

## Black-and-White or Color Marks in Vietnam – Picking the Right Path

*In the fast-paced world of commerce, trademarks serve as powerful assets that distinguish one business from another. They are the face of a brand, carrying with them the goodwill and reputation built over time. Registering a trademark is a strategic move that bestows exclusive rights to its owner, providing a shield against the use of confusingly similar marks. However, the decision of whether to register a mark in black and white or its specific colors can be a complex and crucial one. To shed light on this matter, we delve into the reasons why applying for both versions may prove to be a prudent choice, particularly for trademark owners seeking protection in Vietnam.*

### Registration requirements

Under local trademark registration procedures, it is required to specify the exact colors that the mark encompasses. If the application is approved, the color description is officially confirmed in the trademark certificate. When a trademark is registered in black and white, the protection is limited to that specific representation. Any variations in color used by competitors may not be covered by the registered mark's protection. This limitation could become a concern if the color of the mark plays a crucial role in its distinctiveness and consumer recognition. Alleged infringers might argue that their use of a similar mark in a different color does not create the same commercial impression and is unlikely to cause confusion among consumers. In such cases, the protection afforded by a black and white trademark registration may not be sufficient to address potential instances of infringement.

### Protection scope

The scope of trademark rights is precisely defined in the registration certificate. The protection of a trademark is contingent upon two factors: the registered trademark itself and the list of goods and/or services registered under that trademark. Therefore, a trademark is protected only as it is registered. If a trademark owner chooses to register the black and white version alone, it may not be sufficiently shielded from infringement claims concerning color variations.

Color can often be a critical element that contributes to a mark's distinctiveness and brand recognition. In certain industries, consumers may associate specific colors with particular brands or products. For example, a soft drink company might use a distinctive color for its packaging, which consumers instantly recognize. In such cases, a black and white trademark registration might not adequately protect the unique color element that consumers associate with the brand. As a result, alleged infringers could argue that their use of the mark in different colors does not infringe on the registered mark's distinctive features.

To ensure comprehensive protection, considering registration of both black and white and color versions is prudent.

### Evidence of use

Article 5.c (2) of the Paris Convention provides that “*use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark*”. Therefore, in cases where color does not significantly contribute to the distinctiveness of the mark, utilizing the black and white version can be considered use of the registered color mark. This can act as a valuable defense against cancellation requests from third parties. However, if color plays a crucial role in the mark's distinctiveness, relying solely on the black and white version may not suffice to protect against non-use grounds for trademark revocation in Vietnam.

### Uncertainty in creative differences

Vietnam's IP law and regulations do not provide clear guidelines on how much creative differences are allowed before altering the distinctive character of a registered trademark. Consequently, trademark examination decisions are made on a case-by-case basis by IP VIETNAM's examiners. This unpredictability makes it essential for trademark owners to consider registering both versions to minimize ambiguity and potential risks.

### Claim of priority rights

Priority rights in trademark registration are based on the first application for protection of the same subject matter. However, claiming priority for a black-and-white trademark does not automatically extend to the same

mark in other colors and vice versa. IP VIETNAM considers black and white marks and their colored counterparts as separate subject matters during examination.

### Final thoughts

The decision of whether to register a trademark in black and white or in its actual color form presents a multifaceted challenge, especially in Vietnam's evolving trademark landscape. As trademark infringement or disputes in Vietnam become increasingly complex, it is imperative for trademark owners to adopt a proactive strategy to safeguard their intellectual property assets. Vietnam's fast-paced economy and rising commercial activities have resulted in a competitive business environment where brand identity and recognition hold paramount importance. Trademark infringement cases are becoming more intricate, making it crucial for businesses to secure their rights through all possible avenues.

In order to optimize protection and mitigate risks, trademark owners are strongly advised to pursue both black and white and color versions through separate applications in Vietnam. This strategic approach not only ensures the utmost safeguarding of rights for the trademark owner but also fortifies their defense against potential infringement claims.

At KENFOX, we are dedicated to providing you with comprehensive trademark protection in Vietnam. Our services extend beyond mere registration of black-and-white and color versions of your trademark; we take a holistic approach to safeguard your intellectual property assets effectively in the ever-evolving business landscape of Vietnam. Trust in our unwavering dedication to protecting your brand and intellectual property assets. With our in-depth knowledge of the Vietnamese trademark system, we provide strategic advice tailored to your unique needs, empowering you to make informed decisions about your intellectual property.

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