

Vietnam IP News Bulletin

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WHAT LEGAL TOOLS ARE AVAILABLE UNDER VIETNAMESE LAW TO PROTECT THE BRAND IDENTITY OR OTHER ASPECTS OF PRODUCTS?

The following intellectual property (“**IP**”) rights can be used, depending on the nature of the brand or products, to protect the business interests under the laws of Vietnam:

Trade dress/get-up: Generally, trade dress may consist of one or more elements (*e.g. color, size, and/or shape of packaging*); or it may be the overall image or concept of a product, packaging and/ or decoration that may reflect the full look and feel of a business including signs, logos, uniforms, merchandising, websites and labels. Therefore, trade dress refers to the manner in which a product is “dressed up” to go to market. In Vietnam, trade-dress falls within the scope of “unfair competition” as provided in Article 130, Vietnam IP Law. Trade dress or commercial indications are further specified under Article 19.1(b), Circular No. 11/2015/TT-BKHCN which provides that commercial indications include industrial property subject matters (*marks, trade names and geographical indications*) and the following subject matters: (i) *Goods labels, which are scripts, prints, drawings or photos of letters, pictures or images stuck, printed, attached, molded, carved or engraved directly on goods or commercial packages of goods or on other materials to be affixed on goods or commercial packages of goods*, (ii) *Business mottos, which are groups of words appearing beside enterprise names or labels affixed on products of enterprises to emphasize business purposes or guidelines of enterprises or customers targeted by such products*, (iii) *Business symbols, which are signs, letters, figures or configurations uniquely designed and used as symbols of enterprises in their business activities*, and (iv) *Package designs, which are designs and decorations of goods packages, including shapes, patterns, figures, letters, numbers, colors, presentations, blending of colors, arrangements and combination of these elements to create a particular impression or typical feature of goods packages*. Protecting your trade dress may be essential to creating your unique brand. Because trade dress often serves the same function as a trademark – identifying the source of products in the marketplace, in Vietnam, it can generally be protected under trademark laws, and in some cases, it can be registered as a trademark. It is advisable to seek professional advice from Vietnam local IP agent on this if you are interested in protecting your trade dress in Vietnam.

Industrial designs: Exclusivity over a product's aesthetic features such as its shape, ornamentation, patterns, lines or color that meet certain prescribed requirements may be secured via industrial design protection. To be protected under Vietnam IP Law, an industrial design must be new, creative and capable of industrial application. Industrial design protection does not protect any technical features of the article to which it is applied, and can only apply to a shape insofar as the shape is not wholly determined by a technical function. An industrial design right is time-limited (generally a maximum of 15 years), but provides exclusive rights. Statutorily, under Vietnam IP Law, the industrial design right holders are entitled to prevent competitors from marketing products that are identical or insignificantly different from that of their industrial designs protected in Vietnam. This is construed that holder of an industrial design protected in Vietnam may prevent marketing of new products with the same or slightly similar shapes, whether or not copying has taken place, and whether or not consumers are actually confused. It is important to note that if you wish to protect your industrial design, you are advised to keep the industrial design of your product confidential prior to registration to avoid losing its novelty, one of the requirements for an industrial property to be patented in Vietnam.

Copyright: Copyright is one category of IP rights, which is codified and recognized under Vietnam IP Law. Works protectable under Vietnamese copyright laws are defined as “literary, artistic, and scientific works”, which principally include the following: (a) *Literary works, scientific works, textbooks, teaching courses and other works expressed in written language or other characters*; (b) *Lectures, addresses and other speeches*; (c) *Press works*; (d) *Musical works*; (dd) *Stage works*; (e) *Cinematographic works and works created by a process analogous to cinematography (hereinafter all referred to as cinematographic works)*; (g) *Plastic art works and applied art works*; (h) *Photographic works*; (i) *Architectural works*; (k) *Sketches, plans, maps and drawings related to topography or scientific works*; (l) *Folklore and folk art works* and (m) *Computer programs and data collections*.

Unlike trademarks, under Article 6.1, Vietnam IP Law, “*copyright shall arise at the moment a work is created and fixed in a certain material form, irrespective of its content, quality, form, mode and language and irrespective of whether or not such work has been published or registered*”. The aforesaid provision means that a work is automatically protected in Vietnam without having to register it with Vietnamese competent authority. This principle of copyright protection is in line with those under Berne Convention. Further, under Berne Convention, when a work is created/published in a member country of Berne Convention, such a work shall enjoy protection in all countries thereof. Berne Convention requires its member countries to provide the author of any Berne-qualifying work the same treatment as it provides its own nationals with regard to their works. Therefore, the copyright registration of a work in a Berne member country where Vietnam is a signatory would be a good ground for proving the copyright subsisted in such a work before Vietnamese authority. However, as a matter of fact, a copyright registration in Vietnam of the work would facilitate much the enforcement in Vietnam. Hence, it is advisable to obtain a copyright registration for your work in Vietnam before taking enforcement actions.

Patents: To qualify for protection, inventions must meet the criteria of novelty, inventive step

and industrial applicability as provided under Articles 60, 61 and 62, Vietnam IP Law.

Trade secrets: Trade secret is defined as information obtained from activities of financial or intellectual investment, which has not yet been disclosed and which is able to be used in business. To be eligible for protection in Vietnam, a trade secret must satisfy the following conditions: (i) It is neither common knowledge nor easily obtainable; (ii) When used in business activities, the trade secret will create for its holder advantages over those who do not hold or use it and (iii) The owner of the trade secret maintains its secrecy by necessary means so that the secret will not be disclosed nor be easily accessible.

Of note, in practice, there are very few cases of enforcement of trade secrets are being reported publicly in Vietnam. Holders of trade secret may choose this way of protection of their IPR asset when **(a)** they possess good security (physical, technical, contractual security, etc.), **(b)** they do not want to disclose externally (e.g. product formula, source codes). And **(c)** technical solution is difficult to copy/difficult to apply reverse engineering, which can be used over the period of patent protection.

Unfair competition laws: Unfair competition relating to IP is governed mainly by Vietnam Competition Law, although Vietnam IP Law does include some general provisions on unfair competition. Under the laws, IPR holders may take action against unfair business actions of competitors. These may provide you with some additional protection against those trying to copy different aspects of your products. In practice, however, a legal action based on competition laws is often difficult, expensive and time consuming.

Cumulative protection: Depending on your brand identity and products, you may be able to use a variety of IP rights. In detail, since no explicit regulations are available in Vietnamese laws that prohibit the overlapping protection under copyright law, industrial design law or trademark law, a particular sign may have cumulative protection under the laws of *copyright*, *industrial design* and *trademark in Vietnam*. Hence, such a sign may qualify under the respective laws as an artistic work, ornamentation or logo. However, the degree and scope of such cumulative protection varies widely. For example, Vietnam's industrial design legislation only allows a registered design to be protected for up to 15 years, after which it will be of public domain. This registered design can in fact, however, be protected in the form of trademark and/or copyright, making the term of protection of that subject matter quite long (*75 years after the author's death for copyright holder*) or may even become indefinite in case of trademark (*every 10 years the stakeholder renews it*). Thus, please be mindful that seeking protection under more than one regime is a belt-and-suspenders form of enforcement, allowing the IPR holders to resort to a second or even third mode of protection should the first fail or expire.

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