

Why should figurative marks and product labels be registered as copyright in Vietnam?

Surprise, shock, bewilderment, anxiety, pessimism and a scenario that all doors are closed is a common state/feeling that many foreign trademark owners fall into when they discover that their trademarks, even their product packagings have been filed for trademark or industrial design registration by a third party in Vietnam. Other holders are desperate that the risk of business strategy in Vietnam will be broken down/jeopardized when they detect that their trademarks and/or their product labels being copied in their entirety, or only some minor changes thereof are made by the third parties for the purpose of business exploitation.

Obviously, registering a trademark or industrial design in a country where you are doing business or planning to do business is extremely necessary. In Vietnam, in the context that the registration of a trademark or industrial design takes quite a long time from 18-24 months for trademarks and 8-15 months for industrial designs, it will not be definitely enough to register only Trademarks / Industrial Designs. The hereinbelow cases are given to provide a broader view of the sophistication of IP theft in Vietnam and why foreign companies should register trademarks and product packaging as copyrights in Vietnam.

Background

Case 1: Prospan cough medicine v. PROSTIBAME cough syrup supplements



“PROSPAN” is a brand name of cough medicine owned by Engelhard Arzneimittel GmbH & Co. KG. (“Engelhard Arzneimittel”), a 140-year-old pharmaceutical manufacturer based in Germany. “PROSPAN” Trademark was registered in Vietnam. The “PROSPAN” cough medicine products have been widely advertised in Vietnamese media and is a popular and indispensable product in every Vietnamese family’s medicine box. However, their distributor, SOHACO Pharmaceuticals Company, discovered that a dietary supplement manufacturer in Vietnam had commercialized PROSTIBAME cough syrup products with a highly similar packaging compared to that of the “PROSPAN” cough medicine.

Case 2: HAICNEAL medicated shampoo v. HAINOZAL cosmetic shampoo

“HAICNEAL” is a pharmaceutical brand name for medicated shampoos manufactured by DIHON – a Chinese pharmaceutical corporation. DIHON's Vietnamese distributor discovered that a company in Hai Duong province, Vietnam had been manufacturing and marketing cosmetic shampoos bearing the "HAINOZAL" sign similar in appearance to the "HAICNEAL" shampoo packaging of DIHON.

What is the legal route to handle the above cases?

Despite having registered trademark in Vietnam, Engelhard Arzneimittel cannot rely on the trademark rights to deal with the competitor's behavior because the “PROSTIBAME” trademark is completely different from the “PROSPAN” trademark. Similarly, DIHON cannot rely on the “HAICNEAL” trademark to fight against the Vietnamese company because the “HAINOZAL” trademark is deemed different from the “HAICNEAL” trademark.

However, based on the fact that the packaging of "PROSPAN" and "HAICNEAL" products have been widely used and advertised in commerce in Vietnam, KENFOX IP & Law Office has advised these companies to handle the cases on the [unfair competition](#) ground. In order to win the case of unfair competition, the right holder is obliged to provide a lot of documents to prove that the trademark has been widely used in Vietnam, has acquired a good reputation and has become the "*commercial indications*" in Vietnam in good time before the third party uses its packaging. Under the strategic consultation of KENFOX IP & Law Office, a petition to handle unfair competition with a lot of supporting documents has been submitted to the Enforcement Authority of Vietnam. Both cases were then successfully resolved when the Enforcement Authority concluded that the competition was unfair.

What needs to do if the packaging of your products is illegally copied in Vietnam?

Imagine a situation when you have not yet commercialized your products in Vietnam, there have appeared competing products with identical packaging but different brands. Obviously, in order to handle the case according to the provisions of "*unfair competition*" legislation, you must prove that your labels/packages have been widely used in commerce in Vietnam and the prestige and reputation of the products bearing such labels/packages have been well-known to local customers. This is clearly a requirement that cannot be met if you are just starting to sell your products in Vietnam.

Register your trademark, industrial design, product packaging in form of copyright at the Copyright Office of Vietnam without delay. Copyright registration at the Vietnam Copyright Office can be an effective solution in many cases:


- (i) **Opposition against trademark applications:** A copyright registration certificate issued by the Copyright Office of Vietnam is considered as a valid document demonstrating that you are the legitimate owner of the protected work. You can use the [Copyright Registration Certificate](#) as a basis to prove that your intellectual property rights have been established before the other party applies to register a trademark in Vietnam to request the Intellectual Property Office of Viet Nam not to grant a protection title to the other party. Of course, the chance of success in trademark opposition does not depend merely on proving that you have been granted a Copyright Certificate by the Copyright Office of Vietnam.
- (ii) **Handling the situation of copying, stealing intellectual property while you do not have a Trademark Registration Certificate and/or Industrial Design Patent in Vietnam:** Expertise Center of Copyright and Related Rights (ECCR) has come into operation and received petitions for assessment of copyright and related rights infringement in Vietnam. Therefore, if you are granted a Copyright Certificate, you can file a petition to [ECCR](#) for expert conclusion/assessment, based on which you may request the Vietnamese enforcement authority to handle the act of copyright infringement.
- (iii) **IPR Infringement Warning/Cease and Desist letters:** You can use the Copyright Registration Certificate as a legal tool to notice and warn those who have been, are and will be infringing your IP rights.
- (iv) **Defend yourself against allegations of IPR infringement from other right holders:** It is possible that one day your trademark will be successfully registered by a third party and they will send a Cease and Desist Letter or request actions from Vietnamese enforcement authorities. A Copyright Registration Certificate issued by the Copyright Office of Vietnam at this time can be a legal tool to help you defend the use of your trademark/package and also a measure to let the trademark speculator see that it is not easy to treat your goods based on a trademark registration in bad faith.

The cases in practice: Conflict between copyright and trademark?

Case 1: A typical copyright-trademark case from Korean company in Vietnam

Vietnamese consumers are familiar with Korean goods due to their diversity, attractive design, and reasonable price. This attracts a large number of dishonest traders who desire to earn illegal profits by commissioning the production of products with trademarks and packaging identical or very similar to Korean brands to deceive Vietnamese consumers.




Laorganic, the owner of “Foellie” (), a well-known brand in Korea and in Vietnam detected various counterfeit products being advertised in e-commerce websites in Vietnam. This company finds difficult to request Vietnamese enforcement authorities or other relevant competent authorities to take actions because their trademark application for “Foellie” has not been granted protection in Vietnam. [Mr. Quan, Nguyen Vu](#), an IP Attorney of KENFOX IP & Law Office advised Laorganic to immediately register the mark “Foellie” in form of copyright in Vietnam within 15 working days. Based on the Copyright Registration Certificate, Laorganic filed a request for copyright infringement assessment ECCR. ECCR then issued a copyright assessment which concludes that the use of the “Foellie” copyrighted logo is a copyright infringement. With the Copyright Registration Certificate issued by the Copyright Office of Vietnam and ECCR’s copyright infringement assessment, Laorganic sent requests to Shopee and Lazada, two largest e-commerce websites in Vietnam to remove (or disable) the infringing accounts or links which contain the “Foellie” copyrighted logo. Realizing that Laorganic is currently a copyright owner in Vietnam, Shopee and Lazada agreed to remove a lot of the infringing accounts or links out of their e-commerce websites.

Case 2: Can foreign entities use copyright to fight against [trademark squatting](#) in Vietnam?

To answer the above question, please see a relevant case below.

In a recent copyright-trademark case ruled by the Intellectual Property Office of Vietnam, Musidor B.V., the

owner of the famous rock band “The Rolling Stone” who is the copyright owner of the logo  with the common name “Tongue and Lips logo”. Musidor B.V. detected that a third party had applied for and used the



logo “**HANOI ROCKS** **HOSTEL**” for a hotel in Hanoi, Vietnam as well as in commercial activities, websites and social networking accounts such as Facebook, Instagram, YouTube, etc. without their permission. Musidor B.V. filed a Notice of Opposition against the third party’s trademark based on two grounds, (i) the mark “The Tongue and Lips logo” by Musidor B.V. is a well-known mark, widely used and known trademark, protected by trademarks in more than 50 countries around the world before the time the infringer files a trademark application in Vietnam and (ii) the infringer’s trademark contains the “Tongue and Lips logo” almost identical to Musidor B.V.’s logo qualified as a work of applied art and protected as copyright under Berne Convention to which Vietnam is a member. The Intellectual Property Office of Vietnam accepted Musidor B.V.’s opposition and refused registration of the infringer’s mark due to its confusingly similar to the applied art work “The Tongue and Lips logo” by Musidor B.V. according to Article 39.4(g) [Circular No. 01/2007/TT-BKHCHN](#).

Final thoughts

The registration of trademarks and/or industrial designs in Vietnam is unquestionably necessary. However, you do not have a legal basis to request intervention from the authorities if the Trademark/Industrial Design is still being appraised and has not been awarded a Protection Title. Waiting 1-2 years to address IPR infringement is too late, and your company may become entirely swallowed/overwhelmed by counterfeit and infringing goods.

Meanwhile, a logo/product packaging may qualify for protection as a trademark/industrial design and/or copyright. As a matter of principle, copyright of a work usually arises before trademark rights and is at the core of creativity. Copyright registration has several advantages: **(i)** Inexpensive; **(ii)** Much faster than Trademark/Industrial design registration and **(iii)** Copyright Registration Certificate can be used to combat IPR infringement. Therefore, besides registering Trademarks/Industrial Designs, priority should be given to registering figurative trademarks, logos, product packaging as copyright as soon as you design them.

Currently, apart from trademark and industrial design registration, various entities choose to register their figurative marks and product packaging as copyright because of the superiority of the copyright protection mechanism in Vietnam, especially when the ECCR has carried out the assessment of copyright and related rights infringement at the request of IPR holders and Vietnamese enforcement authorities.

KENFOX IP & LAW OFFICE, one of the professional IP service providers with the strongest and fastest growth in patent services, offers a comprehensive range of IP services in Vietnam, Laos, Cambodia, Myanmar, and other Asian nations. KENFOX entered the list of the top ten patent filing companies at IP Vietnam in 2019. In 2020 and 2021, KENFOX ranked among Vietnam's top 20 patent filing firms. KENFOX is proud to be consistently voted “Boutique Trademark Law Firm of the Year in Vietnam” by major international organizations in 2021-2022 by Global Law Experts and “Laos IP Firm of the Year for the 2021 Asia IP Awards” by Asia IP.

Contact KENFOX IP & Law Office immediately if you need a professional intellectual property services firm to assist you in developing your business in the proper direction.

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