

# Vietnam IP News Bulletin

Kenfox IP & Law Office

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## TRADEMARK EXAMINATION PRINCIPLES NEWLY ADOPTED BY IP OFFICE OF VIETNAM AS OF DECEMBER 2020

To be more compatible with the recent signed trade pacts, including European Vietnam Free Trade Agreement (“EVFTA”), the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (“CPTPP”), and most recently the Regional Comprehensive Economic Partnership (“RCEP”) and the UK Vietnam Free Trade Agreement (“UKVFTA”), some new critical trademark examination principles/practices have been introduced/adopted by the IP Office of Vietnam (“IP Vietnam”). KENFOX IP & LAW OFFICE provides below several important takeaways.

### 1. Three-dimensional mark

Statutorily, a trademark is eligible for protection in Vietnam when satisfying two requirements, i.e.

- (i) It is a visible sign in the form of letters, words, drawings or images including holograms, or a combination thereof, represented in one or more colors, and
- (ii) It is capable of distinguishing goods or services of the trademark owner from those of other subjects. (*See Article 72, Vietnam IP Law*).

In light of the foregoing stature, *3D marks* can be protected in Vietnam.

However, account should be taken into account that in respect of both national applications and international applications, if a three-dimensional mark is identified as the shape/container design of the claimed goods, such a 3D mark shall be refused registration even if it is combined with other distinctive elements.

For international applications only: If the applied-for three-dimensional mark is deemed not the shape/container design of the goods under the list of claimed goods and services, then it shall be

accepted for registration as a 3D trademark in Vietnam.

For national applications:

- The IP Vietnam's examiners are entitled to request the applicant to confirm the nature of the applied-for mark (*i.e.*, a two-dimensional or three-dimensional mark).
- If an applied-for mark is claimed as a 2D mark, it is indeed the shape/container design of the goods under the list of claimed goods/services, but it is combined with other distinctive components, then the 2D mark shall be accepted for registration as a whole with the shape/container design being disclaimed.

## 2. Trademarks comprising uncommon languages

Common languages officially recognized by the IP Office of Vietnam comprise 3 languages, i.e. (i) Vietnamese, (ii) English and (iii) French.

That being said, in trademark examination, the words/phrases in uncommon languages such as German, Spanish or Italian is not the minimum source of information that examiner must conduct searches. As such, it is interpreted that words/phrases in uncommon languages such as German, Spanish or Italian may be accepted for registration as trademarks, even if such words/phrases carry meanings descriptive of the claimed goods/services. This is due to the fact that local consumers may understand the descriptive meaning of such uncommon languages.

However, in case the IP Vietnam's examiner for any reasons come to know that a mark comprising words/phrases in the above uncommon languages is deemed descriptive of the claimed goods/services, such a mark (i) will be only registered if it contains other distinctive elements with the descriptive words/phrases being disclaimed, or (ii) will be refused registration under Article 74.2(c), Vietnam IP Law if it does not contain any other distinctive elements.

In case the words/phrases in uncommon languages and do not belong to Latin-origin language, but they are represented in identical form of Latin language which Vietnamese consumers can recognize and memorize, e.g. the word "**ABPOPA**" (in Russian, it is pronounced as "**AVRORA**"), if in the trademark application:

- (a) The applied-for trademark merely contains this word (e.g. "**ABPOPA**") and is described as a word/phrase belonging to Slavic languages, the trademark application will be refused protection under Article 74.2(a), Vietnam IP Law. In detail, such a word "**ABPOPA**" is deemed as a word in uncommon languages.
- (b) The applied-for trademark contains this word (e.g. "**ABPOPA**") and is described as a word/phrase belonging to Slavic languages, but it is in combination with other distinctive element, such a trademark will be accepted for registration with the word (e.g. "**ABPOPA**") being disclaimed.

## 3. Trademarks that employ geographical names

In order for examiner to determine whether a geographical names is a sign indicating the

geographical origin of the claimed goods/services, it is required to assess the relationship between the claimed goods/services and geographical location as stated in a trademark application.

- (a) If the geographical name and the claimed goods/services are (i) unrelated or (ii) related but the geographical name no longer indicates its geographical origin, the geographical name shall not be deemed a badge of origin of those claimed goods/services. That said such a geographical name is entitled to be protection as a trademark.
- (b) If the geographical name and the claimed goods/services have an unclear relationship, (i) the geographical name would be evaluated from the district level upwards, and (ii) the relationship between the applicant's address and the area bearing this geographical name must also be considered. If the applicant's address is included in such a geographical name, the trademark that employs such geographical name will be protected as a whole with such geographical name being disclaimed. If the applicant's address is not included in such a geographical name, such a geographical name in the applied-for trademark will be refused protection.
- (c) Where the geographical name and the claimed goods/services have a close relationship, the mark bearing the geographical name shall be refused protection, regardless of the administrative level of the geographical name.

#### **4. Other principles adopted for examining trademark registrability**

##### **General principles**

- A mark must be examined in its entirety without being split into different constituents, if those constituents are connected. (*E.g. A mark comprising a cat holding a pen applied to register for the stationery products can not be divided into a cat and a pen for examination purpose so that the pen will be disclaimed*).
- The disclaimer of a mark does not totally depend on the applicant's description of the mark as stated in the trademark application. (*E.g. The applicant describe his mark as two alphabet letters "C" and "D" integrated into each other, but the representation of that mark is so unique that it is unrecognizable, a disclaimer will not be adopted*).
- Common figurative elements (*e.g. globe, rice, crown device*) that have been stylized shall not be disclaimed, as the protection is actually granted for the stylization and/or representation of those elements.

##### **Concrete exemplified cases**

- If a mark contains letters combined with numbers (e.g., "BCD30" or "B8VTC"), each constituent component shall not be divided to be disclaimed.
- If a mark contains letters combined with a special symbol such as an ampersand (e.g., "A&K" or "A & K"), those terms (e.g., "A&K" or "A & K") shall be wholly disclaimed.
- If a mark contains elements that are connected but could be separately disclaimed, those components shall not be separately disclaimed (e.g., "T-Fone", "K-PAINT").
- If a mark is a descriptive device or contains a descriptive device that is uniquely stylized or is in combination with other figurative elements, such descriptive device shall not be disclaimed.
- Simple geometric figures constituting a mark shall not be disclaimed in the said mark.

- If a mark contains elements that are descriptive of only part of the classes of designated goods or the designated goods/services, a disclaimer shall be imposed only on those classes or goods/services.
- Trademarks such as “**Black Sheep**” for the services in Class 43 or “**Natural Island**” for the goods in Class 03, despite comprising the descriptive element, are combined with other element that make the overall mark non-descriptive, the descriptive components shall not be separately disclaimed in the mark.
- If a mark contains a country name that is identical to the applicant’s nationality but is written as an adjective and is combined with other components to create a distinctive phrase (e.g., “**American Beauty**” or “**French Bull**”, etc.), the mark shall be protected without any disclaimer imposed on the country name in adjective form. Meanwhile, if the country name is written as a noun in the mark, the mark shall be protected as a whole with a disclaimer on the country name (e.g., “**Vietnam Smile**”).

### **5. Collective marks, Certification marks containing a geographical name or other sign serving as a geographical indication of foreign specialties**

The applicants do not need to provide a Permit on use of the geographical name from a competent authority in that country or any document, evidence substantiating entitlement to use the geographical name in the trademark to indicate that such Collective marks, Certification marks have been protected in the country of origin.

### **6. Letter of Consent to overcome a trademark refusal in Vietnam**

Statutorily, Vietnam does not adopt consent letter regime to exclude the likelihood of confusion. Still, in practice, the examiners could accept such letter on case-by-case basis. Currently, a Letter of Consent is acceptable to overcome a trademark refusal in Vietnam if it satisfied two following requirements:

- The applied-for mark is not identical or is relatively distinguishable from the citation.
- Some contents must be included in a Letter of Consent, such as: Name, Address of the citation, Trademark, Trademark Registration Number of the citation, Name, Address of the applicant, list of goods/services approved under the Letter of Consent, an affirmation from the cited trademark owner that they accept/will not protest use and registration of the applied-for trademark, signature and seal (if any) of the cited trademark owner.

#### **Additional noteworthy points**

- A new mark, which is similar to a registered mark of the same applicant, which has been granted registration on the basis of an Letter of Consent, will be registered when the applicant submits new Letters of Consent issued by all owners of relevant citation(s). This being said, the applicant cannot use the same Letter of Consent they used to pursue the registration of their similar mark to overcome refusal of the latter mark.
- As for appeals filed after 15 January 2018, Letters of Consent will not be accepted in the appeal proceedings of the trademark applications as “new facts/evidence” that may change decisions being appealed.

## 7. Determining legal status of citation

The time for determining relevant prior marks is computed from the filing date or the priority date of an applied-for mark.

Because information on the citation may change over the course of time, information about the cited mark(s) is determined at the time the applied-for mark is examined.

The foregoing principle implies that it is now possible to use the successful non-use cancellations/invalidations against the cited mark(s) as a ground to request the IP Vietnam to accept protection for an applied-for mark, regardless of whether the cited marks were still valid at the filing date of the applied-for mark. This new principle has resulted in a termination for a long debate on determination of legal status of citations between IP Vietnam and IP practitioner recently.

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