



NEWS

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THE NATIONAL ASSEMBLY APPROVED 11 LAWS

The 13th session of Legislature XIII of the Vietnamese National Assembly (NA) concluded on June 26, 2015. In this session, the NA approved:

1. Law on Government Organization (amended);
2. Law on Local Government Organization;
3. Law on the Vietnam Fatherland Front (amended);
4. Law on Election of National Assembly Deputies and Local People's Council Members;
5. Law on State Budget (amended);
6. Law on State Audit (amended);
7. Law on Promulgating Normative Legal Documents;
8. Law on Military Service (amended);
9. Law on Natural Resources, Marine and Island Environments;
10. Law on Veterinary; and
11. Law on Labour Safety and Hygiene.

In addition, the NA also adopted 9 resolutions and discussed 15 other important draft laws.

LAUNCH OF ONLINE CONSULTATION TOOLS FACILITATING REGISTRATION OF TRADEMARKS AND DESIGNS IN ASEAN REGION

On August 25, 2015, ASEAN countries officially launched the online consultation tools facilitating the registration of trademarks and designs in ASEAN region, namely:

ASEAN Tmview: offers public online access to information on nearly 3 million trademark registrations and applications having effects in the participating ASEAN countries. (For more detail, see www.asean-tmview.org)

ASEAN TMclass helps you search for and verify the correct classification of those terms for goods or services in accordance with the criteria established by the International Classification (Nice Agreement) as well as those established by ASEAN for the purpose of the registration of marks, with over 13,800 names of goods and services accepted by all ASEAN IP Offices. (For more detail, see www.asean-tmclass.org), and

ASEAN Designview: offers public online access to information on more than 80,000 registered industrial designs having effects in the participating ASEAN countries. (For more detail, see www.asean-designview.org).

The above said online consultation tools facilitating the registration of trademarks and designs have been developed by the Intellectual Property Offices of the ASEAN Member States with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III), and were officially launched during the Singapore IP Week this past August. These tools are provided free-of-charge.

**VIET NAM RECOGNIZES
THE IP OFFICE OF SINGAPORE AS AN
INTERNATIONAL SEARCHING AUTHORITY
(ISA), AND INTERNATIONAL PRELIMINARY
EXAMINING AUTHORITY (IPEA)
UNDER THE PCT**

 On September 8, 2015, the National Office of Intellectual Property of Vietnam (NOIP) issued Notification No. 8450/TB-SHTT officially recognizing the Intellectual Property Office of Singapore (IPOS) as an International Searching Authority (ISA), and International Preliminary Examining Authority (IPEA) under the PCT.

The NOIP's decision is believed to create more opportunities and convenience to the Vietnamese entities and individuals who use PCT international filing system to seek patent protection in foreign countries. In detail, Vietnamese applicants now have one more option of ISA and IPEA to apply to their PCT applications in addition to the Intellectual Property Offices of Australia, Russia, Sweden, Republic of Korea, Japan and the European Patent Office which were previously recognized by the NOIP.

PCT patent applications filed in Vietnam, Mexico, Brunei, Japan and Laos will be the first to gain access to Singapore's new service as an International Searching Authority and International Preliminary Examining Authority in the coming months. These arrangements were set out under bilateral agreements signed during the IP Week in Singapore this past August.

Previously, at the 46th session of the Assembly of the PCT Union (PCT Assembly) held in Geneva during the period from September 22 to 30, 2014, the Assembly appointed the IPOS as an ISA and IPEA under the PCT. Late August 2015, IPOS did notify the WIPO that it would officially begin operations as ASEAN's first ISA and IPEA from September 1, 2015.

For information regarding relevant service fees of IPOS or other National IP Offices that have been recognized as an ISA or IPEA, please see updates at <http://www.wipo.int/pct/en/appguide/index.jsp>

**VIETNAM AND EU
CONCLUDED NEGOTIATION ON
FREE TRADE AGREEMENT**

 On August 04, 2015, the European Union and Vietnam officially established principles for the basic content of the EU – Vietnam Free Trade Agreement (“EVFTA”), after three years and several rounds of intense negotiation.

The EVFTA is a comprehensive agreement including the following main contents: Trade of Goods, Principles of Origin, Customs, Sanitary and Phytosanitary (SPS), Technical Barriers to Trade (TBT), Trade of Services, Investment, Trade Defence, Competition, State Owned Corporation, Government Procurement, Sustainable Development, Capacity Build and Cooperation, Intellectual Property and Legal Matters.

Concerning the intellectual property rights, Vietnam has committed to a high level of protection, going beyond the standards of TRIPs agreement. The scope of intellectual property protection include copyright, patent and other commitments relating to geographical indications and pharmaceutical products.

Concerning geographical indications, when EVFTA takes effect, 169 of the EU's geographical indications will be protected in Vietnam and 39 of Vietnam's geographical indications will be protected in the EU, all of which are for agricultural products and foodstuffs. Concerning the pharmaceutical sector, EU will benefit from improved data protection and the possibility to extend patent protection to up to two years in case there are delays in obtaining authorization.

**TRANS PACIFIC PARTNERSHIP AGREEMENT
REACHED**

 According to a Joint Statement by Trans Pacific Partnership (TPP) Ministers at their Meeting on October 05, 2015 in Atlanta, USA, the members of TPP has reached a final agreement after five years of intense

negotiations.

The Agreement was reached after nations had solved remaining challenging issues from the TPP Ministers Meeting in July, 2015, in Hawaii, USA, including intellectual property protection with regards to pharmaceutical products, market access of some sensitive products such as automobiles or milk...

Immediately after the conclusion of the TPP negotiations announced, an updated "Summary of the Trans-Pacific Partnership Agreement" has been published on the official website of Office of the United States Trade Representative (USTR) presenting the main features and contents of the TPP's 30 chapters. (Please see more details at: <https://ustr.gov/about-us/policy-offices/press-office/press-releases/2015/october/summary-trans-pacific-partnership>).

To formalize the outcomes of the agreement, negotiators will continue technical work to prepare a complete text for public release, including the legal review, translation, and drafting and verification of the text. However, currently it is unclear when the TPP will be officially signed.

TPP is a free trade agreement which involve nine countries: The United States, Australia, Brunei Darussalam, Chile, Malaysia, New Zealand, Peru, Singapore, and Vietnam.

STATISTICS: APPLICATIONS FILED WITH AND REGISTERED BY THE NOIP DURING THE FIRST HALF OF 2015

According to statistics of the National Office Intellectual Property of Vietnam ("NOIP"), in the first six months of 2015, a total of

14,964 applications for registration of industrial property right filed with the NOIP, representing an increase of 17% over the same period last year. The number of registrations of patents/utility solutions, industrial designs and trademarks granted by the NOIP in the first six months of 2015 was 7,741, representing an increase of 2% over the same period a year ago. The table below shows details of applications filed with and registrations granted by the NOIP during the period.

APPLICATIONS FILED

	Patent	Utility Solution	Industrial Design	Trade-mark	Total
First half of 2015	252	114	678	13905	14949
First half of 2014	206	125	684	11691	12706

REGISTRATIONS GRANTED

	Patent	Utility Solution	Industrial Design	Trade-mark	Total
First half of 2015	26	36	434	7245	7741
First half of 2014	25	43	434	7058	7560

NEW LEGISLATION

REGULATION NO. 01/QC-SHTT-TTRBKH&CN-DTCBL-QLTT-CSKT ON COORDINATING AND SHARING INFORMATION THROUGH THE IPR ENFORCEMENT INFORMATION SYSTEM

On August 14, 2015, a number of intellectual property right (IPR) enforcement authorities of Vietnam have jointly promulgated the Regulations No. 01/QC-IP-TTrBKH&T-DTCBL-QLTT-CSKT on coordinating and sharing information through the IPR enforcement information system (hereafter referred to as "Regulation"). This Regulation has been developed within the framework of the project "Strengthening IPR enforcement in Vietnam" funded by Japan International Cooperation Agency ("JICA") and aimed at enhancing the effectiveness

of prevention and sanctions against acts of counterfeiting and infringement of industrial property rights.

The IPR enforcement authorities participating in this program include the National Office of Intellectual Property (NOIP), the Inspectorate of the Ministry of Science and Technology (MoST), the Market Management Department under Ministry of Industry and Commerce (MoIC), Anti-Smuggling Investigation Department under the General Department of Custom, Ministry of Finance and the Economic Police Department under Ministry of Public Security.

According to this Regulation, the IPR enforcement authorities shall periodically provide information by directly inputting data into the IPR enforcement

information system. Of note, information about the seizures of and sanctions on counterfeit goods and goods infringing IPRs (including information about the seized goods, infringers, act of infringement, types of goods, quantity, decisions to apply sanctions, information on registrations for customs monitoring requests) will be monthly provided by the Inspectorate under MoST, Market Management Department under MoIC, Anti-Smuggling Investigation Department under the General Department of Custom (in case there are new information or final decisions).

Regrettably, the said information shall probably be only provided and shared by and between the IPR enforcement authorities, as the Regulation does not mention the possibility of access by the public.

CIRCULAR NO. 11/2015/TT-BKHCN ON SANCTIONS AGAINST ADMINISTRATIVE VIOLATIONS IN THE FIELD OF INDUSTRIAL PROPERTY

On June 26, 2015, Ministry of Science and Technology (MoST) issued Circular No. 11/2015/TT-BKHCN detailing and guiding a number of articles of Decree No. 99/2013 on sanction against administrative violations in the field of industrial property. Circular 11/2015 came into effect as of August 11, 2015, replacing the old Circular No. 37/2011/TT-BKHCN. Some of the most remarkable new changes under Circular 11/2015 are as follows:

1. Concerning Additional Sanctions

Circular 11/2015 has clarified conditions for imposing additional sanctions. Its Article 3 clearly specifies that confiscation of goods and means of administrative violation as described in Article 3 and Article 12 of Decree 99/2013 shall be applied where there is willful violation and one of the following: (i) when it is necessary to ensure that material evidences and means of violations are not destroyed or dispersed or changed, or to prevent the possible subsequent violations; (ii) Violators are unidentifiable.

2. Determination of the value of Infringing Goods/Services

Circular 11/2015 provides for new method of determination of the value of infringing goods/services in its Article 5. Accordingly, the total value of the infringing goods/services shall be determined according to the following formula: Total value of infringement goods/services is (=) the quantity of infringing goods or volume of infringing services multiplied by (x) the unit price of infringing goods or services at the time of the administrative violation.

(i) In case where there are grounds to believe that listed prices stated in contracts or invoices or import declarations are untruthful, competent authority shall apply next prices in the priority order:

- The price according to the notice of local financial authority;
- In case there is no notice of price, the price shall be based on the market price in the localities at the time the administrative violations occurred;
- The cost price of infringing goods if the goods not yet been brought out for sale.

(ii) In case where there are grounds to apply the above provision (i), a competent person handling the case may issue a decision on temporary seizure of evidences of infringement and form a valuation council.

3. Concerning Acts subject to Administrative Sanctions

Circular 11/2015 supplemented some provisions on acts which are subject to administrative sanctions. Of particular note is act of infringing upon industrial property rights on the internet. According to Article 10, IPR infringing acts which occur on the internet, but are aimed at consumers or information users in Vietnam shall be considered as acts subject to administrative sanctions in Vietnam. In addition, owners of national domain names that hire organizations or individuals to perform the above described acts shall also be subject to administrative sanctions.

4. Concerning Procedures for Applying Administrative Sanctions

Circular 11/2015 has supplemented requirements concerning documents proving the right to request competent authority to handle infringement cases (Article 23) and the competence of the head of specialized science and technology inspection teams (Article 27).

Of particular note, Circular 11/2015 has no longer contained provisions on coordination for handling cases of infringement related to domain names and to enterprise names. Instead, a joint circular is expected to be issued by Ministry of Science & Technology, Ministry of Information & Communications and Ministry of Planning & Investment to regulate this issue.

CIRCULAR No. 13/2015/TT-BTC: NEW REGULATIONS ON CUSTOMSPROCEDURE

On January 30, 2015 Ministry of Finance issued Circular No.13/2015/TT-BTC to replace Circular No.44/2011/TT-BTC dated

April 1st, 2011 providing guidelines on inspection, supervision, temporary suspension of customs procedures for exported and imported goods subject of request for enforcement of intellectual property rights (“IPRs”); control of counterfeit goods and goods infringing IPRs. This new circular became effective as of March 15, 2015 and has the following new features in comparison with the old Circular 44/2011:

1. New regulations on manner to handle counterfeit goods or goods with signs of counterfeit

Pursuant to the old Circular 44/2011, upon detecting the goods suspected of IPR infringement, Custom Authority had only to send to the IPR holder a notice containing the following information: name of goods, quantity of goods, value of goods, origin of goods, importer, exporter, invoice number. Whereas, in accordance with Article 14 of the new Circular 13/2015, in addition to the above information, Custom Authority must send photographs of suspected goods (if any) to the IPR holder. This new requirement is expected to facilitate process of determination by IPR holders of whether the suspected goods are effectively counterfeit goods, so that they can rapidly decide to submit or not an official request for temporary suspension of custom procedure in order to enforce their IPRs.

2. IPR holders will be provided with more information on goods suspected of IPR infringement

Pursuant to Article 14 of Circular 13/2015, IPR holders will be given 05 working days to respond to the Custom Authority’s notice as to whether they will file an official request for temporary suspension of custom procedure or not. Whereas, under the old Circular 44/2011, this period was limited to only 03 working days.

3. New regulation on the manner to handle counterfeit goods or goods having signs of counterfeit

Pursuant to Article 13 of Circular 13/2015, during the time of carrying out their duty, if counterfeit goods or goods with signs of counterfeit are detected, the Custom Authority shall proceed as follows:

- (i) In case of detection of counterfeit exported, imported goods, preventive measures and sanctions shall be applied in accordance with legal provisions on handling of administrative violations.
- (ii) In case of detection of exported and imported goods with signs of counterfeit, the Director of the Sub-department of Customs shall request the person who made customs declaration to

provide with the following documents related to the goods: (a) sale contract of goods or other equivalent evidence: 01 copy; (b) technical documents or certificate of analysis (if any): 01 copy.

- (iii) In case the owner of the genuine goods is identified, he/she shall provide documents related to goods (including catalogs, expert’s assessment, documents from abroad, results of handling of similar cases etc...). In case the owner of the genuine goods cannot be identified, Customs Authority shall proceed to identification based on customs dossiers, actual goods, results of analysis of risks associated with the goods and anti-counterfeiting legal provisions; cooperate with customs control forces to investigate and verify (if necessary) or transfer information, case files to customs control forces for further investigation, verification and handling of the case.

4. Change of competent department in charge of receipt and handling of the requests for temporary suspension of custom procedure in relation with IPR infringement.

Pursuant to Article 6 of Circular 13/2015 on filing application for inspection, supervision of exported or imported goods subject to request for IPR enforcement, the competent Department in charge of receipt and handling requests for temporary suspension of custom procedure in connection with IPR enforcement is Customs Management Supervision Department. Previously, the competent department was the Smuggling Investigation and Prevention Department.

**DECREE No. 21/2015/ND-CP:
NEW REGULATIONS ON ROYALTY AND
REMUNERATION FOR CINEMATOGRAPHIC,
ARTISTIC, PHOTOGRAPHIC AND
THEATRICAL WORKS AND OTHER FORMS OF
ARTISTIC PERFORMANCE**

On February 14, 2015 the Government issued Decree No. 21/2015/ND-CP providing for royalty and remuneration for cinematographic, artistic, photographic, theatrical works and other forms of artistic performance, replacing Chapters I, III, IV, VIII, IX and X of Decree No. 61/2002/ND-CP of the Government on Royalty Regime. Decree 21/2015 becomes effective as of April 15, 2015.

Previously, on March 14, 2014, the Government issued Decree 18/2014/ND-CP guiding the royalty regime in the fields of press and publication. Thus, Decree 61/2002 has been replace in whole by the two Decrees 21/2015 and 18/2014. Some of remarkable new features of Decree 21/2015 in comparison with the old Decree 61/2002:

- Similarly to all of legal texts adopted after 2005 (date of adoption of the IP Law), Decree 21/2015 replace the notion “owner of the work” used in Decree 61/2002 by the notion “copyright owner” to be in line with provisions of the current 2005 Civil Code and the 2005 IP Law.

- With regard to persons subject to application of Decree 21/2015: This new Decree is applied only to organizations/ individuals creating, exploiting or using works funded by the State or organizations/ individuals exploiting or using copyrighted works owned by the State.

- Principles of payment of royalty and remuneration: Beside the principle of mutual agreement by the parties, Decree 21/2015 ensures

payment of royalty not only to the author and owner of derivative copyrighted work, but also to the author and owner of the original work in case of use and exploitation of the derivative work.

- Of note, Decree 21/2015 has expressed recognition of the economic value of the works and creative efforts of creators and artists and facilitated negotiation and agreement between author and user on royalty and remuneration based on the quality of the work.



OPPOSITION AGAINST REGISTRATION OF THE TRADEMARK “RIVER WOOD” AND THE NOTION OF “WIDELY USED TRADEMARK”

D&N International has recently succeeded in opposing against the registration of the trademark “RIVER WOOD”, which is substantially identical to the trademark “RIVER WOODS”, owned by one of its Clients. Of note, this mark has been registered and widely used in many countries around the world, but not in Vietnam.

Facts

The Client, American Clothing Associates (“ACA”) is the sole proprietor of the trademark “RIVER WOODS” for goods/services in classes 3, 9, 14, 16, 18, 20, 24, 25, 35 & 40 (“Trademark”), which has been registered and used in numerous countries around the world and has been recognized as well-known in some countries.

Having discovered that one Vietnam-based company named Công ty Cổ phần Dệt may Đầu tư Thương mại Thành Công (“Thành Công Company”), had applied for registration of the trademark “RIVER WOOD” (“the Opposed Mark”) substantially identical to the Trademark, for the similar/ related services in classes 35, 36, 37, 43 & 44, on 29 May 2012, ACA company, represented by D&N International, filed with the NOIP an opposition against granting a registration certificate to the Opposed Mark.

In the opposition, ACA argued that the Opposed Mark was not qualified for registration based on the following grounds: (i) the Opposed Mark was

substantially identical to the Trademark, which has been registered and widely used in numerous countries around the world and become well-known for the similar/related goods/services; (ii) ACA and the Applicant of the Opposed Mark operate in the same field of business, therefore ACA believes that the registration and use of the Opposed Mark, substantially identical to the Trademark, in Vietnam will mislead the public into believing that the Applicant of the Opposed Mark has a business relationship with or is an affiliate of ACA, that will cause confusion as to the origin of the goods/services bearing the marks.

To prove that the Trademark has been widely used, the following information and documentary had been submitted by ACA to the NOIP:

- List of worldwide registrations and pending applications for “RIVER WOODS”;
- List of RIVER WOODS stores worldwide, period of 2004-2012;
- List of ACA’s distributors, suppliers and licensees;
- ACA’s Annual Turnover (2004-2011);
- Copies invoices for exporting goods bearing RIVER WOODS trademark;
- List of ACA’s worldwide clients;
- List of customers worldwide who have ordered for the winter of 2012 up to now;
- Advertisement and promotion materials;
- Copy of Decision on opposition, in which Korean Intellectual Property Office recognized “RIVER WOODS” worldwide famous mark.

After examining and considering the opposition arguments and supporting document provided by ACA, on 18 June 2015 the NOIP issued notifications accepting opposition filed by ACA and refusing to grant a registration certificate for the Opposed Mark on the ground that it is substantially identical with the ACA's trademark "RIVER WOODS" thus may cause confusion as to the origin of services provided by ACA.

Comments:

Of note, this case is not the first one where the NOIP refuses to grant a registration certificate to a trademark on the ground that it is confusingly similar with others' trademark, which has been widely used in foreign countries, although this trademark has not been registered or used in Vietnam.

As usual, the NOIP does not officially recognize the ACA's Trademark a famous mark, however, interestingly, in this case, the NOIP has confirmed that the Opposed Mark may cause confusion as to the origin of services bearing the Trademark. In other word, the NOIP implicitly recognizes the oversea wide use of ACA's Trademark. Of particular note, it is rather difficult to see the difference between the notion of "wide use of a trademark" and that of famous mark. To prove the wide use of a trademark, the owner usually bases on the same criteria for recognition of a well-known mark. Nevertheless, according to a number of Vietnamese trademark attorneys, practice shows that the term "widely-used mark" seems to be more easily accepted by the NOIP's examiners than that of "well-known mark".

It is worth reminding that Article 4 of the IP Law of Vietnam provides that "Well-known mark is a mark widely known throughout territory of Vietnam"; and Article 75 provides for some criteria for well-known status of a mark. However, it is not easy to apply these legal provisions in practice due to lack of guiding materials. And as a result, still no mark has been officially recognized as well-known in Vietnam up to now.

OPPOSITION AGAINST TRADEMARK REGISTRATION: "BICABO" CONSIDERED CONFUSINGLY SIMILAR TO "PICATO"

Recently, D&N INTERNATIONAL has successfully opposed registration of the trademark « BICABO » for pharmaceutical products in class 05, as it is confusingly similar to its Client's protected trademark « PICATO ».

Facts

On January 27, 2010, D&N INTERNATIONAL, representing its Client (LEO Pharma A/S), filed with the NOIP an opposition against the trademark application No. 4-2009-09807 for « BICABO » in the name of "Seo Kyung Company" on the ground that it is confusingly similar to the Client's trademark « PICATO » being protected for « pharmaceutical products » in class 05 under the International Registration No. 921056. The main argument of the opposition is that the trademark "BICABO" is confusingly similar to the trademark "PICATO" in respect of structure, appearance, pronunciation, and the list of registered goods.

"Seo Kyung Company" has opined that their trademark "BICABO" is distinguishable from the trademark "PICATO" in respect of structure, appearance and pronunciation. Specifically, the trademark "BICABO" is pronounced as /bi-ca-bo/, whereas, the trademark "PICATO" is pronounced as /pi-ca-to/. These trademarks have only one identical syllable /ca/, the remaining syllables, namely /bi-bo/ and /pi-to/, are pronounced differently. In order to prove the distinguishability, Seo Kyung Company also argued that the prefix « BICA » and the suffix « CABO » can be found in different trademarks registered in the name of different owners.

Upon examination of arguments provided by the parties, the NOIP has agreed with the D&N INTERNATIONAL's arguments. Specifically, the NOIP has concluded that the trademark "BICABO" and the cited trademark "PICATO" both include six letters, four of which, namely "I, C, A, O", are arranged in the same position. The consonants "B", "P" combined with the vowel « I » constitutes very similar syllables. The mere difference of two letters « B » and « T » is not sufficient to distinguish the trademark « BICABO » from the trademark "PICATO ». The designated goods of two trademarks are also identical. The fact that the prefix « BICA » and suffix « CABO » are protected in many trademarks of different owners is not a legal basis for assessing the dissimilarity between these trademarks.

Therefore, on 5 January, 2015 the NOIP issued the Decision No. 173/QD-SHTT to officially refuse to protect the trademark « BICABO » as it is confusingly similar to the trademark « PICATO » protected with regard to pharmaceutical products.

D&N INTERNATIONAL CO., LTD (D&N International)

D&N International is a Vietnam's leading firm providing professional legal services in the field of Intellectual property, investment consultancy and business law.

As a representative for a large number of reputable clients from over 50 countries, each year, D&N International settles thousands of cases relating to establishment and enforcement of IP rights, as well as provides consultancy services for various investment project, both domestic and foreign.

With our professional and experienced lawyers, IP attorneys and associates, D&N International commit ourselves to providing our clients with high-quality services at reasonable price, helping clients enhance their business effectiveness and create competitive advantage in both their domestic and international markets.

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