

## How to register a geographical indication in Vietnam?

### Overview:

Geographical indications (GIs) are categorized as a type of industrial property right in Vietnam and protection of GIs are regulated under the Law on Intellectual Property. A GI identifies a product as originating from a specific geographical location and possessing unique qualities or characteristics that are attributable to that location. GI protection can help build confidence among customers by providing assurance of the product's authenticity and quality, as well as its cultural and traditional value.

For producers, GI protection can enhance the reputation of their products and increase their market value, as customers are willing to pay a premium for products with a recognized GI status. This can lead to increased income and job opportunities for local producers, as well as support for the development and promotion of regional economies.

Moreover, GI protection can contribute to sustainable development by preserving traditional production methods and promoting environmental and social responsibility. By promoting the use of local resources and supporting traditional agricultural practices, GI protection can help to maintain the biodiversity and cultural heritage of the region.

Overall, GI protection is an important tool for promoting and preserving the unique cultural and traditional value of local products, while also providing economic benefits to producers and contributing to sustainable development.

### What are required documents for GI registration in Vietnam?

The registration of a geographical indication (GI) in Vietnam requires the submission of a set of documents to the Intellectual Property Office of Vietnam (**IP VIETNAM**), which is the agency responsible for administering GI protection in Vietnam. The required documents for GI registration in Vietnam include

- (i) The name or the sign that is the geographical indication (**GI**) (*soft file*);
- (ii) List of goods bearing the geographical indication;
- (iii) Description of peculiar characteristics or quality or reputation of the product bearing the geographical indication and characteristics of natural conditions attributing to the peculiar characteristics or quality, or reputation of the product (hereinafter referred to as the "**Description of peculiar characteristics**"). The description must be confirmed by the applicant that all information in the description is true and verified. (*02 copies*);
- (iv) The map of the geographical area corresponding to the GI. The map must be confirmed by the applicant that it is true and verified (*02 copies*);
- (v) Documents evidencing that the GI is under protection in the country of origin if it is a foreign GI;
- (vi) Original signed Power of Attorney (**PoA**) (*notarization or legalization is not required*). A copy of the executed PoA can be accepted at the time of filing trademark applications, but the original one must be submitted **within 30 days** from the filing date.

### What are the most important notes about GI registration in Vietnam?

1. Each GI application may register only one GI used for one product <sup>1</sup>;
2. Requirements for "description of peculiar characteristics" <sup>2</sup>

A description of peculiar characteristics of the product must contain the following principal information:

(i) Enumeration of the given nature/quality of the product bearing the GI dictated by geographical conditions - by means of sense, qualitative and quantitative indicators to physical, chemical and biological properties, which can be tested by technical devices or experts using a specified testing method; and/or

<sup>1</sup> Rule 43.2 of Circular No. 01/2007/TT-BKHCN

<sup>2</sup> Rule 43.2 of Circular No. 01/2007/TT-BKHCN

(ii) Reputation of the product bearing the GI dictated by geographical conditions - determined through the widespread knowledge of interested consumers about that product, which can be tested; and

(iii) Geographical conditions liable to the nature/quality and reputation of the product bearing the GI, including unique meteorological, hydrological, geological, topographic and ecological elements and other natural conditions; unique elements being skills of producers, including also a traditional production process of the locality (*which might cover one, several or all production stages, from production of materials, processing of materials to making of products, and even the stage of product packing if this stage has an effect on the nature/quality and reputation of the product*) if that process is liable to create and maintain the nature/quality and reputation of the product bearing the GI, which contain information that is clear and detailed enough to be tested (*if the above information contains secrets or technical know-how not yet disclosed or widely known beyond the locality, the applicant may refuse to supply detailed information on those secrets or know-how without being assured of confidentiality of those information upon his/her request*); and

(iv) Correlation between particular nature/ quality and reputation of the product bearing the GI defined at Points (i) and (ii) above and geographical conditions defined at Point (iii) above.

The description of peculiar characteristics of the product must be accompanied with documents proving that information on the nature/quality/reputation are grounded and true (*results of examination, research, survey, etc*).

### 3. Requirements for “maps of geographical areas subject to GI”<sup>3</sup>

A map of a geographical area subject to a GI must be adequately informative, based on which the geographical area where exist all natural conditions liable to the particular nature/quality and reputation of the product can be accurately identified. The map may be submitted together with documents describing the geographical area subject to the GI.

**FYI** A map of the geographical area corresponding to the GI is required as part of the application for GI registration. This map is used to demonstrate the geographical boundaries of the area where the product originates and is produced according to the specific characteristics and qualities that are associated with the GI.

The map must be confirmed by the applicant to be true and verified, which means that the applicant must certify that the map accurately reflects the geographical area associated with the GI and that the information provided is correct. This certification is typically done through a signed statement by the applicant or a legal representative attesting to the accuracy of the map and the information provided.

A map of the geographical area corresponding to the GI is required as part of the application for GI registration for several reasons:

- *To establish the link between the product and the geographical area:* A GI is based on a unique link between a product and its geographical origin. By providing a map of the geographical area, the applicant can help to establish the specific characteristics and qualities of the product that are derived from its geographical origin.
- *To prevent false claims and misuse:* By providing a map of the geographical area, the applicant can help to ensure that the GI is not falsely claimed or improperly used in connection with products that do not meet the criteria for GI protection.
- *To help consumers and producers:* A map of the geographical area can provide a visual representation of the area and help consumers and producers understand the characteristics and qualities of the product associated with the GI.
- *To facilitate administrative procedures:* The map of the geographical area can also help the examining authority to determine whether the application meets the requirements for GI protection and to verify the accuracy of the description of the product and its origin.

### 4. Documents evidencing that the GI is under protection in the country of origin if it is a foreign

<sup>3</sup> Rule 43.5 of Circular No. 01/2007/TT-BKHCN

The document that evidences that the GI is under protection in the country of origin is a required document for GI registration in Vietnam. This document is usually referred to as the "*proof of protection*" document. This document can take different forms depending on the legal system of the country of origin. For example, in some countries, the proof of protection may be a Certificate of Registration or a Declaration of Protection issued by the competent authority responsible for GI protection. In other countries, the proof of protection may be a court judgment or an administrative decision that recognizes the GI and its protection.

Regardless of the form of the proof of protection document, it must clearly demonstrate that the GI is protected in the country of origin and that the applicant has the legal right to use and register the GI in connection with the product. This document is crucial to establishing the validity and authenticity of the GI and to ensuring that it is not misused or falsely claimed.

**FYI!** The "proof of protection" document is important in granting a geographical indication (GI) registration certificate because it demonstrates that the GI is already protected in the country of origin, and that the applicant has the legal right to use and register the GI in connection with the product. This ensures that the GI registration is valid and authentic and that it is not misused or falsely claimed. It also serves as an important reference for the examiner to verify the authenticity and validity of the GI application.

One of the requirements for GI registration is that the product must originate from the geographic region that the GI represents, and that it possesses specific qualities or characteristics that are due to its origin. Therefore, the proof of protection document serves as evidence that the GI is associated with a specific geographic region and that the product meets the required characteristics. GI protection is intended to protect consumers from misleading information about the origin and characteristics of the product and to prevent unfair competition by unauthorized use of the GI by third parties.

Without the proof of protection document, it may be difficult to establish the authenticity and validity of the GI and the applicant's right to use and register the GI. Therefore, the proof of protection document is an essential requirement for GI registration and is necessary to ensure that the GI is effectively protected and respected.

#### 5. Documents evidencing that the GI is under protection in the country of origin if it is a foreign G

Any documents submitted are in a foreign language to support the GI application in Vietnam must be translated into Vietnamese.

#### 6. Procedures for registration of GI in Vietnam

Geographical Indication (GI) registration is a legal process that provides protection to distinctive products from specific geographical regions. In Vietnam, the GI registration process involves the following steps:

##### **Step 1: Filing a GI application**

An application for GI registration in Vietnam must be filed with the Intellectual Property Office of Vietnam (**IP VIETNAM**). IP VIETNAM will affix its stamp on the GI application and return an original GI application (inserted IP VIETNAM's receipt stamp) as an official filing receipt to the applicant/IP agent.

##### **Step 2: Examination for the GI application**

A GI application will be firstly examined as to formality, then, published on the Industrial Property Gazette of Vietnam, and substantively examined thereafter and grant of protection if meeting requirements of protection under the laws of Vietnam. Hereunder are detailed steps:

##### **Formality examination:**

Timeline: 01 months from the filing date.

It takes 01 month for IP VIETNAM to complete a formality examination of a GI application in Vietnam. In the course of formality examination, IP VIETNAM's examiner shall examine the completeness, accuracy and conformity with requirements as set forth in Rule 13 and 14 of Circular No. 01/2007/TT-BKHCN. If the GI application is in conformity with the formality examination requirements, IP VIETNAM will issue a "**Decision on formality acceptance**" and then, within 02 months, will publish the GI application in the official gazette.

If GI is incomplete, incorrect, or not in accordance with the requirements set forth, IP VIETNAM shall notify the applicant under a "**Notification of deficiency**", requesting the applicant to provide documents or correct the application to meet the requirements within 02 months from the date of notification. In case that the applicant cannot provide or correct the application within the given time limit, IP VIETNAM shall issue a "**Decision of refusal of the GI application**".

The applicant shall have right to appeal IP VIETNAM's Decision of Refusal within 90 days from the date of awareness or receipt thereof or file a lawsuit against IP VIETNAM's Decision of Refusal within 01 from the date of awareness or receipt thereof.

#### **Publication of application:**

Timeline: 02 months from the date of the Decision of formality acceptance.

All GI applications accepted as formality shall be published in the Industrial Property Official Gazette within 02 months from acceptance date.

#### **Substantive examination:**

Timeline: 06 months from the publication date:

After the formality examination, IP VIETNAM will conduct a substantive examination of the GI application to determine whether it meets the requirements for protection as a GI in Vietnam. The following issues will be examined by IP VIETNAM in the course of substantive examination:

- Whether an object stated in a GI application is considered incompatible with the type of GI protection title (*i.e. whether it is not a visible sign used to indicate a product originating in a specific area, locality, territory or nation according to the provisions of Clause 22, Article 4 of Vietnam IP Law*).
- Whether there exists a geographical area subject to the GI stated in the application;
- Whether the product originates in the above geographical area;
- Whether the product has a given nature/quality and/or reputation dictated by geographical conditions of the above geographical area according to the provisions of Article 82 of the Intellectual Property Law.
- Whether the GI sought for registration has become a common name of goods in Vietnam;
- Whether the GI which belongs to a foreign country is not protected or ceases to be protected or has fallen into disuse in that country;
- Whether the GI sought for registration in Vietnam is identical or similar to a protected mark in Vietnam and its use can mislead as to the origin of a product;
- Whether the GI misleads consumers as to the true geographical origin of the product bearing it.

#### **Informing of substantive examination result:**

On the date of expiration of the time limit for substantive examination of a GI application at the latest, IP VIETNAM shall send to the applicant one of the following notices:

##### *Notification of intention to grant protection:*

If the object claimed in the GI application meets protection conditions, IP VIETNAM shall issue a "**Notification on intention of granting protection**" and set the time limit of 03 months from the issuance date of the notification for the applicant to pay registration fee.

##### *Notification of refusal:*

If the object claimed in the GI application does not meet the protection conditions, IP VIETNAM shall issue a **“Notification of refusal”**, in which clearly stating the reason(s) of refusal and setting a time limit of 03 months from the issuance date thereof for the applicant to give opinions. A 3-month extension request is acceptable if requesting in writing by the applicant.

If the correction and response to the notification of refusal of the applicant is accepted, IP VIETNAM shall issue a **“Notification on intention of granting protection”**. Otherwise, IP VIETNAM will issue **“Decision of Refusal”**.

The applicant shall have right to appeal IP VIETNAM’s Decision of Refusal within 90 days from the date of awareness or receipt thereof or file a lawsuit against IP VIETNAM’s Decision of Refusal within 01 from the date of awareness or receipt thereof.

### **Step 3: Grant, registration and publication of Certificates of registered geographical indications:**

Within 15 days after the applicant makes full payment of the registration fees as required, IP VIETNAM shall carry out the procedures for granting Certificate GI Registration and recording in the National Register of Geographical Indications.

All decisions on granting the GI Certificate Registration shall be published in the Industrial Property Official Gazette within 02 months from the issuance date of the Decisions.

Timeline: In a smooth case, it may take 12-15 months from the filing date to obtain a GI Registration Certificate in Vietnam.

### **How is a GI application examined in Vietnam?**

The examination of a GI application in Vietnam is carried out by IP VIETNAM, which is responsible for administering GI protection in Vietnam. Here is an overview of the GI examination process in Vietnam:

A GI application will be firstly examined as to formality, then, published on the Industrial Property Gazette of Vietnam, and substantively examined thereafter and grant of protection if meeting requirements of protection under the laws of Vietnam.

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- Whether the GI sought for registration has become a common name of goods in Vietnam;
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## What are the main reasons for refusal of registration of a GI in Vietnam?

There are several reasons why a geographical indication (GI) application may be refused registration in Vietnam. Here are some of the main reasons:

- (i) **Conflict with prior rights:** The product may conflict with prior rights, such as trademarks or other GIs, that are already registered or pending registration in Vietnam.
- (ii) **Lack of distinctiveness:** The product does not have distinctive qualities or characteristics that can be attributed to its geographical origin.
- (iii) **Lack of evidence:** The application does not provide sufficient evidence of the link between the product and the geographical area, or of the product's reputation and recognition in the marketplace.
- (iv) **Generic or misleading terms:** The product's name may be too generic or misleading, making it difficult to distinguish from other products in the marketplace.
- (v) **Non-compliance with formal requirements:** The application may not meet the necessary formal requirements, such as missing or incomplete documents or inaccurate information.
- (vi) **Violation of public order or morality:** The product's name or characteristics may be considered offensive or contrary to public order or morality.

If a GI application is refused registration, the applicant may file an appeal with the NOIP or challenge the decision in court. It is important to note that the examination of GI applications in Vietnam is a complex and lengthy process, and it is recommended to seek legal advice from a qualified professional to ensure that all necessary requirements are met.

## Whether a GI can be protected under an International IP Agreement?

Vietnam entered two significant international trade deals in 2018-2019 that require, among other things, a higher standard of intellectual property protection in Vietnam. The first is the Comprehensive and Progressive Trans-Pacific Partnership Agreement ("**CPTPP**"), which was signed in March 2018 and took effect on 14 January 2019. The second is the EU-Vietnam Free Trade Agreement ("**EVFTA**"), which was signed in June 2019 and entered into force on 1 August 2020.

EVFTA is a free trade agreement between the EU and Vietnam. The EVFTA is one of the most comprehensive and ambitious free trade agreements that the EU has ever signed with a developing country. It covers a wide range of areas, including trade in goods and services, investment, intellectual property, and sustainable development. One important aspect of the EVFTA is its recognition and protection of geographical indications (GIs). GIs are products that have a specific geographical origin and possess qualities or a reputation that are attributable to that origin. Under the EVFTA, 169 European GIs are recognized and protected in Vietnam, including well-known products such as Champagne, Parmigiano Reggiano, and Roquefort cheese.

Conversely, the EU recognizes and protects 39 Vietnamese GIs, including products such as Phú Quốc fish sauce and Buôn Ma Thuột coffee. The recognition and protection of GIs under the EVFTA help to protect the reputation and quality of these products and provide benefits to producers, consumers, and regional economies.

## How does EVFTA affect GI registration and protection in Vietnam?

The EVFTA has a significant impact on GI registration and protection in Vietnam in the following ways:

- **Increased protection for European GIs in Vietnam:** Under the EVFTA, Vietnam has agreed to protect 169 European GIs, including famous products such as Champagne, Parmigiano Reggiano, and Roquefort cheese. These GIs will receive the same level of protection as Vietnamese GIs, which will provide increased legal protection for European producers.
- **Streamlined GI registration process:** The EVFTA provides for a streamlined process for GI registration in Vietnam, which should make it easier and faster for European producers to

register their GIs in Vietnam. The agreement also provides for cooperation between Vietnam and the EU on GI protection, which should help to facilitate the registration process.

- **Cooperation and information exchange:** The EVFTA encourages cooperation and information exchange between the EU and Vietnam on GI protection, providing a framework for sharing best practices and promoting greater understanding of each other's GI systems.
- **Promotion of sustainable agriculture and rural development:** The EVFTA includes provisions that promote sustainable agriculture and rural development in Vietnam, including the promotion of GIs. This should help to support local communities and traditional production methods, while also promoting high-quality products that are associated with specific geographical areas.
- **Improved enforcement of GI protection:** The EVFTA provides for improved enforcement of GI protection in Vietnam, including stronger measures to prevent the misuse of GIs and the unauthorized use of protected indications, including through the use of civil and criminal penalties for infringement. This should help to deter unauthorized use of GIs, protect the reputation and quality of GIs, while also promoting fair competition and consumer confidence.

In a nutshell, the EVFTA strengthens GI protection in Vietnam and provides new opportunities for Vietnamese and EU producers to benefit from GI registration and protection. By promoting greater cooperation and information exchange between the EU and Vietnam, the EVFTA helps to create a more robust and effective system of GI protection that benefits producers and consumers alike.

### What are the differences between GI, Collective and Certification marks?

**Geographical Indication:** A GI is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In other words, a GI is used to indicate that a product is from a specific region and has certain qualities or characteristics that are unique to that region. Examples of GI products include Champagne, Scotch Whisky, and Darjeeling tea.

**Collective marks:** A Collective mark is a sign used by members of a particular association, cooperative, or organization to indicate that their products or services come from a particular source. In this case, the members of the association or organization share a common interest or goal, and the collective mark helps to distinguish their products or services from those of other producers or service providers.

**Certification marks:** A Certification mark is a sign used on products or services to indicate that they meet certain standards or qualifications. Unlike a GI or Collective mark, which identifies the origin or source of a product, a Certification mark indicates that the product or service has been independently verified to meet specific criteria.

Some differences in terms of entitlement, functions and validity of GI, Collective and Certification marks are additional provided below:

#### Entitlement to register:

**Geographical Indication:** The right to register a GI is given to a group of producers, a particular region or locality, or an authority representing them. The registration is based on the characteristics of the product, its reputation, and its association with the geographic region.

**Collective Mark:** The right to register a Collective Mark is given to an association or group of persons who use the mark to distinguish their goods or services from those of others. The registration is based on the distinctiveness of the mark and the association or group that uses it.

**Certification Mark:** The right to register a Certification Mark is given to a person or organization that provides certification services to verify the quality, origin, or other characteristics of goods or services. The registration is based on the certification services provided and the rules and standards used for certification.



**Function:**

- Function: **certify** (*origin, quality, safety, etc.*) of goods or services bearing such mark => Certification mark.
- Function: **distinguish** goods/services of members of an organization which is the owner of such mark from marks of non-members of such organization => Collective trademark
- Function: **identifies** a product as originating from a specific region, locality, territory or country => GI

**Terms of validity:**

- **Geographical Indication:** The validity of a GI is indefinite, as long as the product continues to have the characteristics and reputation associated with the geographic region.
- **Collective Mark:** The validity of a Collective Mark is renewable every 10 years, as long as the association or group that owns the mark continues to exist and use the mark.
- **Certification Mark:** The validity of a Certification Mark is renewable every 10 years, as long as the person or organization that provides certification services continues to meet the standards and rules for certification.