

COMMENTS ON THE DRAFT LAW AMENDING AND SUPPLEMENTING SOME ARTICLES OF THE INTELLECTUAL PROPERTY LAW

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The Intellectual Property Law (IP Law) was first adopted in 2005. After more than 15 years of its implementation and 02 amendments in 2009 and 2019, the IP Law has played an important role in maintaining a legal framework for the establishment, exploitation and protection of IP rights for intellectual assets of organizations and individuals in Viet Nam. At present, the IP Law is being amended and supplemented (the Draft IP Law) to overcome several problems arising in practice, ensuring conformity to the current science and technology development and meeting the commitments under the international treaties Viet Nam has engaged in. In this Legal Newsletter, NHQuang would provide our analyses for the Draft IP Law's salient matters which may impact organizations and individuals having rights and interests related to the intellectual assets.

Supplementing the provision that sound can be registered as a trademark

The supplementation of the sound to be considered for protection as a trademark is an advanced provision in line with Viet Nam's commitments under the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP). Although sound is different from traditional trademarks due to its invisible nature, it has been used and combined with products

or services of various businesses. Accordingly, the demand to register IP rights for sound has been in existence for many years. Regarding the forms of representation, the Draft IP Law stipulates that sound signs are shown in graphical representation. The graphical representation has not been addressed and described in detail in the Draft IP Law, however, it may be guided and specified in the following Circular or Regulation guiding the implementation (for example, graphical representation may be in the form of staff drawings, lyrics, sound wave charts, etc.)

Supplementing the circumstance of trademark certificate invalidation if trademarks become generic term

In fact, the applicable IP Law provides that a mark shall be assessed as indistinctive if it is the generic term of goods or services. However, such assessment only takes place in the official examination for considering the grant of trademark certificates. For example, the "Vaseline" mark applied to cover skincare products has been rejected by Vietnam Intellectual Property Office (VNIPPO) since it is determined as a generic, common and essential designation of goods. This supplemented provision of the Draft Law aims to address the potential transformation of a mark to a generic term after being protected. It means that a trademark may not be secured with 100% protection even if it has passed the VNIPPO's examination and acquired the trademark certificate, since such trademark certificate can be still invalidated if there is a basis to determine that the trademark becomes a "generic term". In the market, there are many trademarks for which trademark certificates are granted but they gradually become indistinctive due to the process of transforming to the generic name of products or services. In some cases abroad, trademarks may even lose the protection as a result of court judgments. This new provision of

the Draft IP Law is relevant to the practical context and Viet Nam's commitments in the European Union-Vietnam Free Trade Agreement (EVFTA).

Providing a separate provision on mechanism for opposition against industrial property registration applications

The Draft IP Law provides a separate provision on the procedures for opposition against applications for industrial property registration in Article 112a. In practice, prior to the draft Article 112a, a third party's opposition against an application for industrial property has taken place, relying on Article 112 of the applicable IP Law on "third party's opinions on the grant of protection certificates". However, relevant individuals and companies should note the time-limits for filing their opposition as mentioned in Article 112a of the Draft IP Law: (a) 09 months from the date when an application for invention registration is posted, (b) 04 months from the date when an application for industrial design is posted, (c) 05 months from the date when an application for trademark registration is posted, and (d) 03 months from the date when an application for geographical indication registration is posted. In addition, opposition petitions must be prepared in writing, attached with documents and citing relevant information for illustration and the opposing party must pay fees and charges as regulated.

Supplementing the "bad faith" element to the act of unfair competition related to domain names

Clause 1 Article 52 of the Draft IP Law adds the "bad faith" element to unfair competition acts specified at Point d Clause 1 Article 130 of the IP Law as follows: "*d) Registering, possessing the right to use or using domain names identical with, or confusingly similar to, the protected trade names or marks of others, or geographical*

indications without having the right to use, for the purpose of possessing such domain name with bad faith, benefiting from or prejudicing the reputation and popularity of the respective mark, trade name or geographical indication." This supplement aims to ensure the compliance with information technology and telecommunications legislation as well as compliance with international laws, specifically Article 18.28 of the CPTPP. In addition, it seems that the above-mentioned provision is a reference to the provisions of the Uniform Domain Name Dispute Resolution Policy ("UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), since the "bad faith" element is one of the three conditions for ICANN to consider canceling a domain name. However, the Draft IP Law has not specified the "bad faith" element and this may be provided further in its guiding documents. Referring to UDRP's guidelines, the registration and use of a domain name with "bad faith" may include the circumstances where the registrant registers the domain name (i) for the purpose of selling, leasing, or transferring a domain name to the trademark owner or competitors of the trademark owner, (ii) in order to prevent the trademark owner from reflecting the mark in a corresponding domain name, (iii) for the purpose of disrupting the business of the competitors, (iv) for intentionally attempting to attract the internet users to the website for commercial gain.

At the moment, the Draft IP Law is still being finalized and multiple provisions thereof are being considered with various draft options. Therefore, the interested enterprises should pay attention to frequently monitor the drafting process of the Draft for timely and accurate update of its regulations.

