

Vietnam IP News Bulletin

Kenfox IP & Law Office

March 2019

TRADEMARK OPPOSITIONS IN VIETNAM

1. Are oppositions filed before the Vietnam IP Office?

KENFOX: Article 112 of the IP Law of Vietnam provides that "As from the date an industrial property registration application is published in the Official Gazette of Industrial Property till prior to the date of issuance of a decision on grant of a protection title, any third party shall have the right to express opinions to the concerned state management agency in charge of industrial property rights on the grant or refusal to grant a protection title in respect of such application. Such opinions must be made in writing and be accompanied by documents or must quote the source of information"

Normally, an opposition to the grant of trademark registration must be filed before the National Office of Intellectual Property of Vietnam. However, under Article 6.4 of Circular No. 01/2007/TT-BKHHCN, if an opposition filed by the third party is related to the registration right, when finding it impossible to determine whether or not such opposition is grounded, the Vietnam IP Office shall notify such to the third party so that the latter can file a petition with a court for handling. Within one month after the Vietnam IP Office issues the notice, if the third party fails to notify the Vietnam IP Office of the filing of a petition with a court for handling, the Vietnam IP Office shall regard the third party as having withdrawn its opposition. If the Vietnam IP Office is notified by the third party within the above time limit, it shall suspend the application

processing until the results of dispute settlement by the court are obtained. After the results of dispute settlement by the court are obtained, the application processing shall be resumed in accordance with those results.

2. Are oppositions filed in a Vietnamese Court?

KENFOX: Article 6.4 of Circular No. 01/2007/TT-BKHCN. In case that an opposition is filed relating the "right to file", and it is not possible for the NOIP to determine whether or not such opposition is grounded, the NOIP shall notify the said situation to the opponent, so that the opponent can submit the case to a competent court for their ruling. Within one (1) month from the date of notification by the NOIP, if the opponent fails to bring the case to the court and notify the NOIP thereof, the opposition as filed at the NOIP shall be deemed withdrawn. If the NOIP is notified of the initiation of the lawsuit before the court, the NOIP will suspend the prosecution of the opposed application, awaiting the judgment of the court. After the court's judgment is issued, the NOIP will resume their examination of the opposed application basing on such a judgment.

3. Can any party file an opposition against an IP application in Vietnam?

KENFOX: Any natural or juridical person may file a trademark opposition. Legal interest is not required.

4. Is special legal interest necessary to file an opposition in Vietnam?

KENFOX: Legal interest is not required to file an opposition against a trademark application in Vietnam.

5. Is an opposition filed with the Vietnam IP Office against a pending trademark application before its grant of registration?

KENFOX: Article 112 of the IP Law of Vietnam provides that *"As from the date an industrial property registration application is published in the Official Gazette of Industrial Property till prior to the date of issuance of a decision on grant of a protection title, any third party shall have the right to express opinions to the concerned state management agency in charge of*

industrial property rights on the grant or refusal to grant a protection title in respect of such application. Such opinions must be made in writing and be accompanied by documents or must quote the source of information". Statutorily, an opposition must be filed with the Vietnam IP Office against a pending trademark application before its grant of registration.

6. Whether an opposition should be filed against a trademark application before its examination?

KENFOX: Article 112 of the IP Law of Vietnam provides that "*As from the date an industrial property registration application is published in the Official Gazette of Industrial Property till prior to the date of issuance of a decision on grant of a protection title, any third party shall have the right to express opinions to the concerned state management agency in charge of industrial property rights on the grant or refusal to grant a protection title in respect of such application. Such opinions must be made in writing and be accompanied by documents or must quote the source of information".* Thus, an opposition action against a trademark application can be taken from the publication date of the application till the date when the registration/protection for such trademark is granted. In a broader sense, an opposition must be filed as from the date of publication of the pending application in the IP Gazette, which means after completion of the formality examination over such a trademark application.

7. Does the Vietnam IP Office's examiner hold up examination for pending application until an opposition decision against the conflicting citation is issued?

KENFOX: In principle, the prosecution of trademark applications, and proceeding of opposition are two separate procedures in Vietnam. Thus, the Vietnam IP Office's examiner is not obliged to hold the examination of the pending applications until the opinions on the opposition case is issued or the opposed mark is refused. However, in practice, the applicant may file with the Vietnam IP Office a request to hold the examination of the pending applications. Such request may be, in case-by-case basis, acceptable, and the applications may be kept pending a bit longer to await the opinions on the opposition case or decision on the registrability of the opposed marks.

8. Under the laws of Vietnam, whether a supplemental period for submitting evidence in an

opposition is available? If available, please advise the supplemental period.

KENFOX: There is no explicit regulation on the matter. However, in practice, further submission in support to an opposition action can be filed in 2-3 months from the filing date of the opposition action.

9. Whether it is possible to submit the original power of attorney to the Vietnam IP Office after the opposition deadline?

KENFOX: Under Article 112 of the IP Law of Vietnam, “*an opposition action against a trademark application can be taken from the publication date of the application till the date when the registration/protection for such trademark is granted*”. In light of the foregoing provision, the due date for opposition under the laws of Vietnam is not a fixed deadline. In light of the foregoing provision, deadline for filing opposition against trademark applications in Vietnam is not a fixed one. Opposition can be filed at any time before the grant of protection for the trademarks. Hence, provided that the opposition is filed before the grant of protection for the trademarks, original POA can be submitted later, normally 1 month from the filing date of the opposition action.

10. Can KENFOX file an opposition in the name of our client in order not to disclose our name?

KENFOX: Any natural or juridical person may file a trademark opposition. Legal interest is not required. Thus, it is possible for KENFOX to file a trademark opposition in the name of other party in order not to disclose your name.

12. Can you provide us with any remarks in relation to an opposition in Vietnam?

KENFOX: The due date for opposition under the laws of Vietnam is not a fixed deadline. Practically, it is preferable to file the opposition within the substantive examination period, so that it can be well-considered before the Vietnam IP Office’s rendering any conclusion/ decision on the registrability of the opposed mark.

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*Should your clients be interested in IP protection in the above-mentioned jurisdictions, please feel free to **contact us**.*