

Pharmaceutical Trademark Opposed in Vietnam: What Strategies for Successful Defense?

In a recent trademark opposition case, our firm, KENFOX ip & Law Office, successfully defended AJANTA PHARMA LIMITED's pharmaceutical trademark "VILDAREL" against opposition from BIOFARMA, owner of the prior mark "VASTAREL" (IR No. 221430). [The opposition](#), based on Article 74.2(e) of Vietnam's IP Law, alleged that "VILDAREL" was confusingly similar to "VASTAREL" and could potentially harm BIOFARMA's brand reputation.

The applied-for mark filed by AJANTA PHARMA LIMITED	The prior mark in the name of BIOFARMA
VILDAREL	VASTAREL

To bolster its claim of similarity, BIOFARMA presented a comparison table highlighting the purported similarities between "VILDAREL" and "VASTAREL." This table aimed to visually demonstrate the points of convergence between the two marks, attempting to persuade the VNIPO of their potential for confusion:

Prior mark	<u>V</u>	A	S	T	<u>A</u>	<u>R</u>	<u>E</u>	<u>L</u>
Opposed mark	<u>V</u>	I	L	D	<u>A</u>	<u>R</u>	<u>E</u>	<u>L</u>

BIOFARMA further supported its opposition by citing precedents from earlier trademark cases involving "VASTAREL". Specifically, they referenced VNIPO's refusals of the marks "VOSFAREL" and "VOSFAREL-DOMESCO" due to their similarity to "VASTAREL". To strengthen this argument, BIOFARMA presented expert opinions from the [Vietnam Intellectual Property Research Institute](#) (VIPRI) confirming that "VOSFAREL" infringed upon the "VASTAREL" trademark. Additionally, they cited an inspection conclusion from the Inspectorate of the Ministry of Science & Technology, which deemed "VOSFAREL-DOMESCO" and "VOSFAREL Mr-DOMESCO" confusingly similar to "VASTAREL", constituting trademark infringement.

We concurred with VNIPO's previous refusals in the "VASTAREL" v. "VOSFAREL" cases but stressed the unique circumstances surrounding "VILDAREL". Our [counter-arguments](#) effectively demonstrated the significant differences between the marks at issue, persuading VNIPO to reject BIOFARMA's opposition. This resulted in a favorable outcome for our client, with VNIPO granting registration for the "VILDAREL" trademark.

KEY TAKEAWAYS

1. Constituent elements of pharmaceutical trademarks

Pharmaceutical trademarks are often based on their underlying molecule or ingredient names, offering clues to the drug's function or composition. This practice stems from the desire for memorability, as healthcare professionals and patients can more easily recall names that subtly reflect the drug's purpose. Furthermore, companies frequently use common prefixes or suffixes (like "-mab" for monoclonal antibodies, as in "Rituximab" or "Adalimumab") to signal the drug's therapeutic area. This approach, coupled with the frequent use of International Nonproprietary Names as a foundation for trademarks, contributes to the observed similarities between different brands.

If you could identify a common source or origin for the pharmaceutical trademarks in dispute, focus your arguments on the distinct connotations and meanings they convey.

- Even though pharmaceutical trademarks might share a common origin (molecule name, INN, etc.), the subtle variations and the way those elements are combined can create significant differences in connotation and meaning. This allows companies to differentiate their products and establish unique brand identities.
- Even if two trademarks share a common root, they might emphasize different parts of it. This can lead to distinct associations. For example, one might highlight the therapeutic effect while another focuses on the mechanism of action.
- Companies often combine elements derived from the source with unique prefixes, suffixes, or other invented components. These additions can significantly alter the overall impression and [create a distinct identity](#).

- Even small changes in spelling or pronunciation can create significant differences in how a trademark is perceived and remembered. This can be achieved through creative use of vowels, consonants, and syllable structure.
- The trademark is just one element of a broader brand strategy. Marketing campaigns, packaging design, and other communication efforts contribute to the overall perception of the drug and its associated brand.

Highlight how subtle variations, distinctive elements, and phonetic or visual nuances create unique brand identities, impacting perception and memorability. This demonstration of individualized brand identity is crucial for successfully defending your trademark in [opposition, refusal](#), or invalidation cases in Vietnam.

In essence, while the origin of pharmaceutical trademarks might be similar, the subtle ways in which companies manipulate and combine these elements can lead to vastly different connotations and ultimately influence how the brands are recognized, perceived, and memorized.

In the "VILDAREL" case, we successfully argued that despite sharing a popular prefix with "VASTAREL," the marks were distinguishable due to their distinct suffixes and overall impressions. We emphasized the specialized knowledge of healthcare professionals, the target consumers, and their ability to differentiate between subtle variations in pharmaceutical trademarks.

2. Trademark examination in other jurisdictions where two marks are filed for registration

Trademark examination outcomes in other jurisdictions can provide valuable support in defending pharmaceutical trademarks in Vietnam. Positive decisions from countries with robust IP systems, such as India, China, the EU, or the US, can serve as persuasive precedents, demonstrating that similar marks have been deemed distinguishable elsewhere.

When citing international precedents, it is essential to (i) **Select relevant jurisdictions:** Prioritize jurisdictions with comparable legal frameworks and examination standards. (ii) **Conduct thorough research:** Ensure the cited cases are factually similar and involve comparable marks, and (iii) **Provide clear comparisons:** Present a concise comparative analysis highlighting the phonetic, visual, and conceptual differences between the marks.

In the "VILDAREL" case, we used the positive trademark examination result from India to support our arguments for distinctiveness. Despite "VASTAREL" having an earlier filing date in India, the Intellectual Property Office of India granted [registration](#) to "VILDAREL", recognizing the sufficient differences between the marks. This precedent reinforced our argument that the marks could coexist without confusion in the marketplace.

Utilizing international precedents strategically can bolster arguments for distinctiveness and contribute to a successful defense in Vietnamese trademark disputes.

3. Precedents of similar pharmaceutical trademarks

Providing examples of similar pharmaceutical trademarks that have been successfully registered in Vietnam can significantly bolster your arguments for distinctiveness. It demonstrates that the VNIPO has previously accepted marks with similar characteristics, suggesting a precedent for accepting your mark as well. It suggests consistency in VNIPO's examination practices, implying that if similar marks were previously accepted, your mark should also be [considered favorably](#). Presenting concrete examples can help mitigate any subjective judgment by the examiner and provide a more objective basis for assessment.

To this end, you need to [conduct thorough searches](#) on the VNIPO's online trademark database to identify registered marks that share similarities with yours. Focus on marks in the same class (pharmaceutical products) and those with similar prefixes, suffixes, or overall construction. Use this strategy in conjunction with other arguments, such as emphasizing the differences between the marks, targeting the relevant consumer, and demonstrating honest intentions. The following similar marks have been found to support our arguments:

Trademark 1	VIL<u>OG</u>REL Application No.: 4-2008-04763 Filing date: 11/03/2008 Registration No.: 128297	VA<u>ZO</u>GREL Application No.: 4-2015-34982 Filing date: 11/12/2015 Registration No.: 306646
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	Registration date: 29/06/2009 Owner: Công ty cổ phần dược phẩm Cửu Long Class 05: Pharmaceutical preparations	Registration date: 15/10/2018 Owner: Công ty cổ phần dược phẩm Sao Kim Class 05: Pharmaceutical preparations
Trademark 2	PANGAGEL Application No.: 4-2018-44416 Filing date: 17/12/2018 Registration No.: 375591 Registration date: 07/01/2021 Owner: Công ty TNHH xuất nhập khẩu tổng hợp Nam Phú Class 05: Pharmaceutical preparations	LANDAGEL Application No.: 4-2010-24815 Filing date: 25/11/2010 Registration No.: 176089 Registration date: 22/11/2011 Owner: Công ty cổ phần dược phẩm Khang Minh Class 05: Pharmaceutical preparations
Trademark 3	DERMYCOL Application No.: 4-1998-37839 Filing date: 17/12/2018 Registration No.: 31537 Registration date: 13/07/1999 Owner: Công ty TNHH dược phẩm Sài Gòn Class 05: Pharmaceutical preparations	DERMACOL Application No.: 4-2001-01806 Filing date: 17/12/2018 Registration No.: 45033 Registration date: 25/04/2001 Owner: Công ty cổ phần dược phẩm Nam Hà Class 05: Pharmaceutical preparations

Final thoughts

Trademark oppositions often present formidable challenges and require strategic legal expertise, particularly when the prior trademark owner presents substantial evidence of prior use or registration, including favorable decisions from Vietnamese authorities. However, with a thorough analysis of the specific facts, a comprehensive understanding of Vietnamese trademark law and practice, and a strategic approach, it is possible to achieve a favorable outcome and secure your trademark rights. KENFOX's success in the "VILDAREL" case exemplifies our ability to develop and execute effective strategies, securing our clients' trademark rights and enabling their continued brand development.

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