Ministry of Science and Technology
Intellectual Property Office of Vietnam
Director General Mr. Dinh Huu Phi
384-386, Nguyen Trai Street
Thanh Xuan District
Ha Noi, Vietnam

Via email
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November 21, 2019

RE: INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON THE IP LAW OF VIETNAM

Dear Director General Dinh Huu Phi,

The International Trademark Association (INTA) is pleased to provide comments on the IP Law of Vietnam.

INTA is a not-for-profit global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation.

INTA’s has 7,200 member organizations from 189 countries. INTA members collectively contribute almost US $12 trillion / €8.8 trillion / ¥73 trillion to global GDP annually. The Association’s member organizations represent over 31,000 trademark professionals and include brand owners from major corporations as well as small- and medium-sized enterprises, law firms, and nonprofits including in Vietnam.

Headquartered in New York City, INTA also has offices in Brussels, Santiago, Shanghai, Singapore, and Washington D.C. and representatives in Geneva and New Delhi.
The following are detailed comments on the IP Law’s policies and it includes a sample response on the Survey on the Policy Impact Report on current practice and policies on the enforcement of Intellectual Property Rights (“IPRs”) in Vietnam.

Policy 1: To encourage activities of creation, exploitation and utilization of works, performances, audio and visual fixation and broadcasts

INTA welcomes the proposed wording regarding amendments to Articles 29 and Article 36 and proposes no further recommendations on this policy objective.

Policy 6: To ensure convenient, efficient, reasonable and transparent procedure

Comments on Industrial Designs

Specifically regarding “industrial design applications”, we applaud the proposal to simplify the application documents. In relation to the requirement of descriptions, we consider that these should be optional: a description can help clarify the features being claimed for protection or other aspects of the design. Further, it is our view that descriptions should only relate to features that appear in the representations of the design and should not contain statements concerning non-visual features, protection requirements, or value of the design (e.g. novelty, individual character, non-obviousness, or technical value). The description should, as proposed, not define the scope of protection of a design.

As to the suggestion to “require the registry to announce closely similar industrial designs identified in examination (citations)”, we note that it is indeed helpful in such case to provide registration certificates to the applicant of the cited designs, where available. However, we would urge the registry to include, in the examination of designs, an analysis of actual conditions in which the public will encounter the designs rather than based solely on classification.

In relation to “publication of industrial design application”, we agree that the IP Law should be amended to allow delays in publishing industrial design applications. It is INTA’s view that, if the applicant elects to do so, it should be possible to defer publication of a design. The maximum permitted deferment period. Specifically regarding industrial design applications, we applaud the proposal to simplify application documents. In relation to the requirement of descriptions, we consider that these should be optional: a description can help clarify the features being claimed for protection or other aspects of the design. Further, it is our view that descriptions should only relate to features that appear in the representations of the design and should not contain statements concerning non-visual features, protection requirements, or value of the design (e.g. novelty, individual character, non-obviousness, or technical value). The description should, as proposed, not define the scope of protection of a design.

As to the suggestion to “require the registry to announce closely similar industrial designs identified in examination (citations)”, we note that it is indeed helpful in such case to provide registration certificates to the applicant of the cited designs, where available. However, we would urge the registry to include, in the examination of designs, an analysis of actual conditions in which the public will encounter the designs rather than based solely on classification.

In relation to “publication of industrial design application”, we agree that the IP Law should be amended to allow delays in publishing industrial design applications. It is INTA’s view that, if the applicant elects to do so, it should be possible to defer publication of a design. The maximum
permitted deferment period should be at least 12 months after the date of application. Payment of the publication fee, if any, should be optional at the filing stage. An application for publication should be filed, at a time of the applicant’s choosing before the end of the deferment period and payment of the publication fee made in order for the design to be published. Claiming priority from an earlier design application should not change the available term of deferment of the publication of the design filed. In the case of multiple design applications, a request for deferment of publication should be permitted to concern only some of the designs of the multiple application.

We agree that the IP Law should be amended with provisions on handling appeals, for designs as well as for other types of intellectual property rights.

In relation to trademarks, we suggest that the deadline for submission of opposition to an application to be within 9 months from the date of publication or within 3 months from the date of re-publication in case of amendment.

In relation to “appeal handling procedure”, INTA agrees that the IP Law should be amended with supplementation of specific provisions on handling appeals in IP. In practice, the Intellectual Property Office of Vietn...
In relation to “administrative sanctions” and “border measures”, we encourage consideration to be given both to administrative sanctions for infringement of industrial design rights and to include clearance suspension (in border measures) for infringement of industrial design rights.

We also would like to provide the additional general comments on the IP Law as listed below.

1. Refusal of trademark slogan:
In practice, the Intellectual Property Office of Vietnam may refuse trademark protection of slogan regardless of descriptive meaning for the goods or services applied for registration. It is recommended that the IP law should be amended for granting trademark protection of certain slogans which are not descriptive of applied goods/services.

2. Abuse of invalidation process:
Infringers can take advantages of invalidation actions to suspend enforcement actions, by means of which once an IPR owner initiates infringement claims against infringers, the infringers can lodge a counter-attack invalidation claim against the trademark registration certificate of the IPR owner. Due to the invalidation action, the competent authorities tend to suspend the administrative proceedings until the Intellectual Property Office of Vietnam issues its decision on the invalidation request.

* * *


PART II.

SURVEY QUESTIONS ON IPRS ENFORCEMENT

1. Have you ever requested others (or assisted, provided professional advice – on the side of an IP agent) to deal with infringement of intellectual property (“IP”) rights?

☐ Yes
☐ No

2. When your IP rights are infringed, which measures do you choose to handle?

☐ Negotiate with infringers
☐ Request infringers to cease the infringement
☐ Request competent authorities (inspectors, economic police, market management bureau, customs, ...) to impose administrative sanctions
☐ Initiate a lawsuit before the Court
☐ Initiate arbitration proceedings
☐ Other measures: ...............................................................................................................................................

3. Which difficulty do you have in your request to deal with IP rights’ infringement?

☐ Do not know which authorities are empowered to act against the infringement
☐ Not aware of the procedure for dealing with infringement
☐ The procedure for handling infringement is too complicated
The law and guiding circulars/decrees are unclear and overlapping
Do not know which organizations/agencies that can be of support and assistance

Others:
- The time frame for handling is too long.
- There are six authorities having competence for handling the IP infringement in Vietnam (specialized inspectorates, market management authority (market surveillance), Customs offices, economic police, competition administration and courts). This may make the power of IP enforcement authorities thin and weak.
- Level of monetary fine applied as to trademark/IP infringers is low and this may not a strong warning to other potential infringers.
- Activity of destruction of fake and infringing products is normally not strict and the authority normally does not notify of time and date of the destruction so that the IP Agent of the IP/trademark Owner can join it.

4. **How do you evaluate the effectiveness of the administrative remedy when handling intellectual property rights infringement?**
- Effective due to the simple, fast and inexpensive procedures for IP rights holders
- Ineffective due to the complicated procedures, low-level of sanctions that are not enough for deterrence and recidivism prevention.
- Others: .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... .......................................................... 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7. Have you ever requested the IPR enforcement authorities to deal with online infringement?  
☑ Yes  
☐ No

8. If yes, which of the following IPRs that such online infringement violated?  
☑ Copyright  
☐ Related rights  
☐ Patents/utility models  
☐ Industrial design  
☑ Trademark  
☑ The right to prevent unfair competition  
☐ Others: ........................................................................................................................................

9. Which difficulty do you encounter when requesting the enforcement bodies to handle online infringement?  
☑ Unclear regulations in relevant law  
☑ Difficulty to identify infringement acts  
☑ Difficulty to collect evidence  
☑ Difficulty to determine the value of infringing goods  
☑ No mechanisms for enforcement against infringing parties in foreign countries  
☐ Others: ........................................................................................................................................

10. Have you ever filed a petition to the Court to handle IPR infringement?  
☑ Yes  
☐ No  
If not, proceed to section D.

11. How would you rate the general procedure at the Court?  

<table>
<thead>
<tr>
<th>Criteria</th>
<th>Very good</th>
<th>Good</th>
<th>Fairly good</th>
<th>Not good</th>
<th>Bad</th>
</tr>
</thead>
<tbody>
<tr>
<td>Procedure (publicly open, clear, simple ...)</td>
<td>☑️</td>
<td></td>
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<td>☑️</td>
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<td>Cost</td>
<td>☑️</td>
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<td>Processing Time</td>
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<td>Transparency</td>
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<td>Professional qualifications of judges</td>
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<td>☑️</td>
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<tr>
<td>Court's judgments are free and fair</td>
<td>☑️</td>
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</tbody>
</table>
12. Did you require the Court to apply preliminary injunctions (retention; seizure; sealing; prohibiting any alteration of the original state; prohibiting any movement, etc.) or not?

☐ Yes
☒ No

13. How would you rate the procedure for applying preliminary injunctions at the Court?

<table>
<thead>
<tr>
<th>Criteria</th>
<th>Very good</th>
<th>Good</th>
<th>Fairly good</th>
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</thead>
<tbody>
<tr>
<td>Procedure (public, clear, simple ...)</td>
<td>☑</td>
<td>☑</td>
<td>☑</td>
<td>☒</td>
<td>☑</td>
</tr>
<tr>
<td>Costs (official fee paid for state agencies)</td>
<td>☑</td>
<td>☑</td>
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<td>☑</td>
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<tr>
<td>Processing time of the Court (to meet &quot;urgent&quot; purposes)</td>
<td>☑</td>
<td>☑</td>
<td>☑</td>
<td>☒</td>
<td>☑</td>
</tr>
<tr>
<td>Other opinions: the number of case is not much due to the procedure to prove the urgent is complicated and prolonged.</td>
<td>☑</td>
<td>☑</td>
<td>☑</td>
<td>☑</td>
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</table>

14. In your opinion, is it necessary to set up a specialized Court to handle civil IP disputes?

☒ Yes, because it will improve the quality of handling civil IP disputes at the Court
☐ No, because of the number of civil IP disputes requested to handle by the Court is not high
☐ No, because the set-up of a specialized court to handle civil IP disputes will change the organizational system of courts in Vietnam.
☐ Other opinions: ........................................................................................................................................

16. Did you require the Court to compel infringing parties to pay reasonable fees for the cost of hiring lawyer?

☒ Yes
☐ No

17. Did you require the Court to determine the level of damages?

☒ Yes
☐ No

18. If yes, what is your main ground for damages claim?
19. Have you ever requested ex officio border measures for suspected infringing upon IPRs goods?
☑ Yes
□ No

20. How do you assess the application of ex officio border measures on infringing upon IPRs goods?
☑ Already appropriate
□ Too broad, ex officio border measures should be applied only to suspected counterfeits
□ It is not feasible for goods infringing patent rights or industrial design rights because assessment of infringement related to these subjects is often complicated, takes time, and therefore affects the normal circulation of goods.
□ Others:

21. Should customs proactively suspend customs procedures for suspected counterfeit/ infringing upon IPRs goods?
☑ Yes, in order to enhance the effectiveness of the control of imported and exported goods related to IPRs.
□ No, because the proactive suspension of customs procedures causes damages to the goods owners if the suspected goods temporarily suspended are not counterfeits.
□ Others:

22. How do you expect the enforcement of IPRs to be improved?
□ Continue to amend and supplement for the legal provisions on enforcement of IPRs to be clear and transparent
☑ Re-organize the enforcement system of IPRs, especially the system administrative enforcement authorities in the orientation of:
  ☑ Reducing the number of administrative enforcement authorities
  □ Clearer delineation of administrative enforcement authorities’ authorization
  ☑ Set up a lead IPR enforcement authority
☑ Accelerate IPRs enforcement through civil litigation (by the Court), gradually reducing administrative handling measures
□ Simplify procedures for enforcement of IPRs
☑ Strengthen the capacity and qualifications of the enforcement bodies, including:
  ☑ Technical infrastructure
Database, information system
Officials, staffs
Publicize the handled cases, decisions of authorities (administrative enforcement bodies, courts)
Other measures, specifically: .................................................................
1. Fine to infringers:
   IP Enforcement Authorities should apply a high monetary fine as to the infringers as of deterrent.
2. IP Courts in Vietnam:
   IP Courts for hearing and judgment of IP cases are recommended to be set up in the country.
3. Administrative Procedure:
   It is recommended to consider setting up one single IP enforcement authority under administrative procedure.

For any questions relating to this submission please contact me or Mr. Seth Hays, Chief Representative, Asia Pacific, at shays@inta.org and Anticounterfeiting Advisor, Asia, Valentina Salmoiraghi at vsalmoiraghi@inta.org.

Sincerely,

Etienne Sanz de Acedo
Chief Executive Officer
International Trademark Association (INTA)

CC: Deputy Chief Inspector, Ministry of Science and Technology, Ms. Nguyen Nhu Quynh