


Canceling a Trademark Registration in Bad Faith in Vietnam: What a Genuine Trademark Owner Needs to Do?

[Executive summary]: Tân Việt Company, a Vietnamese enterprise, successfully secured the trademark "CAF PROFESSIONAL SOUND" under Registration No. 390821 with IP VIETNAM. Upon discovering this registration, Kafu Company, a China-based company, filed an invalidation with IP VIETNAM.

Category	Details
Applied-for trademark	
Class & goods	09 (Audio equipment such as speakers, audio amplifiers, disc players). 35 (Trading, importing and exporting audio equipment such as speakers, sound amplifiers, disc players).
Application/Registration No.	4-2018-28713 (390821)
Applicant	Công ty cổ phần xuất nhập khẩu & đầu tư phát triển Tân Việt (Tan Viet Company)
Genuine trademark owner	Foshan City Nanhai Kafu Professional Audio Equipment Factory (Kafu Company)
Action	Filing a trademark invalidation request
Legal grounds	<ul style="list-style-type: none"> ▪ Article 87.2 (i.e., Organizations and individuals may register a trademark for goods they distribute or sell even if they do not manufacture these goods themselves, as long as the manufacturer agrees to this arrangement and does not use the mark themselves) ▪ Article 87.7 (i.e., preventing representatives or agents from registering trademarks in their own name without the consent of the actual trademark owner, in countries that are parties to treaties that Vietnam has agreed to. An agent or representative can only register a mark under their name if: (i) They have explicit agreement from the original trademark owner, or (ii) There is a justifiable reason for the registration).
Ruling	<p>After a thorough review of the evidence and arguments presented, IP VIETNAM decided to invalidate Trademark Registration No. 123570, citing Article 87.2 and 87.7 as legal grounds.</p> <p>IP VIETNAM'S invalidation Decision was made based on substantial proof provided by Mainetti (UK) Limited, including:</p> <p>(i) Kafu Company and Tan Viet Company had a commercial relationship since 2016. Tan Viet Company was an exclusive agent of Kafu Company. Documentation attesting to this partnership includes a variety of pivotal records:</p> <ul style="list-style-type: none"> ✓ Contract details: The "CAF" sign is prominently displayed on the "box speaker" under Contract No. 01/NK/2016, executed on August 8, 2016. ✓ Invoice evidence: The logo of Kafu Company is featured on Invoice number CAF1002, issued on July 29, 2016. ✓ Distributorship: An Exclusive Distributor Certificate validates the exclusive rights granted to the partnership, spanning from 2016 to 2019. <p>(ii) No written authorization of Kafu Company for Tan Viet Company to apply for registration of the trademark "CAF PROFESSIONAL SOUND, fig" for products and services in class 09 and 35 in Vietnam. Kafu Company has never agreed to let Tan Viet Company register the CAF trademark in Viet Nam.</p>

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

By Nguyen Vu QUAN
Partner & IP Attorney