

Vietnam IP News Bulletin

Kenfox IP & Law Office

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USE OF THE TRADEMARK SYMBOLS IN VIETNAM

1. In some countries to display the symbol ® or TM on the trademarks so to be fully protected; i.e: initiating opposition proceedings/ profit recovery or damages. Please advise us under the laws of Vietnam if it is obligatory to use the symbols on the trademarks and the consequences for failure to do so.

KENFOX: No regulations on compulsory use of the symbol ® or TM on the trademarks to indicate the status of a trademark in Vietnam. Thus, in case a trademark is already registered in Vietnam, it is not is mandatory to use the symbols ® or TM on the trademark and there is no consequence for failure to do so. In other words, the registered trademark is still fully protected without displaying the symbols ® or TM.

2. What are consequences if we use the symbol ® and TM although the mark in question has not been registered in Vietnam.

KENFOX: If a trademark has not been registered in Vietnam, even if the same has been registered in other countries, the act of using the symbol ® is considered as “Providing **false indications** on the legal status of IP rights” under Article 7, Circular 11/2015/TT-BKHCN as below:

“1. Act of false indication of legal status specified at Point b, Clause 1, Article 6 of Decree No. 99/2013/ND-CP shall be understood as the use of indicative information misleading that a subject enjoys the industrial property rights protection in Vietnam though he/she/it is not or has

not been eligible for protection, including the case where he/she/it has filed a registration application but is not yet granted a protection title or his/her/its protection title has been revoked or invalidated, or the term of protection has expired, for example:

a/ Printing on his/her/its products, goods, goods packages, means of business or means of services an indication misleading that such products, goods or services bear protected marks, such as “mark registered for protection,” “protected mark,” “mark under exclusive right of...,” including the use of the symbol ® (indicating that a mark has been granted a registration certificate);”

Acts of providing false indications on the legal status of IP rights are administratively sanctioned per Article 6, Decree 99/2013/ND-CP. Sanctioning forms imposed on the infringer are as follows:

- A warning or a fine of between VND 500,000 and 1,000,000 if the infringer is an individual. The fine for the entity is doubled.
- Forcible removal of infringing elements on goods or means of business.
- Forcible public correction of errors.

Regarding the symbol TM, we find that the entities doing business in Vietnam use it for the unregistered trademarks. However, given that the meaning of this symbol is not provided in the laws of Vietnam, use of such symbol may cause no risks.

3. If our trademarks have been registered in Vietnam, what are the consequences if we omitted the symbols on the trademarks (despite having the trademarks already registered)?

KENFOX: As advised in question 1 above, no legal consequence for the trademark owners results from failure to use the symbols ® or TM on the trademark, although the mark has been registered in Vietnam.

4. Whether the goods produced in Vietnam for export only subject to be deemed as “providing false indications on the legal status of IP rights” if the trademark affixed to the “manufactured-for-export-only” goods has not been registered in Vietnam?

KENFOX: For the goods produced in Vietnam for export: if the product is produced for

exportation only and not marketed in Vietnam, the regulations on “*providing false indications on the legal status of IP rights*” will not be applied.

5. Whether the goods imported into Vietnam subject to be deemed as “providing false indications on the legal status of IP rights” if the trademark affixed thereto has not been registered in Vietnam?

KENFOX: For the imported goods, if a trademark has not been registered in Vietnam, act of affixing the symbols ® may imply that such a mark has been registered in Vietnam. Thus, such act of use may be deemed as “providing false indications on the legal status of IP rights” per Article 7, Circular 11/2015/TT-BKHCN and be sanctioned under Article 6, Decree 99/2013/ND-CP.

6. Advise us the advantages using a designation such as “registered trademark” in connection with designated goods or services.

KENFOX: Use of the trademark symbol “®” in Vietnam when a mark matures into registration may help remind the public of trademark ownership, thereby warn against possible trademark infringement.

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.