

## When New Facts Will Be Accepted for an IP Appeal in Vietnam?

Protecting intellectual property (IP) rights in Vietnam can be fraught with challenges, particularly when faced with unfavorable decisions issued by the IP Office of Vietnam (IPVN). One such hurdle lies in the complex and evolving landscape of "new facts" in IP appeal proceedings. What constitutes a "new fact"? When can it be introduced? And how does this impact the outcome of an appeal? These questions have perplexed IP rights holders and practitioners alike. As Vietnam's IP landscape evolves, so too do the rules governing "new facts", creating both opportunities and challenges for those seeking to protect their intellectual assets.

### 1. The Concept of "New Facts" in IP Appeals

New facts in an IP appeal are those that existed during the examination of the IP application but, due to objective reasons, IPVN and relevant parties could only become aware of after the issuance of the Decision on grant or refusal of the protection certificate.

New facts that were not established by the applicant during the examination of the application and which could have altered the outcome of the appealed decision or notice are generally considered to be outside the scope of an appeal and are therefore not admissible. Such new facts may include a Letter of Consent ("LoC") or a Decision on 5-year non-use cancellation or [invalidation](#) against the cited trademark provided by the trademark applicant to support their trademark appeal.

### 2. Historical Overview of "New Facts" in Vietnam

New facts in an IP appeal were first defined in Circular No. 16/2016/TT-BKHCHN. According to this circular, new facts are those that were not considered during the examination process.

Prior to issuance of Circular No. 16/2016/TT-BKHCHN taking effect as of 01 January 2018, new facts (e.g., LoC or a Decision on 5-year non-use cancellation or invalidation against the cited trademark provided by the trademark applicant after their filing of a trademark appeal) were still accepted. This practice has facilitated IPR holders to pursue the IP applications which faced refusal Decision issued by IPVN.

### 3. Legal Basis for the Treatment of "New Facts"

The concept of "new facts" in appeal proceedings has been a point of contention in Vietnam due to its potential to influence the outcome of cases. Arguments made by IP practitioners are that new facts should be allowed to be submitted any any stage of the appeal proceedings. Various jurisdictions accept submission of LoC or results of 5-year non-use [cancellation](#) or invalidation during the appeal proceedings and appeal proceedings involving IP is a specialized field, not similar to other fields, such as a special mechanism should be adopted to appeal settlement. However, from the perspective of law makers, only when proving that an IP refusal Decision issued by the IP Office of Vietnam is unlawful, the appeal can be accepted. Submitting new facts (e.g., Letter of Consent) after filing an appeal can't serve the purpose of proving that an IP refusal Decision is unlawful. Therefore, such submission of LoC is not accepted. Under Circular No. 16/2016/TT-BKHCHN, IP applicants had to submit new facts before IPVN issue a refusal Decision if they want to overcome the [refusal notice](#).

The contradictory provisions under Circular No. 16/2016/TT-BKHCHN results from the fact that it followed the principles as set out under the Law on Complaints, which governs general complaints. In detail, the appeal is only considered valid when the appellant have grounds for the belief that such decisions and notices are unlawful and directly infringes upon their legitimate rights and interests (Article 2.1 of Law on Complaint and Article 21.1 (a) of Circular No. 16/2016/TT-BKHCHN).

### 4. The Evolution of "New Facts" Under Circular No. 23/2023/TT-BKHCHN

However, following the 3<sup>rd</sup> revision to Vietnam's IP Law in 2022 and the issuance of Decree No. 65/2023/ND-CP, the Ministry of Science & Technology of Vietnam issued Circular No. 23/2023/TT-BKHCHN ("**Circular 23**"). Accordingly, Circular No. 16/2016/TT-BKHCHN ceased to be effective from the effective date of Circular No. 23.

In Circular 23, provisions on "new facts" were continuously changed. In detail:

- Per Article 35.3 (b) Circular No. 23/2023/TT-BKHCHN, *[facts that exist in the course of examination of an industrial property registration application but due to some objective reason, IPVN and related organizations and individuals only know such facts after the decision on grant of/refusal to grant a protection title (below referred to as new facts) is issued will be not accepted in the course of settlement of an IP appeal unless such circumstances are put forth by a third party under Article 38.6 (b) of Circular No. 23/2023/TT-BKHCHN]*.

- Under Article 38.6 (b) of Circular No. 23/2023/TT-BKHCN, [*in case an appellant who is not the applicant or requester for establishment of industrial property rights or registration of a contract on transfer of industrial property rights subject to the appealed decision or notice provides new facts that are likely to affect appeal settlement conclusions, IPVN shall re-examine new fact-related contents according to procedures for re-examining the registration application for establishment of industrial property rights. Based on such examination results, the first-time appeal settler shall issue an appeal settlement decision].*

The trademark appellant may utilize the mechanism outlined in Article 38.6(b) of Circular No. 23/2023/TT-BKHCN to “formalize” the submission of “new fact” after filing the appeal through the “[third party](#)” mechanism. The crux of this provision is determining when “new fact” will be admissible in IP appeals in Vietnam.

- Under Article 38.6(b) of Circular No. 23/2023/TT-BKHCN, new fact (e.g., a LoC) proactively submitted to IPVN by the proprietor of a conflicting trademark can be a valuable tool in resolving trademark appeals. The submission of a LoC from the proprietor of a conflicting trademark may fall within the provision of Article 38.6 (b) of Circular No. 232023/TT-BKHCN, supporting the resolution of the applicant's appeal and may be considered as new admissible fact in the proceedings.
- Similarly, if a third party (not the appellant) submits that the cited mark registration is under the 5-year non-use cancellation or invalidation process, this may fall into the scope of Article 38.6 (b) of Circular No. 232023/TT-BKHCN and IPVN may need to suspend examination of the appeal because of a new fact submitted by a third party which is likely to affect appeal settlement conclusions.

In short, only when the “third party” submits new facts to the [appeal](#), will the addition of those new facts be accepted in the appeal resolution process in Vietnam. New facts submitted by the appellant will not be considered or accepted in the appeal proceedings before IPVN.

## 5. Implications of the New Regulations

The ability of third parties to introduce new facts is assumed to enable IPVN to have a more comprehensive understanding of the relevant facts, potentially leading to more accurate decisions and eventually, make a fairer and more accurate decision. However, introducing new facts through third-party submissions can prolong the appeal process and increase its complexity. IPVN may need to conduct additional investigations or hearings to evaluate the new [evidence](#). If third parties are allowed to introduce new facts after the appeal has been initiated, IP agents or IP applicant need to use “hands” of a third party to submit “new facts” to IPVN so that such third party’s new fact submission is deemed valid. This mechanism will increase costs and complexity of appeal proceedings in Vietnam.

### Final thoughts

The mechanism of accepting new evidence submitted by a third party during an IP appeal presents both opportunities and risks for all stakeholders.

IP owners and their lawyers must fully grasp these new rules and be well-prepared to use this mechanism. To protect their rights, IP holders should submit all relevant evidence from the outset and be ready to adapt their strategies as needed. This change to the “new facts” rule marks a significant step forward in improving Vietnam’s IP system, but it requires flexibility and careful thought from all involved parties.

KENFOX IP & Law Office understands the challenges and complexities of facing a trademark refusal decision. With 15 years of practical experience, our team of IP experts has assisted numerous clients in overcoming IPVN's refusal decisions, ensuring successful IP protection in Vietnam. We adopt a comprehensive approach, combining in-depth IP knowledge and extensive practical experience to effectively carry out appeal procedures. We work closely with our clients to analyze the reasons for refusal, develop a compelling appeal plan, and ensure compliance with statutory deadlines.

Contact KENFOX IP & Law Office if you need our professional support to secure your IP rights in Vietnam.

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