

Registering Trademarks in Black and White or in Color: What Is the Optimal Protection Strategy in Vietnam?

Every element that constitutes a brand - even the smallest detail - can serve as either a competitive advantage or a strategic vulnerability in the pursuit of market share and consumer trust. A trademark, as a core commercial identifier, is not merely a visual symbol but also embodies the reputation, value, and identity of the business. Accordingly, the decision to register a trademark in black and white or in its color version should not be treated as a mere formality. Rather, it must be approached as a strategic legal determination with direct implications for the scope of intellectual property protection and the effectiveness of enforcement against potential infringements.

With extensive practical experience in intellectual property law, KENFOX IP & Law Office provides legal insights into why the dual registration of both black-and-white and color versions of a trademark may constitute a prudent strategy. This approach enables trademark owners to establish a more comprehensive and enforceable protection framework in Vietnam—a market rich with opportunity but also increasingly complex in its legal landscape.

Registration requirements

Under the applicable laws and prevailing trademark registration practices in Vietnam, applicants are required to clearly and accurately specify the colors that constitute the trademark in the application. If the application is approved, the color description will be officially recorded in the Trademark Registration Certificate, thereby defining the corresponding scope of [legal protection](#).

Where a trademark is registered solely in black and white, the scope of protection is confined to that specific form of representation. Variations in color used by third parties - although similar in layout or structure—may fall outside the ambit of protection conferred by the registered mark. This presents a significant challenge in enforcement, particularly in cases where color serves as a key element in establishing the distinctiveness and commercial recognition of the trademark in the marketplace.

In such circumstances, alleged infringers may assert that the use of a similar trademark with different colors does not create a similar commercial impression and is unlikely to cause confusion among consumers. As a result, the registration of a black-and-white version alone may not provide a sufficient legal basis to address infringing acts that involve color-based variations.

Evidence of use

Article 5.c(2) of the Paris Convention provides that: “*Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark*”.

Based on this provision, in cases where color is not a determinative factor in establishing the distinctiveness of the [trademark](#), use of the black-and-white version may be considered legitimate use of the registered colored mark. Such use may serve as a valid legal basis for opposing a non-use cancellation action initiated by a third party.

However, where color constitutes a core element contributing to the distinctive character of the mark, the mere use of a black-and-white version may not satisfy the requirement of genuine use. In such cases, failure to use the trademark in the form in which it was registered within the prescribed statutory period may expose the mark to the risk of cancellation in Vietnam at the request of a third party.

Lack of clarity in assessing creative variations

Vietnam's current intellectual property legal framework—including the Law on Intellectual Property and its implementing regulations—does not provide specific criteria for determining the extent to which creative variations may be deemed not to alter the distinctive character of a registered trademark. In practice, the assessment of such variations is largely subject to the professional judgment of individual examiners at the Intellectual Property Office of Vietnam (IP VIETNAM) and is conducted on a case-by-case basis.

This lack of consistency and predictability in examination outcomes presents considerable legal risks for trademark owners, particularly when seeking to establish evidence of use or to enforce rights against infringing

acts. To ensure a comprehensive scope of protection and to minimize disputes arising from differing interpretations during enforcement, trademark owners are advised to consider registering both black-and-white and color versions of their marks.

Claiming priority rights

Priority rights in trademark registration are established based on the first application seeking protection for the same trademark subject matter. However, a claim to priority based on a black-and-white trademark application is not automatically deemed to extend to the corresponding color version of the mark, and vice versa.

In practice, the Intellectual Property Office of Vietnam (IP VIETNAM) considers black-and-white and color trademarks as two distinct applications, each possessing separate and independent distinctive elements. As such, in order to ensure full recognition of priority rights, applicants must file applications that correspond specifically to each version of the mark for which [protection](#) is sought.

Final thoughts

The decision to register a trademark in black and white or in its actual color form is a strategic and multifaceted consideration, particularly in the context of Vietnam's evolving trademark protection framework. As trademark infringement and dispute cases in Vietnam grow increasingly complex, it is imperative for trademark owners to proactively develop robust intellectual property protection strategies.

Vietnam's rapidly developing economy and highly competitive business environment have elevated the importance of brand identity and market recognition. In this setting, trademark infringements are becoming more sophisticated and difficult to detect, requiring businesses to utilize all available legal tools to establish and safeguard their trademark rights effectively.

To maximize the scope of protection and proactively mitigate potential [legal risks](#), trademark owners are strongly encouraged to file separate applications for both the black-and-white and color versions of their marks in Vietnam. Adopting this dual-registration approach not only facilitates the establishment of a more comprehensive protection regime but also strengthens the legal foundation for defending against disputes or infringing acts that may arise during the commercial exploitation and use of the mark in the marketplace. At KENFOX, we are committed to providing our clients with comprehensive and effective trademark protection solutions in Vietnam. Our services go beyond the mere registration of trademarks in black-and-white and color formats; they are grounded in an overarching legal strategy designed to ensure maximum protection of intellectual property rights in a dynamic and evolving legal and market environment.

With a team of seasoned professionals who possess in-depth knowledge of Vietnam's trademark legal framework, KENFOX delivers tailored strategic advice aligned with each client's specific business operations and protection objectives. We take pride in being a trusted partner, supporting our clients in the establishment, maintenance, and enforcement of their intellectual property rights in a proactive and effective manner.

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