



Q & A

About Registering Trademark
In Vietnam

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What is trademark?

Trademark is defined as any sign used to distinguish goods or services of different organizations or individuals.

Some objects ineligible for protection as trademark?

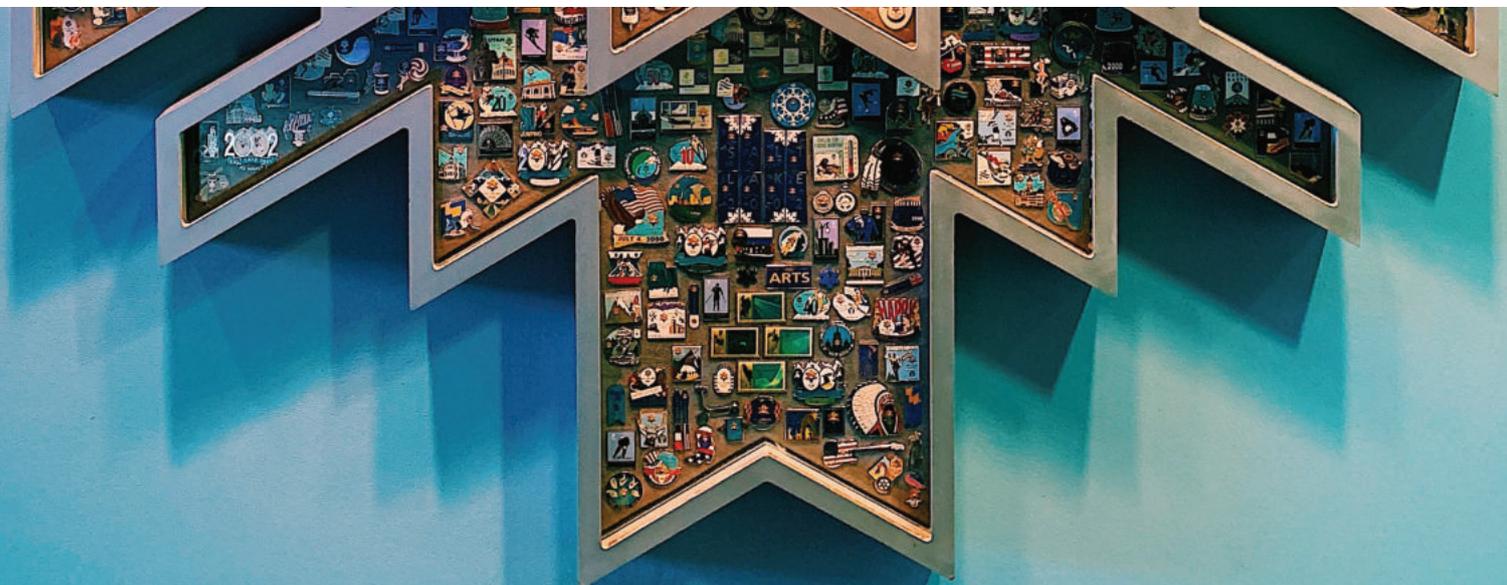
The following signs shall be ineligible for protection as marks:

1. Signs identical with or confusingly similar to national flags or national emblems.
2. Signs identical with or confusingly similar to emblems, flags, armorial bearings, abbreviated names or full names of Vietnamese State bodies, political organizations, socio-political organizations, socio-politico-professional organizations, social organizations or socio-professional organizations or with international organizations, unless permitted by such bodies or organizations.
3. Signs identical with or confusingly similar to real names, aliases, pseudonyms or images of leaders, national heroes or famous personalities of Vietnam or foreign countries.
4. Signs identical with or confusingly similar to certification seals, check seals or warranty seals of international organizations which require that their signs must not be used, unless such seals are registered as certification marks by such organizations.
5. Signs which cause misunderstanding or confusion or which deceive consumers as to the origin, properties, use, quality, value or other characteristics of goods or services.



How is a trademark considered to be distinctive?

A mark shall be deemed to be distinctive if it consists of one or more easily noticeable and memorable elements, or of many elements forming an easily noticeable and memorable combination, and does not fall into the cases stipulated in clause 2 of Article 74 Law on Intellectual Property.



How many types of trademark?

In accordance with the Law on Intellectual Property, trademarks are classified into four groups:

Collective trademark means a mark used to distinguish goods or services of members from those of non-members of an organization which is the owner of such mark.

Certification trademark means a mark which is authorized by its owner to be used by another organization or individual on the latter's goods or services, for the purpose of certifying the origin, raw materials, materials, mode of manufacture of goods or manner of provision of services, quality, accuracy, safety or other characteristics of goods or services bearing the mark.

Integrated mark means identical or similar marks registered by the same entity and intended for use on products or services which are of the same type or similar types or interrelated.

Well-known mark means a mark widely known by consumers throughout the Vietnamese territory.

How long for the process of mark registration in Vietnam?

The processing of mark registration in Vietnam shall be conducted within the time mentioned below:

- Formal examination: An application for registration of industrial property shall have its form examined within one (01) month from the filing date. The purpose of this stage is to examine compliance with regulations related to the form of the registration application then evaluate whether this application is valid or not.
- Publication of application: An application for the mark registration shall be published within two (02) months as from the date such application is accepted as being valid. Subsequently, these applications shall be published in the Official Gazette of Industrial Property.
- Substantive examination: nine (09) months from the date of publication of the application with the purpose of evaluating of the eligibility for grant of protection titles for subject matter stated in such applications under protection conditions and for determination of the respective scope of protection.



How long is the trademark protection period in Vietnam?

A certificate of registered mark shall be valid from the grant date until the end of ten (10) years after the filing date and may be renewed for many consecutive terms, each of ten (10) years.



What are the rights of trademark owner?

In accordance with Clause 1 Article 123 Law on Intellectual Property, rights of owners of marks includes:

- To use or authorize others to use industrial property objects according to the provisions of Law on Intellectual Property.

Use of a mark means the performance of the following acts:

- (a) Affixing the protected mark on goods, goods packages, business facilities, means of service provision or transaction documents in business activities;
 - (b) Circulating, offering, advertising for sale or stocking for sale goods bearing the protected mark;
 - (c) Importing goods or services bearing the protected mark.
- To prevent others from using industrial property objects according to the provisions of Article 125 of this Law;
 - To dispose of industrial property objects according to the provisions of Chapter X of this Law.



What is considered a infringement of the trademark rights of the other?

The following acts, if performed without the permission of mark owners, shall be deemed to be infringements of the right to a mark:

- a. Using signs identical with protected marks for goods or services identical with goods or services on the list registered together with such mark;
- b. Using signs identical with protected marks for goods or services similar or related to those goods or services on the list registered together with such mark, if such use is likely to cause confusion as to the origin of the goods or services;
- c. Using signs similar to protected marks for goods or services identical with, similar to or related to goods or services on the list registered together with such mark, if such use is likely to cause confusion as to the origin of the goods or services;
- d. Using signs identical with, or similar to, well known marks, or signs in the form of translations or transcriptions of well-known marks for any goods or services, including those not identical with, dissimilar or unrelated to goods or services on the lists of those bearing well known marks, if such use is likely to cause confusion as to the origin of the goods or services or misleading impressions as to the relationship between users of such signs and well known mark owner.

What can a trademark owner do if his or her trademark has been infringed?

An intellectual property right holder shall have the right to apply the following measures to protect the intellectual property rights of such holder:

- (a) To apply technological measures to prevent acts of infringement of its intellectual property rights;
- (b) To request any organization or individual who commits an act of infringement of the intellectual property rights of the holder to terminate such act, make a public apology or rectification, and pay damages;
- (c) To request the competent State body to deal with acts of infringement of its intellectual property rights in accordance with the provisions of this Law and other relevant laws;
- (d) To initiate a lawsuit at a court or a claim at an arbitration centre to protect the legitimate rights and interests of the holder.

Can the trademark be terminated or cancelled after registration?

The validity of a protection title shall be terminated in the following cases:

- The owner fails to pay the stipulated validity maintenance or extension fee;
- The owner declares relinquishment of the industrial property rights;
- The owner no longer exists, or the owner of a certificate of registered mark is no longer engaged in business activities and does not have a lawful heir;
- The mark has not been used by its owner or the licensee of the owner without justifiable reason for five (5) consecutive years prior to a request for termination of validity, except where use is commenced or resumed at least three (3) months before the request for termination;
- The owner of a certificate of registered collective mark fails to supervise or ineffectively supervises the implementation of the regulations on use of the collective mark;
- The owner of a certificate of registered certification mark violates the regulations on use of the certification mark or fails to supervise or ineffectively supervises the implementation of such regulations;

A protection title shall be entirely invalidated in the following cases:

- (a) The applicant for registration has neither had nor been assigned the right to register the invention, industrial design, layout design or mark;
- (b) The industrial property object failed to satisfy the protection conditions at the time the protection title was granted.

A protection title shall be partly invalidated as to the part which failed to satisfy the protection conditions.

What is the “First to file principle” ?

“**First to file principle**” is applied to cope with cases in which there are more than one protection registration application for the same or similar subject matter of industrial property rights. This principle is prescribed particularly at Article 90 of Law on Intellectual Property to protect the rights and interests of the earlier applicant with the same subject matter of industrial property rights. To be more detailed:

1. In case many applications are filed for registration of the same patents or similar patents, or for registration of industrial designs identical with or insignificantly different from another, the protection title may only be granted to the valid application with the earliest priority or filing date among applications satisfying all the conditions for the grant of protection title.
2. In case there are many applications filed by different persons for registration of identical or confusingly similar marks for identical or similar products or services, or in case there are many applications filed by the same person for registration of identical marks for identical products or services, the protection title may only be granted for the mark in the valid application with the earliest priority or filing date among applications satisfying all the conditions for the grant of a protection title.
3. In case there are many registration applications specified in Clauses 1 and 2 of this Article and satisfying all the conditions for the grant of a protection title and having the same earliest priority or filing date, the protection title may only be granted for the object of a single application out of these applications under an agreement of all applicants. Without such agreement, all relevant objects of these applications will be refused for the grant of a protection title.

Who has a right to registering trademark?

In accordance with Law on Intellectual Property, the entities having the right to register marks include:

- Organizations and individuals shall have the right to register marks to be used for goods such organizations or individuals produce or for services such organizations or individuals provide.
- Any organizations or individuals lawfully engaged in commercial activities shall have the right to register a mark for a product which the latter puts onto the market but which was manufactured by others, provided that the manufacturer does not use such mark for a product and does not object to such registration.
- Lawfully established collective organizations shall have the right to register collective marks to be used by the members of the collective organization pursuant to the regulations of the collective organization on use of collective marks. For signs indicating geographical origins of goods or services, an organization with the right to register means a local collective organization of [other] organizations or individuals engaged in production or trading in the relevant locality.
- Organizations with the function of controlling and certifying quality, properties, origin or other relevant criteria of goods or services shall have the right to register certification marks, provided that such organizations are not engaged in production or trading of such goods or services.
- Two or more organizations or individuals shall have the right to jointly register a mark in order to become its co-owners on the following conditions:
 - (a) Such mark is used in the names of all co-owners or used for goods or services which are produced or traded with the participation of all co-owners;
 - (b) The use of such mark does not cause confusion to consumers as to the origin of goods or services.



APOLAT LEGAL LAW FIRM

99-101 Nguyen Dinh Chieu St., Ward 6, District 3, HCMC
info@apolatlegal.com
(+84) 911 357 447