



The intellectual property of reputable and well-known businesses is perpetually the target of imitation. **Nguyen Vu Quan**, IP attorney at Kenfox IP and Law Office, explains the solutions in Vietnam for businesses in this area.



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Enterprises cannot always wait for others to help protect them from IP misuse

The greater the businesses' prestige and goodwill, the more vulnerable it is to illegal business activities from others. As soon as the designs and logos for a reputable and well-known business's product line are introduced to the market, products with similar or even identical designs, patterns, and logos appear almost immediately.

The effective tools to repress IP infringements

According to observations, in recent times the use of copyright to prevent trademark/industrial design infringement in Vietnam is a new trend and tends to increase because it satisfies two requirements of the rights holder – the speed and efficiency comparable to enforcement based on trademark/industrial design (ID) rights.

After the Expertise Center of Copyright and Related Rights (ECCR) was established in 2016 and began operations in the last two years, when an infringement is detected, rights holders can use the copyright registration certificates to request the ECCR to provide expert opinions/assessment conclusions on whether or not an infringement is being committed. On that basis, it can use administrative and/or civil mechanisms to fight against intellectual property rights (IPR) infringement.

Practice indicates that enforcing trademark and ID rights in Vietnam presents numerous challenges, exacerbated by the length of time required to examine applications in Vietnam. The actual examination time for a trademark application can range between 16-18 months, or even several years if it is opposed by a third party or is denied protection by the Intellectual Property Office of Vietnam. The pro-

longed time for trademark/ID examination in Vietnam contributes significantly to the aforementioned situation, and at the same time, it also gives rise to a slew of negative consequences:

Third parties take advantage of the pendency of trademark/ID to commercialise their products without fear of being sued. Although the (unregistered) trademark/ID has been widely used in legal business activities in Vietnam and has developed into a commercial indication, Vietnamese Enforcement Authorities are reluctant to deal with alleged unfair competition actions.

In addition, third parties take advantage of the copyright protection mechanism to register the trademark or design of the product packaging of the legitimate trademark owner as copyright as a way to obstruct enforcement actions by rights holders, even after the mark has been granted a trademark registration certificate. In Vietnam, invalidating a copyright registration is not easy and often takes a long time.

Register procedures

In many cases, a logo may qualify for protection as a trademark and/or copyright, while a product packaging may qualify for concurrent protection under all three types of intellectual property: trademark, ID, and copyright. Numerous rights holders register trademarks and IDs in the belief that anti-infringement enforce-

ment based on trademark and ID rights will be stronger and more effective than copyright.

Therefore, for a long time, copyright has been only viewed as a source of supporting documents/arguments in IPR protection strategies. As a result, the establishment/protection of copyright in Vietnam has been undervalued and ignored.

Unnecessary high standards but unspecific for establishing rights to IPR subject matters, the backlog of trademark/ID applications making it impossible for the rights holders to take enforcement actions, the prolonged time to resolve IP complaints/disputes, and IP theft/blatant appropriation all serve as essential reasons which have discouraged many investors, legitimate brand owners, and businesses in Vietnam.

While trademark/ID registration can take several years, copyright registration in Vietnam is relatively quick and simple. Along with meeting the "originality" requirement (meaning a work is protected on the basis of the author's creation, regardless of novelty or creativity), the

grant of a copyright registration certificate (CRC) to a work submitted to the Copyright Office of Vietnam under the Ministry of Culture, Sports, and Tourism is based on the commitment that the work was created by the author himself and did not copy from that of any other individual/organisation.

The downside risk of the copyright registration mechanism in Vietnam is that due to the extremely fast and open nature of this mechanism for copyright registration, many trademarks or logos, and other forms of intellectual property belonging to rights holders have been illegally copied, registered as works of applied art, and granted CRCs.

These certificates are used as a talisman by nefarious traders to ward off accusations of IP infringement. Obviously, this is a large legal loophole that has been abused. This will certainly spark many disputes and conflicts over IP rights, turning/escalating them into serious and uncontrollable problems.

Proposed solutions

The recent signing of big trade pacts, such as those

with the EU and the UK, have triggered a continuous amendment of Vietnam's IP laws that are expected to meet a higher standard of intellectual property protection. However, reality shows that fighting IPR infringement is always a never-ending battle in any jurisdiction.

Therefore, instead of waiting for a change in national legislation, protecting yourself against IP theft is still a wise and effective approach. To mitigate the aforementioned negative consequences, fight against IPR infringements in Vietnam, and prevent and limit damage, businesses should carry out the necessary procedures to register for protection of their trademarks and product packaging designs in the form of copyrights in Vietnam, in addition to trademark and/or industrial design registration before launching products on the market.

Copyright registration is inexpensive, and the time required to obtain a copyright certificate is very short, between 15-20 working days after submitting a valid dossier. Vietnamese law does not prohibit the registration of an IP object under two or three types of IP, as long as it satisfies the protection criteria.

In the context that the trademark/ID has not been granted a protection title and it is not easy to prove that "commercial indications" have been widely used in Vietnam, possessing a CRC in Vietnam for a trademark or product packaging design

will bring many benefits to businesses.

The first benefit is the burden of proof. In Vietnam, the holder of a CRC is not required to prove ownership of the work in dispute, unless there is other evidence as prescribed in Article 49.3 of the Law on Intellectual Property of Vietnam.

Next is an assessment of copyright infringement. The CRC in Vietnam serves as the legal basis and is a required document for requesting an assessment of copyright infringement in Vietnam. In detail, before filing a copyright alleged infringement case with a competent Vietnamese enforcement authority, to support a copyright infringement allegation a rights holder may submit a request for assessment to the ECCR.

There are also legal grounds for asserting IPR rights. Vietnamese enforcement agencies often hesitate to take enforcement measures if rights holders do not submit the CRC along with the petition for handling copyright Infringement under the country's administrative and/or civil proceedings.

Registration of works in Vietnam also helps mitigate the risk of being appropriated by other organisations or individuals seeking to register and acquire legal ownership of the work.

For the reasons mentioned, the CRC will become a powerful and effective tool to seek protection in trademark, ID disputes, and infringement.

However, submitting a CRC alone may not be sufficient to establish ownership of the registered work in a dispute. In such a case, the owners should proactively collect, systematically store, and submit proof of their own independent creation and design of the works as a solid basis for establishing their copyright.

IPR infringements are becoming increasingly sophisticated and continue to grow at an alarming rate in Vietnam. Waiting for years for a trademark/ID to be granted protection in Vietnam is not an effective therapy.

Therefore, a time-efficient and fast IPR protection strategy should involve prioritising all necessary resources for copyright registration in addition to the registration of trademark/ID (if applicable) as soon as possible, especially when the ECCR has carried out the assessment of copyright and related rights infringement upon the requirements of IPR holders and authorities. ■



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