

VIETNAM

Addressing the conflict between trade mark and copyright in relation to logos

Tilleke & Gibbins

Hanoi



Linh Thi Mai Nguyen and Son Thai Hoang

Under Vietnamese law, if a logo is capable of distinguishing the goods or services of its holder from those of others, it can qualify for trade mark protection. If the logo is created personally by the author without copying others' works and is fixed in a material form, it can also be copyrighted as a work of applied art (assuming it meets the minimum creativity threshold).

Such parallel protection by both trade mark and copyright laws can lead to a conflict of rights when one party obtains trade mark rights to a logo through registration with the National Office of Intellectual Property (NOIP), while another party obtains protection for an identical or confusingly similar logo through the copyright regime. How does the law address this conflict? The answer depends on which right existed first.

If copyright arose first

There is no direct provision that a trade mark registration will be invalidated if it is identical or similar to a prior copyrighted logo. However, there are some indirect provisions that a copyright owner can rely on to challenge a trade mark registration. Article 17 of Decree No 103/2016/ND-CP of September 22 2006, guiding the implementation of the IP Law, stipulates a principle on respecting previously established IP rights: "industrial property rights of an organisation or individual may be invalidated or banned from exercise if they conflict with previously established intellectual property rights of another organisation or individual."

This provision can be understood to mean that a third party can rely on its

prior copyright (an intellectual property right) for a logo to invalidate a trade mark registration, if the use of the logo protected by the contested registration conflicts with its copyright. But it does not work the other way around, as it specifies that only "industrial property rights", not "intellectual property rights", may be invalidated. However, as this provision is vague (it does not provide concrete circumstances/conditions for the invalidation) it is rarely applied in practice.

Another relevant provision is Point 39.4(g) of Circular No 01/2017/TT-BKHCN guiding the implementation of Decree No 103/2006/ND-CP, which stipulates that a sign is ineligible for protection as a trade mark if it is identical or confusingly similar to images or characters or figures in other persons' widely known works under copyright protection, unless it is so permitted by the owners of those works. Strictly speaking, a logo would not likely be regarded as characters or figures in the context of the above provision. As such, this provision is also not likely to be applicable to settle the conflict of rights.

If trade mark right arose first

Article 55 of Vietnam's IP Law provides that a certificate of copyright registration can be invalidated if the certificate holder is not the real author/owner, or the registered work is ineligible for protection. As such, if it is discovered that the owner of a copyrighted logo copied that logo from another's trade mark (personal creation is a prerequisite for copyright), the certificate for such copyright could be invalidated. In reality, however, it is not easy to prove/conclude the act of copying, especially if the two logos are not identical. If the trade mark owner cannot prove that the copyright holder copied its logo, the subsequent copyrighted logo can co-exist with the trade marked logo.

Shortcomings of the law

It is clear that the law does not provide sufficient solutions to address the conflict of rights, leaving a loophole for sly infringers to purposely seek copyright protection for a logo as a defence against trade mark infringement charges for their

use of such logo.

As a result, registration and enforcement authorities face difficulties in handling conflicts between trade mark and copyright in a consistent and appropriate manner. The NOIP, in one opposition proceeding, agreed with a copyright holder to refuse registration of a logo as a trade mark on the grounds that it conflicted with an earlier established copyrighted logo. However, in a similar case where the copyright holder sought to invalidate a trade mark registration based on its prior copyrighted logo, the NOIP rejected the request.

The Copyright Office of Vietnam (COV) may agree to invalidate a copyright certificate if a third party can successfully prove that the copyright holder copied rather than created its logo, but, as discussed above, proving the act of copying is extremely difficult, and often requires a court case. In one recent case, the COV refused to cancel a dubious copyright registration, the trade mark holder who had created the logo sued in court, and the court ordered the registration to be cancelled.

Recommendations

Until the law is revised to effectively settle the conflict of rights between trade mark and copyright, IPR holders should consider obtaining registration for logos by both trade mark and copyright regimes to maximise protection in Vietnam.

Although registration of a copyright with the COV is not mandatory for copyright protection, it is generally recommended since a certificate of copyright registration is useful prima facie evidence of ownership in conflicts and/or enforcement. Furthermore, copyright protection requires no evidence of use to be maintained, while a trade mark registration may be cancelled if the registered logo has not been used for five consecutive years. In addition, copyright is not limited by class of goods and services, so if a third party's logo is used on goods or means of services which are not identical or similar to those bearing the registered trade mark, copyright enforcement can possibly be applied where trade mark protection fails.