

## What Are Key Considerations For International Trademark Registrations Designating Vietnam?

Over 9,000 international trademark applications designating Vietnam were filed annually from 2020-2022 has partly reflected the convenience and efficiency of the Madrid system in assisting IPR holders to secure protection for their brands in Vietnam. The Madrid System offers efficiency, cost savings, and a simplified approach to international trademark registration. These advantages make it an increasingly preferred option for businesses seeking to protect their brands in multiple countries, including Vietnam, as it streamlines the process and provides a cost-effective means of securing global trademark rights.

Detailed regulations governing the processes and requirements for international trademark applications designated to Vietnam are meticulously outlined in Article 27 of Decree No. 65/2023/ND-CP. KENFOX would like to provide you with 10 (ten) salient points that trademark owners should take into account when their trademark is filed under the Madrid system designating Vietnam.

### 1. Substantive examination

After receiving a notice from the WIPO's International Bureau (IB) about a Madrid Application designating Vietnam, the Intellectual Property Office of Vietnam (**IP VIETNAM**) is required to conduct a substantive examination of the application. This examination is similar to the examination of a national trademark application to determine the registrability of the mark. A Madrid Application designating Vietnam may be refused registration based on absolute grounds as per Articles 73, 74.2 a, b, c, d, đ of the Law on Intellectual Property and/or relative grounds as per Articles 90.2, 74.2 e, g, h, i, k, l, m, n, o, p of the Law on Intellectual Property.

The examination is concluded within 12 months from the date of IB's notification.

### 2. Procedure for eligible marks

If the mark meets the registration requirements as per Vietnamese law, IP VIETNAM is to:

- (i) Issue a decision on the protection of the internationally registered mark within 12 months from the date of IB's notification. The mark is recorded in the National Register of Industrial Property and a Statement of Protection is sent to the IB.
- (ii) Publish the decision in the Official Gazette of Industrial Property within 2 months of issuance. The scope of protection is determined based on the application filed with the IB and accepted by IP VIETNAM.

### 3. Temporary refusal

For marks that don't fully meet protection conditions or exhibit shortcomings (e.g., lacks required information, issues with collective marks, certification marks, etc.), IP VIETNAM issues a temporary refusal notice within the 12-month period. This notice details the content and reasons for the intended refusal.

### 4. Deadline

A response must be submitted to IP VIETNAM within 3 months of computed from the date IP VIETNAM sends its provisional refusal to the IB (not the date of receiving or being aware of the refusal).

### 5. Acceptance of corrections of deficiencies

If the applicant satisfactorily corrects errors or makes reasonable objections within the 3-month period, IP VIETNAM proceeds with protection for the corrected parts, issuing a decision and publishing it in the Official Gazette.

### 6. Partial refusal

If the applicant fails to correct deficiencies or objections within the given period, IP VIETNAM applies the same procedures outlined in Point 5, but exclusively for the goods and services that meet protection conditions.

### 7. Total refusal

If the applicant fails to address deficiencies or objections for the entire list of goods and services within the 3-month period, IP VIETNAM issues a decision refusing protection for the entire mark.

### 8. Appeal procedures

Appeal procedures for decisions concerning the international registration application follow the same process as for national trademark applications. If a decision is considered incompatible with legal provisions, the applicant can file a complaint (an appeal). The complaint (appeal) settlement results are communicated by IP VIETNAM. If changes occur due to complaint (appeal) settlement, IP VIETNAM informs the IB.

### 9. Certificate of protection

Following the acceptance of international registration in Vietnam, the trademark owner can request IP VIETNAM to issue a certificate confirming protection of International Registration Application designating Vietnam

### 10. Third Party Opinions

Opinions from third parties regarding the Madrid Application are considered during the application process if submitted within 12 months from the date of the International Office's notification. These opinions serve as reference sources for IP VIETNAM's decision-making process.

### Final thoughts

The Madrid system for the international registration of trademarks offers several advantages over the traditional national trademark application process. One advantage is that it compels IP VIETNAM to speed up examinations. IP VIETNAM must complete its examination within 12 months from the date of notification by the International Bureau (IB). Failure to issue a provisional refusal within this prescribed timeline automatically grants protection to the trademark in Vietnam. This speeds up protection and instills confidence in trademark owners.

However, there's a potential downside. If a mark is refused, it can lead to extra costs and delays. The Madrid system expedites registration but doesn't guarantee acceptance in every designated country.

To mitigate this risk, trademark owners are strongly advised to conduct comprehensive availability searches in Vietnam before filing their international application. This proactive step allows them to assess the likelihood of their mark being accepted and reduces the chances of a costly refusal. If a trademark owner only intends to designate one or two countries for protection, they may find it more cost-effective to opt for the direct national filing route in those specific countries, rather than relying solely on the Madrid system.

In conclusion, the Madrid system offers an efficient and convenient means of securing international trademark protection, particularly in countries like Vietnam. However, trademark owners should carefully evaluate the advantages and disadvantages of this route and take proactive steps, such as availability searches, to minimize potential risks and costs associated with refusals in specific jurisdictions. The decision to use the Madrid system or pursue direct national filings should be based on the specific needs and circumstances of each trademark owner.

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