

Overcome a provisional refusal against an International Registration Designating Vietnam – difficult but never give up!

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How should you address to overcome a provisional refusal against an International Registration Designating Vietnam ("IRDV")? What steps can be taken to ensure your trademark is protected in Vietnam? In recent years, international registration of trademarks designating Vietnam has increasingly preferred taking into account of the simple and convenient procedures that can save a lot of time and money, but it also includes many potential risks relating thereto. **KENFOX IP & LAW OFFICE** has assisted its client to overcome a provisional refusal against an IRDV under various proceedings in Vietnam.

Background:

Guangzhou City Baiyun Lianjia Fine Chemical Factory (website: <http://www.danzi.cn/>), located in Guangzhou City, Guangdong Province China, engages in, inter alia, the Personal Care Products - Perfumes, Cosmetics, and



Other Toilet industry. This entity filed IR No. 1175364 ("DANZ 婭") for the goods in Class 03 designating Vietnam. The Intellectual Property Office of Vietnam (IP Vietnam) notified the International Bureau of its provisional refusal per Article 74.2(e), Vietnam IP Law, giving out a prior mark "DAN" for the goods in Class 03 under national Trademark Registration No. 24666 as a citation thereagainst ("**first refusal**")

Actions taken:

- ✓ Filing an appeal against the IP Vietnam's provisional refusal: Our analysis on dissimilarity of the marks in question, and similar precedents have been provided against the IP Vietnam's provisional refusal.

Mark	Applied-for trademark under IRDV No. 1175364	Cited trademark registration No. 24666
		
Class 03	Hair lotions; facial cleanser; cleaning preparations; polish; abrasive paper; perfumery; dentifrices; cosmetics; incense; shampoos for pets.	Shampoos, soap, Washing powder

- ✓ Issuing a Decision on refusal of IR No. 1175364: In review of our appeal, the IP Vietnam has not accepted our arguments on dissimilarity of the two marks in question, and thus, continued to withstand its rejection (**second refusal**) and issued Decision No. 2531/QĐ-SHTT dated 22/6/2016, concluding that the applied-for mark did not satisfy requirements of protection under Article 74.2(e).
- ✓ Filing another appeal with Minister of Science & Technology: Unsatisfactory with the IP Vietnam's refusal Decision, we filed another appeal thereagainst with the Minister of Science & Technology, providing detailed analysis on dissimilarity between the two marks, emphasising that they are completely distinguishable and that the separation of marks into different parts for examination purpose to conclude that a later-filed mark is confusingly similar is not based on the position/stance of the consumers and thus, not appropriate.

Outcome:

The Ministry of Science and Technology ("**MOST**") conducted an oral hearing for our appeal. Participants to this oral hearing were the MOST's representatives in role of the state body in charge of appeal settlement, our firm as the IP agent of Guangzhou City Baiyun Lianjia Fine Chemical Factory and the IP Vietnam as the appellee.

In the oral hearing, we re-submitted with emphasis all arguments as stated in the first appeal. Our arguments included the applied-for mark is structurally, visually and phonetically different from the citation;

further, the verbal element "**DANZ**" was just one among various figurative and verbal elements in the applied-mark at issue, and thereby, making the overall presentations of the two marks totally distinguishable. We further submitted, upon conducting additional searches on the IP Vietnam's online trademark database, that "DAN" trademark (the trademark comprising the element "DAN") had also been accepted by the IP Vietnam for registration in the name of different owners, making it not so strong element. In this regard, the IP Office should have examined the trademarks in their overall presentations, rather than their separate elements. In light of the foregoing facts, we asserted that there would be no likelihood of confusion as to the origin of goods bearing the mark in question by the use and registration of such a mark.

After oral hearing, the MOST found that our arguments, facts and evidence are rooted and convincing, as such, reversed the conclusion of the examiners at the IP Vietnam's Trademark Department, annulled Decision 2531

(and Provisional Refusal Notification) and approved protection for the mark "**DANZ**" under IR No. 1175364 in the name of Guangzhou City Baiyun Lianjia Fine Chemical Factory (CN) in Vietnam.

Takeways:

- (1) It is undoubtedly not easy to overcome a refusal against a trademark which arises from conflicts with earlier mark(s), especially when arguments have been rendered, then, rejected. How to overcome multiple grounds of rejection against an applied-for trademark requires in-depth knowledge, expertise and experience from IP practitioners. This case has required a lot of efforts and skill as well as expertise from KENFOX attorneys. We know the focal point to determine the success in overcoming the IP Vietnam's refusal, especially when it came to the second appeal filed with the MOST.
- (2) We do not think it is right to take a part in the whole mark and compare it with a prior mark. We think it is a dangerous method to adopt to divide the entirety of a mark into different portions and seek to conclude that such a compared portion is confusingly similar to a prior mark, especially when the prior mark is a short mark (*i.e. a mark with just one syllable*). Such comparison is a "dot-and-go-one". However, dividing the applied-for trademarks for examination on registrability thereof has now become a common practice in Vietnam. The breaking of a trademark into separate elements to assess its similarity to other prior marks without taking the mark entirety (trademark constituents) into account will result in a false inference on likelihood of confusion created by this trademark against others. We take the view that the likelihood of confusion must therefore be appreciated globally, taking into account of all factors relevant to the circumstances of the case.

- (3) When the first appeal filed with the IP Vietnam is rejected, the applicant is still statutorily entitled to file a second appeal with the MOST. Vietnam adopts a 2-level appeal system. Thus, in case the appeal filed with the IP Vietnam against the refusal (*"the 1st appeal"*) fails, the trademark applicant is entitled to file a further appeal to the MOST (the supervising body of the IP Vietnam- *"the 2nd appeal"*) or initiate an administrative lawsuit before a Vietnamese court.
- (4) Oral Hearing is a proceeding which is a common occurrence during the appeal settlement procedure at MOST. This proceeding provides the appellant and the IP Vietnam (*i.e. the party subject to an appeal*) an opportunity to present arguments to the MOST. Such proceeding can be complex and can involve discussions of great technical detail. Accordingly, significant time and efforts should be spent preparing for, and attending the oral proceedings before the MOST so as to convince the MOST to accept arguments in favor of the appellant.