

Trademark Law in Thailand

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Trademark protection in Vietnam is regulated by the Civil Code, which became effective on July 1, 1996, Decree 63/CP, which became effective on October 24, 1996, Circular No. 3055/TT-SHCN, which became effective on January 15, 1997 and amendment of and addition to Decree 63/CP under Decree 06/2001/ND-CP dated February 1, 2001 which became effective on February 16, 2001.

Vietnam is a signatory to the Paris Convention for the Protection of Industrial Property, the Madrid Agreement concerning the International Registration of Marks, Stockholm Convention establishing the World Intellectual Property Organization and the Patent Cooperation Treaty (PCT). From January 1, 2002, Vietnam officials applied the Eighth Edition of the International Classification of Goods and Services under the Nice agreement for registering trademarks and the Seventh Edition of the International Patent Classification (IPC) for patent registration.

Registration

Patent and trademark matters are within the jurisdiction of the National Office of Industrial Property (NOIP), to whom applications for registration, complaints and notices of infringement are to be filed.

Protected marks include letters, words, devices, pictures, photographs, three-dimensional signs, or any combination thereof, in one or more colors. Vietnam provides for the registration of trademarks, service marks, collective marks and three-dimensional marks.

The following types of marks cannot be registered:

- Marks that are identical or confusingly similar to registered or well-known marks of Vietnam, foreign countries, and international organizations;
- Marks that are identical or confusingly similar to State flags, State emblems, images of national leaders, heroes, or distinguished persons, protected trade names of

another person, geographical indications, or Vietnamese or foreign organizations, unless permission is granted from the competent authority;

- Marks that are simple geometric shapes, a collection of figures or letters incapable of being pronounced, or foreign letters of uncommon languages, except for widely-used signs;
- Marks that are misleading or deceptive as to the origin, nature, purpose, or value of the product or services;
- Generic or descriptive marks;
- Marks that are contrary to public order, morality or prevailing law.

Vietnam follows the first-to-file principle to determine priority of trademark rights when two or more applications file applications to register identical or confusingly similar marks for the same or similar goods or services.

Vietnam does not require evidence of use at the time of filing an application for renewal. In compliance with Article 5(c) of the Paris Convention, Vietnam does afford a grace period of five years regarding non-use.

Application Procedures

Trademark applications must be filed on an official form, which requires the name, business address, telephone numbers, and nationality of the applicant. If the applicant is not a natural person, then the application must include a notarized statement demonstrating the legal existence of the company, describing its activities and listing its authorized representatives. Additionally, the applicant must supply fifteen (15) trademark specimens, a description of the goods or services bearing the mark and their classification, a notarized power of attorney and certified copies of prior applications for priority registration claims.

Applications are examined by the NOIP for form and substance. The NOIP will examine for form within three (3) months from the filing date. If the documents submitted with the application are in proper form, the NOIP will issue a notice of acceptance. If the application is incomplete, the applicant will be given two (2) months to amend the application.

Once the trademark application is accepted in form, the NOIP will examine the trademark application to determine whether the mark conflicts with a prior right. The examination must be completed within nine (9) months from the issuance of the NOA. If the mark passes, a

Certificate of Trademark Registration will be granted and a notice of registration will be published in the Official Gazette of Industrial Property.

If a mark is rejected, refused or invalidated, the applicant may appeal to the NOIP within ninety (90) days, who will examine and issue a decision within thirty (30) days from receipt of the appeal. The applicant may appeal the NOIP decision to the Minister of Science, Technology and Environment within thirty (30) days of notice, who will issue a decision within forty-five (45) days of the appeal. An applicant may appeal through the courts.

The registered trademark is protected for an initial period of ten (10) years, commencing from the date of filing. Registrations may be renewed for successive periods of ten (10) years. Renewal requests should be filed six (6) months prior to expiration, although the NOIP will accept renewal application up to six (6) months after expiration with the payment of additional fees. Well-known marks are protected indefinitely from the time they are recognized as such.

Opposition

Vietnam does not provide for an official opposition procedure. However, the owner of a trademark who discovers that his mark has been appropriated or is confusingly similar to the contested mark may file an unofficial opposition. An opposition should be filed with the NOIP, must provide the reasons why opposition is sought and include evidence to support the claim.

More protection is provided for trademark registrations filed under the Madrid Agreement as all such marks are published in the "Les Marques Internationales" gazette prior to being accepted for registration in Vietnam.

Cancellation

A trademark registration may be cancelled upon application by the owner or any third party if it was registered contrary to law, if the applicant was not entitled to apply for registration, or if the mark does not meet the necessary criteria for protection. A registration may also be partially cancelled if one or more parts are not valid.

Cancellation actions can be filed:

- If the mark has been registered for at least five years and has not been used in Vietnam during the five-year period immediately preceding the cancellation action, and the owner

lacks a legitimate reason for not using the mark. As long as a cancellation action is not commenced, a mark will remain protected even if it is not used for five years or longer.

- When the mark is identical or confusingly similar to a well-known mark as established on the basis of Decision of Recognition of Well-known Trademark under Decree 06/2001/ND-CP. A mark that has been used continuously for prestigious products so that they become widely-recognized in Vietnam and is accorded as a well-known trademark shall be protected perpetually from the date on which the mark is recognized as well known in the decision. To show that a mark is well-known outside of Vietnam, the party should submit documentary evidence of overseas registration, sales, advertising, and other history of use.
- When the registrant ceases to exist and there is no successor with the right to use the mark.
- When the registrant did not have the legal right to apply for trademark protection. E.g. the registrant did not carry on or did not intend to carry on lawful production or service activities, or the registrant was not authorized by the manufacturer of the trademarked product to register the trademark.

Assignment and Licensing

Registered trademarks can be assigned with or without the goodwill of the business as long as it does not cause confusion as to the distinctive characteristics or the origin of the goods or services bearing the mark. Partial licensing of a trademark for a portion of the goods or services is also possible, but partial assignments are not provided for. Assignment of joint mark(s) will only be effected simultaneously for all joint marks. The assignment is required to be registered with the NOIP in order to be legally effective and binding.

Enforcement

Enforcement of trademark protection against infringers can be pursued through criminal prosecutions, civil suits, administrative proceedings, and a number of informal measures. Criminal prosecutions generally have limited rewards for the trademark owner, who may wish to recover damages from the infringer. Higher awards may be obtained through civil suits, but the outcome of civil suits can be unpredictable because the Civil Code is vague in this area of law, and judges have limited experience with these types of cases. As a result, trademark owners may wish to enforce their registrations via state agencies or via informal means, as outlined below.

Administrative actions are handled by the relevant state authorities, which include People's committees of all levels, the specialized IP inspectorate, economic Police agencies, customs and the Market Control Department under the Ministry of Trade. Depending on the severity of the infringement, violators may be subject to warnings, search and seizure, injunction, damages, and the destruction of the infringed goods. Vietnam has implemented procedures for seizing imports and exports bearing foreign trademarks when the manufacturer lacks proof of a legitimate license or permission from the trademark owner. A Customs Law creating a Customs registry for trademarks is currently pending and would allow for more effective enforcement at the country's borders.

Complaints must be filed with the appropriate government agency in the province or city where the infringement occurred. Proof of trademark ownership and evidence of infringement, such as samples of the counterfeit item and the genuine product, must be provided by the complainant. If the challenged mark is not identical to the registered mark but is similar, the NOIP will decide whether the marks are so similar as to cause confusion among the public and whether there has been an infringement. The NOIP will issue its decision within one to three months from the date the complaint is filed.

Licensed IP agents and other authorities in Vietnam cannot assist in infringement cases unless the complainant has already registered the mark in question. Licensed IP agents may also insist on receiving the NOIP opinion letter in order to confirm the infringement before taking any action. Once confirmation is received, the agent may issue a cease and desist letter to the infringer, or the agent may take other actions.

Many infringers are ignorant of the law and may not realize they are violating the law. For example, it is particularly difficult for small shop owners to ascertain the authenticity of the articles offered to them by wholesalers. While this does not constitute a valid legal defense, it is useful to keep this in mind when negotiating with infringers. Informal measures are often more effective than administrative or court remedies in stopping the sale and production of counterfeits. Sending warning letters, meeting with the infringers, or providing confirmation from the NOIP that the goods are counterfeit can put an immediate stop to the infringement. In addition, personal contact with the infringer may provide the trademark owner with valuable information about the source of counterfeits and the manner in which the infringer operates. This information may prove beneficial should formal action and investigations become necessary.