

How Philipp Plein Triumphed Over Trademark Rejection in Vietnam?

Article 74.2 (e) of Law on IP stipulates that: “2. A mark shall be deemed to be indistinctive if it is a sign falling into one of the following categories: (e) *Signs other than integrated marks which are identical with or confusingly similar to registered marks of identical or similar goods or services on the basis of applications for registration with earlier filing dates or priority dates, as applicable, including applications for registration of marks filed pursuant to a treaty of which the Socialist Republic of Vietnam is a member*”. In order to assess the similarity of marks at issue, it is required (i) to compare an applied-for trademark to the cited mark(s) and concurrently, (ii) to compare goods or services bearing the marks in question. A likelihood of confusion of marks is established in case both above requirements are satisfied.



Philipp Plein applied to register its mark “” (“PP, device”) through the Madrid system under International Registration No. 1098038 for the goods in Classes 03, 14, 18, 20, 21, 24, 25 & 28, covering “*Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry; precious stones; horological and chronometric instruments*” in Class 14 and “*Clothing, footwear, headgear*” in Class 25 designating various countries, including Vietnam.

The Intellectual Property Office of Vietnam (“**IP Vietnam**”) refused registration of Philipp Plein’s “PP, device” mark on the ground is considered confusingly similar to two prior trademarks under Article 74.2



(e) Vietnam’s IP Law, specifically, the mark “” (“QP, QUÝ PHÁT, device”) for the services in Class 35 (Trading in gold and silver) and 40 (Processing and processing of gold and

silver) in the name of Quy Phat Jewelry Company Limited and the mark “” (“QP, QP FASHION”) for the goods in Class 25 (Clothing...) in the name Do Van Hai.

Dissatisfied with IP Vietnam’s decision to resolve the appeal, Philipp Plein filed a second appeal with the Ministry of Science and Technology (**MOST**) –IP Vietnam’s superior agency. In the appeal, KENFOX provided and focused on the following analysis: (i) Similarities and dissimilarities between the marks at issues; (ii) The portion is playing a key/fundamental role in performing the distinguishing function (origin-indicating function) for the marks in question; (iii) Scope of protection of a trademark in Vietnam under Article 16 of Decree 103/2006/ND-CP with emphasis that separating a composite mark into two portions to assess the confusing similarities between it and an applied-for mark will distort and falsify the scope of protection of marks; and (iv) **Some similar precedents to the case in question.**

To resolve the second appeal, an Oral Hearing was held with the participation of three parties, including: representatives of the MOST as the appeal settlement agency, representatives of the IP Vietnam as the responding party and the representatives of the Philipp Plein as the appellant.

After listening to the arguments and opinions of the involved parties, the related documents submitted into consideration, the MOST concluded that while the trademark applied for is composed of two letters, “PP” which in opposite position and the two cited marks also include the word “QP” in an opposite position, the similarity between these brands is insufficient/not to the extent that it can cause confusion

for consumers and, thus, they are found distinguishable in their totality. The MOST issued a Decision on settlement of the second appeal, annulling the IP Vietnam's refusal Decision and requesting the IP Vietnam to initiate procedures for protection of the mark "PP, device" under IR No. 1098038 in the name of Philipp Plein.

Final thoughts:

Overcoming notices and decisions of refusal for trademark protection by IP Vietnam is consistently a challenging task, especially when a trademark application has faced rejection twice. Nevertheless, not every opportunity has closed. There will be various preparations and approaches to consider, but, most importantly, a wise and strategic approach is essential to secure ultimate victory for our clients. The Oral Hearing for appeal resolution can also be viewed as a Simplified Court Hearing or Shortened Trial or Court Summary Proceedings to adjudicate a case, in which the Appeal Settlement Agency (MOST) serves as the Court, the appellant (IP Representative of the applicant) acts as the plaintiff and the responding party (IP Vietnam) acts as the defendant.

KENFOX attorneys, with extensive experience in multiple appeal proceedings, are prepared to advise in detail on documents required for the appeal procedure in Vietnam, as well as know how to analyze what content, focus on what points, to make effective use of documents to support complaints, respond to situations/developments in a flexible way to get an edge in the debating process for the clients.

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