

New product launch: How to keep your product design from being "stolen"?

For products where the external appearance provides part or all of the brand identity for consumers, protecting the external form is as important as protecting the trademark. The success of a product is often influenced by its external appearance. In a trend where consumers tend to focus on the aesthetics of a product, the appearance of a product can often be equivalent to or, in some cases, more important than its function.

However, the path to successful [industrial design](#) ("ID") registration is not without its challenges. Legal "traps" in ID registration are ever-present, and many applications have been rejected due to omissions or errors in the preparation process. Nevertheless, by understanding the legal requirements and clearly identifying potential legal risks, you can effectively navigate these latent obstacles

KENFOX IP & Law Office, with 15 years of experience in advising on and handling complex intellectual property (IP) disputes, analyzes and outlines 7 key strategies to help you minimize the risk of rejection and effectively protect your IDs in Vietnam.

1. Avoid legal "hidden pitfalls": Precisely the subject of ID protection

Not all external shapes of products are protected as industrial designs. Incorrect identification of the subject matter can lead to the registration application not meeting the conditions and being rejected, or being required to amend the application, thereby wasting time and costs.

More importantly, incorrectly identifying the subject matter for ID protection can jeopardize the opportunity to protect the product under other IP rights and obtain exclusive protection. A functional product design could be protectable as a patent instead of an industrial design. If a product design incorporates novel technical or functional features that solve a specific technical problem or provide a non-obvious benefit, it may be eligible for patent protection rather than industrial design protection. For instance, a new design for an engine component that enhances engine performance or reduces energy consumption could be protectable as a patent.

Three Categories of Designs Excluded from Industrial Design Protection (*Article 64 of [Vietnam's IP Law](#)*):

- [i] Shapes of products dictated by their technical features;
- [ii] External shapes of civil or industrial construction works;
- [iii] Shapes of products invisible during use.

You must determine whether the design of their product is eligible for industrial design protection. It is crucial to note that for protection, an industrial design must be the **external shape** of a **complete product** or a **detachable part** capable of independent circulation. Only complete products and detachable parts of products can be registered for industrial design protection. If a component on a product cannot be detached from the product, it lacks the ability for independent circulation and therefore cannot be registered for industrial design protection.

2. Prevent "imitators": Effective strategies to protect product design secrets

Products of reputable and renowned companies are often prime targets for imitation and copying. Many businesses employ a "hiding" or "late launch" strategy for industrial designs to protect product secrets until the very last minute. By postponing the disclosure of ID information, companies can effectively conceal their product designs from competitors, minimizing the risk of imitation before the official market launch.

Upon conceptualizing a novel design, you should promptly initiate the planning and registration processes for industrial design protection (ID) before engaging in any market activities (*e.g., introducing the product to potential customers through pitching, advertising, displaying it on websites, or undertaking any other commercial exploitation endeavors*).

To prevent competitors from copying their product designs prematurely, businesses can request "delayed publication" or "deferred publication" of their ID applications at the time of filing. The Intellectual

Property Law 2022 allows for deferring the publication of ID applications for up to 7 months, provided that the applicant submits a request for deferral at the time of filing. This will delay the disclosure of information about the product's industrial design, keeping the company's unique design confidential until the official launch, creating a surprise effect and attracting market attention, increasing product value, optimizing profits, and protecting the design from copying before the product is officially released into the market

3. Grasp requirements and avoid errors: Preparing a set of industrial design photos and drawings

The scope of protection for an ID is determined based on what is depicted in the set of photographs or drawings (Article 76, [Decree 65/2023/ND-CP](#)). Therefore, you must ensure that the set of photographs or drawings fully and accurately describes all the details and structural features of the ID you wish to protect. Any details not shown in the set of photographs or drawings may not be protected under the Design Patent.

The set of photographs or drawings of an ID serves as the basis for assessing its registrability and protectability. The Intellectual Property Office of Vietnam ("IP VIETNAM") will utilize these materials to evaluate whether the ID meets the protection criteria, including novelty, distinctiveness, and industrial applicability. IP VIETNAM will compare and contrast the photographs or drawings of the ID in the registration application with those of previously registered or used IDs to assess novelty and distinctiveness.

In the event of disputes regarding the scope of protection for an ID, the set of photographs or drawings can be utilized as evidence to elucidate the ID and determine its scope of protection.

Therefore, you must prepare a set of photographs or drawings that includes all the minimum necessary projections. The set of photographs or drawings must accurately represent the product's details, ensuring proper scale, clarity, and numbering. If the application includes multiple designs or products, each design or product must have a complete set of photographs or drawings. You should retain the original set of photographs or drawings for potential future use.

4. Carefully check the industrial design registration application

During the preparation of the ID application dossier, it is necessary to carefully check the information in the related documents to ensure that the information is complete, consistent, accurate, and valid. If there are differences between the documents due to objective reasons, it is necessary to submit an explanation letter or supplement supporting documents to explain the difference in order to avoid being issued a notice. At the same time, it is also necessary to pay attention to the deadlines for submitting additional related documents so that appropriate actions can be taken in a timely manner.

5. Determine the right time to file industrial design applications

In Vietnam, the "first-to-file" principle is applied to industrial designs. Early filing helps businesses assert ownership and [prevent product design copying](#). It is recommended to file an industrial design registration application as soon as possible to avoid the risk of the industrial design losing its novelty unintentionally or intentionally. A third party may unintentionally file a similar industrial design registration application, causing the business to lose protection for its product design.

The registration of an industrial design must also be made before public disclosure through use, sale, marketing, or any other form of public exploitation of the product. Many businesses make the serious mistake of applying trademark thinking to industrial designs by test-selling products or putting product images on websites for public introduction, and then filing for registration. In fact, once a product has been sold on the market, the industrial design of that product will be considered to have lost its "novelty" and cannot be protected. To be protected, an industrial design must meet three criteria: (i) novelty, (ii) creativity, and (iii) industrial applicability.

Industrial designs require "absolute novelty", which means they have not been publicly disclosed before the date of filing the application. Putting a product on the market before registration will cause the industrial design to lose its novelty and cannot be protected. Putting a product on the market in any form before filing an application for protection of the design and packaging of the product will make the

industrial design accessible to the public and thus, no longer have "novelty" to be protected. Therefore, before filing an ID application, it is extremely important to maintain absolute secrecy for the design and packaging of the product.

If an industrial design application has been filed abroad (a member of the Paris Convention), it is necessary to pay attention to filing an application in Vietnam immediately before the foreign application is published, or best of all, to request the priority date of the Vietnamese application according to the date of filing the foreign application within 6 months from the date of filing the application abroad.

6. Search information and the protectability of industrial designs

Before registering an industrial design, you should conduct a search and find relevant information. By searching for information, you can determine whether your design is unique enough and not confusing with other designs on the market. This helps you assess the protectable potential of their design to decide whether to file an application or modify your design to avoid infringing on the IPRs of others. The search can be done by yourself or through a search service.

7. Combine various forms of IPR protection

A product can meet the conditions for protection under multiple forms of IPRs such as patents, industrial designs, trademarks, and copyrights in Vietnam. Each form of IPR protection has its own advantages and scope of protection.

- **Patent:** Protect the new and creative features and functions of a product.
- **Industrial design:** Protect the external appearance and aesthetics of a product.
- **Trademark:** Protects logos, brands, and product names.
- **Copyright:** Protects creative, literary, and artistic elements expressed in a product (such as user manuals, software, graphic design).

The combination of multiple forms of IP protection will help to comprehensively protect the different aspects of a product. Therefore, in addition to industrial designs, you should consider the possibility of additional protection under other forms such as trademarks, patents, or copyrights to achieve the best possible protection for your product.

Registering trademarks, industrial designs, and even copyrights simultaneously not only helps protect the visual and design elements of a product but also helps you build a strong legal toolkit to [handle IP infringement](#). Combining the registration of all three types of IP will create more legal grounds to combat IP infringement and prevent competitors from easily copying products. In case the product is copied or counterfeited, you can use one or all three types of protection to request Vietnamese [enforcement agencies](#) to handle infringement through administrative measures (*confiscation of infringing products, destruction, administrative sanctions*), civil measures (*requesting the infringing party to cease infringement, apologize, make public correction, compensate for damages*), or criminal measures. Note that criminal sanctions do not apply to industrial design infringement

Relying on only one form of protection can be risky for your company, as it may leave certain aspects of your product unprotected or subject to lengthy registration processes. For instance, trademark registration in Vietnam can take between 15 and 20 months. Combining multiple forms of protection can help mitigate these risks and protect your company from legal disputes. Employing a multifaceted IP protection strategy proves to be an effective approach to comprehensively shield products, enhance competitiveness, attract investments, and expand business opportunities

Final thoughts

"It's too late to close the stable door after the cow is gone" - a seemingly simple proverb yet holding a valuable lesson that remains relevant for businesses operating in Vietnam amidst the rampant prevalence of counterfeiting. Instead of scrambling to address the aftermath of infringement, proactively safeguard your "cow" - your unique creations and business endeavors - by registering intellectual property rights (IPR) promptly. The haunting fear of having one's creative efforts stolen and exploited by competitors constantly weighs on businesses.

To "immunize" yourself against industrial design theft, you need to equip yourself with knowledge of IP law and a deep understanding of the registration process. This will help you accurately identify the scope of protection, prepare a complete application file, avoid errors, and ensure the legality of ID protection. It should be considered a business "strategy" rather than just a legal matter.

Contact KENFOX IP & Law Office for comprehensive consulting services on industrial design (ID) registration and effective intellectual property protection solutions tailored to your business needs.

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