

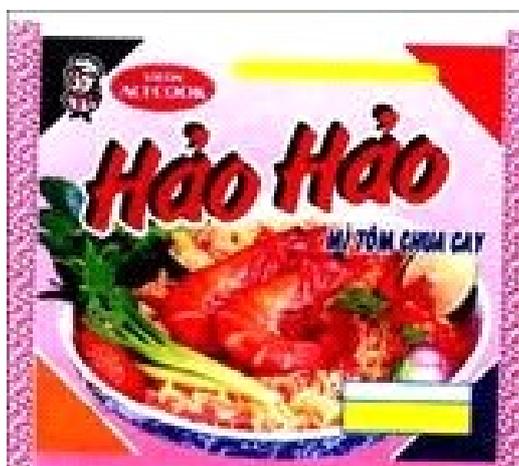
Modified trademark can defeat non-use claim Vietnam - IPMAX Law Firm

April 22 2016

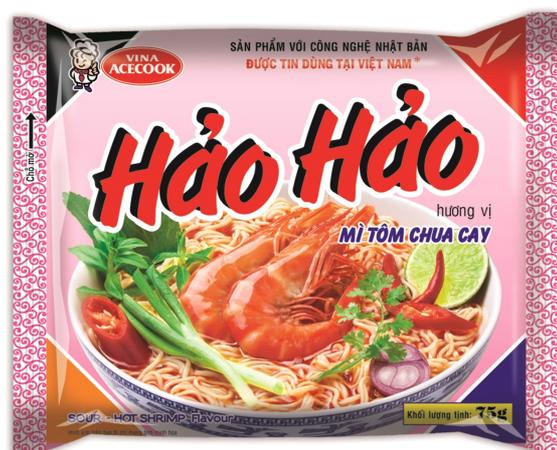
The National Office of Intellectual Property of Vietnam (NOIP) has recently rejected a non-use cancellation action sought against a registered mark, holding that use of a mark by the owner in a slightly modified form is sufficient to maintain registration of the mark.

Under Article 95 of the Intellectual Property Law, a trademark registration may be cancelled at the request of a third party if the mark has not been used by its owner or its licensee without justifiable reasons for five consecutive years prior to the request for cancellation for non-use, except where use of the mark has commenced at least three months before the request for cancellation for non-use.

Trademark Registration 62360 for Hao Hao Instant Noodle packaging design – as shown below – was subject to a request for cancellation for non-use.



In defence, the owner of the mark, Acecook Vietnam, filed evidence of use of the mark as presented below:



This mark differed from the mark as originally registered in that:

- it featured the word element 'Vina Acecook' in the oval device in the top-left corner of the packaging instead of 'Vifon Acecook' as in the registered mark. In fact, 'Vina Acecook' was the abbreviation of the new trading name of the trademark owner; and
- some figurative elements – including images of the onion, the coriander leaves and the red pepper – were represented slightly differently from the registered mark.

In its decision, NOIP upheld the arguments of the trademark owner that the slight modification of some

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minor descriptive elements did not alter the general impression and distinctive character of the mark, and that its function of identifying the origin of goods had been maintained.

However, because the word element 'Vifon' did not appear in the trademark in use, NOIP decided to partially cancel the registration with respect to a part of the mark, namely the 'Vifon' word element.

The current trademark law has no provision explaining whether use of a registered mark in a modified form will be sufficient. Thus far, it has been generally understood that use of a trademark must be in the form in which it was originally registered to be acceptable as trademark use.

Vietnam has been a member of the Paris Convention for the Protection of Industrial Property since 1949. According to Article 5C(2) of the Paris Convention, use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.

NOIP's approach is in accordance with the Paris Convention. The remaining question is how far the mark in use can differ from the registered mark. For trademark owners, it is always advisable to consider registering modified versions of their registered trademarks.

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