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New finds this week

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New finds this week

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Strengthening Trademark Protection: Enhanced Third-Party Rights in Vietnam's IP Law

Overview

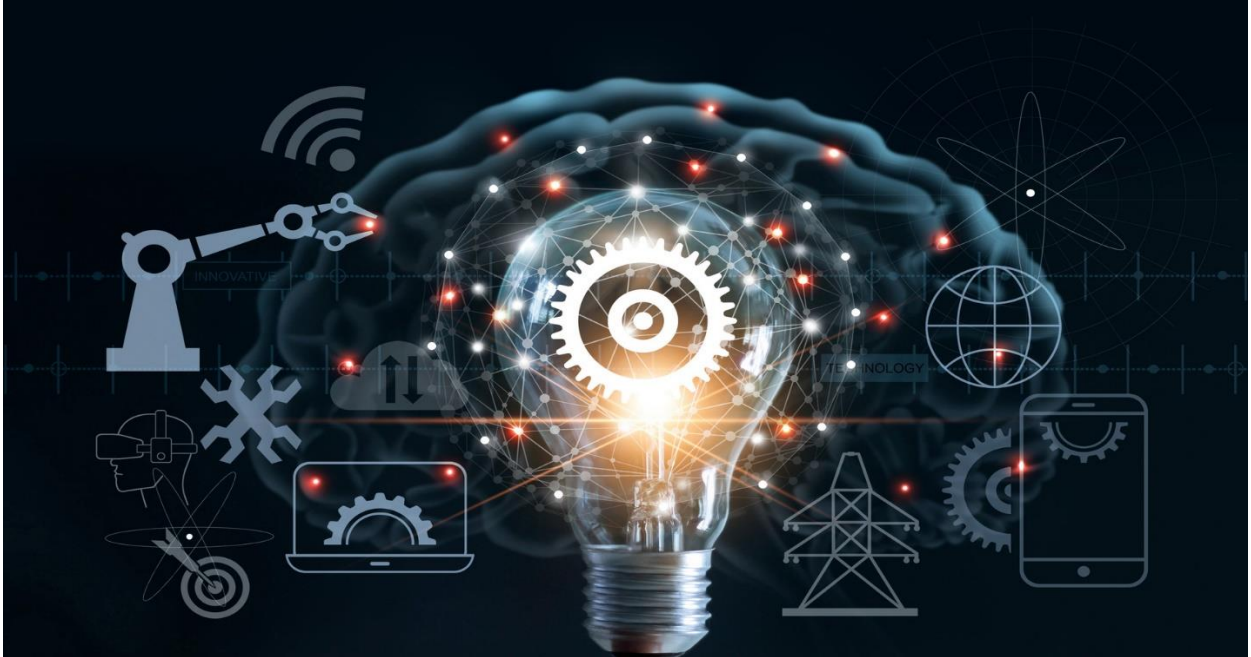
The following article discusses third-party rights in trademark applications and highlights recent changes to Vietnamese IP Law. This represents a significant advancement in Vietnam's IP law, establishing a legal framework prioritizing fair protection for rightful owners. The emphasis on the role of third-party observation during the application examination phase for protection titles is particularly noteworthy.

Enhanced role of third-party observation and opposition

In the substantive examination phase of an application, third parties are allowed to submit their opinions to the Intellectual Property Office of Vietnam regarding granting protection title to industrial property objects. This provision is mentioned in the IP Law and has been reiterated in the 2009 and 2019 amended versions of the law. Third-party observation is confined to submitting opinions, and no further communication or discussion is permitted between the third party and the IP Office of Vietnam. Third-party opinion is considered a source of information for reference during substantive examinations. The IP Office of Vietnam is not obligated to send its settlement result to a third party.

However, the latest amended version of the IP Law, effective from January 1, 2023, emphasizes and enhances the role of third-party observation. In addition to submitting opinions, third parties now have the right to file opposition to granting protection titles to industrial property objects in applications during the substantive examination phase with the IP Office of Vietnam. The IP Office of Vietnam is now responsible for resolving third-party opposition and sending its settlement result to the opposers. This is a significant development in the 2022 version of the IP Law, aimed at ensuring fair protection for rights holders.





Time limits for submitting third-party opinions and oppositions

When exercising the third-party observation right, it is essential to note that the opinion or opposition must be submitted to the IP Office of Vietnam within the time limits set by the IP Law. For third-party opinions, they should be submitted after the application publication date and before the decision to grant protection title to the application. Regarding international trademark applications designating Vietnam under the Madrid Agreement and Protocol, the time limit for submitting a third-party opinion is regulated differently. As per article 27.10 of Decree 65, it can be submitted after the publication date of the international application and before either the date on which the IPVN accepts the international application or the end of 12 months from the International Bureau's notification of the international application designating Vietnam.

For third-party opposition, it must be submitted within five months of the publication date of the trademark application, which is two months from the date on which the IP Office of Vietnam legitimately accepts the trademark application. The trademark application will be checked for compatibility with the IP Law's requirements within one month of its filing date, not including time for supplements, revisions, or both, at the IP Office of Vietnam's request. It's worth noting that before the effective date of the IP Law's 2022 amended version, many third-party opinions were submitted in the form of third-party oppositions within the nine-month substantive examination duration from the publication date and before granting the protection title to the industrial property objects in the applications.

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Requirements and process for filing third-party opposition

When filing a third-party opposition, it is essential to note that the application must be made in Vietnamese. The IP Law does not stipulate a specific form for the application. While accompanying documents may be in a foreign language, the IP Office of Vietnam may request a Vietnamese translation to facilitate the process.

Once the application dossier meets the statutory requirements, the IP Office of Vietnam will notify the trademark applicant of the opposition and set a two-month time limit for the applicant to respond. Suppose the trademark and the goods or services described in the application are found to be identical or confusingly similar to those presented by the opposer. In that case, the IP Office of Vietnam will settle the opposition alongside the substantive examination of the trademark application. The IP Office will then notify the opposer of the settlement result and the substantive examination result of the trademark application.

After receiving the trademark applicant's response to the opposition, the IP Office of Vietnam may inform the opposer and set a two-month time limit for the opposer to respond.

The IP Office of Vietnam will review third-party opposition to trademark applications and notify the opposer of the settlement and substantive examination results. Suppose the opposition is related to the right to file the trademark application. In that case, the opposer may need to bring the case to court for settlement under the Civil Procedure Code unless specific conditions are met. The opposer must submit a copy of the court's acceptance notice to the IP Office within two months of the notification.

If the court accepts the claim, the trademark application process will be temporarily suspended until the court issues a verdict. If no court acceptance notice is submitted within two months, the opposition will be considered withdrawn.

Legal basics and surveillance search tools for third-party opposition

When opposing a trademark application in Vietnam, one can refer to the IP Law's 2022 amended version for legal stipulations. These stipulations cover various aspects, such as the distinctiveness of trademarks, right-to-file applications, and bad-faith filing. It is advisable to seek advice from a qualified trademark attorney in Vietnam to understand the legal grounds for opposing the application.

In addition, trademark owners and opposers can conduct surveillance on trademark applications in Vietnam by utilizing different search tools. These tools include the Industrial Property Gazettes published monthly by the IP Office of Vietnam, WIPO Publish trademarks, VN Trademarks, and other international and regional IP information search tools. Additionally, local law firms can provide services for information searches, surveillance, and assistance with opposition.



Balancing effort and formality in using opinions and oppositions for trademark conflicts in Vietnam

In the context of Vietnam's trademark registration system, both opinions and oppositions are important tools for addressing potential conflicts. An opinion provides a quick and cost-effective way for interested parties to raise concerns while examining a trademark application. It allows for early issue identification and smoother registration processes. On the other hand, an opposition offers a more formal and structured platform for challenging a trademark application with solid legal grounds. It enables the opposer to defend their legitimate trademark rights and prevent conflicting marks from being registered.

The choice between opinion and opposition depends on practical considerations, such as balancing effort and formality. Opting for an opinion may be suitable in more straightforward situations or when a quick response is needed. However, when efficiency and a settlement result from the IP Office of Vietnam are desired, opposition is preferable.

Further refinement of the legal framework surrounding third-party opinions and oppositions can enhance transparency and clarity in Vietnam's trademark system, ultimately strengthening the protection of intellectual property rights. While both opinion and opposition allow opposers to challenge the trademark application, opposition is a formal, more robust, and interactive platform between the parties. An opinion, on the other hand, constitutes an expeditious and less stringent mechanism for an opposer. An opinion necessitates only a written submission substantiated by relevant legal arguments and supporting evidence. In contradiction, an opinion is not subject to a filing fee. The ease and lack of cost associated with filing an opinion could lead to frivolous or strategic filings intended to delay or disrupt the application process. This could become a concern if an opinion becomes more widely used.

Furthermore, it is crucial to acknowledge that the IP Office of Vietnam considers an opinion solely as an information reference during the examination process of the opposed trademark application. Consequently, it generally does not provide the opposer with formal notification regarding the outcome of the application's assessment. Therefore, an opinion may not have the same persuasive influence as an opposition. Conversely, an opposition requires specific filings, fees, and a structured communication process in which both parties present arguments. The IP Office of Vietnam must settle an opposition and notify the opposer of its settlement alongside the substantive examination result of the trademark application.

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Opinion and opposition mechanisms are crucial safeguards within Vietnam's trademark registration system. An opinion offers a flexible and cost-effective means for interested parties to bring potential conflicts to the IP Office of Vietnam's attention during the substantive examination of the application. This enables the early identification of issues and potentially smoother registration processes. Conversely, an opposition provides a more structured and formal platform for challenging the trademark application with solid legal grounds. By engaging in opposition proceedings, the opposer can defend its legitimate trademark rights against the conflicting marks and prevent the conflicting marks from registration.

The choice of opinion or opposition hinges on a practical consideration – the balance between effort and formality. In more straightforward situations, or when a quick response from the IP Office of Vietnam is required, the opinion option might be a suitable choice. However, from an efficiency point of view, with a settlement result from the IP Office of Vietnam, the option of opposition becomes preferable. Looking ahead, continued refinement of the legal framework on the option of a third-party opinion or a third-party opposition can further enhance transparency and clarity of the IP Office of Vietnam's trademark system, fostering a more robust environment of protection for intellectual property rights.



Conclusion

In conclusion, the recent amendments to Vietnam's IP Law mark a significant advancement in the protection of intellectual property rights. By enhancing the role of third-party observation and opposition, the law provides a more robust framework for addressing potential conflicts in trademark applications. The distinction between opinions and oppositions allows for flexibility and formality, catering to different needs and scenarios. Opinions offer a quick and cost-effective way to raise concerns, while oppositions provide a structured and formal platform for defending legitimate trademark rights. As Vietnam continues to refine its legal framework, these mechanisms will enhance transparency, clarity, and fairness in the trademark registration process, ultimately strengthening the protection of intellectual property rights in the country.

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