

Vietnam IP News Bulletin

Kenfox IP & Law Office

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TRADEMARK CANCELLATION PROCEEDINGS (INVALIDATION ACTIONS) IN VIETNAM

1. Are trademark cancellation proceedings as invalidation actions filed before the Vietnam IP Office or any other body?

KENFOX: Article 95 and 96 of the IP Law of Vietnam. Trademark cancellation proceeding is carried out under a cancellation procedure before the Vietnam IP Office, which is the agency that granted the trademark registration.

2. Whether trademark cancellation proceedings as invalidation actions are filed in a Vietnamese Court?

KENFOX: The trademark invalidation is not subject to the court's jurisdiction. Trademark cancellation proceeding is firstly carried out at the Vietnam IP Office, which is the agency that granted the trademark registration. After the Vietnam IP Office's Decision on the trademark cancellation is issued, if the concerned party does not agree with such Decision, in conformity with Article 14 of Decree No. 103/2006/ND-CP, it can bring the case to a competent Vietnamese court.

3. Can any person file a trademark cancellation proceeding as invalidation actions with the Vietnam IP Office?

KENFOX: Article 96.3, the IP Law of Vietnam. Any natural or juridical person may file a trademark cancellation proceeding. Legal interest is not required

4. Is special legal interest necessary to file a trademark trademark cancellation proceeding as invalidation actions in Vietnam?

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

5. Is there any exclusion period for cancellation proceedings as invalidation actions in Vietnam?

KENFOX: Under Article 96.3, the IP Law of Vietnam, the statute of limitations for filing invalidation action against trademark registrations shall be 5 years from the granting date of the trademarks, except where such trademark registration was obtained on dishonesty or bad-faith of the applicant.

6. Does exclusion period for cancellation proceedings as invalidation actions depend on the grounds?

KENFOX: Article 96 of the IP Law of Vietnam. Yes, the exclusion period for cancellation proceedings depend on the ground based on which the cancellation proceedings is initiated. In details:

- Any time within the validity of the trademark registration in case the invalidation is made on ground of bad faith.
- 5 years from the granting date of the trademark registration in case the invalidation action is made on ground of the trademark's failure to meet protection requirements.

7. What is the exclusion period for each ground under the laws of Vietnam?

KENFOX: Article 96 of the IP Law of Vietnam. As mentioned above, only in case of a trademark cancellation proceedings based on the applicant's dishonesty/bad-faith which the statute of limitations is the whole term of the trademark protection, for other grounds for a trademark cancellation proceedings, the statute of limitation is 05 years from the grant date.

8. Does examiner hold up examination for pending application until a cancellation decision against the conflicting citation is issued under the laws of Vietnam?

KENFOX: In principle, the prosecution of trademark applications, and proceeding of invalidation are two separate procedures. Hence, the examiner is not obliged to hold the examination of the pending applications until the decision on the invalidation case is issued. 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 decision on the invalidation case to be issued.

9. Is it possible for KENFOX to file trademark cancellation proceedings as invalidation actions in the name of other party in order not to disclose our name?

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

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