The KLEEMANN Case in Vietnam: A Strategy to Block a Prior-Filed Trademark Application Based on Widespread Use Rights

In strict first-to-file jurisdictions like Vietnam, international brands frequently face the risk of bad-faith preemptive filings by third parties. The years-long legal battle over the KLEEMANN trademark shows that even when a third party files first, the rightful owner can still prevent the registration of conflicting marks by pursuing a well-planned opposition strategy, presenting compelling evidence of widespread prior use, and proactively addressing relevant issues with the trademark examiner.

Background

KLEEMANN HELLAS SA, headquartered in Kilkis, Greece, is one of the world's leading lift and escalator manufacturers. Ranked among the top 10 elevator companies globally, KLEEMANN has commercialized its products in 138 countries, including Vietnam, where its lift products had already been widely distributed and recognized through local partners prior to 2020.

On **28 May 2020**, a Vietnamese entity - **Viettech Technology Development Investment Joint Stock Company** (Viettech) - filed **Vietnamese Trademark Application No. 4-2020-19010** for the mark **"KLEEMANN, device"** (KLEEMANN) covering goods in **Class 07** (including lifts/elevators).

To protect its established brand identity and prevent consumer confusion in the Vietnamese market, KLEEMANN HELLAS SA instructed **KENFOX IP & Law Office** to challenge Viettech's application.

Legal Strategy

On **28 February 2022**, KENFOX filed a formal **Notice of Opposition (No. PĐ4-2022-00168)** with the Intellectual Property Office of Vietnam (**IP Vietnam**) against Trademark Application No. 4-2020-19010.
Because Vietnam operates under a strict first-to-file system, overcoming a prior-filed local application requires robust proof of prior use and wide recognition. KENFOX built a comprehensive evidentiary package comprising a notarized Declaration and 13 color-printed annexes centered on three core arguments:

- **Legitimate Ownership and Global Reputation:** Establishing KLEEMANN HELLAS SA as the legitimate global owner of the "KLEEMANN" marks, supported by international registration certificates (such as EU Trademark Registration No. 006188254), global sales data across more than 100 countries (2016–2021), industry awards, and international rankings.
- **Prior Commercialization in Vietnam:** Proving that "KLEEMANN" lift products had been extensively used and commercialized in Vietnam well before Viettech's filing date of 28 May 2020. This was substantiated by local sales-purchase contracts and VAT invoices issued to Vietnamese customers through local distributor Huy Hoang.
- **Likelihood of Confusion:** Demonstrating that Viettech's applied-for mark was confusingly similar to KLEEMANN's widely recognized mark for identical goods (elevators/lifts) in Class 07.

Addressing Procedural Hurdles at IP Vietnam

During the examination process, a notable legal development arose: IP Vietnam initially issued a Notice of Intended Refusal against the Vietnamese applicant's application on the grounds that the applied-for mark was confusingly similar to a prior-registered trademark owned by a third party, KLEEMANN GmbH (which is actually the German parent company of KLEEMANN HELLAS SA (Greece)).

However, the IP Vietnam examiner did not include or cite Notice of Opposition No. PĐ4-2022-00168 as a basis for refusing the Vietnamese applicant's applied-for mark. This created a risk that the examiner might overlook KLEEMANN HELLAS SA's Notice of Opposition.
This risk became even more pronounced when, on 20 July 2022, the Vietnamese applicant filed a response seeking to overcome the Notice of Intended Refusal, arguing that its "elevators/lifts" were completely different from the list of goods in Class 07 protected under KLEEMANN GmbH's registration.

Recognizing that this response could undermine IP Vietnam's initial intention to refuse, KENFOX immediately took strategic steps to ensure that KLEEMANN HELLAS SA's Notice of Opposition would be fully considered by the examiner:

- **In-Person Examiner Consultation:** On **31 August 2022**, KENFOX attorneys met directly with the responsible examiner at IP Vietnam to highlight the extensive local use and reputation of KLEEMANN HELLAS SA and urge formal consideration of Opposition No. PĐ4-2022-00168.
- **Formal Notification to the Applicant:** Following KENFOX's intervention, IP Vietnam issued **Notice No. 8108** on **9 September 2022**, formally notifying Viettech of KLEEMANN HELLAS SA's opposition and setting a strict deadline (9 October 2022) for Viettech to respond.

Concurrently, KENFOX also assisted KLEEMANN HELLAS SA in filing its own multi-class trademark applications in Vietnam - such as Application Nos. 4-2021-53201 and 4-2021-53202 across Classes 06, 07, 09, 35, 37, and 42 - to secure affirmative statutory protection.

Favorable Substantive Examination Outcome

Following sustained monitoring and follow-ups, substantive examination yielded a major breakthrough. Under **Notification No. 89733/SHTT-NH.IP** (dated **11 June 2026**), IP Vietnam refused Trademark Application No. 4-2020-19010 for all designated goods in Class 07.

Crucially, the Notification expressly confirmed that IP Vietnam had considered **Opposition No. PĐ4-2022-00168** and grounded the refusal under **Article 74.2(g) of Vietnam's Intellectual Property Law** - finding that Viettech's applied-for sign is confusingly similar to KLEEMANN HELLAS SA's "KLEEMANN, device" mark, which had already been widely used and recognized for elevators in Class 07 prior to the application's filing date.

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