

You are in preview mode

DISABLE PREVIEW MODE



16 Dec
2019

Vietnam to amend Intellectual Property Law to comply with FTAs

Vietnam - [IPMAX Law Firm](#)

- **The Ministry of Science and Technology has issued proposed amendments to the Intellectual Property Law**
- **One of the aims is to bring the national legislation into line with the CPTPP and the EVFTA**
- **Among other things, the proposed amendments clarify the grounds for revocation in accordance with Article 12.22.3 of the EVFTA**

Pursuant to the amendments to Vietnam's Intellectual Property Law in June 2019, in mid-September 2019 the Ministry of Science and Technology issued proposed amendments to the law and is now seeking comments from the public and experts on the outline of the amendments. The main purpose of the amendments is to solve the issues raised in practice during the 10 years of implementation of the law, as well as to fully comply with the new generation of free trade agreements (FTAs) - namely, the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) and the EU-Vietnam Free Trade Agreement (EVFTA).

This update summarises the proposed amendments regarding trademarks, geographical indications (GIs) and enforcement.

Proposed amendments related to trademarks

Exclusion of trademark protection for plant variety names

Article 74.2 of the Vietnamese IP Law 50/2005/QH11 states that the "common names of goods or services" or the "categories of goods or services" shall not be registrable as trademarks as they lack distinctiveness. However, it is unclear whether plant variety names may be considered as the "common names of goods or services" or "categories of goods or services" and may be refused protection on this basis. This has led to several conflicts between trademark registrations and plant variety names, and to situations where the owner of a registration for a plant variety, following the expiration of such registration, uses a trademark registration for the name of the plant variety to prevent the public from using that name. It is therefore suggested in the proposed amendments that "names of plant varieties" be excluded from trademark protection.

Removal of disposition related to associated marks

Pursuant to Article 4.19 of the IP Law, an associated mark means an identical or similar mark registered by the same entity for similar or interrelated products or services. Under the current IP Law, associated marks are protected under the same conditions and procedures as ordinary trademarks. For simplicity purposes, it is proposed that the definition of 'associated marks' be removed from the law.

Amendment regarding the criteria for well-known trademarks

Article 4.20 of the IP Law, which provides for the definition of a 'well-known mark', only refers to the knowledge of the mark by "consumers in Vietnam". In addition, the criteria for determining whether a mark

is well known refer to the concept of “relevant consumers” without any further clarification. It is proposed that the concept of ‘relevant consumers’ should be further clarified.

Further, Article 75 of the IP Law sets out a list of criteria for assessing whether a mark is well known. However, it is unclear whether, to prove that a mark is well known, the owner must present evidence for all the listed criteria as, in many cases, this is not feasible. It is suggested that the upcoming amendments should further clarify that it is not necessary to present evidence relating to all the criteria listed in Article 75 and that the list should be treated as non-exhaustive.

Protection of sound marks

Article 18.18 of the CPTPP provides for the possibility of registering sound marks. Parties to the CPTPP should comply with this obligation within three years of the date of entry into force of the treaty. Sound marks are excluded from protection under the current definition of ‘trademarks’ in the IP Law, which defines trademarks as “visible signs”. Therefore, it is suggested that the “visible signs” condition should be removed from the definition of ‘trademarks’ in the IP Law; this also opens up the possibility of considering protection for other non-traditional trademarks in the future.

Clarification of the grounds for revocation

Pursuant to Article 12.22.3 of the EVFTA, any use of a registered trademark - by its owner or with its consent - that is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services, shall make the trademark liable to revocation or, alternatively, be prohibited by the relevant domestic law. Currently, such ground for revocation is not explicitly included in the IP Law. It is thus proposed to include it as one of the grounds for revocation of a trademark registration.

Procedure

The proposed amendments also include provisions introducing further changes concerning the procedures for handling third-party opinions, oppositions, cancellations and appeals.

Proposed amendments related to GIs

Article 23 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) provides for the obligation to protect homonymous GIs for wines. The current IP Law does not explicitly include provisions related to the protection of homonymous indications. It is proposed that such provisions be included in the upcoming amendments.

Pursuant to Article 12.29 of the EVFTA, the legitimate use of such GIs shall not be subject to any registration by users or further charges. However, under the current law, the users must be included in the certificate of protection of the GI. It is thus suggested that this requirement be removed.

Proposed amendments related to the enforcement of IP rights

The proposed amendments specifically include a provision regarding Customs’ authority to take *ex officio* action against counterfeit and pirated goods, which is a requirement under Article 18.76.5 of the CPTPP and Article 58 of the TRIPS. This point is not clear under the current IP Law.

It is also proposed that administrative proceedings (when the authorities take actions against IP rights infringements either proactively or at the request of the IP rights holders) shall be limited to cases involving counterfeit and pirated goods only, following the minimum requirements of the TRIPS and other FTAs to which Vietnam is a party. This proposal aims to have more IP disputes (other than those involving counterfeit and pirated goods) resolved through civil proceedings and to reduce the financial and human resources used by the administrative authorities when handling such disputes.

Next steps

The Law on Amendments and Supplementations to the Intellectual Property Law is due to be completed and submitted to the National Assembly for further comments in 2020. It is hoped that it will be promulgated in 2021.

Ted Ginsburger

IPMAX Law Firm

Linh Hoang

IPMax Law Firm

TAGS

[Trademark law](#), [Government/Policy](#), [Asia-Pacific](#), [Vietnam](#)