

Main takeaways for seeking protection for industrial designs in Vietnam

Industrial designs serve as an valuable tool for any manufacturer who relies on the outward appearance of their products to attract customers and entice potential buyers to choose their offering over the competition. As such, features protectable as industrial designs can be used both purely as a form of aesthetic enticement, as well as a way to distinguish your products, helping them stand out from a multitude of similar goods.

Combating design infringement has never been easy. Design registrations protect against infringers from producing the same goods or products which do not produce a different overall visual impression on an 'informed user'. As such, designs in your IP portfolio can immediately challenge the unintelligent counterfeiter who tends to simply produce an imitation product.

1. Patentable and non-patentable industrial designs

Industrial design patents protect the specific appearance of a product, covering its three-dimensional configurations, lines, colors, or a combination of these elements. Some appearances will not be patentable as industrial designs in Vietnam:

- The appearance of a product dictated by the technical features of the product;
- The appearance of a civil or an industrial construction work, except for the appearance of the separate sections or modules that may be used independently or assembled to create a construction such as shops, kiosks, mobile homes or similar products;
- The appearance of a product, which is invisible during the use of the product (exploitation of a product's utility by ordinary methods and by any consumer, excluding its maintenance or repair);
- Appearances which are contrary to social ethics and public order.

How a product is defined in the industrial design related aspect in Vietnam? A "product" means an object, device, apparatus, means, or part for assembling or integrating these products, which is manufactured by industrial or handicraft methods, having a clear structure and function, and circulated independently. Thus, graphic user interfaces, typefaces, and icons do not fall within the scope of the definition of a product. Likewise, a "pattern" which cannot be circulated independently is not patentable. Of note, products containing a pattern, however, can be protected as an industrial design".

From the foregoing definition of a product, it is not patentable for a part of an integrated product that is inseparable from the integrated product, or can be separated from the integrated product only by destroying the integrated product. This is because that "part" is unable to be circulated independently. However, in practice, the Intellectual Property Office of Vietnam ("IP Vietnam") accepts design applications (*priority rights*) for designs of the integrated products claiming priority rights from priority applications for partial designs in foreign countries.

There is no specific definition for 2D industrial design. However, as long as it is qualified as a product, 2D design is patentable under industrial design. Something in the form of a label, ribbons, lace, fabrics, or "sheets" which are very thin may be considered as equivalent to 2D design.

2. Essential shaping features

Understanding the essential shaping features of an industrial design is critical to determine likelihood of industrial design infringement. Features which are noticeable/memorable, necessary and sufficient to identify an industrial design and distinguish it from another one used for the same type of product are deemed essential shaping features.

The same type of product is the product that has usages or functions identical or similar to each other. A complete product and parts used for assembling or incorporating a complete product are different types of product. Two industrial designs are considered not significantly distinguishable when they are used for the same type of product and have the same gathering of substantial design features.

Essential or non-essential?

Whether color is considered as an essential shaping feature of an industrial design? The answer is variable. For a 3D design, the color of a design is not considered an essential shaping feature. However, for the packaging or for 2D designs where surface decorative features is an important attraction, color in a certain decoration combination providing aesthetic impression to consumers can serve as an essential shaping feature.

Dimension, such as the distance of decorative lines on 2D design like fabrics, paper, is considered as an essential shaping feature of a design. However, the dimension of a product containing the design, when changed in the form of zoom out or zoom in, is not considered an essential shaping feature.

It is of further note that the material used for the manufacture of the product embodying the design is not regarded as an essential shaping feature of a design.

3. Unity of design requirements

Failure to satisfy the uniformity requirement (*unity requirement*) will result in rejection of protection for application for industrial design. An application for industrial design registration is considered having conformed to a requirement of unity of design in three cases:

- (i) it requests protection of an industrial design of a product; or
- (ii) it requests protection of industrial designs of multiple products in a set of products, of which each product has a corresponding industrial design; or
- (iii) it requests protection of an industrial design of a product accompanied with one or several variations of that industrial design. The first variation must be a basic variation.

The variations of an industrial design must not differ significantly from the basic variation and from each other.

From the foregoing regulations, embodiments filed in a single industrial design application must share a single general inventive concept and must not significantly differ. In practice, the unity of the industrial design application may be treated on case by case basis and will depend on the examiners who may request separate designs in divisional applications. At the same time, there are cases where examiners require the designs from separated applications are incorporated into a single application.

4. Requirements on some important documents in an industrial design application

- *01 industrial design description (Design specification)* which must satisfy requirements provided in Point 33.5, Circular No. 01/2007/TT-BKHCHN.

Basically, the required contents in an industrial design must contain the title of the design, field in which the product is used, closest prior art design(s) (if any), listing of photos/drawings, shaping features of the design to disclose the nature of the design new features of the design, and claims

- *Photos or drawings of industrial designs*

Generally, the applicant must submit 04 sets of photos or 04 sets of drawings of an industrial design. A set of photos/drawings is normally required a perspective view and six basic views (front, rear, right, left, bottom and top views) that must be in the same scale, same direction and in the required order as listed. For industrial design of a packaging, only one view may be acceptable. The same is true for 2D design.

IP Vietnam always requires photos/drawings that are clear and well defined; drawings must be presented with unbroken lines; the background of a photo or drawing must be monochrome and contrast with the industrial design.

- *Trademarks used in design*

IP Office of Vietnam may request the applicant to provide evidence of legitimate use of any trademark in the

design. The applicant will be asked to remove the trademark, if there is evidence of non-legitimate use.

5. Grounds of refusal against an industrial design application

An industrial design application may be refused for protection on the following grounds:

- (a) Failure to satisfy requirement of industrial design protection: The design does not comply with the definition of a design. *Partial designs* may be objected to on this ground.
- (b) Set of drawings/photos: Some main reasons pertaining to drawings/photos include poor quality graphic in design; the ratio: the drawings which are directly photographed of the finished products are different in ratio
- (c) Other grounds:
 - (i) The industrial design does not satisfy the requirements of patentability: novelty, inventive step, and industrial applicability.
 - (ii) Lack of applicant's address in priority design application
 - (iii) The industrial design application does not fulfill the unity of design requirement.
 - (iv) The industrial design application does not fulfill the first-to-file principle.
 - (v) The industrial design is contrary to social morality or public order.

6. Enforcement of industrial design rights in Vietnam

Provisional right conferred to a pending industrial design application in Vietnam

Where an applicant for registration of an industrial design knows that such industrial design is being used by another person without prior use right for commercial purposes, the applicant may notify that user in writing of the filing of his/her application. This should clearly specify the filing date and the date of application publication in the Official Gazette of Industrial Property so that the later shall terminate or continue such use.

Where the person notified continues using such industrial designs, as soon as an industrial design patent is granted, the owner of such industrial design shall have the right to request the user of such industrial design to pay a compensation equivalent to the price for licensing of such industrial design within the relevant scope and duration of use.

Enforcement actions against industrial design infringement

Should your industrial design be infringed in Vietnam, there are two main avenues of enforcement which can be pursued; administrative actions, or civil litigation. Criminal remedies are not applicable to infringements over industrial design rights in Vietnam.

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