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Guideline for handling outstanding appeals against disclaimers imposed by IP Vietnam

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- **IP Vietnam has updated its rules on filing appeals against disclaimers in notices of grant**
- **Notification 3280/TB-SHTT provides guidance on filing appeals against disclaimers made by IP Vietnam, which were submitted before 15 January 2018 and remain unresolved**
- **This demonstrates that IP Vietnam wishes to clear up outstanding issues for trademark owners in applying for trademark registration in Vietnam**

Following the entry into force of Circular 16/2016/TT-BKHCN on 15 January 2018, which amended Circular 01/2007/TT-BKHCN (14 February 2007) of the Ministry of Science and Technology on industrial property registrations and related procedures, on 26 February 2020 the Intellectual Property Office of Vietnam (IP Vietnam) issued Notification 3280/TB-SHTT. The notification provides guidance on filing appeals against disclaimers made by IP Vietnam, which were submitted before 15 January 2018 and remain unresolved.

A trademark is often registrable as a whole, but one or more specific elements of the mark may be generic, descriptive or in any other way not eligible for protection on their own. In this case, IP Vietnam states in its notice for granting registration for the entire mark that these elements are not protected separately. In other words, it includes a disclaimer.

Previously, if an applicant disagreed with this disclaimer, they were not able to respond or object to it because of a lack of regulations on the procedure for doing so. They therefore had to either:

- allow the applied mark to expire by not paying the registration fee; or
- temporarily accept the notice of grant, pay the fee to register the entire mark and subsequently appeal with regard to the content in the disclaimer.

The amendment in Circular 16, which came into effect on 15 January 2018, allows the applicant to raise objections against disclaimers within three months of the date of receiving the notice of grant.

A number of appeals filed against disclaimers before 15 January 2018 are still pending before the trial board due to a lack of guidance. IP Vietnam issued a new guideline on the procedures for handling these appeals in order to address the situation, which is summarised below.

First, the board will issue a notification to the applicant to refuse to handle the filed appeal if it has not been accepted for handling or reject the appeal if it has been accepted for handling but not yet resolved. In this notification, the board will allow the applicant to carry out one of the two actions below within three months:

- accept the disclaimer by paying the registration fee; or
- file an objection, which will be handled by the Trademark Examination Centre.

When processing these objections, the centre will conduct the re-examination of the application with regard to the disclaimer, which is as follows:

- if the applicant's objection is accepted, it will issue a new notice for granting registration for the mark in which the disclaimer is removed; or
- if the objection is rejected, it will render a new notice for granting registration, upholding the original disclaimer. If the applicant eventually agrees with IP Vietnam's opinion, it will pay the granting fees. Otherwise, IP Vietnam will issue a refusal to protect the mark.

The new procedure demonstrates that IP Vietnam wishes to clear up outstanding issues for trademark owners in applying for trademark registration in Vietnam. Applicants of nationally filed applications will also find this an advantage as compared to applying for registration in Vietnam under the Madrid system. Currently, when filing under the Madrid system, international registration holders may not be notified of any disclaimer that IP Vietnam includes, nor do they have the opportunity to respond to it.

Thanh Tran

IPMAX Law Firm

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