**The inattention of protecting registration of intellectual property, foreign trademarks to be in troubles in Vietnam**

*The registration of protection of industrial property rights is not a new issue, but when using the trademarks in foreign markets, if both domestic or foreign enterprises have not prepared in advance, they will still face the same issue: disputes of intellectual property rights.*

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First story: A Vietnamese person usually looked for foreign products on the Internet and found an extremely useful product, but it was unavailable in Vietnam. This person bought and after researching it, the person decided to establish a company, registered the product’s trademark, design protection and proceed to manufacture the product. Because of its beneficial use, the product was easily entered into stores and e-commerce websites in Vietnam.

After the foreign company had discovered that the Vietnamese product is the same as its product, it tried to contact and require the Vietnamese company to stop infringing its trademark and industrial design. However, the Vietnamese company replied that the product had been theirs and protected in Vietnam legally.

Second story: This is a foreign company that transferred the right of use, patent and trademark of its professional manufacturing process to other countries. In Vietnam, this foreign company also permits exclusive right of use (an exclusive license Agreement) to a Vietnamese company. In this license Agreement, the foreign and Vietnamese companies are particularly signed. However, the Vietnamese company only had its signature without sealing. During the first three-year period of the license Agreement, the Vietnamese company sufficiently paid the foreign company the using fee. Accordingly, the Vietnamese company’s products were manufactured based on the transferred formula and sold in Vietnam.

However, after more than one year, the Vietnamese company did not pay the trademark using fee, which the foreign company had required many times. Nevertheless, the Vietnamese company refused to pay without specific reasons. After investigating, the foreign company discovered that the Vietnamese company had arbitrarily registered the trademark in Vietnam and granted a trademark protection certificate and that was a reason why that company had refused to pay the trademark using fee.

Those are two of the situations that many foreign companies have faced related to the industrial property right (“IPR”) in Vietnam. Furthermore, the foreign companies in Vietnam struggle a lot against the resolution procedure of the Intellectual Property Right dispute.

**Do the foreign trademarks have to register the protection when entering into Vietnamese market?**

Currently, Vietnam has Law on Intellectual Property 2005, amended 2009 (“IP Law”), stipulating subjects that belong to the IPR, including (i) patent, (ii) industrial design, (iii) semiconductor integrated circuit disposition design, (iv) trademark, (v) geographical indication. This group is only protected by the IPR if its subjects applied the registration form to the competent authority of the IPR and were granted the protection certificate.

In addition, Vietnam is also a member of multilateral, bilateral Treaties, such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), Madrid Agreement Concerning the International Registration of Marks 1891 amended 1979, Protocol Relating to the Madrid Agreement 1989 of World Intellectual Property Organization (WIPO) and other bilateral treaties. Therefore, when the foreign companies desire to protect the IPR in Vietnam, they have the right to submit the registration application to the IPR authority of Vietnam or register an international trademark under the Madrid system to require the protection in Vietnam in accordance with regulations of the treaties that Vietnam is also a member. Especially for famous trademarks, the IPR is established based on its use, so this kind of trademark is non-compulsory to be registered.

Thus, the same as Vietnamese trademark overseas, if the foreign trademark wants to be protected in Vietnam, its owner also has to submit the registration application to prevent other people’s registration or violation of it.

It is noted that the trademark registration procedure under the first to file rule. In case there are many applications of different people for registering the trademarks, which are duplicated or even similar to being confused, of use for the products, services duplicated or similar to each other, the protection certificate is only granted for the trademark having a prior date or the soonest application date in the valid form. In case there are many applications that meet conditions to be granted the protection certificate and also have the prior date or the soonest application date, the protection certificate is only granted for the subject of one of those applications under an agreement among the applicants; if the agreement cannot be made, the subjects corresponding to those applications will be refused to be granted the protection certificate.

Thus, the foreign trademark cannot be granted the protection certificate if that trademark was registered before by another Vietnamese or foreign enterprise. Although famous foreign trademarks do not have to be registered, its owner still has to prove its popularity in use if this trademark is violated and required to be protected in Vietnam.

**Protection of Intellectual Property right in law aspect of Vietnam**

If believing the Intellectual Property right is infringed, the owner of this right can use some self-protection rights such as (i) requiring organization, individual violating to stop this infringing act, apologize, remedy, compensate for damage, (ii) requesting the State authority to handle the violation and complaining the State authority about the Intellectual Property right to request a resolution, or (iii) bringing a lawsuit to the court or arbitration to protect the legitimate rights and interests. Pursuant to Article 91 Civil Procedure Code 2015 and Article 203 of IP Law, plaintiff and defendant in a lawsuit of IPR violation must bear the burden of proof.

Moreover, Decree No. 99/2013/ND-CP dated 29 August 2013 of Vietnam on stipulating sanction of administrative violation in the IPR stipulates the acts, sanctions, remedies to handle the violations which are less serious than crime.

In addition, Criminal Code 2015, amended 2017 of Vietnam also provided that a person intentionally violates the IPR of the trademark or the geographical indication protected in Vietnam and the subjects are goods with the falsified trademark or geographical indication in commercial scope or for illegal earnings, can be fined or put into prison. Also, commercial legal entities can be banned in certain fields of business and operation or to raise capital from one to three years.

It can be seen that protecting registration and handling the IPR violation are stipulated by the laws of Vietnam. However, the complaint/suing procedure is costly and usually wastes time, but it is not ensured to have an expected result if evidence is uncertain. Therefore, beside developing the trademark in both domestic and international markets, the owner of intellectual property rights needs to actively submit an application of protecting registration which is as well as a prerequisite to protect the legitimate rights and interests in the best manner to avoid being put on the back foot.

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