

## How to Establish That the Applicant “Knew” or “Had a Basis to Know” in Cases of Trademark Registration in Bad Faith?

Proving that the trademark registration applicant “knew” or “had a basis to know” about the trademark of legitimate trademark owners under Article 34.2 of Circular 23/2023/TT-BKHCH is not simple. Vietnam's Intellectual Property Law does not establish specific regulations on documents that need to be provided for proof purposes. However, on the basis that trademark disputes registered in “bad faith” have been handled, KENFOX IP & Law Office provides an overview of necessary documents and evidence to help legitimate trademark owners prove that the applicant “knew” or “had a basis to know” about that trademark before filing an application for registration in Vietnam.

### 1. Reputation or widespread use of the mark

These documents are intended to demonstrate that the trademark is recognized by the public, actively marketed, and widely known. This makes it reasonable to assume that anyone in the relevant field or even the general public would already know the brand. Therefore, the applicant cannot be unaware of the existence of the trademark before filing the application in Vietnam. The documents that need to be provided are as follows:

- *Trademark Registration Certificates:* Provide a copy of the trademark registration prior to the trademark filing date, showing that the true owner's trademark has been officially recognized and protected.
- *Sales and marketing materials:* Demonstrate widespread use of the mark in commerce, including promotional materials, sales data, advertising campaigns, and distribution information, particularly in regions where the legitimate trademark owner is doing business.

### 2. Documentation of public outreach

- *Public presence:* Document of participation in the display of branded goods at trade fairs, exhibitions or industry events where the trademark of the true trademark owner was displayed and the applicant may have attended.
- *Publications and communications:* Articles, news reports, and publications showcase branded merchandise and demonstrate the brand's visibility and recognition within the industry.

### 3. Presence in the digital environment

- *Online presence:* Documents and data about the online visibility of the brand owner's trademark, such as search engine results, website traffic statistics and online social platforms.
- *Domain name:* Documentation of a domain name registration that matches or is closely related to the trademark of the legitimate trademark owner, showing that the trademark was in use in the digital environment before the applicant's filing date.

### 4. Market survey and consumer evaluation and recognition

- *Surveys:* Consumer survey documents show that consumer awareness of the brand is associated with the product/service of the authentic brand owner.
- *Evaluations and certifications:* Documentation of evaluations and recognition from customers or partners about the brand and linking that brand to the business of the legitimate brand owner.

### 5. Previous relationships

Documentation of [the previous relationship](#) between the legitimate trademark owner and the applicant in bad faith is the strongest, convincing and most direct evidence, proving the applicant's awareness of the existence of the trademark, including but not limited to the following documents:

- *Emails, letters, and memorandum of understanding:* Any written correspondence between the legitimate trademark owner and the applicant discussing the trademark or related business activities. Documents relating to any joint venture, collaboration or partnership in which the trademark is involved or discussed.

- *Meeting minutes*: Documentation of meetings where trademarks were discussed. If the applicant was present at these meetings or was represented, these documents can serve as evidence of their knowledge.
- *Contract or agreement between two parties*: Any contract or business agreement (even if not yet finalized) that mentions trademarks. This includes licensing agreements, non-disclosure agreements (NDAs) or any other commercial contracts in which the trademark is mentioned.
- *Previous trademark disputes*: Includes any previous Cease & Desist Letters or similar legal notices sent to the applicant or interested parties regarding unauthorized use of the trademark, as well as any documents relating to trademark disputes or negotiations.
- *Trade shows, exhibitions*: If both parties attend the same trade shows, conferences or industry events where the trademark is displayed or discussed, documents from these events can be used as evidence. proof

## Final thought

If a mark is proven to [have been widely used and recognized](#), it is essentially reasonable to argue that other organizations and individuals within the same geographical or commercial scope will be aware of the mark. there. This argument carries weight when the applicant operates in the same industry or has the same market sector as the legitimate trademark owner. Documents detailing the previous relationship between the applicant and the trademark owner serve as evidence that the applicant knew or should have known about the legitimate trademark owner's trademark before filing the application.

In the case of Przedsiębiorstwo Produkcyjno-Handlowe "EVELINE COSMETICS" [opposing the trademark registration application](#) "EVELINE COSMETICS, device", the IP Office of Vietnam (**IP VIETNAM**) has determined that with the documents and evidence provided by the legitimate trademark owner, it is grounded to confirm that the trademark "EVELINE COSMETICS, device" is owned by this company and the trademark "EVELINE COSMETICS, device" has been widely used and recognized before the time of filing the application by the Vietnamese applicant.

However, each document and [evidence](#) in cases of trademark registration with malicious intent must be collected and processed carefully to ensure that they can be considered admissible documents and evidence. On that basis, arguments that the applicant "knew" or "had a basis to know" about the trademark before filing the application are valid and accepted by IP VIETNAM.

Please contact KENFOX IP & Law Office, if you need professional advice and representation to reclaim your trademark through opposition procedures or cancellation of trademarks registered in bad faith in Vietnam.

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