

REGISTRATION AND ENFORCEMENT OF TRADEMARK RIGHTS IN VIETNAM

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INTRODUCTION

- Overview of Intellectual Property Law of Vietnam;
- Vietnam is a member of Interational Treaties;
- Legal documents on Registration and Enforcement of Trademark Rights in Vietnam

I. Registration of Trademark

1. Introduction

a. Definition of Trademark:

- Any sign used to distinguish goods or services of different organizations and individual.
- It could be a visible sign in the form of letters, words, pictures, figures, including three-dimensional figures or a combination thereof, represented in one or more colors;

b. What are not registered as Trademarks:

- Signs identical with or confusingly similar to the national flags, national emblems, names of political organizations, socio-political organizations...;
- Signs identical with or confusingly similar to real names, alias, pen names or images of leaders, national heroes of Vietnam or foreign countries;
- Signs identical with or confusingly similar to certification seals, control seals, warranty seals of international organizations;
- Signs liable to mislead, confuse or deceive consumers as to the origin, quality, value or other characteristics of the goods or services.

I. Registration of Trademark

1. Introduction (continued)

c. Who are entitled to register Trademarks:

- Organizations or individuals have the right to registration of a Trademark to be used for goods or services he or she produced or supplied.
- Organizations or individuals legally engaged in the trade in a product produced by a third party have the right to registration of a Trademark to be used for the product, provided that the producer neither uses such a Trademark for the product nor objects to such registration.

I. Registration of Trademark

2. Procedures for Trademark Registration

a. Filing Application for Registration:

- First-to-file rule is applied;
- Claiming priority is possible;
- Foreigners without Representative Offices/Branches in Vietnam must use local Industrial Property Agents (Patent/Trademark Attorneys) for the services.

b. Examination of Application:

- Examination as to form;
- Examination as to substance

I. Registration of Trademark

2. Procedures for Trademark Registration (continued)

c. Refusal/Acceptance of Registration

- If the Trademark does not meet protection criteria, it will be refused;
- If protection criteria is met, it will be registered.

d. Granting Certificate of Registration

- The Applicant must pay the prescribed fees for granting of Certificate of Trademark Registration;
- The Trademark shall then be recorded on the National Register;
- The Trademark Rights shall begin from the Registration Date and shall expire at the end of 10th year counted from the filing date. It is possible to be renewed.

I. Registration of Trademark

3. What should Trademark Owner do after Registration

a. Requirement on Use of Trademark:

- The owner of a Trademark shall be obliged to use it continuously. The validity of ownership right of a Trademark shall be terminated if it has not been used for a continuous period of more than 5 years.

b. Renewal of Validity of Certificate of Trademark Registration:

- Within 6 months before the expiration date, the owner of Trademark may file a request for renewal of its trademark. Late renewal can be made provided that it is no later than 6 months after the expiration date.

I. Registration of Trademark

4. What are the Rights of Trademark Owners

- The Exclusive Right to Use the Trademark;
- The Right to Assign the Trademark;
- The Right to Grant License to Other Parties;
- The Right to Enforce the Trademark Rights

Applications for Trademark Registration filed in Vietnam

Years	Applications for Trademark Registration filed by		
	Vietnamese	Foreigner	Total
2001	3095	3250	6345
2002	6560	2258	8818
2003	8599	3536	12135
2004	10641	4275	14916
2005	12884	5314	18018

II. Enforcement of Trademark Right

1. Introduction

- The owner of a registered trademark has the exclusive rights to manufacture, use, import, sell, advertise, store or offer for sale the products bearing the trademark. Any use by a third party of a registered trademark, without authorization from the owner and for the commercial purposes, is regarded as an act of infringement.
- The following measures are available for trademark owners to enforce its rights: the Civil Procedure, Criminal Procedure, Administrative Procedure, Provisional Measures and Border Measures

II. Enforcement of Trademark Right

2. What are acts of trademark infringement

- Using signs identical with a registered trademark for identical goods or services;
- Using signs identical with a registered trademark for similar or related goods or services;
- Using signs similar to a registered trademark for identical or similar goods or services;
- Using signs identical with or similar to a well-known trademark for any goods or services.

II. Enforcement of Trademark Right

3. Civil Procedures

a. Introduction

- There is no special court for dealing with Trademark Infringement in Vietnam;
- Provincial People's court shall handle Trademark Infringement cases;
- If one party is foreigner, the competent courts is either People's Court in Hanoi or Ho Chi Minh City.

II. Enforcement of Trademark Right

3. Civil Procedures (continued)

b. Civil Remedies

The court shall take the following civil remedies to handle acts of infringement of Trademark rights:

- Compelling termination of the infringement of Trademark rights;
- Compelling public rectification and apology;
- Compelling the performance of civil obligations;
- Compelling compensation for damages;
- Compelling destruction, distribution or use for non-commercial purpose in respect of infringing goods, provided that such distribution and use does not affect the exploitation of rights by the Trademark owner.

II. Enforcement of Trademark Right

4. Administrative Procedures

a. The following acts of Trademark infringements shall be subject to the administrative remedies:

- Committing an act of infringement of Trademark Rights, which causes loss to consumers or the society;
- Not terminating an act of infringement of Trademark Rights, even if a warning letter has been sent by the Trademark owner;
- Producing, importing, transporting, and trading in counterfeit goods;
- Producing, importing and trading in articles bearing a trademark that is identical with or confusingly similar to a registered trademark

II. Enforcement of Trademark Right

4. Administrative Procedures (continued)

b. Administrative penalties and remedies

- Main remedies:

- + Warning;

- + Monetary fine.

- Complementary remedies:

- + Confiscation of counterfeit goods, materials, raw materials...;

- + Suspension of relevant business activities for a definite term.

- + Compelling destruction, distribution or use of the counterfeit goods for non-commercial purposes;

- + Compelling re-export of the counterfeit goods after removing infringing elements.

II. Enforcement of Trademark Right

4. Criminal Procedures

Individuals who have committed acts of infringement of Trademark Rights having factors that constitute a crime shall be liable to the criminal liabilities.

- Manufacturing and/or trading in fake goods equivalent to the quantity of genuine goods valued more than thirty million VND or under thirty million VND but causing serious consequences;
- Manufacturing and/or trading in fake goods being food, foodstuffs, curative medicines, preventive medicines
- Manufacturing and/or trading in fake goods being animal feeds, fertilizers, veterinary drugs, plant protection drugs, plant varieties, animal breeds
- Infringing upon Trademark Rights causing serious consequences.

II. Enforcement of Trademark Right

5. Criminal Procedures (continued)

- Punishment includes:
 - Imprisonment: At least 6 months. In some cases, up to 15 years, life or death penalty;
 - Monetary fines: between VND 20 and 200 million (equal to USD 1,300 and 13,000);
 - Trademark owner may require compensation for damages.

II. Enforcement of Trademark Right

6. Provisional Measures

- Upon or after initiation of a lawsuit, a Trademark Owner has the right to request the court to apply provisional measures.
- The following provisional measures are applicable to goods suspected of infringing of Trademark Rights:
 - Seizure;
 - Attachment;
 - Sealing, prohibition of changing status or displacing;
 - Prohibition of transferring ownership;

II. Enforcement of Trademark Right

7. Border Control Measures

a. Introduction

- Vietnam has a long borders with China, Laos & Cambodia;
- Trademark Infringement happens to almost every kind of goods from daily consumption goods to luxury goods, from simple goods to medicines, foods...;
- Trademark Infringement does not only happen at the borders but also inside the country;

b. Relevant State Authorities & Border Control Measures

- Customs Offices at all levels;
- Suspension of Customs procedures;
- Supervision to detect goods

II. Enforcement of Trademark Right

c. Remedies

- To temporarily postpone customs procedures;
- To eliminate the illegal factor/elements;
- To re-export goods;
- To confiscate goods;
- To distribute confiscated goods to entities for use for non-business purposes;
- To destroy confiscated goods.

II. Enforcement of Trademark Right

8. Current situation on Enforcement of Trademark Rights in Vietnam

Although the enforcement of Trademark Rights in particular has been paid a special attention, unfortunately the actual enforcement is not as good as expected.

- The reasons of the ineffective enforcement of Trademark Rights in Vietnam could be understood as below:
 - + The limited awareness of the enforcement forces on Trademark Rights, including the judges, economic polices, customs officers;
 - + The cooperation among enforcement forces is not good; the cooperation of the Trademark Owners with the enforcement forces is included;
 - + The punishment imposed is not strong enough to prevent the infringement;
 - + The lack of special forces, such as special court for dealing with Intellectual Property cases.

Conclusion

- Intellectual Property / Trademark is still a new field in Vietnam;
- The government is trying to improve the legislation system and acquire experience from developed countries with a view to building a better Intellectual Property system;
- Vietnamese people are more and more aware of the benefits of Trademark Registration;
- Enforcement of Trademark Rights is facing many difficulties due to the lack of legal grounds;