

Vietnam IP News Bulletin

Kenfox IP & Law Office

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OTHER TRADEMARK RELATED QUESTIONS IN VIETNAM

1. Is "expedited examination" available/adopted in Vietnam?

KENFOX: There is no explicit regulation on the matter. In the past, the Vietnam IP Office, on case-by-case basis, allowed an expedited examination over a trademark application. At present, the IP Office may accept fast-track trademark examination for special cases with the imperative reasons. This needs to be approved by Director and Manager of Trademark Department of the IP Office of Vietnam.

2. Which edition of NICE Classification is adopted in Vietnam now?

KENFOX: Vietnam has adopted the international classification of goods and services for the purposes of trademark registration although it is not a member of the Nice Agreement. Vietnam currently adopts the 11th edition of the Nice Classification system.

3. Is the wording in the "class headings" of the NICE Classification acceptable in all classes?

KENFOX: Class headings or general description of goods/services is not acceptable. For the purpose of calculation of fees, the description of goods/services must be sufficiently specific. In other words, the goods and services under any applications must be listed into specific items, preferably using the terms guided in the Alphabetical List of the Nice Classification.

4. How long does it take to receive an examination report on a trademark application in Vietnam?

KENFOX: Under IP Law 2005, a trademark application must undergo 02 phases of examination, namely formality examination (in 1 month from the filing date) and substantive examination (in 9 months from the publication date), making the total time for examination of a trademark application, including publication, be roughly 12 months from filing. However, in practice, the examination is often prolonged 15-18 months or even more.

5. How long does it take to achieve a trademark registration in Vietnam after trademark filing?

KENFOX: In case the trademark is concluded to be registrable, the applicant will be invited to pay the granting fee in one (1) month from the date of notification. Registration can be issued in 10 days from the date of payment of the granting fee. Hence, under the laws, total time from filing till receiving a registration, in a smooth case, is approx. 13-14 months. In practice, the said timeline may be prolonged to 15-18 months.

6. Will there be a deadline to respond to an office action? If yes, please indicate the usual deadline.

KENFOX: Subject of the type of office action, a different deadline will be set forth by the Vietnam IP Office.

For an office action on formality examination, the applicant must submit a response within 02 months from the date of the Vietnam IP Office's Notification.

For an office action on substantive examination, the applicant is required to submit a response within 03 months from the Vietnam IP Office's Notification.

7. Is it possible to extend the deadline to respond to the office action? If yes, please indicate the number of allowed extensions and durations.

KENFOX: Under Article 9.2 of Circular No. 01/2007/TT-BKHCN, it is possible to extend the

deadline to respond to the office action. The time-limits stipulated for an applicant and related parties to lodge, amend or supplement documents or to provide opinions may be extended by the same period as is stipulated for the fixed time-limit, on condition that the person requesting the extension of time lodges a written request prior to expiry of the fixed time-limit and pays any fees required by the regulations. However, the laws are silent on the number of allowed extensions. The NOIP will consider the request of extension and accept it on case-by-case basis.

8. Could "lapsed trademarks" be cited against a new application?

KENFOX: Article 74.2h, the IP Law 2005: *[A mark should be refused for protection if it is] Signs identical with or confusingly similar to another person's mark which has been registered for identical or similar goods or services, the registration certificate of which has been invalidated for no more than five years, except where the ground for such invalidation was non-use of the mark pursuant to sub-clause (d) of article 95.1 of this Law.]*". Thus, in case a trademark is lapsed after it is examined, it will not be cited against a later-filed similar mark. However, if a registered trademark is lapsed by non-renewal, it can be still a citation against a later-filed similar mark in 5 years from the date of its expiry.

9. Disclaimer related matters in trademark protection in Vietnam

KENFOX: Point 14 of Circular No. 16/2016/TT-BKHCN (effective as of 15 January 2018): *[If the trademark has elements ineligible for separate protection (to be disclaimed), the notice shall specify that the application is granted, explain ineligibility for separate protection, and that the applicant may express his/her opinion within 03 months]*.

In view of the foregoing, the applicant has rights to challenge/object to disclaimer entries. In case of disclaimer, the IP Office of Vietnam must explicitly state the intention and reason for such disclaimer and the applicant is entitled to state its opinion regarding such disclaimer within three (03) months from the notification date.

10. Does the Vietnam IP Office's examiners accept the registration of the same or similar mark under a same registrant, designating same or similar goods/services? If no, please advise how much different would be required?

KENFOX: Article 90.2 of the Vietnam IP Law: *[In case there are many applications filed by different persons for registration of identical or confusingly similar marks for identical or similar products or services, or in case there are many applications filed by the same person for registration of identical marks for identical products or services, the protection title may only be granted for the mark in the valid application with the earliest priority or filing date among applications satisfying all the conditions for the grant of a protection title]*

Registration of the same mark for the same goods/ services in the name of the same owner is not acceptable under the laws of Vietnam. However, if there is any different between the marks or the goods/ services there under, making them be deemed similar, not identical, the registration thereof may be acceptable on a case-by-case basis. The difference in terms of the marks or the goods/ services there under may be rather slight.

11. Is "Information statement system" adopted under the laws of Vietnam? "Information statement system" means notifying the examiner regarding the reasons for refusal based on an unregistered prior trademark before/during examinations.

KENFOX: "information statement system" is not available under the laws of Vietnam. In practice, any third party may file with the Vietnam IP Office a statement notifying the examiner of a possible refusal based on an unregistered prior mark before or during the examinations. However, for such a statement to be well-considered, it is recommended to file a Notice of Opposition based on such unregistered prior mark, not a simple statement.

12. Whether partial payment for registrations fee acceptable in Vietnam?

KENFOX: no explicit regulation on the matter is provided under the laws of Vietnam. Having checked this matter with the Vietnam IP Office, we learnt that partial payment might be acceptable if a justification is submitted and approved by a senior official of the Vietnam IP Office. Kindly note that we are not aware of any case where the payment is made in part.

13. Whether possible to divide an application in Vietnam?

KENFOX: Article 17.2a of Circular No. 01/TT-BKHCN provides that "*the applicant may divide, on his/her own initiative or upon the request of the Vietnam IP Office, his/her application (division and transfer of one or several technical solutions in an invention registration application, one or several industrial designs in an industrial design registration application, one or several components of a mark or part of the list of goods and services in a mark registration application to one or several new applications referred to as divisional applications)*". Thus, it is possible to divide an application under the laws of Vietnam.

14. Are capital letters deemed identical to small letters in trademark examination in Vietnam?

KENFOX: Practice indicates that in examination of trademark similarity, capital letters are deemed identical to small letters

15. Can the Vietnam IP Office's examiner ask the applicant to enter a "colour claim" if the trade mark features colour?

KENFOX: There is no explicit regulation on color claim if the trademark features colour. However, as a matter of fact, if the trademark is in color to be filed for registration, the applicant should so indicate by describing the colour claims and, if such description is not clear, an Office Action may be raised by the Vietnam IP Office.

16. Does a registration in black and white provide protection for all colours in Vietnam?

KENFOX: At present, Vietnam has not laid down any regulations that a registration in black & white provide protection for all colors.

Generally, applicants should register marks in black and white rather than in color because in practice, a black-and-white mark would offer the broader scope of protection, i.e., protecting such mark in all colors. Further, in most cases, the use of a color mark which is registered in black and white can help revoke the cancellation of registration of such mark due to non-use provided under Article 5 of Paris Convention in which Vietnam is a contracting party, "*use of a*

trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark”.

17. Whether a trademark registered in standard font can be used in other fonts without being detrimental to the trademark as originally registered in Vietnam?

KENFOX: The Vietnam IP Law and Regulations do not contain provisions on whether the use of a registered mark in a modified form will be sufficient to prove the use of the registered itself. Thus, it has been generally construed that use of a trademark must be in the form in which it was originally registered to be acceptable as trademark use. However, kindly note that Vietnam is a member of the Paris Convention for the Protection of Industrial Property, which specifically stipulates under Article 5C(2) that use of a trademark by the proprietors in a form differing in elements “which do not alter the distinctive character of the mark in the form in which it was registered” shall not entail cancellation of the registration and shall not diminish the protection granted to the mark. In view of the foregoing, we opine that the word mark can be filed in “standard font” in Vietnam and the subsequent use of such registered mark may be in any fonts, provided that such font does not alter the distinctive character of the registered mark in Vietnam.

18. Is it possible to voluntarily disclaim descriptive words at the time of filing a trade mark application in Vietnam? If yes, advise how the Vietnam IP Office’s examiner consider such disclaim.

KENFOX: The IP Law of Vietnam and other relevant legislation do not contain regulations on voluntary disclaim descriptive words at the time of filing a trade mark application. As a matter of fact, the descriptive words will be requested to be disclaimed in a Notice of intention of grant of protection title after concluding substantive examination. At such stage, in case the applicant agrees with the examiner's disclaimer, he shall pay the registration fees for the protection title to be granted. Otherwise, an response may be filed against such disclaimer.

19. Please advise us how to record a translation and transliteration of foreign words at the

time of filing to avoid an office action?

KENFOX: When filing an application for registration of a mark comprising Latin foreign words rather than Vietnamese, in the description of the trade mark application form, a translation and transliteration of foreign words must be provided at the time of filing.

20. May we submit a catalogue with the application form to describe the nature of goods to avoid an office action?

KENFOX: Normally, the description of goods/services must be sufficiently specific and detailed in the application form. In some cases where are difficult to explain the goods, a detailed explanation is more preferable than a catalogue although the latter may be sometime accepted.

21. Please advise if the Vietnam IP Office issues an extension of protection certificate if the trademark is filed using the Madrid Protocol system?

KENFOX: Article No. 41.6(e) of Circular No. 01/2007/TT-BKHCN provides that *"As from the date international registration of a mark is recognized as effective in Vietnam and as requested by the owner, the National Office of Industrial Property shall issue a certificate of protection on payment of fees"*

Despite explicit regulations on issuance of Trademark Registration Certificate for an Int'l Application filed through Madrid Agreement/Protocol as mentioned above, the Vietnam IP Office has never received any request for such issuance up to now and, thus, the Vietnam IP Office has not issued such Certificate. The Vietnam IP Office's examiner informed us that we may still request the Vietnam IP Office to issue the above-mentioned Certificate for their actions. However, due to the aforesaid (i.e. the Vietnam IP Office has never received any request for such issuance up to now and, thus, it has not issued such Certificate), it is uncertain whether the Vietnam IP Office will agree to issue a Trademark Registration Certificate for an Int'l Application filed through Madrid Agreement/Protocol.

22. Please advise if "late filing" of documents is permissible in Vietnam?

KENFOX: Article 9.2 of Circular No. 01/2007/TT-BKHCHN: The time limit for applicants and concerned parties to submit, modify or add documents or give their opinions may be prolonged once for a period of time equal to the set time limit, if the applicant submits a written request for prolongation before the date of expiration of the set time limit and pay a prescribed fee. Thus, statutorily, the late filing of documents is accepted, provided that the applicant must submit a request for extension before the time-limit.

23. Please advise if signature by procurator such as executed by KENFOX acceptable?

KENFOX: We may sign on behalf of the applicant in the applications, requests, responses, or some other letters. However, there are still documentations (for example, affidavit, declarations, etc) to be submitted to the Vietnam IP Office that need be signed by the trademark holders themselves.

24. Do examiners judge the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation etc.? If so which is the most importance factor?

KENFOX: Article 39.8 of Circular 01/2007/TT-BKHCHN: 39.8. Assessment of confusing similarity of signs sought to be registered to other marks:

a) To assess whether or not a sign sought to be registered and stated in an application is identical or confusingly similar to another mark (hereinafter referred to as control mark), it is necessary to compare the disposition, content and pronunciation (for character signs), significance and form of expression of the sign (for character signs and figure signs), and concurrently compare the goods and services bearing the sign with those bearing the control mark defined at this Point.

b) Signs identical to control marks: A sign shall be considered identical to a control mark if it resembles the control mark in terms of disposition, content, significance and form of expression.

c) A sign considered confusingly similar to a control mark if:

(i) It is similar to the control mark in terms of disposition or/and content or/and pronunciation or/and significance or/and form of expression in such a way that makes consumers misjudge these two objects as one or an object as a variation of the other or these two objects of the same origin;

(ii) *It is merely a transliteration or translation of the control mark, in case the control mark is a well-known mark.*

The Vietnam IP Office's examiners judge the similarity or dissimilarity of the marks in their entirety as to appearance, pronunciation, connotation, etc. Under the laws, if similarity is found in either appearance, pronunciation or connotation, the trademark is found similar to the prior mark. Subject to particular situation of each case, some of the factors can prevail over the others in determining the similarity. Thus, it is difficult to say which is the most important factor in general.

25. The 11-member Comprehensive and Progressive Agreement for Trans-Pacific Partnership ("CPTPP") officially came into force on December 30, 2018. The trade deal was signed by Australia, Brunei, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore and Việt Nam in Santiago in March 2018. The CPTPP took effect in Vietnam on 14 January 2019. Could you please advise if the CPTPP has any effects on the current IP Law of Vietnam, particularly on issues concerning common names of goods in Vietnam?

KENFOX: Yes, per Article 18.33 of the CPTPP which provides for "*Guidelines for Determining Whether a Term is the Term Customary in the Common Language*",

[With respect to the procedures in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical Indications) and Article 18.32 (Grounds of Opposition and Cancellation), in determining whether a term is the term customary in common language as the common name for the relevant good in the territory of a Party, that Party's authorities shall have the authority to take into account how consumers understand the term in the territory of that Party. Factors relevant to such consumer understanding may include:

(a) whether the term is used to refer to the type of good in question, as indicated by competent sources such as dictionaries, newspapers and relevant websites; and

(b) how the good referenced by the term is marketed and used in trade in the territory of that Party].

From the foregoing provision of the CPTPP, per Notification No. 1926/TB-SHTT dated 01

February 2019, issued by the IP Office of Vietnam, in determining whether or not a term is the common name of goods in Vietnam, the authority must be allowed to take into account how consumers understand the term in Vietnam. In detail, In the process of examining geographical indication applications, with regard to those filed as from the effective date of the CPTPP, the determination of whether or not a term is the common name of goods in Vietnam as set forth in Article 80.1 of the IP Law must be based on how consumers in Vietnam understand the term, which may include the following factors:

- (i) whether or not the term is used to refer to the type of goods in question in sources of information such as dictionaries, newspapers, market research reports, and related websites;
- (ii) how the goods referenced by that term are marketed and used in trade in Vietnam (*i.e., being used in recognized international standards to refer to a category or group of goods, e.g., import and export tariffs, etc.*).