

How to Prove Well-Known Trademark Status in Vietnam: Legal Pathways and Practical Insights

Trademark squatting is emerging as a serious legal challenge for international businesses operating in Vietnam. Numerous global brands have found themselves in disadvantaged positions when their trademarks were preemptively registered by third parties, obstructing business operations and eroding brand value. In this context, obtaining **well-known trademark** recognition serves as an essential legal tool, not only to prevent intellectual property infringements but also as a key solution for businesses to restore and protect their legitimate rights.

However, unlike many jurisdictions that adopt a formal registration system for well-known marks, Vietnam's legal framework takes a **case-by-case assessment approach**, with a strong emphasis on actual use and market presence. This means there is no standalone application procedure for establishing well-known status. Instead, trademark owners must proactively navigate multiple legal channels, including **opposition, invalidation proceedings, litigation, or administrative enforcement**—to obtain official recognition from the **Intellectual Property Office of Vietnam (IPVN)** or the courts. Additionally, the support of **"Assessment Conclusions"** from the **Vietnam National Intellectual Property Institute (VNIPI)** is playing an increasingly influential role, serving as powerful evidentiary material in brand protection efforts.

Legal grounds and practice

Securing protection for a **well-known mark** in Vietnam presents unique challenges under the current legal system. According to Vietnam's **Intellectual Property Law 2022**, a well-known mark is defined as one that is **"widely known by the relevant sections of the public throughout the territory of Vietnam."** In principle, information on well-known marks is to be entered into the **"List of Well-Known Marks"** maintained by the IPVN. However, in practice, this list has yet to be officially published or fully maintained by the IPVN. As a result, recognition of well-known status in Vietnam remains primarily **dispute-driven**, typically arising during the resolution of specific legal proceedings.

Unlike in many other countries, Vietnam does not have an **independent registration procedure** for well-known marks. This means trademark owners cannot file a separate application with the IPVN solely for the recognition of their mark as well-known. Instead, **rights in a well-known mark are established based on actual use**, not registration. **Article 6(3)(a) of the IP Law 2022** clearly stipulates that industrial property rights in a well-known mark are **"established based on use, independent of registration procedures."** In other words, to safeguard their rights, owners must be prepared to submit adequate evidence in line with **Article 75 of the IP Law** during disputes or when seeking recognition of well-known status.

2. How a trademark can be recognized well-known status in Vietnam

2.1. Obtaining well-known status of a mark in Vietnam via the IPVN and Vietnamese courts

The IPVN and Vietnamese courts will only treat a mark as well-known when it is at issue in a trademark dispute.

In trademark examination or opposition proceedings, the IPVN may **ex officio** refuse to register a confusingly similar mark by invoking the prior well-known mark. In practice, the IPVN has blocked junior marks (for example, refusing "EUROGO" due to the well-known URGO mark, or rejecting a device similar to Nike's Swoosh) once it deems the senior mark famous. Likewise, when a trademark owner sues for **infringement** or unfair competition, the owner can request the court to recognize its mark as well-known.

Vietnamese courts **rarely** declare fame on their own initiative; they often seek the IPVN's opinion. For example, in *Interbrand Group v. Interbrand JSC* the plaintiff had not registered "INTERBRAND" in Vietnam, so the court asked the IPVN to verify its fame. After the IPVN recognized the mark's reputation, the court ruled in the plaintiff's favor.

Therefore, if a trademark owner wishes to obtain recognition of his mark as a well-known one in Vietnam, they should consider taking actions via the following routes:

- (i) Filing an **opposition/invalidation** against a third party's mark. For trademark opposition, the IPVN reviews the arguments and evidence from both parties and subsequently issues an official letter on the opposition, which serves as a reference during substantive examination, rather than a formal decision. For trademark invalidation, the IPVN may also concludes in its Decision on whether the mark is a well-known in Vietnam.

- (ii) Filing a **petition** and/or **lawsuit** against the alleged infringers under **administrative proceeding** or **civil litigation**. In cases of trademark infringement, the well-known status of a mark can be asserted in court or administrative proceedings to establish infringement. Courts and administrative bodies often file a request to the IPVN to seek the latter's opinion regarding well-known status.

2.2. Obtaining well-known status of a mark in Vietnam via an “Assessment Conclusion” (or “Expertise Opinion”) from Vietnam National Intellectual Property Institute

A very unique feature of IPR enforcement in Vietnam is that IPR holders **can** file requests with Vietnam National Intellectual Property Institute (“**VNIPI**”) (formerly, “Vietnam Intellectual Property Research Institute” - **VIPRI**) to seek its “Assessment Conclusion” (or “Expertise Opinion”) on whether the sign used by a third party may constitute trademark infringement **before** filing a request for handling IPR infringement in Vietnam. If the VNIPI’s “Assessment Conclusion” (or “Expertise Opinion”) is issued in favor of the trademark owner, most of petitions for handling IPR will be accepted by the Vietnamese enforcement authority.

Recently, the VNIPI has accepted requests from trademark owners for confirming the well-known status of trademarks. We have recently assisted Heineken Asia Pacific, a wholly owned subsidiary of Heineken N.V., headquartered in Singapore to deal with some trademark disputes in Vietnam. We have successfully obtained well known status of a mark in Vietnam via “Assessment Conclusion”/“**Expertise opinion**” from the **VNIPI**.

Apart from required documents as set out under Article 75 of Vietnam’s IP Law, one pre-requisite requirement is that such a mark must have been registered in Vietnam.

VNIPI’s “Assessment Conclusion”/“Expertise opinion”: How valuable is it?

The VNIPI’s **assessment conclusion** serves as a **source of evidence** in Vietnam although it's important to understand its legal weight and practical role.

The VNIPI’s assessment conclusions are **not mandatory** or **legally binding**. They are considered expert opinions, not final judgments. Despite this, they are **highly influential for Vietnamese enforcement authorities**. The enforcement authorities in Vietnam, like, Market Management Bureau, Police, Customs, and Courts, often rely on the VNIPI’s Assessment Conclusions as initial evidence when deciding whether to proceed with investigations or enforcement actions. Rights holders are encouraged to include a favorable VNIPI’s Assessment Conclusion when submitting a Petition for Handling of IPR Infringement. It strengthens the case and can significantly sway the outcome. The VNIPI’s is recognized as a specialized agency under the Ministry of Science and Technology, which lends credibility to its assessments in the eyes of enforcement bodies.

We note, however, that in practice, the VNIPI’s “Assessment Conclusion”/“Expertise opinion” is considered by **the IPVN examiners** in trademark opposition or invalidation cases on **case-by-case basis**. Our recent discussions with the IPVN examiners have indicated that the VNIPI’s “Assessment Conclusion”/“Expertise opinion” are considered as a “reference” document, not binding to the VNIPI examiner who will conduct independent examination. Therefore, in **some** cases, although VNIPI’s “Assessment Conclusion”/“Expertise opinion” stated that the marks are deemed “confusingly similar”, the IPVN examiners still accepts registration for a later-filed mark, saying that their viewpoint is different.

Evidence and Documentation Requirements for Well-Known Status Recognition in Vietnam

To have a trademark recognized as a well-known mark in Vietnam, the trademark owner must provide substantial evidence and documentation in accordance with Article 75 of Vietnam's Intellectual Property Law and relevant guidelines.

Article 75 of Vietnam IP Law provides that criteria for the consideration and evaluation of a mark as a well-known mark shall be chosen from several or all of the following criteria:

1. **Level of recognition by relevant consumers:** The number of consumers who know the mark through purchasing, using products/services, or through advertising activities.
2. **Scope of circulation:** The geographical area where goods/services bearing the mark are circulated.
3. **Sales and revenue:** Total revenue or the quantity of products/services sold in the market.
4. **Duration of use:** The continuous period the mark has been in use.

5. **Reputation:** The widespread fame of products/services associated with the mark.
6. **International protection:** The number of countries where the mark has been protected.
7. **International recognition:** The number of countries that have recognized the mark as well-known.
8. **Commercial value:** The transfer, licensing, or capital contribution value of the mark.

Notably, Vietnamese authorities place significant emphasis on evidence of actual use in Vietnam. Data on sales, advertising, distribution networks, marketing campaigns, articles in Vietnamese media, or consumer surveys within the country are all highly valuable documents when proving well-known status.

Final thoughts

In the context of increasing trademark squatting and complex intellectual property disputes, establishing and protecting the well-known status of a mark in Vietnam is not just an urgent legal necessity but also a long-term business strategy for international enterprises. Although Vietnam does not have a formal registration mechanism for well-known marks, trademark owners can effectively utilize existing legal tools such as opposition procedures, invalidation, infringement handling through administrative enforcement agencies or litigation in the courts, as well as pursue **VNIPI Assessment Conclusions** to strengthen their position in protecting their legitimate rights.

By **QUAN, Nguyen Vu** | Partner, IP Attorney
PHAN, Do Thi | Special Counsel
HONG, Hoang Thi Tuyet | Senior Trademark Attorney

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com