goods or services bearing such marks*". So, in light of Article 139.4, the IP Law 2005, in case of various similar marks for similar goods/ services in the name of one owner, subject to the Vietnam IP Office's assessment on whether the similarity of marks and/or goods/services may cause confusion once some of these similar marks are assigned, the Vietnam IP Office may request an assignment of all similar trademarks to avoid causing any confusion.

8. Can the Vietnam IP Office's examiner reject assignment of similar marks used on similar goods/services and invalidate the assignment after the procedure has been completed?

KENFOX: Article 139.4 of the IP Law of Vietnam on restrictions on assignment of industrial property rights provides that "*The assignment of the rights to marks must not cause confusion as to properties or origins of goods or services bearing such marks*".

In principle, trademark assignment must not cause confusion as to properties or origins of the goods/services bearing the marks. Thus, in case there are various registrations for similar marks in the name of the same owner, all such trademark registrations are requested by the Vietnam IP Office to be assigned to avoid causing confusion to consumers. If only some of the trademarks are assigned, and the process for recording the assignment at the Vietnam IP Office has been completely, a third party may request the Vietnam IP Office to invalidate the said assignment recordal on a ground that such assignment caused confusion to the public, and was made in contrary to Article 139.4 of the IP Law 2005. If the third party's arguments are found grounded, the Vietnam IP Office shall invalidate the assignment recordal, and those trademarks subject to the assignment will be returned to the ownership of the assignor.

9. Must all identical or confusingly similar trademarks in relation to the same goods or services be assigned to the same owner under the laws of Vietnam?

KENFOX: Article 139.4 of the IP Law of Vietnam on restrictions on assignment of industrial property rights provides that "*The assignment of the rights to marks must not cause confusion as to properties or origins of goods or services bearing such marks*". In principle, trademark assignment must not cause confusion as to properties or origins of the goods/services bearing the marks. Thus, all identical or confusingly similar trademarks in relation to the same goods or services must be assigned to the same assignee.

Copyright © 2019 by CHU THANH TU, Trademark Manager at KENFOX IP & LAW OFFICE. No part of this publication may be reproduced, distributed, or transmitted in any form or by any means, including photocopying, recording, or other electronic or mechanical methods, without the prior written permission of the publisher, except in the case of brief quotations embodied in critical reviews and certain other noncommercial uses permitted by copyright law.

KENFOX IP & Law Office, is one of the leading IP law firms providing a full spectrum of IP related services in **Vietnam**, **Laos**, **Cambodia** and **Myanmar**. With a team of fully qualified and experienced attorneys and specialists in the IP field and such key technology fields as: *Biology, Biomedical Engineering, Chemical Engineering, Chemistry, Civil Engineering, Computer Science, Electrical Engineering, Mechanical Engineering, Electronics, Pharmacy or Telecommunication, etc.*, we take great pride in providing a wide range of discerning clients around the world with professional and high quality services vis-à-vis establishing and enforcing IP rights in the above jurisdictions.

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