



How to protect your marks in Vietnam?

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Vietnam, Intellectual Property

LL.M, Melbourne University Law School

IP Diploma, Federal Institute of IP, Moscow

Vietnam-qualified lawyer and licensed IP Agent

25-years experience in IP

Leading lawyer in IP in Vietnam by Asia Pacific, Asia IP, Asialaw & Practice, PLC Which Lawyer?, Legal 500 Asia Pacific, Managing Intellectual Property, World Trademark Review, World Intellectual Property Review.

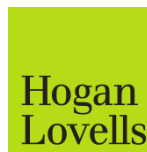


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Practice areas

Management and enforcement of intellectual property rights
Intellectual property and competition law interface
Strategic counselling and portfolio development
Technology transfer and licensing
Product registration, packaging and labelling

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Content

1. Legislation

2. Practice overview

3. Tips

International treaties and conventions

- Paris Convention for the Protection of Industrial Property
- Madrid Agreement Concerning the International Registration of Marks
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol)
- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).

Domestic legislation

- Civil Code
- Criminal Code
- Law on Intellectual Property
- Law on Competition
- Law on Handling of Administrative Violations
- Law on Customs
- Sub-laws: Decrees, Circulars, Inter-Ministerial Circulars, Directives, etc.

Practice overview: Current status

- IP legislation is fairly comprehensive:
 - Covering all major aspects of IP protection
 - Meets the international standards
- Many efforts made in raising the public awareness and improving IPR protection
- Enforcement remains a big concern

Practice overview: Current issues

- Awareness
- Transparency
- Online infringement
- Trademark and domain name conflicts
- Trademark and trade name conflicts
- Unfair competition
- Enforcement and IP Court

Tips

- ☞ Choosing a name
- ☞ Registering the name
- ☞ Commercializing the name
- ☞ Protecting the name

Choosing a name

✓ DO:

- Must be a visual sign (word, device or word & device combination)
- Must be distinctive of designated goods/services

✗ DO NOT:

- Against social orders
- Generic names
- Descriptive
- Identical/confusingly similar (to emblems, flags, famous persons, etc.)
- Make consumers confused (about origin/quality/value/etc.)
- Simple geometric figure
- Etc.

Registering the name

- First to file.
- Non-traditional marks are not protectable
- Prior use without registration does not secure a right (unless well-known mark)
- Priority claims
- No requirement of use when filing
- Incontestable after 5 years in registration
- Non-use cancellation: after 5 years from registration date

Registering the name (Cont.)

Prosecution of application

- File application (as soon as possible)
- Formality examination (1 month)
- Publication of application (2 months)
- Substantive examination (9-12 months)
- Granting (1-3 months)
- Post granting: renewal (maintenance)
- Recordal of name/address change
- Registration of assignment: Compulsory
- Registration of licensing: Optional

Commercializing the name

- Assignment: Registration is compulsory. Effective from the date of registration of the assignment by the IP Office
- Licence: Registration not compulsory, but strongly advisable.
- Franchising

Protecting the name

- Maintenance (renewal of registration)
- Non-use cancellation risk (by competitors, third parties, authorities, ...)
- Use as a trademark, not as a generic name

Protecting the name (Cont.)

- Watching for conflicting names:
 - Conflicting trademark applications: Opposition
 - Conflicting trademark registrations: Cancellation
 - Conflicting trade names.
 - Conflicting domain names.
- Monitoring the market:
 - Trademark infringement actions
 - Unfair competition actions

Enforcement

- Warning letter, Cease and desist letter, Cautionary notice
- Administrative action: recommended
- Civil action: No IP court, need more experienced judges, award of damages including legal fees.
- Criminal action:
 - Trademark & GI counterfeit goods
 - Both individuals and legal persons may be criminally liable to infringement of intellectual property rights.

Determining clear objective(s)

- Immediate stop the infringement?
- Deterrence effect?
- Damages?
- Criminal charges?
- Licensing of your IPR?



Administrative action v. Civil litigation

Civil actions	Administrative actions
<ul style="list-style-type: none"> - Damages available 	<ul style="list-style-type: none"> - Damages not available
<ul style="list-style-type: none"> - No immediate stop of infringement - Costly - Time-consuming - Procedure: troublesome - Decision: difficult to enforce - Collecting evidence: difficult (preliminary injunctions: difficult to obtain) 	<ul style="list-style-type: none"> - Immediate stop of infringement - Less costly - Less time-consuming - Procedure: less troublesome - Decision: enforceable - Useful for collecting evidence for court action
<p>---> <i>To be encouraged</i></p>	<p>---> <i>Now: More popular in Vietnam</i></p>

Criminal prosecution

- **What?** Copyright, trademark & GI (counterfeiting only).
- **Who?** Physical and legal persons.
- **Individual infringers:** Up to 3 years imprisonment, 5 year practising ban, VND 1 billion monetary fine (appr. US \$50,000).
- **Legal person infringers:** Up to VND 5 billion monetary fine (appr. US \$250,000), 3 year ban from doing business.
- **Civil claims:** Compensation for damages.

Border control measures

- Custom recodal: effective.
- Detention:
 - **Imports and exports;**
 - **Request by trademark holder is mandatory.**
 - **Security deposit required.**
- Customs authorities can impose administrative sanctions or arrange for criminal prosecution.

New regime for settlement of IPR & domain name disputes

Authorities can:

- 1) Compel change of infringing content on the corresponding website.***
- 2) Compel transfer of the infringing domain name.***
- 3) Revoke the infringing domain name if the user of the infringing domain name fails to comply with (1) or (2).***

New regime for settlement of IPR & domain name disputes

Read more at:

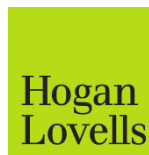
<http://www.limegreenipnews.com/2017/04/vietnam-new-rules-for-resolving-vn-disputes/>

<http://ehoganlovells.com/rv/ff0033e2200fed8ac574833805438f903515f6c5/p=6737489>

Raid action



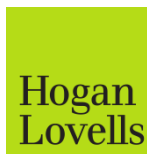
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Raid action



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Counterfeit goods



Removal of counterfeit marks



Removal of counterfeit marks



Re-exporting of goods after removal of counterfeit marks



Re-exporting of goods after removal of counterfeit marks



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