

VIETNAM

New guidance on enforcement regime

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On June 26 2015, the Ministry of Science and Technology (MOST) issued Circular 11/2015/TT-BKHCN providing guidance on the implementation of Government Decree 99/2013/ND-CP dated August 29 2013 on administrative sanctions in industrial property. The new circular took effect on August 11 2015. Because administrative measures play a very important role in the enforcement of IP rights in Vietnam, Circular 11 was eagerly awaited as it would provide a replacement for Circular 37/2011/TT-BKHCN dated December 27 2011, a document originally designed to provide guidance on the now-expired Decree 97/2010/ND-CP dated September 21 2010. Attempts to implement Decree 99 while referring to the old circular often led to legal barriers and conflicts that were difficult to reconcile.

Though it contains several new provisions, Circular 11 maintains a troublesome provision: IP right holders should be aware that in the process of resolving domain name disputes by administrative measures in cases where the use of the domain name is considered an act of unfair competition, the owner of the trade mark/trade name/geographical indication must provide evidence demonstrating that the infringer has continued to use a confusing trade mark, trade name, or geographical indication in its domain name(s) despite being requested to terminate the use by the rightful owner. This condition is a de facto obligation to send an advance warning. Many commenters in the drafting process had recommended removing this obligation from the circular, but the competent agencies did not agree.

Circular 24 clarifies domain name revocation

Shortly after Circular 11 took effect, the

Ministry of Information and Communications (MIC) issued Circular 24/2015/TT-TTTC dated August 18 2015 on the management and use of Internet resources. Among the many general provisions of Circular 24, which takes effect on October 10 2015, there are brief but important provisions on a subject of considerable interest: Guidance on the mechanism for resolving disputes over .vn domain names.

Article 12 of Circular 24, which sets out the circumstances in which domain names are to be revoked, reconfirms the viewpoints of the MIC on the procedures for resolving domain name disputes when it mentions in Article 12.1(a) that domain names will only be revoked pursuant to the execution of minutes of successful conciliation by the parties to the dispute, a legally effective decision of an arbitrator, or a legally effective judgment or decision of the court. Circular 24 also mentions the revocation of domain names by administrative measures, but stipulates that this revocation requires a decision on administrative sanctions from an inspectorate of information and communications [Article 12.1(c)]. It does not, however, provide for the revocation of domain names under a decision on administrative sanctions from the Inspectorate of MOST, the agency that most frequently handles and resolves similar types of disputes. This shows that Circular 24 does not resolve situations where, in the past, there has been a lack of coordination among agencies in resolving domain name disputes. Circular 24 only opens up other possibilities for domain names to be revoked when it stipulates that they may be revoked in other cases as prescribed by the government, which provides some flexibility in choosing enforcement bodies.

Other documents racing against the clock

There are at least two further documents related to the enforcement of IP rights which may be forthcoming — a joint circular relating to the coordination mechanism between the MIC and MOST in the enforcement of administrative decisions on domain names subject to IP infringement (this is expected to resolve the aforementioned coordination issue) and a circular on the coordination mech-

anism between MOST and the Ministry of Planning and Investment in the enforcement of administrative decisions on revocation or removal of enterprise names/trade names subject to IP infringement. At the moment, it appears that these circulars need to be issued before July 1 2016; otherwise they will be unenforceable, because when the new Law on Promulgation of Legal Documents takes effect on July 1 2016, joint circulars between ministries will no longer be defined as legal normative documents that are recognised in Vietnam's legal system.

Faced with such a situation, if there is not effective cooperation and a drastic plan of action between the concerned ministries, the likelihood that joint circulars will be issued prior to the time mentioned above is very remote, which will lead to the odd situation in which many important regulations cannot practically be enforced despite everyone being aware of the risk in advance.

The agencies, particularly MOST, are actively drafting the joint circulars to be able to resolve the difficulties related to the revocation of domain names and enterprise names, with the hope that such efforts will eventually bring about concrete results.