

NOTICE

On the application of a number of provisions of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP)

On 12 November 2018, the 6th Session of the 14th National Assembly of Vietnam ratified the CPTPP under Resolution No. 72/2018/QH14. On 26 November 2018, the Ministry of Foreign Affairs and Trade of New Zealand issued Document No. LGL/CPTPPD/2018-15 announcing that the CPTPP would come into effect in Vietnam on 14 January 2019.

On the basis of the provisions specified in Article 6.1 of the 2016 Law on Treaties and Article 5.3 of the Law on Intellectual Property (the “IP Law”), the National Office of Intellectual Property of Vietnam (NOIP) agrees to apply a number of intellectual property obligations where there are differences between the CPTPP and the IP Law and other related legal documents before these obligations are stipulated in legal documents, as follows:

I. OBLIGATIONS AND METHODS OF APPLICATION

1. Article 18.27

Obligation: Recordal of trademark licenses is not required: (i) to establish the validity of the license; or (ii) as a condition for use of a trademark by a licensee to be deemed to constitute use by the holder in a proceeding that relates to the acquisition, maintenance or enforcement of trademarks.

Method of application:

As from the effective date the CPTPP, all trademark licenses shall be valid for third parties regardless of their registration with the NOIP (rather than as under Article 148.2 of the IP Law).

The use of a trademark by a licensee under a license as stipulated in Article 124.5 of the IP Law shall be regarded as the use of the trademark by the owner in the procedures for acquisition, maintenance and enforcement of trademarks, regardless of the registration thereof with the NOIP.

2. Article 18.32.1.b

Obligation: In the procedures for protection or recognition of a geographical indication, it is required that the geographical indication may be refused when a third party objects to the protection or recognition of the geographical indication on the ground that the protection or recognition of such geographical indication is likely to cause confusion with a trademark that has been protected in Vietnam.

Method of application:

When a third party provides an opinion as to a geographical indication application, the NOIP will receive and handle it in accordance with Point 6 of Circular No. 01/2007/TT-BKHCN of the Ministry of Science and Technology dated 14 February 2007 guiding the implementation of Decree No. 103/2006/ND-CP of the Government dated 22 September 2006 detailing and guiding the implementation of a number of articles of the Law on Intellectual Property on industrial property, as amended and supplemented under Circular No. 13/2010/TT-

BKHCN dated 30 July 2010, Circular No. 18/2011/TT-BKHCN dated 22 July 2011, Circular No. 05/2013/TT-BKHCN dated 20 February 2013 and Circular No. 16/2016/TT-BKHCN dated 30 June 2016.

Opposition to a geographical indication application by a third party for the reason that the geographical indication is “likely to cause confusion” with another person’s protected trademark must be considered instead of (the reason that the geographical indication) “will cause confusion” as set forth in Article 80.3 of the IP Law.

The assessment of the likelihood of causing confusion must take into account the fact that the geographical indication is oftentimes a pre-existing object (regardless of the registration) and is known by many people, or even well-known, and is thus likely to “be confused” rather than “cause confusion” with a trademark.

3. Article 18.32.5

Obligation: If the protection or recognition of the translation of transliteration of a geographical indication is provided through administrative procedures, then such procedures and the grounds for protection/cancellation must be equivalent/identical to those applicable to regular geographical indications.

Method of application:

Applications for geographical indications in the form of translation or transliteration filed as from the effective date of the CPTPP are handled in the same manner applicable to regular geographical indication applications.

4. Article 18.33

Obligation: In determining whether or not a term is the common name of goods in Vietnam, the authority must be allowed to take into account how consumers understand the term in Vietnam.

Method of application:

In the process of examining geographical indication applications, with regard to those filed as from the effective date of the CPTPP, the determination of whether or not a term is the common name of goods in Vietnam as set forth in Article 80.1 of the IP Law must be based on how consumers in Vietnam understand the term, which may include the following factors: (i) whether or not the term is used to refer to the type of goods in question in sources of information such as dictionaries, newspapers, market research reports, and related websites; (ii) how the goods referenced by that term are marketed and used in trade in Vietnam (i.e., being used in recognized international standards to refer to a category or group of goods, e.g., import and export tariffs, etc.).

5. Article 18.34

Obligation: An individual component of a multi-component term that is protected as geographical indication shall not be protected if that individual component is the common name of the associated goods.

Method of application:

In respect of geographical indication applications filed as from the effective date of the CPTPP, if a geographical indication is a multi-component geographical indication of which an individual component is identified as the common name of goods in Vietnam, then the component will be excluded from the scope of protection (with a disclaimer thereon) when the multi-component geographical indication is approved protection in Vietnam.

6. Article 18.38

Obligation: In determining if an invention is novel or has an inventive step, each Party shall disregard at least information contained in public disclosures if the public disclosure: (i) was made by the patent applicant or by a person that obtained the information directly or indirectly from the patent applicant; and (ii) occurred within 12 months prior to the date of the filing of the application in the territory of the Party.

Method of application:

As from the effective date of the CPTPP, the provisions of Article 60.3 of the IP Law regarding the circumstances where an invention shall not be considered as lacking novelty shall be applied as follows:

- The invention is publicly disclosed by the person having the right to registration or the person who obtained the information directly or indirectly from the person having the right to registration (regardless of whether this information is obtained with or without permission of the person having the right to registration); and

- The public disclosure in the above-mentioned circumstance occurs within no more than 12 months before the filing date of the patent application at the NOIP (without consideration of the priority date).

Information disclosed publicly in the above case shall not be used as a cited document (not in the “state of the art”) to determine the novelty or inventive step of the invention concerned.

II. SUBJECTS OF APPLICATION

According to the National Treatment and Most-Favored Nation principles of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the principle of National Treatment of the Paris Convention for the Protection of Industrial Property, the above guidelines are applicable to applications filed by organizations and individuals who are citizens of member countries of the World Trade Organization (WTO) or the Paris Convention, and:

- Applications for Invention Patents/Utility Solution Patents whose filing dates range from 14 January 2019 onwards; or

- Applications for geographical indications whose filing dates range from 14 January 2019 onwards.

Should any issues arise during the implementation process, please promptly report them to the NOIP (through the Legal and Policy Department) for consideration and resolution.

Recipients:

- Leaders of departments under the NOIP (for implementation);
- Ministry leadership (for reporting);
- Departments of Science & Technology, IP representative organizations (for information);
- NOIP leadership; and
- Archives: Admin., Legal and Policy Dept.

DIRECTOR GENERAL

(signed and stamped)

Dinh Huu Phi