



Linh Thi Mai Nguyen
Head of Trademark - Vietnam
mailinh.n@tilleke.com

3D Trademarks in Vietnam: Multiple Dimensions of Uncertainty

Under Vietnam’s Intellectual Property Law, three-dimensional trademarks are registrable, with the same criteria for protection as two-dimensional marks. However, a sense of confusion is inevitable when looking at the overall picture of 3D mark registration in Vietnam.

The NOIP’s View on Inherent Distinctiveness

The National Office of Intellectual Property (NOIP) has recently taken the stance that 3D marks without distinctive word/device/color elements are not inherently distinctive. Such 3D marks are usually refused protection on the grounds either that they are descriptive of the products, even if the 3D shapes are unique and nonfunctional, or that they are the common shapes of the products and are therefore generic. If a mark is considered descriptive, it can only be registered if it has obtained secondary meaning through use. If it is considered generic, it is not registrable, strictly speaking, even with evidence of use. However, there is a fine line between descriptive and generic in Vietnam. In many cases, even if a 3D mark is refused for being generic, it can be registered if the owner can prove that the 3D shape has obtained secondary meaning.

To prove secondary meaning, evidence of use of the mark in Vietnam (before the filing date) is the most influential factor. Evidence of use in other countries is considered, but carries less weight. The NOIP has sole discretion in deciding whether the evidence is sufficient to prove secondary meaning, and its examiners’ rulings tend to be subjective. For example, if a particular shape of bottle is commonly found in the market—even if this is the result of a 3D mark being widely counterfeited—the examiner may view this as evidence that the mark is nondistinctive because it is merely the common shape of the product.

But trademark owners can also meet with positive outcomes. For example, the NOIP recently granted protection to Cartier’s famous “Red Box” 3D mark based on intensive evidence of use of the mark in Vietnam and around the world.

Different Division, Different Practice

Setting aside the issues of prior rights, it can be difficult to understand why some marks are granted protection, while others are refused. For example, a search for 3D marks in the NOIP and WIPO online databases identifies four different bottles of spirits, each with curves and

patterns contributing to what would appear to be similarly distinctive designs. Yet two of these bottles were granted protection as 3D marks, while two were refused. In fact, two of the marks—one approved, one rejected—belong to the same owner, a famous European whiskey brand.

The chief difference in these cases, then, does not appear to be one of distinctiveness, but rather that the two refused marks were extended to Vietnam under the Madrid Protocol, while the two approved marks were filed as national applications. In fact, one may find that 3D marks filed through the Madrid system are rarely granted protection, while 3D marks filed as national applications are more commonly approved.

The reason lies in the different practices of the examiners. Currently, international registrations designating Vietnam are examined by the geographical indication (GI) division, while national applications are examined by the trademark division. Examiners in these divisions hold different views on 3D marks. Specifically, examiners in the trademark division often approve protection for 3D marks that combine a distinctive element (word or device) and a product shape, but require the 3D shape to be disclaimed. Conversely, examiners at the GI division often refuse such marks, as they hold the view that for 3D marks, the 3D device is the single most important element, and if the 3D device (the shape) is not distinctive, then the mark should not be protected, because the purpose of protecting a 3D mark is lost if the mark is protected as a whole but the 3D shape is disclaimed. Unlike national applications (where the NOIP has sole discretion over disclaimers), for international registrations, the NOIP cannot by itself disclaim a certain element of a mark, unless the applicant voluntarily and clearly indicates a disclaimer in the international registration. Without the ability to add a disclaimer, the NOIP opts to simply refuse these marks.

Confusing Scope of Protection

Taking a closer look at some of the 3D marks that have been granted protection, one might wonder what exactly is being protected in these marks, since the 3D shapes, word elements, and devices are *all* disclaimed. The answer, of course, is that it is the *combination* of these elements that is protected. Or, in other words, the protection of such marks is only useful against counterfeiting where the counterfeit goods copy the exact shape and all the word/drawing/color elements on that shape. If a counterfeiter copies the shape only, in principle, that is not considered trademark infringement, as the shape is not separately protected.

Despite the inconsistencies and shortcomings discussed above, trademark owners are advised to pursue 3D mark registration if they seek protection of a 3D mark in its entirety. Additionally, they should opt for national trademark filing for a better chance of success. Though the current practice may not protect 3D marks to the extent owners desire, a certificate of registration will always be a plus for enforcement purposes, as the enforcement authorities usually request such documents before taking any actions. 🍷

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