



MANUAL FOR BRANDING AGRICULTURAL PRODUCTS

A GUIDE FOR ENTERPRISES AND COOPERATIVES

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A guide for enterprises and cooperatives

(Translated version from the original version in Vietnamese)

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FOREWORD

Agriculture and food production have made a significant contribution to export, job creation, and income generation. The export turnover of the agricultural, forestry and fishery sector in 2021 reached 48.6 billion USD, of which there are 6 commodities of over 3 billion USD, including wood and wood products (US\$ 14.8 billion), seafood (US\$8.88 billion), cashew nuts (US\$3.64 billion), fruits and vegetables (US\$3.55 billion), rubber (US\$3.28 billion), rice (US\$3.3 billion) and coffee (US\$3.07 billion) and exported to the major markets such as the US, EU and Japan (Ministry of Industry and Trade 2022).

Despite impressive and remarkable export turnover, up to 90% of Vietnam's agricultural output is still exported as raw materials, and its export price is lower than that of many other nations that produce the same products. Although Vietnam takes lead in exporting many agricultural products, the country hasn't got strong agricultural brands that are widely recognized by global customers. 80% of exported agricultural products are either still unbranded or not fully adhered to global value chains. Many goods are exported and marketed under foreign brands and by non-Vietnamese companies in overseas markets.

Branding and protecting Vietnamese agricultural product brands on domestic and international markets are crucial in the context of extensive and profound international economic integration with a number of new-generation free trade agreements (FTAs). This strategy requires a strong cooperation of state management agencies, industry associations, and the business community.

Vietnamese enterprises must raise their awareness of protecting brands for agricultural products and actively branding their products. Many enterprises currently just focus on production and business activities in an effort to overcome technical barriers without paying attention to the legal protection of their intellectual property (IP) rights through brands and trademarks. The protection of brands and trademarks must comply with international regulations and norms. Branding and protecting brands should be initiated right after defining markets to penetrate. However, in order to maintain and develop sustainable brands, and increase export value of agricultural products, actors involved in agricultural value chains, especially producers, processors and traders, should actively and quickly adapt to market changes and demands. The underlined issues are

production and trade activities according to international standards, investment in cutting-edge machinery and equipment, and adoption of new technology to production and processing, etc.

This manual systematizes issues related to brand building, management and development based on the approach of IP protection. It is expected that this manual provides enterprises, cooperatives and producers with detailed information, rules and regulations on branding of some key markets of Vietnamese agricultural products and fruits, so that they can effectively apply in their own production and business activities, contributing to promote Vietnamese agricultural products in the international market.

This manual is structured into the following main sections:

- Part 1: Basics of branding
- Part 2: Types of trademark protection
- Part 3: General regulations on trademark protection in Vietnam
- Part 4: Regulations on international trademark registration
- Part 5: Lessons learned from some cases of trademark protection and trademarks disputes abroad

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ACRONYMS

EU	European Union
EUIPO	European Union Intellectual Property Office
EUTM	European Union Trade Mark
Coop.	Cooperative
GI	Geographical Indication
IFAD	International Fund for Agricultural Development
IP	Intellectual Property
IPVN	National Office of Intellectual Property of Vietnam
JPO	Japan Patent Office
KIPO	Korean Intellectual Property Office
MARD	Ministry of Agriculture and Rural Development
MOIT	Ministry of Industry and Trade
MOST	Ministry of Science and Technology
NOIP	National Office of Intellectual Property
PGI	Protected Geographical Indication
POA	Power of Attorney
SME	Small and Medium Enterprises
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
UNIDO	United Nations Industrial Development Organization
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Office
WTO	World Trade Organization

PART 1.

BASICS OF BRANDING

1.1. Definitions and concepts

1.1.1. What is a brand?

According to the World Intellectual Property Organization (WIPO): A brand includes a set of signs (tangible or intangible) to identify a product that is manufactured or supplied by an individual or an organization.

According to Kotler and Armstrong (2017): A brand is defined as “a name, term, sign, symbol, design (or combination of these) that identifies the maker or seller of the product” and distinguishes the goods and services of one maker or a seller from those of other makers or sellers”.

According to Keller (2003): A brand is a set of associations in the consumers’ minds that increase the perceived value of goods or services. These associations must be unique and prominent.

Traditional views (WIPO) emphasize only the tangible elements of brands. These traditional views consider a brand as part of products and underline the distinctive function of brands, helping customers to recognize the goods and services of a specific maker or a seller.

Meanwhile, modern views (Kotler, Keller) see the product as part of a brand. In addition to the basic distinctive function of brands, in the context of globalization and increasing competition, brand functions are extended to perceived values, impression or image of products and services in the consumers’ minds.

In summary, a brand is a combination of tangible and intangible elements to distinguish goods and services and constitute special imprints in the mind of customers.

1.1.2. What is a trade name?

A trade name is an official name under which an individual or an organization conducts business, capable of distinguishing the business entity bearing it from another entity in the same business domain and area (*Clause 21, Article 4, Law on Intellectual Property – IP Law*)

1.1.3. What is a trademark?

A trademark (or trade mark or a mark) means any sign used to distinguish goods and/or services of different organizations or individuals (*Clause 16, Article 4, IP Law*).

A trademark shall be protected when it satisfies the following conditions (*Article 72, IP Law*):

- Being a visible sign in the form of letters, words, drawings or images, including holograms, or a combination thereof, represented in one or more colors;
- Being capable of distinguishing goods or services of the mark owner from those of other subjects.

Marks are mainly used to affix to goods and services to indicate the producer or the supplier.

Example: Coca-Cola, Sony, Vinataba, Vinamilk, Trung Nguyên, Vietnam Airlines, TH True Milk...



1.2. Distinction between brands and trademarks

A brand includes not only signs as in a trademark, but more importantly, refers to the image of goods and/or services in the consumers' minds. Brands are considered as the "soul" and trademarks are considered as the "body" of goods and services.

Dimension	Brand	Trademark
Legal aspect	The concept is not legalized in Vietnam and internationally. Brands are not subject to protected IP rights in Vietnam	The concept is legalized in Vietnam and internationally. Trademarks are subject to protected IP rights in Vietnam.
Material aspect	Persist in the consumers' minds	Consumers perceive through images, words, symbols, etc.
Time/existence duration	Long term	In a defined period of time

On legal and legislation aspect:

From a legal perspective, using the term of “trademark” goes in line with the provisions of Vietnamese law, but in terms of corporate governance, “brand” is more widely used.

The Law on Intellectual Property of Vietnam (IP Law) does not have a definition of “brands”, but gives a definition of trademarks. Thus, only “trademarks” are subject to the IP protection in Vietnam.

On material aspect:

Brands refer to the images and impression of goods and services in the minds of consumers.

Example:

- *when it comes to Nokia phones, consumers envision a durable product;*
- *when it comes to Iphone, consumers picture a “luxury” product;*
- *when it comes to Moc Chau milk, consumers imagine extended green prairie.*

On time aspect:

Brands exist longer than trademarks. Trademarks can be created in a short period of time, while branding (creating brand image in the minds of consumers) is a long process.

Brands are permanently positioned in minds of consumers. Trademarks are only valid for a certain period (trademark protection is usually 10 years and can be extended).

Well-known or famous brands will last over time, but trademarks are subject to changes according to external factors such as consumer tastes and preferences.

Trademarks are recognized and protected by the State. Brands are the result of the long-term efforts of businesses and are perceived and appreciated by consumers.

1.3. Structure of a brand

Brands are made up of following core elements:

- **Readable part** includes elements that can be read, affecting the consumers’ hearing such as company name (for example, P&G, Nokia...), product name (such as 555, Coca Cola...), slogans (“I love Vietnam” of Honda motorbikes; “Green

grasslands, fresh milk” of Moc Chau milk; Biti’s “Cherish Vietnamese foot”....), piece of music, singing and other vocal elements.

- **Unreadable part** includes elements that cannot be read but only be perceived visually, such as drawings, symbols (Vietnam Airlines’ golden lotus), colors (Nokia’s blue, Coca-Cola’s red), design and packaging form (Heineken beer bottle style) and other visual elements.
- **Brand loyalty of consumers** refers to the attachment and love of customers to companies and enterprises. Loyal customers are those who are always with the company, even during difficult times.

From marketing perspective, a good or a service is a composite and complex construct. A sustainable agricultural brand is built and maintained based on 3 element layers:

- i. Inner ring (core value): the attributes that bring direct values to the users, consumers

Example: Fruits (mangos, pomelos, etc.) provide energy and vitamins to the consumers

- ii. Middle ring (sentiment value): the attributes and values that indirectly affect emotions and purchase decisions of consumers.

For example: packaging, logo, delivery services, etc. affect the consumers’ feelings and decision.

- iii. Outer ring (promises and belief): Values of company’s philosophy and responsibility towards the community and consumers.

For example: Fruits brand associated with soil conditions, history and culture of the production area; The fruit brand is committed to supporting farmers with capital to adopt good production practices, to protect environment, etc.

Table 1: A guide to define values of a agricultural brand

Direct value	Sentiment value	Belief value (promises)
• Organic practices • Nature-smart, climate-smart • No pesticides • No preservatives • No toxins • Good taste • Flavor and fragrance • Good for health •	• Logo • Packaging • Website • Color • Social network • After-sales services • Policy • Other graphic design • Environmental protection...	• Brand story • Vision • Mission • Operational philosophy • Responsibility to community ...

1.4. Role of branding and brand management

1.4.1. For producers

- Branding is a tool to identify and differentiate products, a means to legally protect the advantages and unique characteristics of products and services, as well as to create a legal basis to protect the interests of enterprises.
- Branding affirms the quality of products and services, putting product images ingrained in the minds of consumers, and constitutes competitive advantage. Brands are intangible assets, making an important contribution to increasing profits and raising added value of goods and services.
- Branding helps enterprises, especially small and medium-sized enterprises (SMEs), to access different markets. Branding facilitates businesses in expanding their markets and attracting potential customers.
- Investments in building and developing brands will attract customers. Brands are the decisive factor when customers choose to buy, because brands give them confidence in the origin and quality of the products, enable time-saving in information searches, and reduce risks

- Branding helps to reduce costs for trade promotion and marketing activities. Brands are an effective marketing tool for enterprises to approach target markets and implement market expansion.
- Strong brands generate profits and dividends. Giant groups and companies in the world, such as Coca-Cola, BMW, American Express, or Adidas, take their branding strategies very seriously. All of these big companies see their brands beyond a sales tool. Branding is considered as a management tool that can create business value. Branding agricultural products allows suppliers to increase their negotiating position with big buyers.
- Brands are not only enterprises' assets but also country's property. When entering international markets, brands associate with national images through trademarks, place of origin, and product characteristics. The more famous brands a country has, the higher its economy's competitiveness will be, and the more its position will be consolidated in the international arena, facilitating socio-cultural cooperation and development, international exchanges, and world economic integration. For example, when it comes to Sony, Toyota, Toshiba, etc., everyone knows that they are famous Japanese products, although nowadays they are produced in many countries thanks to international labor divisions or joint ventures driven by international investment and technology transfer.

1.4.2. For consumers

- Brands help consumers identify the origin of products, attribute responsibility to manufacturers or suppliers, and create consumer trust in the price and quality of products. Origin of products benefits consumer in terms of reduced risks in consumption, saving costs for searching, and assured quality.
- Brands can alter perception and experiences of consumers about products. For consumers, brands make their life more convenient and interesting.
- Brands contribute to protecting the interests of consumers. State-protected trademarks prevent products from being counterfeited or misrepresented to deceive consumers. Brands enable consumers to buy and consume products of committed quality and make consumers satisfied with product quality.

1.5. Brand building process

Branding agricultural products is not only designing logos or slogans, but also to make consumers recognize the place of origin of the products and the sustainable value chains, including quality commitments. Branding requires the efforts of all related actors (the State, farmers, enterprises, distributors, exporters, etc.) at all stages (production, collection, processing, meeting quality standards or requirements, food safety, transportation, trade, etc.) in order to satisfy the needs of consumers.

1.5.1. Brand positioning

Brand positioning is a set of activities aimed at determining a place for a product and its brand in the mind of the customers. Brand positioning sets the goal of giving the brand its own image compared to other brands.

Brand positioning should be formed in parallel with the process of brand design and brand creation. There are different approaches to position brand, namely: positioning based on problems and solutions; features-based positioning; quality-based positioning; opponents-based positioning; value-based positioning; usage-based positioning; relationship-based positioning; expectation-based positioning; emotion-based positioning.

For Vietnamese agricultural products in general and fruits in particular, brand positioning should be based on strategies of quality-based positioning, value-based positioning, and emotion-based positioning.

Steps to do brand positioning:

- Determining the competitive environment: It is to determine competition landscape in the market and competitors' activities (*For example, in market A, where are the fruits coming from? What are the prices? ..*);
- Identifying target customers: It is to define market segments (by gender, by income, by geographical location, etc.);
- Understanding customers: It is to build knowledge about customers' psychology, their needs and their consumption habits (*what are the characteristics of consumption of agricultural products and fruits of the market?...*);
- Defining product benefits: It is to identify functional and emotional benefits that drive purchasing behaviors of the consumers (*e.g., nutritional value of fruits, cultural and social values associated with products...*)

- Defining brand personality: Brand personality is a set of human characteristics (personality traits, demographic characteristics) that are attached to a brand. Brand personality is a distinctive element of a brand - expressing a particular human trait or a certain lifestyle associated with the brand. Brand personality is often culturally and symbolic, making it an effective tool to raise awareness about branding.

For example, fruits of the Mekong Delta region recall reminiscent images of hardworking, sincere, generous farmers....

- Identifying reasons for trust: They are proven reasons to convince customers to trust brands (*quality, place of origin,*);
- Identifying features differentiated from competitors: The differences are those attract customers and make them choose this brand over another.
- Defining the brand essence: It is to define the core characteristics of the business, i.e. the values that the company stands for.

1.5.2. Defining brand architecture

Brand architecture is a structure built with the purpose of organizing brands in a category to define the role of each specific brand as well as relationship between brands. Brand architecture represents strategic roles of each individual brand. A brand architecture which is built professionally and effectively will bring benefits such as creation of brand power, fair resource distribution, clear positioning of brands, and limited confusion in the mind of customers. To create maximum connection and interaction between brands of the same enterprise, brand manager needs to manage and focus on the following 4 factors:

- i. Brands portfolio: including all brands as main brands, sub-brands, co-brands;
- ii. Roles of specific brands in the portfolio: clearly defining the role of each brand in the company's overall business strategy;
- iii. Structure of the brands portfolio: defining importance and priority order of brands in the portfolio;
- iv. Brand expansion strategy: a brand extension model relevant to the company's culture and development vision.

Enterprises can consider using one of the following brand architecture strategies:

- Family brand strategy (single brand): one general brand is applied to all products in the category.
- Individual brand strategy (multi-brand): a separate brand is built for each line of goods and service, or separate brands are developed for each target markets...
- Integrated brand strategy: a mix use of both single brand and multi-brand approach for products and/or services of the business.

Before entering a new market, enterprises need to conduct market research, especially niche markets, to define their position and properly assess potential products to stabilize trade flows.

If producers or suppliers find it impossible to develop market with their own brand, they can participate in an existing distribution system in compliance with the distributor's standards. Moreover, producers and suppliers are be able to learn about strategic partners, national and international agreements preferential tariffs and procedures for related products and services.

For example, many Vietnamese products are exported to foreign countries through distributors, under the trademarks or tradenames of distributors, processors, etc.

1.5.3. Building brand identity system

The brand identity system is what consumers see and hear about the brand in their daily life. The identity system of a brand is all types and ways in which the brand can approach customers such as logos, slogans, business cards, envelopes, bags, packages, labels; billboards, advertising banners, advertisements in the media; promotional materials and publications (flyers, posters, catalogs, flags, shirts, hats...); means of transport; all kinds of office publications; distribution system, chain of stores and other forms of public relation, promotional events, etc.

The brand identity system aims to create associations that enterprises want to build and preserve in the minds of customers through products (categories, characteristics, quality and value of products, ...) to distinguish one brand from another.

The brand identity system is a tool to effectively promote a brand. Therefore, it is an asset that needs to be under long term management and investment.

1.5.4. Design and constitute elements of brand

The general principle is to make a brand distinctive from the brands of the same goods and services. A strong brand is the combination of powers of words, images and other tools capable of capturing customers' attention.

a) Brand name

The brand name is considered the most important element of a brand as well as connection between products and customers. A brand name is a concise, simple, and effective communication tool. Under IP law, a brand name is a protected combination of words or letters capable of distinguishing products or services of one enterprise from those of others. Each brand name has its own creation, but should follow the rules:

- *Simple, easy to remember, easy to read:* Simplicity will help customers easily and quickly perceive the brand. A short name is easy to recall because it is easily kept and deciphered in the mind.
- *Friendly and meaningful:* A brand name is proved to be clear and impressive if it is visualized by association with a specific person, place, animal or something. For example, Apple computers, Red Bull energy drinks, Puma sport equipments, etc.
- *Highly adaptable:* A brand name can be used for different products of the same category; and acceptable across different territories and cultures.
- *Distinctive and unique:* The unique of a brand name is an competition advantage over competing brands. For example, many companies combine letters to create brand names that have never been known, even in dictionaries like Xerox, Exxon, Google or Rozion...
- *Satisfying protection requirements:* A brand name can be distinguished, neither overlapping nor similar to protected marks of other producers or suppliers.

b) Logo

Logo is used as a symbol to increase the public awareness of the brand name. Many studies on consumer attitude show that brands associated with logo of strong impression to consumers, are easily recognizable and recallable. Moreover, logos can contain and convey certain messages and meanings, thus increasing the public awareness of companies. Consumers easily recognize and recall logos which are more abstract, distinctive, and unique.

Logos are categorized in 3 types:

- Letterform marks are logos are designed as forms of monogram (letter mark) or wordmarks (logotype). These logos consist of letters, usually brand initials, which are specially design with unique typography or font.
- Pictorial marks (or logo symbol) are an icons or graphic-based logos which include images, pictures or special characters.
- Combined marks are logos including both images and letters. This is the most commonly used logos as they are easily to be recognized.

Notes:

- Marks must be clear, visible and distinguishable.
- It is recommended to include less than 3 colors to ensure aesthetic and save costs. Marks in black and/or white give a higher level of protection.
- When designing marks, it is necessary to pay attention to the applicability of the mark (forms of attaching, stamping, printing....). Therefore, designs with uniform geometry are encouraged.
- It is advised to avoid using real images of products if the mark owners don't take the photo or create the images by themselves. Geographical name of places and locations should not be used on common marks since these marks shall not be subject to legal protection (if the place name is the prominent element in the mark).
- Elements that are not distinguishable should not be the main and prominent component of the mark. Other speaking, these elements should be secondary descriptive elements and make up a small part of the overall mark.



c) Brand story

A brand story is effective marketing tool. A brand story is a cohesive narrative that

encompasses the facts and feelings that are associated with the products and services. A brand story inspires an emotional reaction and creates an imprint in the consumers' minds. Some considerations to be taken when developing a brand story as follows:

- The narratives tell the story about the product, its place of origin and local people in view of encouraging consumers to discover, and to improve sales.
- In a brand story, it is necessary to briefly introduce the outstanding features and characteristics of the goods and services (for example, farming process, technology applied, unique differences, etc..)
- For agricultural products, the production methods and the nutritional value should be included (for example, ancient Shan Tuyet tea leaves are picked by manual of the ethnic farmers, cultivation of Shan Tea follows organic farming process, etc.).

1.5.5. Trademark registration

a) What is trademark registration?

Trademark registration is an administrative procedure managed by competent state authorities to recognize the ownership of marks in a certain legal form.

Trademark registration is initiated by an entity wishing to own the mark through filing registration application to the competent authority.

If the mark(s) and the application meet all the legal conditions and requirements, they will be recognized as the IP of the applicant. Information about the trademark owner or holder and marks will be recorded in the National Mark Register, and the trademark owner or holder will be granted a license of trademark registration.

b) Benefits of trademark registration

Trademark registration is not mandatory, but necessary. Only protected trademarks are recognized as the exclusive property of the companies. Absence of trademark registration, on one hand, the trademark owners or holders don't have the property rights over the trademark; on the other hand, they shall face the risks of becoming the illegal user of a trademark if that trademark is registered by someone else before hand.

Trademark registration is to:

- Establish ownership of the trademark;
- Protect marks and trademark owner or trademark holder by law;

- Constitute the exclusive use of the trademark;
- Keep trademark not being violated or stolen by others;
- Avoid committing infringement of trademark rights of the others ;
- Constitute the basis for the trademark use and transfer ;
- Help consumers identify and choose the right products they need.

For rural and agricultural products, especially specialty products, trademark registration in the form of IP will contribute to: (i) Protecting the reputation of specialties, avoiding abuse or counterfeits; (ii) Encouraging diversified agricultural production and stabilizing rural areas. On the contrary, absence of an IP registration means no legal tools to protect those specialties. Consequently,

- specialties shall be gradually lost or misused or be subject to counterfeiting.
- agricultural production is underdeveloped, making rural people abandon farming works and migrate to urban areas; the countryside will be negatively impacted from the both economic and social perspectives.
- producers don't have opportunities to upgrade their production and sales process; and there are acts of price-making, unfair competition, and reduced revenue, etc.
- manufacturing enterprises shall downsize their production and business scale; insufficiencies in quality goods to supply to the market and export. Trading businesses shall lack of goods to sell on the market, leading to monotonous and unsustainable business.

c) Who are the right to register trademarks?

All legal business entities, including companies, households, cooperatives, etc. (collectively referred to as enterprises) have the right to register trademarks.

Rights of trademark registration:

- Manufacturing enterprises have the right to register trademarks for their goods or services.
- Trading enterprises have the right to register trademarks for goods that they sell and which are produced by another enterprises if the producers does not use the trademark and does not oppose to the registration of such trademark.

Rights to register certification marks and collective marks:

- Legally established collective organizations with 2 or more members (cooperative alliances, cooperatives, associations, groups of companies, etc.) having independent production and business activities, have the right to register collective marks which can be used by the member enterprises for their goods and services;
- If trademark contains signs indicating the geographical origin of goods or services, the organization having the right to trademark registration must be a collective structure of organizations and individuals conducting production and business in that locality.
- Organizations with the function of controlling and certifying the quality, characteristics, origin or other criteria related to goods and/or services have the right to register a certification mark to license other enterprises to use the mark on the condition that the trademark owner do not conduct the production or trading of such goods or services.

d) When should the trademark be registered?

Early trademark registration affects the possibility of being granted a trademark license. In the event that two people or organizations use the same mark for the same or similar products/services and both satisfy protection criteria, the one who registers the trademark first will be granted a trademark license; while the other using that trademark will be considered violating the law. Thus, if there is no or late trademark registration for a product or a service, the trademark will belong to someone else and the trademark owner faces risk of being claimed illegal use.

Should a trademark be used in business before trademark registration? There is a view that a trademark can be used before registration to test the competitiveness of a product and/or service. However, the risk is that while a company tests their trademark and build its reputation, someone else may proceed the trademark registration before hand. Therefore, companies are advised to register trademarks as soon as starting a business.

e) Steps to proceed branding

Step 1: Defining the list of products to be protected	Including not only products with advantages in quality, associated with the locality, but also new, potential products that are suitable for the markets in the list of registered marks.
Step 2: Select signs to be registered for protection	Signs show the value of the business and products (possibly a mark already used in commercial activities). It is necessary to pay attention to the issues of using common signs (names of places, names of collective organisations) and individual signs of the unit.
Step 3: Select the type of registration	It should be based on the characteristics of the product and the characteristics of the production organization as well as the ability to organize the management and control of quality. Determine the scope of the mark registration area (domestic or international).
Step 4: Trademark registration	Process the registration procedures in markets in accordance with relevant laws and regulations.

1.5.6. Production organization and value chain linkage

Main reasons hindering development of Vietnamese agricultural brands are fragmented and small production, the gap between a big order and timely response to customers' needs. Besides, product quality is unstable due to weak control of the source of plant varieties, backdated farming and production process, rudimentary technology of harvesting, processing, limited application of technology in production and harvest. Today, many agricultural sub-sectors are comprehensively invested, from selecting varieties, cultivating, harvesting to registering IP rights, promoting trade. However, finding consumption market for the agricultural outputs is still a puzzle for value chain actors. Agricultural production and trading activities are navigated mainly by SMEs with limited financial and human resources, so Vietnamese agricultural brands are still unknown to global customers.

Brand management and development associated with production organizations and value chain linkages base on the following rules:

- Increasing investment in science and technology, human resources to improve productivity and quality of goods;
- Promoting agro-processing, especially processing fruits;

- Building up and standardizing production and distribution chains for domestic and export;
- Improving product quality management;
- Creating linkages in the value chain, with the leading role of enterprises to steer the price and quality of the goods.
- Encouraging «four-player» cooperation in the whole branding process:
 - Farmers comply with process of good production and are built capacity through agricultural extension programs;
 - The State has programs to promote agriculture and rural production development;
 - Scientists engage in research of new high-quality varieties, development of post-harvest process;
 - Enterprises commit to executing contracts which set reasonable prices paid to farmers.
- Building operational and inclusive value chains and distribution channels from production to domestic consumption and export.
- Developing agricultural tourism and rural tourism to strengthen linkages and connections in the consumption of agricultural products (including fruits).

1.5.7. Quality control

Quality management is considered a practical measure to promote global commercialization, to improve the competitiveness of organizations and enterprises as well as the competitiveness of the national economy. Good quality management organization will help businesses meet mandatory and voluntary standards to ensure product quality, environmental protection and consumer health. For agricultural products, quality and food safety are the core of the quality management system throughout the value chain.

Certification and standards for agricultural exports (mandatory):

- Regulations on food safety
 - Regulations on pesticide residues: maximum residue levels (MRL),

- Traceability
- Quarantine regulations: Producers must comply with phytosanitary regulations to prevent the migration and spread of diseases and pests to other areas. The major importing countries conduct pest risk analyses to determine the level of risk of imported products and to inspect the products at destination to ensure that the risk under the benchmarking level.

Voluntary standards and certification: These standards refer to environmental issues (such as soil conservation, water protection, pesticide use or waste management), social issues (such as producer income, workers' rights, occupational health and safety) or other aspects of production such as food safety.

- Environmental certification: organic agriculture, ISO 14001
- Social certification: Fair Trade (Fair Trade), SA 8000
- Food safety and good practice certification: GAP (Global GAP, ASEANGAP, JGAP, ChinaGAP), Certificate of good processing practice (International Food Standard Certification - IFS), quality safety rules food (SQF), British Retail Consortium Standards (BRC), ISO 22000
- Certified product quality characteristics: Geographical Indication (GI), HALAL certification

1.5.8. Trade promotion

- Organizing the promotion and introduction of Vietnamese agricultural products to foreign countries; Connecting domestic and foreign production; ensuring information connection.
- Having attractive packaging and labelling to attract domestic and foreign customers.
- Strengthening the provision of information, marketing the image of agricultural brands in the press and television. In the era of information explosion, the press is one of the best channels to bring information about products and services to consumers. On the other hand, proactively providing information on agricultural brands will help journalist and communication experts come up with suitable and effective communication ways to approach consumers as well as promoting Vietnamese agricultural products in the international markets.

- Enhancing awareness of distributors and consumers about agricultural products through trade promotion activities:
 - Coordinating national and regional programs and events to carry out promotion strategies, to promote typical local brands, to introduce products on mass media, and to make connections at national and international trade shows;
 - Linking regions; participating in exhibitions, forums and conferences, and developing distribution channels in potential markets.
 - Developing strategies for trade promotion, market research, brand communication, creating favorable conditions for agricultural products to penetrate into fastidious and high-end markets at home and abroad.
- Improving capacity, knowledge and information on international treaties when entering international markets; improving knowledge of enterprises and cooperatives and other actors about IP.
- Developing competitive pricing policy and promoting agricultural products through domestic and traditional trade fairs, websites, advertisements on media, etc.; Fulfilling all commitments on contract execution.

1.5.9. Brand management and development

Building and operating a brand management system: upon forms of protection and production characteristics, different brand management systems are built. For community marks (collective mark, certification mark, geographical indication), production and trade businesses need to comply with provisions of a general management system. A comprehensive brand management system (production, processing, supply, ...) will ensure a strong and stable brand.

Activities to promote value of branding:

- Doing researches and applying new technologies into quality control system such as upgrading machinery and equipment systems, adopting new technologies in product traceability (QR code, block chain, etc.).
- Developing systems to promote products: identification system, website, reporting system, social network, etc.

- Building up trade channels: it is necessary to define product segments, ways of selling products (wholesale, retail, export, online sales, etc.) to come up with specific commercial solutions.

At the stage of post-registration, upon any disputes or conflicts, some considerations to be taken as follows:

- Enterprises need to assess the nature of the dispute to opt for appropriate solutions.
- Different options taken into consideration are arbitration, commercial court or negotiation. Of these three options, negotiation is considered the best way but this route requires the ingenuity of the negotiator and the financial ability of partners.
- Negotiation enables parties concerned to:
 - Save time as a commercial court takes longer for handling disputes. In case of arbitration, in theory, the arbitrator's decisions can be canceled by a commercial court, that makes the case prolonged.
 - Save costs (as court fees or arbitration fees, attorney fees, judgment enforcement fees, etc.)
 - Have higher possibility to recover assets and the turnover (as upon successful negotiation, parties concerned are more open and willing to responsible for any incurred costs or payment).
 - Maintain relationship and reputation of partners.
- However, the limitation of negotiations is that it is weak enforcement of negotiation verbal notes, as these minute notes are not legally effective as court judgement or arbitration decision. Therefore, there are also cases where enterprises take advantage of the negotiation process to prolong the time for lawsuits.

PART 2.

TYPES OF TRADEMARK PROTECTION

2.1. Signs to distinguish marks

2.1.1. Signs not protected as marks

The Articles 73 of the IP Law stipulates that following signs shall not protected as marks:

- Signs identical with or confusingly similar to national flags or national emblems;
- Signs identical with or confusingly similar to emblems, flags, armorial bearings, abbreviated names or full names of Vietnamese state agencies, political organizations, socio-political organizations, socio-political-professional organizations, social organizations or socio-professional organizations or international organizations, unless permitted by such agencies or organizations;
- Signs identical with or confusingly similar to real names, alias, pseudonyms or images of leaders, national heroes or famous personalities of Vietnam or foreign countries;
- Signs identical with or confusingly similar to certification seals, check seals or warranty seals of international organizations which require that their signs must not be used, unless such seals are registered as certification marks by those organizations;
- Signs which cause misleading or confusion or deceive consumers as to the origin, properties, intended utilities, quality, value or other characteristics of goods or services.

2.1.2. Distinctiveness of marks

A mark shall be considered distinctive if it consists of one or several easily noticeable and memorable elements, or of many elements forming an easily noticeable and memorable combination, and does not include signs and elements which are unable to distinguish.

A mark shall be not protected if they are considered as indistinctive, having signs identical or similar to signs already registered.

a) Normal signs which are indistinctive

- Simple shapes and geometric figures, numerals, letters or scripts of uncommon languages, except where such signs have been widely used and recognized as a mark;

Example:   

- Conventional signs or symbols, pictures or common names in any language of goods or services that have been widely and regularly used and known to many people;

Example: “Honey”, “Mango”,

- Signs indicating time, place and method of production, category, quantity, quality, properties, ingredients, intended utility, value or other characteristics, which is descriptive of goods or services, except where such signs have acquired distinctiveness through use before the filing of mark registration applications;

Example: “The best”, “Traditional”, “Since1950”

- Signs describing the legal status and business field of business entities;

Example: “Joint stock company”, “Cooperative”, “Estate”, “Crop production”

- Signs indicating the geographical origin of goods or services, except where such signs have been widely used and recognized as a mark or registered as collective marks or certification marks;

Example: “Delta”, “North”, “Red River”

b) Signs are considered identical or confusingly similar

- Signs other than integrated marks which are identical with or confusingly similar to registered marks of identical or similar goods or services on the basis of registration applications with earlier filing dates or priority dates, as applicable, including mark registration applications filed under treaties to which the Socialist Republic of Vietnam is a contracting party;
- Signs identical with or confusingly similar to another person’s mark which has been widely used and recognized for similar or identical goods or services before the filing date or the priority date, as applicable;
- Signs identical with or confusingly similar to another person’s mark which has been registered for identical or similar goods or services, the registration certificate of which has been invalidated for no more than 5 years, except where the ground for such invalidation is non-use of the mark according to Point d, Clause 1, Article 95 of this Law;

- Signs identical with or confusingly similar to another person's mark recognized as a well-known mark which has been registered for goods or services which are identical with or similar to those bearing such well-known mark, or for dissimilar goods or services if the use of such mark may affect the distinctiveness of the well-known mark or the mark registration is aimed at taking advantage of the reputation of the well-known mark;
- Signs identical with or similar to another person's trade name currently in use if the use of such signs may cause confusion to consumers as to the origin of goods or services;
- Signs identical with or similar to a GI being protected if the use of such signs may mislead consumers as to the geographical origin of goods;
- Signs identical with, containing or being translated or transcribed from geographical indications being protected for wines or spirits if such signs have been registered for use with respect to wines and spirits not originating from the geographical areas bearing such GIs;
- Signs identical with or insignificantly different from another person's industrial design which has been protected on the basis of an industrial design registration application with the filing date or priority date earlier than that of the mark registration application.

2.2. Common mark

There are two basic types of trademark, namely trademark of goods and trademark of service.

- Trademark of goods is used to distinguish goods of different individuals and business organizations for showing producers of those goods. Trademarks of goods that are descriptive or bear product names are not registrable.
- Trademark of services is used to differentiate services (finance, banking, travel, catering, etc.) of one service provider to those of other providers. Service marks are often affixed on boards or banners to make the services recognized by the consumers. Service marks can be registered, renewed, cancelled, transferred of ownership and right to use under the same conditions as marks of goods.

2.3. Integrated mark and well-known trademark

2.3.1. Integrated mark

An integrated mark means identical or similar marks registered by the same entity and intended for use on products or services which are of the same type or similar types or interrelated (*Clause 19, Article 4, IP Law*). An integrated mark makes customers assured when using products or services as the integrated mark has a connection with products and services they have used before.

For example: Honda's product lines of Wave motorcycles include: Wave, Wave RX, Wave SX... But this trademark is an integrated mark because it meets three conditions: Honda is the only entity to register the mark; these products all have similar basic features and belong to the Wave motorcycles series.

2.3.2. Well-known trademark

A well-known mark means a mark widely known by consumers throughout the Vietnamese territory (*Clause 20, Article 4, IP Law*).

The following criteria shall be taken into account when a mark is considered well-known (*Article 73, IP Law*):

- The number of involved consumers who have been aware of the mark through purchase or use of goods or services bearing the mark or through advertising;
- Territorial area in which goods or services bearing the mark are circulated;
- Turnover of the sale of goods or provision of services bearing the mark or the quantity of goods sold or services provided;
- Duration of continuous use of the mark;
- Wide reputation of goods or services bearing the mark;
- Number of countries protecting the mark;
- Number of countries recognizing the mark as a well-known mark;
- Assignment price, licensing price, or investment capital contribution value of the mark.

Some features of well-known trademarks:

- It is regulated that well-known trademarks are established through the recognition procedure of the competent state agency, not through the procedure of filing a trademark application like other common marks.
- In general, well-known trademarks are subject to a stronger protection. For example, a well-known trademark is protected even when it is not registered (or not used) in a certain territory.
- Furthermore, if marks are protected against confusingly similar marks only if they are used for identical or similar products, well-known trademarks are usually protected against marks identical or confusingly similar even if they are used for unrelated products, if certain conditions are met.
- The main purpose of stronger protection is to prevent companies from taking advantage of the reputation of a well-known mark and/or causing damage to the reputation and trust of customers in the mark.

2.4. Collective mark

2.4.1. Definition

A collective mark means a mark used to distinguish goods and/or services of members from those of non-members of an organization which is the owner of such mark (*Clause 17, Article 4, IP Law*).

2.4.2. Eligible organizations for collective mark registration

Collective organizations lawfully established shall have the right to register collective marks to be used by their members under the regulations on use of collective marks. For signs indicating geographical origins of goods or services, organizations having the right to register them shall be collective organizations of entities or individuals engaged in production or trading in relevant localities (*Clause 3, Article 87, IP Law*).

According to the provisions of Decree No. 77/2019/ND-CP dated October 10, 2019, the collective group (“tổ hợp tác”) has no legal status, so it shall not have the right to register collective marks.

2.4.3. Features of collective mark

- The characteristic of collective mark is that many entities have the right to use the collective mark. Yet, it should be noted that when a collective organization uses

the collective mark, the mark is no longer considered as a collective mark but a common mark because it is used by only one entity.

- In general, the collective mark is owned by an association or a cooperative, but these organizations themselves do not use the collective mark. Only their members can use collective mark to sell their products and/or services.
- The collective organization that owns the exclusive collective mark grants its members the right to use the mark provided that the members comply with the conditions and standards specified in the regulations on the use of the collective mark (for example, technical standards, quality standards, geographical origin).
- Registering collective mark is an effective way to jointly market the products of a group of producers and/or traders as individual or separate effort would make it more difficult to have their individual marks to be widely recognized by consumers.

Example: A typical successful collective mark is MELINDA which is used by 5,200 apple producers in the Valle di Non and Vale del Sole regions of Italy. Any producer is entitled to use the mark MELINDA owned by the MELINDA Company as long as their apple product meets the standards set forth by this company.

2.5. Certification mark

2.5.1. Definition

A certification mark means a mark which is authorized by its owner to be used by another organization or individual on the latter's goods and/or services, for the purpose of certifying the origin, raw materials, materials, mode of manufacture of goods or manner of provision of services, quality, accuracy, safety or other characteristics of goods and/or services bearing the mark (*Clause 18, Article 4, IP Law*).

Example:

ISO 9000 quality standard recognized worldwide is a certification mark

Vietnam's national brand "Vietnam Value" is a certification mark

2.5.2. Eligible organizations for certification mark registration

Organizations with the function of controlling and certifying quality, properties, origin or other relevant criteria of goods or services shall have the right to register certification

marks, provided that they are not engaged in production or trading of such goods or services (*Clause 4, Article 87, IP Law*).

In reality, entities register certification marks for agricultural products are relatively diversified, but most of them are state management agencies.

2.5.3. Features of certification mark

Certification mark is issued to certify the conformity to defined standards but are not restricted to any member.

Certification mark may be used by any organizations or individuals provided they can prove that the products or services concerned meets pre-defined criteria and standards.

The main difference between a collective mark and a certification mark is that a collective mark can only be used by a specific group of businesses (for example, a member of an association) while a certification mark can be used by any organizations or individuals that comply with the criteria and standards developed by the owner of the certification mark.

An important condition for a certification mark is that the applicant for the certification mark shall be deemed to be “competent to certify” the products concerned.

Example: The Woolmark certification mark is only used to certify products manufactured from 100% wool.

2.6. Geographical indication

2.6.1. Definition

WTO¹ defines a geographical indication (GI) as an indication which identifies a good as originating in the territory of a member, or a regional locality in that territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin.

2.6.2. General conditions for protected geographical indication

A GI shall be protected when it satisfies the following conditions (*Article 79, IP Law*):

- The product bearing the GI originates from the area, locality, territory or country corresponding to such GI;

¹ TRIPS – Agreement on Trade-Related Aspects of Intellectual Property Rights): https://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm#general

- The product bearing the GI has a reputation, quality or characteristics mainly attributable to the geographical area, locality, territory or country corresponding to such GI.

2.6.3. Objects are not protected under GI

- Names and indications have become common names of goods according to the perception of relevant consumers in the territory of Vietnam;
- GIs of foreign countries in which the GIs are not protected, terminated or no longer in use;
- A GI identical or similar to a mark that is being protected or has been filed under a trademark application with an earlier filing date or priority date; if the use of that GI is made, it is possible to cause consumers' confusion about the origin of the goods;
- A GI misleads consumers to the true geographical origin of the product bearing the GI.

2.6.4. Right to register GI

The Article 88 of IP Law stipulates regulations on the right to register GI:

- The right to register Vietnamese GIs belongs to the State.
- The State allows organizations and individuals producing products bearing GI, collective structure representing organizations and/or individuals or management agencies of localities to which the GI pertain to exercise the right to register such GI.
- Persons who exercise the right to register GI shall not become owners of the GI.

2.7. Which type of product protection should be chosen?

For each form of IP protection for agricultural products, in addition to legal requirements, protection strategy also associate with different practical conditions:

Table 2: Registration options for intellectual property protection

Dimension	Geographical Indication	Mark	Certification mark	Collective mark
Conditions to apply	Applicable to products with unique reputation/ properties /quality associated with geographical areas and places (2). Geographical factors include natural conditions, customs, skills or production experiences that other places do not have.	Applicable to organizations and individuals producing and trading products. A registered mark is a visible sign (with pictures, letters, or a combination of both), capable of distinguishing it from the marks of other organizations and individuals	Applicable to organizations that have the ability to certify origin/ process/ characteristics/ quality, etc. of products Name of place or geographical elements may be included	Applicable to collective organizations (cooperative, association, ...) that jointly produce and trade goods and/or services. Name of place or geographical elements may be included.
Owner(3)	State	Organizations, individuals who apply for trademark registration	Organizations, individuals who apply for certification mark registration	Collective groups or organizations who apply for collective mark registration
Users	Eligible organizations and individuals are permitted to use by the State representative	Organizations and individuals are allowed to use the registered marks.	Organizations and individuals get permission to use from the mark owner. The trademark owner does not directly use the certification mark	Members of collective organizations are allowed to use the collective mark

2 Geographical areas and place names must be permitted by the People's Committees of provinces and centrally run cities, and applied with geographical indications, collective marks, and certification marks.

3 Ownership are constituted when National Office of Intellectual Property grant the Registration Certificate.

GENERAL REGULATIONS ON TRADEMARK PROTECTION IN VIETNAM

3.1. Legal framework for trademark protection

- Integrated Document No. 07/VBHN-VPQH of June 25, 2019 of the Office of the National Assembly on Law on Intellectual Property:
 - Law on Intellectual Property No. 50/2005/QH11 passed by the National Assembly on November 29, 2005, taking effect as from 01 July, 2006;
 - Law No. 36/2009/QH12 of June 10, 2009 on amending and supplementing a number of articles of the Law on Intellectual Property, taking effect as from January 01, 2010;
 - Law No. 42/2019/QH14 of June 14, 2019, amending and supplementing a number of articles of the Law on Intellectual Property, taking effect as from November 01, 2019.
- Decree No. 103/2006/ND-CP of September 22, 2006 of the Government, detailing and guiding the implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property.
- Decree No. 122/2010/ND-CP of December 31, 2010, amending and supplementing a number of articles of the Decree No. 103/2006/ND-CP.
- Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology (MOST), guiding the implementation of the Decree No. 103/ND-CP of September 22, 2006 detailing and guiding the implementation of a number of articles of the Intellectual Property Law regarding Industrial Property.
- Circular No. 16/2016/TT-BKHCN of June 30, 2016 of the MOST amending and supplementing a number of articles of Circular No. 01/2007/TT-BKHCN dated February 14, 2007 of the MOST guiding the implementation of Decree No. 103/ND-CP of September 22, 2006 of the Government detailing and guiding the implementation of a number of articles of the Intellectual Property Law regarding Industrial Property, amended and supplemented according to the Circular No. 13/2010/TT-BKHCN of July 30, 2010, the Circular No. 13/2010/TT-BKHCN of July 30, 2010, the Circular No. 18/2011/TT-BKHCN of July 22, 2011 and the Circular No. 05/2013/TT-BKHCN of February 20, 2013.
- Circular No. 263/2016/TT-BTC of November 14, 2016 of the Ministry of Finance on collection, payment, management and use of industrial property fees and charges

3.2. Regulations on application for trademark registration

3.2.1. Application document for trademark registration

The application for trademark registration includes the following documents:

◆ **Compulsory documents**

- Declaration for registration, which are typed according to the Form: 04-NH Appendix A of the Circular No. 01/2007/TT-BKHCN (02 copies);
- Mark specimens (01 mark specimen attached to the written declaration; 05 identical specimens);
- Fee and charge receipt;
- For an application for registration of a collective mark or certification mark, in addition to the documents specified above, the application must also contain the following documents:
 - Regulations on use of collective mark and certification mark;
 - Description/Explanation of particular characteristics and quality of the product bearing the mark (if the to-be-registered mark is a collective mark used for a product with unique characteristics or a mark for certification of the quality of a product or a mark for certification of geographical origin);
 - Map showing the indicated territory (if the to-be-registered mark is a mark for certification of the geographical origin of a product; or collective mark or certification mark having designation of GI or any sign of geographical origin of local specialties);
 - Document of the People's Committee of a province or city directly under the Central Government permitting the use of geographical names or signs indicating the geographical origin of local specialties to register a trademark (if the registered mark is a collective mark certification mark contains place names or signs indicating the geographical origin of local specialties).

◆ **Other documents (if any)**

- Power of attorney (in case the request is filed through a IP representative);
- Documents certifying the permission to use special signs (if the trademark

contains emblems, flags, armorial bearings, abbreviated names or full names of Vietnamese state agencies/ organizations or international organizations, etc.);

- Paper on assignment of the right to file an application (if any);
- Documents certifying the lawful right of registration (in case the applicant enjoys the right to file from another person);
- Documents evidencing the right of priority (if the patent application has a claim for priority right).

3.2.2. General requirements for registration applications

Application dossier must be made according to the standard form and have all the information and documents submitted together with regulations (application forms are available at www.ipvietnam.gov.vn). Enterprises need to fill all the information in the boxes in the Declaration of trademark registration (or Declaration).

The mark specimens should be clear and sharp in an area of 8x8cm. If color protection is required, all mark specimens on the Declaration and enclosed documents must be presented in the correct colors to be protected.

When filing a trademark application, in the Declaration, the goods and services intended to bear the mark in the application need to be classified according to the Classification of Goods and Services of the Nice Agreement (NLC)⁴. The applicant can refer to the web portal of the National Office of Intellectual Property of Vietnam (IPVN) at www.ipvietnam.gov.vn to determine the list of goods and services as the basis for grouping and the version of NCL being applied at the time of application⁵. If the applicant fails to classify or classifies incorrectly, the IPVN will do the classification during the application examination and the applicant must pay an additional classification fee as prescribed.

3.2.3. Fee and charge for trademark registration

1.	Official charge for filing application	VND 150,000
2.	Fee for publication of application	VND 120,00

⁴ Nice Agreement, a multi-lateral treaty managed by WIPO, establishes the Nice Classification (NCL). The Nice Agreement was concluded on June 15, 1957 and revised at Stockholm, on July 14, 1967 and at Geneva on September 28th, 1979. The Nice Agreement concerns the international classification of goods and services for the purposes of the registration marks. The NCL includes class headings, explanatory notes and an alphabetical lists of goods and services. The NCL embraces 35 classes of goods and 11 classes of services. The NCL is frequently updated and amended and a new edition is published every 5 years and a new version of each edition is published annually.

⁵ The edition is effective at the time of building this manual is Version 11-2022: https://ipvietnam.gov.vn/documents/20182/1237885/23.03.22_Class+headings+Nice+11-2022+%28Final%29.pdf/6868d882-30c8-4e0a-a814-164f7dd2a43c

3.	Fee for the trademark search for the substantive examination process	VND 180,000 per 01 group of goods or services
4.	Fee for the trademark search from the 7 th good or service onwards	VND 30,000 per 1 good or service
5.	Fee for formality examination	VND 550,000 VNĐ per 01 group of goods or services
6.	Fee for formality examination from the 7 th good or service onwards	VND 120.000 VNĐ per 01 good or service

3.3. Preparing the application documents

3.3.1. Design marks (logo)

Trademarks need to be unique and recognizable in order to be able to perform a distinguishing function:

- Choose signs that are easy to read, write, spell and memorize.
- Avoid choosing signs that are inherent in everyone's use (images, words describing products/services, common product names, letters, numbers, drawings, etc)
- Do not choose signs that are praiseworthy, misleading or confusing to consumers.
- Do not choose signs that are contrary to social order and ethics, such as symbols of terrorist organizations, reactionaries, etc.
- Do not choose signs that contain too many elements leading to confusion and failure to perform the function of the mark
- Don't use signs in a language that Vietnamese consumers will be unable to recognize and remember.
- Limit the use of place names on the mark if it is not a collective or certification mark.



3.3.2. Filling the application form

The Declaration of trademark registration is made according to the form No. 04-NH Appendix A of Circular 01/2007/TT-BKHCN

(1) Box number ① Mark: *To show the mark to be registered*

- Mark specimen: The sample of the mark must be clearly presented, in the correct color claimed for protection, or in black and white if color protection is not required, and with dimensions of each dimension not larger than 80mm and not less than 30 mm, attached (glued or printed) to the 80mm x 80mm square printed on the Declaration;
- For 3D mark: the mark template is a photograph or a perspective drawing and may be accompanied by a projection
- Type of mark: Cross x in the corresponding box if you want to register a collective mark, a certification mark, or an associate mark. For an associated mark, the applicant must specify the linking elements of the mark or of goods or services; if not specified, the mark is examined as for ordinary marks.
- Description of mark:
 - If the mark is composed of many elements, the constituting elements and the combination between those elements must be clearly indicated; if the mark contains figurative elements, the content and meaning of the figurative elements must be clearly stated;
 - If the mark is colored, the claim for protection of the color mark must be clearly stated and the name of the color shown on the mark
 - If the mark contains non-Vietnamese words and words, it must be transliterated and translated into Vietnamese;
 - If the mark contains numerals other than Arabic numerals or Roman numerals, it must be translated into Arabic numerals.

(2) Box number ② Applicant

The applicant is the name of who wishes to register the mark in order to become the owner of the mark. Applicant as an organization puts the name of the organization and the address recorded in the Certificate of Business Registration/Certificate of Household

(3) Box number ③ Representative of the Applicant

- Legal representative of the applicant: In case the applicant is an enterprise with legal status, the individual conducting transactions on behalf of the enterprise is the legal representative of the enterprise (the head) or the authorized person by law (deputy, or subordinate).
- In case the applicant is a household, the individual conducting transactions on behalf of the household is the head of the household or the person authorized by the household head, which is recorded in the Certificate of Household Business Registration.
- An Industrial Property Representative authorized by the applicant: the individual conducting transactions on behalf of the authorized Industrial Property Representative is the legal representative or the person legally authorized by the Industrial Property Representative (with a Certificate of Practices).
- Another person authorized by the applicant: the individual who performing transactions on behalf of the applicant are individuals authorized by the applicant to represent their civil relations rather than for business purposes.

(4) Box number ④

In case the applicant is titled a priority right of the first filing, all information about the “first-to-file” right and information of the first application submitted

(5) Box number ⑤ Fees and charges

It is necessary to determine the number of groups of goods and services and the number of products and services in each group to calculate the correct fees, especially in the case of payment of fees and charges by post or bank transfer to the account of the IPVN.

(6) Box number ⑥ Attached documents to the application

Cross x to the list of documents included in the application

(7) Box number ⑦ List of goods and services bearing the mark

List of products and services that need to be registered and grouped according to the NCL published by the IPVN on the Industrial Property Official Gazette and the website <http://www.noip.gov.vn>. If the goods and/or services are not classified or classified

incorrectly, the IPVN will classify and the applicant must pay the fee for classification service as prescribed.

(8) Box number ⑧ Characteristics of goods and services certified by the mark (for certification mark). Briefly describe the following features:

- Geographical origin: characteristics related to the origin
- Quality: accuracy, safety, etc.
- Other characteristics: raw materials, materials, production methods, methods of providing services, etc.

(9) Box number ⑨ Commitments of the Applicant

The individual conducting transactions on behalf of the applicant or the applicant's representative (as instructed in box ③) fills in their full name, title (if any) and sign box on ⑨ each page of the Declaration. The applicant or his representative who is a legal entity or an organization must affix the seal.

3.4. Guide to proceed the application

3.4.1. Application submission

Applicants can choose to submit their application in paper form or via online through the virtual public services portal of IPVN, specifically:

a) Paper filing

The applicant may submit an application for a trademark directly or via postal service to one of the address of the IPVN:

- Head Office of IPVN: 386 Nguyen Trai, Thanh Xuan district, Hanoi.
- Representative Office of IPVN in Ho Chi Minh City at: 7th floor, Ha Phan Building, 17/19 Ton That Tung, Pham Ngu Lao Ward, District 1, Ho Chi Minh City.
- Representative Office of IPVN in Da Nang City at: 3rd floor, 135 Minh Mang, Khue My ward, Ngu Hanh Son district, Da Nang City.

In case of filing an application for a trademark by post, the application charges/ fees must be transferred by postal service, and then a copy of the Money Transfer Receipt must be attached to application and sent to one of the above-mentioned IPVN's offices to prove the fees payment.

(Note: If fees or charges are transferred to one of the above-mentioned IPVN's offices, the applicant must send the application dossier to the corresponding office).

b) Online filing

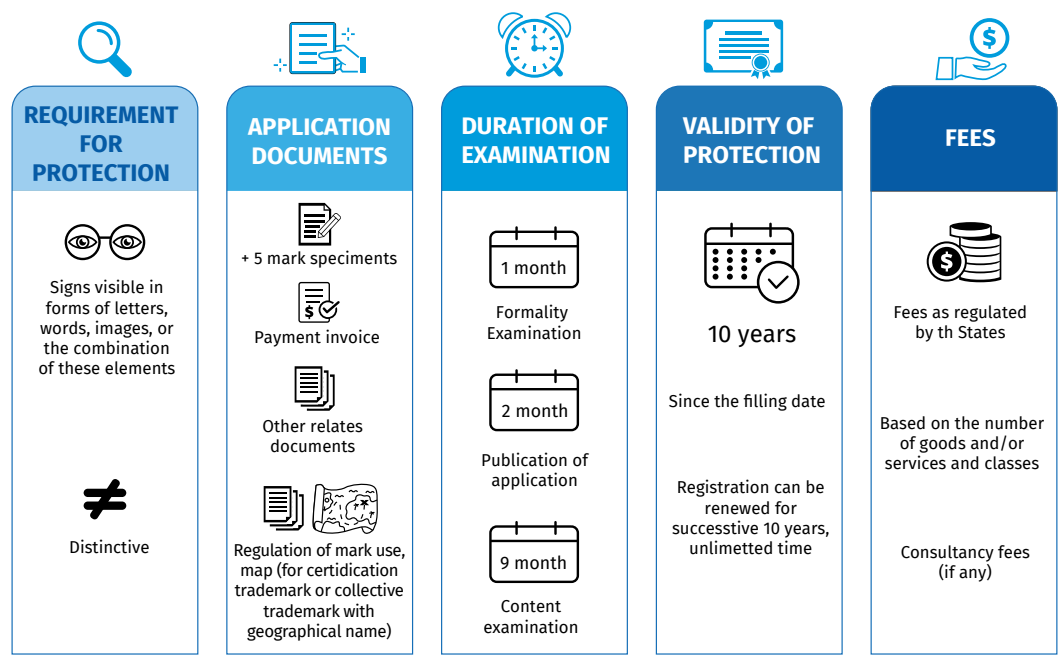
- Conditions for online filing: The applicant need to have a digital certificate, a digital signature and an account approved by the IPVN on the Online Application Receiving System.
- Online filing:
 - The applicant needs to complete the steps of online trademark registration on the IPVN's Online Application Receiving System. Once all steps are completed, a confirmation of online submission is sent to the applicant.
 - The confirmation of online submission must be presented to one of the IPVN's office and the applicant needs to attach documents (if any) and pay fees/charges as prescribed within 01 month from the date of online submission.
 - If all documents and fees/charges mentioned above are fully submitted as prescribed, IPVN will provide an application number in the Online Application Receipt System. If any required documents or fees/charges are not submitted, the application will be rejected.
 - In the event that the applicant fails to complete the prescribed application procedure, the online application will be canceled and an Online Application Cancellation Notice will be sent to the applicant via the Online Application Receiving System.

3.4.1. Procedure to process the application

From the date on which the registration application is received by the IPVN, the trademark registration shall be examined in the following steps:

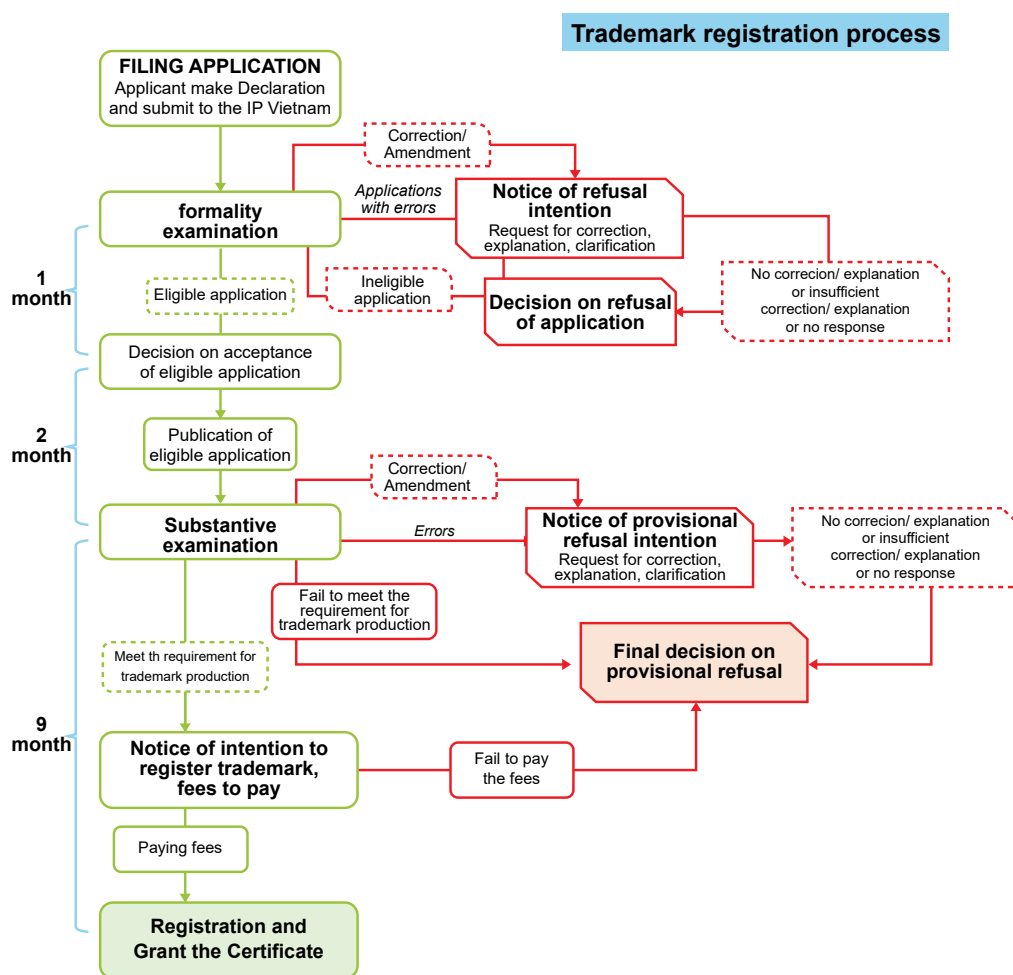
- Formality examination: A trademark registration shall be subject to a formality examination within 01 month from the filing date.
- Publication of trademark registration: A trademark registration shall be published within 02 months after it is accepted as a valid application;
- Substantive examination: An industrial property registration application shall be subject to a substantive examination within 09 months from the date of publication.

Figure 1: Conditions and process to file the application at the IPVN



During the examination of a trademark registration, when the application contains errors that need to be amended or supplemented or does not satisfy the protection criteria, the IPVN will send a Notice of examination results, specifying the deficiencies and a deadline to request the Applicant to respond. The applicant's response will be handled by the IPVN who then will make relevant decisions. In case of disagreement with the NOIP's decisions related to the registration procedure, the Applicant may carry out with the complaint procedure to the IPVN.

Figure 2: Procedure of application examination at the IPVN



3.4.2. Validity of trademark license

A certificate of trademark registration is valid from the date of issue to the end of 10 years from the filing date, and can be renewed for every successive 10 years.

The certificate of trademark registration is valid throughout the territory of Vietnam and only valid in Vietnam.

Trademark registration certificates in other countries are not valid in Vietnam. To get trademark protection in any country of interest, businesses must register their trademarks according to the laws of those target countries.

3.5. Experiences of building and protecting trademarks in Vietnam

3.5.1. Common shortcomings and mistakes in the trademark registration

- A trademark is cumbersome and confusing when it contains too many descriptive components, user guides, ingredients or components of the goods and/or services;
- A trademark is represented in unclear, blur and wrong-size format. The mark on the Declaration and the attached specimen are not of the same colour.
- A mark specimen containing an obvious sign indicating a geographical origin that is not consistent with the actual origin of the goods/services, or a sample of a mark containing only a geographical name or a part of a geographical name standing separately as an independent component of the mark but the mark is not subject to registration of neither collective nor certification mark;
- Detailed description of the mark doesn't reflect the distinctive component of the mark; or the mark description incorrectly represents the shapes and colour shown on the mark specimen;
- The Applicant's name is not consistent with the certification seal on the Declaration;
- The address of the Applicant is not clear enough to communicate the Notices/ Decisions;
- The person who signs in the Declaration does not have enough evidence to prove their ability and competence to represent the Applicant (for example, the Deputy Director of a enterprise signs the Declaration without Power of Attorney made by Director);
- The general list of products and/or services is not clear enough to verify the related classes and to define fees/charges.
- Names of the products and/or services are too detailed or use unfamiliar local terms.

3.5.2. Search information about protected marks

In order to minimize any potential risks, save time and costs related to trademark registration if someone else has registered a trademark identical or similar to the mark to be registered for the same or similar product or service, the applicant should proceed pre-filing trademark searches to explore the possibility of trademark registration.

Search activities are of the scope of work of the management agency (IP Office). However, to improve the possibility of trademark protection, the applicant can do searches by his own, or recruit a professional experienced in trademark registration (IP representatives, IP consultant).

Searching activities include:

- Trademark name: Looking up the ability to distinguish the names of tentative marks to see whether the mark overlaps with the names of previously filed or registered trademarks.
- Classification of goods/services: Defining the class of goods and/or services to be registered according to the NCL which is regularly updated on the website of the IPVN (see 3.2.2).
- Classification of shapes: The international classification of figurative elements according to the "Vienna Agreement"⁶ aims to simplify and unify the way of evaluating figurative elements in marks in the international scope.
- Name of product/service: Verifying the name of the products/services related.

Information on registered or filed trademarks can be obtained from the following sources:

- The Industrial Property Official Gazette is issued monthly by the IPVN;
- National Trademark Register (archived at the IPVN);
- Digital library of industrial property on the WIPO publish platform by following the link: wipopublish.noip.gov.vn
- Industrial property electronic library of the IPVN <http://iplib.noip.gov.vn/WebUI/WSearch.php>
- Database of international trademark registration under the Madrid System: <https://www3.wipo.int/madrid/monitor/en/>

Pre-filing trademark search is a reference step to avoid duplicate trademarks. The functional agency managing the trademark registration and trademark protection (IPVN) makes final decision, but it is advised to consult IP professionals prior to proceeding the trademark registration.

⁶ The Vienna Agreement which establishes an international classification (Vienna Classification) of the figurative elements of marks, was concluded in 1973, revised in 1985 to enable national IP Offices (party to or not party to the Vienna Agreement) to refer when examining marks that consist of, or contain figurative elements. The current Classification is the Edition 6 which is effective as from January 01, 2008. The Classification is a hierarchical system classified into 29 categories, 144 divisions, 1,667 sections to which the figurative elements of those marks belong.

PART 4.

**REGULATIONS ON
INTERNATIONAL
TRADEMARK
REGISTRATION**

4.1. The need for trademark protection abroad

In recent years, Vietnam is one of countries the most active in enhancing trade cooperation with countries and territories world-wide. A number of bilateral and multilateral treaties and free trade agreements (FTA) have affirmed the confidence of the international community in Vietnam's development potentials, and opened up export opportunities for key industries of Vietnam, especially agriculture, forestry and fisheries. In the big world market full of opportunities and acute competition, Vietnamese enterprises are said to gradually build their reputation through product quality and branding.

Many Vietnamese companies focus on production and trade to overcome the barriers on business conditions or standards in export market, but don't pay enough attention to trademark protection. Trademarks, as a component of a brand, are the intellectual property of enterprises, and are an effective tool in international economic integration. Trademark registration is voluntary and optional, but it constitutes recognition of the market for the products or services.

Trademark registration in Vietnam and abroad is crucial for Vietnamese enterprises, especially those have export activities. The exclusive protection of trademarks in the export market shall:

- Help businesses to penetrate and develop their export markets;
- Have trademarks be protected by law against any violations, unfair competition or appropriation of competitors;
- Help local producers or makers to increase the distinguishability of the mark from others;
- Increase commercial value.

4.2. Principles and rules

For a product or a service, reputation is an intangible element expressed in the form of a trademark, which is protected by law if it meets the conditions stipulated in the IP Law of each country. In general, following principles and rules are applied to the IP protection in the international market:

4.2.1. Principle of territorial rights

Territorial rights: A trademark exclusively protected in a country or territory does not mean that the trademark is protected worldwide. The trademark's effects only extend to the territory or territories where protection is requested. For a trademark protected in the territory of interest, the applicant must satisfy all conditions required by law and navigate the registration process in accordance with regulations of the respective country or territory.

A pre-requisite for trademark protection sets that the trademark intended for registration is not identical or similar to any other marks in the target country. To meet this condition, the applicant is recommended to do a clearance search before filing an application.

Although applicants can use some free search engine systems such as the WIPO Global Brand Database (<https://branddb.wipo.int/branddb/en/>) or the European Union's trademark search engine (TMView - <https://www.tmdn.org/tmview/#/tmview>), each country has its own trademark database. The regulations on similarity of trademarks differ among countries and territories.

A clearance search of the trademark registration and preliminary assessment is recommended to be carried out by professionals such as an IP representative or a law office in the target country.

4.2.2. Principle of “first-to-file”

In the event that trademarks applied for registration are identical, the trademark registration shall be granted to the first person or company filing the application in that country (“first-to-file” rule).

4.2.3. Principe of IP Representative

In addition to legal expertise, it is not mandatory for a foreign enterprise to work with an IP representative or an IP attorney to file a trademark registration. Working with IP representatives is beneficial because they understand the legal jargon and nuances of the application form, helping the applicant to avoid errors within the application itself and saving both time and money in the overall application process. The applicants can do a search and selection of an experienced service provider in a foreign country. However, authorizing an IP representative domiciled in Vietnam will help the applicant reduce efforts in information exchange, document collection and monitoring of trademarks.

There are two options for protecting a trademark abroad:

1. The direct route: The national route is where separate applications for trademark registration are filed directly with the IP Offices of each country or territory where protection is sought. The regional route is where a single application is filed with an intergovernmental organization in the region where protection is sought (for example, the European Union Intellectual Property Office);
2. The international route (via the Madrid System), where a single application is filed for multiple countries and regions where protection is sought.

4.3. Consequences of losing trademarks

Trademark appropriation is a common occurrence in Vietnam and internationally. Once a trademark is not registered abroad in time and other producer or supplier succeeds in mark registration, consequences that enterprises may encounter are:

- If the goods are not exported to a foreign market, any export plan will be impossible. Thus, enterprises must change and switch to other marks if they want to continue their export strategies. This action thus incur new costs.
- If the goods are already exported to that market, the legal owners of the registered mark would be able to request legal interventions that may lead to the surrender of imported goods, sanction against the owner of goods, and the risk of losing market.
- If the trademark is appropriated in the neighbouring countries of Vietnam, there is a risk that the trademark appropriator will produce counterfeit goods and sell them into Vietnam.

4.4. Direct national and regional for international trademark registration

International trademark registration is done when trademark owners or holders file application for trademark protection directly to the IP Office of the countries of interest.

The international application needs to be prepared in local languages and meet the regulations of the respective countries. All the registration process and fees correspond to the regulations of those countries.

Direct application in a country of interest is suitable when the applicant just targets just a few markets (1 to 3 countries), making it easy for proactively managing the status of the application and then sustaining the validity of the protection title.

4.4.1. Trademark registration in European Union

Website: <https://euipo.europa.eu/ohimportal/en/home>

a) General information

The European Union (EU) consists of 27 member states: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden. The European Union Intellectual Property Office (“EUIPO”) has developed a standard legal system that applies to all member states. Trademarks registered through this system are known as the European Union Trade Mark (“EUTM”).

When registering a trademark through the EUTM registration system, the trademark holder only has to submit a single application, and the trademark can be protected in all EU member countries. However, if a trademark is rejected or invalidated in a member state, it is also invalidated in the community as a whole. At this point, if the trademark holder still wants to register the trademark in other countries in EU, the applicant can convert the EUTM application into a separate national application for each country of interest. The application resulting from the conversion bears the same filing date as that of the EUTM application.

Since the EUTM registration system is independent from national registration system, the trademark owner is free to file either a EUTM application or a national application, or both of them. EUTM and national registered trademarks can coexist.

The 5 official working languages of EUIPO include English, French, German, Italian and Spanish.

Box 1: Options for registering trademarks in the EU

- **National level:** Applications are submitted directly to the IP Offices in the target EU countries. This route allows only the protection the mark within a country of target.
- **Regional level:** Applications are filed at the Belenux Office of IP (BOIP) to have the trademark protection valid in the countries of Belgium, Netherlands and Luxembourg.
- **EU level:** Applications are submitted to register EU Trademark at the EU Intellectual Property Office (EUIPO). Any change or cancelation shall be applied and valid in all state members.
- **International level:** Trademark owners or holders can register their trademarks through the Madrid System to have their trademarks protected in EU countries. However, this route doesn't automatically cover all 27 member states. This single procedure is recommended if you only use your trademark in a few European countries or if you want to protect your trademark outside the EU.

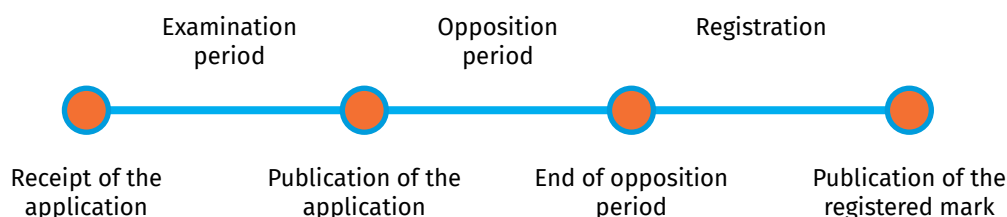
b) Application dossier includes following documents:

- Power of Attorney (if any);
- Request for registration of a trademark;
- Applicant's details;
- Representation of the trademark;
- List of the goods and/or services;
- Invoice of fees payment.

c) Duration of registration procedure

Registering an EU trademark (in case of absence of objection or rejection) usually takes around 9 to 12 months.

Figure 3: Trademark registration procedure in EU



Note:

- The fees for trademark registration shall be paid within 1 month since the date of filing the application to enact the official application procedure in the EUIPO system.
- When filing the application, the applicant can request additional search services from EUIPO. The search report will be sent to the applicant prior to the publication of the application. In the event of an identical or similar trademark (“control trademark”), the holder of this control trademark will also be notified by EUIPO.
- During the examination of the application, if there are any errors or objections to the application, EUIPO will send a notice to the applicant to request an amendment or a response to the objection within 02 months. In case the amendment/response is not accepted by the registration authority, the trademark application may be rejected or cancelled.
- At the end of the examination stage, the trademark application will be published in the EU Trademark Bulletin to enable any third parties to make objections (if any) within 3 months from the date of the publication of the trademark.
- At the end of the objection stage, if the trademark does not receive any objection from the third party or the opposition is rejected, EUIPO will grant the single registration certificate of the trademark to the applicant.
- The applicant may request EUIPO to proceed under the “Fast Track” system if the application meets certain conditions, more details at: <https://euipo.europa.eu/ohimportal/en/fast-track-conditions>

d) Validity of the trademark protection title

EU trademark is valid for 10 years since the filing date and can be renewed for successive 10-year periods an indefinite number of times. The proprietor of the trademark may request the renewal of the term during a six-month period prior to expiry date of trademark protection. An application for renewal may be filed after expiry of legal protection of the trademark within a six-month grace period upon payment of surcharge.

e) Types of trademark protection

- Common mark;

- Collective trademark, Certification trademark (may include geographical name of place).
- Geographical Indication (registered at the Agricultural Commission of EU)

f) Registration fees

- The reference fee (for a one-class trademark, excluding search fee): €2,700 (around VND 65,000,000), including:
 - Basic fee (for the first class of good and/or service): €850 for online filing, €1,000 for paper application at the EUIPO.
 - Basic fee for a collective trademark or certification trademark: €1,800 for paper filing; €1,500 for online filing.
 - Fee for application for a mark in 2 classes: an extra of €50.
 - Fee for each additional class thereafter: an extra of €150
 - *For example: an application for three-class trademark will be €1,050 for online filing, €1,200 for paper filing.*

g) Notes

- The list of goods and services is described in accordance with EUIPO regulations;
- EUTM accepts any marks can be represented in any form with the application of technology, on condition that those marks are shown in clear and precise representation. For example, sound mark, motion mark, multimedia mark and other untraditional marks.
- It is necessary to monitor similar trademarks of others filed later to oppose;
- The trademark owner should provide proofs of trademark use within 5 years from the filing or priority date;
- Comparative advertisements may be considered a trademark infringement;
- EU trademark owner can prevent all third parties from bringing goods into EU, even if the goods are only in transit through EU member countries destined to countries outside the EU.

4.4.2. Trademark registration in the United States

Website: <https://www.uspto.gov/>

a) General information

The United States Patent and Trademark Office (USPTO) is the federal agency that receives patent and trademark applications and grants US patents and registering trademarks in the country.

USPTO applies the principle of “first to use” and has some mandatory requirements as follows:

- Trademark has been already in use in the US; or
- Applicant intend to use the trademark in the US;
- The trademark has been filed for registration in a country that is a party to the Paris Convention, or a country that is a party to an International Trademark Agreement recognized by the United States; or the trademark has been registered in the Applicant’s country of origin (Vietnam).

USPTO requires the trademark holder to submit the Declaration and Proof of Use in the US twice (2 times): in the 5th and 9th years from the date of granting the trademark certificate. This requirement also applies to subsequent life cycles of rights protection (every successive 10 years).

b) Application dossier includes:

- Engagement Letter with an US Representative (available form)
- Representation of trademark (specimen of no bigger than 8cm x 8cm)
- List of goods and/or services

c) Duration of registraton procedure

Registering an US trademark (in case of absence of objection or rejection) usually takes around 12 to 18 months.

Note:

- After the end of the examination stage, the trademark application will be published for the third parties to make objections (if any) within 1 months.
- Upon specific cases of the use of the trademark or the status of the trademark

registration, USPTO will notify the applicant (after the objection period) of further procedures to complete the trademark registration, specifically as follows:

- If the trademark is registered based on “already in use” basis, or based on a basic application (Vietnam), the USPTO will officially grant a protection title.
- If a trademark is registered based on “intent to use” basis, the USPTO will notify the applicant to submit following additional documents within 6 months: (1) Statement of use of mark, or (2) A 6-month extension request to file a Statement of use of mark. These documents will also subject to examination by the USPTO to decide whether to grant a protection title to the applicant.
- Any delay in response to USPTO’s Notification (including registration, post-registration, and maintenance) will result in the cancellation actions.

d) Validity of trademark protection title

US trademark is valid for 10 years since the date of granting the registration certificate and can be renewed for successive 10-year periods an indefinite number of times.

In addition to the renewal procedure, the trademark holders need to pay attention to the maintenance of the marks and the actual use of the trademark in the territory of the United States.

e) Types of trademark protection

- Common trademark;
- Collectice trademark; Certification trademark (it may include the geographical name).

f) Registrtion fees

Fees associated with filing US trademark application (for a one-class of good and/or service, exclude trademark search fee): USD 2,200 (approximately VND 51,000,000).

4.4.3. Trademark registration in Australia

Website: <https://www.ipaustralia.gov.au/>

a) General information

IP Office of Australia (IP Australia) is the Australian Government agency that administers IP rights and legislation relating to patents, trademarks, designs and plant breeder’s rights.

In Australia, the principle of “first-to-file” is applied.

b) Application dossier include:

- Trademark representation (specimen of not bigger than 8cm x 8cm)
- List of goods and/or services to be registered

c) Duration of registration procedure

Registering an trademark in Australia (for straightforward cases, without objection or rejection) usually takes around 15 to 18 months.

Note:

- IP Australia provides online public service “TM Headstart” to assist applicants in a preliminary assessment of the mark before filing an official application. More details at: <https://www.ipaustralia.gov.au/trade-marks/applying-for-a-trade-mark/how-to-apply-for-a-trade-mark/tm-headstart>.
- After the examination stage, the trademark application will be published for the third parties to make objections (if any) within 2 months. At the end of this stage, if there is no objection, the trademark will be granted a protection title.
- In the event that the trademark does not meet the requirements for protection, the applicant will receive a Notification from IP Australia and have 15 months to respond. The applicant has the right to request an extension of 15 months to respond.
- The applicant may request the IP Australia to carry out an accelerated examination after 7 months from the filing date of application, provided that the reasons given are reasonable and well-founded.

d) Validity of trademark protection title

Protected trademark is valid in Australia for 10 years since the filing date and can be renewed for successive 10-year periods. The proprietor of the trademark may request a renewal of the term during a one-year period prior to expiry date of trademark protection.

e) Types of trademark protection

- Common trademark;
- Collective trademark/ Certification trademark (may include the name of place of origin);
- Geographical indication

f) Registration fees

Fees associated with filing trademark application in Australia (for a one-class of goods and/or services, exclude trademark search fees) is USD 1,800 (approximately VND 42,000,000).

4.4.4. Trademark registration in Japan

Website: <https://www.jpo.go.jp/e/index.html>

a) General information

The current law that provides the principles of establishing and enforcing IP rights regarding trademarks is the Japanese Trademark Act dated 13 April 1959, through many amendments and supplements, the latest edition being in 2020.

Japan Patent Office (JPO) is the agency that receives applications and grants trademark registration certificates in the country.

Japan has its own laws and policies for GI, which are administered and enforced by the Japan's Food Industry Affairs Bureau (FIAB) - Ministry of Agriculture, Forestry and Fisheries (MAFF).

Japan applies both the International Classification of goods/services under the Nice Agreement and Japan's National classification system.

In Japan, the principle of "first to file" is applied.

The filing of a trademark application in Japan can be done through a Japanese IP lawyer or representative agency or the applicant can file in person. However, filing through a lawyer or representative will have more beneficial because with their professional expertise and experiences, they can advise on problems that may be encountered in the application or in the trademark, make the application smooth and more convenient, monitor the status of the application and notify the applicant promptly of the status of the trademark application.

b) Application dossier includes:

- Name and address/domicile of the Applicant;
- 20 specimens of trademark (representation of not bigger than 8cm x 8cm);
- List of goods and/or services to be registered.

c) Duration for registration procedure

Registering trademark in Japan takes from 10 to 15 months.

Note:

- In case the trademark has been used in the territory of Japan, the applicant can use this information to request the JPO to carry out an Accelerated Examination. The time for JPO to issue the first Notification of substantive examination's result will be within 1.5 to 2 months from the date of request for Accelerated Examination.
- The applicant can request the JPO to carry out the "Fast Track" examination procedure if the application meets certain conditions, more details at: https://www.jpo.go.jp/e/system/trademark/shinsa/shohyo_fast_e.html
- After the end of the examination stage, the trademark application will be published for the third parties to make objections (if any) within 2 months. At the end of this stage, if there is no objection, the trademark will be granted a protection title.

d) Validity of trademark protection title

Trademark protection in Japan is valid for 10 years since the filing date and can be renewed for successive 10-year periods.

e) Types of trademark protection title

- Common trademark;
- Collective trademark (may include the geographical name of place);
- Geographical Indication (registered at MAFF).

f) Registration fees

The fees to be paid to the JPO is ¥12,000 for the 01 first class of one application, ¥8,600 for each subsequent class in the same application.

Fees associated to the trademark registration (for a one-classe trademark application, excluding search fee): USD 2,000 (approximately 46,000,000).

4.4.5. Trademark registration in Republic of Korea

Website: <https://www.kipo.go.kr/en/MainApp?c=1000>

a) General information

Korea has been a Party to the Paris Convention since May 4, 1980, and has joined WIPO since March 1, 1979

The current law that provides the principles of establishing and enforcing IP rights regarding trademarks is the Korean Trademark Act dated January 13, 1990, through many amendments and supplements, the latest edition being in 2011.

The Korean Intellectual Property Office (KIPO) is the agency that receives applications and grants trademark registration certificates in this country.

In the Republic of Korea, the principle of “first-to-file” is applied.

b) Application dossier includes

- Power of Attorney (POA) signed and sealed by the applicant. For legal entities, the person signing the POA must be the legal representative or authorized by the legal representative in accordance with the law;
- Trademark specimen (representation of high-resolution);
- List of goods and/or services to be registered according to the Nice Classification.

Note:

- The official language of trademark applications in the Republic of Korea is Korean.
- An application for a trademark registration in the Republic of Korea must contain at least the following content
 - Representation of the trademark;
 - Details of the applicant;
 - The goods and/or services and the designated type(s) of the trademark.
- A certified copy of the Priority Document along with a Korean translation must be filed within 3 months of filing the trademark application. This period is not extended.
- Scanned copy of POA submitted at the same time as the trademark application in Korea. If it is not filed at the time of application, KIPO will issue a notice of filing and specify the time period for submitting the POA.

c) Duration of registration procedure

Registering trademark (for straightforward cases) in the Republic of Korea often takes from 12 to 14 months.

Notes:

- The applicant has the rights to request KIPO to carry out the accelerated examination procedure immediately after filing the application if certain conditions are met such as: the trademark has been used or is intended to use in the near future in the Republic of Korea; the mark has been searched by professional designated by KIPO, or the trademark is being used by a third party. Examination results will be notified within 2 months (instead of 8-10 months as of normal examination).
- After the examination stage, the trademark application will be published for the third parties to make objections (if any) within 2 months. At the end of this stage, if there is no objection, the trademark will be granted a protection title.

d) Validity of trademark protection title

Protected trademark in the Republic of Korea is valid for 10 years since the filing date and can be renewed for successive 10-year periods. The proprietor of the trademark may request the renewal of the term during a one-year period prior to expiry date of trademark protection. An application for renewal may be filed after expiry of legal protection of the trademark within a six-month grace period.

e) Types of trademark protection

- Common trademark
- Collective trademark;
- Certification trademark (may include the geographical name of place)

f) Registration fees

Fees associated to the trademark registration (for a one-class trademark registration, excluding search fee): USD 1,200 USD (approximately VND 8,000,000).

Registration fees must be paid within 2 months from the date of receipt of the Fees Notice.

g) Requirement for use

The validity of a trademark registered in the Republic of Korea may be revoked through a

court hearing if it is found that the mark has not been used for 3 consecutive years prior to the filing date of the judicial proceedings.

4.4.6. Trademark registration in China

Website: <https://english.cnipa.gov.cn/>

a) General information

China has been a party to the Paris Convention since March 19, 1985, and a member of WIPO since June 3, 1980.

The current law that provides the principles of establishing and enforcing IP rights regarding trademarks is the Trademark Law of China dated August 23, 1982, coming into effect as from March 01, 1983; and through many amendments and supplements, the latest version being in 2019. The establishment and enforcement of IP rights for trademarks is applied throughout the territory of the People's Republic of China, excluding Taiwan and Hong Kong.

China National Intellectual Property Administration (CNIPA) is the agency that receives applications and grants trademark registration certificates in the country.

The China Trademark and Patern Office (CTMO) only accept the list of goods and services as stipulated in the Nice classification.

In China, the principle of "first-to-file" is applied.

b) Application dossier includes

- Original Power of Attorney: as available form, signed by the Applicant;
- The Power of Attorney is simply signed by an individual who is the legal representative of the applicant authorizing a selected IP agency in China. There is no need for notarization or consular legalization.
- Trademark specimen (representation of not bigger than 8cm x 8cm);
- A list of goods and/or services to be registered;
- A copy and translation of business registration certificate (for organization applicant);
- A copy of ID card/passport (for individual applicant);
- Certified copies of priority documents if priority shall be claimed.

Note:

- A multiple-class application is possible under the new China Trademark Law effective as from May 1st, 2014.
- However, filing a multiple-class trademark application is not recommended in China because of the registration practices in China and the following legal reasons:
 - First, trademark transfer simultaneously cover all classes under the initial application. Currently, division of a trademark application occurs only when a trademark application is partially denied, then the applicant can choose to split the trademark application to have partial registration endorsed and then proceed a new trademark application, while the rejected parts are subject to appeals process or are simply abandoned. Application division is generally not possible in other situations.
 - Second, the application for multiple classes does not save the application costs. The registration fees are still calculated on the basis of the number of classes and there don't have any discount for any additional classes for the same application.

c) Duration for registration procedure

Registering trademark in China (for straightforward cases without opposition nor rejection) takes from 18 to 24 months.

Note:

- China is the country with the largest number of trademarks in the world. In addition, trademark appropriation is a common phenomenon in China, therefore, applicants are recommended to conduct a trademark search prior to filing an trademark application in China.
- The trademark database in China is not made available to the public and can only be searched through an IP representative in China.
- The “Fast Track” examination is applied on a trial basis from the beginning of 2022.

d) Validity of trademark protection title

Protected trademark in China is valid for 10 years since the date of granting the registration certificate and can be renewed for successive 10-year periods. The proprietor of the trademark may request the renewal of the term during a six-month period prior to expiry date of trademark protection. An application for renewal may be filed after expiry of legal protection of the trademark within a six-month grace period upon payment of surcharge.

e) Types of trademark protection

- Common trademark;
- Collective trademark (may including the geographical name of place);
- Certification trademark (may including the geographical name of place);
- Geographical Indication.

f) Registration fees

Registration fees for reference (a one-class trademark registration, excluding search fees): USD 600 (approximately VND 14,000,000).

g) Requirement for use

Any registered trademark which is not used for three consecutive years after the date of registration, shall be subject to cancellation actions of non-use.

Table 3: Advantages and disadvantages of direct route

Advantage	Disadvantage
Short time of application processing in developed countries. Work directly with IP Offices in each country. Take advantage of the separate support systems ("Fast Track"; "TM Headstart") of national IP Offices in the country of interest	if the applicant file applications in multiple countries at the same time, varied registration process may challenge the application management (manage different registration numbers, renewal dates and procedures) Application fees vary among IP Offices. Additional costs for translation and the use of local representatives would be incurred when filing national or regional applications.

4.5. International trademark registration via the Madrid System

4.5.1. What is Madrid system?

Website: <https://www.wipo.int/madrid/en/>

The Madrid System is a system of the international trademark registration administered by the International Bureau of the World Intellectual Property Organization (WIPO) to facilitate the simultaneous registration of trademark worldwide. This system is governed by two treaties:

- (i) the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement (Marks)), concluded at Madrid on 4th April 1892, and revised at Brussels (1900), at Washington (1911), at The Hague (1925), at London (1934), at Nice (1957) and at Stockholm (1967), and amended on 28th September 1979. Currently, there are 55 States party to the Madrid Agreement (updated on 09th June 2022 on WIPO website), and
- (ii) the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol), concluded on 27th June 1989 in Madrid, and then amended in 2006 and 2007. Currently, there are 112 members to the Madrid Protocol (updated on 09th June 2022 on WIPO website).

The fundamental difference between the Madrid Protocol and the Madrid Agreement is the applicant may base their international application on a registration or an application filed with the IP Office of origin.

The Madrid Protocol was created, existing in parallel with the Madrid Agreement, to overcome the limitations of the Madrid Agreement and bring more flexibility to the Madrid System. All members of the Madrid Agreement have become Contracting Parties to the Madrid Protocol, and under the provisions of the Madrid Agreement, the international trademark registration basically follows the Madrid Protocol (with the exception of some terms relating to fees, issues relating to old international registrations... still bound by the Madrid Agreement).

States and organizations party to the Madrid System are collectively referred to as Contracting Parties. By 9th June 2022, the Madrid System has currently 112 members, covering 128 countries and territories and accounting for more than 80% of world trade⁷.

⁷ Updated at https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf

Vietnam is party to the Madrid Agreement (1949) and the Madrid Protocol (2006), so Vietnamese businesses can proceed trademark registration to countries and territories that are parties to the Madrid System.

4.5.2. Brief description of the Madrid System

Table 4: Key contents of the Madrid system

Dimension	Content
Objectives and benefits of application via Madrid system	The Madrid system simplifies the administrative aspect and offers a convenient and cost-effective way for trademark owners to obtain and maintain trademark protection: • Application filed at one place to seek a protection of trademark in multiple markets. • Application made in one language, be subject to payment of one set of fees (with exceptions, e.g. two sets of fees in Japan...) in one currency; • Simple and convenient post-registration management (modification, transfer of rights, cancellation, additional registration in other countries...)
Characteristics of Madrid application	An application for international registration under the Madrid System (referred to as an <i>international application</i> or a <i>Madrid application</i>) must be based on a basic application or registration (the basic mark, <i>i.e.</i>, before filing an international application, the person or entity must have already filed or registered the same mark in the IP Office of origin).
Who may use the system	• Any natural person or legal entity with a real and effective industrial or commercial establishment in a Contracting Party; or • is domiciled in a Contracting Party; or • is a national of a Contracting Party <u>For example:</u> - If you are a citizen or have business activities in Australia, you have connection to Australia (a member of the Madrid System) and you shall file an international application through the IP Australia - If you have connections to several Contracting Parties (for example, you may be a Vietnamese national living in the United States), you can choose any of these Contracting Parties (Vietnam or the USA) to apply for the trademark registration.
To whom the application is filed?	An application shall be filed to the International Bureau of WIPO through the local IP Office of the Contracting Party for trademark registration. In Vietnam, IPVN is the focal point.

Dimension	Content
Validity of international registration	An international registration is valid for 10 years, counted from the date of the international registration and may be renewed every 10 years, by payment of the prescribed fees.
Independence of international registration on basic application	International registration shall be subject to national registration (base application) for 5 years after registration. If the basic application or registration is invalidated (in whole or in part) for any reason, the international registration will be invalidated accordingly. In this case, the applicant may convert the international application into a national applications (submitted to the Contracting Parties designated by the initial international registration) and enjoy the filing date as same as the date of filing international registration or later specified date (even priority date, if applicable). After the above 5-year period, the international registration is independent of the basic of application or registration.
Trilingual Regime	English, French, Spanish (in Vietnam, only English and French are accepted)
Priority rights	An international application shall enjoy the right of priority according to the principle of priority as provided for in the Article 4 of the Paris Convention for the Protection of Industrial Property. <i>For example: if an international application is filed within six months from the date of filing of the base application, priority can be claimed for the international application as the date of filing of the base application</i>
Process of registration under the Madrid system	Apply in the country of origin. The local IP Office apprais the application and transfer to the International Bureau of WIPO; The International Bureau examines the formal requirements of the application, publishes the application in the IP Gazette, and forwards the application to the designated Contracting Parties; Designated Contracting Parties shall examine the application and notify the results (protection accepted or rejected) to the International Bureau of WIPO. The International Bureau of WIPO notifies the applicant of the result. (For details, see Figure 4)

Dimension	Content
Registration fees	International registration is subject to following fee schedule: • Basic fee; • Supplementary fee for each class of goods and services beyond three classes; • Complementary fee for each designated Contracting Party or individual fee for each designated Contracting (depending on the specific case); • Additional fees for each class of good or service exceeding three classes; For applications originated from Vietnam, an additional processing fee must be paid at the IPVN). For detailed information on the schedule of fees see is available at: https://www.wipo.int/madrid/en/fees/sched.html https://www.wipo.int/madrid/en/fees/ind_taxes.html
Representative of the Applicant before the International Office	The applicant or holder may appoint a representative to act on their behalf (to file or manage an international registration) before the International Bureau. With regard to who may be appointed as a representative before the International Bureau, the Madrid System does not provide requirements as to professional qualification, nationality, residence or domicile. The applicant or holder may appoint a representative in an international application or in a separate official form (form MM12) or by a letter of appointment submitted to the International Bureau. The representative can declare the scope of empowerment to act on behalf of the applicant in the subsequent designation and/or other documents (change of name, of address...) or other papers signed by the applicant and submitted through the IP Office of origin.
Subsequent designation (extension of scope of protection)	A subsequent designation to request for extending the scope of protection of international registration can be filed after the international application is granted and registered by the International Bureau (granting an international registration number) by submitting a request (form MM4) and paying fees.

Dimension	Content
What actions can the applicant can perform under the Madrid system?	The applicant may perform following actions: • File a request for international registration (the form MM2); • Request extension of geographical scope of international registration (the form MM4); • Renew an international registration (the form MM11); • Cancel an international registration (the form MM7, MM8); ... The applicant can manage different aspects of international registration using 22 MM forms downloadable at: https://www.wipo.int/madrid/en/forms/

4.5.3. Procedure of filing and processing international registration under the Madrid System

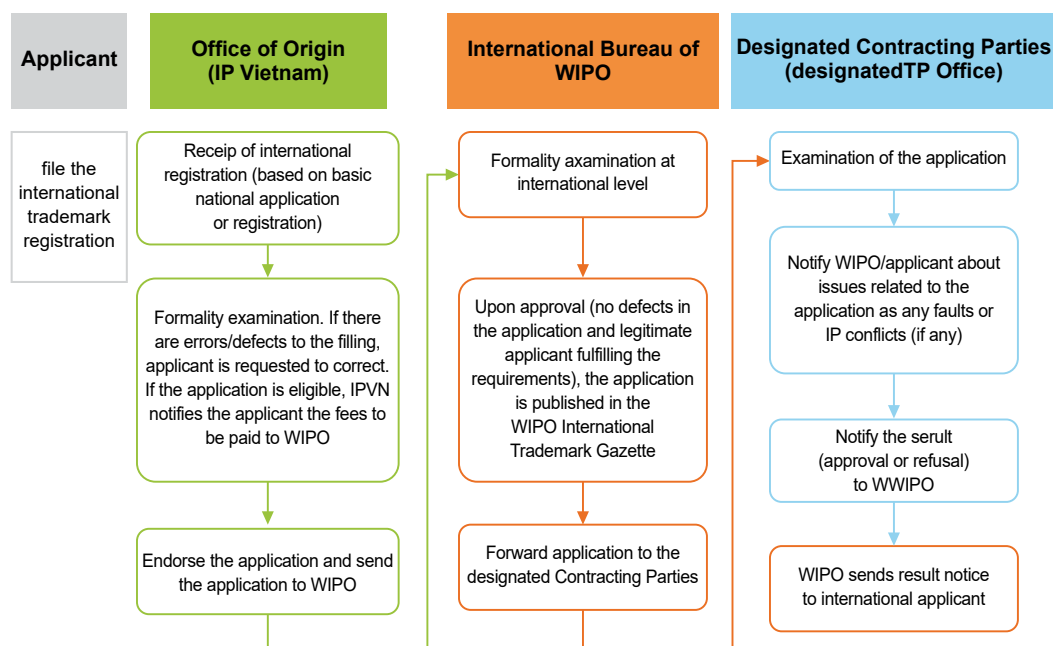
Based on a basic mark, an international application must be presented to the International Bureau through the Office of origin. The international application indicates the countries of interest for trademark protection.

Applications of international trademark registration of individuals or companies domiciled in Vietnam shall be made in English and submitted at the office of IPVN.

Addresses for filing the international registration: Head Office of IPVN in Hanoi, and Representative Offices of IPVN in Da Nang and Ho Chi Minh City.

The applications then will be processed and handled at the Center for Examination of Geographical Indications and International Trademarks under the IPVN.

Figure 4: Procedure for international trademark registration



Procedure for examination of international application at the IPVN

- Before the Office of origin transmits the international application to the International Bureau of WIPO, it must certify that the particulars of the international application correspond to the particulars appearing in the basic mark.
- If the application has no errors or defects, IPVN notifies the applicant fees to be paid to WIPO, and at the same time, the application is transmitted to the International Office of WIPO.
- After sending the application to WIPO, IPVN notifies the application and co-monitor the application.
- The applicant directly pays the fees to WIPO via bank transfer and submits the payment invoice (proof) to IPVN to complete the submission. IPVN verifies the payment document, if there are errors, the applicant is asked to correct.
- If the application has errors or defects, IPVN issues an official written request to the applicant to correct the errors. Once the application is completed, IPVN sends the payment notice and repeats the process as above.

- After sending the application to WIPO, if there is any notice from WIPO (for example, correcting the list of goods and/or services, omission or exchange of other related issues...), IPVN coordinates the matter handling according to regulations of the Madrid System

Procedure for examination of international application at the International Bureau:

- After receiving the international application from the Office of origin, the International Bureau examines the formality of the application (are there enough minimum documents? do the documents meet the requirements? are fees all paid?...).
- Where the International Bureau finds that the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the WIPO Gazette of International Marks (the Gazette). The applicant and designated Contracting Parties will be notified the publication.
- If the application does not meet all the requirements, the International Bureau notifies the applicant. The applicant has 3 months to correct all the defects. The correction period can be extended up to further 3 months. If the applicant does not correct all the defects within the allowed period, the application will be cancelled

Substantive examination of the international application at the designated IP Offices:

- The International Bureau then notifies the IP Offices of each of the members designated in the international application (or subsequently in the international registration). The designated Offices will examine the international application in line with their own national trademark legislation and practice, just as they would have done if the trademark owners had chosen the direct route. Within a given time limit, the designated Offices will notify their decisions (rejection or protection) to the International Bureau.
- The time limit for the designated Offices to examine the application and notify the results to the International Bureau is from 12 to 18 months (depending on Contracting Parties) or may be longer if the refusal is made. Each of designated Offices have the right to refuse protection, within the time limit specified in the Protocol. Unless such a refusal is notified to the International Bureau within the applicable time limit, the mark is deemed automatically protected in the designated Contracting Parties.

- If an designated Office refuses the protection, the applicant may contest the provisional refusal within the applicable means set out in the relevant national legislation – just as if the mark had been filed directly.

4.5.4. Application documents according to the Madrid System

Table 5: List of documents to be submitted under the Madrid System

No	Name of the document	Quantity	Note
1	Vietnamese declaration for international registration of goods/ services of Vietnamese origin Application form: Declaration 06-DKQT; Another application (designated later, extended): Declaration 08/SDTK	2 copies	Form No: 06-DKQT Appendix C of Circular No. 01/2007/TT-BKHCHN
2	Form MM2 (in English)	2 copies	https://www.wipo.int/madrid/en/forms/
3	Basic mark (basic registration or basic application in Vietnam)	1 copy	For basic registration: registration number, date of registration For basic application: application number, date of filing
4	Trademark representation	5 specimens	Trademark specimens must be identical with the application or registration license in Vietnam
5	Payment invoice for the fees for international registration at IPVN	1 copy	VND 2,000,000
6	Power of Attorney	1 copy	Applicable in case of filing through an IP Representative domiciled in Vietnam
7	Declaration of trademark use in the United States (Declaration MM18)	3 copies	Applicable in the case of filing and designating the United States

The classification of goods and services according to the latest International Classification of Goods and Services (NICE Classification - [Nice Classification](#)). For grouping, the Madrid Goods & Services Manager can be used ([Madrid Goods & Services Manager](#)).

Note: An applicant cannot add or expand a list of goods and services after an international application has been filed, or even expand a category that includes goods and services mentioned in the base trademark. Any request for expanding trademark portfolio after submitting the form MM2, the applicant needs to file a new international application.

4.5.5. Schedule of fees

- The fees for international trademark registration payable at the IPVN include:
 - New registration application (application for establishing rights): VND 2,000,000;
 - Other types of applications (such as extension of protection territory, renewal of registration, cancellation of registration...): VND 1,000,000;
- The fees for international application or registration (to be paid directly to the International Bureau - <https://madrid.wipo.int/feecalcalcapp/>). IPVN will notify the applicant about the amount of fees to be paid directly to the International Bureau via bank transfer.
- Schedule of fees prescribed by the Regulations under the Madrid Protocol includes basic fee, supplementary fee for each class of goods and services beyond three classes; individual fee for each designated Contracting Party in respect of which an individual fee is payable and complementary fee, and surcharge (if any).
- The applicant can calculate fees and charges by using the online tool provided by WIPO at <https://www.wipo.int/madrid/en/fees/calculator.jsp>.

4.5.6. Effects of an international registration

Trademark international registration is valid for 10 years and can be renewed for a successive 10 years. The applicant can directly request for a renewal at the end of the 10-year validity period and the validity extension is effect in all designated Contracting Party. A letter reminding the extension shall be sent by WIPO to the trademark owner and/or their legal representative within 6 months before the expiry of the trademark protection.

The Madrid e-Renewal Service allows trademark owners to submit a request to renew an international registration within 3 months before its validity expires until the end of the 6-month grace period after the expiry date of validity and pay fees via their account at WIPO or credit cards.

4.5.7. Considerations when registering trademarks under the Madrid System

- **Pre-filing searches:** This is a general rule when implementing trademark registration, even in Vietnam. The purpose of the search is to check in advance whether there is already a similar mark in the country of registration, so that the applicant can (1)

decide whether to file an application, or (2) minimize the possibility of rejection when filing an application, or (3) provide evidences to assess the possibility of protection.

- **Optimizing the benefits of the system:** Basic registration fees can be saved when the applicant designates more countries in single application.

Table 6: Costs comparison of trademark registration via the Madrid route and direct route in the EU, Japan, Korea, Australia, China and the US

	EU	Japan	ROK	Australia	China	US	Total (VND)
Direct Route	US\$ 2,800	US\$ 2,000	US\$ 1,200	US\$ 1,800	US\$ 600	US\$ 2,200	≈ 244,000,000
Madrid Route	≈ VND 120,000,000						≈ 120,000,000
	Difference						≈ 124,000,000

- **Date of international registration:** First-to-file is the most important rule in trademark registration. For an international application, the applicant has two (02) months to obtain the filing date in Vietnam.

*For example: The date of filing an international registration application at the IPVN is **January 1, 2022**, if the application meets all basic conditions (information in the application, full payment of fees), IPVN will certify and transfer the application to the IPVN. WIPO before **March 1, 2022**, the filing date is counted as **January 1, 2022**. If the application is flawed and the applicant is slow to supplement it, leading to the IPVN transferring the application to WIPO after March 1, 2022, WIPO will record the filing date **from the date of receipt of the application from the IPVN** (Example: March 2, 2022). During this process, if another application (similar mark) is filed on **February 1, 2022** and meets all basic conditions, is certified by the IPVN and forwards the application to WIPO, the original applicant **pre-application date will be forfeited**.*

- **Technical terms:** In the trademark description and product classification, the use of technical terms should be done or consulted by professionals to avoid errors and prolonging examination.

- **Application tracking and management:** It is advised to regularly check the status of the application on Madrid Monitor platform to promptly handle WIPO's notices or arising problems (<https://www.wipo.int/madrid/monitor/en/index.jsp>).
- **Dependency rule:** According to the "central attack" rule under the Madrid System, an international registration remains dependent on the basic mark for a period of five years from the date of the international registration. If the basic mark ceases to have effect for any reason, either partially or totally, for example, it is refused, withdrawn, cancelled or not renewed, within this five-year period, the international registration will be cancelled to the same extent. After the expiry of this five-year period, the international registration becomes independent of the basic mark.
- **Converting an international registration into a national application if the international registration is invalidated:** In order to minimize the negative impact of the "central attack" rule, the Madrid System allows the applicant to convert the cancelled international application into multiple national or regional applications (designated Contracting Parties to the international application) within 3 months from the date of WIPO's official notice of cancellation provided that additional conversion fees are charged according to the laws of each Party. National applications for such countrys or regions are still entitled to the filing date of the international registration or a later designated date (even a priority date).
- **Use of trademark:** The Madrid System deals with only a trademark registration, while other regulations for maintaining trademarks in a specific country and territory are different. In particular, the actual use of the trademark in some countries such as the United States and Singapore is a mandatory condition to maintain the validity of the trademark.
- **Transfer of trademark:** the owner of the mark under international registration is only allowed to transfer the mark to an individual or legal person having the nationality of Contracing Parties to Madrid. This means that it is not possible to transfer part or all of the international registration to another whose nationality is not a member of the Madrid System.

Box 2: Some notes when proceeding the application under the Madrid System

- The more countries the applicant designates in the international application, the more they can save the base registration fees;
- Name and addresses of the applicant are made in bilingual;
- It takes two months to get the filing date in Vietnam;
- Dependency period under the “central attack” rule is 5 years;
- The transfer of trademark to entities outside the parties of the Madrid System is not allowed;
- Terminology related to the goods and services shall follow the WIPO rules.
- It should pay attention to the use of the trademark during the examination period;
- Regular check the status of trademark application at the WIPO digital platforms to promptly and timely handle possible and potential problems;
- In the case of collective mark or certification mark, it is necessary to contact the designated countries to submit relevant documents required;
- Check in advance whether there are similar or identical trademarks in the country to be designated;
- If the documents are in other languages than English, clear translation is needed.

4.5.8. Advantages of the Madrid System

The overall advantage of the Madrid System is that it simplifies the administrative aspect of seeking protection of a trademark in multiple territories. With just one application through the Madrid System, trademark owners/holders can simultaneously file applications in countries of interest among 128 members party to the Madrid System instead of filing multiple national or regional applications with different IP Offices

Once the trademark is registered through the Madrid System, the trademark owner/holder can add further territories to their existing international registration by way of subsequent designation. This gives the trademark owner/holder the flexibility to expand the scope of protection in line with their evolving business strategy and financial situation.

Despite the number of countries or territories designated in the international registration, under the Madrid System, there is only one expiration date. The trademark then can be renewed with one simple procedure.

Table 7: Overview of the Madrid international trademark registration system

Advantages	Disadvantages
• Application is filed at a country or a territory, the trademark can be protected in many countries and territories • One registration form is done for application to many countries at the same time. • Only one application in one language (English, French, or Spanish) and paying one set of fees in one currency (Swiss francs) • Applications and protection titles are managed on one platform, with real-time status updates. • Save time and costs significantly; • Registration management (modification, transfer, cancellation...) is easily proceeded. • Application processing time is well-defined (12 to 18 months) in accordance with each country's commitment to WIPO.	• International registration must be based on an national application or an national registration. • All forms and information are not available in Vietnamese; and all exchanges must not be made in Vietnamese. • It is necessary to hire an IP representative in the country of interest to ensure the smooth application process and avoid potential refusal.

PART 5.

**LESSONS LEARNT
FROM SOME CASES
OF TRADEMARK
PROTECTION
AND TRADEMARK
DISPUTES ABROAD**

Upon joining the international market of acute competition, many Vietnam businesses have faced legal issues concerning trademark protection. Cases of trademark disputes of ST25 rice, Trung Nguyen coffee, Ben Tre coconut candy, and Vinamit, etc. have provided valuable lessons for Vietnamese businesses in the context of increasing regional and global integration.

5.1. Trademark disputes in China: Ben Tre coconut candy and Vinamit

a) Case of Ben Tre coconut candy

This is the first case that a Vietnamese company succeeded in claiming their trademark ownership right in the international market.



Dong A General Manufacturing and Trading Limited Company produces Ben Tre coconut candy since 1978 and has a good reputation in both domestic and foreign markets.

In 1998, when sales in the Chinese market were very high, the company's sales were falling sharply. Through many information channels, Ms. Nguyen Thi To (Auntie Hai To), owner of the Ben Tre coconut candy brand, recognized counterfeiting coconut candies in the Chinese market. The Coconut Forest Company in China bought coconut candy from individual makers and traders in Vietnam and then labelled the mark of Ben Tre coconut candy for selling in the Chinese market.

In August 1998, Ms. Hai To discovered that the Coconut Forest Company had applied for a trademark registration of "Ben Tre coconut candy" in China for 8 months and would be granted an exclusive trademark license in the next 3 months.

Ms. Hai To reported the infringement at the National Trademark Administration Department of the People's Republic of China, stating the economic and legal damages caused by counterfeits in China and Vietnam. After nearly 2 years of big efforts, with the support of Ben Tre province, by the end of 1999, Ms. Hai To was successful in proving that the products of Coconut Forest Company were fake and China's trademark authority made a legal decision to force the Coconut Forest Company to destroy all counterfeit goods.

See the list of marks of Dong A Ltd. Co. registered in Vietnam in the Appendix 3.

b) Case of Vinamit

“Duc Thanh” is a trademark of Vinamit Vietnam Joint Stock Company (Vinamit JSC.) since its establishment (1991) and is also a popular trademark of Vinamit in the Chinese market. Since 1997, Vinamit JSC. started to bring dried jackfruit products labelled with “Duc Thanh” trademark to China.



Vinamit had “Duc Thanh” trademark registration in China, but their protected trademark was only in Vietnamese, not in Chinese. A distributor of Vinamit had registered exclusively “Duc Thanh” trademark in Chinese market, and then dominated the local market (Chinese) and quickly produced similar products.

In 2007, only when an exclusive license of Duc Thanh trademark was granted to an Chinese trader, did Vinamit discover their weakness. The key point was that under the Chinese law, the full trademark protection is endorsed for trademark presented in both original language and the language of the target country. As consequent, from the position of a trademark owner, Vinamit became a counterfeiter. All goods bearing the Vinamit trademark were rejected by the Chinese supermarkets and the company was vulnerable to be knocked out of the Chinese market. Even, the managers of Vinamit faced legal risks as Chinese law stipulated that trademark counterfeiting subject to a 5-year prison sentence.

In 2010, Vinamit discovered the owner of the business producing counterfeit products was Mr. Xie Hong Yi, a Chinese trader cum a business partner of Vinamit.

From 2010 to 2012, Vinamit pursued a lawsuit against Mr. Xie Hong Yi to reclaim its Duc Thanh trademark. Despite the National Office of Intellectual Property of China made a ruling decision that “Duc Thanh” trademark belonged to Vinamit and Mr. Xie Hong Yi were ordered to return “Duc Thanh” trademark to Vinamit. However, Mr. Xie Hong Yi didn’t execute the decision of the National Office of IP of China, but sued a legal protest against Vinamit at the Beijing Commercial Court.

By the end of 2012, the Beijing Commercial Court declared Vinamit JSC. as winner of the trademark dispute with Mr. Xie Hong Yi.

c) Some lessons learnt

Products of reputation and high quality are vulnerable to counterfeiting and appropriation of trademark. The ones who appropriate the trademark may be a business partner or a distributor in the international market.

First, trading partners can apply for trademark registration. Therefore, when signing commercial contracts for goods, producers or manufacturers pay attention to the provisions of IP rights. Central considerations refer to the uses the product name/brand, packaging, labelling, disputes handling, the partner's obligations to IP rights, etc. The trademark registered in Vietnam serves as the basic for negotiating these clauses.

Second, the trademark in dispute has not been officially recognized for registration in the host country, so businesses can pursue lawsuits and complaints. At the time of the discovery of the infringement, the trademark "Ben Tre coconut candy" was under examination and had not been yet granted an exclusive protection title in China. Therefore, the complaint process of Dong A Co., Ltd took not too long (2 years) and achieved the desired results. If the above trademark had been granted a protection title, the case would be more complicated. For example, (i) it would took a longer processing time due to a more complicated procedure for the established IP rights; (ii) the appropriating party would have the right to request the state management agency to supervise and sanction the violation of IP rights; (iii) trademarks protected locally (China) would be more likely to be prioritized.

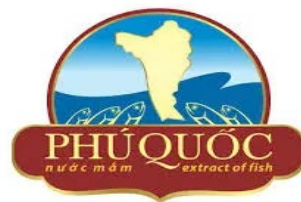
Third, the word part of the mark intended for protection should be transcribed or translated into the language of the target country (importing country).

Fourth, the product's packaging should be protected under industrial design to have a comprehensive protection.

5.2. Infringement of Vietnamese GI abroad: case of Phu Quoc extract of fish

a) General information

The GI of Phu Quoc extract of fish was the first trademark recognized for national protection in 2001. At that time when there was no concept of GI in the provisions of IP rights protection in Vietnam, the Phu Quoc fish sauce



trademark was recognized as designation of origin under the Civil Law and Decree 63/1996.

After 4 years, in 2005, the Ministry of Fisheries issued a temporary regulation on control and certification of fish sauce bearing the name of origin of Phu Quoc. Phu Quoc Fish Sauce Association is authorized to exploit the GI of Phu Quoc fish sauce, and grants the right for qualified manufacturers to use Phu Quoc GI on their products.

In 2010, with the support of French experts, Phu Quoc Fish Sauce Association and authorities of Kien Giang province promoted the registration of this collective mark to foreign countries. The GI of Phu Quoc extract of fish has been officially protected in the EU since 2012.

In fact, the name of Phu Quoc extract of fish had been used as a trademark by a company domiciled in the US since 1982. Viet Huong Fishsauce Company (in the USA) was granted the Phu Quoc fishsauce trademark by USPTO in 1982. On the fish sauce products of this company, the trademark “Phu Quoc fish sauce” had been used with the map of Vietnam and Phu Quoc island. The company then registered the trademark “Phu Quoc fish sauce” in the EU and Australia. In 2006, this company successfully registered the Phu Quoc trademark in China with the same logo and mark representation.

On May 11, 2011, Viet Huong Trading Co., Ltd (VIET HUONG TRADING COMPANY LIMITED), a legal entity in Hong Kong, officially filed application number 9448516 to the competent authority to register for exclusive protection of the trademark “Phu Quoc” under the group of 30 (including fish sauce) in the territory of China.

b) Lessons learnt

Firstly, a foreign entity owning a Vietnamese GI means that Vietnam's IP is appropriated. Businesses operating in the related field can be sued when exporting goods to foreign countries where the trademarks are exclusively protected. Enterprises may also be prevented from exporting at the border gates as trademark infringements are claimed.

Secondly, the recognition of GIs in a country is only a very first step as of the overall process to have the GI fully recognized and absolutely protected. A number of actions to be done in favor of GI protection such as: establishing management body, fundraising, financial management, etc. In order to protect GIs in a synchronous and comprehensive manner, especially in foreign countries, after being recognized and granted a protection title at home, GIs owners (for example, Phu Quoc Fish Sauce Association) can proceed

international registration for GIs as collective mark under the Madrid System, in view of enjoying protection in the countries of this system.

5.3. Dispute over the ST25 Rice trademarked in the United States

a) General information

The ST25 rice variety has been granted a protection certificate No. 21.VN.2020 according to Decision 45/QĐ-TT-VPBH dated March 6, 2020 of the Director of the Department of Crop Production, Ministry of Agriculture and Rural Development. The patent holder is Ho Quang Tri Private Enterprise and the rice breeders are Mr/Ms. Ho Quang Cua, Tran Tan Phuong, Nguyen Thi Thu Huong.

As of April 2021, 4 enterprises in the USA submitted 5 applications for registration of the use of trademarks containing the phrase “ST25” for rice products in the US market, of which: 03 trademarks using “ST25” together with geographical indication signs (VIETNAM, SOCTRANG), 02 trademarks using only “ST25” (group of rice and rice products). For the trademark “ST25” of I&T Enterprise Inc (the only one of the 4 US enterprises verified to meet the basic requirements of USPTO), after 30 days from the date of publication (May 4, 2021) if there are no objections or complaints, would be approved for registration and exclusive protection for rice products in the US.

b) Lessons learnt

Firstly, it is necessary to pay attention to the principle of territorial rights regarding protection of IP. The ST25 rice variety that has been protected as a plant variety in Vietnam does not mean that the ST25 variety is protected in the US. Similar to Vietnam’s regulations on plant variety protection, in order to be protected in the USA, seed owners must also apply for protection at the Plant Variety Protection Office (PVPO) under USDA. The variety claimed for protection must be recognized and tested. With the examination results of the USPTO on “ST25” trademark application, it can be seen that the ST25 rice variety protection application had not

Principles of IP protection:

The principle of territorial rights:
Trademark is protected in places where the registration is made.
The ST25 variety protected in Vietnam doesn’t mean that it is protected in the USA.

Plant variety protection: In the US, plant varieties can be protected, but they must be recognized by the US authority and must also go through the testing and trial production process.

been filed with the PVPO, therefore, USPTO examiners determined the “ST25” trademark of I&T Enterprise Inc meets the protection criteria under US law.

Second, the relationship between the cultivar name and the product description signs should be clarified. There are differences between the provisions of the US trademark law and the viewpoints of “variety name”, “product description sign” with respect to the signs “gạo ST25/ST25 rice”, “gạo thơm ST25/ST25 fragrance rice” and “ST25”. The USPTO examiners may consider that, in the United States, the “ST25” sign standing alone doesn’t automatically refer to the name of a particular plant or rice variety. Objectively, if we are consumers in the US, and I&T Enterprise Inc sells rice using the sign “ST25” on their packaging, it is difficult for US consumers to have associations to link to the ST25 rice variety, ST25 rice, or ST25 fragrance rice of Vietnam

Third, it is advised to brook an opposition against an application as soon as there are infringement signs. In order to ensure the reputation of the world’s best rice, protection of the Vietnam’s unique rice variety, and the reputation of Vietnam’s rice on the world market, it is necessary to conduct an opposition to the application (in case the opposition document is not fully built, it can be made an objection to request additional timing for opposition). According to the provisions of US law, the principle of “first-to-come”, “first-to-use” are applied. Thus, to oppose to the application of US applicants, Mr. Ho Quang Cua can show proofs that the invention and commercial use of ST25 rice had existed before the filing date of I&T Enterprise Inc in the US (before January 2020). For example, all evidences to show the ST25 variety was invented and made by Mr. Cua, to show that he is the owner of the rice taking part to the Contest (contest regulations, contest’s criteria to rank rice, etc.)

Fourth, what is the option to ensure the export of ST rice to the US market without violating IP protection in the US? In case ST25 rice of I&T Enterprise Inc is protected in the US, Vietnamese enterprises cannot use the sign “ST25 rice” or “ST25 fragrant rice” or even “product harvested from ST25 rice variety” as commercial indications on the packaging of products exported to the US. Two possible solutions to this matter are: (1) Vietnamese enterprises do not use the signs of “ST25 rice”, “ST25 fragrant rice” on packages of exported rice, but can use their own trademarks and brands for the US market (for example, “LocTroï”, “Bao Minh”, or “Vinafood”, ...) without regard to the existence of the “ST25” trademark owned by I&T Enterprise Inc in the US. ; (2) The Vietnamese side negotiates to buy back the registered trademark of I&T Enterprise Inc to ensure its smooth and stable trading of rice in the US market.

With the technical support of TDL international law firm, in parallel with filing the opposition to the US company's application, enterprise Ho Quang Tri submitted a new trademark application in the US market with the trademark of “Gạo Ông Cua”. On the USTPO website, there are no descriptions or phrases related to the signs of “ST25”, “World’s Best Rice” for this trademark application.



Fifth, it is necessary to pay attention to the issue of trademark protection in the domestic market to prevent counterfeiting and imitation of famous brands. As of December 2021, Ho Quang Tri Enterprise only has a license of registration of “SR SOC RICE” trademark. Two other trademarks (“Rice Ong Cua” and “Rice ST”) have been filed for registration at the IPVN and are under the registration process. However, for ST rices, the enterprise haven’t published yet the self-declare product quality according to regulations. The production and trading of rice bearing the trademarks of “Rice Ong Cua”, “Rice ST” which are not granted the trademark license and entitled self-published quality criteria leading to insufficient grounds for market management force to handle infringements of these trademarks. Therefore, businesses need to pay attention to the product quality management in parallel with the trademark registration process.

5.4. Experiences in managing and maintaining effects of international trademark registration

- Each country has its own rules and regulations on maintaining the validity of a trademark registration.
- The most common method of maintaining the validity is to proceed the renewal of protection titles (for every 10 years). This procedure needs to be done within 6 months or 1 year prior to expiry date of trademark protection (depending on national regulations). If the trademark owner/holder does not initiate the renewal process as required time limit, the protection title will automatically expire and there is no way to resolve.
- In some countries, providing evidences to prove that the mark is actually used is required to maintain the validity of the protection title. This procedure is not mandatory in other countries, however, third parties have the right to request the state management agency to cancel the validity of the protection title if they can

prove that the trademark owner/holder don't use that mark for 3 or 5 consecutive years.

- The management of trademark registration and effectiveness as well as renewal process to maintain the validity of protection titles should be entrusted to an IP professional agency to ensure the compliance with the time limit and regulations of each country. The timing of the necessary procedure usually arises between 5 and 9 years after the approval of registration, so trademark owner/holder finds hard to monitor, manage and control. In addition, during the protection cycle, if any problems arise (for instant, objections, opposition, complaints, etc.), the trademark owner/holder will be notified and warned and advised by its IP consultant.

What to do when the trademark is registered by someone in a foreign country?

Branding requires a lot of investment and different types of resources. Building reputation in the domestic market is a solid basis for businesses to approach international markets. However, the greater the reputation is, the higher the risk of trademark violation, appropriation or unfair competition is. The act of trademark appropriation means that the trademark of a Vietnamese enterprise is registered for exclusive protection in another country or territory by other organizations or individual. When any infringement is discovered, Vietnamese businesses have two options:

- *Dispute handling:* Pursuing a trademark dispute in a foreign country requires a lot of effort and is costly. Barriers of geographical distance, language and knowledge of local laws are inevitable difficulties. This strategy is suitable for big enterprises with sufficient financial resources and reputation, and a powerful IP portfolio (effective trademarks, commercial potential, etc.) to maintain and develop the market.
- *Building new trademarks:* As mentioned above, a trademark is an important component of the branding process,

What to do when the trademark is registered abroad by others?

Negotiation;

Objection to application/ registration;

File a case in court;

Switch to using another trademark;

Within a specified time limit, if the trademark owner does not use the mark in their operations, it is advised to file a request to the local IP Office to cancel or invalidate the registration.

ensuring consumers' recognition of goods or services produced by a manufacturer/maker to the goods or services produced/supplied by the others. The cost of designing and developing a new trademark may be less expensive than pursuing a lawsuit, but the market's remembrance of the product and trade name shall be at the starting point. The decrease in business results is unavoidable but just represents a small part of other intangible losses and damages such as effort and intelligence that business owners invest in their products.

REFERENCES

- Barjolle D., Silvander B., (2003), *Facteurs des succès des produits d'origine certifiée dans les filières agro-alimentaires en Europe : marché, ressources et institutions*.
- Bộ Công Thương. 2022. *Báo Cáo Xuất Nhập Khẩu Việt Nam 2021*. Nhà xuất bản Công Thương (Industry and Trade Publishing House).
- Keller, Kevin Lane. 2003. "Understanding Brands, Branding and Brand Equity." *Interactive Marketing* 5 (1): 7–20. <https://doi.org/10.1057/palgrave.im.4340213>.
- Kotler, Philippe T., and Gary Armstrong. 2017. *Principles of Marketing*. 17th Edition. Global Edition. Pearson. <https://www.pearson.com/se/Nordics-Higher-Education/subject-catalogue/marketing/Principles-of-Marketing-Kotler-Armstrong.html>.
- Lưu Đức Thanh, 2019. Xây dựng, quản lý và phát triển thương hiệu cộng đồng. Tạp chí Khoa học và Công nghệ Việt Nam. Số 9/2020. Tr 4-8.
- Mai Asia Limited, 2009. *Branding Asia for the Future: Collection of cases in brand development from South East Asia*. Ho Chi Minh City General Publishing House. 48 trang.
- Petra van de Kop, Denis Sautier, Astrid Gerz (Eds.). 2006. *Origin-based Products: Lessons for pro-poor market development*. ISBN: 9068321668
- Vũ Trọng Bình, Đào Đức Huấn., (2007). *Geographical indication and appellation of origine in Vietnam: reality, policy, and perspective*, Hanoi, Agricultural Publishing House, 228 p.
- Vũ Trọng Bình, Đào Đức Huấn, Paule Moutier, Bùi Thị Thái, Hoàng Vũ Quang., (2008). *Mô hình bảo hộ chỉ dẫn địa lí ở Việt nam, hiện trạng, khó khăn và triển vọng*
- WIPO, 2022. Guide to the International Registration of Marks under the Madrid Protocol (bản cập nhật 2022). Ấn phẩm số 455E/22. 260 trang. <https://www.wipo.int/publications/en/details.jsp?id=4600&plang=EN>
- WTR, 2021. World Trademark Review Yearbook: A global guide for practitioners 2021/2022. <https://www.worldtrademarkreview.com/global-guide/the-wtr-yearbook/2021>
- Legal documents and papers on IP of Vietnam and IP regulations in some countries (EU, America, Japan, South Korea, China)

APPENDIX

Appendix 1: List of websites and portais to manage trademark registration

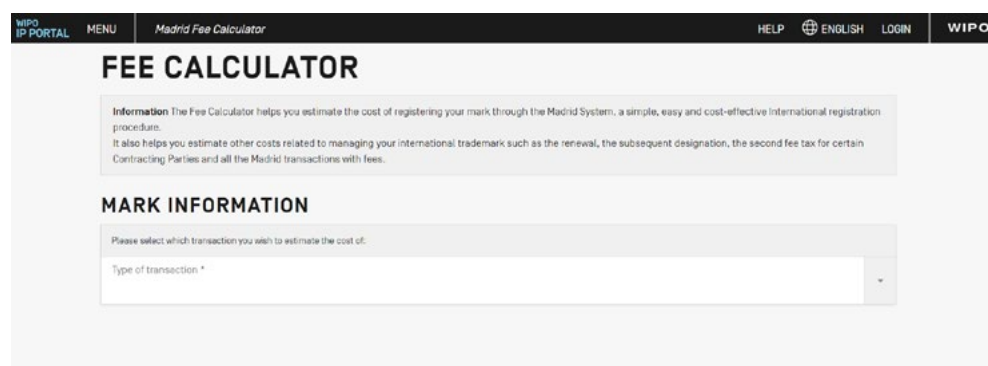
National Office of Intellectual Property of Vietnam	https://www.ipvietnam.gov.vn/
WIPO Global Brand Database	https://branddb.wipo.int/branddb/en/
International Classification of Goods and Services (NLC)	Nice Classification (wipo.int)
List of States party to the Madrid System	https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf
Madrid System forms (downloadable)	http://www.wipo.int/madrid/en/forms/
Madrid Goods and Services Manager	http://www.wipo.int/mgs/
Schedule of Fees (Madrid system)	https://www.wipo.int/madrid/en/fees/sched.html
Fee calculator (Mardid system)	http://www.wipo.int/madrid/en/fees/calculator.jsp?
Monitoring the registration (Madrid System)	https://www.wipo.int/madrid/monitor/en/index.jsp
European Trademark Search engine (TMView)	https://www.tmdn.org/tmview/#/tmview
European Intelltectual Property Office	https://euipo.europa.eu/ohimportal/en/home
US Patent and Trademak Office	https://www.uspto.gov/
Intellectual Property Office of Australia	https://www.ipaustralia.gov.au/
Cơ quan đăng ký sáng chế Nhật Bản	https://www.jpo.go.jp/e/index.html
GI Registration in Japan (Minsitry of Agriculture, Forestry and Fisheries)	https://www.maff.go.jp/e/policies/intel/gi_act/index.html
Korean Intellectual Property Office	https://www.kipo.go.kr/en/MainApp?c=1000
China National Intellectual Property Administration	https://english.cnipa.gov.cn/
China Trademark Office	https://www.chinatradeoffice.com/

Appendix 2: Guide to calculate fees under the Madrid System

Step 1: Navigate <https://madrid.wipo.int/feecalapp/>

Step 2: Select Type of transaction – 4 options, including:

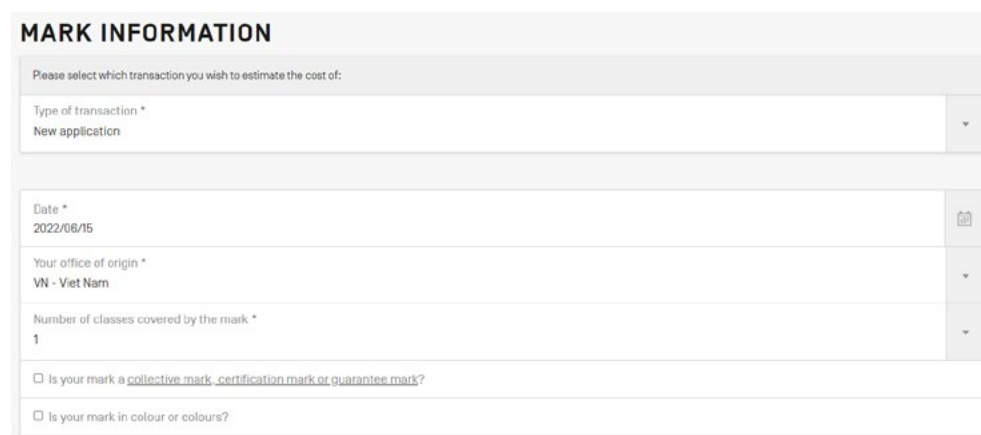
- New application
- Subsequent designation
- Second Part fee
- Renewal



The screenshot shows the 'FEE CALCULATOR' page on the WIPO IP Portal. The page has a dark header with 'WIPO IP PORTAL', 'MENU', 'Madrid Fee Calculator', 'HELP', 'ENGLISH', 'LOGIN', and 'WIPO'. Below the header, the title 'FEE CALCULATOR' is prominently displayed. An information box explains that the calculator helps estimate the cost of registering a mark through the Madrid System. Below this, the 'MARK INFORMATION' section contains a prompt: 'Please select which transaction you wish to estimate the cost of:'. A dropdown menu is shown with 'Type of transaction *' and a downward arrow.

Step 3: Select option “Submit a new application”, then choose in order

- Select “Office of origin” (as Vietnam);
- Choose “number of classes cover by the mark”
- Choose the type of trademark (collective mark, certification mark), if it doesn’t relate to common trademark
- Choose trademark with colors or trademark in black and white



The screenshot shows the 'MARK INFORMATION' form with the following fields filled out: 'Type of transaction *' is set to 'New application'; 'Date *' is '2022/06/15'; 'Your office of origin *' is 'VN - Viet Nam'; 'Number of classes covered by the mark *' is '1'. There are two unchecked checkboxes at the bottom: 'Is your mark a collective mark, certification mark or guarantee mark?' and 'Is your mark in colour or colours?'. The form has a light gray background and a white border.

Step 4: Select the countries where you intend to register, then Click “Calculate”

- There are a total of 111 countries/regions
- In this example, 6/111 countries/regions are elected including: European Union, China, Korea, Japan, Australia, United States.

Please select the contracting parties
Hide

Search contracting party

☐ AE - United Arab Emirates	☐ GG - Guernsey	☐ MZ - Mozambique
☐ AF - Afghanistan	☐ GH - Ghana	☐ NA - Namibia
☐ AG - Antigua and Barbuda	☐ GM - Gambia	☐ NO - Norway
☐ AL - Albania	☐ GR - Greece	☐ NZ - New Zealand
☐ AM - Armenia	☐ HR - Croatia	☐ OA - African Intellectual Property Organization (OAPI)
☐ AT - Austria	☐ HU - Hungary	☐ OM - Oman
☐ AU - Australia	☐ ID - Indonesia	☐ PH - Philippines
☐ AZ - Azerbaijan	☐ IE - Ireland	☐ PK - Pakistan
☐ BA - Bosnia and Herzegovina	☐ IL - Israel	☐ PL - Poland
☐ BG - Bulgaria	☐ IN - India	☐ PT - Portugal
☐ BH - Bahrain	☐ IR - Islamic Republic of Iran	☐ RO - Romania
☐ BN - Brunei Darussalam	☐ IS - Iceland	☐ RS - Serbia
☐ BQ - Bonaire, Sint Eustatius and Saba	☐ IT - Italy	☐ RU - Russian Federation
☐ BR - Brazil	☐ JM - Jamaica	☐ RW - Rwanda
☐ BT - Bhutan	☐ JP - Japan	☐ SD - Sudan
☐ BW - Botswana	☐ KE - Kenya	☐ SE - Sweden
☐ BX - Benelux	☐ KG - Kyrgyzstan	☐ SG - Singapore
☐ BY - Belarus	☐ KH - Cambodia	☐ SI - Slovenia
☐ CA - Canada	☐ KP - Democratic People's Republic of Korea	☐ SK - Slovakia
☐ CH - Switzerland	☐ KR - Republic of Korea	☐ SL - Sierra Leone
☐ CN - China	☐ KZ - Kazakhstan	☐ SM - San Marino
☒ CN - China	☐ KZ - Kazakhstan	☐ SM - San Marino
☐ CO - Colombia	☐ LA - Lao People's Democratic Republic	☐ ST - Sao Tome and Principe
☐ CU - Cuba	☐ LI - Liechtenstein	☐ SX - Sint Maarten (Dutch part)
☐ CW - Curaçao	☐ LR - Liberia	☐ SY - Syrian Arab Republic
☐ CY - Cyprus	☐ LS - Lesotho	☐ SZ - Eswatini
☐ CZ - Czech Republic	☐ LT - Lithuania	☐ TH - Thailand
☐ DE - Germany	☐ LV - Latvia	☐ TJ - Tajikistan
☐ DK - Denmark	☐ MA - Morocco	☐ TM - Turkmenistan
☐ DZ - Algeria	☐ MC - Monaco	☐ TN - Tunisia
☐ EE - Estonia	☐ MD - Republic of Moldova	☐ TR - Türkiye
☐ EG - Egypt	☐ ME - Montenegro	☐ TT - Trinidad and Tobago
☒ EM - European Union	☐ MG - Madagascar	☐ UA - Ukraine
☐ ES - Spain	☐ MK - The Republic of North Macedonia	☒ US - United States of America
☐ FI - Finland	☐ MN - Mongolia	☐ UZ - Uzbekistan
☐ FR - France	☐ MW - Malawi	☐ WS - Samoa
☐ GB - United Kingdom	☐ MX - Mexico	☐ ZM - Zambia
☐ GE - Georgia	☐ MY - Malaysia	☐ ZW - Zimbabwe

Selected Contracting Parties 6 / 111
Select All
Unselect All

Reset
Calculate

Step 5: Select “Calculate”

- The displayed results include 3 types of fee: Basic fee; fees of contracting parties; complementary fees”.
- Grand Total are in Swiss Francs (CHF)
- When selecting “Details”, the specific fee of each country will be displayed

Basic fee	653.00	Details
Fees of contracting parties	1,936.00	Details
Complementary fee	100.00	Details
Grand Total (CHF)	2,689.00	

Contracting Party	Calculation	Classes	Amount
AU - Australia	[Individual fee (international application): 263.00]	1 ▾	263.00
EM - European Union	[Individual fee (international application): 897]	1 ▾	897.00
JP - Japan	[Individual fee (first part): 92.00] This may be subject of the payment of a second part of the individual fee which can be estimated separately by clicking here	1 ▾	92.00
KR - Republic of Korea	[Individual fee (international application): 224.00]	1 ▾	224.00
US - United States of America	[Individual fee (international application): 460.00]	1 ▾	460.00
Total (CHF)			1,936.00

Appendix 3: List of marks registered in Vietnam of Dong A Limited Company

Source: <https://ipplatform.gov.vn/database/nhan-hieu>

1	4-1990-02655	4-0002501-000	Ben Tre	30	27.05.03	
2	4-2000-48662	4-0040295-000	HỒNG PHƯỚC	30		
3	4-2002-02074	4-0047350-000	YẾN LAN	30		
4	4-2010-26866	4-0189055-000	BENTRE Thơm Ngon, Tinh Khiết Từ Dừa, hình	30	05.01.07, 05.01.12	
5	4-2011-26413	4-0225041-000	BENTRE, hình	35	05.01.07, 05.01.12, 26.01.02, 26.07.05	
6	4-2011-26414	4-0225042-000	BENTRE	35		
7	4-2012-00305	4-0215411-000	BENTRE	30		
8	4-2013-07787	4-0240336-000	DongA, hình	30	05.03.09, 05.03.11, 05.03.13, 26.04.02	
9	4-2013-07788	4-0240337-000	Award winning brand from Auntie Hai To, hình	30	02.03.01, 25.07.20, 26.01.01, 26.11.12	
10	4-2013-07789	4-0240338-000	Hình	30	05.01.12, 05.01.16, 05.07.09, 05.07.21, 26.04.02, 26.04.04, 26.13.25	
11	4-2013-08496	4-0237269-000	Auntie Hai To Award winning brand from [Bín zhi: Bón Tre], hình	30	02.03.01, 25.07.20, 26.04.02, 26.11.12	
12	4-2013-08497	4-0231778-000	Award winning brand from Auntie Hai To coconut candy [Bín zhi yézi tang: kẹo dừa bón tre], hình	30	02.03.01, 25.07.20, 26.04.02, 26.11.12	
13	4-2019-31434	4-0397129-000	Bón Tre 1997 YEAR COCOA COCONUT CANDY [Bín zhi: Bón Tre Yuan Chan Guo Chao Nan: Sản xuất tại Việt Nam Jing hanliang: 400 Ke Trọng lượng tịnh 400 gram Keke yezi tang: kẹo dừa cacao], hình	30	02.03.01, 05.01.07, 05.01.12, 05.07.21, 08.01.23, 24.05.01, 26.01.01	
14	4-2019-31435	4-0397153-000	Bón Tre Kẹo Dừa Bón Tre PANDAN COCONUT CANDY 1997 YEAR [Bín zhi yézi tang: Kẹo dừa là dừa Jing hanliang: Trọng lượng tịnh: 400 gr], hình	30	02.03.01, 05.01.07, 05.01.12, 05.07.21, 08.01.23, 11.03.01, 24.05.01, 25.05.25, 26.01.02	

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