

## Gathering Convincing Evidence: The Key to Success in Protecting Non-Traditional Trademarks in Vietnam

In intellectual property (IP) disputes involving non-traditional trademarks (such as product shape, color, fragrance, sound, moving images, etc.), gathering compelling evidence to prove the link between the non-traditional element and the brand plays a crucial role and directly affects the outcome of the case. Failure to prove the distinctiveness of non-traditional trademarks can lead to serious legal risks for the owner, such as trademark refusal, loss of exclusive rights to the non-traditional element, and trademark infringement lawsuits.

What are other reasons why non-traditional trademark owners need to collect convincing documents and evidence? What should owners do to strengthen their legal position and effectively respond to disputes and IP infringements related to non-traditional trademarks? KENFOX IP & Law Office, with extensive experience in intellectual property consulting, would like to share some aspect of the above matter.

### 1. Gathering Compelling Evidence: Why It's Essential for Non-Traditional Trademark Protection

Non-traditional trademarks such as color (monochrome trademarks), three-dimensional trademarks (3D) and trade dress (or get-ups) are often considered to [lack inherent distinctiveness](#) and are refused protection under Articles 74.2(a) and 74.2(b) of the Intellectual Property Law because they are not generally perceived by the public as an indication of the origin of the goods, i.e., they do not fulfill the "distinctive" function of a trademark, but are only intended to enhance the aesthetic appeal and make the goods more attractive to potential consumers. Therefore, the examiner will refuse protection for such trademarks due to lack of distinctiveness.

To overcome non-traditional trademark registration refusals, the owner must demonstrate the clear distinctiveness of the non-traditional sign compared to common elements. An effective strategy is to use the non-traditional trademark consistently and uniformly in all marketing, communication, and promotion activities. As a result, brand awareness is strengthened, a strong connection is established between the non-traditional trademark and the product/service, making it easy for the public to recognize and associate with it. This means that the owner of a non-traditional trademark must establish goodwill or reputation associated with the goods or services in the minds of the public. This goodwill or reputation must come from a specific distinguishing feature of the product or service (e.g., name, logo, packaging style, color...), embedded in the minds of the public because it is the attractive force that brings customers to the brand owner.

For example, [the "gold" color of Lindt's](#) (Germany) rabbit-shaped chocolate products has become a reputable and renowned brand identification mark, achieving distinctiveness through a consistent use strategy over many decades.

The primary function of a trademark is to distinguish the goods or services of one enterprise from those of another. For non-traditional trademarks, demonstrating distinctiveness is particularly crucial. Clear evidence that a non-traditional trademark has been used distinctively and is recognized and remembered by the public will facilitate the assessment of the non-traditional trademark's ability to fulfill its "distinctive function" by the relevant authorities.

With compelling evidence of ownership of a non-traditional trademark, the owner can protect their brand from copying and imitation. By examining the evidence, the competent authorities have the basis to determine infringement, compel the infringer to cease the infringement and compensate the legitimate trademark owner for damages.

### 2. Enhancing Distinctiveness for Non-Traditional Trademarks: What To Do?

Non-traditional trademarks, including colors, product shapes, packaging, sounds, etc., are playing an increasingly important role in brand building, development, and customer attraction. However, protecting intellectual property rights for this type of trademark often presents challenges due to its intangible nature and easier replicability compared to traditional trademarks. To strengthen their legal position and enhance the ability to demonstrate distinctiveness for non-traditional trademarks, owners need to develop an effective strategy from the outset.

#### [a] Maintaining Records and Providing Evidence of Extensive Use for Non-Traditional Trademarks

Maintaining comprehensive [evidence of non-traditional trademark use](#) strengthens the argument that the non-traditional trademark has been used consistently and uniformly, thereby demonstrating its distinctiveness and brand recognition capabilities. This supports the resolution of disputes related to non-traditional trademarks and protects intellectual property rights against copying, imitation, and infringement.

From the very beginning of using non-traditional elements, owners should carefully store all relevant information. Record the specific dates when the non-traditional trademark began to be used for the brand. Document in detail the markets, regions, products, and services where the non-traditional trademark is used. Store all documents related to promotional and marketing activities using non-traditional elements, including advertising campaigns, PR articles, and marketing materials. Collect and store customer feedback on non-traditional elements, including opinions, reviews, and brand awareness.

To enhance the effectiveness of demonstrating the distinctiveness of a non-traditional trademark, documents and evidence of its use should emphasize the "consistency" and "long-term" nature of its usage. This indicates that the non-traditional trademark is not a random element but an integral part of the owner's brand strategy. Evidence should be presented logically to establish a clear "connection" between the non-traditional trademark and the brand, demonstrating that the non-traditional trademark has become a distinctive feature of the brand and is recognized by the public.

In addition, the owner should provide data and statistics to strengthen the argument and increase the persuasiveness of the evidence (such as: sales of products bearing non-traditional trademarks have grown over time; brand recognition rates have increased after using non-traditional trademarks in advertising campaigns; website traffic and social media engagement have increased when using non-traditional trademarks).

Vietnamese Intellectual Property Law does not establish regulations on the extent to which a trademark that lacks (does not have) inherent distinctiveness must be [used "extensively"](#) in commerce to meet the criteria for "distinctiveness" or "secondary meaning." However, reference can be made to the provisions of Article 19.1(d) of Circular 11/2015/TT-BKHCN on the enforcement of rights against unfair competition to provide supporting documents. Owners of non-traditional trademarks can provide the following documents and evidence, noting that all evidence will be accepted if it shows that the sign is recognized as a trademark and is associated with a specific commercial source in Vietnam, such as:

- Statistics on revenue and sales in Vietnam;
- Statistics on advertising investment in Vietnam;
- Consumer and market surveys in Vietnam;
- Reports from business and consumer associations in Vietnam;
- Reports on the types, scope and scale of advertising campaigns in Vietnam;
- Documents on digital advertising and marketing campaigns in Vietnam;
- Catalogs, price lists and invoices in Vietnam;
- Management reports.

### **[b] Market surveys in Vietnam**

Consumer surveys are an important tool for measuring the level of consumer awareness and recall of non-traditional trademarks. They help to determine the level of association between a non-traditional trademark and a specific product/service and brand. This, in turn, increases the effectiveness of demonstrating the distinctiveness of a non-traditional trademark.

To conduct an effective survey, the owner should (i) Clearly define the survey objectives, (ii) Choose an appropriate survey method, (iii) Carefully design survey questions, (iv) Partner with reputable market research firms, and (v) Analyze the collected data scientifically (*Using appropriate statistical methods to analyze data and draw conclusions, using charts and tables, explaining the meaning of survey results and linking them to the goal of demonstrating the distinctiveness of a non-traditional trademark*).

Surveys can be conducted through face-to-face interviews, online surveys, or market research. The brand owner should collaborate with market research companies to collect scientific evidence of a clear link between the non-traditional branded product and the brand owner in the minds of consumers. Survey results will provide specific data on the level of association between the non-traditional element and the brand, strengthening the argument for the uniqueness and distinctiveness of the trademark.

### **[c] Filing a Non-Traditional Trademark Application in Vietnam**

Owners may consider [registering non-traditional trademarks](#), although this registration may encounter difficulties during the substantive examination process due to higher requirements for demonstrating distinctiveness, leading to high costs and uncertainty. However, successful registration will provide the owner with stronger legal protection, making it easier for them to enforce their rights and combat infringement.

### [d] Professional Legal Support in Vietnam

Owners should consult with an intellectual property (IP) lawyer to obtain advice on a non-traditional trademark protection strategy, as well as to assist them in gathering evidence, preparing the application, and conducting the necessary legal procedures to effectively enforce IP rights for the non-traditional trademark.

### Final thoughts

Non-traditional trademark protection presents several challenges due to their inherent difficulty in identification and distinctiveness compared to traditional trademarks. This can lead to increased disputes and legal risks. Additionally, gathering evidence of use, demonstrating distinctiveness, and registering non-traditional trademarks often involve higher costs compared to traditional trademarks.

Despite these challenges, non-traditional trademarks can evolve into unique intellectual property assets that leave a lasting and powerful impression on consumers. They can effectively differentiate businesses amidst a sea of traditional trademarks, increase access to new markets, and attract potential customers. It seems that everything has its price, and the greater the risk, the higher the potential reward.

Contact KENFOX IP & Law Office if you require professional assistance in protecting your non-traditional trademarks in Vietnam.

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