

"Fabrilar" vs. "FABRICA" and "FABRICAIR": How to successfully appeal a trademark refusal in Vietnam?

Vietnam – On 16/10/2024, the IP Office of Vietnam ("IP VIETNAM") issued a Decision on acceptance of IR No. 1470915 for the mark "Fabrilar" in the name of Aspöck Systems GmbH, withdrawing its provisional refusal decision and terminating a lengthy 4-year appeal process. This is a great victory for our client, Aspöck Systems GmbH, an Austrian company that specializes in developing and manufacturing lighting systems for vehicles, founded in September 1977.

The mark "Fabrilar" under IR No. 1470915, designating Vietnam, faced a [provisional refusal](#) for all goods and services in Classes 11 and 37, as well as certain goods in Class 09 and services in Class 35, due to the mark being allegedly similar to two cited marks "FABRICA" and "FABRICAIR".

Cited mark 1		Cited mark 2	
Trademark 1 :	FABRICA	Trademark 2 :	FABRICAIR
Int'l Registration No.:	654791	Int'l Registration No.:	958906
Registration Date:	24 April 1996	Registration Date:	27 February 2008
Owner:	FABRICA S.R.L.	Owner:	FABRICAIR A/S
Address:	Via Villa Minelli 1 PONZANO VENETO (Treviso) (IT)	Address:	Islandsvej 3 DK-4681 Herfølge (DK)
Classes:	16, 25, 35, 38, 41, 42	Classes:	11, 19, 24

To address a trademark refusal based on alleged [similarity to prior marks](#), applicants have several strategies to overcome the refusal. They can present arguments highlighting the dissimilarities between the applied-for mark and the cited marks, focusing on visual, phonetic, or conceptual distinctions. Alternatively, they may obtain a Letter of Consent from the owner of the cited marks, allowing coexistence. Another option is to challenge the validity of the cited marks through a five-year non-use cancellation action. Additionally, applicants can amend their application by limiting or removing the conflicting goods or services to avoid overlap.

The client informed us that Fabrica S.R.L., owner of the trademark "FABRICA" (IR No. 654791), operates in a completely different field as a "publishing house", whereas the Danish company FABRICAIR A/S specializes in manufacturing air ducting systems under the trademark "FABRICAIR" (No. 958906). The client asked whether we could include arguments in our response requesting IP VIETNAM to grant protection for their mark, emphasizing the distinct nature of the respective businesses.

This is a common argument raised by trademark owners when facing a refusal, asserting that the primary business activities of the cited trademark owner differ significantly from their own, and therefore, no conflict of interest would arise if the marks co-exist. However, in practice, IP VIETNAM examiners do not focus on the actual business sectors of the cited trademark owners. Instead, they assess the similarity of the marks by directly comparing the applied-for mark with the cited marks, as well as the respective goods or services associated with them.

The client faces a challenging situation as their mark, "Fabrilar", is phonetically similar to the two cited marks, "FABRICA" and "FABRICAIR". Additionally, the goods and services associated with their mark in Classes 11 and 17, as well as certain goods and services in Classes 09 and 35, are considered similar to those covered by the cited marks.

After analyzing the cited marks, we developed a strategic approach to address the complex refusal by adopting comprehensive measures. These included [removing certain directly conflicting services](#) in Class 35 to overcome the conflict with the first cited mark and obtaining a Letter of Consent from the owner of the second cited mark.

After carefully taking our appeal into consideration, which presented detailed arguments on the mark's distinctiveness and the absence of consumer confusion, IP VIETNAM found our reasoning persuasive and withdrew its provisional refusal, ultimately granting protection for our client's mark.

Key takeaways

[1] Letter of Consent

Statutorily, Vietnam does not adopt consent letter regime to exclude the likelihood of confusion. Vietnam's IP law doesn't explicitly include Letters of Consent (“LoC”) as a deciding factor in trademark disputes. This means IP Vietnam isn't obligated to accept an LoC as automatic proof that confusion is unlikely. The core principle in trademark law is preventing consumer confusion. Even if two trademark owners agree that confusion isn't likely, IP Vietnam's primary focus is whether the marks are similar enough to confuse consumers about the origin of goods or services. This is why clear evidence of dissimilarity is so important, even with an LoC.

However, a LoC *does* hold value as supporting evidence. While not legally binding, a Letter of Consent can positively influence IP Vietnam examiners. It can demonstrate that the owner of the prior mark doesn't believe there will be confusion and thus doesn't object to the [registration](#) of the adverse party's mark. This can strengthen arguments on distinguishability between the marks in questions because:

- (i) When a trademark owner provides a Letter of Consent, they implicitly acknowledge that they don't see the applicant's mark as an [infringement](#) of their own. It suggests that the parties most likely to be harmed by potential confusion (i.e., the trademark owners themselves) don't see a problem and thus, they believe the marks are sufficiently different to coexist in the marketplace without causing confusion.
- (ii) It signals to IP Vietnam that the two parties have already resolved any potential disputes themselves, making the examiner more likely to accept the applicant's arguments for distinguishability.
- (iii) With the issue of potential infringement seemingly resolved by the LoC, IP Vietnam can focus more objectively on assessing the inherent differences between the marks. This allows you to emphasize those distinctions more effectively.

IP VIETNAM handles LoCs on a case-by-case basis. The strength of your arguments and the specific circumstances of your case will significantly impact the outcome. You must still present compelling arguments on dissimilarities between the marks at issues concerning Visual appearance, pronunciation, meaning, target consumers and goods/services, demonstrating minimal likelihood of confusion to increase your chances of success.

[2] Deleting the conflicting goods/services

Rendering strong arguments against a trademark refusal is helpful to overcome the refusal, but it is not always the case, especially, when two marks are highly similar and the goods/services are closely related. If the marks are visually, phonetically, or conceptually very similar, it becomes harder to convince IP Vietnam that there is no likelihood of confusion. Therefore, if [the chances of overcoming the refusal](#) seem slim, relying solely on arguments in cases of high similarity is risky. To mitigate this risk, proactively explore alternative options such as deleting the directly conflicting goods/services. Deleting conflicting goods/services demonstrates to IP Vietnam that you're willing to take steps to address their concerns and coexist peacefully with the owner of the cited mark. This can make them more receptive to your arguments for the remaining goods/services.

Deleting overlapping goods/services can be a highly effective strategy for overcoming trademark refusals in Vietnam, especially in cases of high similarity. If the conflicting goods/services are not core to your business, deleting them might be a worthwhile trade-off to secure the trademark for your main offerings.

Final thoughts

Overcoming [trademark refusals in Vietnam](#) requires deep expertise and strategic persistence. Trademark refusals based on similarity can be difficult to overcome, especially, high similarity between marks and related goods/services can make success challenging.

However, it is not the end of the road. By combining meticulous argumentation with proactive measures like securing a Letter of Consent and strategically deleting conflicting goods/services, applicants can increase their chances of securing trademark protection in Vietnam, even in the face of challenging refusals.

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