

## Trademark Registration in Vietnam: What You Need to Know

Registering a trademark in Vietnam is a crucial step for any business or individual seeking to protect their brand and prevent unauthorized use by others. However, the process of registering a trademark can be complex and involves various steps that must be carefully followed. In order to successfully register a trademark in Vietnam, it is important to understand the availability searches, required documents for filing, the trademark examiner's steps and practices, how to respond to an office action, and the current protection of unconventional trademarks such as sound and smell marks. Additionally, understanding the implications of disclaimers in the trademark protection scope is also critical. In this article, we will explore these important aspects of trademark registration in Vietnam to help you navigate the process with confidence and ensure the best possible protection for your brand.

### 1. Conducting a trademark search in Vietnam: Why and Where?

Prior to submitting a trademark registration application in Vietnam, it is highly advisable to conduct a thorough trademark availability search. This serves the crucial purpose of ensuring that your proposed trademark does not infringe on the rights of another individual or entity who may have already registered a similar or identical trademark for the same or similar goods. By conducting a comprehensive trademark search, you may figure out whether your proposed trademark will face potential legal challenges or disputes in the future.

While a pre-filing trademark search is not mandatory in Vietnam, it is highly recommended due to the significant time, effort, and financial resources that can be saved by avoiding potential trademark conflicts with prior registrants. By conducting a thorough search before developing, adopting, and applying to register a trademark, an applicant can prevent the likelihood of facing legal disputes or objections from prior rights holders. Therefore, it is strongly advised to conduct a trademark search to minimize any potential risks and ensure the smooth registration of your proposed trademark in Vietnam.

A trademark search in Vietnam can be conducted online at the following official websites:

- [http://wipopublish.ipvietnam.gov.vn/wopublish-search/public/trademarks;jsessionid=7EC5107C900B8E6A1BB8C1145C8D3ED9?0&query=\\*. \\*](http://wipopublish.ipvietnam.gov.vn/wopublish-search/public/trademarks;jsessionid=7EC5107C900B8E6A1BB8C1145C8D3ED9?0&query=*.)
- <https://ipplatform.gov.vn>
- <https://www3.wipo.int/madrid/monitor/en/>

### 2. Establishing trademark rights in Vietnam: How and What critical notes?

Trademark rights are established in Vietnam through the process of trademark registration. The registration process is handled by the Intellectual Property Office of Vietnam (**IP VIETNAM**). Once a trademark is registered, the owner is granted exclusive legal rights to use the trademark in connection with the designated goods or services.

In Vietnam, the "**first to file**" principle is followed for trademark registration. This means that the person or entity who files the trademark application first is granted ownership of the trademark in that jurisdiction. However, there are some exceptions to this rule, including prior use, well-known marks, and trade names. These exceptions can provide grounds to overcome the "first to file" principle and establish rights in a trademark even if another party has already filed a trademark application for the same or a similar mark.

Although it is possible to use unregistered trademarks in commercial activities in Vietnam, doing so exposes the user to a range of unpredictable risks. These risks may arise if the use of the unregistered trademark conflicts with prior-registered or well-known marks, or if the trademark is considered to be contrary to morals, good customs. Additionally, using a trademark that suggests a false indication as to the nature, origin, source, or other characteristics of the goods or services may also lead to legal consequences.

Given the potential risks associated with using unregistered trademarks, it is advisable to register a trademark in Vietnam to establish legal ownership and protect against potential legal disputes.

### 3. Obtaining a Trademark Registration Certificate in Vietnam: How long?

In accordance with Vietnamese trademark laws, it typically takes 12 months from the date of filing a trademark application to obtain a Trademark Registration Certificate. However, in practice, the average time for the processing of a trademark application and registration, without facing any opposition, is approximately 16 to 20 months.

#### 4. Advantages of a trademark registration for the owner: What?

The benefits of registering a trademark include the following:

- ✓ **Exclusivity:** The registered owner of a trademark has the exclusive right to commercially use the trademark in Vietnam. The exclusive rights arising out of a trademark registration allow the owner to prevent/deter all others from unlawfully using the trademark, marketing identical or similar products under an identical or confusingly similar trademark.
- ✓ **Easier enforcement against trademark infringements.** A trademark registration provides prima facie evidence of ownership and validity, which usually carries a presumption that you are the owner of the trademark and therefore have the right to prevent use of that trademark by others. This reduces the burden of proof in court proceedings: you don't have to prove that the trademark is valid, that you are its owner or that there is goodwill associated with the trademark. A trademark registration in Vietnam allows the registrant access to bring actions in particular courts (Registration of a trademark allows access to bring actions in the Vietnamese People's Courts in Civil and Commercial Matters and the Criminal Courts in Criminal Matters).
- ✓ **Deterrence:** A trademark registration in Vietnam enables you to use the symbol ® after the trademark, which alerts others to the fact that it is registered. It allows use of "Registered Trademark" or other suitable terms or abbreviations to demonstrate ownership of the trademark. This may help to deter others from unlawfully using the trademark.
- ✓ **Royalties:** A trademark registration in Vietnam provides the owner with the opportunity to generate royalties through licensing. It is easier to sell or license a registered trademark, and usually at a higher price. In addition, while in most countries it is not mandatory, registration makes it simpler to use a trademark in a franchising agreement or in merchandising.

#### 5. Registrable marks in Vietnam: What?

The following signs that can be reproduced graphically and are capable of distinguishing the goods or services of one person or entity from another are registrable as a trademark:

- ✓ words;
- ✓ names;
- ✓ devices;
- ✓ certain three-dimensional shapes (Often an application to register a three-dimensional shape encounters an objection that the mark is not capable of distinguishing the applicant's goods. The likelihood of an objection's being raised depends on the shape and the goods/services claimed)
- ✓ colors (A single-color mark generally is considered not capable of distinguishing, and substantial evidence of use of the mark is required to secure acceptance; but combinations of colors generally are inherently registrable);
- ✓ sounds;
- ✓ trade dress/get-up (only trade dress/get-up with distinctive elements)
- ✓ combinations of the above elements.

#### Other types of registrable trademarks in Vietnam

- ✓ collective marks;
- ✓ certification marks;
- ✓ well-known marks;
- ✓ service marks.

#### 6. Unregistrable marks in Vietnam: What?

Trademarks are a bridge between consumers and producers, helping consumers associate a product with its origin so that they can correctly choose the goods they wish to buy. Thus, the main function of a mark is to distinguish between different businesses' goods/services (i.e. identifying the source of goods/services in the marketplace) and prevent consumers from being confused about the source. Therefore, if a sign is not distinctive, it cannot function as a trademark and its registration should be refused.

The following marks are not registrable in Vietnam.

- ✓ marks contrary to moral standards or public order;

- ✓ generic terms;
- ✓ names, flags or symbols of states, nations, regions or international organizations;
- ✓ non-distinctive trademarks, absent a showing of acquired distinctiveness (secondary meaning);
- ✓ marks that function principally as geographic location names (but not geographical indications or appellations of origin);
- ✓ signs used as a means of advertising;
- ✓ literary, artistic or scientific terms;
- ✓ marks that may mislead consumers
- ✓ technical terms used in the industry.

## 7. Non-traditional marks in Vietnam: What

Trademarks based on a single color, appearance, shape, sound, smell, taste and texture are often difficult to register.

### <i> Three-dimensional shapes (3D marks) in Vietnam:

No separate provisions are set out in the laws of Vietnam concerning registration of a 3D mark. It is possible to register the shape of a product as a three-dimensional trademark, provided the shape performs the function of a trademark in the marketplace. To qualify, the shape of the product must be distinctive. The shape should also not be dictated by the function of the product.

For a 3D trademark application in Vietnam, all images (from different views) of such a 3D mark must be combined in one image so as to be affixed onto the trademark application. The applicant is obliged to submit a two-dimensional representation including all views of the 3D mark to affix onto the trademark application.

A three-dimensional shape mark will be refused registration if it consists exclusively of (a) a shape that results from the nature of the goods themselves; (b) a shape of goods that is necessary to obtain a technical result; or (c) a shape that gives substantial value to the goods.

An application claiming a shape as a trademark must include descriptions and representations that show each feature of the trademark sufficiently clearly to permit proper examination of the trademark. In general, representations of the shape mark should be in the form of perspective or isometric drawings that show clearly all the features of the trademark (usually, top, bottom and side views are required). The parts of the configuration claimed to constitute the trademark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines. The drawings, views and/or photographs of the trademark must also be accompanied by a written description of the trademark. The description and pictorial representation of a shape trademark should together clearly define all the details that constitute the trademark.

The advantage of trademark protection once you decide to register a shape under a 3D mark rather than industrial design protection, is that it may last indefinitely and is usually cheaper to obtain.

Some original shapes may also qualify **for copyright and industrial design** protection in Vietnam.

### <ii> Color marks in Vietnam:

Single colors cannot be registered. A combination of colors should be arranged or combined in an unusual and distinctive manner. Kindly note that marks registered in black and white or grayscale are construed broadly to protect the mark both as registered and in other color combinations.

### <iii> Trade dress registration in Vietnam:

“Trade dress” is not defined in Vietnamese law. The term “trade dress” is commonly construed to be a product’s appearance when it is used to identify the creator of that product. Trade dress comprises of the total image of a product and may include features such as size, shape, color, texture, graphics, or particular sales techniques.

In Vietnam, a trade dress often serves the same function as a trademark – identifying the source of products in the marketplace – in Vietnam it can generally be protected under trademark laws, and it can be registered as a trademark. It may be protectable under unfair competition laws or actions for passing off. In short, a trade dress/get-up in Vietnam may be protected under the trademark or unfair competition laws, which may protect the distinctive packaging or shape of a product.

**<iv>Sound marks in Vietnam:**

A sound mark is a type of non-traditional trade marks. Protection of sound marks is a requirement under Article 18.18 of the CPTPP to which Vietnam is a member. To register a sound mark in Vietnam, under Article 105.2 of Vietnam IP Law 2022, the applicant is required to submit:

- ✓ A magnetic sound recording of the trademark on a medium that allows for easy replaying. Currently, the most common media are CDs, DVDs and MP3 recordings; and
- ✓ A graphical representation of that sound mark (i.e a sound mark in Vietnam must be represented graphically) for examination on distinctiveness and availability of the sound for registration.

Kindly note that a lengthy piece of musical notation, such as the complete score of an orchestral or piano piece, is unlikely to meet registrability requirements.

**<v> Hologram marks in Vietnam:**

No separate provisions are set out in the laws of Vietnam concerning registration of a hologram mark. The applicant is advised to provide clear representations that show all the features of the trademark. Each of the various views of the hologram must be depicted in the representation so that all the material features of the mark are apparent. However, for simple holograms where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable

The application must be accompanied by a description of the trademark that likewise clearly describes all the features of the trademark. A copy of the actual trademark should also be provided.

**<vi> Motion marks (Moving marks) in Vietnam:**

Moving marks can be represented by a sequence of still pictures in the correct sequence that corresponds to the mark in use and a written description describing the nature of the mark represented by the still pictures.

No separate provisions are set out in the laws of Vietnam concerning registration of a motion mark (moving mark). If an applicant is interested in protecting a motion mark (moving mark) in Vietnam, he should provide clear representations that show all the features of the trademark. The application must be accompanied by a description of the trademark that likewise clearly describes all the features of the trademark. A copy of the actual trademark--for example, as a video clip--should also be provided.

The description of a motion mark (moving mark) in Vietnam should include the following information:

- ✓ That the mark is a moving image;
- ✓ What the images depict, i.e., what the change in appearance is;
- ✓ How many images are involved;
- ✓ What is the sequential order of the images;
- ✓ That there is a single sequence of the movement (and not a variable sequence).

**<vii>Taste marks (Flavor marks) in Vietnam:**

Vietnam has not recognized taste marks (flavor marks). Thus, taste marks (flavor marks) are not registrable and protectable in Vietnam.

**<ix>Touch marks in Vietnam:**

Vietnam has not recognized touch marks. Thus, touch marks are not registrable and protectable in Vietnam.

**8. Prior use of trademarks in Vietnam: What are associated risks and benefits?**

Use of an unregistered mark may place the user at risk of trademark infringement (i.e. **runs the risk of infringing the trademark rights of others**) if such an unregistered mark is deemed confusingly similar to a prior mark. However, using an unregistered mark prior to applying to register it may bring certain benefits, i.e.,

**Increasing chance of success in registering marks of low distinctiveness:** A descriptive trademark may acquire distinctiveness through widespread use prior to the filing date. It is possible to overcome an objection of devoid of distinctive character if the applicant can provide evidence to prove that his trademark has acquired secondary meaning or distinctiveness through use. A descriptive trademark acquires secondary meaning if

the applicant can prove that the consuming public recognizes that the descriptive name is a trademark that refers to his products.

**Filing oppositions and invalidation actions:** The genuine trademark owner may provide evidence to prove their used-based rights of their unregistered mark under either and/or both of the following grounds (i) well-known ground (Article 74.2i of Vietnam IP Law) and/or (ii) wide-use ground (article 74.2g of Vietnam IP Law) to file a Notice of Opposition and/or an invalidation action against a registered mark in Vietnam.

**Facilitating enforcement against infringement/ unfair competition actions:** In practice, industrial property rights over unregistered mark in some limited cases may be protected and enforced by Vietnam as if they have been registered in the form of trademark or industrial design. Protection against infringement may be available for marks with substantial and longstanding use that are not registered.

**Defending against an alleged trademark infringement claim:** Owner of an unregistered trademark might defend against infringement claims by establishing that he or she would be entitled to registration in his/her own name if he/she were to apply for registration of his/her mark. It's possible to bring an invalidation action against the previously registered mark in this situation.

## 9. Filing a trademark application in Vietnam – What to require and should must not overlook?

### Requirements for trademark filing in Vietnam

- (i) A trademark representation (trademark image) (a depiction of the mark an applicant seeks to register) (For marks comprising a three-dimensional shape of the goods or packaging, line drawings should clearly show all dimensions of the mark). Description of the trademark: meaning, colors claimed, translation or transliteration of characters into English if the mark contains foreign characters
- (ii) A list of goods/services bearing the mark;
- (iii) Priority claim, where priority of an earlier application is claimed;
- (iv) A Power of Attorney (**PoA**).

### Critical notes:

- PoA: The PoA should be signed only. Neither notarization nor legalization for the PoA is required. A scan of PoA is accepted at filing, provided that an original duly executed PoA must be submitted to the Intellectual Property of Vietnam within 01 months. One PoA can be used for multiple trademark filings in Vietnam.
- Joint applicants: They are permitted in Vietnam, meaning that more than one individual or entities can be the applicants of a trademark applications in Vietnam.
- Madrid System: Vietnam is a party to the Madrid Protocol and the Madrid Agreement and may be designated in international applications. An international application is subject to the same registrability requirements and examination procedure as a locally filed application.
- Non-Eu member: Vietnam is not a member of the European Union; a European Union Trade Mark registration (formerly a Community Trade Mark registration) is not effective in Vietnam.
- Non-regional trademark protection mechanism in Vietnam: No multinational regional registrations are available in Vietnam.
- No requirement of proof of use for trademark registration in Vietnam: Use of a mark in the marketplace is a requirement for registration in Vietnam. Proof of use is not required prior to the issuance of a registration or the issuance of a notice of allowance/acceptance.

## 10. Classification of goods/service in Vietnam: How?

Vietnam currently adopts the Nice Classification 11th Edition. The goods and services under any applications must be listed into specific items, preferably using the terms guided in the Alphabetical List of the Nice Classification

If a trademark covers more than one class of goods and/or services, one application can cover multiple classes of goods or services.

For a multi-class application, the applicant must pay class fees on a per-class basis.

## 11. Claiming priority for a trademark filed in Vietnam: How?

An applicant who wishes to obtain an IP right in different countries in a timely manner needs to apply to the relevant bodies in these countries as soon as practical. However, it takes time to prepare and translate application documents, as well as to find the funds for application fees. For this reason, it can be difficult for the applicant to apply to all countries at the same time. If the applicant does not file simultaneously, another party may file the same application preemptively. In order to solve this problem, the Paris Convention lays down a priority system, whereby applicants for inventions, utility models, industrial designs or trademarks filed in one member country enjoy priority when they file the same applications in other member countries within a prescribed time limit. That is to say, the first filing date in one member country will be regarded as the priority date for any subsequent filings in other member countries.

If an applicant's home country is a member of the Paris Convention, the filing date of its home application can be claimed as the filing date in Vietnam, provided that its home application was filed within the fixed period of six months preceding the application in Vietnam.

If an applicant's home country is a member of the World Trade Organization, it should be possible to claim the home filing date.

An International Registration can be based on a national application or registration in this jurisdiction.

## 12. Trademark Examination Process in Vietnam – What steps and timeline?

A trademark application in Vietnam undergoes 02 examination stages: Formality Examination and Substantive Examination.

**Formality Examination:** The examiner of the Intellectual Property of Vietnam will examine the application to make sure that it complies with the administrative requirements or formalities (i.e. for compliance with the filing requirements; classification: i.e., to ensure that the goods or services fall within the class(es) listed in the application; clarity: i.e., that descriptions are clear and understandable).

**Substantive Examination:** The examiner of the Intellectual Property of Vietnam will examine all aspects of a trademark application to find out whether the application violates any prohibitive provisions, as well as whether the application conflicts with any prior registered trademark right. The following will be examined to determine registrability of an applied-for mark in Vietnam:

- **Descriptiveness:** i.e., to check whether a trademark functions solely to provide information about the goods and services affiliated with the trademark;
- **Distinctiveness:** i.e., to ensure that trademarks are capable of being represented graphically and of distinguishing the goods or services of one individual or organization from those of other individuals or organizations;
- **Deceptiveness:** i.e., to check whether a 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, prior-filed application or earlier unregistered rights resulting from an official search.

### Deadline to respond for Formality and Substantive Examination Notice:

A response to a Formality Examination Notice must be submitted within 2 months (computed from the date of the Notice) and 3 months for a Substantive Examination Notice (computed from the date of the Notice).

## 13. Overcoming trademark refusals in Vietnam – How?

**Trademark refusal issued on absolute grounds** (*absolute grounds refer to the categories of signs which are excluded from registration by specific provisions of the trademark law; reasons inherent in the trademark itself*):

You are advised to prepare and submit arguments to confirm that your trademark has a distinctive character.

**Trademark refusal issued on relative grounds** (*those that arise because of the existence of prior rights, whether in registered marks or otherwise*)

The trademark applicant may consider 4 main options below to overcome a trademark refusal based on relative grounds:

- (i) *Arguing dissimilarities between the applied-for mark and the cited mark;*

- (ii) *Submitting a Letter of Consent (LOC): See more about LOCs in Vietnam at <https://kenfoxlaw.com/a-letter-of-consent-to-overcome-a-refusal-against-a-trademark-application-in-vietnam/>*
- (iii) *Taking a 5-year non-use cancellation action against the cited mark;*
- (iv) *Taking an invalidation action against the cited mark.*

#### 14. Disclaimer practice for trademarks in Vietnam – How?

Vietnam employs a disclaimer practice where trademark applicants are required to relinquish any exclusive rights to non-distinctive elements of their trademark. However, it is not obligatory for applicants to explicitly state the disclaimer in the application form. The Intellectual Property Office of Vietnam will automatically consider what element of the mark is not inherently distinctive after concluding a substantive examination and issue a statement of disclaimer regarding those elements in their Notice of Substantive Examination.

In the event of a disclaimer, under [Circular No. 16/2016/TT-BKHCN](#), the Intellectual Property of Vietnam must state explicitly the intention and reason for such a disclaimer, and the applicant has three (03) months from the date of notification to state its opinion regarding such a disclaimer

#### 15. Filing a third-party observation or an opposition against trademarks in Vietnam: How?

Once a trademark application has been published in the industrial property gazette of Vietnam, third parties are entitled to submit their opinions on the matter. Such opinions may be conveyed to the Intellectual Property Office of Vietnam via two distinct routes: (i) third party observation, or (ii) opposition.

- **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.

Based on the foregoing, two similarities can be drawn between third party observation and third party opposition. Firstly, no vested interest is required to commence either of these proceedings. Any bona fide third party, not limited to those with related rights and interests, retains the right to express their opinion regarding the registration of an application through either of the aforementioned procedures. Secondly, both proceedings present clear legal grounds for the public to offer their views on the issuance of an exclusive right to an industrial property subject matter. The public is obligated to adhere to these grounds if they consider that the registration subject matter may lead to conflict, negative impact or fails to meet the protection criteria.

One of the most significant differences between the two aforementioned routes pertains to the time limit for submitting a third-party observation or opposition. While a third party may file an observation during the trademark substantive examination period, as long as it is done before the issuance of a protection title decision by IP VIETNAM, a trademark opposition must be filed within 5 months of the publication date of the trademark application and before the decision to grant a protection title is made. As such, after the 5-month period following the publication date has elapsed, no trademark opposition may be submitted. Nevertheless, this does not signify the end of the road for third parties, as they may still employ the "third party observation" mechanism to petition IP VIETNAM to reject the registration of the applied-for mark.

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