

# Trademarks

## 3.1 Definition and Registrability

A trademark is defined as a sign used to distinguish the goods or services of one producer/service provider from those of another. The trademark may be presented in the form of letters, pictures or a combination thereof in one or several colors. To be registrable, a trademark must be distinctive and must not fall within the signs excluded from registrability.

A sign used as a trademark shall be deemed distinctive if the following conditions satisfied:

- (i) It is created from one or a number of elements that are prominent and easily recognized, or from elements that are, as a whole, prominent and easily recognized;
- (ii) It is not identical with or confusingly similar to another persons trademark currently protected in Vietnam;
- (iii) It is not identical with or confusingly similar to a trademark of another person claimed in prior-filed applications in Vietnam including those trademarks filed under the Madrid Agreement;
- (iv) It is not identical with or confusingly similar to a trademark of another person, the protection validity of which has expired or been suspended within the last 5 years, except where the validity was suspended on the basis of non-use;
- (v) It is not identical with or confusingly similar to a trademark of another person recognized as well-known in accordance with Article 6bis of the Paris Convention, or a trademark that has been widely used and recognized;
- (vi) It is not identical with or confusingly similar to a protected trade name or geographical indication;
- (vii) It is not identical with or confusingly similar to a patented industrial design or a prior-filed industrial design; or
- (viii) It is not identical with or confusingly similar to a symbol or character subject to another person's copyright, which has been widely known, unless permitted by such person.

The following signs shall be excluded from trademark protection:

- (i) Signs that do not possess distinctiveness, such as simple shapes and

geometric shapes, figures, capital letters, , and foreign letters of uncommon languages which does not derive from Latin (such as, Arabian, Chinese, Japanese, Korean, Thai, etc.) . Those signs can be however registered if they have been widely used and recognized;

(ii) Conventional signs, symbols, ordinary devices, and denominations of goods in any language that are used widely and popularly and known to many people;

(iii) Signs indicating time, place, manufacturing process, type, quantity, quality, nature, composition, utility or value that are descriptive of goods, services or origin thereof;

(iv) Signs likely to mislead or cause confusion or to deceive consumers as to the origin, nature, function, utility, quality or value of goods or services;

(v) Signs identical with or similar to official quality marks, control marks, warranty marks, etc. of Vietnam, foreign countries or international organizations;

(vi) Signs or names (including pictures, names, nicknames and pseudonyms), devices or symbols identical with or confusingly similar to national flags, national emblems, portraits of national leaders or heroes, public figures, geographical denominations, organizations of Vietnam and foreign countries, unless duly authorized; and

(vii) Signs that are contrary to law, social interests, public order and humanity.

### **3.2 Who May File and Where to File Trademark Applications**

All individuals and entities involved in legal production and business activities are entitled to file applications for trademark registrations to be used for products or services they are manufacturing or providing or intend to manufacture or provide. Actual or prior use of a trademark is not required to seek trademark registration in Vietnam. So businesses including foreign ones can seek registrations of trademarks for future use in Vietnam, provided that a registered mark may not be discontinued for any five consecutive years. Otherwise, the trademark is vulnerable to cancellation.

Trademark applications can be filed with the NOIP in Hanoi or the NOIP's branch in Ho Chi Minh City. Vietnamese citizens and entities may file

trademark applications directly with the NOIP. Foreign citizens permanently residing in Vietnam or foreign entities having legal presence in Vietnam or real and effective production and business establishments in the country may also file applications directly with the NOIP. Other than these specified cases, all applications of foreign applications must be submitted through a licensed local IP agency like Vision & Associates.

### **3.3 “First to File” Principle**

Like other industrial property objects, the “first to file” principle is also applied for trademark protection in Vietnam, accordingly the trademark registration will be granted to the person who first filed the trademark application.

However, the “first to file” principle shall not apply to cases of well-known marks under the Paris Convention or those which have been widely used and recognized. In such cases, the priority will be given to the person who can prove that his trademark has been well-known or been widely used and recognized, without subject to the “first to file” principle.

### **3.4 Priority**

Priority can be claimed in accordance with the Paris Convention, based on an earlier application filed in a foreign country or an officially recognized international exhibition held in Vietnam or in a foreign country. Priority can be also claimed according to bilateral agreements or based on the reciprocity principle. To secure the priority right, the application must be filed within 6 months from the filing date of the first application filed abroad or the date of the exhibition as above mentioned.

### **3.5 Trademark Applications**

Each application can be used for one trademark only. However, multi-class applications are possible in Vietnam, accordingly up to 45 classes of goods and services can be claimed under one application. The goods and/or services under the application must be classified according to the International Classification of Goods and Services under the Nice Agreement (currently the ninth edition is applicable).

The NOIP accepts a general power of attorney for trademark filings of one applicant. In case the power of attorney specifies particular marks of

the applicant, then separate power of attorney will be required for any subsequent marks of the applicant not specified in the original power of attorney. Neither notarization nor legalization is required regarding the Power of Attorney. The power of attorney is not required at filing , provided that the original copy is supplemented within 01 months from the filing date.

For documents required for trademark filing in Vietnam, please see Filing Requirements in Vietnam.

### **3.6 Examination**

All trademark applications will be examined by the NOIP with respect to formality requirements, within 01 months from the filing date. If the application is found to satisfy the formality requirements, then it will be accepted as legitimate by the NOIP in a Notification of Acceptance which provides official filing date, official filing number, and priority date if any. In case the application does not meet the formality requirements, the NOIP will reject the application by a Notification of Refusal of Acceptance or request corrections or amendments, as the case may be.

Upon expiry of the formality check and where the application is accepted as legitimate, the application will be published in the IP Gazette within 2 months from the acceptance date and then, passed to substantive examination which takes place within a 06 month period from the date of publication of the application. The substantive examination is to consider whether the claimed trademark (i) possesses distinctiveness and (ii) is of those signs excluded from trademark protection. During this period, the applicant may make amendments to the application, however only minor changes to the trademark or goods and/or services claimed are acceptable. For example, the applicant can restrict the goods and/or services claimed but not expand them.

Trademark applications filed internationally under the Madrid Agreement shall be also subject to the substantive examination which lasts 12 months from the date of publication of the extension of protection to Vietnam by WIPO.

### **3.7 Grant of Certificate of Trademark Registration or Acceptance of Protection**

If upon expiry of the substantive examination, the trademark is found to be registrable, the NOIP will grant Certificate of Trademark Registration for the trademark, and publish the Certificate in the IP Gazette, Volume B. Regarding the international trademarks filed under the Madrid Agreement, the NOIP will issue Decision of Acceptance of Protection for the trademark in question. The international registration of a trademark, accepted for protection in Vietnam by the NOIP, shall be effective from the date it is published in the IP Gazette, Volume B until the end of the 20-year term of the international registration.

Where the trademark is unregistrable, the NOIP will issue a Notification of Examination Result of Application notifying the applicant of the intended refusal of grant of the certificate and reasons therefore, or of the deficiencies or amendments which should be corrected or made. The applicant has 2 months to reply or make necessary amendments. If the applicant fails to reply or the response is not appropriate, the NOIP will officially issue a Notification of Refusal of Granting Certificate of Trademark Registration. To the contrary where the response is satisfactory, the Certificate of Trademark Registration or Decision of Acceptance of Protection will be granted as above mentioned.

### **3.8 Well-known Trademarks**

Intellectual Property Law, which came into effect from July 1, 2006 has defined for a well-known mark, which states “well-known mark is a mark widely known throughout territory of Vietnam”. According to the IP Law, industrial property rights to well-known trademark is are established based on its use without subject to registration.

Also, according to the IP Law, statutory criteria for determining a well-known trademark are:

- (i). The number of the related consumers who are aware of the mark through purchase or use of the goods or services bearing the mark or through advertising;
- (ii). Territorial scope of circulation of the goods/services bearing the mark;
- (iii). Turn-over of the sale or supply of the goods or services bearing the mark or the volume of the goods sold or the services supplied;
- (iv). The period of continuous use of the mark;
- (v). Widespread goodwill of the goods/services bearing the mark;

- (vi). Number of the countries granting protection to the mark;
- (vii). Number of the countries recognizing the mark as well known;
- (viii). Value of assignment, licensing price, or the value of investment capital contribution in respect of the mark.

The laws also provides procedures for recognition of well-known marks. Accordingly, the well-known marks, which are recognized under civil procedures or by the NOIP's decision shall be recorded in the List of Well-known Marks kept at the NOIP.

### **3.9 Protection Term and Renewal**

A certificate of trademark registration shall be effective from the granting date and last for 10 years from the filing date, and can be renewed for indefinitely for each consecutive 10-year term.

To renew the validity of a certificate, the trademark owner must apply for renewal and pay the renewal fee within 6 months before the expiry of the preceding validity term. Renewal request may be filed late within a 6-month grace period, subject to a fine of 10 percent of the renewal fee for each month overdue.

### **3.10 Rights and Obligations of Trademark Owners**

A trademark owner shall be entitled to (i) exclusive use of the trademark, including the right to license the right to use the trademark, (ii) request any person infringing his trademark rights to cease from the infringement and ask for any damage suffered.

The trademark owner must use the trademark continuously and must not discontinue use of the trademark for any consecutive 5 years. Otherwise, the certificate of trademark registration shall be suspended at a third party's request.

### **3.11 Appeal/Opposition Proceedings**

The applicant may lodge appeals/oppositions against the NOIP's rejection of acceptance of applications or of granting certificates. Any third party has the right to appeal or oppose the grant of a certificate of trademark registration, subject to a prescribed fee.

The appeal/opposition must be made in writing and submitted to the NOIP within 3 months from receipt of the NOIP's decision subject to the appeal/opposition. In case of a third party opposing the grant of a certificate of trademark registration, the opposition may be filed at any

time during the validity term of the certificate. The NOIP shall be obliged to reply to the appellant within 30 days from receipt of the opposition. In case of disagreement with the NOIP's response, the appellant may appeal further to the MOST or initiate a lawsuit against the NOIP at the administrative court under the People's Court System.

### **3.12 Cancellation and Suspension of Certificate of Trademark Registration**

A certificate of trademark registration may be cancelled wholly or partly, by any third party's request, in the following cases:

- (i) The person who has been granted the certificate was not entitled to apply for the trademark registration, nor assigned the right to file the application from the entitled person; or
- (ii) The trademark under the certificate does not meet the protection criteria as stipulated.

The validity of the certificate of trademark registration may be also suspended on the following grounds:

- (i) The grantee submits a written request to the NOIP for abandonment of the certificate; or
  - (ii) The grantee fails to pay the renewal fee within the prescribed time limit; or
  - (iii) The trademark under the certificate has not been used for any consecutive 5 years without any justifiable reasons (non-use basis); or
- The grantee no longer exists or terminates the operations.

### **3.13 Trademark Infringements**

The use of a registered trademark as described above shall be considered as a trademark infringement if it is conducted without the consent of the trademark owner. The current trademark laws make available administrative, civil or criminal remedies, where appropriate, for a trademark owner to enforce his rights in case of infringement. For details of enforcement of trademark rights and remedies available, please see Section 8 hereunder.

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# Appellation of Origin

## 4.1 GEOGRAPHICAL INDICATIONS

### Definition of Geographical Indications

The term “geographical indications” in IP Law 50/2005 henceforth replaces both the term “geographical indications”, which is stipulated in the Government’s Decree No. 54, and “appellation of origins”, which is used in the previous Civil Code 1996 and the Government’s Decree No. 63. In the IP Law 50/2005, “geographical indications” are defined as “signs that are used to identify products as originating from an area, locality or country”. Such definition is rather broad to the extent that it could cover the two previous concepts of “geographical indications” and “appellation of origins”.

### Protection conditions

Geographical indications shall be protected if the following conditions are met:

- (i) products bearing geographical indication geographically originate from the area, locality or country indicated by such geographical indications; and
- (ii) products bearing geographical indication have reputation, quality or characteristics that are essentially attributable to the geographical conditions of the area, locality or country indicated by the geographical indication.

“Reputation” of products bearing geographical indication is determined by the level of its prestige among consumers that calculated by the level of awareness of and level of frequency of choosing the products made by consumers. Meanwhile, “quality or characteristics” of products bearing geographical indication are measured by one or several indicators such as quantitative, qualitative norms or physical, chemical, microbiological sensations and these indicators can be by examined by technical means or experts using appropriate



testing methods. The “geographical conditions” of the territory indicated by geographical indications shall include the natural factors (climate, hydrograph, geology, terrain, ecological system and other natural factors) and human factors (skills, expertise of manufacturers, process and traditional mode of manufacture) that essentially determine the reputation, quality or characteristics of products bearing geographical indications.

## **Exceptions**

The following subject matters shall not be protected as geographical indications:

- (i) Designations, indications having become generic names of goods in Vietnam;
- (ii) Geographical indications of a foreign country where it is not or no longer protected or no longer used;
- (iii) Geographical indications identical with or similar to a mark having been protected if their use will cause confusion as to the origin of the products;
- (iv) Geographical indications misleading consumers as to the true geographical origin of products bearing such geographical indications.

## **Regime of protection**

Geographical indications can be protected not only by a sui generis system under the registration procedures for acquisition of right but also by alternative legal tools of certification mark/collective mark and anti-unfair competition. In particular, the IP Law 50/2005 states that a trademark shall not be considered as distinctive if it is a sign indicating the geographical origin of goods or services, except for those, which have been, registered as collective marks or certification marks. In addition, the IP Law also prescribes the act of using commercial indications (including marks, trade names, business symbols, business slogans, geographical indications, package designs, label designs,

etc.) that cause confusion as to the business entities or business activities or commercial source of goods or services or the origin, production method, feature, quality, quantity or other characteristics of goods or services shall be considered as an act of unfair competition.

### **Who May File and Where to File Geographical Indication Applications**

The right to register geographical indications shall belong to the State of Vietnam. However, the State permits individuals/organizations manufacturing products bearing the geographical or their representative association or the local administrative authority to exercise the right.

Geographical indication applications can be filed with the NOIP in Hanoi or the NOIP's branch in Ho Chi Minh City or Da Nang City.

### **Geographical Indication Application**

Each application can be filed for one geographical indication that used for one product only.

Applications for registration of geographical indications shall be subject to two-step examination. The formality examination shall be conducted within one month from the filing date while the corresponding time limit for substantive examination is 6 months from the date of publication of the application. Applications for registration of geographical indications, after duly accepted as to form, shall be published in IP Gazette for opposition.

For documents/information required for geographical indication filing in Vietnam, please see Filing Requirements in Vietnam.

### **Protection Term**

A certificate of geographical indication registration shall have indefinite validity from the granting date.

## **Cancellation and Invalidation of Certificate of Geographical Indication Registration**

A certificate of geographical indication registration may be cancelled by any third party's request, in the following cases:

- (i) The application for registration neither has right to registration; or
- (ii) The geographical indication under the certificate does not meet the protection criteria as stipulated.

The validity of the certificate of geographical indication registration may be also suspended on the grounds that the geographical conditions attributable to the reputation, quality or characteristics of the product bearing a geographical indication have changed resulting in a loss of the reputation, quality or characteristics of the product.

## **Geographical indication infringement**

The following acts shall be considered as infringement of the rights to a protected geographical indication:

- (a) Using the protected geographical indication for products that do not satisfy the peculiar characteristics and quality of the product having the geographical indications although such products originate from a geographical area bearing such geographical indication;
- (b) Using the protected geographical indication for products similar to the product having the geographical indication for the purposes of taking advantage of reputation and goodwill of such geographical indication;
- (c) Using a sign identical with or similar to the protected geographical indication for products not originating from the geographical area bearing the geographical indication and therefore causing consumers mislead about the products originating from that geographical area;
- (d) Using a protected geographical indications of wines or spirits for the wines or spirits that are not originating in the territories corresponding to the geographical indication,

even where the true origin of goods is indicated or the geographical indication is used in translation or transcription or accompanied by such words as “kind”, “type”, “style”, “imitation” or the like.

## **4.2 LAYOUT DESIGNS OF SEMICONDUCTOR INTERGRATED CIRCUITS**

### **Definition of Layout Designs of Semiconductor Integrated Circuits**

Layout Designs of Semiconductor Integrated Circuits (hereinafter referred to as “Layout Designs”) are defined as “three-dimensional disposition of circuitry elements and interconnections of such elements in a semiconductor integrated circuit” in which the integrated circuits are prescribed as product, in its final form or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on a piece of semiconductor material and which is intended to perform an electronic function. “Integrated circuit” is synonymous with “IC”, “chip” and “microelectronic circuit”.

### **Requirements for protection**

A layout-design shall be eligible for protection if it is originality and commercial novelty.

These criteria are specifically defined as follows:

#### ***Originality***

A layout design shall be considered as original if it is resulted from its author’s own creative effort and not to be widely known among creators of layout-designs or manufacturers of semiconductor integrated circuits at the time of its creation. In addition, a layout design that is a combination of common general elements and interconnections shall be considered as original if such a combination as a whole is

original.

### ***Commercial novelty***

The commercial novelty of layout design is understood as the layout design has not been commercially exploited anywhere in the world prior to the filing date of the application for registration.

A layout-design shall not be considered as lacking of commercial novelty if the layout design registration application is filed within 2 years from the date such layout design was commercially exploited for the first time anywhere in the world by the person who has the right to registration or his/her licensee.

Commercial exploitation of a layout-design means any act of public distribution for commercial purposes of a semiconductor integrated circuit produced by incorporation of the layout-design, or an article incorporating such a semiconductor integrated circuit.

The following subject-matters shall not be protected as layout designs:

- (a) Principles, processes, systems or methods operated by semiconductor integrated circuits
- (b) Information or software contained in semiconductor integrated circuits.

### **Who May File and Where to File Layout Design Applications**

The right to file a layout design application belongs to inventors who have created the layout design by his/her own efforts and expenses. In case a layout design is created by the inventors during the course of employment or hire, the entitlement to file layout design applications for such layout design shall belong to the entities or individuals who have invested finance and material facilities to the inventors through employing or hiring. In addition, persons entitled to

file an application may assign that right to other organizations or individuals through written contract or inheritance in accordance with the law.

The right to file layout design applications for layout design made by using the State budget belongs to the State.

All applications must be lodged with the NOIP, which has been entrusted to be the State administrative authority under the jurisdiction of the Ministry of Science and Technology. Vietnamese entities and individuals, foreign individuals permanently residing in Vietnam, and foreign entities having an industrial or commercial establishment in Vietnam may file patent applications directly or through an IP agency licensed to practice before the NOIP. Foreign individuals not permanently residing in Vietnam and foreign entities having no industrial or commercial establishment in Vietnam shall file applications for patent rights through a licensed IP agency. As of July 2006 there are forty-three local IP agencies licensed to practice in Vietnam before the NOIP.

### **Layout Design Applications**

Each application can be filed for one layout design only.

Applications for registration of layout design shall be subject to the formality examination within one month from the filing date. After duly accepted as to form, applications for registration of layout designs shall be published in IP Gazette for opposition within three months in the manner of allowing direct access at the NOIP without reproduction of such published layout design. The certificate of layout design of semiconductor integrated circuit registration shall be granted to the applicant if no opposition is filed within the duration of publication of the application.

For documents required for filing applications of layout designs, of domestically filed applications for inventions, please see Filing Requirements in Vietnam.

### **Protection Term**

A certificate of layout design of semiconductor integrated circuit registration shall have validity from the granting date and expiring at the earliest date among the following:

- (a) The end of 10 years as from the filing date;
- (b) The end of 10 years as from the date the layout-designs were first commercially exploited anywhere in the world by the person having the right to registration or his or her licensee;
- (c) The end of 15 years as from the date of creation of the layout-designs.

### **Rights of owner of a layout-design**

The owner of a layout-design has the right to exploit the layout-design or prevent any person from performing the following acts: (i) reproducing the layout-design; or making a semi-conductor integrated circuit in accordance with the protected layout-design; (ii) distributing, leasing, advertising, offering or storing a copy of the protected layout-design; (iii) importing a copy of the protected layout design, a semi-conductor integrated circuit manufactured in accordance with the protected layout or goods manufactured in accordance with such a semi-conductor integrated circuit.

### **Cancellation or Suspension of layout designs**

At any time after a layout design is granted, any party may file a written request with the NOIP to cancel such patent. The grounds for cancellation may be:

- 1. The applicant was not entitled to apply for the layout design, nor assigned that right from the entitled person; or
- 2. The layout design did not meet the protection conditions at the time the certificate of layout design registration was issued.

The certificate of layout design semiconductor integrated circuit registration may be suspended at the request of any party, based on the grounds that (a) the owner fails to pay

the prescribed annuity or renewal fee as prescribed; (b) the owner declares a disclaimer of the rights conferred by the layout design; or (c) the layout design owner no longer exists, and there is no lawful successor.

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## **Trade Names-Trade Secrets-Unfair Competition**

On 3 October 2000, the Government issued Decree 54/2000/ND-CP on the protection of the industrial property rights related to trade secrets, geographical indications, trade names and unfair competition.

The Decree, effective on 18 October 2000, guided in detail the protection of industrial property rights of “other objects” as specified in Article 780 of the Civil Code of Vietnam; which include: trade secrets, geographical indications, trade names and protection of the right against unfair competition. This was a step towards harmonization of Vietnam’s legal framework and towards bringing this legal framework into compliance with TRIPS and the trade pact Vietnam had signed with the United States.

The Decree provided definitions for trade secrets, geographical indications, trade names and also provided the scope of protection of those objects. The rules for anti-unfair competition were also included in the Decree, for the purpose of protection of the rights and benefits of the manufacturers and traders.

In addition to addressing the main subject matters of IP protection such as patent, trademark, industrial design, copyrights and related rights, and layout designs of semiconductor integrated circuits, as demanded by the TRIPS Agreement, IP Law 50/2005 explicitly addresses protection for trade secrets, geographical indications, and trade names, and anti-unfair competition. IP Law 50/2005, which replaces Decree 54/CP, came into effect on 1 July 2006.

### **5.1 Trade secrets**

Trade secrets are defined as information obtained from financial or intellectual investment activities, which has not been disclosed and is applicable in business, when they satisfy in full the following criteria:

- (i) The information is neither common knowledge nor easily obtained; and
- (ii) They can be applied in business and, when used, will enable the holders of such information to have more favorable advance than other people who do not have or use such information in production, business;



and

(iii) They are confidentially kept by the holders with necessary measures so that such information will neither be disclosed nor easily accessible.

Under IP Law 50/2005, the following confidential information shall not be protected as trade secrets:

- (i) Personal status secrets;
- (ii) State management secrets;
- (iii) Security and national defense secrets;
- (iv) Other confidential secret information irrelevant to business

The holders of the trade secrets are all organizations and individuals who have legally acquired the trade secrets the trade secrets and keep it confidential. A trade secret acquired by an employee or a party carrying out the assigned duty during performance of assigned duties shall belong to the employer or the duty assignor, unless otherwise agreed by the parties. The holders of the trade secrets are entitled to use their trade secrets by applying them to manufacture products, supplying services or trade in goods or selling, advertising for sale, storing for sale and importing a product obtained by applying the trade secret. Such rights shall be protected during the time such trade secrets still satisfy the said criteria of the trade secrets.

Under the IP Law 50/2005, the following acts shall be considered as an infringement of the rights to a trade secret:

- (i) Accessing or acquiring information embodied in a trade secret by taking acts against security measures taken by the lawful controller of the trade secret;
- (ii) Disclosing or using information embodied in a trade secret without permission of the holder the trade secret;
- (iii) Breaching security contracts or deceiving, inducing, bribing, forcing, seducing or abusing the trust of persons in charge of security in order to access, acquire or disclose a trade secret;
- (iv) Accessing to or acquiring information embodied in a trade secret, that is submitted by another person under procedures for granting a license of business or marketing in respect of a product, by actions against security measures taken by competent agencies;
- (v) Using or disclosing trade secret, while knowing or being obliged to know that it has been acquired by another person engaged in one of the acts referred to in items # i, ii, iii and iv;
- (vi) Failure to perform the obligation of security.

For the first time, limitations of the rights of an owner of a trade secret has been introduced in the law, including exemption from rights for (i) disclosure or use of a trade secrets acquired without knowing or having reason to know that it has been illegally acquired by others; (ii) disclosure of the trade secrets in order to protect the public; (iii) use of secret data for non-commercial purposes; (iv) disclosure or use of a trade secrets created independently; and (v) disclosure or use of trade secrets generated by analyzing or evaluating a legally distributed products; unless otherwise agreed between the analyzers or evaluators and

the owner of the trade secret or the sellers of the product.

The IP Law 50/2005 also introduce the obligations to maintain secrecy of date of tests during the course of work of the competent authorities to maintain secrecy of the date submitted thereto by the applicant.

## **5.2 Trade name**

Trade names mean the name of the organizations, individuals which is used in business activities to distinguish the business entity bearing such a name from other business entities engaging in the same field and locality of business and which satisfy the following criteria:

- (i) It consists of a proper name, except where it has been widely known as a result of use; and
- (ii) It is not identical with or confusingly similar to another person's trade name prior used in the same field and locality of business; and .
- (iii) It is not identical with or confusingly similar to another person's trademark or a geographical indication having been protected prior to the date such trade name is used.

Name of administrative, political, social, professional agencies and organizations or of the subjects which do not relate to the business activities shall not be protected as trade name.

The holders of the trade names are the organizations, individuals that legally uses such trade names in the course of business. The holders are entitled to use the trade names for the business purposes, reflecting the trade names in the transaction papers, documents, signboards, products, goods, commodities, package and advertisement.

The trade names are protected when the holders of such names still maintain their business activities under such names.

The IP Law 50/2005 also stipulates the acts of using commercial indications identical with or similar to another person's trade name prior used for the same or similar goods/services that causes confusion as to business entities, business premises or business activities under the trade name shall be considered as infringement of the rights to the trade name. The holder of such trade name thereby shall have the right to request the infringers to stop the infringement acts, apologize, publicly rectify and pay for damage compensation and/or to request the competent state agencies to handle acts of infringement or initiate a lawsuit at a competent court or an arbitrator for protection their legitimate rights and interest.

## **5.3 Anti-Unfair competition**

Unfair competition acts related to the industrial property as defined under IP Law 50/2005 include the acts:

- (i) Using commercial indications that cause confusion as to business entities, business activities or commercial origins of goods or services.
- (ii) Using commercial indications that cause confusion as to the origin, production method, feature, quality, quantity or other characteristics of goods or services; or as to the conditions for the provision of goods and services;
- (iii) Using a trademark protected in a country that is a member of an

international treaty, to which the Socialist Republic of Vietnam is a party, which prohibits the representative or agent of the owner of the trademark from using the owner's trademark, if the user is such a representative or agent and the use is without the owner's authorization and without reasonable grounds;

(iv) Registering or possessing the right to use or using a domain name identical with or confusingly similar to another person's protected trademark or trade name, or a geographical indication that one does not have the right to use, for the purpose of possessing the domain name, taking advantage of or prejudicing the reputation and goodwill or the respective trademark, trade name or geographical indication.

Apart from IP Law 50/2005, Law on Competition of Vietnam also introduces unfair competitive acts including any of the following:

- (i) Misleading instructions;
- (ii) Infringement of trade secrets;
- (iii) Coercion in business;
- (iv) Defamation of another enterprises;
- (v) Causing disruption to the business activities of another enterprise;
- (vi) Advertisement aimed at unfair competition;
- (vii) Promotion aimed at unfair competition;
- (viii) Discrimination by an association;
- (ix) Illegal multi-level selling of goods;
- (x) Other unfair competitive acts stipulated by the Government.

Organizations, individuals which suffer damage or would be damageable due to unfair competition acts in the field of industrial property are entitled to request the competent State authorities to compel the person having unfair competition acts to stop conducting such acts, pay compensation for damage, or to impose administrative or criminal measures upon such person.

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# Copyrights

## 6.1 Authors and Copyright Owners

Copyright protection shall be given to an author who is defined as the person directly creating the whole or part of a literary, artistic, scientific work and as the person who have created derivative works from other's works, including works translated from one language into another, recreated, transformed, adapted, compiled, annotated, or selected works.

Apart from the author of a work, the legal owner of a work shall be also entitled to copyright protection. The legal owner of a work may be one of the following:

- (i) The author or co-authors of the work;
- (ii) Organizations and individuals who assign tasks to authors or who enter into contracts with authors;
- (iii) A heir of the authors;
- (iv) The assignee of rights over the works; or
- (v) The State, in certain cases.

In accordance with Vietnamese IP Law 50/2005, the author and copyright holders are defined as (i) Vietnamese organizations and individuals; (ii) foreign organizations and individuals whose works to be protected were first published in Vietnam and not yet published in any other country, or whose works were published in Vietnam within thirty days from the date of the first publication in another country; and (iii) foreign organizations and individuals whose works have been protected in Vietnam in accordance with an international treaty on copyrights to which Vietnam is a member.

## **6.2 Copyrighted Works**

Copyright protection is given to literary, artistic or scientific works which fall within any of the following categories:

- (i) Literary and scientific works, textbooks, teaching materials, and other works expressed written letters or other characters;
- (ii) Lectures, addresses, and other speeches;
- (iii) Press works;
- (iv) Musical works;
- (v) Dramatic works;
- (vi) Cinematographic works and works created by similar methods;
- (vii) Fine art works and applied art works;
- (viii) Photographic works
- (ix) Architectural works;

- (x) Sketches, plans, maps, and drawings relevant to topography or scientific works;
- (xi) Folklore and folk art works;
- (xii) Computer programs and data collections.
- (xiii) Derivative works;

To qualify for protection, a work must be original. The current copyright rules expressly state that copyright protection for a work is granted upon creation of the work in a given work, without subject to publication or registration. The protection is also given to the work irrespective of its form of embodiment and quality.

Derivative works shall only be protected if such protection is not prejudicial to the copyright in the works used to create such derivative works.

### **6.3 Exceptions**

Under the prevailing regulations of Vietnam, the following subject matter shall be excluded from copyrights protection

- (i) News of the day, as mere items of information;
- (ii) Legal legislations, administrative and other judicial documents, and official translations thereof;
- (iii) Processes, systems, method of operation, concepts, principles and data.

### **6.4 Property and Personal Rights of Copyright Owners and/or Authors**

An author and/or copyright owner shall be entitled to certain “property” rights and “personal” rights, as the case may be. Personal rights include (1) to name the work; (2) to have real names or pen names put on the work or have real names or pen names cited when the work is published or used; (3) to publish the work, or permit others to do so; (4) to protect the integrity of the work, to allow or not allow other persons to alter, garble or distort the contents of the work by any means that prejudice against author’s honor and prestige. Property

rights include (1) to make the derivative works; (2) to display the works to the public; (3) to reproduce the works; (4) to distribute or import the originals and copies of the works; (5) to disseminate the works to the public via radio, television, internet or by any other technical means; and (6) to lease the original or copies of a cinematographic works or computer programs. Organizations, individuals who wishes to exploit or use one, several or all of property rights and rights of publication of work are obligated to ask for permission from the copyright owners and pay royalties, remuneration and other material benefits.

## **6.5 Fair Use**

An individual or organization may use a published copyright work for “non-commercial purposes” without the permission of the author and without paying royalties provided such use does not adversely affect the normal exploitation of the work and does not cause any detriment to the author’s enjoyment of copyright in the work. The author’s name and the origin of the work must, however, be mentioned.

“Non-commercial purposes” are defined to include the following acts:

- (i) Making one copy of the work of an author for the purposes of science research and individual teaching;
- (ii) Reasonably quoting a work in order to comment on or illustrate one’s own works, without falsifying the author’s views;
- (iii) Quoting from a work in order to write an article published in a newspaper or periodical, in a radio or television broadcast or in a documentary, without falsifying the author’s views;
- (iv) Quoting from a work in school or university for lecturing purposes without falsifying the author’s views and not for commercial purposes;
- (v) Copying a work for archival in the library and for the purposes of research;

- (vi) Performing a dramatic works or other art work in mass cultural, communication or mobilization activities without collecting fees in any form;
- (vii) Audio-visual recording or a performance in order to report current events or for teaching purposes;
- (viii) Photographing or televising a work of fine-art, architecture, photograph, or a work of applied fine-art displayed at a public place in order to present images of such work;
- (ix) Transforming a work into Braille or into characters of other languages for the blind;
- (x) Importing 1 copy of others' works for personal use.

However, the above-mentioned uses shall not apply to the architectural works, fine-art works and computer software.

## **6.6 Term of Protection**

In general, copyright is protected for the lifetime of the author plus fifty years after his/her death. Some personal rights (such as the rights to name the work, to have the author's name attached to the work, and to protect the integrity of the work) last indefinitely.

With respect to cinematographic works, photographic works, dramatic works, applied art works, anonymous works; the copyright shall last for 50 years from the date of first publication.

## **6.7 Copyright Registration**

In Vietnam, copyright arises as from the date on which a work is created and expressed in a certain material form regardless of its content, quality, form, mean, language, whether or not it has been published or registered. Accordingly, though registration of a work is not required for the work to be protected, registration provides proof of authorship or ownership. In order to register a work, an author or copyright

owner must file an application for registration with the National Office for Copyright Office (NOC), which is based in Hanoi. The application must follow the form specified by the Ministry of Culture and Information and contain papers proving the authorship/ownership of the work, and pay a registration fee. In case the NOC approves the application for registration, the individual who or organization, which holds the registration certificate for the work, will be assumed to be the legal owner of the work in case any dispute regarding the ownership of the work arises.

## **6.8 Assignment and Licensing of Copyright**

An author or copyright holder of a work can transfer all or any of the property rights and the right to publish the work, or given written permission to others to do so in respect of that work to another person or to license another person to use such copyrights or related rights. A licensee to the licensed copyrights or related rights over the work may sub-license such rights in respect of that work upon the consent of the author (or of the copyright holder).

Where a work, performance, audio and visual fixation, or broadcast is under joint ownership, the licensing of copyright or related rights therein must be agreed upon by all co-owners. If a work, performance, audio and visual fixation or broadcast is composed of separate parts that have been separately created by different authors or owned by different copyright/related right holders, such authors or copyright/related right holders may license their copyrights or related rights with respect to their separate parts to other organizations or individuals.

## **6.8 Contract for Assignment and Use of Copyrighted Works**

A contract for the assignment of copyright or related rights must be made in writing and include provisions which specify the following matters: the names and addresses of the



assignor/licensor and the assignee/licensee; the grounds for the assignment/license; the scope of the license (for the licensing of copyright or related right); the price and method of payment; the rights and obligations of the parties; and the liability for contractual breach. Such contracts are not subject to registration to be legally effective. Of note, personal rights are not subject to transfer/licensing, except the right of publication of the work.

## **6.9 Infringement and Enforcement**

An author or owner of a copyrighted work has the right to claim for protection if any of the following acts is conducted in respect of that work without his/her consent:

- (i) Seizing copyrights of a literary, artistic, scientific work;
- (ii) Assuming the author's name of a work;
- (iii) Publishing, disseminating a work without permission of author;
- (iv) Publishing, disseminating a co-author work without permission of other co-author(s);
- (v) Modifying, mutilating or distorting a work in any forms which is prejudicial to the author's honor and prestige;
- (vi) Copying a work without permission of the author or the copyright owner;
- (vii) Making derivative works without permission of the author or the copyright owner of the work used to make such derivative work;
- (viii) Exploiting a work without permission of copyright owner, without paying royalties and remuneration and other material benefits under the law;
- (ix) Renting a work without any payment of royalties, remuneration and other material benefits to its author and copyright owner;
- (x) Photocopying, producing, disseminating, publishing, displaying or communicating a work to the public by broadcasting network or digital devices without permission of

the copyright owner;

(xi) Publishing a work without permission of the copyright owner;

(xii) Intentionally canceling or invalidating technical methods applied by the copyright owner to protect copyrights of his/her work;

(xiii) Intentionally erasing or amending electronic information on copyrights management of a work;

(xiv) Producing, assembling, altering, distributing, importing, exporting, selling or leasing an item of equipment when knowing or having basis to know that such equipment is used for invalidating the technical measures taken by the copyright owner to protect the copyright to his/her work;

(xv) Making and selling a work of which the author's signature is being forged;

(xvi) Exporting, importing, disseminating copies of a work without permission of the copyright owner.

Where his/her copyrights are infringed, the author or owner of the work shall be entitled to apply the following measures for protecting their copyrights:

(i) Taking technological measures to prevent infringement of copyrights;

(ii) Requesting the infringer to cease the infringement, apologize publicly, issue a public rectification, and/or compensate for damage suffered;

(iii) Requesting the competent authorities to handle the infringement;

(iv) Initiating a lawsuit at a competent court or an arbitrator to protect their legitimate rights and interests.

## **6.10 Copyright Protection of Foreign Works**

### **6.10.1 International Conventions and Treaties**

Up to date, Vietnam is the member of the following international convention on copyright protection:

(i) Berne Convention for the Protection of Literary and Artistic Works;

- (ii) Brussels Convention relating to the distribution of program-carrying signals transmitted by satellite;
- (iii) Geneva Convention for the protection of producers of phonograms against unauthorized duplication of their phonograms;
- (iv) Rome Convention for the protection of performers, producers of phonograms and broadcasting organizations.
- (v) Agreement on trade-related aspects of intellectual property rights (TRIPS Agreement)

Accordingly, works belonging to foreign individuals and juridical persons shall be protected in Vietnam if they fall within any of the following:

- (i) Works were first published in Vietnam and not yet published in any other country, or works were published in Vietnam within thirty days from the date of the first publication in another country;
- (ii) Works were created and expressed in a given material form in Vietnam;
- (iii) Works have been protected in Vietnam in accordance with an international treaty on copyrights to which Vietnam is a member.

#### **6.10.2 Vietnam-United States Copyright Agreement**

On 27 June 1997, the United States and Vietnam entered into a bilateral copyright protection agreement (Agreement). The Agreement took effect on 23 December 1998 with an exchange of diplomatic notes between the two parties. The entering into force of the Agreement enables US copyright owners and authors to have a legal basis to take legal action against piracy of their works in Vietnam. The Vietnamese copyright owners and authors have the same rights in the US.

The Agreement protects: (i) works have been protected by either the US or Vietnamese government; (ii) works were first published in either the US or Vietnam; and (iii) works were first published in a country which is a member of a

multilateral copyright treaty to which either the US or Vietnam is a member, provided the copyrights of such works were acquired by a US or Vietnamese copyright holder within one year following the date of the work's first publication.

The Agreement also states that the works of nationals or domiciliaries of the US or Vietnam, which were first published in either country before the Agreement comes into force, will be also given copyright protection, provided that such works have not yet become part of the public domain. However, any copyright infringement committed prior to the Agreement effective date shall not be considered as an act of copyright infringement.

For enforcement, the Agreement specifically requires the two parties, through their national laws, to provide full and effective enforcement of copyrights within their territories by:

- (i) making available in the context of civil actions preliminary injunctive relief, permanent injunctive relief, damages, and the seizure and destruction of infringing goods and materials and machinery predominately used to create them;
- (ii) enacting criminal procedures and penalties to deter infringers from engaging in copyright piracy on a commercial scale, including the imposition of fines and imprisonment sufficient to provide a deterrent, seizure and destruction of infringing goods and materials and machinery predominately used to create them; and
- (iii) making available effective enforcement at their borders, providing for the seizure and destruction of infringing goods in transit or bound for import or export.

With such enforcement measures, the Agreement provides the US copyright holders a higher level of protection than that given to Vietnamese copyright holders by the Vietnamese laws.

### **6.10.3 Vietnam-Switzerland Bilateral Agreement**

Vietnam also signed a bilateral agreement regarding

intellectual property rights with Switzerland on 13 July, 1999. The Agreement came into force on 28 June 2000/ The purpose of the Agreement is to strengthen co-operation between the two countries in the field of IP protection. The Agreement provides that nationals and organizations of each country shall enjoy national treatment.

#### **6.10.4 Memorandum**

Apart from the above-mentioned international conventions and bilateral agreements on copyright protection, Vietnam also signed the following Memorandum:

- (i) Memorandum of Understanding between Department of Intellectual Property of the Kingdom of Thailand and Agencies concerned the Socialist Republic of Vietnam on the Cooperation of the Promotion and protection of intellectual property;
- (ii) Memorandum of Understanding between the Department of Intellectual Property of the Kingdom of Thailand and the Copyright Office of Vietnam on cooperation in the field of copyright and neighboring rights;
- (iii) Memorandum Cooperation in Copyrights and Relevant Rights between the Copyright Office of the Socialist Republic of Vietnam and the National Copyright Bureau of the People's Republic of China.

The signing of these Memorandums shall strengthen mutual protection of copyright and relevant rights in Vietnam and other countries.