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# Overcoming trademark refusal in Vietnam arising from multiple grounds of rejection, difficult but not impossible

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It is no doubt very difficult to overcome a refusal against a trademark which arises from conflicts with earlier mark(s), especially when more than one grounds of rejection are raised. How to overcome multiple grounds of rejection against an applied-for trademark requires in-depth knowledge, expertise and experience from IP practitioners.

This trademark case concerned two refusals based on two grounds of rejection (*i.e. absolute and relative grounds*) arising from Vietnamese intellectual property ('IP Vietnam'), under which the trademark was applied for registration and successfully accepted in an appeal proceedings in Vietnam.

**Background:**

Origin Herbal Hair Treatment Pte. LTD applied to register applied to register " Origin " ("Bee Choo Origin, device") the goods in Class 03 mainly covered hair care products under Trademark Application No. 4-2013-10176 in Vietnam.

On completion of substantive examination, the IP Vietnam issued its refusal (*first refusal*) against the "Bee Choo Origin, device" trademark, concluding that it did not satisfy requirements of protection under Article 74.2(c) and 74.2(e), Vietnam IP Law given that the verbal element "origin" is descriptive of the claimed goods in Class 03 and the rest element "BEE CHOO" is deemed confusingly similar to prior trademarks "CHOO" and "DrBEE" under Registration No. 77258 and 154327 respectively, with particulars as follows:

| Applied-for trademark under Application No. 4-2013-10176 | Cited trademark registration No. 77258 | Cited trademark registration No. 154327 |
|---|---|---|
| Bee Choo Origin | **CHOO** | **Dr.Bee** |

**Actions taken:**

Having reviewed the case, the applied-for trademark and the citations may be distinctive in terms of structure and representation. Thus, at the client's request, arguments and analysis on distinguishability and inherent distinctiveness of the applied-for trademark based on the arguments and facts were submitted as summarized as follows:

- Appearance of the marks: The applied-for trademark is composed of the verbal element “Bee Choo Origin” represented in bold red and a figurative element (i.e. two green leaves), making it a whole and, thus, it is an inherent distinctive mark. The cited marks merely consists of verbal elements without any stylization or figurative elements. As such, the representation of the applied-for trademark is completely different from the cited marks “Dr. Bee” and “CHOO” under under Registration No. 154327 and 77258 respectively, making the overall impressions created by the marks at issue different. Thus, the the marks in question will be perceived or memorized in the minds of the average consumers in different manner.
- The applicant does not request excluvive protection for the verbal element “Bee”, “Choo” or “Origin” and accordingly, proposes that the applied-for trademark should be protected as a whole.
- The trademark “Bee Choo Origin, device” is protected and co-existing in various countries where the cited mark “CHOO” is also accepted for registration.
- Difference in goods sought for protection although all the marks in question are intended for the goods in Class 03.

In light of the foregoing facts, the likelihood of confusion on the commercial origin of goods bearing the mark in question could not be established.

In review of the response, the IP Vietnam continued to withstand its rejection (*second refusal*) and released a Decision No. 12667/QĐ-SHTT (“**Decision 12667**”) on refusal against the applied-for trademark. Unsatisfactory with the IP Vietnam’s Decision 12667, a complaint/appeal No. KN4-2015-00486 has been filed with arguments almost the same with those submitted in the first response.

**Outcome:**

The IP Vietnam’s Enforcement and Appeal Settlement Department found that the 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 12667 and approved protection for the mark “ Origin ” under Trademark Application No. 4-2013-10176 in the name of Origin Herbal Hair Treatment Pte. LTD in Vietnam.

**Lessons learnt**:

(1) Splitting 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. It should be noted that an applied-for trademark must be examined in its entirety to decide whether there exists a risk of actual confusion on commercial origin of the goods bearing the applied-for trademark as opposed to prior ones, based on which a trademark refusal is deemed grounded.

(2) In case a trademark is refused for protection by one or more than one cited trademarks, arguments and analysis of the most prominent and impressive part of the trademarks in questions and the commercial impressions that the trademarks brought to consumers must be stressed and focused. Furthermore, documents that demonstrate the co-existence of those marks in different countries are valuable and persuasive for the IP Vietnam to consider withdrawing its refusal against the applied-for trademarks.

***KENFOX IP & LAW OFFICE was successful in this trademark case. If you wish to receive more information, please contact:***

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Chu Thanh TU is a partner in the IP litigation and investment consultancy practice of KENFOX.

TU concentrates his practice on IP litigation and transactions and on counseling startup companies on new business formations and structure. TU has represented clients at all levels of litigation and his clients range from emerging companies to leading generic pharmaceutical companies, medical device manufacturers, optical and laser technology companies, publishers and media companies, major universities, and information services and technology companies.

TU has represented his clients in complex litigation and appellate courts, in alternative dispute resolution forums and before the IP Office of Vietnam, Intellectual Property Departments of Laos, Cambodia and other Asian jurisdictions. He has resolved many disputes without the costly involvement of litigation and has settled many litigated matters to avoid protracted proceedings and related costs. TU has presented both legal and technical issues in a manner easily understood by the enforcement authorities. He also provides expert legal opinions for clients who have been accused of patent infringement.

TU also provides legal advice in areas of foreign investments pertaining to setting up a 100% foreign invested or joint venture enterprise, joint stock company in Vietnam, registration and de-registration of branches, businesses and representative offices, finding partnerships, settling negotiations, reviewing and drafting of legal documents, etc. His commercial advise also encompasses overseeing and handling corporate and real estate mergers and acquisitions, restructurings, securities offerings for clients in the automotive, machinery, banking and finance, chemicals, pharmaceuticals, computer software, energy, real estate development and management, commercial and industrial construction, and entertainment industries.

**Experience**

- Established a non-infringement position for a Vietnamese corporation when threatened with litigation.
- Offered counseling on patentability issues at every stage of the product cycle, including its genesis to clients.
- Provided clients with evaluations of the strength and scope of patents and related intellectual property in valuing businesses and technologies for acquisition purposes.
- Counseled to clients on patent infringement likelihood, provided patent opinions for both offensive and defensive purposes.

- Conducted patent infringement enforcement actions, prosecution and defense, including litigation when necessary.
- Provided clients with alternative dispute resolutions, both before and during litigation, including party-to-party negotiations, court assisted mediation, the use of mediators and arbitration proceedings.
- Represented clients with preparation of dossiers and documents and liaised with competent authorities for implement of procedures of investment registration and investment project evaluation the laws.
- Represented clients on negotiation with their partners with regard to their needs of investment cooperation, assignment/receipt of assignment of project.