

## Key takeaways from the recent trademark assessment conclusion issued by the Vietnam Intellectual Property Research Institute

### Background:

HOA SEN Vietnam Co., Ltd, a company engaged in design, art design, advertising, and communication.

In **2013**, HOA SEN Company registered a mark including the verbal element "HOA SEN" in combination with a number of other elements (**HOA SEN, device**) at the Intellectual Property Office of Vietnam ("[IP Vietnam](#)") for 04 classes of services including:

Trademark: HOA SEN, device  
 Class 35: *Advertising services, presentation/display of goods on communication media for sales.*  
 Class 40: *Printing services.*  
 Class 41: *Television program production activities; photography; organizing cultural, artistic and sports events*  
 Class 42: *Print product design service*

In 2017, the distributor and sales agent of HOA SEN Company, IDEA Vietnam Co., Ltd ("**IDEA Company**"), was discovered to have been using a logo featuring the verbal element "HOA SEN" on various platforms such as websites, Facebook, quotations, name cards, and brochures to promote their "calendar" products.

HOA SEN Company submitted a request to the Vietnam Intellectual Property Research Institute ([VIPRI](#)) to obtain an assessment conclusion on the use of the "HOA SEN, device" sign on IDEA VIETNAM's business materials for the sale and advertising of printed calendars. The purpose of the request is to establish a basis for requesting the other Vietnamese enforcement agencies to handle the case. Specifically, HOA SEN Company seeks to determine whether the use of the "HOA SEN, device" sign in order to introduce, sell, offer for sale, advertise to sell printed calendar products infringes on their rights to the "HOA SEN, device" mark, which is protected for "*advertising services, presentation/display of goods on communication media for sales*" in Class 35.

After examining the assessment request, VIPRI determined that "*Even though IDEA Company's use of the "HOA SEN, device" sign is identical to HOA SEN Company's registered trademark, the "printed calendar" product differs in nature, function, and target audience from the protected services in Class 35, which involve promoting and presenting products on various media for sales purposes targeted at businesses/individuals with commercial activities. As a printed paper product for tracking time and planning, calendars are usable by all types of consumers*". Therefore, VIPRI concluded that there is insufficient evidence to support the claim that IDEA Company's use of the "HOA SEN, device" sign is an infringement on the trademark rights of HOA SEN Company.

### What factors does VIPRI consider when interpreting the scope of protection for trademarks in its assessment conclusions?

It is entirely possible for conflicting opinions to arise in this case, as the line between what is considered right or wrong is heavily dependent on each party's subjective views. In fact, when faced with the same problem, there can be numerous distinct perspectives and assessments.

Article 11 of [Decree 105/2006](#), as amended in 2009, specifies that in order to identify a trademark infringing element, it is crucial to take into account the "scope of trademark protection". The determination of the trademark's protection scope is based on two factors: (i) the trademark itself, and (ii) the list of goods/services indicated in the trademark registration certificate.

The trademark "HOA SEN, device" is safeguarded for Class 35 services, which includes "*presenting/displaying **goods** on communication media for sales.*" This registered service is extensive and all-encompassing. Therefore, the scope of trademark protection can be construed to cover all kinds of "**goods**" in society, without any specific item being excluded. The product "**calendar**," on the other

hand, is designed for sale to the general public and not only to individuals or companies engaged in business activities, as VIPRI clarifies.

Given that the service category is safeguarded as "*presentation/displaying of **goods** on communication media for sales,*" the product "**calendar**" is fully encompassed by the protection afforded to "*presentation/calendar of **goods** on communication media for sales.*"

As per the law, a trademark must be protected as if it were granted a Protection Title. The service of "*presentation/displaying of **goods** on communication media for sales*" is all-encompassing and broad-ranging. HOA SEN Company **has not specified any particular product or service for this presentation/displaying service**. Consequently, it can be understood that the service of "*presentation/displaying of **goods** on communication media for sales*" has a vast scope of protection and is not restricted in any way. The trademark owner is entitled to introduce any "**goods**" for sale through this service. As for the product "**calendar**," it is a type of goods that is produced, supplied, and sold to consumers. Hence, it can be entirely introduced, presented, and displayed in the media for sale. In other words, the product "calendar" falls entirely within the scope of the service of "*presentation/displaying of **goods** on communication media for sales.*"

The assessment conclusion by VIPRI that the product "**calendar**" is not within the purview of the service of "*presentation/displaying of **goods** on communication media for sales*" has resulted in the trademark owner being deprived of their trademark rights or has limited the scope of protection offered by the trademark. The issue at hand is whether HOA SEN Company has the right to present or display the calendar on communication media for sales under the protected service of "*presentation/displaying of goods on communication media for sales.*"

Given that the registered and protected service (which is not limited to any product) encompasses "*presentation of **goods** on communication media for sales,*" HOA SEN Company has the right to introduce products such as the "calendar" or any other goods in the media for sale, in accordance with the nature and scope of the registered service.

#### Whether VIPRI made a mistake about the assessment request?

HOA SEN Company enlisted the services of VIPRI to assess the service of "**introducing, offering for sale, and advertising calendar products** on means of business of IDEA Company" in comparison to the protected service of "*presentation of goods on communication media for sales.*" HOA SEN Company did not request VIPRI to evaluate the specific product of IDEA Company, which is the calendar. The action taken by IDEA Company is to introduce, offer for sale, and advertise printed calendar products rather than producing them. Thus, it can be deduced that the service of "*introducing, offering for sale, and advertising printed calendar products*" falls within and/or is encompassed by the scope of the service of "*presentation of goods on communication media for sales.*"

Assessment request	Explanation of the assessment conclusions of VIPRI	Perspective from HOA SEN Company
<p>The service of "<i>presentation/displaying of <b>goods</b> on communication media for sales</i>" in comparison with the service of "<i>introducing, offering for sale, advertising</i>" printed calendar products"</p>	<p>Explanation: <u>The product under review "printed calendar"</u> is considered different from the protected services in terms of nature, function and target audience...</p>	<p>HOA SEN Company <b>did not request</b> VIPRI to compare or evaluate the "printed calendar product" itself. VIPRI's assessment conclusion regarding the "<i>printed calendar product</i>" <b>is not</b> relevant to the subject of the assessment request. HOA SEN Company did not submit the printed calendar products for assessment. The assessment request was solely to determine whether the "introduction, offering, and advertising services" of printed calendar products provided by IDEA Company are within the scope of the service "presentation/displaying of goods on communication media for sales" bearing the mark "HOA SEN, device" of HOA SEN Company.</p>

		<p>The accused infringing party, IDEA Company, provides a similar service to HOA SEN Company, which involves <b>introducing, advertising, and offering for sale products</b>. Specifically, IDEA Company is introducing and advertising "<b>printed calendars</b>," which falls within the scope of the "<b>goods</b>" generally introduced, advertised, and offered for sale that are protected under HOA SEN Company's trademark.</p>
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### What can be done about VIPRI's assessment conclusions?

HOA SEN Company has the option to request a re-assessment procedure from VIPRI. In order to do so, they will need to submit compelling arguments and analyses that point out any unjustified assessments made in VIPRI's previous conclusion. If VIPRI finds that the arguments presented for the re-assessment are valid, they may revise their previous conclusion and issue a new one. KENFOX IP & Law Office has assisted numerous trademark owners in successfully challenging adverse assessment conclusions made by VIPRI.

### Key takeaways

#### 1. Specifying the goods/service in Class 35 is better to fight against trademark infringement in Vietnam

It is essential to specify the particular goods in Class 35 when registering a trademark that pertains to services of introducing, advertising, selling, or purchasing multiple goods. Although these services are generally considered broad, VIPRI tends to focus on specific goods during assessment and evaluation. Therefore, failing to explicitly indicate specific goods within the services can result in an unfavorable assessment conclusion when compared to a specific product advertised, introduced, or offered for sale on the means of business.

If the "goods" in the service of introducing, advertising, selling, or purchasing multiple goods in Class 35 does not specify any specific goods, VIPRI will deem that it does not target any specific goods. As a result, if a third party uses a sign identical to a registered trademark protected for "the service of introducing, advertising, selling, or purchasing multiple goods," the specific goods introduced, advertised, or sold by the adverse party will not fall within the scope of the service. Essentially, the introduction, advertisement, and sales of a specific product by the adverse party will be deemed dissimilar from the introduction, advertisement, and sales of multiple goods protected by the registered trademark.

Therefore, it is essential to provide detailed information on specific goods within Class 35 when applying to register a trademark in Vietnam.

#### 2. Trademark protection in Vietnam: When specificity matters more than broadness

When a Trademark Registration Certificate is granted for a trademark that meets the protection requirements, the extent of protection for that trademark is determined by the trademark and the list of products and services specified in the trademark application. This means that trademarks are only protected in relation to the products or services that are explicitly listed in the trademark registration application.

If you register a trademark for a specific service or product, such as "Deein" for the service of "real estate", the protection of your trademark will only extend to that specific service or product. This means that if a third party uses your trademark "Deein" for the same real estate service, you can take legal action against them for unauthorized use. However, if they use your "Deein" trademark for other services such as "restaurant, cafe, printing, cosmetology, hospital", they will not be infringing on your trademark rights for "real estate" service.

HOA SEN Company assumes that the service it registers with the trademark in Class 35, "*presentation of goods on communication media for sales*," has an unrestricted scope of protection, allowing the

introduction and sale of **any "product."** As "**calendar**" is a product that HOA SEN Company produces, supplies, and sells, it can be fully "introduced/sold" on communication media under the service "*presentation of goods on communication media for sales.*" Therefore, HOA SEN Company believes that it is not necessary to register the product "printed calendar" or specify the type of product for the service of "*presentation of goods on communication media for sales*" in Class 35. Listing such a service would provide the broadest scope of trademark protection.

HOA SEN Company's failure to specify or list the product "printed calendar" in the service of "presentation of goods on communication media for sales, namely, printed calendar" in Class 35 may be the reason why VIPRI believes that there is insufficient evidence to establish a violation, even though Vietnamese enforcement authorities may reach a different conclusion.

### 3. VIPRI's ruling should not be seen as the end of the road

In certain cases that KENFOX IP & Law Office has dealt with, there have been instances where VIPRI concluded that no infringement took place, but the Inspectorate of the Ministry of Science and Technology (**IMOST**) still found violations and reached a contrary conclusion to VIPRI. This indicates that the two state agencies hold opposing perspectives on intellectual property issues. Additionally, there was a case where VIPRI determined that an infringement had occurred upon assessment, but IP VIETNAM provided an expertise opinion that no infringement had taken place.

### 4. Importance of accurately identifying goods/services in trademark applications

To ensure the maximum protection for your trademark and avoid infringements by third parties, it's crucial to specify the goods/services that your trademark represents in your application. While some trademark owners prefer to register general categories of goods/services, this approach can have both benefits and drawbacks. Therefore, it's essential to accurately and unambiguously identify the nature of the goods/services and list them in your trademark application to establish clear boundaries for your trademark protection.

To fully safeguard your trademark against infringement by third parties, it is crucial to have a comprehensive understanding of intellectual property laws. If you lack such knowledge, it may be challenging to protect your trademark to the maximum extent possible. To avoid such pitfalls and ensure that your business grows in the right direction, it is advisable to seek professional assistance from [KENFOX IP & Law Office](#), an experienced intellectual property service company. Get in touch with us today to explore how we can support you.

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