

How to Successfully Argue Wide Use Evidence in Trademark Opposition and Cancellation Cases in Vietnam?

Trademark opposition and cancellation serve as crucial legal remedies for legitimate trademark owners to safeguard their intellectual property rights. In Vietnam, genuine trademark owners are entitled to employ their prior evidence of wide use to file a Notice of Opposition or a cancellation action against a trademark squatter. As such, it is critical to understand how National Office of Intellectual Property of Vietnam (**IP VIETNAM**) evaluates the evidence of prior use and the extent to which a mark must be used to succeed in an opposition or cancellation based on unregistered rights.

Facts:

A recent case that exemplifies the above mentioned principle is the cancellation action initiated against Registration No. 123570 (filing date: 24/12/2007) for the mark "MAINETTI" in Classes 20 and 35, owned by Cong ty TNHH Suntex (**Suntex**). Suntex faced a cancellation action based on the ground that Mainetti (UK) Limited had widely used the trademark "MAINETTI" prior to Suntex's filing date. Additionally, the true owner of the mark argued that "MAINETTI" is a distinctive trade name of their subsidiary company, which was established in Vietnam in 2003, and that the third party's claim that they created the mark was dishonest.

The evidence and arguments submitted to IP VIETNAM in support of trademark cancellation are those to prove the date when the trademark of the legitimate owner was first created and how it has been used since then, the countries where the mark is being protected, and the countries where the mark is being used, including those relating to use of the mark "MAINETTI" by MAINETTI (Vietnam) Co., Ltd., a Vietnam-based subsidiary of Mainetti (UK) Limited. All evidence was dated before the filing date of the mark "MAINETTI" filed by Suntex.

In its defense, Suntex argued that they never knew about the trademark "MAINETTI" of Mainetti (UK) Limited. However, the legitimate owner proved that Suntex's arguments were false. In the end, the case was settled in 2015 by a decision in favor of the real owner, and the validity of the mark "MAINETTI" under Registration No. 123570 was cancelled.

Key takeaways:

Evidence of wide use of a mark outside Vietnam

Article 74.2(g) of [Vietnam's IP Law](#) allows evidence of prior, wise use of a mark in commerce to serve as a basis for refusing, filing a Notice of Opposition against an applied-for mark or initiating a cancellation against a trademark registration. This provision disqualifies marks that are identical to or confusingly similar to a widely used and recognized mark for similar or identical goods or services before the filing date or priority date, as applicable. However, it remains unclear whether evidence of a mark's wide use and reputation outside of Vietnam is admissible in such cases. It is still a matter of debate whether the duration or length of use of a mark will impact IP VIETNAM's review and consideration of evidence related to a trademark's use.

In practice, IP VIETNAM has handled various cases in which evidence of wide use of an unregistered mark is required to win a case. While evidence of wide use of a mark outside Vietnam may carry some weight in an opposition or cancellation proceeding against a trademark filed or registered in bad faith, it is ultimately up to IP VIETNAM's discretion to determine whether to accept such evidence. Thus, the admissibility of evidence of wide use of a mark outside of Vietnam remains uncertain.

Proving malicious intent/bad faith of the trademark registrant

[Vietnam's amended IP Law of 2022](#) introduced the legal term "[bad faith](#)" into Articles 96 and 117 to address two main issues. Firstly, to close legal loopholes in the "first-to-file" principle, which grants protection titles to the earliest filed trademark applications, including those made in bad faith. Secondly, to combat trademark squatting, a growing trend in emerging economies like Vietnam. With the inclusion of the "bad faith" provision, legitimate trademark owners have an additional legal basis to challenge the

validity of a trademark filed or registered by a third party with malicious intent, in order to reclaim their trademark rights under opposition or invalidation proceedings. However, legal documents such as decrees and guiding circulars of Vietnam have not yet provided detailed elements, criteria, and requirements to determine whether a trademark has been filed or registered with bad faith. This lack of clarity may perplex genuine trademark owners attempting to prove the bad faith of the applicant.

When there is no direct evidence to prove that a third party was aware of the genuine trademark owner's mark and applied to register it in bad faith, the genuine trademark owner often relies on evidence of wide use to demonstrate that the adverse party could not have been unaware of the mark. However, the acceptance of this argument varies depending on the examiner responsible for the case. While some examiners may accept this argument, others may refuse it due to their individual viewpoints. Therefore, whether or not this argument is accepted depends on the subjective perspective of the examiner handling the case.

How wide a mark must be used in commerce

Vietnam follows the first-to-file principle for establishing intellectual property rights. However, if an applied-for trademark is deemed confusingly similar to a prior mark, even if unregistered, that has been widely used and recognized in commerce, registration will be refused. But there is no explicit provision in Vietnam's IP Law regarding how widely a mark must be used to prevent an adverse party's trademark application.

As such, there is no definitive answer to how widely a mark must be used in commerce to succeed in a trademark cancellation or opposition, as it depends on various factors such as the case's specific circumstances, applicable laws and regulations, and the examiner's awareness and knowledge. Generally, the mark should have significant and ongoing commercial use and recognition in the relevant market. The evidence of wide use must be abundant and strong enough to prove that the mark is widely used and recognized by consumers for similar or identical goods or services before the filing date of the challenged trademark application.

Factors such as the duration and frequency of use, the extent of sales, the market share of the mark, and the degree of recognition by relevant consumers or business partners are considered in evaluating the wide use of a mark. However, it is ultimately up to the discretion of the examiner or decision-maker handling the case to weigh the evidence and determine whether it meets the necessary threshold to win a trademark cancellation or opposition.

In practice, to provide wide use of mark, the trademark owner is advised to provide evidence based on the following criteria:

- (i) Invoices or sales records showing the volume and frequency of sales under the mark.
- (ii) Advertising and promotional materials used in connection with the mark.
- (iii) Customer feedback, surveys, or testimonials demonstrating the mark's recognition and reputation among relevant consumers.
- (iv) Distribution and marketing strategies and plans that highlight the use and promotion of the mark
- (v) Licenses or franchise agreements that show the use of the mark by other businesses.
- (vi) Media coverage or industry publications that feature the mark or discuss its reputation and recognition.
- (vii) Any relevant awards or recognitions received by the mark or the business using it.

How IP VIETNAM evaluates evidence of prior use in trademark opposition and cancellation cases

IP VIETNAM evaluates evidence of prior use in trademark opposition and cancellation cases by considering various factors such as the duration, intensity, and geographic extent of use. They may also consider the nature and scope of the goods or services on which the mark has been used and the level of recognition of the mark in the relevant market. In addition, IP VIETNAM may examine the quality of the evidence presented, including whether the evidence is reliable, relevant, and sufficient to establish the prior use of the mark in question.

IP VIETNAM also considers the distinctiveness of the mark, the similarity between the contested mark and the prior used mark, and whether the use of the contested mark is likely to cause confusion among

consumers. The trademark owner must demonstrate that the contested mark is likely to cause confusion, deception, or mistake among consumers, which is a key element in proving infringement of unregistered rights.

In summary, IP VIETNAM evaluates the totality of the evidence submitted by the trademark owner to determine whether the prior use of the mark was widespread, continuous, and significant enough to prevent the registration or to cancel the registration of a similar or identical mark.

Avoiding trademark theft in Vietnam

To avoid a risk that a mark is appropriated by a bad faith party, it is recommended that foreign trademark owners should take the following measures:

- (i) [Register your trademark](#) in Vietnam as soon as possible. This will help to establish a priority right in Vietnam and prevent others from registering a similar or identical trademark.
- (ii) Conduct regular trademark searches in Vietnam to monitor any unauthorized use of your trademark. This will help you detect any potential infringement early and take appropriate action to protect your rights.
- (iii) Consider applying for international registration of your trademark through the Madrid System. This will allow you to register your trademark in multiple countries, including Vietnam, using a single application.
- (iv) Enforce your trademark rights in Vietnam by taking appropriate legal action against any infringement or unauthorized use of your trademark.

How trademark owners collect and present strong evidence of prior use in opposition or cancellation proceedings

- **Keep detailed records:** Maintaining detailed records of the trademark's use, including the date of first use, geographical extent of use, and the scope of the products or services associated with the trademark, can be very helpful in establishing the extent and duration of use of the trademark.
- **Collect sales and marketing materials:** Collecting sales and marketing materials, such as brochures, advertisements, and promotional materials, can help demonstrate the extent and duration of the trademark use.
- **Gather witness testimony:** Witness testimony from individuals who have knowledge of the trademark use, such as employees, customers, and industry experts, can be a powerful tool in establishing prior use.
- **Conduct a trademark watch:** Regularly monitoring the use of the trademark in the marketplace and taking appropriate enforcement action against infringers can establish the trademark's prior use and the owner's willingness to protect their rights.
- **Use of third-party evidence:** In addition to their records, trademark owners can gather third-party evidence of the trademark's prior use, such as news articles, industry reports, and customer feedback.
- **Conduct a survey:** Conducting a consumer survey to show the level of recognition and association of the trademark with the goods or services in question can be strong evidence of prior use.
- **Work with a trademark attorney:** Working with a trademark attorney who is familiar with the laws and procedures of the relevant jurisdiction can be invaluable in developing a strategy for collecting and presenting strong evidence of prior use.

The bottom line:

In conclusion, providing strong and abundant evidence of wide use of a trademark is crucial in succeeding in trademark opposition and cancellation cases in Vietnam. Legitimate trademark owners must understand how IP VIETNAM evaluates the evidence of prior use and the extent to which a mark must be used to win the case. By carefully preparing and presenting convincing evidence and arguments, legitimate trademark owners can effectively protect their intellectual property rights in Vietnam.

**By Nguyen Vu QUAN
Partner & IP Attorney**