

Opposing an Application Mark without prior rights in Vietnam, is it possible?

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Introduction

You became aware that a third party had applied to register a mark in Vietnam which is strikingly similar to yours. Although you lack prior intellectual property rights in Vietnam, you wish to prevent such a similar mark from maturing into registration and would like to know whether a Notice of Opposition can be filed in this situation. The question on the availability of the right to oppose the registration of an Application Mark is critical for IPR holders, particularly those seeking to file a trademark opposition but lacking prior rights. The answer is yes, but only where appropriate.

Opposition grounds

As a matter of law and practice, to prevent registration of an Application Mark in Vietnam, one may consider filing a Notice of Opposition with the IP Office of Vietnam ("IP Vietnam"). A trademark opposition in Vietnam may be based on (i) **absolute grounds** (i.e. an application mark contains/comprises signs excluded from registration (e.g. generic terms, descriptive signs, deceptive signs, immoral signs, etc.) and (ii) **relative grounds** (i.e. similar to a prior right (e.g. a prior trademark, industrial design, and/or copyright).

Absolute grounds for trademark opposition

Without a prior right as a ground for opposition in Vietnam, it is obvious that a Notice of Opposition, if filed, must be predicated on absolute ground/s. You may file an opposition based on any of the absolute grounds specified in Articles 73.5 and 74.2 (a, b, c, d, and dd) of the Vietnam Intellectual Property Law. Hereunder are several noteworthy points which should be taken into account if you decide to oppose a mark based on absolute grounds.

Whether an Application Mark contains/is made up of "Generic term/s"?

A generic term is one that is understood by the relevant public to be the common name for the goods or services. A generic term does not qualify for trademark protection because it can not serve its essential distinguishing function, or in other words, can not function as a source indicator to distinguish the goods or services from members within the class, and thus its registration should be refused. The law does not allow an individual/entity to claim as its proprietary mark a generic term, that is, a word that identifies the type of product/ service involved.

A sign is generic when it identifies the category or type of goods/service. It is critical for both the trade and consumers that no one be permitted to monopolize such a generic term. Marks which has become so widely used (e.g. "**Aspirin**" for the pain relievers or "**Vaseline**" for the cosmetics or "**Thermos**" for beverage containers, etc.) and lost their ability to brand will be deemed generic terms and may be a ground for opposition if such marks are applied for registration.

A generic sign is completely devoid of distinctiveness; even if it has been used extensively and may have acquired a secondary meaning, it cannot be registered because it cannot be monopolized in light of the trade's absolute need to be able to use it. In line with the aforesaid principle, a Latin-origin character that is a meaningful word, the meaning of which has been so frequently and widely used in a relevant field in Vietnam that it loses its distinctiveness is deemed indistinctive to be eligible for trademark registration (*See Rule 39.3(d) of Circular No. 01/2007/TT-BKHCN, as revised*). In addition, a word or phrase that is used in Vietnam as the

common name of the very related goods or service is ineligible for trademark registration (See Rule 39.3(e) of Circular No. 01/2007/TT-BKHCHN, as revised)..

FYI! Secondary meaning implies that the mark has acquired distinctiveness among consumers or the mark has transcended the literal meaning itself to become associated with the source.

1. IP Vietnam refused registration for the mark “Vaseline” for cosmetics applied by UNILEVER because the term “**Vaseline**” is deemed a generic name widely used to denote a petroleum jelly, thus, not eligible for trademark registration. UNILEVER appealed this refusal by providing multiple documents proving that the sign “Vaseline” has been widely used since 1872 and has been protected in many countries before applying for registration in Vietnam. However, IP Vietnam upheld its refusal, adding that in the English - Vietnamese dictionary published in Vietnam, the word "vaseline" is used to denote a petroleum jelly and that the terms “vaseline” is protected in foreign countries does not mean that it will have to be protected in Vietnam.
2. In a recent trademark case, IP Vietnam refused protection for the figurative element “



in a composite mark, stating that the device has been widely used and known by the relevant public for the cosmetics products.

Whether an Application Mark contains/is made up of “Descriptive term/s”?

In general, a mark is considered merely descriptive if it describes a function, feature, purpose, use, quality, characteristic or ingredient of the goods or services identified in the trademark application.

Rule 39.3(g, h) of Circular No. 01/2007/TT-BKHCHN (as revised) provides that a sign that describes [the very goods or service bearing the mark, such as a sign indicating time, location, geographical origin (except when the registered mark is a mark certifying the geographical origin of a goods or a collective mark), method of manufacture, type, quantity, quality and characteristics (except when the registered mark is a mark certifying the quality of a goods or service), composition, utility and value of a goods or service] and/or [the legal status or business lines of the mark proprietor] cannot function as a trademark because it will not be recognized as a distinct element indicating a commercial origin different from competing goods or services of different manufacturers/suppliers.

In trademark examinations in Vietnam, for word marks, Vietnamese examiners only conduct substantive examinations based on prior marks made up of words in common languages. In Vietnam, common languages officially recognized by IP Vietnam comprise 3 languages, i.e. (i) Vietnamese, (ii) English and (iii) French. That being said, the words/phrases in uncommon languages such as German, Spanish, or Italian are not the minimum source of information that examiners must conduct searches. As such, it is interpreted that words/phrases in uncommon languages, such as German, Spanish, Italian, etc., may be accepted for registration as trademarks, even if such words/phrases carry meanings descriptive of the claimed goods/services. This is due to the fact that local consumers may not understand the descriptive meaning of such uncommon languages.

However, under recent trademark examination principles/practices introduced/adopted by IP Vietnam, for word marks made up of foreign scripts and transliterations, keep in mind that a Vietnamese examiner will examine foreign script marks by applying the general standards of "descriptiveness". If IP Vietnam's examiner, for any reason, comes to know that a mark comprising words/phrases in the above uncommon languages is deemed descriptive of the claimed goods/services, such a mark (i) will be only registered if it contains other distinctive elements with the descriptive words/phrases being disclaimed, or (ii) will be refused registration under Article 74.2 (c) of Vietnam IP Law if it does not contain any other distinctive elements.

In case the words/phrases in uncommon languages and do not belong to Latin-origin language, but they are represented in identical form of Latin language which Vietnamese consumers can recognize and memorize, e.g. the word “ABPOPA” (in Russian, it is pronounced as “AVRORA”), if in the trademark application:

- (a) The applied-for trademark merely contains this word (e.g. “ABPOPA”) and is described as a word/phrase belonging to Slavic languages, the trademark application will be refused protection

under Article 74.2(a), Vietnam IP Law. In detail, such a word “ABPOPA” is deemed as a word in uncommon languages.

- (b) The applied-for trademark contains this word (e.g. “ABPOPA”) and is described as a word/phrase belonging to Slavic languages, but it is in combination with other distinctive element, such a trademark will be accepted for registration with the word (e.g. “ABPOPA”) being disclaimed

FYI! A descriptive mark can be accepted for registration because of carelessness/oversight of the examiner. A word looks like a coined name at the outset, but a deep search may uncover that it is descriptive of goods claimed thereunder. The mark “**BEVIGENE**” is an illustrative example. This trademark was applied for registration by a Vietnamese company for pharmaceutical preparations in Class 05 and should have been refused for protection, but surprisingly, it was allowed for registration in Vietnam. We have conducted various internet searches and found that “BEVI” is actually the name of a gene. Information on the “BEVI” gene is found in some websites below:

- ✓ See [[https://www.cell.com/fulltext/0092-8674\(78\)90353-7](https://www.cell.com/fulltext/0092-8674(78)90353-7)]: *The results confirmed that a gene, **Bevi**, previously assigned to human chromosome 6, dominantly controls baboon type C virus expression in hybrid cells*].
- ✓ See [<https://pubmed.ncbi.nlm.nih.gov/198140/>]: *A new genetic locus, **Bevi**, on human chromosome 6 which controls the replication of baboon type C virus in human cells*].
- ✓ See [<https://pubmed.ncbi.nlm.nih.gov/222543/>]: *The Bevi locus (chromosome 6) encodes a post-penetrational cellular function required for baboon endogenous virus replication in human cells*].

From the foregoing, the mark “BEVIGENE” is actually a combination of the name of a gene “BEVI” and the word “GENE” which is a basic physical and functional unit of heredity and a sequence of nucleotides in DNA. In this regard, the cited mark “BEVIGENE” is apparently descriptive of the goods in Class 05.

The above case is a clear indication that a thorough search for an Application Mark should be conducted to determine whether it is a coined or a meaningful name to assess a prospect of winning a trademark opposition. If the name is meaningful, you should determine whether it is deemed descriptive (in any foreign languages) of the designated goods/services under the Application Mark for the purpose of filing an opposition.

Whether an Application Mark merely describes geographical origin?

A sign capable of indicating a product's or service's geographical origin is one that contains a geographical name or a figurative element indicating a geographical origin (for example, national emblem; symbol of a region/area; map of a region/area, etc...).

When should you oppose an Application Mark containing a geographical sign? An opposition should be filed in the circumstances where an Application Mark contains geographical signs which are prohibited from registration specified under Rule of Trademark Examination issued by IP Vietnam as follows:

- (i) A sign contains merely the geographical name or the geographically indicative figurative element (figurative geographical element); or, a geographical name or a geographically indicative figurative element is more prominent than other elements (*including where the remaining elements of the sign are of little or no distinctiveness*); or, a geographical name or a geographically indicative figurative element stands separately and prominently as an independent constituent of the mark.
- (ii) The above-mentioned geographical name or geographically indicative figurative element coincides with a geographical name or or a geographically indicative figurative element respectively of Vietnam and other countries. The administrative geographical names mentioned here refer to the district level or higher. It may also refer to a lower level geographical name such as commune, village, hamlet, etc. if the lower level geographical names have a reputation for respective products and services.
- (iii) Verbal signs coincide with foreign geographical names which are widely known or listed in common dictionaries related to geographical names (Larousse, Longman, etc.) or are widely known through information sources from the INTERNET.

FYI! IP Vietnam recently specified geographical term-based trademark application. In order for examiner to determine whether a geographical name is a sign indicating the geographical origin of the claimed goods/services, an examiner needs to assess the relationship between the claimed goods/services and geographical location as stated in a trademark application.

- (a) If the geographical name and the claimed goods/services are (i) unrelated or (ii) related but the geographical name no longer indicates its geographical origin, the geographical name shall not be deemed a badge of origin of those claimed goods/services. That said such a geographical name is entitled to be protection as a trademark
- (b) If the geographical name and the claimed goods/services have an unclear relationship, (i) the geographical name would be evaluated from the district level upwards, and (ii) the relationship between the applicant's address and the area bearing this geographical name must also be considered. If the applicant's address is included in such a geographical name, the trademark that employs such geographical name will be protected as a whole with such geographical name being disclaimed. If the applicant's address is not included in such a geographical name, such a geographical name in the applied-for trademark will be refused protection.
- (c) Where the geographical name and the claimed goods/services have a close relationship, the mark bearing the geographical name shall be refused protection, regardless of the administrative level of the geographical name.

Whether an Application Mark contains/is made up of "Deceptive term/s"?

Signs that cause consumer confusion or mislead them about the origin, properties, use, quality, value, or other characteristics of goods or services are not eligible for registration under Article 73.5 of the Vietnam Intellectual Property Law. To prevail on the "deceptive" ground, you must establish that the connotation (contained in the trademark, its use in relation to nominated goods or services that is deemed to deceive or cause confusion) is derived from the trademark itself, that the deception is obvious and direct, and that there is an immediate danger of being misled by the trademark.

If you can demonstrate that there is a reasonable risk or likelihood that the consumer will be deceived or misled as a result of the mark's use in commerce, you may oppose on the "deceptive" ground. A careful examination of the list of goods and services bearing the mark must be conducted to determine whether, when applied to the designated goods/services, the sign is deceptive or misleading to the relevant consumers. Practice indicates that depending on the list of goods/service, a trademark application may be distinctive for some, descriptive for others and/or deceptive for still others.

Conclusion

The above has clarified the question of this article. In brief, blocking registration of an Application Mark without prior rights in Vietnam is possible. The likelihood of success is determined by whether you can establish that the Application Mark falls into scenarios where it is deemed (i) generic, (ii) descriptive, (iii) geographically descriptive and/or (iv) deceptive.