

## MAY 2009 Vietnam: Distributor's trade mark registration overturned

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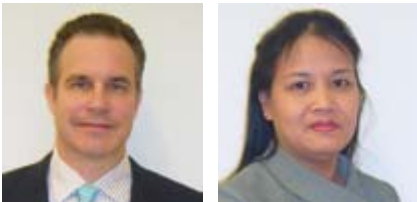
On January 16 2009, the Appeals Court of the Supreme People's Court in Ho Chi Minh City overturned a ruling of a lower court in a trade mark cancellation case that has drawn the attention of many IP practitioners and scholars in Vietnam.

The rights holder in the case was Vien Son Company, which was an exclusive distributor of Kingmax computer memory chips in Vietnam. Vien Son, as an exclusive distributor of Kingmax (Taiwan), which is a computer memory chip manufacturer, had registered the Kingmax trade mark in Vietnam. Upon discovering that other companies were also importing Kingmax chips into Vietnam (parallel imports), Vien Son filed a request with the Customs authorities to seize any imports of Kingmax chips into Vietnam by third parties. As a result, the Customs authorities at Tan Son Nhat Airport in Ho Chi Minh City seized a shipment of Kingmax RAM chips imported by a local computer company valued at \$11,340.

The local computer company then filed a cancellation petition with the National Office of Intellectual Property (NOIP) seeking the cancellation of Vien Son's Kingmax registration on the grounds that Vien Son as a distributor had no right to file for the registration of the trade mark Kingmax that is used by the manufacturer on its products. The NOIP then issued Decision no 1352/QD-SHTT cancelling Vien Son's registration despite the fact that the Kingmax (Taiwan) computer memory chip manufacturer had authorised Vien Son to file for the trade mark registration.

Vien Son then filed an administrative case in the Ho Chi Minh City lower court against the NOIP, maintaining that the cancellation of its registration was not warranted or proper under the law. The lower court agreed with Vien Son and vacated the NOIP's cancellation order. However, in its decision, the Appeals Court upheld the decision of the National Office of Intellectual Property that had cancelled the trade mark registration for the trade mark Kingmax that was held by Vien Son.

This ruling once again reminded IP owners that they should register their trade mark in their own name when deciding to enter their products into the Vietnamese market to ensure the normal circulation of their products in the market, and also affirmed that distributors are not allowed to register the manufacturer's trade mark in their own name in Vietnam, even if the manufacturer allows them to do so.



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