

**Important changes to trademark-related procedures before NOIP;
applicants set to benefit**
Vietnam - IPMAX Law Firm

IP offices
Examination/opposition
Registration
Cancellation
National procedures

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- **New circular introduced important changes to trademark-related procedures before NOIP**
- **Applicants now have longer time periods to respond to office actions**
- **New facts and evidence shall not be accepted during appeal procedure**

Effective as of January 15 2018, Circular 16/2016/TT-BKHCN (dated June 30 2016) of the Ministry of Science and Technology, amending Circular 01/2007/TT-BKHCN (dated February 14 2007), introduced important changes to trademark-related procedures before the National Office of Industrial Property (NOIP).

Some of the most significant changes are summarised below:

1. Time limit for responding to office actions - applicants are now given longer time periods to respond to office actions. Particularly, the time limit for responding to an office action regarding a formality examination has been extended from one to two months, with a possible extension of two further months. Similarly, the time limit for responding to an office action regarding a substantive examination has been extended from two to three months, with a possible extension of the same period.
2. Withdrawal of applications - it is now clearly stated that, if an applicant withdraws an application, it will no longer be able to revive such application in the future.
3. Right to object to disclaimers - previously, an applicant did not have the opportunity to object to a disclaimer made by the NOIP when granting the registration of a mark. An applicant is now entitled to file an objection against such a disclaimer within 90 days of the date of the NOIP's decision.
4. Consideration of new facts and evidence - applicants are allowed to submit new facts and evidence to overcome a refusal by the NOIP after a substantive examination. The NOIP may then withdraw the refusal and re-examine the application taking into account the newly submitted facts and evidence. However, the amended circular now clearly states that new facts and evidence shall not be accepted during the appeal procedure.
5. New procedures for handling appeals - when handling complicated appeals, the NOIP may now decide to consult independent experts or set up an advisory panel. The NOIP may also hold dialogues during which the parties may present arguments to the NOIP or the advisory panel.
6. Right to be informed of the result of the examination of an opposed application - previously, the NOIP was under no obligation to provide the opponent with the result of the examination of the opposed application, but it did have to inform the opponent of the result of the examination of the opposition. Now, in addition to notifying the opponent of the opposition's result, the NOIP will have to provide the opponent with the details of the examination of the opposed application.
7. Right of Madrid registration holders to file a response to a provisional refusal before the appeal process - previously, if a Madrid registration was provisionally refused, the registration holder was entitled to file an appeal with the NOIP, which was handled by the NOIP's Trial Board. Now, before such appeal stage, the registration holder may first file a response to the NOIP, which shall be handled by the Geographical Indication Division – that is, the division that actually conducted the substantive examination of the Madrid registration. With this new provision, Madrid registration holders now have equal opportunities with national application holders in overcoming a refusal by the NOIP. The only difference is that Madrid registration holders have 90 days, instead of 60, to file a response; this is justified by the fact that Madrid registration holders need more time to find a local agent and provide it with a proper power of attorney to handle the case.
8. Time limit to send notice of a cancellation action - within one month of the date of receipt of a request for the termination or cancellation of a trademark registration, the NOIP must notify the holder of the trademark registration. Such time limit was not previously specified, leading to some delays in the handling of requests for termination/cancellation at the NOIP.

9. Recognition of well-known trademarks - a mark can now be recognised as well known through a decision of the NOIP in infringement, appeal, cancellation or opposition cases, and shall then be added to the list of well-known marks maintained by the NOIP. Previously, well-known trademarks could be recognised only by a court decision and, in theory, by a decision of the NOIP to record a well-known mark. However, no such decision had been made by the NOIP in the absence of detailed guidance for handling requests for the recordal of well-known marks.

Following the entry into force of the amendments, the NOIP has been working hard to adopt changes with regard to related forms and internal procedures. It is expected that these improvements will be very beneficial to trademark applicants.

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