

Should I file an observation or opposition in industrial property procedures under Vietnam's IP Law 2022?

If you believe that a trademark application in Vietnam is likely to conflict with or adversely affect your prior rights, or that it does not meet the criteria for protection, you may submit your opinions on the grant of an exclusive right to such a trademark application to the Intellectual Property Office of Vietnam (**IP VIETNAM**) after it has been published in the industrial property gazette of Vietnam. The Vietnam IP Law 2022 gives third parties two options for voicing their opinions on pending trademark applications in Vietnam: **(i)** third party observation and/or **(ii)** opposition.

1. What are a trademark opposition and an observation?

- **Opposition** is an administrative procedure that allows a third party to challenge the validity of an industrial property registration application and then request the competent agency to refuse the grant of a protection title, provided that the opponent provides the legal grounds to prove his case.
- **Third party observation** is a procedure that allows the public to provide their opinion on industrial property registration applications, from which the examining agency makes decisions on applications under examination. Third-party's observation often serve as a reference source for examiners during the application examination process.

2. Filing an opposition or filing a third-party observation, what are similarities and differences?

A major distinction between filing an opposition and a third-party observation is the deadline set out for each procedure. For an opposition, there is a strict filing deadline (i.e **5 months** from the publication date of the **trademark** application. For **industrial design** and **patent** applications, the deadline is **04 months** and **09 months** respectively). Meanwhile, **no hard deadline** is set out for filing **observations**. An observation may be filed during the pendency of a trademark application in Vietnam from its publication until IP VIETNAM issues a Decision to grant a trademark registration certificate.

Comparison	Criteria	Third party observation (Article 112)	Third party opposition (Article 112a)
Similarity	<ul style="list-style-type: none"> ✓ Before the date of issuance of the decision on granting a protection title, any third party has the right to give an opinion against or to oppose to the grant of a protection title. ✓ No interest is required for the filing of a third-party observation or opposition. ✓ Third-party observation /Oppositions must be submitted in writing, stating the legal grounds, analysis, and arguments. 		
Difference	Fee	No official fees	Subject to prescribed fees
	Deadline	Third party's observation may be filed <u>during the trademark substantive examination period</u> , provided that such opinions are submitted before IP VIETNAM issues a decision to grant a protection title.	Opposition must be filed within 5 months from the publication date of the trademark application and before the issuing date a decision on the grant of a protection title.
	Procedure	IP VIETNAM only receives the third-party observation, but may not respond or initiate its own procedures to deal with such third-party observation.	IP VIETNAM receives oppositions, issues opposition number, and initiate a specific procedure for addressing the third party's opposition as an independent procedure (<i>similar to the procedure for invalidation, cancellation or appeal</i>).
	Feature	Being only a reference source of information in prosecution of industrial property registration applications (<i>being only opinions serving as reference information</i>)	Being a separate and independent procedure, like trademark cancellation, invalidation or appeal proceedings.

3. What are grounds to file an opposition/observation?

A trademark application may be denied registration in Vietnam on **absolute** and/or **relative** grounds. Absolute grounds refer to the categories of signs that are excluded from registration by specific provisions of the trademark law. Relative grounds refer to those that arise due to the existence of prior rights, whether in the form of registered marks or otherwise. Generally, an opposition/observation may be filed on the following grounds:

- **Descriptiveness:** i.e., an application trademark functions solely to provide information about the goods and services affiliated therewith the trademark;
- **Distinctiveness:** i.e., an application trademark is not capable of being represented graphically and of distinguishing the goods/services of one individual or organization from those of other individuals or organizations;
- **Deceptiveness:** i.e., an application trademark is of such a nature as to deceive the public (for instance, as to the nature, quality or geographic origin of the goods or services);
- **Conflict** with prior registration and/or prior right established through use.

See our articles titled:

- ✓ “**Trademark Oppositions in Vietnam**” at: <https://kenfoxlaw.com/ip-practice-in-vietnam/trademark-oppositions-in-vietnam>
- ✓ “**Questions on trademark oppositions in Vietnam**” at: <https://kenfoxlaw.com/questions-on-trademark-opposition-in-vietnam>
- ✓ “**Opposing an Application Mark without prior rights in Vietnam, is it possible?**” at <https://kenfoxlaw.com/opposing-an-application-mark-without-prior-rights-in-vietnam-is-it-possible>
- ✓ “**What strategies to reclaim unregistered trademark rights in Vietnam?**” at <https://kenfoxlaw.com/what-strategies-to-reclaim-unregistered-trademark-rights-in-vietnam>

The bottom line

If the deadline for filing an opposition has missed, the door has not shut down. You may still have chance to file observation with IP VIETNAM voicing your opinions on pending trademark applications under observation procedure. Even if the observation you have made is not used to bar an application from maturing into registration, an [invalidation](#) action is still available against the third party’s trademark.