

DESK FOR THE PROTECTION OF THE INTELLECTUAL PROPERTY AND OBSTACLES TO TRADE

Desk Ho Chi Minh City

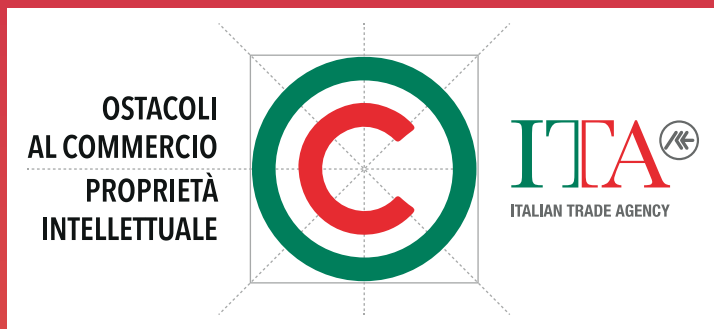


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Ministero degli Affari Esteri
e della Cooperazione Internazionale





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INTRODUCTION

In April 2022, with the support of ICE Agency in Ho Chi Minh City, the Desk for Assistance and Protection of Intellectual Property and Trade Obstacles (IPR Desk) was established to provide increasingly integrated and comprehensive assistance for supporting and guiding Italian companies doing business in Vietnam.

More generally, the wider IPR Desk project aims to assist Italian companies engaged abroad in some strategic markets, such as Argentina, Brazil, China, India, Mexico, Russia, Thailand, United States, Turkey, Ukraine, Vietnam.

Therefore, the IPR Desk within the ICE Agency of Ho Chi Minh City is established with the purpose of being a focus point for Italian companies interested in conducting economic-commercial activities in Vietnam, specifically regarding the protection of intellectual property according to local and international legislation and trade matters.

To this end, the IPR Desk in Ho Chi Minh City has developed a “Practical Guide on Intellectual Property in Vietnam” to equip Italian entrepreneurs with an agile tool, simple and fast, easy to consult and hopefully comprehensive on timing, procedures and costs required to protect intellectual property rights in Vietnam.

Intellectual Property is the right over an intangible asset, i.e., the exclusive right of economic exploitation of an invention. In other words, the right of authorship of an idea, invention, as well as an innovative and original production process and, connected, the right to be protected and guarded from any imitation. A protection that becomes even more important whenever one’s name, image, creative idea might be exploited by third parties.

In Vietnam, the legislation on the protection of intellectual property has significantly evolved in the last twenty years, especially following the country advent into the international economic and commercial chessboard and the membership of numerous free trade agreements, which have consequently determined the commitment, provided by the main international treaties, of upholding the protection of intellectual property.

Below is a summary of the relevant local and international regulatory framework related to the protection of patents, trademarks, copyrights, and geographical indications, with the contact details of the competent authorities, and a focus on the procedural, administrative, civil and criminal regulations, which provide the registration and protection phases of intellectual property rights in Vietnam.

The content of this Guide is not intended to constitute legal advice.

Object of protection	Reference legislation	Copyright Office (Hanoi)
Inventions, utility models, industrial designs, industrial layout	Intellectual Property Law 2005, amended and supplemented in 2009, 2019 (Section 1, Chapter VII, VIII, IX, X)	National Intellectual Property Office (“NOIP”) Phone: +84 24 3858 3069 Website: http://ipvietnam.gov.vn/ Email: vietnamipo@ipvietnam.gov.vn
Trademarks	Intellectual Property Law 2005, amended and supplemented in 2009, 2019: (Section 4, Chapter VII, VIII, IX, X)	National Intellectual Property Office (“NOIP”) Phone: +84 24 3858 3069 Website: http://ipvietnam.gov.vn/ Email: vietnamipo@ipvietnam.gov.vn
Copyright and related rights	Intellectual Property Law 2005, amended and supplemented in 2009, 2019 (Chapter VII, VIII, IX)	Office of the Copyright in Vietnam (VOC) Phone: 043 823 6908 Website: http://www.cov.gov.vn/ Email: cbqtg@bvhttdl.gov.vn
Geographical indications	Intellectual Property Law 2005, amended and supplemented in 2009, 2019 (Section 6, Chapter VII, VIII, IX)	Centre for the Examination of Geographical Indications and International Trademarks. Phone: +84 24 39 933 383 (in case the application for registration of the geographical indication has not been submitted) +84 24 38 583 069 – est 4402 or 4413 (if the application for registration of the geographical indication has been submitted and requires the advice of an expert) Website: https://ipvietnam.gov.vn/ Email: vietnamipo@ipvietnam.gov.vn

Relevant legislation

Relevant international legislation

- EU-Vietnam Free Trade Agreement (EVFTA),
- EU-Vietnam Agreement on Investment Protection (EVIPA)
- Paris Convention for the Protection of Industrial Property
- Patent Cooperation Treaty
- Madrid Agreement for the international registration of trademarks
- WIPO Copyright Treaty (WCT)
- WIPO Performance and Phonograms Treaty (WPPT),
- Rome International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention on Related Rights)
- Berne Convention for the Protection of Literary and Artistic Works (Universal Copyright Convention)
- Geneva Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms (Geneva Phonograms Convention)
- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)
- Vienna Agreement establishing an international classification of figurative elements of trademarks
- Nice Agreement on the international classification of goods and services for trademarks

National legislation

- **Intellectual Property Law** No. 50/2005/QH11
- Law amending and supplementing a series of Articles of the IP Law No. 36/2009/QH12
- Law amending and supplementing a series of Articles of the Law on Insurance Activity and the IP Law No. 42/2019/QH14
- **Law on Technology Transfer** No. 07/2017/QH14

- **Decree No. 103/2006/NĐ-CP** on Details and Guide to the Implementation of a Series of Articles of the IP Law on the Protection of IPR,
- **Decree No. 105/2006/NĐ-CP** on Details and Guide to the Implementation of a Series of Articles of the IP Law on the Protection of IPR and State IP Management
- **Decree No. 71/2014/ NĐ-CP** on the Rules of the Competition Law for the imposition of sanctions for violations of the Competition Law
- **Circular No. 01/2007/TT-BKHCH** on Details and Guide to the Implementation of a Series of Articles of Decree No. 103/2006/NĐ-CP
- **Circular No. 263/2016/TT-BTC** on Taxes and Charges for Intellectual Property, Collection, Transfer, Management and Use of the same

THE PATENT IN VIETNAM

The Patent

THE PATENT IN VIETNAM

THE PATENT

The patent is a certificate issued by a competent body based on an application for registration / protection. Various industrial property rights are patentable in Vietnam, such as:

- **Innovation**, defined as a technical solution in the form of a product or process that aims to solve a problem through the application of technology and natural laws.
- **Industrial designs**, the external appearance of a product embodied in a three-dimensional configuration, lines, colors, or a combination of such elements
- **Industrial layouts**, products in intermediate or final form in which the elements – at least one of which is an active one, and some or all interconnections – are formed entirely in or on a piece of semiconductor material and which is intended to perform an electronic function, i.e., integrated circuits

First-to-file principle

Vietnam adopts the so-called *first-to-file principle*, which means that if two or more applications for registration are filed by different parties for the same invention, or for identical or similar utility models, the patent can only be granted to the valid application with the prior filing date.

Right of pre-use

If an individual has used or has created the necessary conditions for use before the filing date or priority date (if any) of an invention or utility model – (hereinafter referred to as *the holder of the pre-use right*) and in the meantime a patent has been granted to a third party, the holder of the pre-use right may continue to use that invention or utility model within the scope and volume previously adopted without the need to compensate the owner of the patent. The claim of the pre-use right by the owner is therefore not considered as patent infringement.

However, the holder may not assign its pre-use right to third parties, neither expand the scope and volume of use without consent of the patent owner.

Principle of priority

Patent applications filed after the first one may claim priority resulting from a prior application filed in Vietnam or in another Country member of an international treaty – to which Vietnam is a party – having provisions on priority rights, or in a Country which has entered an agreement with Vietnam enforcing these provisions if the applicant is a Vietnam or that country citizen.

Alternatively, the applicant may file a patent application for industrial property in any of the member Countries of the Paris Convention, within 12 months.

In addition, if an applicant already holds a patent issued by a PCT member country, it will face faster and lighter application procedure when applying in Vietnam, within 31 months, from the date of priority.

At last, under the EVFTA, the parties will implement patent registration procedures based on the PLT. In addition, the parties have committed to compensate patent holders for any delay.

Types of Patents

Under the definition of invention – a technical solution in the form of a product or process that aims to solve a problem through the application of technology and natural laws – inventions are protected in the form of so-called *invention patents* and *patents for utility models*.

The following table summarizes the main characteristics and differences between patent for invention and patent for utility model.

Type of patent	Protection	Innovative nature	Industrial application	Validity
Invention	Yes	Yes	Yes	20 years
Utility model	Yes	No	Yes	10 years
Industrial Design	Yes	Yes	Yes	5 years*
Industrial Layout	Yes	Yes	Yes	10 years**

*: a patent for industrial design is renewable for two consecutive terms, each of five (5) years

** : an industrial layout certificate is valid from the date of granting until the first of the following:

- Ten (10) years after the filing date
- Ten (10) years after the date on which the industrial layout was first commercially exploited anywhere in the world by a person with the right to register or his licensee
- Fifteen (15) years from the date of creation of the industrial layout

The holder is required to pay a tax on annual basis to renew the validity of the patent in Vietnam

HOW TO OBTAIN PATENT PROTECTION IN VIETNAM

Inventions and utility models

The patent is eligible for registration / protection if it meets the following requirements:

- **Novelty:** the invention has not yet been publicly disclosed or it is known only to a small number of people, who are obliged to keep it secret
- **Innovative Nature:** the patent constitutes an inventive progress that cannot be easily created by a person with ordinary skill in the art
- **Susceptible of Industrial Application:** the invention has the potential for massive production or manufacture of products or repeated application of the process that is the subject matter of the invention and achieve stable results.

However, under Art. 59 of the IP Law, some objects such as scientific discoveries or theories, mathematical methods and others are not eligible for protection as inventions.

Industrial designs

The patent is eligible for registration / protection if it meets the following requirements:

- **Novelty:** if it differs significantly from other publicly disclosed industrial designs. Not if they differ only in aesthetic features that are not easily recognizable.
An industrial design still qualifies as *novelty* if the application is filed within six (6) months from the date of publication, even if it has been published under certain circumstances.
- **Innovative Nature:** based on industrial designs already publicly disclosed through use or written descriptions or

in any other form inside or outside Vietnam before the filing date of the industrial design application or the priority date, the industrial design cannot be easily achieved by a person with an average skill in the art.

- **Susceptible to Industrial Application:** if it can be used as a model for the mass-fabrication of products with the outward appearance that embodies such industrial design by industrial or artisanal methods

However, under Art. 64 of the IP Law, the following objects are not eligible for protection as industrial design:

- 1) External appearances of products due to the technical characteristics of the products
- 2) Exterior aspects of civil or industrial construction works
- 3) Forms of products invisible during the use of products

Layout Design

The patent is eligible for registration / protection if it meets the following conditions:

- **Originality:** the layout design is the result of creative work. A topography that is a combination of common elements and interconnections is considered original only if this combination, as a whole, derives from a non-widely known creative work
- **Commercial Novelty:** if it has not yet been commercially exploited anywhere in the world

An industrial design still qualifies as *novel* if the application is filed within two (2) years from the date on which it was first commercially exploited anywhere in the world:

However, under art.64 of the IP Law, the following objects **are not eligible for** protection as an **industrial layout**:

- 1) Principles, processes, systems and methods managed by semiconductor integrated circuits
- 2) Information or software contained in semiconductor integrated circuits

According to Art. 86 of the IP Law the right to register/protect inventions, industrial designs and layout designs belongs to the author or to the organizations or individuals who funded/employed the author.

Patentability requirements

The patent for inventions and industrial designs is eligible for registration/protection if it meets the requirement of (A) Novelty, (B) Inventive Nature and (C) is Susceptibility of Industrial Application, while the invention may be protected

by obtaining a *utility model patent* if it meets the requirements of points A and C and is not of common knowledge; the patent for industrial layouts must meet the requirement for (A) Originality and (B) Commercial Novelty.

Further and different documents should be attached depending on the kind of application, in general a thoroughly and clear description of all the technical elements, photos, drawings, explanation and scope of protection are needed.

Supporting documents for application

Pursuant to Clause 1, art.100 of the IP Law, the application should include:

- 1) Declaration for the registration of industrial property, pursuant to Model No. 01-SC referred to in Appendix A of Circular No. 01/2007/TT-BKHCHN
- 2) Description of industrial property, which includes (i) the description of industrial property and (ii) the scope of protection.
- 3) Extract of the invention or utility model (not applicable for industrial designs and industrial layouts): no more than 150 words, presented on a sheet of A4 paper. At the time of filing the application it is not required, but – if not attached – it must be added later
- 4) Receipt of payment of the tax for the filing of the application
- 5) Power of attorney (if the application is submitted by a representative)
- 6) Documents attesting to the right of registration of industrial property
- 7) Documents proving the right of priority (if this right is claimed)

Patent Application: Eligibility for Submission

The following organizations and individuals have the right to register industrial property (inventions, utility models, industrial designs, industrial layouts):

- 1) Author who created industrial property with their own work and at their own expense
- 2) Organizations or individuals who have funded or employed the author

Furthermore, if multiple organizations and/or individuals have created or jointly invested in the creation of industrial property, each one has the right to register/protect such industrial property, which can and must be exercised only

with common consent.

Finally, the organizations and/ or individuals entitled have the right to authorize another organization / individual to register on their behalf through a written authorization.

Patent Application: Temporary Application and Ordinary Application

Vietnamese Law and Regulation do not distinguish between different types of demand. The applicant must just meet the above-mentioned conditions and prepare the proper documents.

The international PCT procedure

If the applicant wishes to register his industrial property under the PCT, this patent application is called an international application. Such application may be submitted by at least one (1) individual who is a national of a PCT country or an organization with its registered office in a PCT member country. Consequently, the applicant should be able to prove its status.

Foreign applicants (who come from the contracting country) can also obtain the granting of protection in Vietnam by filing an international application and designating or selecting Vietnam through the PCT system. However, the applicant cannot apply directly, but must apply through a legal representative in Vietnam.

The application for registration in Vietnam under the PCT must be submitted to the NOIP within 31 months from the date of completion of the international application at WIPO or from the date of priority, if any.

If an international application to WIPO designates Vietnam among the countries to which protection extends, the NOIP is the competent authority for the so-called national registration phase, which gives effect to international protection. In this case, to enter the national stage in Vietnam, the applicant must submit to the NOIP – within 31 months from the priority date – the following:

- 1) Declaration of application for registration of industrial property
- 2) Copy of the international application (if the applicant requests entry into the domestic stage before the date of publication of the international application)
- 3) Vietnamese language translation of the international application: the description, consisting of a descriptive section, application for protection, annotations for drawings and extract (the published copy or the original application initially filed, if the application has not yet been published, and the modified copy and explanation of

the modified contents, if the international application has been modified in accordance with art.19 of the PCT)

4) Receipts for payment of taxes and charges in Vietnam

If an international application to WIPO, which elects Vietnam as one of the countries to which protection is applied, is subject to preliminary assessment, the NOIP is the competent authority at the national stage. In this case, to enter the national stage in Vietnam, the applicant must submit to the NOIP – within 31 months from the priority date – the following:

- 1) Declaration of application for registration of industrial property
- 2) Vietnamese translation of the international application
- 3) Vietnamese translation of the attached report of the preliminary assessment of the application
- 4) Receipts for payment of taxes and charges in Vietnam

Once the documents are ready, the procedure is divided into three steps:

- 1) Submission of the international application
- 2) Processing of the international application
- 3) Examination of the international application

Note: For the application examination process please see Appendix 1: Application examination process.

Duration of the Patent

According to Clause 2, art.93 of the IP Law:

- 20 years from the filing date of the patent for invention
- 10 years from the filing date of the patent utility model
- Up to 5 years from the issuance date of the patent for industrial design, renewable for a maximum of two (2) consecutive mandates of five (5) years each
- The industrial layout certificate shall be valid from the issuance date until either:
 - a) 10 years after the filing date

- b) 10 years after the date of commercial exploitation anywhere in the world
- c) 15 years from the date of creation of the industrial layout

According to Art. 94 of the IP Law, it is mandatory to pay the annual tax to renew the patent validity.

Patent protection is lost in the following cases:

- d) The owner of the patent does not pay the maintenance or extension tax
- e) The owner waives his or her IP rights
- f) The owner has ceased (no longer exists) or no longer carries on entrepreneurial activity, and does not have a legitimate heir

Registration fee

Circular No. 263/2016/TT-BTC on taxes and charges for Intellectual Property establishes and lists the administrative fees which are usually less than 1,000 USD for the whole procedure.

Types of violations

According to art.126 of the IP Law, the following acts are violations of the owner's right:

- 1) The use of protected industrial property within the term of validity of the patent/certificate, without the consent of the owner of the patent/certificate.
- 2) The use of protected industrial property without the payment of a fee established by art.131.

Furthermore, pursuant to art.8 of Decree No.105/2006/NĐ-CP, elements considered to be in violation of the owner's right may take one of the following forms:

- 1) A Product or part (Component) of a product that is identical or similar to a product or part (component) of a patent-protected product /invention;
- 2) A Process that is identical or similar to a patent-protected process;
- 3) A Product or a part (Component) of the product manufactured through a process that is identical or similar to a patent-protected process.

Art.9 establishes the elements considered in violation of protected industrial layouts:

- 1) Layout created by illegally copying a protected industrial layout
- 2) Illegally created integrated circuit according to a protected industrial layout
- 3) Product or part (component) of a product incorporating an integrated circuit created in accordance with a protected industrial layout.
- 4) Finally, art.10 defines the elements considered or in violation of protected industrial designs:
 - 1) The product, or part of it, even with an industrial design patent, contains a combination of design features that create an overall combination that is in substance a copy (with virtually indistinguishable difference) of a protected industrial design of another holder
 - 2) The product, or part of it, contains a combination of design features that create an overall combination which is in substance a copy of a protected industrial label, or at least a product within a set of products of another person.

Note: For the right to self-protection, civil and administrative remedies please see Appendix 2: Actions to protect violations.

Technology transfer

According to art.2 of the Technology Transfer Law, the case of technology transfer refers to the assignment or license to use a given technology by the person who has the right to transfer that technology to the transferee.

Art.23 of the Technology Transfer Law and articles 140 and 144 of the IP Law lists the mandatory content of a transfer contract, which must contain, among the usual clauses, (i) the description of the technology, the products derived from the application of the technology, and their quality standard; (ii) the circumstance of assignment of the patent or license of the right to use the patent (including scope of the license, limitations on the right of use and territorial limitations, and duration)

After entering a transfer contract, the parties will have to conduct two different transfer registration procedures, respectively at the Ministry of Science and Technology (MST) and the NOIP. Procedures may be carried out simultaneously or in any order.

Transfer registration procedure at the MST

1) Application for approval: the application dossier for approval shall include:

- a) Technology Transfer Approval Application Form
- b) Proof of the applicant's legal status
- c) Written explanation of the technology to be transferred
- d) Written explanation of the conditions for the application of the transferred technology
- e) Written explanation of the consistency of the transferred technology with the laws on technical standards and regulations

2. Decision on approval: within three (3) working days of receipt of the application, the MST shall examine and, where appropriate, request the integration of the application.

Within thirty (30) days of receipt of a sufficient application, the MST shall issue the result.

3. Application for authorization of the transfer: after approval, the parties can conclude a technology transfer contract. Within sixty (60) days from the conclusion, the party obliged to request the authorization applies for authorization of the transfer to the MST.

The application dossier for authorization shall include:

- a) The application form
- b) Proof of the legal status of the parties to the technology transfer contract
- c) The original or the certified copy of the technology transfer contract, in Vietnamese language.
- d) The certified copy of the patent
- e) Quality standards of products made by applying the transferred technology
- f) Explanation of the conditions for using the technology
- g) Written record of the evaluation of the transferred technology

4. Decision on the authorization of the transfer: within five (5) working days of receipt of the application, the MST shall examine and, where appropriate, request the integration of the application.

Within sixty (60) days of receiving the integration request, the applicant must comply or request an extension (max 60 days) of the deadline. If the applicant does not complete the application, the MST shall notify in writing the refusal.

Alternatively, within fifteen (15) working days of receipt of the sufficient application, the MST shall process the application and issue the result. The rejection shall be motivated.

Transfer registration procedure at the NOIP

1. Prepare a dossier which shall include the following documents:

- a) Written declaration for the registration of the contract for the assignment of the patent drawn up on a special model, not printed (2 copies)
- b) Certified copy of the License Agreement in both original and Vietnamese language (2 copies), each page must be signed by both parties and sealed every two adjacent pages.

Alternatively, when the license for use is granted, the dossier shall include:

- a) Written declaration for the registration of the contract for the license to use the patent drawn up on a special model, not printed (2 copies)
- b) Certified copy of the License Agreement in both original and Vietnamese language (2 copies), each page must be signed by both parties and sealed every two adjacent pages.
- c) The written consent of the co-holders, if any
- d) Written power of attorney, if the file is submitted through a representative
- e) Copies of receipts of taxes and charges paid

2. Submission of the dossier: if the dossier is not complete, the NOIP shall reject the application, indicating the errors in the file and requesting integration within one (1) month. If the applicant does not complete the application, the NOIP shall notify in writing the refusal.

The application is rejected if the License Agreement is missing any of the essential information or they are mistakenly represented or, among others:

- The term of protection of the patent has expired or is the subject of dispute
- There is a reason to believe that the License Agreement infringes the rights of third parties.

3. Decision on the application: if the dossier is complete or successfully integrated, the NOIP shall issue a certificate of registration of the License Agreement and include the transfer of industrial property rights in the National Register of Transfers of Industrial Rights

4. Publication of the transfer: the NOIP shall publish the decision to issue the registration certificate of the transfer contract in the Official Journal of Industrial Property within two (2) months.

TRADEMARKS IN VIETNAM

Trademarks

TRADEMARKS IN VIETNAM

TRADEMARKS

Art.4 of the IP Law defines a trademark as a sign used to distinguish goods or services of one manufacturer or service provider from those of another.

Vietnam applies a few international trademark treaties and complies with the classification provided by the Nice Agreement and the simplified registration procedures of the Singapore Treaty on Trademark Law. In particular, as party of both Madrid Agreement and the Protocol to the Madrid Agreement, in Vietnam it is possible to obtain an international registration that takes effect in each designated country.

First-to-file principle

Vietnam adopts the so-called principle, which means that if two or more applications for registration are filed by different parties for the same trademark, the certificate can only be granted to the valid application with the prior or filing date.

Principle of priority

Applications for registration of a trademark subsequently filed after the first one may claim priority resulting from a prior application filed in Vietnam or in another country member of an international treaty – to which Vietnam is a party – having provisions on priority rights, or in a Country which has entered an agreement with Vietnam enforcing these provisions, if the applicant is a Vietnam or that country citizen.

Since Vietnam has entered to the Paris Convention for the Protection of Industrial Property (“Paris Convention”), the applicant may file the application in any of the other contracting countries, within 6 months.

How to obtain protection of an Italian trademark in Vietnam

An Italian Trademark is eligible for registration / protection if it meets the following requirements:

- a) It is a visible sign in the form of letters, words, drawings or images, including holograms, or a combination thereof, represented in one or more colors.
- b) It can differentiate and distinguish the goods or services of the trademark holder from those of other subjects

However, art.73 of the IP Law provides a list of signs which are not eligible for protection, such as the ones identical or similar to national flags or emblems, Vietnamese state bodies and organizations, leaders, national heroes or famous people of Vietnam or foreign countries, marks of international organizations.

As a general rule, signs liable to mislead, confuse or deceive consumers as to the origin, functional parameters, intended purposes, quality, value or other characteristics of the goods or services should not be protected as trademarks. A sign shall be deemed to have caused confusion as to the origin of goods or services in the following cases:

- a) It is identical or similar to the name or emblem of a nation or territory (national flag, national emblem, name of the nation or locality) or in a confusing manner similar to the name or emblem of a nation or territory, causing an error that the goods or services bearing the mark come from that nation or territory
- b) It is identical or similar to a protected geographical indication, where its use is likely to mislead consumers as to the geographical origin of the goods; is identical to a geographical indication or contains a geographical indication or is translated or inscribed by a protected geographical indication for a wine or spirit, where the sign for which registration is sought as a trade mark for a wine or spirit does not originate in the geographical region subject to that geographical indication
- c) It is a word identical to or similar to the trade name of another person, which has been legitimately used for the same type of goods or services, and capable of making consumers believe that the goods or services bearing the word are manufactured or supplied by the person who filed the name ; is an image identical to or similar to the commercial logo of another person, which has been legitimately used for the same type of goods or services, and capable of making consumers believe that the goods or services that carry it are manufactured or provided by the subject holder of the commercial logo
- d) It is identical or similar to real names, aliases, pseudonyms or images of leaders, national heroes or personalities of Vietnam or foreign countries; it is identical or similar to names or images of typical human characters or figures in widely known works, in the event that its use may make consumers believe that the goods or services that carry it are manufactured or provided by the owners of such works

- e) It is identical or not substantially distinguishable from the industrial designs of other persons protected on the basis of applications for registration of industrial designs with filing dates or priority dates prior to the filing date or priority date of the trademark application

Furthermore, a sign is considered likely to create confusion or mislead as to the nature and value of goods and services in the following cases:

- a) The sign is a word, image, or symbol that gives a misleading impression of the properties or utilities of a good or service, that is, a sign identical with or similar to a trademark or other sign used so widely that it is considered to be associated with a function or utility of a certain type of product or service, and thus making consumers believe that the goods and services bearing the sign also have such a function or utility
- b) The sign is a word or image that gives a misleading impression of the composition or ingredients of a good or service, that is to say, a description of another product or service relevant to the product or service bearing the sign gives the misleading impression that the product or service bearing the sign is composed of or has the same nature as the described good or service

A trademark is distinctive if it consists of two or more easily recognizable and memorable elements, or of several elements forming an easily recognizable and memorable combination. Vietnamese regulation furtherly requires the trademark to be considered distinguishable. Therefore, by way of example, simple shapes, numbers, letters, translations, conventional or symbols and more in general signs that are identical or confusing with other existing trademarks are not eligible for registration and protection.

Types of Trademarks

Art.4 of the IP Law, recognizes five types of trademarks in Vietnam:

- 1) *Ordinary trademark*: sign used to distinguish goods or services
- 2) *Collective mark*: for goods or services of members of an organization
- 3) *Certification mark*: a mark licensed by its owner to other organizations or individuals to certify peculiar characteristics of the goods or services
- 4) *Associated marks*: registered by the same entity, identical and similar to each other
- 5) *Well-known mark*: a mark widely known throughout territory of Vietnam

Forms of trademark protection

Trademarks are protected in the form of a certificate of protection. Trademark rights are recognized by certificate or, for well-known marks, by a decision of the competent authority. Therefore, in cases where the recognition of a well-known trademark leads to a decision on actions against infringements, such trademark will be included in the list of well-known trademarks of the NOIP.

Registration fee

Circular No. 263/2016/TT-BTC on taxes and charges for Intellectual Property establishes and lists the administrative fees which are usually contained in less than VND 4 million for the whole procedure.

Supporting documents for application

According to art.105 of the IP Law, the application for registration of the trademark shall include:

- 1) Declaration for the registration of the trademark, pursuant to Model No. 04-HN referred to in Appendix A of Circular No. 16/2016/TT-BKHCHN
- 2) Documents, samples and information identifying the trademark:
 - a) Samples of the mark and a list of goods or services bearing the mark.

A clarification of the elements of the mark and the comprehensive meaning; if the mark consists of words or phrases of hieroglyphic languages, those words or phrases must be transliterated; if the trademark consists of words or phrases in a foreign language, those words or phrases must be translated into Vietnamese.
The goods or services must be classified according to the Nice Agreement.
 - b) Regulations on the use of collective marks:
 - iii) Details of the holding organization
 - iv) Condition to become a member of the collective organization
 - v) List of members authorized to use the trademark
 - vi) Conditions for using the trademark
 - vii) Remedies applicable in case of infringements

- h) Regulation on the use of certification marks:
 - i) Details of the holding organization
 - ii) Conditions for using the trademark
 - iii) Characteristics of goods or services certified by the mark
 - iv) Methods of evaluation and supervision of the characteristics
 - v) Expenses payable by the mark user
- 1) Receipt of payment of the tax for the filing of the application
- 2) Power of attorney (if any)
- 3) Documents certifying the right of registration of the trademark
- 4) Documents proving the right of priority (if any)

Secondary meaning

A descriptive term is distinctive of specific products if it has acquired a secondary meaning, that is, if a particular commercial source it's connected to the products. The very fact that the trademark has been used in normal commercial practice for a certain period may be sufficient to be eligible for registration.

Trademarks are not eligible for protection in Vietnam, if they consist of simple and geometric figures, numbers, letters or writings of uncommon languages, unless that sign has been widely used and recognized as a trademark.

The Madrid system

Vietnam is a member of the Madrid System. Therefore, it is possible to file application in Vietnam for the protection of trademarks in other members countries, and vice versa.

Madrid applications designating Vietnam

An application filed at the WIPO designating Vietnam must go through the ordinary registration process in Vietnam, prescribed by Law. Once successfully completed, the NOIP issues and publishes a decision of acceptance for the protection of an internationally registered trademark in the Official Journal of Industrial Property. In addition, the holder of an internationally registered trademark may request the NOIP the issue a certificate of protection in Vietnam.

Madrid applications originating in Vietnam

Vietnamese organizations or individuals have the right file international registration of trademarks according to the Madrid System, if:

- a) Protection is claimed in a country member of the Madrid Agreement, provided that the trademark has already been registered in Vietnam
- b) Protection is claimed in a country member of the Madrid Protocol, but not a member of the Madrid Agreement, provided that the applicants have already filed applications for registration of the trademark in Vietnam.

The NOIP is the state agency responsible for handling Madrid applications originating in Vietnam.

The application for international registration through WIPO

Applications for registration must contain the following documents:

- 1) Written declaration of application for international registration of a trademark
- 2) Written declaration according to MM2 (the language used is English or French)
- 3) Sample of the trademark to be registered
- 4) Receipts for payment of taxes and charges
- 5) Copy of the registration certificate
- 6) Power of attorney for an individual/organization in Vietnam

Before filing an international application, the applicant must have already file or successfully registered, an application at the National or Regional IP office of origin (*basic mark*). The applicant must then submit the international application through the same IP office, which certify and forward it to WIPO.

The WIPO international registration procedure see firstly a formal examination and publication steps and then a substantive examination and decision by the competent offices in the territories where the applicant seeks protection. These offices will then make a decision within the applicable period (12 or 18 months) which will

be then registered internationally in the WIPO Register.

A refusal decision by a single office shall not affect the decisions of the other competent offices in other territories from which protection is sought.

The international registration of a trademark is valid for 10 years, renewable every 10-year period directly with WIPO.

Note: For the application examination process please see **Appendix 1: Application examination process**.

Loss of trademark rights

According to art.95 of the IP Law, the protection will cease in the following cases:

- a) Failure to pay the due fees for the maintenance or renewal
- b) The holder declares the waiver of its rights
- c) The holder has ceased (no longer exists) or is no longer engaged in business activities without a lawful successor
- d) The trademark has not been used without justified reason for five (5) consecutive years, unless the use has resumed three (3) months before the request for withdrawal
- e) A collective mark is ineffectively supervised by its owner
- f) A certification mark is ineffectively supervised by its owner

Trademark Transfer at the NOIP

Art.140 and 144 of the IP Law provide the regulation for the License Agreement of Trademarks, which is identical for intellectual property rights such as Patents and Trademarks. Please refer to the previous chapter for the transfer of Patents.

Contractual procedures for carrying out the transfer of ownership of the Trademark

The license Agreement shall contain, among the usual clauses, the circumstances of the assignment such as the number of protected instruments, date of issue, class and term of protection.

The Licensing Agreement becomes effective once registered with the NOIP. Therefore, the registration of the contract of assignment of the trademark is a mandatory procedure as explained in the previous paragraphs.

The dossier for the registration of the Trademark License Agreement shall include the following:

- a) Written declaration for the registration of the contract for the assignment of the trademark
- b) Trademark License Agreement
- c) Original Certificate of Protection
- d) The written consent of the co-holders, if any
- e) Rules on the use of the collective or certification mark, if the mark transferred is either a collective or a certification mark

- f) Evidence of the applicant eligibility to apply for certification of collective marks
- g) Written power of attorney, if the file is submitted through a representative
- h) Copies of receipts of taxes and charges paid

Usually, within two (2) months the NOIP issues and publishes a decision, unless there is any need to amend or supplement the dossier. However, in practice, it takes four (4) to six (6) months depending on the circumstances.

Types of violation

Art.129 of the IP Law sets the following acts as violations of the trademark holder's right:

- 1) Using signs identical with protected marks for goods or services identical with those in the list registered with the mark;
- 2) Using signs identical with the protected marks for goods or services similar to or related to those in the list registered with the mark, if such use is likely to create confusion as to the origin of the goods or services;
- 3) Using signs similar to protected trademarks for goods or services that are identical, similar or related to goods or services on the list registered with that trademark, if such use is likely to create confusion as to the origin of the goods or services;
- 4) Using signs identical with or similar to well-known

marks, or translations or transliteration, for any goods or services, if such use is likely to create confusion as to the origin of the goods or services or misleading impressions as to the relationship between the users of those signs and known trademark owner.

Furthermore, the signs affixed on products, packaging, means of services, transaction documents, signs, means of advertising or other activity that are identical or mistakeable with the trademark, are deemed as infringement (art.11 of Decree No.105/2006/NĐ-CP).

An alleged infringing sign or product is considered counterfeit by means of comparison with the sign or product related to the trademark. An infringing good can only be confirmed if:

- 1) The suspicious sign is identical or confusingly similar to the trademark.

A sign is considered identical to a trademark if it has the same composition of words, including the pronunciation, the phonetic transcription of letters, meaning, image and symbol.

- 2) Products having the suspicious sign are identical or similar to those bearing the trademark.

A product is considered identical or confusingly similar to other products bearing the trademark, if it is identical or similar in substance, functions, utility and distribution channel.

Regarding well-known trademarks, a suspicious sign is deemed as infringement if:

- 1) The suspicious sign satisfies the condition specified

in point 1 above

- 2) Goods or services bearing the suspicious sign satisfy the condition specified in point 2 above
- 3) Goods or services are not identical, similar or related to goods or services bearing the known trademark but are likely to mislead customers or create wrong impressions of the relationship between the manufacturer or trader of those goods or services and the proprietor of the well-known trademark

Note: For the right to self-protection, civil and administrative remedies please see Appendix 2: Actions to protect violations.

Italian Sounding

Italian Sounding is the use of geographical names, images and marks that evoke Italy to promote and market products that are not associated to our country. This behavior of improper use of the Italian language with the purpose of adopting misleading marketing techniques should qualify as unfair competition. However, the Vietnamese laws and regulations do not explicitly prohibit such conduct.

According to art.198 of the IP Law, those who suffer from damage caused by acts of unfair competition shall have the right to request the Court to impose civil remedies (listed in the paragraph Civil Remedies). Furthermore, the suffering party may request the application of administrative remedies provided by the Competition Law and in particular by Decree No. 71/2014 / NĐ-CP.

COPYRIGHT IN VIETNAM

Copyright

COPYRIGHT IN VIETNAM

COPYRIGHT

According to art.4 of the IP Law, copyright is the right of an organization or individual to works created or owned by them.

In addition, art.4 defines copyright related rights, which indicate the rights of an organization or individual to performances, phonograms, broadcasting programs, and satellite signals carrying encrypted program.

In accordance with the Berne Convention for the Protection of Literary and Artistic Works, Paragraph 1, Article 6 of the IP Law establishes the following:

- 1) Copyright shall arise when a work is created and expressed in a certain material form regardless of its content, quality, form, mean, language, whether or not that work has been published or registered;
- 2) Related rights shall arise when a performance, a phonogram, a broadcast program or satellite signal carrying encrypted program is reproduced or displayed without causing loss or damage to the right or author.

It should also be mentioned that under Chapter 12, Section B of the EVFTA Vietnam recently acceded to the WIPO Copyright Treaty (WCT) and to the WIPO Performance and Phonogram Treaty (WPPT), both treaties came into force this year (2022). Signing these treaties will help Vietnam and entrepreneurs who want to do business in the country to face the challenges associated with copyright and the unauthorized use of creative works on the Internet and other digital networks.

Furthermore, as a contracting country to the Universal Convention on Copyright, a copyright in Vietnam can be automatically protected for works created in other acceding countries. In the meantime, the applicant could also apply its copyright in Vietnam to obtain the national Copyright Registration Certificate.

Copyright registration is intended to guarantee and protect the creators of the works from the illegal use of the protected works, such as theft, copying and abuse of such works. In the event of disputes, the Copyright Registration

Certificate is the best proof of the author's ownership over the work. In addition, the Copyright Registration Certificate constitutes proof of ownership of the creative work in the context of corporate valuations, in the event of listing of the company, or in the case of transactions such as M&As.

In general, copyright and related rights regulated by the IP Law are rather progressive, and relatively consistent with the international conventions to which Vietnam is a Contracting State.

Protection conditions

Art.14 of the IP Law specifies a whole range of works protected by copyright, from literary, scientific, journalistic and dramatic works to graphics, sketches and data collections.

According to art.13 of the IP Law, copyright authors and owners are organizations or individuals having protected copyrights, these among others include the following subjects:

- a) Authors who create their work by using their own time, finance and other physical and technical materials shall have the so-called personal rights (art.19) and property rights (art.20)
- b) Co-authors who create their work by using their own time, finance and other physical and technical materials shall have personal rights and property rights (art.19-20)
- c) Any organization that assigns the task of creating a work to an author, who is its employee, shall be the owner of property rights referred to in art.20 and personal rights pursuant to par.3, art.19 of the IP Law, unless otherwise agreed.
- d) Any organization or individual that is by contract assigned one, more or all of the rights provided for in par.3, art.19, and art.20 of the IP Law.
- e) Authors and owners of copyrights include: To further specify, authors and owners of copyrights include not only Vietnamese organizations and individuals but also foreign organizations and individuals of which works were published for the first time in Vietnam and in no other country or were simultaneously published in Vietnam within thirty (30) days from its first publication in another country;

The State of Vietnam is the copyright owner of the following works:

- a) Anonymous works
- b) Works for which the term of protection has not expired but the copyright owner has died without leaving an heir,

or the heir has waived, or has not, the right to such works

- c) Works of which owner rights are assigned to the State by the copyrights owner.

Supporting documents for application

Authors and holders of copyright and related rights may directly file, or authorize third parties to file an application for copyright registration or related rights in Vietnam. These applications shall include the following:

- 1) Declaration form for registration of the copyrights or related rights (regulated by the Ministry of Culture and Information).
- 2) The form must be in Vietnamese and signed by the author, copyrights, related rights owners or person authorized to submit the application. It also must contain: complete information about the applicant, author and copyright or related rights owner; a summary of the main contents of the work, performance, phonogram or broadcasting program; time, location, and forms for publication; company bearing responsibility relating to the information given in the application.
- 3) Two copies of the work applied for copyrights or related rights registration
- 4) A power of attorney (if the application is submitted by a representative)
- 5) Documents proving the right to file the application if the applicant acquires that right as a result of inheritance, transfer or assignment

If the work has co-authors or the copyright or related rights belong to joint ownership, written consent of the co-authors or co-owners shall be needed.

Duration of protection granted to a work

According to the IP Law, copyrights include personal rights and property rights:

- a) Personal rights:
 - a) Give names to his or her work
 - b) Put his or her real name or pseudonym in the works; to have their real names or pseudonyms mentioned when his or her work is published or used

- c) Publish his or her work or authorize other people to do so;
- d) Protect the integrity of his or her work;
- b) Property rights
 - a) Create derivative work
 - b) Perform the work to the public
 - c) Reproduce the work
 - d) Distribute or import the original or copies of the work
 - e) Communicate the work to the public by wire or wireless means, through electronic information network or other technical means
 - f) Lease the original or copies of cinematographic work and computer programs

As to the duration of copyright protection, personal rights – with the exception of the right to publish works or authorize other persons to publish them – are protected indefinitely, and are inalienable.

Furthermore, regarding the personal right to publish one's work or to authorize other persons to publish one's works, as well as the property rights listed above, protection is guaranteed as follows:

- Cinematographic, photographic, applied art and anonymous works have the term of protection of seventy-five (75) years from the their first publication
- For Cinematographic, photographic and applied art works that remain unpublished within twenty-five (25) years from the date of fixation, the term of protection is one hundred (100) years from the fixation date of the work.
- For other works, when information about their authors is published, the term of protection is guaranteed for the entire life of the author and for fifty (50) years from the year of the author's death.

Registration process

Filing application for copyright and related rights registration certificate is not a mandatory procedure for the entitlement to the copyright or related rights, but is necessary to prove the author and the owner of the work in case of disputes.

The procedure for filing copyright and related rights involves the following steps:

- 1) Preparation of the supporting documents for filing application for copyright and related rights registrations certificate as indicated in the previous paragraph
- 2) Submission of the application for registration with the Copyright Office of Vietnam (COV), which is the authority responsible for granting the certificate.
- 3) The COV issues the copyright registration certificate and publishes the copyright or related rights certificate in the National Register of Copyright and Related Rights. In case of refusing to grant the certificate, the Ministry of Culture and Information shall inform the applicant in writing within fifteen (15) working days from the date of receipt of the application.

Registration fees

Circular No. 211/2016/TT-BTC on taxes and charges for copyright and related rights establishes and lists the amounts to be paid for the registration. Taxes for copyright and related rights registration certificates may vary from 100,000 to 600,000 VND

Transfer of the use of copyrights and related rights

Rights relating to copyright and related rights may be assigned or licensed for use through a written contract; however, personal rights – which are inalienable – cannot be transferred, except for the right of publication. Therefore, the transfer of copyright and related rights is limited to rights: publication of works and property rights

Some of the information required to be included in the contract is:

- 1) Names and addresses of the assignor and assignee or of the licensor and licensee depending on the case
- 2) Grounds of assignment or scope of the license, depending on the case
- 3) Price and payment methods
- 4) Rights and obligations of each party
- 5) Obligations for breach of contract

If the copyright or related rights to be transferred are co-owned, the transfer of rights must be agreed by all co-owners.

Furthermore, where a copyrighted work is co-owned, the holders of the copyright or related rights may transfer their title in its separate part to third parties.

Finally, where the copyright or related rights are licensed to third parties, these may in turn license these rights, with the prior consent of the owner of the copyright or related rights.

Once the transfer contract has been drawn up in accordance with the Law, it must be submitted to the COV through an application for renewal of copyright or related rights.

According to Clause 3, art.36 of Decree No. 22/2018/NĐ-CP, the application for transfer provides for a file containing:

- 1) Application form for registration of copyright or related right using the prescribed form referred to in Appendix 2 of Circular No. 08/2016/TT-BVHTTDL
- 2) Two copies of the work
- 3) Documentation evidencing the change of the owner

In addition, the previous certificate of registration of copyright or related rights must be returned.

Within 12 working days from the date on which a valid application is received, pursuant to art.37 of Decree No. 22/2018/NĐ-CP, the COV shall change the copyright registration certificate or related right registration certificate.

GEOGRAPHICAL INDICATIONS

Geographical indications

GEOGRAPHICAL INDICATIONS

GEOGRAPHICAL INDICATIONS

The concept of geographical indications was first defined in the TRIPS Agreement as an indication which identify a good as originating in the territory of a Country, or a region or location in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

According to the World Intellectual Property Organization (WIPO), a geographical indication (GI) is a sign used on products that have a specific geographical origin and have qualities or reputations due to that origin, thus providing a clear link between the product and its original place of production.

In Vietnam, the IPO Law defines a GI as a sign used to identify a product as originating in a specific region, locality, territory or Country.

GI are qualified as “signs”, but unlike trademarks, these are usually names or visual signs, symbols that have the function of indicating the origin of the product. For example, some Vietnamese GIs are Thanh Ha’s lychee, Doan Hung’s pomelo, Buon Ma Thuot’s coffee, etc.

The EVFTA recognizes and protects 169 European GIs such as Champagne, Feta, Parmigiano Reggiano, Rioja and Roquefort (*unfortunately the indications “mozzarella”, “parmesan”, “pecorino”, “provolone” are not protected*).

Use of Geographical Indications

All the Vietnamese GIs are owned by the State which grants the license to use to individuals and organizations in relevant locations and place those products on the market. The rights to GIs are not transferable to third parties.

The use of a GI should comply with the following rules of art.124, IP Law:

- Affixing the protected GI to goods or package of goods, commercial facilities and documents related to transactions and commercial activities

- Circulating, or offering, advertising, storing for sale of goods bearing the protected GI (art.21 of Decree No. 103/2006/ND-CP, the activities related to circulation include acts of sale, display for sale, shipment of products)
- Import goods bearing the protected GI

Protection of geographical indications of products

In Vietnam, IPR related to GI are established by the relevant state authority or via the recognition of international registration under a treaty to which Vietnam is member.

The certificate of protection of a GI shall contain the organization managing that GI, the organizations and/or individuals which have the right to use that GI, the protected GI, the particular characteristics of the products bearing that GI and the particular characteristics of the geographical conditions and areas bearing that GI.

A certificate of protection of a GI has unlimited validity from the date of grant. However, the validity may cease to exist if the geographical conditions determining the reputation, quality or special characteristics of GI products have changed.

Vietnamese Geographical Indications

Only the State has the right to register Vietnamese GIs. Thus, it licenses the right of registration of GIs to third parties producing GI products, namely collective organizations representing those producers, and the administrative bodies of the localities related to those GIs.

Foreign individuals and organizations holding rights to GI of foreign countries under the laws of the country of origin have the right to register such GIs in Vietnam (art.8, Decree 103/2006/ND -CP). Foreign GIs are also automatically recognized and protected if the origin country is member of a Treaty in which the parties pledge to recognize and protect the intellectual property respectively.

Italian and foreign Geographical Indications

Italian GIs are automatically recognized and protected as foreign country member of international treaties with Vietnam to recognize and protect the intellectual property of the other country.

Conditions for the protection of geographical indications

Art.79 of the IP Law sets out two conditions for issuing the GI protection certificate:

- 1) The product having the GI originates from the area, locality, territory, or country corresponding to such GI.

To qualify as originating in a specific geographical area, the product should be harvested, manufactured, or processed from that geographical area.

- 2) The product having the GI has a reputation, quality, or characteristics essentially attributable to the geographical conditions of the area, locality, territory, or country corresponding to such GI.

Specifically, the quality and characteristics of GI products must be determined by one or more qualitative, quantitative, or physically, chemically, microbiologically perceptible criteria which can be tested by technical means or by experts through appropriate methodologies.

In addition, the reputation of GI products is determined by consumer confidence in such products in so far as those products are widely known and selected by consumers.

According to art.82 of the IP Law requires to demonstrate that natural factors and human factors specific to the geographical area have influenced the quality, characteristics, or reputation of the product. *Natural factors* include climatic, hydrological, geological, topographical, and ecological factors and other natural conditions. *Human factors* include the skills and competencies of producers and the traditional production processes of localities.

Subject matters that cannot be protected as geographical indications

According to art.80 of the IP Law, the following objects are not protected as geographical indications:

- a) Designations, indications having become generic names of goods in Vietnam (e.g., vodka, whiskey, etc.)
- b) GI of a foreign country where they are not, or are no longer, protected or used
- c) GIs identical with or similar to a protected trademark, where the use of that GI is likely to create confusion as to the origin of the goods
- d) GIs misleading consumers as to the true geographical origin of products bearing those GIs.

Supporting documents for application

Art.106 of the IP Law sets the required documents to be included in the application dossier:

- 1) Declaration for the registration of the GI, pursuant to Model No. 05-CDDL referred to in Appendix A of Circular No. 01/2007/TT-BKHCHN, which contains the name or sign of the GI, and the product having the GI
- 2) Description of the peculiar characteristics and quality, or notoriety of the product having the GI, and particular elements of natural conditions determining the peculiar characteristics and quality, or notoriety of the product. The description should contain:
 - a) Description of the relevant product, including raw materials, and physical, chemical, microbiological, and perceptible properties
 - b) Method of determination of the geographical area corresponding to the GI
 - c) Evidence proving that the product originates in that geographical area (Art 79, IP Law)
 - d) Description of the local and stable methods of production and processing
 - e) Information on the self-control mechanisms of the peculiar characteristics or quality
- 1) Topographic map of the geographical area having the GI
- 2) Documents proving that the GI is protected in the country of origin (if any)
- 3) Power of attorney (if the application is submitted by a representative)
- 4) Documents certifying the right of registration of the GI
- 5) Documents proving the right of priority (if this right is claimed)

Note: For the application examination process please see Appendix 1: Application examination process.

Misuse of Geographical Indications

Art.129 of the IP Law sets the following acts as violations of GIs:

- 1) Using the GI for products that do not satisfy the peculiar characteristics and quality of GI products, although such products originate from geographical areas bearing such GI;
- 2) Using of GI for products similar to product having GI for the purpose of taking advantage of its reputation and goodwill;
- 3) Using a sign identical with or similar to a protected GI for products not originating from the geographical area

bearing the GI, and therefore misleading customers;

- 1) Using a GI of wines or spirits for products not originating in geographical areas bearing such GI, even where the true origin of the goods is indicated or the geographical indication is used in translation or transcription or accompanied by words such as “kind”, “style”, “type”, “imitation” or similar

Consequently, for the determination of acts in violation of the rights of the protected GI, the following conditions must be met:

- 1) The GI is protected by intellectual property rights;
- 2) There is an act in violation of the GI;
- 3) The person who commits the violation is neither the owner nor any person authorized by the Law or by a competent office
- 4) The violation took place in Vietnam, i.e. on the Internet but directed at Vietnamese consumers or users.

Furthermore, the signs affixed on products, packaging, means of services, transaction documents, signs, means of advertising or other activity that are identical or mistakeable with the protected GI, are deemed as infringement a GI (art.12 of Decree No 105/2006/NĐ-CP).

An alleged infringing sign or product is considered counterfeit by means of comparison with the sign or product related to the protected GI. An infringing good can only be confirmed if:

- 1) The suspicious sign is identical or confusingly similar to the protected GI.
- 2) A sign is considered identical to a protected GI if it has the same composition of words, including the pronunciation, the phonetic transcription of letters, meaning, image and symbol.
- 3) Products having the suspicious sign are identical or similar to those bearing the protected GI.

A product is considered identical or confusingly similar to other products bearing the protected GI, if it is identical or similar in substance, functions, utility and distribution channel.

Regarding wines and spirits, unless falling in the scenario of points 1 and 2 above, they are considered an infringement of the GI rights when they bear identical signs, including their phonetic translation or transcription or accompanied by parts of the speech, types, forms, adaptations or similar terms, and used for products not originating in the geographical area of the protected GI.

Liability for illegal use

The illegal use of GIs usually brings to three responsibilities: compensation for damages, sanction and implementation of the corrective measures above-mentioned (Decree No 99/2013/NĐ-CP).

Compensation for damages

According to art.16 of Decree N.105/2006/ NĐ-CP, the damages resulting from an infringement of IPR consists of actual losses, including physical and spiritual losses directly caused to the right holder by acts of infringement. Actual losses shall be regarded as occurred if:

- The physical or spiritual benefit is real and belongs to the aggrieved party
- The aggrieved party could achieve the above benefit
- There is a decrease or loss of the benefit of the aggrieved party after the act of infringement as compared to the possibility of achieving such benefit if such a violation does not occur and is the direct cause of such decrease or loss of the benefit.

The aggrieved party may request the Court to determine the amount of the damage related to the ancillary costs (temporary storage, maintenance, implementation of urgent interim measures, entrusted assessment service, preventing and remedying the consequences of the infringement, notification and correction of public perception relating to acts of infringement).

Note: For the right to self-protection, civil and administrative remedies please see Appendix 2: Actions to protect violations.

Sanctions

The infringer will be sanctioned when selling, offering, transporting (including in transit), storing or displaying for sale goods or services that violate the right to GI, whether self-built or borrowed from third parties. The sanction will be determined in the amount of from VND 500,000 to VND 250 million, depending on the value of the goods or services respectively from VND 3 to 500 million.

The amount shall increase by 1-2 times (but not exceeding VND 250,000,000) if the offenders perform or instruct third parties to perform the following acts:

- Design, manufacture, processing, assembly and packaging of goods bearing signs of violation of GI rights

- Printing, gluing, attaching, casting, stamping or other forms of stamps, labels and other articles bearing signs of violation of GI rights
- Import of goods bearing signs of infringement of GI rights

For perpetrators of the above infringements, a sanction from VND10 to 30 million will be imposed.

For acts of infringements related to signs, commercial transaction documents, commercial means, service vehicles and packaging of goods, a sanction from of VND 10 to 20 million will be imposed.

In addition, the perpetrators commercial activity can be suspended for a period of between 1 and 3 months and further financial penalties under the Criminal Code.

In this case, and only for individuals, the sanction may range from VND 50 million to 1 billion and a non-custodial sentence of up to 3 years, if the acts in violation are carried out on a commercial scale procured notable illicit profits. Further sanctions involve the prohibition of holding certain positions, exercising certain professions or carrying out certain jobs for a period of 1 to 5 years.

Meanwhile, the sanctions applicable to organizations and legal entities, range from VND 500 million to VND 5 billion, if the acts in violation are carried out on a commercial scale procured notable illicit profits. Further sanctions involve the suspension of business activities for a period between 6 to 24 months, and, in case of most serious violations, an additional penalty up to VND 300 million and the inhibition of carrying out any activity, operating in certain sectors or attracting investment capital, for a period of 1 to 3 years.

APPENDIX 1: APPLICATION EXAMINATION PROCESS

The application examination process for filing patents, trademarks and geographical indications consists of four stages. NOIP officials will examine the application on the following stages:

1) Formal examination. Following this first formal examination, the application for registration could be considered invalid in the following cases:

- a) The application does not meet the formal requirements
- b) The object declared in the application is not suitable for protection
- c) The applicant does not have registration rights
- d) The application is filed in violation of the regulations on filing methods
- e) The applicant does not pay the fees and related charges

For applications for registration falling within the cases listed above, the NOIP proceeds to:

- a) Notify the refusal to accept the formally invalid application, giving clear reasons and setting a deadline within which the applicant can correct

the errors or oppose such refusal;

- b) Notify the final refusal, if the applicant does not act following point (a).

However, if the applicant adequately corrects the errors or raises a justified objection, or in the event that the initial application is accepted, the NOIP issues a notification of acceptance or grants a certificate and registers it directly in the National Register of Industrial Property.

Note: rejected applications are deemed as not filed unless they serve as a reason for alleged priority.

2) Publication by NOIP in the Official Journal of Industrial Property, respectively:

- Inventions and utility models: in the 19th month from the filing date
- Industrial designs: within two (2) months from the acceptance notification
- Trademarks: within two (2) months from the filing date or priority date
- Geographical indications: within two (2) months from the acceptance notification

The NOIP must keep the information confidential. If

any damage should result from an information leak, the officials in charge shall be liable and reimburse the damage.

From the date of publication until before the date of issue of the decision granting the protection title, any third party has the right to express an opinion to the NOIP about the granting or refusal to grant a protection title for such application. Such opinions must be filed in writing and accompanied by supporting documents or must cite the source of the information.

3) Complete a substantive examination

- Patents: within eighteen (18) months from the date of publication or seven (7) months in the case of industrial design.
- Trademarks: within nine (9) months from the date of publication
- Geographical indications: within six (6) months from the date of publication

Furthermore, if the application relates to inventions, the applicant or any third party may request NOIP to perform a substantive examination within forty-two (42) months from the filing date or priority date, or thirty-six (36) months in case of a utility model patent application.

The NOIP is obliged to conduct and complete the substantive examination within eighteen (18) months from the publication or from the receipt of the request.

After publication in the Journal and before the result notification, the applicant has the right to:

- a) Modify or supplement the application form
- b) Split the application (*the filing date of the original application shall be kept*)
- c) Request registration of changes to the applicant's name or address
- d) (For patents and trademarks only) Request registration of the change of the applicant following the transfer of the application on the basis of a contract, legacy or inheritance, or decision of a competent authority
- e) Convert the application for a patent for invention into an application for a utility model, and vice versa.

In any event, any modification or supplementation of an application for registration must not extend the scope of the subject matter already set out or indicated in that application, must not alter the nature of the subject matter of registration indicated in the application, and must ensure uniformity of application.

In addition, before the result notification, the applicant shall have the right to file a written request of withdrawal. Any withdrawn application is deemed as not filed, unless they serve as a ground for claims of priority right.

- 4) The NOIP may refuse to grant the patent in the following cases:
- a) If the object does not fully meet the conditions for protection
 - b) If the application does not have the earliest filing date or priority date (first to file principle)

- c) If there are multiple applications that meet all the conditions and have the same priority, and the applicants do not agree to grant the patent to a single application
- c) Trademarks: within two (2) months from the filing date or priority date
- d) Geographical indications: within two (2) months from the acceptance notification

In case of refusal, the NOIP shall proceed as follows:

- a) Notify the refusal, clearly stating the reasons and setting deadline to file for opposition.
- b) Notify the final refusal if the applicant, upon notification of the first refusal, does not raise objections or makes an unjustified objection to such refusal
- 1) Substantive examination:
 - a) Inventions and industrial models: no more than eighteen (18) months from the publication or from the request for substantive examination
 - b) Industrial designs: no more than seven (7) months from the date of publication
 - c) Trademarks: within nine (9) months from the date of publication
 - d) Geographical indications: within six (6) months from the date of publication

Alternatively, if the outcome of the substantive examination is positive or if the applicant has raised a justified opposition to the refusal, **the NOIP issues patent, trademark or geographical indication** certificates and registers it in the Register.

Duration of the registration process

The duration of the registration process is divided into three (3) stages:

- 1) **Formal examination** of the application: within one (1) month from the submission
- 2) **Filing of the patent application:**
 - a) Inventions and utility models: within the 19th month following the filing date or priority date.
 - b) Industrial designs: within two (2) months from the acceptance notification

Usually, the duration of the whole registration procedure is thirty-eight (38) months for invention or utility model, ten (10) months for industrial design and one (1) month for industrial layouts – which does not require substantive examination. In case of trademark registration, the procedure is twelve (12) months. However, in practice, the actual duration may vary.

APPENDIX 2: ACTIONS TO PROTECT VIOLATIONS

Right to self-protection

The holder of the industrial property has the right to use appropriate measures to protect his IPR. In particular, the holder may:

- 1) Apply so-called technological prevention measures:
 - a) Display approximate information on the origin of the infringement, title of protection, holder, scope and period of protection and other information on its IPR, to inform and warn that they should not be infringed;
 - b) Use technical measures to mark, identify, distinguish and safeguarding protected products
- 1) Require by written notice any organization or individual committing an act of infringement to terminate such act, make a public apology or correction, and compensate for damages.
- 2) Require the competent authority support.
- 3) Initiate a lawsuit in a court or a complaint at an arbitration center.

Depending on the nature and gravity of the infringement, the competent authority will issue an appropriate

sanction through the application of civil, administrative or criminal remedies.

Civil remedies

Courts may apply the following civil remedies:

- Mandatory cessation of unlawful acts
- Mandatory public apology and rectification
- Obligation to perform civil obligations
- Obligation to pay damages
- Destruction, distribution or use for non-commercial purposes of products, raw materials, materials and facilities used primarily for the production or trade of goods that infringe IPR, provided that such destruction, distribution or use does not prejudice the exploitation of the holder's right.

Furthermore, under art.206 of the IP Law, the holder has the right to ask the court to apply urgent interim measures (preservation, confiscation, sealing, prohibit any alteration, movement, transfer of ownership, others), either at the time of the act or after the start of a lawsuit.

Administrative remedies

The following acts of violation of industrial property rights are subject to administrative sanctions:

- 1) Infringing intellectual property rights causing loss and harm to consumers or society
- 2) Failure to terminate an act of infringement following a written requesting of termination
- 3) Manufacture, import, transport, or trade in counterfeit goods, including:
 - a) Goods bearing counterfeit trademarks
 - b) Goods bearing counterfeit geographical
 - c) Pirated goods, i.e. copies made without the permission of the holder
- 1) Production, import, transport, or trade of articles bearing a trademark or geographical indication which is identical with or confusable with a protected one.

Any organization or individual that commits an act of infringement will have to terminate that act and will be subject to a financial sanction, other than additional sanctions (confiscation of counterfeit goods, materials and structures and fixed-term suspension of business activity).

Other provided sanctions might be:

- Mandatory destruction (*as in the civil remedies*);
- Mandatory transportation out of the territory of Vietnam of goods that violate industrial property rights or counterfeit goods and materials and facilities

used primarily for the production or trade of such counterfeit goods.

Criminal remedies

Anyone who commits an act of infringement of intellectual property rights involving a criminal element is prosecuted under criminal law.



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