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# **Protecting Well-Known Trademarks and Measures to Prevent Bad Faith Registrations in Vietnam**

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- 1. Vietnam protection of well-known TM**
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# I. Vietnam protection of well-known TM:

- Vietnam became the party to the Paris Convention on Protection of Industrial Property (the Paris Convention) since 1949.
- The first Ordinance on protection of trademarks in 1982.
- The Law-decree on protection of industrial property in 1989.
- The Civil Code in 1995 and the Civil Code in 2005 (revised).

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# I. Vietnam protection of well-known TM:

- The Civil Code 1995 and the Civil Code 2005 do not specify the protection of well-known trademarks.
- Prevailing effect of the Paris Convention as for the well-known trademark protection.
- Decree No.06 required well-known trademarks be registered in Vietnam.
- The new Law on Intellectual Property in 2005 replaces the old regulations.

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# I. Vietnam protection of well-known TM:

- Vietnamese jurisdiction does not require a well-known trademark to be registered under regular trademark registration procedure.
- The right over a well-known trademark in Vietnam automatically established through the use thereof in commerce without any registration (Article 6 IP Law 2005).

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# I. Vietnam protection of well-known TM:

- A well-known TM in Vietnam is defined as a mark widely known by consumers throughout the Vietnamese territory (Article 4 IP Law 2005).
- A mark, from a third party, shall be refused for protection if it is identical with or confusingly similar to another person's mark recognized as a well-known mark for goods or services which are identical with or similar to those bearing such well-know mark.

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# I. Vietnam protection of well-known TM

- Article 129 of the IP Law 2005: acts regarded infringing the rights to well-known trademarks
  - ✓ any sign identical with or similar
  - ✓ any translation or transliteration
  - ✓ for any goods and services, including those dissimilar or unrelated
  - ✓ likely to cause confusion as to the origin
  - ✓ wrong impression as to the relationship

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# I. Vietnam protection of well-known TM:

- Under other circumstances, a mark also may be refused if the use of such mark may affect the distinctiveness of the well-known trademark in Vietnam or aimed at taking advantage of the reputation of the well-known mark.

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## II. Criteria for recognition of well-known trademark in Vietnam

- 8 criteria for the assessment of a trademark to be regarded well-known (Article 75 of the IP Law):
  - ✓ Consumers aware of the trademark
  - ✓ Territorial scope of circulation of goods
  - ✓ Turn-over of the sale of goods
  - ✓ The period of continuous use of the trademark
  - ✓ Widespread goodwill of the goods
  - ✓ Countries granting protection to the trademark
  - ✓ Countries recognizing the mark as well known
  - ✓ Value of assignment, licensing, investment

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## II. Criteria for recognition of well-known trademark in Vietnam

- However, it is reported that very few well-known trademarks in Vietnam has been recognized.
- Trademark owners, especially foreigners, face difficulties to prove that their trademark is well-known in order to obtain benefits from wider protection.

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## III. Procedures for recognition of well-known marks in Vietnam

- If a well-known mark is recognized according to civil procedures or under a recognition decision of the IPVN, that well-known mark shall be recorded in the list of well-known marks kept at the IPVN.
- However, currently there is still no official list for well-known trademarks in Vietnam.

In practice, it has been considered case by case, such as by a decision/notification of the IPVN under cases of cancellation/opposition procedure.

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### III. Procedures for recognition of well-known marks in Vietnam

- New regulations set out in the Decree, but have no Circular guiding, so the IPVN has not implemented.
- The IPVN will develop a process to register a trademark into the Well-known Trademark List in the future.

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## IV. Bad Faith Registrations

Typical examples of bad faith trade mark filings in Vietnam include:

- i) A trade mark that is identical or confusingly similar to a well-known trademark with the intention of preventing the owner of such well-known trademark from entering the Vietnam market.
- ii) A well-known trademark with no intention of using it, but for the sole purpose of benefiting from the sale, licensing or transfer of the registration to the rightful owner of the wellknown trademark.
- iii) An applicant simply wishes to profit from the reputation of a well-known trademark.

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## IV. Bad Faith Registrations

- Article 198 of the IP Law 2005 allows the trademark owners to apply different measures to enforce their rights
- ✓ Request of organizations, individuals committing the acts of infringement to terminate their infringing acts
- ✓ Request of the competent state agencies to handle the acts of infringement
- ✓ Taking a lawsuit before a competent court or an arbitrator

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## IV. Bad Faith Registrations

- The IP Law 2005 does not mention the burden of proof as to a well-known trademark.
- Governmental regulations (Decree 105) oblige the well-known trademark owner to submit the proof of his well-known trademarks.
- Ministerial instructions (Circular) set out the particular materials to be regarded the relevant evidence of a well-known trademark.

# Thank you!

