

VIETNAM

What constitutes “material alteration” of a mark?

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Article 115 of Vietnam’s IP Law prohibits any amendment of a mark in a pending application that “materially alters” the character of the original mark or expands its scope of protection. However, the question of what constitutes material alteration in Vietnam is not easily answered, as the law remains silent, and the interpretation of the National Office of Intellectual Property (NOIP) can vary depending on the department or the examiner.

In common practice, the NOIP considers that the *deletion* of portions of a mark, even if the deleted portions are dominant, does not materially alter the original mark but rather narrows its scope of protection. For example, during the substantive examination of a mark on relative grounds, the NOIP may refuse registration for a portion of the mark for all or some classes of goods/services. The applicant can typically overcome this partial refusal by deleting the portion of the mark subject to the refusal and submitting a new mark without the refused portion to obtain a registration.

The issue of material alteration also arises when considering whether the evidence of use of a mark in different forms is accepted as use of the original mark, for proving secondary meaning or defending a non-use cancellation. In principle, a mark in actual use which is considered to be a material alteration of the original mark will not be accepted as use of the original mark.

Item 39.5(b) of Circular 01/2007/TT-BKHCN guides that to be accepted as having acquired distinctiveness through use, an applied-for mark must be presented in the form in which it has been uninterruptedly and widely used. In common practice, the NOIP often strictly follows this guidance and may not

accept evidence of a use of mark in different forms as admissible evidence showing the secondary meaning of the original mark. Article 124.5 of the IP Law stipulates that the mark in actual use should be the “protected mark,” which can also be understood to mean that the mark in actual use should be exactly the same as the mark in the registration. However, in practice, the NOIP commonly applies the approach under Article 5 of the Paris Convention, to which Vietnam is a member, that the “use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the [registered] mark ... shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.”

For mark owners, the common practice in Vietnam is to obtain a registration for a mark in a standard font. The owner may then rely on evidence of use of its mark in a stylized form to demonstrate the genuine use of the registered mark in defense of a non-use invalidation action. However, conversely, the use of a mark in a standard font is often not accepted as genuine use of a registered stylized mark. Similarly, the use of a mark in colour is usually accepted as genuine use of a mark registered in black-and-white, but if the mark is registered in colour, the use of the mark in black-and-white, or in a different colour, may not be accepted as genuine use of the registered mark.

Again, in practice, the issue of whether the mark in actual use is a material alteration of a registered mark has been assessed inconsistently. In the 2006 case *Vina Acecook v Asia Foods*, the NOIP’s decision on settlement of non-use invalidation action against the registered mark “VIFON ACECOOK, HAO, mi tom chua cay, Device” stated that the owner’s change and addition of descriptive elements to the registered mark, including the word “huong vi” (“flavour”), and a pepper and vegetable device, was not a material alteration. The NOIP thus accepted evidence of use of such mark as genuine use of the challenged mark. However, the NOIP decided to partially invalidate the word portion “VIFON” in the registered mark, which is the trade name of the mark owner, due to non-use. The petitioner then appealed the NOIP’s decision and the case is still pending.

In view of the inconsistencies, trade mark holders should re-evaluate their portfolios to minimise any possible risk. If possible, they should file applications to seek registration of their marks in both black-and-white and colour, or in any colour combination, particularly when the colour combination is likely to be considered the distinctive aspect of the mark. Similarly, it is advisable for mark holders to file applications for marks in both standard and stylized fonts. If only one mark is chosen, it is advisable to file the version of the mark that is in use or will be used. If the mark is to be used in different forms, a black-and-white version in a standard font should be filed. If, for some reason, the manner of the mark which the holder uses steps away from the original registered mark, it is advisable to file a new mark.