

Assessing Intellectual Property Rights Infringement in Vietnam: Four Key Considerations

Upon suspecting an infringement of their intellectual property (IP) rights, holders can submit a request to the Vietnam Intellectual Property Research Institute (VIPRI) for an assessment or expert opinion to determine the presence of infringement elements.

After reviewing the documents and evidence provided, VIPRI will issue a written assessment or professional opinion in the form of an "Assessment Conclusion". This conclusion serves as initial evidence for the IPR holder to include with the Petition for Handling of IPR Infringement, which is submitted to administrative enforcement agencies (such as Market Management, Police, Customs, and the Scientific and Industrial Property Inspectorate) and the Court. These bodies will then consider whether to accept or reject the petition addressing the alleged infringement of intellectual property rights. Therefore, before filing a Petition for handling IP infringement in Vietnam, the rights holder should request an assessment from VIPRI.

1. IP infringement assessment conclusion: Why necessary?

The VIPRI's Assessment Conclusion plays an important role in protecting and enforcing intellectual property rights in Vietnam.

- *Not compulsory, but encouraged:* Although the expert opinions from VIPRI are not binding or mandatory, a favorable Assessment Conclusion should be included in the Petition for Handling of IPR Infringement if it supports the rights holder. As an agency under the Ministry of Science and Technology, VIPRI is recognized as a specialized authority in the IP field. Therefore, opinions from VIPRI are considered reliable and can significantly influence the outcome of a case, particularly when they favor the IPR holder.
- *Important for Vietnamese law enforcement agencies:* The current reality of handling intellectual property rights infringement in Vietnam demonstrates that IP enforcement agencies (both administrative enforcement bodies and courts) frequently rely on the Assessment Conclusions from VIPRI. These conclusions serve as an initial legal basis for accepting inspections, examinations, and actions against acts considered to infringe intellectual property rights in Vietnam.

Expert opinions are given significant importance in resolving IP infringement cases. Due to the complex nature of IP-related issues, these opinions are crucial for clarifying legal matters and contributing to a more accurate assessment of cases. This clarity facilitates informed decision-making, enhances transparency among enforcement agencies in Vietnam (such as the Market Management Department, Economic Police, and the Inspectorate of the Ministry of Science & Technology), and aids the courts.

- *Helpful to IPR holder:* The assessments and opinions from VIPRI can help resolve disputes and encourage respect for IP rights in Vietnam. Many IPR holders use VIPRI's assessment conclusions and expert opinions as initial evidence and send Cease & Desist Letters to alleged infringers. In various where KENFOX has represented its clients, 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.

2. Assessment of IP Infringement: What subject matters does VIPRI evaluate?

VIPRI, an institute under the Ministry of Science and Technology, is accredited to deliver expert opinions on IP infringement cases related to industrial property subjects such as inventions, industrial designs, semiconductor circuit layouts, trade secrets, trademarks, trade names, and geographical indications. Requesters may ask VIPRI to (i) determine the scope of protection for industrial property rights, (ii) assess similarity, (iii) identify infringing elements, and (iv) calculate damages. However, due to limited human resources, VIPRI currently only provides assessment services for the following four subject matters:

- Inventions

- Industrial Designs
- Trademarks, and
- Geographical Indications.

Currently, VIPRI does not opine on matters of unfair competition, trade name or copyright.

3. Process for assessing IPR infringement: What steps?

- *Submit a request for an Assessment Conclusion:* The IPR holder or related parties must submit a request for an assessment to VIPRI. This request should be accompanied by documents and evidence related to the alleged infringement.
- *Confirmation of receipt of request and documents:* VIPRI reviews the completeness and validity of the request and attached documents. If necessary, VIPRI may request additional documents or information.
- *Conducting the assessment:* Experts from VIPRI will analyze and evaluate relevant factors to determine whether intellectual property rights infringement has occurred. This process includes comparing and analyzing the protected IP rights with the documents and samples suspected of infringement.
- *Issuing the Assessment Conclusion and returning the results:* After completing the assessment process, VIPRI will issue an 'Assessment Conclusion.' This document will clearly outline the methods used and the results of the assessment. The Assessment Conclusion will be returned to the requester within 15-20 working days for trademarks, industrial designs, and geographical indications, and within 30-50 working days for inventions.

4. Utilizing VIPRI's Assessment Conclusions to Protect and Enforce Intellectual Property Rights: How?

IPR holders in Vietnam can use VIPRI's Assessment Conclusions to protect and enforce their intellectual property rights in the following ways:

- *Filing applications for registering trademarks, inventions, and industrial designs:* VIPRI's Assessment Conclusions can assist IPR holders in determining the level of distinguishability and [the potential for infringement](#) and conflict among IP subject matters. Based on this information, IP rights holders can decide whether to apply for registration of their IP assets at the Intellectual Property Office of Vietnam.
- *Filing an opposition or a third-party observation:* VIPRI's Assessment Conclusions can also serve as a substantial basis to support arguments in [oppositions or third-party observations](#). These conclusions can help demonstrate that the subject matters applying for registration do not meet the required criteria for intellectual property rights protection.
- *Initiating infringement proceedings:* VIPRI's Assessment Conclusions can be used to initiate legal proceedings against infringers who use a similar or identical sign without permission. These conclusions can serve as evidence to establish the ownership of the IP rights and to demonstrate the infringement committed by the infringer.
- *Delivering cease and desist letters (C&D Letter):* VIPRI's assessment conclusions can be used to send a [C&D Letter](#) to notify organizations and individuals who are likely to infringe on intellectual property rights, requesting them to voluntarily stop the violation. The C&D Letter can include an Assessment Conclusion as evidence that an infringement is likely to occur and to demonstrate that the IPRs are legally protected and currently in effect.
- *Licensing negotiations:* The assessment conclusions from VIPRI can be used to negotiate agreements for transferring intellectual property rights. These conclusions can help determine the value of the intellectual property and the conditions under which it can be licensed.

Final thoughts

Conclusion Assessments by VIPRI play an important role in enforcing and resolving intellectual property rights disputes in Vietnam, especially those related to trademarks, inventions, and industrial designs. The fact that both IPR holders and alleged infringers use VIPRI's assessment services demonstrates that the expert

opinions and assessment conclusions from VIPRI are considered valuable, neutral, and trustworthy sources of documents and evidence on IP issues in Vietnam.

In a context where IP rights enforcement is increasingly complex and most [IP enforcement agencies in Vietnam](#) require expert opinions from independent third parties, the role of VIPRI in IP enforcement and dispute resolution becomes particularly crucial. As businesses increasingly rely on their IP assets to drive innovation and growth, effective enforcement and protection of these rights are essential. The assessment conclusions and expert opinions from VIPRI ensure that IPR disputes are resolved fairly and effectively. Additionally, they help businesses have confidence in the protection and enforcement mechanisms for their IP rights in Vietnam.

Please contact KENFOX IP & Law Office for advice on handling IP infringement and strategies for addressing IP assessment issues to optimally protect your legitimate rights and interests in Vietnam.

**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