

Settlement of disputes relating to trademarks

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Vietnam

*Training on Opposition and Appeal Procedures for Trademarks and
Industrial Designs*

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Causes of Intellectual Property Rights disputes

- For the IPRs is a form of property (IPRs disputes often relate to the inheritance, assignment).

Ex: “Trung Duong” case

- The use of an IP rights is closely connect to actions against the use of that IP rights of others: self-protection, Civil procedure, Criminal procedure, Administrative procedure; Border procedure; Protection against Unfair-Competition...

Trademark “TRUNG DUONG”

- The trademark “TRUNG DUONG” is protected for the service “photograph”;
- Decision of the Court: each party has the right to keep a shop sign “TRUNG DUONG” after the divorce;
- In that decision, does the Court divide an intellectual property?
- Base to determine the right: the right to apply for a Protection Title; Trade Registration

Causes of Intellectual Property Rights disputes

- Subject matters of Intellectual Property are possibly changeable.
- The Intellectual Property Rights is limited within the territory of a nation, even of a region: trademark “VINATABA”, unfair-competition action.
- The establishment of a Intellectual Property Rights often requests a certain procedure: application of requesting for a Protection Title, publication, assignment...

VINATABA – Territory limitation

- A well-known trademark in Vietnam under the name of Vietnam National Tobacco Corporation;
- An Indonesian Company has applied the trademark “VINATABA” in 12 countries;
- What can Vietnam National Tobacco Corporation do in this situation?
- What are opinions of other related countries?

Right holder prevents the use of his IP subject matter by others

- The right holder himself can request other people to respect his rights.
- The right holder can request authority agencies (Courts, Administrative Agencies, Customs...) to handle acts of violation:
 - + Request to terminate the acts of violation;
 - + Request a compensation for damages caused by the acts of violation.;
 - + Request to full-fill the civil obligations.

Deny of committing an act of violation

- Oppose to the conclusion of the act of violation in the case of trademark “NIKKO” for “air conditional” & trademark “NIKKO” for “air filter system”.
- Committed action relates to various fields:
 - + Parallel importation;
 - + Non-commercial use;
 - + Prior use;
- Request to cancel the validity of related Trademark Registration Certificate.

The establishment of industrial property rights

- Some important IP subject matters (invention, industrial design, trademark...) are established in basing on Registration Certificate issued by an authority agency.
- Trademark Registration Certificate is to confirm a protected industrial property rights over a concrete IP subject matter in a limited territory of a related country.
- To trademarks that are protected under Madrid Agreement, the Registration Certificate is the International Registration accepted by appointed countries.



Mission of the IP Office

- According to regulations of Paris Convention, every country member has to institute an office to committee the mission of establishing IP rights for patent and trademark (minimum condition).
- The IP office is in charge of the following missions:

Receive applications and fees; carry out formal examination; publish all officially accepted applications in the Official Gazette; carry out substantive examination; decide to grant or not to grant a Registration Certificate; settle all appeals and requests of cancellation or termination of the validity of protection titles; maintain the validity of protection titles; furnish information on industrial property.

Terminate/Cancel the validity of a Trademark Registration Certificate

- The termination of the validity of a Trademark Registration Certificate: The owner of a Trademark Registration Certificate has not used the trademark for 5 consecutive years prior to the request for termination of validity and does not have a legitimate reason for this.

(ex: “BOSH”, “VINATABA” in Laos)

- The cancellation of the validity of a Protected Title: The person who has been granted a Protection Title for an invention, industrial design, lay-out design of semiconductor integrated circuit, trademark; The subject matter of the protection does not meet the relevant criteria.

(ex: cancel the validity of a Patent protecting packed hammock in USA and Japan).

Handle infringements of industrial property rights

- The IP rights holder has the following rights:
 - Order the infringer to terminate the infringement, to apologise and rectify publicly, to pay damages;
 - Request authority agencies to handle the infringement according to IP law and other related regulations;
 - File a legal action to the Court or the Arbitrator to protect his legal rights and interests.

Appeals relating to industrial property

- Decisions relating to the above mentioned contents as well as decisions relating to the establishment are appealable:
 - +Decisions of handling infringement of IPRs;
 - +Decisions of termination of the validity of Protection Title;
 - +Decisions of cancellation of the validity of Protection Title;
 - +Decisions of accept/refusal to accept the application and other relevant decisions.

Relation among procedures

- Relation among procedure of dealing with infringements of industrial property rights, establishment of industrial property rights, and termination/cancellation of the validity of Protection Titles.
- + The establishment of industrial property rights basing on an unfair competition objective (the person who is presumed to be the violator of the industrial property rights is in fact the one who has the right to register such subject matter of industrial property) (ex: “EnE” case).
- + Determine the IP right that is infringed (ex: “NIKKO” case).

Trademark “EnE” case

- Hai Binh Company (VN) was granted a Trademark Registration Certificate protecting “EnE” for “petrol pump”.
- Hai Binh requested the Customs to temporary stop the importation of petrol pump from EnE Company (KR).
- EnE Company requested the NOIP of VN to cancel the Trademark Registration Certificate granted to Hai Binh Company for Hai Binh Company used to be the agent of consuming goods for EnE Company.

Relation among procedures

- Relation between the procedure of establishment and procedure of termination/cancellation of the validity of Protection Titles:

During the examination of application of application, weak points of subject matters using to refuse an application are discovered, such as:

- + A protected trademark that has not been used in a period of 5 years after its registration;
- + The subject matter of industrial property failed to satisfy the protection conditions at the grant date of the Protection Title.

Ex: cases “BIRD’S NEST” and “COTTO”.



“BIRD’S NEST”

- Dona Newtower was granted Trademark Registration No. 22912 protecting “BIRD’S NEST” for “soft-drink” in class 32.
- The International Process Food Company infringed the IPRs of Dona Newtower by using trademark “BIRD’S NEST”.
- The International Process Food Company informed that: in English, another meaning of “BIRD’S NEST” is “swallow’s nest”, so it can not be protected as a trademark for products containing swallow’s nest. The soft drink made by Dona Newtower with trademark “BIRD’S NEST” also contains swallow’s nest as one ingredient.

Trademark “COTTO”

- The Thai Ceramic Co., Ltd was granted Trademark Registration No. 28974 protecting “COTTO” for goods in class 19. This company considered that The Glass and Constructive Ceramic Company infringed his right by importing the Italian chains producing ceramic brick bearing trademark “COTTO”.
- The Glass and Constructive Ceramic Company requested the NOIP of VN to cancel in part the validity of the Trademark Registration No. 28974. The main reason is: “COTTO” is descriptive, in Italian, “COTTO” means “baked clay” or “baked ceramic brick”, and was widely used in pointing this kind of goods.

Appeals according to Industrial Property laws

- A person who wants to be owner of an industrial property subject matter has to file an application to the NOIP of VN and follows regulations of procedure.
- The NOIP of VN will accept to grant a Protection Title for the applicant if the subject matter in the application adapt the relevant criteria of protection. On the contrary, the NOIP will refuse to grant a Protection Title or refuse to accept the application if it does not adapt the formality conditions.
- Relevant person or organization can appeal decisions relating to the establishment of IPRs.

Industrial property regulations

- Law Application: Article 220 IP Law
- Any applications which have been filed with competent authorities before the effective date of this Law shall be handled in accordance with legal instruments at the time of the filing of the application.
- Grounds for invalidation of a Protection Title shall only be subject to the provisions of legal documents applicable at the time of its grant.

Industrial property regulations

- Important principle in handling request of invalidation of the validity of a Protection Title:
Grounds for invalidation of a Protection Title shall only be subject to the provisions of legal documents applicable at the time of its grant.
- Decree No. 197 HDBT dated December 14, 1982: “regulations on trademarks”;
- Ordonnance on protecting the industrial property rights;
- Civil Code 1995;
- Intellectual Property Law 2005.



Appeal complies with provisions of the law on complaints

- “Appeal” is an activity in which a citizen, an organization requests an authority agent to review his administrative decision or action as they have a legal base to estimate that the administrative decision or action is illegal, infringed their legal rights and interests.
- “Settlement of appeal” is an activity of verifying, concluding and deciding practiced by an appeal settlement official.

Trademark “Ông Thọ” for “milk”

- In 1994, Friland Frico Domo Company - FFD (Holland) filed an application to request a protection in Vietnam for trademark “LONGEVITY BRAND & ONG THO, figure (of an old man)” for product “milk”.
- This application was refused by the NOIP for the part “ONG THO” because this part is confusingly similar to trademark “ONG THO” of Vietnam Milk Company which had been widely used.
- FFD appeal the refusal decision to the Government by reasoning that FFD is the truly owner of trademark “ONG THO”.

Paris Convention

- Article 6 quinquies

Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

Paris Convention

- Country of origin:
 - Country member of the Convention;
 - Country of the Union where the applicant has a real and effective industrial or commercial establishment;
 - Country of the Union where the applicant has his domicile;
 - Country of which the applicant is a national.

Paris Convention

- Article 6 septies
- If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation.

Paris Convention

- “SA GIANG” is a familiar trademark in Vietnam and also in foreign countries for product “swell shrimp cake”. “SA GIANG” is protected under Registration No. 827 for Sa Giang Company.
- In 1990, Director Chanh of Sa Giang Company authorized the Francexco Import – Export to apply trademark “SA GIANG” in France and other European countries. In France, Francexco Import – Export was granted Registration No. 15591569 and this Company was owner of this trademark in Germany and Benelux under International Registration No. 617723.



Paris Convention

- Article 6bis
- The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods.

Well-known trademark

Budweiser

- “Budweiser” is a well-known American trademark of Anheuser Busch for “beer”.
- “Budweiser” is also a long-standing trademark of Budejovic Budvar (Czechoslovakia) that protected in many European countries.
- A famous conflict in the world and also in Vietnam.
- The Anheuser Busch requested to cancel the validity in Vietnam of the International Registration protecting “Budweiser”.

Related legislative texts

- Law of Appeal and Accusation.
- Ordonnance on procedure of settlement administrative cases.

Ordonnance on procedure of settlement administrative cases

- Appellant: individuals, organizations who estimate that their legal rights and interests are infringed by an administrative decision or action.
- Defendant: organ, director of the organ, officials who issued the decision which is considered illegal by the appellant party.
- People whose rights and interests are related to the result of settlement of administrative appeal.

Ordonnance on procedure of settlement administrative cases

- The Court's jurisdiction: The People's Court at the provincial level has the jurisdiction at first instance over administrative actions against administrative decisions of ministries, ministerial level agencies where the plaintiff's residence or working place (if the plaintiff is an individual) or headquarter (if the plaintiff is an organization) is found.

Ordonnance on procedure of settlement administrative cases

- The Court rejects the complaint in the following cases:
 - + The plaintiff does not have the right to lodge the suit;
 - + Expiration of the time limit for the plaintiff to lodge the suit and the plaintiff has no suitable reasons for his lateness;
 - + Condition to sue an administrative action is not met;
 - + The case has been settled by a sentence or an enforced decision of a Court;
 - + The Court has no jurisdiction over the case.

Case “Anphanam”

- “ALPHA” is protected for “gold” (class 14)
- “ANPHANAM” is protected for service “gold merchandise” (class 35)
- Owner of “ALPHA” requested the NOIP to cancel the validity of “ANPHANAM”. The NOIP rejected the request for those two trademarks are not confusingly similar.
- Owner of “ALPHA” sued the case to the Court and the Court accepted to receive the complaint.
- The NOIP objected to the acceptance of the Court by the reason that the owner of “ALPHA” did not have the right to sue the case because he had not appealed the reject decision of the NOIP.

Terminate the validity of the Registration

- The trademark has not been used by its owner or his licensee without justifiable reasons for a term of 5 consecutive years prior to a request for termination of validity, except the use is commenced or resumed at least 3 months before the request for termination

Terminate the validity of Trademark registration protecting “BOSS”

- Reemstma Cigarettenfabriken GmbH requested the NOIP to terminate the validity of 6 registrations protecting “BOSS” granted to the Hugo Boss AG (product “cigarette” and “cigarette equipment – cl. 34). The NOIP accepted this request for the following reason:
 - The Hugo Boss AG did not produce or merchandise “cigarette” in the world.
 - The Hugo Boss AG did not submit any evidence proving his use of trademark “BOSS” for registered products.
 - The Hugo Boss AG appeal the decision of invalidation: he has a justifiable reason for his non-use of the trademark in Vietnam.

Cancellation of the validity of Registration

- Reasons:
 - + The applicant for registration neither has right to registration nor has been assigned such right;
 - + The registration for an invention, utility solution or industrial design incorrectly states the creator due to misinformation supplied deliberately by the applicant;
 - + The subject matter of the registration does not meet the relevant criteria.

Cancellation of the validity of Registration

- Causes:
 - Information supplied by the applicant is incorrect (The applicant for registration neither has right to registration nor has been assigned such right, the registration states incorrectly the creator);
 - Patent information is not enough to; determine the criteria for protection;
 - Result of NOIP's examination is not up to date with the appearance of new products;
 - Interior conflict of the registration's holder (especially due to the division of organization);
 - Complicity from the origin of the industrial property subject matter.

Cancellation of the validity of Registration

- Disputes relating to the origin of the product
Ex: trademark “BUDWEISER”

One of the reasons mentioned by Budejovic Budvar for the cancellation: “BUDWEI” is an old name of a region which has a tradition of producing “beer” in Czechoslovakia. That’s the reason why Vietnam can not protect “BUDWEISER” for an American Company.

“BIRD’S NEST”

- Dona Newtower was granted Trademark Registration No. 22912 protecting “BIRD’S NEST” for “soft-drink” in class 32.
- The International Process Food Company infringed the IPRs of Dona Newtower by using trademark “BIRD’S NEST”.
- The International Process Food Company informed that: in English, another meaning of “BIRD’S NEST” is “swallow’s nest”, so it can not be protected as a trademark for products containing swallow’s nest. The soft drink made by Dona Newtower with trademark “BIRD’S NEST” also contains swallow’s nest as one ingredient.

Determinate the act of violating IP rights

Base on the protected trademark can determinate the act of violation such as:

- Act of using protected object
- The producer is not the right holder
- Illegal use the protected object (time, procedure...)

Using the protected Trademark

In comparison of two factor is Trademark and product/service that applied

- Trademark unidentical with protected Trademark
- Trademark is considered confusingly similar to protected Trademark

Products and service of the same class:

- Function, purpose of use, service;
- Producing technology, material...
- Market, supply (territory, consumer...)

Using the protected Trademark

Example – trademark “Supermaxilite” has protected for “paint”
(class 02)

- Supermaxilite & Supermaxilitex
- Supermaxilite & Nippon Supermaxilitex
- Supermaxilite & Nippon Supermaxilitex & figure

Analysis:

- Structure
- Meaning
- Possibility of confusing
- Combination and appearance

Using the protected Trademark

Example – Figure trademark “Two colliding bulls” protected for “softdrink” (class 32):

- Colliding Buffalow
- Colliding animals
- Heading animals.

Analysis:

- Meaning of each element;
- Procedure of use;
- Effect to customers.

Using the protected Trademark

Comparision of products and services

-Foundation powder and paint

-Soya milk (class 32) & condensed milk (class 29)
(Truong Sinh case)

-Cigarette (class 34) & Cigarette box in silver (class 14).

-Milk (class 29) and tea (class 30).

Decision of refusal to grant the Protection Title

- Trademark is not protected because of confusingly similar to another protected trademark (with earlier priority date).

Appealable cases:

- a. Prove that trademarks can be identified for they are applied in different products: condensed milk & soya, bisquite & pizza, air purifier & air conditioner;
- b. Reference trademark is requested for cancelation (for bad faith).

Decision of refusal to grant the Protection Title

Reference trademark is requested for invalidation (for not using in 5 consecutive years)

- d. Prove that the registered trademark and the reference trademark are co-exist without causing confusion:
 - Letter of consent of reference trademark (especially when they are in the same cooperation)
 - Agreement of co-existence (with the limitation in goods or services)
 - Both of them are well-known trademarks (ex: BUDWEISER).
- e. Prove that the similar element in those trademarks is a common element or a descriptive character, so that element is not distinctive (ex: pharmaceutical products).

Decision of refusal to grant the Protection Title

2. Trademark is not protected for it is a simple sign and signs without distinctive characteristics.

Appelable cases: trademark was widely used before the applicant date, so that it can be identified. (333, BBC, Bank of America).

3. Trademark is not protected for it is a descriptive sign.

Appelable cases: the trademark of the applicant is a well-known trademark, however it lost its distinctiveness when being used, and now, its distinctiveness is reestablished. (VADOLIN for “skin – care”, “FRIDGE” for “refrigerator”, “XEROX” for “photocopier”).

Appeals, suits relating to IP rights

- Decisions of refusal to accept the application;
- Decisions of termination of the validity of Protection Title;
- Decisions of cancellation of the validity of Protection Title;
- Decisions that relate to the refusal/the granting of Protection Title and other relevant decisions;
- Other decisions (such as: decisions of registration of contracts for transfer of industrial property right)

Person who has right to appeal

- A. Appeal in first instance:
 - Applicant requesting to grant the protection title for invention, utility model, industrial design, trademark (including well-known trademark), and geographic identification;
 - Person who requests for invalidation or cancellation of the validity of protection title (for invention, utility model, industrial design, trademark, geographical indication).
 - Person who requests for registration of contracts for transfer of industrial property right;
 - Person who claims the right of prior use.
 - Other related parties.

Person who has right to appeal

B. Appeal in second instance:

Person who made first instance appeal, related parties.

C. Related parties

Those whose rights and interests are effected by that administrative decision (author, right holder, person who request to confirm his prior use; parties in a transfer contract).

Petition

The content of petition must be presented in a written form (a file). A petition file must include the following contents:

- The appellant, the Industrial Property Representative: name, address, nationality...
- Contents subject to the appeal (decision, document of the NOIP, subject matter of the industrial property, owner of the industrial property rights, author...)
- Request of the appellant to the NOIP, explanatory and legal statements, necessary reasons to apply those legal statements.
- Evidences accompanied with the petition document and explanation about the use of those evidences in proving or clarifying the reason of petition.

Responsibility of appellant and related parties

The appellant and the related parties have the following responsibilities:

- Be honest when providing opinions in the petition file and other documents submitting to the NOIP.
- Satisfying in time all requests from NOIP concerning the petition matter.
- Be liable for the consequences of providing false evidence.

Appeal with the participant of an IP Representative

An IP Representative shall provide services concerning the appeal within the scope of authorization determined in a written power of attorney

An IP shall not simultaneously represent parties in conflict of IP rights

A. The IP representative who represents the appellant to request for an invalidation / termination of a Protection Title is also the one who represented the owner of that Protection Title in the procedure of registration.

B. The IP representative who represents the appellant to appeal against the decision of refusal to grant the Protection Title by reason the subject matter in the application is similar to a subject matter or IP having an earlier priority date is also the one who represented the owner of the later subject matter in his establishment of IP rights.

V. Authority agency

1. National Office of Intellectual Property (NOIP)
2. Ministry of Science and Technology
3. Administrative Court

National Office of Intellectual Property (NOIP)

- The NOIP is the first national authority agency who is responsible to receive, settle petitions relating to decisions of refusal to accept an application, of refusal to grant a Protection Title and petitions relating to the invalidation/termination of a Protection Title.
- The NOIP can cooperate with other authority agencies in settling cases concerning IP rights, especially in determining the scope of protection of a protected subject matter of industrial property or in furnishing information about a protected subject matter of industrial property....

National Office of Intellectual Property (NOIP)

Accepting jurisdiction over petition files

- NOIP has responsibility to receipt of a petition file, the person authorized to resolve the petition shall check the file to ensure that it complies with the requirements of formality then issue a notice to the appellant informing that jurisdiction has been accepted. Jurisdiction shall not be accepted over petition files in the following cases
- (i) The appellant does not have the right to lodge the appeal;
- (ii) The appeal was lodged outside the limitation period for lodging appeal;
- (iii) The petition file fails to satisfy the requirements.

National Office of Intellectual Property (NOIP)

Examination of the petition file

- Check the petition file: The petition file will be checked over the formality, evidences, legal position of the appellant, of the Industrial Property Representative (for their name).
- Inform the appellant: if necessary, the National Office of Intellectual Property shall send a notice to request the appellant to do the following things:
 - + To amend, clarify the request in the petition file, submit more evidences or complete the submitted evidences...
 - + Give opinion over the reasons and opinions of the other party.
- Inform the relevant party of:
 - + Name and address of the appellant and the Industrial Property Representative (if there is such agency).
 - + The request of the appellant, legal base and other related reasons, arguments and evidences.

National Office of Intellectual Property (NOIP)

Treatment of the content of the appeal

- Basing on the arguments, evidences in the petition file, the opinions of the third party and other documents relating to the content of the petition lodging to the NOIP, the NOIP will determine the reasonability of the request made by the appellant (basing on regulations relating to industrial property).
- If the content of the appeal is against the result of examination of the subject matter of industrial property, the NOIP will reconsider that result of examination (procedure of re-examination).

National Office of Intellectual Property (NOIP)

Expert opinion

- To make sure that the grant of a Protection Title is in compliance with regulations, the NOIP can request specialize offices and experts on related fields for their opinions.
- Specialize offices and experts that are asked for opinions from the NOIP are responsible for giving opinions in an honest, objective and responsible way. They have the right to get a remuneration for their opinions. The rate of remuneration depends on the quantity and quality of their opinions and the maximum rate of remuneration payable to the specialize offices and experts on related fields can not be over 40% of the fees for content examination applicable for the subject matter in question.

Expert opinion

- Purpose
- Representative (in person, by group...)
- Working mechanism
- Working achievements
- Value

National Office of Intellectual Property (NOIP)

• Decision on resolution of appeal

A decision on resolution of an appeal will be sent to the appellant and related parties with the following content:

- The main content of the petition file;
- The opinion of the NOIP on the content of the appeal basing on relevant regulations on the intellectual property;
- Conclusion about the appeal (accept or not accept the request of the appellant in the petition file) and conclusion about the maintenance, the amendment, invalidation, termination of the decisions or granted Protection Title that are appealed.

Ministry of Science and Technology

- In case of disagreement with the settlement decision of the NOIP, the appellant and the persons with rights and interest directly related to such decision shall have the right to appeal to the Ministry of Science and Technology (second appeal).

The Administrative Court

- The Administrative Court can handle litigations relating to decisions of grant or decision of refusal to grant a Protection Title, decisions of invalidation/termination of the validity of a Protection Title according to the request of related parties if they disagree with the decision of the NOIP or the Ministry of Science and Technology.

The Administrative Court

1. Litigation to decision of refusal to grant a Protection Title “MERCURE” according to application of Dai Nam Hotel;
2. Litigation to decision of cancellation Trademark “Á Lâm 999”;
3. Litigation to decision of opposition for cancellation Trademark “Quốc Thái”;
4. Litigation to decision of refusal to grant a Protection Title “SUPER MAXILITE”
5. Litigation to decision of cancellation Trademark “EnE”;