



## How is Goods/Service Relatedness Significant for Trademark Registration in Vietnam?



*The nature of goods/services is one of two prerequisite factors (together with trademark itself) in determining the registrability of an applied-for mark. Before applying for a trademark registration, it is important to consider the goods or services that the trademark will be used for. Through a practical trademark case that KENFOX IP & Law Office has successfully overcome the provisional refusal issued by the Intellectual Property Office of Vietnam (IP VIETNAM), this article will explore the concept of goods/services relatedness and its importance in the trademark registration process in Vietnam. The factors that determine whether two goods or services are considered related or not, and how these factors are applied in practice will be delved into.*

**Facts:**

Various trademarks applied for registration in Vietnam were refused registration due to alleged similarity in both trademark themselves and the goods/services associated with them. While determining whether a later-filed mark is confusingly similar to a prior mark may not be overly complicated, analyzing the similarity of the goods/services associated with these marks requires careful consideration. So, an experienced trademark attorney will prioritize demonstrating relatedness of the goods/services bearing the marks in question in order to overcome a provisional refusal against an applied-for trademark that may initially appear similar to a prior mark. To illustrate this, please see a provisional refusal issued by IP VIETNAM with particulars below:

Trademark /Class	Applied-for mark 	Cited mark 
09	Downloadable electronic publications, namely, guides to travel, accommodation, cities, the countryside, the sea, rivers, lakes, sightseeing and cultural activities; downloadable computer software for travel and holiday planning and booking of travel and temporary accommodation.	Downloadable music files; electronic <b>publications</b> , downloadable; electronic books, downloadable; data processing apparatus; audio- and video-receivers; pre-recorded music electronic media; apparatus for the recording, transmission and reproduction of sound and images; computer application software for mobile phones; computer game programs; pre-recorded non-musical electronic media.
35	Advertising; Business management, business administration; office functions; the bringing together, for the benefit of others, of writing implements, photographs, stationery, diaries, calendars, personal organisers, posters, writing instruments, decalcomanias, playing cards, maps, games and playthings, clothing, footwear, headgear, gymnastic and sporting articles, travelling bags, umbrellas, enabling customers to conveniently view and purchase those goods in travel stores;  the bringing together, for the benefit of others, of writing implements, photographs, stationery, diaries, calendars, personal organisers, posters, writing instruments, decalcomanias, playing cards, maps, games and playthings, clothing, footwear, headgear, gymnastic and sporting articles, travelling bags, umbrellas, enabling customers to conveniently view and purchase those goods in a travel catalogue by mail order or by means of telecommunications;	Auctioneering; <b>rental of advertising space and advertising material; advertising agencies;</b> creating and updating <b>advertising material;</b> publication of publicity texts; marketing services; providing business and marketing information; public relations; marketing research; dissemination of advertising for others via the Internet; providing an on-line commercial information directory on the Internet; compilation of information into computer databases; on-line advertising on a computer network; data search in computer files for others; sales promotion for others.

	consultancy services relating to the acquisition of goods and services; business advisory and information services; provision of trade, business, economic information; business research services; compilation and provision of business information; dissemination of business information relating to financial markets.	
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IP VIETNAM declined the registration of the requested trademark due to purportedly confusing similarities between the figurative elements of both the requested mark and a prior mark (denoted as "" and ""), as well as similarities between the goods/services listed in the same classes (09 and 35).

**What actions have been taken to overcome IP VIETNAM's refusal?**

To prove that a finding of confusion has not been established, KENFOX team utilized a comprehensive approach to analyze and distinguish the applied-for mark from a prior mark, focusing on various trademark properties such as trademark constituents, connotation, and commercial impression. However, our efforts did not stop there. We went above and beyond in analyzing the differences between the goods/services associated with both marks, even after the client agreed to delete some of the highlighted goods and services in Classes 09 and 35. With a thorough and convincing demonstration of the unrelatedness of the goods/services, despite being classified in the same class, IP VIETNAM ultimately agreed to withdraw its refusal and issued a statement of grant of protection for our client's marks.

**Some key takeaways**

**Trademark examination in Vietnam**

In some jurisdictions, people might argue that the above-mentioned trademarks are not similar. However, in Vietnam, when it comes to composite marks, examiners tend to divide trademarks into two distinct elements - the figurative element and the verbal element - to evaluate their registrability. This approach often leads to overly strict and unnecessary refusals of trademarks, causing frustration for businesses seeking to protect their brand. By focusing solely on the figurate or verbal aspects of a trademark, examiners may overlook the overall impression and distinctiveness that a trademark can convey. This narrow approach to trademark examination may limit the availability of trademarks in the market and prevent businesses from effectively distinguishing themselves from their competitors. However, proponents of this practice argue that it helps ensure that only truly distinctive marks are registered, preventing confusion among consumers and protecting the integrity of the trademark system.

**Goods/services relatedness in examining trademark registrability in Vietnam**

In order to determine whether a sign sought to be registered and stated in a trademark application is identical or confusingly similar to another mark ("the cited mark"), an examiner is required (i) to compare such sign to the cited mark(s) and at the same time (ii) to compare goods or services bearing such sign to those bearing the cited mark(s). A finding of likelihood of confusion may be established if the following two conditions are fully met:

- [A sign is identical or confusingly similar to the cited mark.](#) In detail, the examiner in Vietnam examines the similarity or dissimilarity of the sign/mark(s) in their entirety as to appearance, pronunciation, connotation, etc. Under the laws, if similarity is found in either appearance, pronunciation or connotation, the trademark is found similar to the prior mark.
- [Goods or services bearing an applied-for mark is identical or similar/related to the protected goods or services claimed under a prior mark.](#)

In [trademark substantive examination process in Vietnam](#), if an applied-for trademark is deemed confusingly similar to a prior mark, the examiner shall assess similarity/relatedness of the goods/services bearing the

marks in question to determine whether a finding of confusion should establish to allow or reject protection of the applied-for trademark. Thus, goods or services do not have to be the same or even competitive and still there can be a likelihood of confusion.

In the above case, IP VIETNAM issued a provisional refusal against the applied-for mark based on the contention that there exists a high level of similarity between the figurative element of both the applied-for mark and a prior mark (denoted as " " and " "), as well as similarities between the goods/services listed in the same Classes 09 and 35. According to IP VIETNAM, this likeness creates a likelihood of confusion regarding the commercial origin of the goods/services in question. In Vietnam, similarity/relatedness of the goods/services is assessed in compliance with Point 39.9, [Circular No. 01/2007/TT-BKHCHN](#), as revised. In detail:

[Point 39.9. Assessment of similarity of goods and services:

a) **Two goods or two services** shall be considered **identical** (of the same type) if these two goods or services have the following characteristics:

(i) *They have the same nature (composition, ingredients) and the same function and utility; or*

(ii) *They have similar natures and the same function and utility;*

b) **Two goods or two services** shall be considered **similar** if these two goods or services have the following characteristics:

(i) *They are similar in nature; or*

(ii) *They are similar in function or utility; and*

(iii) *They are marketed in the same commercial channel (they are distributed by the same mode, or sold together or compete with each other in the same type of shop...);*

c) **A goods and a service** shall be considered **similar** if they fall into one or several of the following cases:

(i) *They have a correlation in nature (a goods or service or a material or component of a goods or service forms constitutes part of the other); or*

(ii) *They have a correlation in function (to accomplish the function of a goods or service, it is necessary to use the other or they are usually used together); or*

(iii) *They have a close correlation in method of realization (a goods or service is the result of the use or exploitation of the other)].*

In evaluating the relatedness of goods or services, the more similar the trademarks are, the less related the products or services need to be to cause a probability of confusion. This principle was demonstrated in Rule 23, Regulation on Trademark Examination in Vietnam, implying that [*An applied-for trademark may be deemed similar to a prior mark, but if the former is applied for the designated goods/services which are quite remote/far from those claimed under the cited mark, likelihood of confusion may not occur*].

Following Point 39.9, Circular No. 01/2007/TT-BKHCHN, an examiner in Vietnam also assesses how consumers are encountering the goods/services in the marketplace (*i.e. marketing practices*) to determine a likelihood of confusion. In other words, if consumers encounter the goods/services and mistakenly believe they share a common source, affiliation, or connection, the marks will be considered confusingly similar. The specified goods/ services play a crucial role in determination of the similarity during the trademark examination in Vietnam. In fact, it is commonly held that confusion is likely where there are similar marks and one mark is for goods and the other is for a service related to those goods. E.g. An applied-for mark "XYZ" for "*Wholesale and retail store services featuring motorcycles and their parts and accessories*" in Class 35 may be held likely to cause confusion with a prior mark "ZYX" for "*motorcycles and their parts and accessories*" in Class 12. Similarly, the "*alcoholic and non-alcoholic beverages*" in Class 32 and 33 may be deemed similar/related to "*food and drink catering services*" in Class 43. As a result, marketing practices are also considered by the examiner to assess whether the public will be confused as to the commercial source of the goods/services.

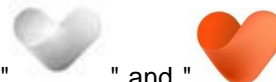
Conversely, if consumers do not encounter the products or services in the marketplace, then even if the marks are identical/confusingly similar, no likelihood of confusion exists. Similar/ identical signs can still be registered, provided that the goods and/or services applied for are unrelated to the ones covered by earlier similar/ identical trademarks. E.g. An applied-for mark "XYZ" for "*Pharmaceutical preparations*" may be held unlikely to cause confusion with a prior mark "ZYZ" for "*Plant Protection Preparations*" although they fall in the same Class 05.

In light of the foregoing, NICE Classification is not the only basis for the examiner in Vietnam to assess similarity/relatedness of the goods/services bearing the marks.

As the above case exemplifies, how the goods and/or services bearing this trademark are deemed related/relevant to those under an earlier mark is very important to determine registrability of similar [trademarks in Vietnam](#). Whether Nice Classification is the only basis for making an assessment on relatedness/relevance of the goods/services bearing trademarks? Of course, it is not.

### Final thoughts

IP VIETNAM has issued a provisional refusal for the applied-for mark, citing similarities between the figurative



elements of both the applied-for mark and a prior mark (referred to as " " and " ") as well as similarities in the goods/services listed in Classes 09 and 35. IP VIETNAM believes that this similarity could cause confusion among consumers regarding the commercial origin of the goods/services in question. While the two marks share a similar element, what important is obviously to focus analysis on unrelatedness of the goods and services bearing those mark in order to prove that one condition for establishing a finding of confusion between the two marks is not satisfied. To this end, it is required to delve into the nature (composition, ingredients) and the function and utility of the goods/services bearing those marks. Only when this distinction is deeply analyzed, can IP VIETNAM's examiner find it satisfactory that the goods/services are, to some extent, similar but they are "far/remote" enough to avoid likelihood of confusion to consumers. Therefore, sharp arguments on relatedness/non-relatedness are significant in winning a trademark refusal or opposition/invalidation action in Vietnam.

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