

VIETNAM

Is a VIPRI opinion the secret to enforcement success?

Tilleke & Gibbins

Hanoi and Ho Chi Minh City



Tom Treutler and Loc Xuan Le

When pursuing an IP enforcement case in Vietnam, counsel will often inform rights holders about the need to obtain a VIPRI opinion as a first step. VIPRI (Vietnam Intellectual Property Research Institute), a quasi-governmental organisation, is the only agency in Vietnam authorised to provide expert opinions (statutorily known as assessment conclusions) on IP infringement.

A useful enforcement aid

Rights holders in an infringement action may ask VIPRI to issue an official but non-binding opinion on whether an IP right (patent, industrial design, or trade mark) is infringed. A favourable VIPRI opinion, finding that a product or service infringes an IP right, can then be submitted to an enforcement agency, such as the Inspectorate of the Ministry of Science and Technology, the Market Surveillance Department, or customs. Based on the non-binding opinion, the enforcement agency can consider whether to proceed with enforcing the IP rights of the complainant, such as by proceeding with an administrative raid and the issuing of sanctions. Courts can also rule on IP cases, and a VIPRI opinion can be very persuasive evidence for the court to rule in the rights holder's favour.

Enforcement agencies do not require a VIPRI opinion to take action, and in many cases have taken action against infringers without a VIPRI opinion. However, for matters such as trade mark infringement where the marks differ slightly, or patent infringement where technical claims must be analysed, the existence of the VIPRI opinion will help the enforcement agency to feel more comfortable proceeding with the enforcement action, and will generally re-

sult in a faster action with more predictable results. VIPRI is recognised for having a strong group of technical experts, and many of its leaders and examiners are former leaders of Vietnam's National Office of Intellectual Property (NOIP).

Obtaining a VIPRI opinion

To seek a VIPRI opinion, the rights holder must fill in a standard form that requires basic information such as the trade mark or patent registration number of the petitioner. Samples or pictures of the infringing product may be submitted with the form. Additionally, a mini brief is often filed wherein the petitioner can explain any nuances of the case, or provide more detailed analysis, for example, by submitting a claim chart and infringement analysis in a patent infringement case.

Information on the well-known character or wide use and recognition in Vietnam of a trade mark or design can be presented to support a VIPRI petition and may be persuasive. However, VIPRI will not opine on the well-known status of a trade mark and cannot declare a trade mark to be well-known; only the NOIP and the enforcement bodies will issue opinions on well-known status.

Generally, VIPRI opinions are issued within two to four weeks after the petition is filed. The longer end of this range typically applies in complex patent petitions, where technical claims must be analysed. For very straightforward trade mark infringement cases, a VIPRI opinion can sometimes be obtained in only a week.

Tips and best practice

In some cases, both the rights holder and the alleged infringer could petition VIPRI, one seeking to prove infringement, one seeking to prove non-infringement. If a second petition is filed for the same case, VIPRI will generally follow the opinion it issued in relation to the first petition. Thus, it is advantageous to be the first to seek an opinion from VIPRI.

If multiple rights are being infringed in a matter, for example, if a product infringes

both a word mark and a logo that are separately registered, it is advisable to seek a separate VIPRI opinion for each IP right. This is to safeguard against a situation in which a favourable opinion and an unfavourable opinion are contained in the same document, and when disclosing the favourable opinion, the unfavourable one is also necessarily disclosed to the infringer and perhaps other parties. Generally, there is no duty to disclose a VIPRI opinion. Thus, any separate negative opinion can be filed in a drawer, and not disclosed. The practitioner may then just use the favourable decision when submitting the case to the enforcement authorities.

Naturally, care should be taken in this case, as if an undisclosed opinion is later revealed in the course of litigation, it may cause the practitioner to lose credibility with the arbiter. An opinion could be discovered if the alleged infringer were to later file a petition for an opinion on non-infringement, as mentioned above, in which case VIPRI would note that it had already ruled on the matter.

Overcoming an unfavourable VIPRI opinion

Many rights holders may be inclined to give up on an infringement action if they are given an unfavourable VIPRI opinion on infringement. However, victory can be seized from the jaws of defeat in this situation. The rights holder still has several options to consider, including not disclosing the opinion to the enforcement agency, seeking a separate professional opinion from the NOIP, or petitioning VIPRI to reverse its opinion. Though reversals are very rare, they have been granted on a few occasions, based on the submission of more persuasive evidence and particularly well-crafted arguments.