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A Roadmap to VIPRI Opinion Success in Vietnam

Rightsholders enforcing trademark, industrial design, or patent rights in Vietnam will often be advised by counsel of the need to obtain a “VIPRI opinion” as a first step in an enforcement case. The Vietnam Intellectual Property Research Institute (VIPRI) is the only agency in Vietnam authorized to provide expert opinions on IP infringement. VIPRI is a quasi-governmental organization, and many of its leaders and examiners are former leaders of Vietnam’s patent and trademark registry, the Intellectual Property Office of Vietnam (“IP Vietnam”—formerly known as the National Office of Intellectual Property or NOIP). Rightsholders or potential defendants in an infringement action may petition VIPRI to issue a non-binding, official opinion on whether an IP right has been infringed. It should be noted that VIPRI will only opine on patent infringement, industrial design infringement, and trademark infringement. VIPRI will not opine on matters of unfair competition or copyright.

A favorable VIPRI opinion, finding that a product or service is infringing an IP right, can then be submitted to an enforcement agency, such as the Ministry of Science and Technology (MOST) Inspectorate, the Market Surveillance Department (MSD), customs, etc. Then, 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 issuance of sanctions (such as fines, seizure and destruction of infringing products, etc.). Courts can also rule on IP cases, of course, and a VIPRI opinion can be very persuasive evidence for the court to rule in the rightsholder’s favor.

It should be noted that the enforcement agencies do not require a VIPRI opinion to take action, and in many cases have taken action against infringers without a VIPRI opinion in hand. However, for matters such as trademark infringement where likelihood of confusion is in question, or where technical patent claims must be analyzed, the existence of the VIPRI opinion will help the enforcement agency to feel more comfortable to proceed with the enforcement action, and generally will result in a faster action with more predictable results.

Petition Form

VIPRI has a form that must be filled in when petitioning for its opinion. The form requires basic information such as the trademark or patent registration number of the petitioner. Samples of the infringing product (or pictures of samples) may be submitted with the form. Additionally, a mini-brief is also often filed with the VIPRI opinion in which the petitioner can explain any nuances of the case, or provide more detailed analysis, such as by submitting a claim chart and infringement analysis in a patent infringement case.

Occasionally, in cases where it is desirable to show the

distinctive nature of a trademark or design, a market survey showing various third-party marks is sometimes submitted to bolster the uniqueness of the rightsholder’s trademark or design. Additionally, some information on the well-known character or wide use and recognition in Vietnam of a trademark or design can also be presented to support a VIPRI petition and may be persuasive. However, VIPRI will not opine on the well-known status of a trademark and cannot declare a trademark to be well-known—only IP Vietnam and the enforcement bodies will issue opinions on well-known status.

If multiple IP rights are being infringed in a matter, it is advisable to seek a separate VIPRI opinion on each right. For example, if a word mark and a logo that are separately registered are both being infringed by a product, the best practice is to seek two separate VIPRI opinions. This is to safeguard against the situation in which one of the VIPRI opinions is favorable, and the other is not. If both are contained in the same document, the unfavorable opinion will unavoidably be disclosed to the infringer, and perhaps other parties as well, when disclosing the favorable one. Otherwise, there is generally no duty to disclose a VIPRI opinion, and any separate, negative opinion can be filed in a drawer, and not disclosed. The practitioner may then only use the favorable decision when submitting the case to the enforcement authorities.

VIPRI Timeline

Generally, VIPRI opinions are issued within two to four weeks after the petition is filed with VIPRI. The longer end of this range typically arises in complex patent petitions, where technical claims must be analyzed. It should be noted that VIPRI has a strong stable of technical experts, with former IP Vietnam examiners in the chemical, biological, mechanical, and electrical arts. For some very straightforward trademark infringement cases, a VIPRI opinion can sometimes be obtained in only a week.

Is a Losing VIPRI Opinion the End of the Case?

Many rightsholders will tend to give up on an infringement action if they are dealt an unfavorable VIPRI opinion on infringement. However, as mentioned, victory can be seized from the jaws of defeat in this situation. Here are a few actual scenarios where the rightsholder came out on top at the end of the action, despite a losing VIPRI opinion at the beginning of the case.

1. VIPRI opinion on trademark infringement lost. Trademark owner then sought IP Vietnam’s opinion on unfair competition, and won unfair competition action.
2. VIPRI opinion lost, but the rightsholder successfully petitioned VIPRI to reconsider. After receiving new evidence and arguments, VIPRI revised its opinion, and an enforcement action was undertaken.
3. VIPRI opinion lost, but not disclosed. Rightsholder then went to enforcement agency, who took action without any opinion.
4. VIPRI opinion lost and disclosed to enforcement agency. Enforcement agency disagreed with the opinion and still took action.
5. Similar to (3), but the rightsholder sought a second opinion from IP Vietnam that turned out different than the unfavorable VIPRI opinion. The enforcement agency then took action. This scenario is rare, but has occurred, even though VIPRI and IP Vietnam usually concur in their opinions.

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Therefore, it is important to creatively consider strategy in the event of an unfavorable VIPRI opinion, as there may be light at the end of the tunnel as has been shown by the above cases.

VIPRI Opinions Sought by Infringers and the Race to VIPRI

It is true that a potential infringer could also seek confirmation from VIPRI that their trademark, design, or patent is not infringing. This is often done in regard to industrial designs related to cars or motorbikes, or parts thereof.

Could there be a case in which both the rightsholder and the infringer petition VIPRI for their opinion? Yes, this could happen. Generally, VIPRI handles matters on a first-come, first-served basis in an *ex parte* fashion—only reviewing the evidence submitted by the first petitioner. Thus, it is advantageous to arrive first at VIPRI. If a second petition is filed seeking an opinion relating to the same potential infringement (or non-infringement), VIPRI will generally just follow the opinion it issued in relation to the first petition.

Administrative and Civil Action Opinions

Often in Vietnam, infringement cases begin as administrative infringement actions filed with the MOST Inspectorate, MSD, etc., but then evolve into civil cases filed in court. This can occur due to a shift in strategy during the case. For example, a rightsholder may wish to seek compensation for damages which are not available in an administra-

tive action, or a court action may be perceived to have a stronger deterrent action. One important practice point to note is that the court will generally request that the parties seek a new VIPRI opinion on the matter after the civil action commences, and the court will not totally rely on (and may not even consider) a prior VIPRI opinion obtained in the earlier administrative action. The reason for this is that the court wants to rely more on opinions sought during the course of the civil litigation, as they are considered as comporting more with the procedural processes and are part of the body of evidence considered in the civil case.

Disclosure of Opinions

Vietnam's IP and professional ethics rules do not have requirements on disclosure. There is no requirement for a lawyer to inform an administrative enforcement agency or a court about an unfavorable VIPRI opinion. However, care should be taken, as if an opinion is not disclosed but is later revealed in the course of litigation, it may cause the practitioner to lose credibility with the arbiter. Such an opinion could be discovered if the infringer were to later file a petition for an opinion on non-infringement, in which case VIPRI would note that it had already ruled on the matter.

Conclusion

As discussed above, VIPRI's and IP Vietnam's opinions and practices play a critical role in the ultimate outcome of an IP infringement case in Vietnam. There are many strategic considerations that must be made at the outset of the case to keep the case momentum going in favor of the rightsholder, and to pick the best road to victory. 🏆