

Protecting your IPR in Vietnam – A Guide to VIPRI's Services and Expertise

1. What services does Vietnam Intellectual Property Research Institute offer?

The Vietnam Intellectual Property Research Institute ([VIPRI](#)) is a research institution under the Ministry of Science and Technology that provides expert opinions on IP infringement cases concerning **industrial property** subject matters such as inventions, industrial designs, designs of semi-conducting closed circuits, trade secrets, marks, trade names, and geographical indications.

IPR holders who suspect that their IP rights have been violated may request VIPRI to provide assessments or expert opinions on the scope of protection of their IP rights, assess similarity, determine infringing elements, and determine damages. However, at present, VIPRI's services are limited to providing assessments and opinions on **inventions, industrial designs, geographical indications, and trademarks**, due to limited human resources. It does not provide opinions on matters of unfair competition, trade name, or copyright.

2. Why to obtain VIPRI's expert opinions before petitioning Vietnamese enforcement bodies to handle alleged IPR infringement?

- **Not binding, but strongly recommended:** While VIPRI's opinions are not binding or mandatory, they are strongly recommended to include in the petition for handling IPR infringement cases. This is because VIPRI is an accredited institution under the Ministry of Science and Technology and is recognized as an expert in the field of IP. Therefore, its opinions are considered highly credible and influential. Thus, VIPRI's opinions can greatly influence the outcome of the case, particularly if they are in favor of the IPR holders.
- **Very important to Vietnamese enforcement authorities:** The role of VIPRI in the Vietnamese legal system highlights the importance of expert opinions in addressing IP infringement cases. Given the complex nature of IP law, expert opinions can help clarify legal issues and provide a more accurate assessment of the merits of a case. This, in turn, can lead to more informed decisions by Vietnamese administrative enforcement agencies (e.g. [Market Management Bureau](#), [Economic Police](#), [Inspectorate of the Ministry of Science & Technology](#)) and the courts.
- **Helpful to IPR holders:** VIPRI's assessments and opinions can assist in resolving disputes between parties and encourage respect for IP rights in Vietnam. Many IPR holders use VIPRI's assessment conclusions/expert opinions in favor thereof as initial evidence and send Cease & Desist Letters ([C&D Letter](#)) to alleged infringers. In various cases handled by KENFOX IP & Law Office, upon receipt of a C&D Letter enclosed with VIPRI's assessment conclusions/expert opinions, the alleged infringers accepted to cease their infringement.
- **Should not be deemed as the end of the road:** Not all of VIPRI's opinion/assessment conclusions that there is no infringement will result in Vietnamese enforcement authorities refusing to handle a trademark infringement case. The authorities may still view the case as an infringement, regardless of VIPRI's assessment. Vietnamese enforcement authorities may not always follow its assessment conclusions. In addition, the scope of protection for IPRs may vary depending on the specific facts and circumstances of each case, and VIPRI's assessment conclusions may not necessarily apply to every situation.

3. What steps does VIPRI take to determine there is an IPR infringement over a registered trademark?

VIPRI takes the following steps to determine whether there is an Intellectual Property Rights (IPR) infringement over a registered trademark:

- **Review of relevant laws and regulations:** VIPRI conducts a review of the relevant laws and regulations related to trademarks and IPR protection in Vietnam. This step ensures that the assessment is conducted in accordance with the legal framework in Vietnam.

- **Examination of evidence:** VIPRI examines the evidence provided by the requester. This may include a comparison of the registered trademark with the alleged infringing mark to determine if there are any similarities that could create confusion among consumers. The analysis may also consider other factors such as the products or services associated with the marks, the channels of trade used by the parties, and the geographic scope of the use of the marks.
- **Assessment Report:** VIPRI then prepares an assessment report that provides its expert opinion on whether there is an IPR infringement over the registered trademark. The report may include an analysis of the evidence, an interpretation of the relevant laws and regulations.

4. How does VIPRI compare a registered trademark with an alleged infringing mark?

VIPRI compares a registered trademark with an alleged infringing mark using a process called a similarity analysis to determine whether there is a likelihood of confusion among consumers. Here are a few examples:

- **Visual Comparison:** VIPRI may visually compare the registered trademark with the alleged infringing mark to determine if there are any similarities that could create confusion among consumers. This analysis may include a review of the shape, color, font, and other visual elements of the marks.
- **Phonetical Comparison:** VIPRI may conduct a phonetic comparison of the registered trademark and the alleged infringing mark to determine if they sound similar when pronounced. This analysis may be particularly relevant for trademarks that include words or phrases.
- **Conceptual Comparison:** VIPRI may also conduct a conceptual comparison of the registered trademark and the alleged infringing mark to determine if they convey a similar message or meaning. This analysis may be relevant for marks that include symbols or logos.
- **Trademark Search:** VIPRI may also conduct a trademark search to determine if the alleged infringing mark is already registered in Vietnam. This search can help identify potential conflicts and assess the likelihood of confusion among consumers.

5. What challenges does VIPRI face when assessing the scope of protection for trademarks, and how does it address these challenges?

VIPRI faces several challenges when assessing the scope of protection for trademarks. Some of these challenges include:

- **Trademark similarity:** Determining the degree of similarity between two trademarks can be challenging, especially when trademarks have similar words or elements. VIPRI addresses this challenge by using a similarity assessment methodology that considers various factors such as visual, phonetic, and conceptual similarity.
- **Geographic scope:** VIPRI needs to assess the geographic scope of a trademark to determine its protection. This can be challenging when a trademark is used on a website but target Vietnamese consumers. VIPRI addresses this challenge by considering the territorial principle of trademark protection and examining the extent of use of the allegedly infringing sign to reach its assessment conclusion.
- **Distinctiveness:** A trademark must be distinctive to be protected. However, determining the level of distinctiveness can be subjective and difficult. VIPRI addresses this challenge by examining the inherent distinctiveness of the trademark in compared to an allegedly infringing sign.
- **Prior rights:** VIPRI needs to ensure that the trademark being assessed does not infringe on prior rights, such as copyrights or other trademarks. VIPRI addresses this challenge by conducting a thorough search of prior rights and considering their potential impact on the scope of protection for the trademark.

In summary, VIPRI addresses these challenges by using a rigorous methodology to assess the scope of protection for trademarks. This includes considering various factors such as trademark similarity, geographic scope, distinctiveness, trademark dilution, and prior rights.

6. How do trademark owners in Vietnam use [VIPRI's assessment conclusions](#) to protect and enforce their trademark rights?

Trademark owners in Vietnam can use VIPRI's assessment conclusions to protect and enforce their trademark rights in the following ways:

- **Filing for trademark registration:** VIPRI's assessment conclusions can help trademark owners determine the degree of distinctiveness and potential infringement of their trademark. Based on this information, trademark owners can file for trademark registration with the Intellectual Property Office of Vietnam to protect their trademark.
- **Opposition proceedings:** If a third-party files an application for registration of a trademark that is similar or identical to the trademark owned by the client, VIPRI's assessment conclusions can be used to file an opposition proceeding to prevent the registration of the conflicting trademark.
- **Infringement proceedings:** VIPRI's assessment conclusions can be used to initiate legal proceedings against infringers who use a similar or identical trademark without permission. The assessment conclusions can be used as evidence to prove the ownership of the trademark and the infringement committed by the infringer.
- **Cease and desist letters (C&D Letter):** VIPRI's assessment conclusions can be used to draft a C&D Letter to inform potential infringers of the trademark owner's rights and demand that they cease using the infringing trademark. The letter can be accompanied by the assessment conclusions as evidence of the trademark owner's ownership of the trademark.
- **Licensing negotiations:** VIPRI's assessment conclusions can be used to negotiate licensing agreements with third parties who wish to use the trademark. The assessment conclusions can be used to establish the value and scope of the trademark, as well as the conditions under which it can be licensed.

In summary, trademark owners in Vietnam can use VIPRI's assessment conclusions to protect and enforce their trademark rights by filing for trademark registration, initiating opposition and infringement proceedings, sending cease and desist letters, and negotiating licensing agreements.

7. How does VIPRI reach an [expert opinion](#) that there is an infringing element to a patented invention?

To reach an expert opinion that there is an infringing element to a patented invention, the Vietnam Intellectual Property Research Institute (VIPRI) typically employs a multi-step process. Here are some general steps that VIPRI may take:

- **Reviewing the patent:** VIPRI will start by reviewing the details of the patent in question, including its claims, specification, and drawings. This helps VIPRI to understand the scope of the patent protection and the specific features of the patented invention.
- **Examining the alleged infringing product or process:** VIPRI will then examine the product or process that is alleged to be infringing on the patent. This will typically involve a detailed analysis of the features and elements of the product or process, as well as a comparison of those features and elements with the claims of the patent.
- **Identifying the elements of the patented invention:** VIPRI will compare the features of the patented invention with the features of the alleged infringing product or process. This helps VIPRI to identify any similarities or differences between the two and determine whether there are any elements of the patented invention present in the alleged infringing product or process.

- **Assessing the scope of the patent:** VIPRI will assess the scope of the patent to determine whether the alleged infringing product or process falls within the scope of the patent claims. This involves a detailed analysis of the language used in the patent claims and an examination of any relevant prior art.
- **Formulating an expert opinion:** Based on the above analysis, VIPRI will formulate an expert opinion on whether there is an infringing element to the patented invention. This opinion will take into account the specific features of the patent and the alleged infringing product or process, as well as any relevant legal and technical considerations.

In light of the foregoing, the process of reaching an expert opinion that there is an infringing element to a patented invention requires a thorough understanding of both the patent and the alleged infringing product or process, as well as relevant legal and technical considerations. The expert opinion of VIPRI is highly regarded in Vietnam and can be used as evidence in legal proceedings related to patent infringement.

8. How does VIPRI compare between a patented invention and an alleged infringing product/process?

To compare between a patented invention and an alleged infringing product/process, the Vietnam Intellectual Property Research Institute (VIPRI) typically follows a process that involves several steps:

- **Examination of the patent:** VIPRI will begin by examining the patent in question to understand its scope and claims. This examination will include a review of the patent's language, drawings, and any other relevant materials.
- **Analysis of the allegedly infringing product or process:** VIPRI will then analyze the allegedly infringing product or process, to determine its features and elements. This analysis will typically involve a detailed review of the product or process, including any relevant documentation, specifications, or other materials.
- **Comparison of the patent and the allegedly infringing product or process:** VIPRI will then compare the patent with the allegedly infringing product or process. This comparison will typically involve a detailed analysis of the features and elements of the product or process, as well as a comparison of those features and elements with the claims of the patent.
- **Identification of similarities and differences:** Based on the comparison and analysis described above, VIPRI will identify any similarities and differences between the patent and the allegedly infringing product or process. This identification of similarities and differences is the basis for the expert opinion regarding infringement.
- **Determination of infringement:** Finally, based on the identification of similarities and differences, VIPRI will determine whether the allegedly infringing product or process infringes on the patent. This determination will take into account the specific language used in the patent claims, as well as the interpretation of that language in light of relevant legal principles.
- In general, the process used by VIPRI to compare between a patented invention and an alleged infringing product or process involves careful examination and analysis of both the patent and the allegedly infringing product or process, as well as consideration of relevant legal principles and industry practices. This allows VIPRI to provide an expert opinion regarding whether there is infringement, which can be used to inform legal action to protect the patent holder's rights.

9. How does VIPRI reach an expert opinion that there is an infringing element to a protected industrial design?

To reach an expert opinion that there is an infringing element to a protected industrial design, VIPRI typically follows a process that involves several steps:

- **Examination of the industrial design:** VIPRI will begin by examining the industrial design in question to understand its scope and features. This examination will include a review of the industrial design's drawings, specifications, and any other relevant materials.

- **Analysis of the allegedly infringing product or design:** VIPRI will then analyze the allegedly infringing product or design, to determine its features and elements. This analysis will typically involve a detailed review of the product or design, including any relevant documentation, specifications, or other materials.
- **Comparison of the industrial design and the allegedly infringing product or design:** VIPRI will then compare the industrial design with the allegedly infringing product or design. This comparison will typically involve a detailed analysis of the features and elements of the product or design, as well as a comparison of those features and elements with the protected industrial design.
- **Identification of similarities and differences:** Based on the comparison and analysis described above, VIPRI will identify any similarities and differences between the protected industrial design and the allegedly infringing product or design. This identification of similarities and differences is the basis for the expert opinion regarding infringement.
- **Determination of infringement:** Finally, based on the identification of similarities and differences, VIPRI will determine whether the allegedly infringing product or design infringes on the protected industrial design. This determination will take into account the specific elements of the protected industrial design, as well as the interpretation of those elements in light of relevant legal principles.

In light of the foregoing, the process used by VIPRI to reach an expert opinion that there is an infringing element to a protected industrial design involves careful examination and analysis of both the protected industrial design and the allegedly infringing product or design, as well as consideration of relevant legal principles and industry practices. This allows VIPRI to provide an expert opinion regarding whether there is infringement, which can be used to inform legal action to protect the industrial design owner's rights.

By Nguyen Vu QUAN
Partner & IP Attorney

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com