The information provided in this guideline has been researched with the utmost diligence, however laws and regulations are subject to change and we shall not be held liable for any information provided. It is suggested to seek updated detailed legal advice prior to embarking on any filing decision or action.
**GLOSSARY TERMS**

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<th>Description</th>
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<td>ASEAN</td>
<td>The Association of Southeast Asian Nations</td>
<td>MOST</td>
<td>Ministry of Science and Technology</td>
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<td>IPC</td>
<td>International Patent Classification</td>
<td>PCT</td>
<td>Patent Cooperation Treaty</td>
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<td>IP Gaz</td>
<td>Official Industrial Property Gazette</td>
<td>TRIPS</td>
<td>Agreement on Trade-Related Aspects of Intellectual Property Rights</td>
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<td>IPR</td>
<td>Intellectual Property Right</td>
<td>VCO</td>
<td>Vietnam Copyright Office</td>
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<td>MCST</td>
<td>Ministry of Culture, Sports and Tourism</td>
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IP PROTECTION IN VIETNAM

OVERVIEW

IP HISTORY

Vietnam has made a considerable progress in establishing a legal framework for the protection of intellectual property (“IP”) rights.

The industrial property protection started in a primary manner in 1981 when Decree 31-CP was issued on 23 January 1981 promulgating the Regulations on Technical Innovation, Rationalization in Production, and on Inventions. Subsequently, the Government issued a number of regulations on trademarks (1982), utility solutions (1988), industrial designs (1988), licensing (1988), and copyrights (1986). However, during this period, the protection was of administrative nature only.

The promulgation of the Ordinance on Protection of Industrial Property Rights on 28 January 1989 is a milestone of industrial property laws in the country. The Ordinance 1989 laid down the foundation for protection of inventions, utility solutions, designs and trademarks, with extensive changes, especially the recognition of exclusive patent rights. This reflected the impacts of the country’s transition from a demanded economy to a market economy under the Doi Moi policy. In 1994, copyright protection was recognized under the Ordinance on Copyrights, which provided a higher level of protection rather than the mere entitlement to remuneration of authors under the earlier regulations.

Early 1995, by filing an application for the membership of World Trade Organization (“WTO”), Vietnam developed an IPRs Action Plan whose overall objective was to make the Vietnamese IP system fully comply with the TRIPs. Accordingly, the most notable development of the IP regime this time is the enactment of the Civil Code 1995, which regulates, among various other civil and ownership matters, industrial property rights (covering inventions, utility solutions, industrial designs, trademarks and appellations of origin of and others specified by laws) and copyrights. It replaced the Ordinance on IP Protection (1989) and the Ordinance on Copyrights (1994). The Government then issued a series of guiding regulations for implementation of IP matters as stipulated under the Civil Code 1995.

However, the IP system is still not fully comply with the requirements of TRIPs-WTO Agreement. In 2005, the National Assembly approved the new Civil Code whose part VI provide for the most basis civil aspects of the IPRs (owners, subject matters, contents, ground for establishing and existing IPRs, licensing and assignment of IPRs). Thus, in comparison with the Civil Code 1995, IP provisions of the Civil Code 2005 have been trimmed and consist of the “core” provisions to regulate the civil relations concerning the IP assets.

On 29 November 2005, the National Assembly enacted the IP Law composed of 6 parts, 18 chapters and 222 Articles. Provisions of the IP Law 2005 fully comply with the TRIPs-WTO Agreement. The enactment of the IP Law in 2005 can be considered as a milestone marking Vietnam’s efforts during 10 years preparing for the country’s accession to the WTO.

CURRENT IP LEGISLATION

Constitution / Basic Law
Other, Constitution, as amended 2001

Main IP Laws (enacted by the Legislature)
Industrial Property & Copyright, Law No. 50/2005/QH11(promulgated by Order 28/2005/L-CTN), 2005
Industrial Property & Copyright (Civil Code), Law, 2005
Competition (Anti-trust), Law No. 27/2004/QH11, 2004
Plant Varieties (Seeds), Ordinance No 15/2004/PL-UBTVQH11, 2004

IP-related Laws (enacted by the Legislature)
Enforcement (Criminal Code), Law No. 37/2009/QH12 (Amendments), 2009
Enforcement (Administrative Violations), Ordinance No. 04/2008/PL-UBTVQH12 (Amendment, promulgated by the Order No. 03/2008L-CTN), 2008
Technology Transfer, Law No. 80/2006/QH11, 2006
Enforcement (Procedures & Settlement of Administrative Cases), Ordinance, 2006
Enforcement (Customs Control Procedures), Law (Amendment), 2005
Enforcement (Civil Procedures), Law No. 24/2004/QH11, 2004
Enforcement (Criminal Procedures), Law No. 19/2003/QH10, 2003
Enforcement (Administrative Violations), Ordinance No. 44/2002/PL-UBTVQH10, 2002
Enforcement (Customs Control Procedures), Law, 2001
Industrial Property (Science & Technology), Law No. 21/2000/QH10, 2000
Enforcement (Criminal Code), Law, 1999
Enforcement (Procedures & Settlement of Administrative Cases), Ordinance, 1996

**IP Laws (issued by the Executive)**
Enforcement (Administrative Violations in Copyright), Decree No. 47/2009/ND-CP, 2009
IP Regulatory Body (Ministry of Science & Technology Organisation), Decree No. 28/2008/ND-CP, 2008
Other (Scientific & Technological Resources), Decree No 169/2007/ND-CP, 2007
Enforcement (Administrative Violations), Decree No. 106/2006/ND-CP, 2006
Enforcement (Administrative Violations in Copyright), Decree No. 56/2006/ND-CP, 2006

**Implementing IP Regulation**
Enforcement (Administrative Violations), Order No. 03/2008/L-CTN, 2008
Enforcement (Criminal Procedures on Infringement of Intellectual Property Rights), Circular No. 01/2008/TTTL_TANDTC_VKSNDTCT_BCA_BTP, 2008
Copyright (Computer Program Protection), Directive No. 04/2007/CT-TTg, 2007
Industrial Property, Circular No. 01/2007/TT-BKHCN, 2007
Undisclosed Information (Data Security of Drug Registration Records), Decision No. 30/2006/QD BYT, 2006
Undisclosed Information (Drug Registration Records), Regulation, 2006
Enforcement (IP Protection & Management), Decree No. 105/2006/ND-CP, 2006
Industrial Property, Decree No. 103/2006/ND-CP, 2006
Plant Varieties, Decree No. 104/2006/ND-CP, 2006
Copyright (Guidelines IP Law), Decree No. 100/2006/ND-CP, 2006
Undisclosed Information, Decision No. 69/2006/QD-BNN, 2006
Enforcement (Border Measures & Imports Exports Procedures), Decree No. 154/2005/ND-CP, 2005
Enforcement (Plant Variety Protection), Decree No. 57/2005/ND-CP, 2005

**INTERNATIONAL CONVENTIONS AND TREATIES**

**WIPO-Administered Treaties**
Summary Table of Membership of the World Intellectual Property Organization (WIPO) and the Treaties Administered by WIPO, plus UPOV, WTO and UN
Rome Convention (March 1, 2007)
Madrid Protocol (July 11, 2006)
Brussels Convention (January 12, 2006)
Phonograms Convention (July 6, 2005)
Berne Convention (October 26, 2004)
Patent Cooperation Treaty (March 10, 1993)
WIPO Convention (July 2, 1976)
Madrid Agreement (Marks) (March 8, 1949)
Paris Convention (March 8, 1949)

**IP-related Multilateral Treaties**
Convention on the Rights of Persons with Disabilities
Convention on the Protection and Promotion of the Diversity of Cultural Expressions (November 7, 2007)
Agreement establishing the World Trade Organization (WTO) (January 11, 2007)
Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (January 11, 2007)
UPOV Convention (December 24, 2006)
International Plant Protection Convention (October 2, 2005)
WHO Framework Convention on Tobacco Control (March 17, 2005)
Kyoto Protocol to the United Nations Framework Convention on Climate Change (February 16, 2005)
Cartagena Protocol on Biosafety (April 20, 2004)
Convention on Biological Diversity (February 14, 1995)
United Nations Framework Convention on Climate Change (February 14, 1995)
Convention concerning the Protection of the World Cultural and Natural Heritage (January 19, 1988)
First Protocol of 1949 Geneva Conventions (April 19, 1982)
First 1949 Geneva Convention (December 28, 1957)
Fourth 1949 Geneva Convention (December 28, 1957)
Second 1949 Geneva Convention (December 28, 1957)

**IP-relevant Bilateral Treaties**

Agreement between Switzerland and Viet Nam on the protection of intellectual property and cooperation in
this area (May 19, 2000)
Agreement between the United States and Viet Nam on Copyright Protection (June 1997)

As an ASEAN member, Vietnam ratified the ASEAN Framework Agreement on Intellectual Property
Cooperation in 1996, under which the conformity with TRIPs Agreement is considered as a basis for the
members’ cooperation in the intellectual property field.

Vietnam has not yet acceded to the Nice Agreement nor Strasbourg Agreement, but it has adopted the
International Classification of Goods and Services and the International Patent Classification (IPC) under
such agreements.

**PATENTS**

**TYPES OF PATENTS**

The current patent rules make available three types of patent, including (i) Patent for inventions, (ii) Patent
for utility solutions, and (iii) Patent for industrial designs.

Invention is a technical solution which must be of worldwide novelty, involve inventive step and be applicable
in various social and economic fields. Utility solution is a technical solution which must be also of worldwide
novelty and applicability but needs not to possess an attribute of inventive step. The subject matter of
inventions and utility solutions may be device, process, substance, micro-organisms, cell culture, and use
thereof according to a new function (improvement thereof).

Industrial design is defined as the shape of a product that is formed by lines, three-dimensional forms and
colors, or a combination thereof, and that must be of worldwide novelty and serve as a pattern for
manufacture of industrial or handicraft products.

**PATENTABILITY**

*Inventions/Utility Solutions*

To be patentable, both inventions and utility solutions must be of worldwide novelty and applicability. In
addition, an invention is required to involve an inventive step while the utility solution is not.

*Novelty*

A technical solution shall be considered to meet the worldwide novelty if, before the priority date of the
patent application claiming the solution, (i) it is not in identical with any solution described in earlier patent
applications, and (ii) it has not been disclosed in Vietnam and abroad in any form of use or description to the
extent that based on such description any person of ordinary skill in the art can effect the solution.
Information on a technical solution will not be considered publicly disclosed unless it is accessible to the
general public.

However, if an invention or utility solution is disclosed by another person without the consent of the inventor
or his assignee and such disclosure takes place within six months before the filing date of the concerned
patent application, then the invention or utility solution shall not be deemed to loss the novelty.

*Inventive Step*

The inventive step is required only for inventions, not for utility solutions. This is essentially a non-
obviousness requirement. A technical solution will be deemed to involve an inventive step if it is a result of
creative work and, based on the state of the art at home and abroad up to the priority date, is not obvious to
a person with ordinary skill in the art.

*Applicability*
An invention or utility solution shall be deemed industrially applicable if it can be executed in the present or future technical conditions.

**INDUSTRIAL DESIGNS**

An industrial design must be worldwide novel, creativity and serve as a pattern for manufacture of industrial or handicraft products. Moreover, industrial designs are required to possess some kind of creativeness because the current rules exclude from patentability those designs easily created by a person with ordinary skill in the art.

**Novelty**

An industrial design shall be deemed to be worldwide novel if (i) it substantially differs from those designs described in the earlier applications, (ii) it substantially differs from those designs that have been published in Vietnam and abroad, and (iii) before the priority date, it has not been disclosed in Vietnam and abroad to such an extent that, based on such disclosure, any person with ordinary skill in the art can effect the industrial design. However, two designs shall not be considered to be substantially different from each other if they differ only in their shaping features that are not easily identified and remembered and such features can not be used to distinguish the two designs as a whole.

**Creativity**

An industrial design shall be considered as creative if it cannot be easily created by a person ordinarily skilled in the art based on the disclosure thereof to the public by means of use, written description or any other way inside or outside Vietnam prior to the date of filing or priority date where priority is claimed. The sources of prior industrial designs based on which the creativity of an industrial design is determined is also expressly defined under the IP Law.

**Industrial mass-production**

To satisfy this requirement, the concerned design must be capable of being used for mass-production of products by industrial or handicraft methods. In absence of this attribute, a work may be protected under copyright laws as an artistic work.

**EXCLUSIONS FROM PATENTABILITY**

For inventions and utility solutions, the following objects shall be excluded from patentability:

- Scientific discoveries or theories, mathematical methods;
- Schemes, plans, rules and methods for performing mental acts, training domestic animals, playing games and doing business; computer programs;
- Presentations of information;
- Solutions of aesthetic characteristics only;
- Plant varieties, animal breeds;
- Processes of plant or animal production which are principally of a biological nature, other than microbiological processes; and
- Human and animal disease prevention methods, diagnostic and treatment methods.

For industrial designs, the following shall be excluded from patentability:

- Outward appearance of a product which is necessarily due to the technical features of the product;
- Outward appearance of civil or industrial construction works; and
- Shape of a product which is invisible during the use of the product.

Also excluded from patentability are those inventions, utility solutions and industrial designs which are contrary to social interests, public order and humanity principle.

**PATENT TERM AND MAINTENANCE/RENEWAL**

The term of patent shall be 20 years for inventions, 10 years for utility solutions, counted from the filing date, subject to annuity payment. The patent for industrial design shall last 5 years from the filing date and can be renewed for two further terms, each of 5 years, subject to payment of renewal fee. All patents for invention, utility solution or design shall be effective from the granting date.
Upon the grant of patent for inventions and utility solutions, the applicant shall have to pay fees for publication, registration in the National Register, grant of the patent and the annuity fee for the patent granting year with respective amount due for that year. The annuity for each of the subsequent years must be paid within 6 months before the date of validity expiry. A six-month grace period is however allowed subject to the penalty of 10 percent of the said annuity for each month over due. For patent for industrial design, the renewal fee must be paid within 6 months prior to the expiry of the earlier validity term. A six-month grace period is also available subject to the penalty of 10 percent of the renewal fee for each month late.

**Rights and Obligations of Patent Owners**

A patent owner shall be entitled to (i) exclusive use of the patented invention, utility solution or industrial design, including the right to license, (ii) request any person infringing his patent rights to cease from the infringement and ask for any damage suffered.

The patent owner has certain obligations including (i) to pay remuneration to the inventor(s), (ii) pay the annuity or renewal fee for maintenance or renewal of the patent, and (iii) use or license the patented invention, utility solution or industrial design to a third party in the form of compulsory license according to the decision of the competent State authority.

**Limitations to Patent Rights**

Patent rights as mentioned above are subject to certain limitations as mentioned below:

1. **Prior Users’ Rights**

An individual or entity who, prior to the publication date of the patent application, had used the invention, utility solution or industrial design independently of the patentee, shall have the right to continue the use after the patent is granted. However, the prior user can not extend the scope or increase the volume of use compared with the use prior to the publication date of the application. Prior user’s right can not be transferred.

2. **Compulsory License**

The Ministry of Science and Technology (“MOST”) may grant a compulsory license in the following circumstances:

- The patentee fails to use the patented invention, utility solution or industrial design, or used but not compatible with the socio-economic development of Vietnam, without any justifiable reasons;
- The person willing to use the invention, utility solution or industrial design has tried by every means to negotiate with the patentee with a reasonable price to enter a license but failed;
- The use of the patented invention, utility solution or industrial design is to serve the demands of national defense and security, prevention and treatment of human disease or other urgent needs of the society.

The licensee of a compulsory license shall have to pay the patentee a certain amount of royalties as specified in the decision of granting compulsory license from the MOST.

3. **Other Limitations**

The following cases are also not covered by the patent rights:

- The use is not for commercial purposes;
- The circulation and use of the products that are sold or marketed by the patentee, his assignee or licensee or a prior user;
- The use of the patented invention, utility solution or industrial design on foreign means of transportation which are in transit or temporarily located in the territory of Vietnam and such use is only for the purpose of maintaining the operation of such means.

**Who May File and Where to File Patent Applications**

Under the current rules, the right to file a patent application (for an invention, utility solution or industrial design) belongs to the inventor(s)/creator(s) or his/her (their) successor(s) in title. However, if an invention, utility solution or industrial design is created under a commission, the right shall be vested in the person who has commissioned the work, for example an employer. In addition, if the object is created as a result of a
service contract between the inventor and another person or entity, such person or entity shall have the right to seek the patent. The assignee of an invention, utility solution or design may also apply for a patent, subject to a deed of assignment required for filing.

All patent applications must be filed with the National Office of Intellectual Property (“NOIP”) which is based in Hanoi Capital. Vietnamese citizens or entities can directly file applications with the NOIP. Foreign citizens permanently residing in Vietnam or foreign entities having legal presence in Vietnam or real and effective production and business establishments in the country may also file applications directly with the NOIP. Other than these specified cases, all applications of foreign applicants must be submitted through a licensed local IP agency like IP Consult LLC. Foreign law firms or IP firms are not permitted to represent clients for filing in Vietnam.

“FIRST TO FILE” PRINCIPLE

The “first to file” principle is adopted in Vietnam for determining priority for patent applications, according to which a patent will be granted to the person who first files an application seeking a patent. If several applications for the same invention, utility solution or industrial design are filed on the same date or claim the same priority date, then all applicants shall be required to merge the applications into one application and only one patent will be granted to all the applicants as co-owners if they so agree. Otherwise, no patent will be granted.

If two or more applications for both invention patents and utility patents are filed for the same technical solution, with the same priority conditions, then the NOIP will request the applicants to select a single form of protection (invention patent or utility solution patent) and merge the applicants in the similar manner as above mentioned.

PRIORITY

Priority can be claimed according to the Paris Convention, based on an earlier application filed in a foreign country or an officially recognized international exhibition held in Vietnam or a foreign country. Priority can be also claimed according to a bilateral agreement or the principle of reciprocity.

To secure the priority right, the application must be filed within 12 months for inventions and utility solutions, and 6 months for industrial designs, from the filing date of the first application filed abroad. For PCT applications, the entering of the national phase in Vietnam must be requested within 21 months if Vietnam is designated and 31 months if Vietnam is selected, counted from the filing date of the first application. If the application claims different priority dates, the above mentioned time limits will be counted from the earliest date of the priority dates. The applicant has the right to withdraw the priority claim in order to defer publication of the application.

PATENT APPLICATIONS

Patent applications must satisfy the unity requirement. Specifically, an application for an invention or utility solution will be deemed to meet this requirement is it relates to one subject matter or a number of subject matters so linked to form a single inventive step. For industrial designs, this requirement will be satisfied if the application claims one design or a number of designs of different products creating a set of products jointly used, or if it concerns designs that are variations of the same design.

For documents required for filing of domestically filed applications for inventions/utility solutions, PCT applications (entering the national phase in Vietnam), and applications for industrial designs, please see Filing Requirements in Vietnam.

CONVERSION OF APPLICATIONS FOR INVENTION PATENT INTO APPLICATIONS FOR UTILITY SOLUTION PATENT

The applicant can convert a filed application for invention patent into an application for utility solution patent. Prior to the notification of refusal of granting the invention patent, the application for invention patent may be converted into an application for utility solution patent, subject to the applicant’s request. All the filing data, such as the filing date and priority date of the original application, shall remain unchanged. In this case, the filing fee and examination fee already paid will not be refunded, and the application conversion fee must be paid.

FORMALITY EXAMINATION
All patent applications including PCT applications shall be examined with respect to formality. The formality examination will be conducted by the NOIP within 1 month from the filing date to see whether the application is accepted as to proper form. During the formality examination period, the applicant may make amendments or additions to the documents of the application, but may not expand the scope (volume) of protection or change the nature of the invention, utility solution or industrial design sought for protection.

If the application meets the formality requirements, it will be accorded with an official filing date, official filing number, and priority date, and the Notification of Acceptance with respect to formality requirements will be issued to the applicant. To the contrary, the NOIP will reject the application with a Notification of Refusal of Acceptance or, where appropriate, notify and request the applicant to rectify the deficiencies.

**PUBLICATION OF PATENT APPLICATION**

All applications for patents of inventions, utility solutions or designs which have been accepted by the NOIP as legitimate shall be published in the Official Industrial Property Gazette (“IP Gaz”), Volume A.

For domestically filed applications for inventions or utility solutions, the application shall be published in the 19th month from the filing date or within two months from the date of the NOIP’s notification of acceptance, whichever is later. If a request is filed for early publication, the application shall be published within two months from the date the NOIP receives the request for early publication or from the date of the NOIP’s Notification of Acceptance, whichever is later;

A PCT application or an application for industrial design patent shall be published within two months from the date of the NOIP’s notification of acceptance after the application enters into the national phase in Vietnam.

As for industrial designs, the applications thereof shall be published within two months from the date of the NOIP’s notification of acceptance.

**REQUEST FOR SUBSTANTIVE EXAMINATION OF APPLICATIONS FOR INVENTIONS/UTILITY SOLUTIONS**

Substantive examination will be conducted by the NOIP for a patent, invention or utility solution application if it has been accepted as to proper and there is a request for substantive examination filed by the applicant or a third party. Request for substantive examination is not required for applications for industrial designs.

Request for substantive examination must be filed within 42 months for inventions and or 36 months for utility solutions from the priority date. The application will lapse if the applicant fails to submit the request for substantive examination within the regulated time limits. Normally such request is made upon filing. However if the request is submitted after filing then it must be made in writing and subject to the substantive examination fee.

**SUBSTANTIVE EXAMINATION AND GRANT OF PATENT**

Substantive examination shall be carried out by the NOIP for an application for invention or utility solution if (i) the application has been accepted as to proper and (ii) a request for substantive examination is filed by the applicant or a third party. Substantive examination will be conducted automatically as to applications for industrial designs that have been accepted as to proper, without subject to request for substantive examination.

The period of substantive examination shall be 12 months for invention and utility solution applications, from the date of receipt of the request for substantive examination if such request is filed after publication of the application, or from the publication date if the substantive examination request is filed before the publication date of the application. For design applications, the substantive examination will last 6 months from the signing date of the Notification of Acceptance.

The applicant may make amendments to the patent application during the substantive examination period. However, such amendments may not change the invention, utility solution or industrial design or extend the scope (volume) of protection claimed. He may also withdraw the patent application at any time prior to the end of the substantive examination period.

Upon expiry of the substantive examination period, if the invention, utility solution or design is found not to be patentable, the NOIP will issue a Notification of Examination Result to the applicant notifying its intended refusal with reasons therefore or deficiencies which need to be corrected. The applicant must respond to the NOIP within 2 months, and if the applicant fails to respond or the response is unsatisfactory, the NOIP will officially reject the application with an official Notification of Refusal.
If the substantive examination finds the invention, utility solution or design to be patentable, then the NOIP will grant a patent and publish in the IP Gazette, Volume B (for granted patents) and enter into the National Register of Industrial Property.

APPEAL/Opposition Proceedings

The following persons shall have the right to submit appeals/oppositions to the NOIP against the acceptance to or refusal of patent applications:

- The applicant itself may file an appeal against the refusal of its application;
- A third party who requested substantive examination may file an appeal against the granting of a patent for the concerned invention, utility solution or industrial design, without subject to any fee; and
- Any third party may oppose the granting of a patent, subject to a certain fee.

The appeal/opposition must be made in writing and submitted to the NOIP within 3 months from receipt of the NOIP’s decision in question for the first two cases mentioned above.

Cancellation and Suspension of Patents

Any third party shall be entitled to file a request with the NOIP to cancel a patent in whole or in part, based on the following reasons:

- The patentee was not entitled to apply for the patent, nor assigned the right to file the application for the patent from the entitled person;
- The right to apply for the patent belongs to a number of natural or legal persons one of whom has not agreed to the filing;
- The patent incorrectly states the inventor(s) due to the applicant’s deliberate fault; or
- Unpatentability of the invention, utility solution or industrial design which has been granted the patent.

The validity of a patent may be suspended if the patentee declares in writing abandonment of the patent or fails to pay the prescribed annuity or renewal fee within the time limits as regulated.

In case of cancellation, the rights conferred by the patent shall be considered as not having been established. And when the patent validity is suspended, the patent rights will be terminated from suspension of the patent.

Patent Infringements

The following acts, committed without the consent from a patent holder, shall constitute a patent infringement:

For inventions/utility solutions, (i) manufacturing products using a patented invention or utility solution; (ii) applying patented process; (iii) exploiting the use of products that have been protected or manufactured under the patented process; (iv) circulating, advertising, offering, or storing patented products, and (v) importing patented products into Vietnam.

For industrial designs, (i) manufacturing products bearing a patented industrial design; (ii) circulating, advertising, offering, or storing patented design, and (iii) importing patented industrial designs into Vietnam.

For enforcement of patent rights and remedies available, please see Enforcement of Intellectual Property Rights.

Trademarks

Definition and Registrability

A trademark is defined as a sign used to distinguish the goods or services of one producer/service provider from those of another. The trademark may be presented in the form of letters, words, pictures, three dimensions images or a combination thereof in one or several colors. To be registrable, a trademark must be distinctive and must not fall within the signs excluded from registrability.

A sign used as a trademark shall be deemed distinctive if the following conditions satisfied:
• It is created from one or a number of elements that are prominent and easily recognized, or from elements that are, as a whole, prominent and easily recognized;
• It is not identical with or confusingly similar to another person's trademark currently protected in Vietnam;
• It is not identical with or confusingly similar to a trademark of another person claimed in prior-filed applications in Vietnam including those trademarks filed under the Madrid Agreement;
• It is not identical with or confusingly similar to a trademark of another person, the protection validity of which has expired or been suspended within the last 5 years, except where the validity was suspended on the basis of non-use;
• It is not identical with or confusingly similar to a trademark of another person recognized as well-known in accordance with Article 6bis of the Paris Convention, or a trademark that has been widely used and recognized;
• It is not identical with or confusingly similar to a protected trade name or appellation of origin;
• It is not identical with or confusingly similar to a patented industrial design or a prior-filed industrial design; or
• It is not identical with or confusingly similar to a symbol or character subject to another person’s copyright unless permitted by such person.

The following signs shall be excluded from trademark protection:

• Signs that do not possess distinctiveness, such as simple shapes and geometric shapes, figures, capital letters, letters that can not be pronounced as a word, and foreign letters of uncommon languages (common foreign languages are widely understood to include English, French, Russian and Chinese). Those signs can be however registered if they have been widely used and recognized;
• Conventional signs, symbols, ordinary devices, and denominations of goods in any language that are used widely and popularly and known to many people;
• Signs indicating time, place, manufacturing process, type, quantity, quality, nature, composition, utility or value that are descriptive of goods, services or origin thereof;
• Signs likely to mislead or cause confusion or to deceive consumers as to the origin, nature, function, utility, quality or value of goods or services;
• Signs identical with or similar to official quality marks, control marks, warranty marks, etc. of Vietnam, foreign countries or international organizations;
• Signs or names (including pictures, names, nicknames and pseudonyms), devices or symbols identical with or confusingly similar to national flags, national emblems, portraits of national leaders or heroes, public figures, geographical denominations, organizations of Vietnam and foreign countries, unless duly authorized; and
• Signs that are contrary to law, social interests, public order and humanity.

WHO MAY FILE AND WHERE TO FILE TRADEMARK APPLICATIONS

All individuals and entities involved in legal production and business activities are entitled to file applications for trademark registrations to be used for products or services they are manufacturing or providing or intend to manufacture or provide. Actual or prior use of a trademark is not required to seek for trademark registration in Vietnam. So businesses including foreign ones can seek registrations of trademarks for future use in Vietnam, provided that a registered mark may not be discontinued for any five consecutive years. Otherwise, the trademark is vulnerable to cancellation.

Trademark applications must be filed with the NOIP. Vietnamese citizens and entities may file trademark applications directly with the NOIP. Foreign citizens permanently residing in Vietnam or foreign entities having legal presence in Vietnam or real and effective production and business establishments in the country may also file applications directly with the NOIP. Other than these specified cases, all applications of foreign applications must be submitted through a licensed local IP agency like IP Consult LLC.

“FIRST TO FILE” PRINCIPLE

Like other industrial property objects, the “first to file” principle is also applied for trademark protection in Vietnam, accordingly the trademark registration will be granted to the person who first filed the trademark application.

However, the “first to file” principle shall not apply to cases of well-known marks under the Paris Convention or those which have been widely used and recognized. In such cases, the priority will be given to the person who can prove that his trademark has been well-known or been widely used and recognized, without subject to the “first to file” principle.
**Priority**

Priority can be claimed in accordance with the Paris Convention, based on an earlier application filed in a foreign country or an officially recognized international exhibition held in Vietnam or in a foreign country. Priority can also be claimed according to bilateral agreements or based on the reciprocity principle. To secure the priority right, the application must be filed within 6 months from the filing date of the first application filed abroad or the date of the exhibition as above mentioned.

**Trademark Applications**

Each application can be used for one trademark only. However, multi-class applications are possible in Vietnam, accordingly up to 45 classes of goods and services can be claimed under one application. The goods and/or services under the application must be classified according to the International Classification of Goods and Services under the Nice Agreement (currently the ninth edition is applicable).

The NOIP accepts a general power of attorney for trademark filings of one applicant. In case the power of attorney specifies particular marks of the applicant, then separate power of attorney will be required for any subsequent marks of the applicant not specified in the original power of attorney. The power of attorney can be submitted by fax, provided that the original copy is supplemented within 1 month from the filing date.

For documents required for trademark filing in Vietnam, please see Filing Requirements in Vietnam.

**Examination**

All trademark applications will be examined by the NOIP with respect to formality requirements, within 1 month from the filing date. If the application is found to satisfy the formality requirements, then it will be accepted as to proper by the NOIP in a Notification of Acceptance which provides official filing date, official filing number, and priority date if any. In case the application does not meet the formality requirements, the NOIP will reject the application by a Notification of Refusal of Acceptance or request corrections or amendments, as the case may be.

Upon expiry of the formality check and where the application is accepted as to proper, the application will be passed to substantive examination which takes place within a 9-month period from the date of acceptance (i.e. the signing date of the Notification of Acceptance). The substantive examination is to consider whether the claimed trademark (i) possesses distinctiveness and (ii) is of those signs excluded from trademark protection. During this period, the applicant may make amendments to the application, however only minor changes to the trademark or goods and/or services claimed are acceptable. For example, the applicant can restrict the goods and/or services claimed but not expand the scope of goods and/or services.

Trademark applications filed internationally under the Madrid Agreement/Protocol shall be also subject to the substantive examination which lasts 1 year from the date of extension of protection to Vietnam.

**Grant of Certificate of Trademark Registration or Acceptance of Protection**

If upon expiry of the substantive examination, the trademark is found to be registrable, the NOIP will grant Certificate of Trademark Registration for the trademark, and publish the Certificate in the IP Gazette, Volume B. As regards the international trademarks filed under the Madrid Agreement/Protocol, the NOIP will issue Decision on Acceptance of Protection for the trademark in question. The international registration of a trademark, accepted for protection in Vietnam by the NOIP, shall be effective from the date it is published in Volume B of the IP Gazette.

Where the trademark is unregistrable, the NOIP will issue a Notification of Examination Result notifying the applicant of its intended refusal and reasons thereof, or of the deficiencies or amendments which should be corrected or made. The applicant has 2 months to reply or make necessary amendments. If the applicant fails to reply or the response is not appropriate, the NOIP will officially issue a Notification of Refusal. To the contrary where the response is satisfactory, the Certificate of Trademark Registration or Decision on Acceptance of Protection will be granted as above mentioned.

**Well-known Trademarks**

Well-known trademarks are protected in Vietnam without subject to registration, under the Paris Convention of which Vietnam is a member. However, unfortunately, the current rules do not provide for statutory criteria
for determining a well-known trademark. Therefore, in practice, the determination of whether a trademark being well known is much depending on the NOIP’s examiners. In absence of the statutory requirements for a trademark to be deemed well-known, the NOIP usually bases on whether the mark in question has acquired distinctiveness through actual use. The concept of “acquired distinctiveness through actual use” means that the mark has been widely used and recognised in Vietnam. To substantiate the claim that the mark is widely used and recognised, the applicant needs to provide the NOIP with as much of the following information as possible by way of an affidavit:

- List of territorial areas in which products bearing the mark are used regardless of having trade mark registration or not;
- Number of relevant consumers who are aware of the mark through purchases or use of the goods/services bearing the mark, or from advertising;
- Total sale of products bearing the mark or the quantity of goods provided;
- Duration of consecutive use of the mark;
- List of copies of registrations and pending applications of the mark in all relevant countries;
- Number of countries recognising the mark as well-known or widely-used mark;
- Assignment price, licensing price, or investment capital contribution which evidences the value of the mark (if any); and
- Advertisement expenditure for the products bearing the mark, i.e. samples of sales brochures, news articles or any other material bearing the mark.

**PROTECTION TERM AND RENEWAL**

A certificate of trademark registration shall be effective from the granting date and last for 10 years from the filing date, and can be renewed for indefinitely for each consecutive 10-year term.

To renew the validity of a certificate, the trademark owner must apply for renewal and pay the renewal fee within 6 months before the expiry of the preceding validity term. Renewal request may be filed late within a 6-month grace period, subject to a fine of 10 percent of the renewal fee for each month overdue.

**RIGHTS AND OBLIGATIONS OF TRADEMARK OWNERS**

A trademark owner shall be entitled to (i) exclusive use of the trademark, including the right to license the right to use the trademark, (ii) request any person infringing his trademark rights to cease from the infringement and ask for any damage suffered.

The trademark owner must use the trademark continuously and must not discontinue use of the trademark for any consecutive 5 years. Otherwise, the certificate of trademark registration shall be suspended at a third party’s request.

**APPEAL/OPPosition PROCEEDINGS**

Oppositions/appeals can be lodged against the NOIP’s decisions to grant or not to grant certificates, which are subject to a prescribed fee.

By opposing a trademark, a third party is entitled to express an opinion to the NOIP that the mark should not be registered at any time from the date the trademark application is published in the Official Gazette of Industrial Property until a decision is issued to grant a title of protection to the mark. As the NOIP is supposed to complete its substantive examination of the trademark application within 9 months of publication, the opposition period should be 9 months from the date of publication. However, as the period of substantive examination often takes longer than six months, the period for opposing a trademark is typically extended accordingly. In many cases, the deadline for opposing a trademark application is not fixed and cannot be known without inquiring with the NOIP. In practice, it sometimes takes the NOIP about 6 month to rule on the opposition once the case is “at issue”, but it can take longer for the NOIP to issue its ruling in other cases.

By appealing the NOIP’s decisions, when the NOIP accepts the opposer’s arguments and issue a 1st Provisional Refusal of the mark in question. The applicant will have 2 months (extendable for a further period of 2 months) to express its opinion to the NOIP. If the NOIP issues a final decision not to grant the registration, the applicant will have 3 months (extendable for a further period of 3 months) to lodge a 1st appeal with the NOIP. If the applicant disagrees with the NOIP’s decision on the 1st appeal, the applicant is entitled to file a 2nd appeal to the MOST, or initiate a lawsuit at court within the prescribed period of time.
More importantly, if the NOIP issues a final decision to grant a protection of title to the opposed trademark, there is no appeal of such decision within the context of the opposition. Rather, the opponent must wait until the trademark is registered, then file a cancellation proceeding with the NOIP.

**CANCELLATION AND INVALIDATION OF CERTIFICATE OF TRADEMARK REGISTRATION**

A certificate of trademark registration may be cancelled wholly or partly, by any third party’s request, in the following cases:

- The person who has been granted the certificate was not entitled to apply for the trademark registration, nor assigned the right to file the application from the entitled person; or
- The trademark under the certificate does not meet the protection criteria as stipulated.
- The validity of the certificate of trademark registration may be also suspended on the following grounds:
  - The grantee submits a written request to the NOIP for abandonment of the certificate; or
  - The grantee fails to pay the renewal fee within the prescribed time limit; or
  - The trademark under the certificate has not been used for any consecutive 5 years without any justifiable reasons (non-use basis); or
- The grantee no longer exists or terminates the operations.

It should be noted that the limitations period for filing a cancellation is 5 years from the date on which a title of protection is granted to the mark in question. However, in the case of a cancellation proceeding based on unfair competition (e.g., if a Vietnamese agent registers the trademark of its principal in Vietnam), the cancellation proceeding may be filed at any time during the validity of the title of protection.

**TRADEMARK INFRINGEMENTS**

The use of a registered trademark as described above shall be considered as a trademark infringement if it is conducted without the consent of the trademark owner. The current trademark laws make available administrative, civil or criminal remedies, where appropriate, for a trademark owner to enforce his rights in case of infringement. For details of enforcement of trademark rights and remedies available, please see Enforcement of Intellectual Property Rights.

**GEOGRAPHICAL INDICATIONS**

**Registribility**

A geographical Indication is defined as a sign that is used to identify products as originating from an area, locality or country provided that the products meet the following conditions:

- products bearing geographical indication geographically originate from the area, locality or country indicated by such geographical indications;
- products bearing geographical indication have reputation, quality or characteristics that are essentially attributable to the geographical conditions of the area, locality or country indicated by the geographical indication.

"Reputation" of products bearing geographical indication is determined by the level of its prestige among consumers that calculated by the level of awareness of and level of frequency of choosing the products made by consumers. Meanwhile, "quality or characteristics" of products bearing geographical indication are measured by one or several indicators such as quantitative, qualitative norms or physical, chemical, microbiological sensations and these indicators can be by examined by technical means or experts using appropriate testing methods. The "geographical conditions" of the territory indicated by geographical indications shall include the natural factors (climate, hydrograph, geology, terrain, ecological system and other natural factors) and human factors (skills, expertise of manufacturers, process and traditional mode of manufacture) that essentially determine the reputation, quality or characteristics of products bearing geographical indications.

However, the following subject matters shall not be protected as geographical indications:

- Designations, indications having become generic names of goods in Vietnam;
- Geographical indications of a foreign country where it is not or no longer protected or no longer used;
- Geographical indications identical with or similar to a mark having been protected if their use will cause confusion as to the origin of the products;
- Geographical indications misleading consumers as to the true geographical origin of products bearing such geographical indications.
FORM AND TERM OF PROTECTION, RENEWAL

A geographical indication is protected in the form of Certificate of Geographical Indication Registration granted by the NOIP. The certificate shall be effective from the granting date and continue for 10 years from the filing date, and can be renewed for unlimited times, each of 10 years.

Renewal request and fee must be filed within 6 months before the expiry of the preceding validity term. Renewal request may be filed late within a 6-month grace period, subject to a fine of 10 percent of the renewal fee for each month overdue.

RIGHTS TO USE OF GEOGRAPHICAL INDICATION

The person who has been granted the right to use a geographical indication under a certificate shall be entitled to (i) use the geographical indication for his or her products, and (ii) request the relevant State authorities to compel another person illegally using the geographical indication to cease from the use and compensate for damage suffered.

It is noted that the right to use a geographical indication shall be by no means assigned or licensed to another person.

APPLICATION AND EXAMINATION

The right to register geographical indications shall belong to the State of Vietnam. However, the State permits individuals/organizations manufacturing products bearing the geographical or their representative association or the local administrative authority to exercise the right. A foreign individual or entity that has been protected a geographical indication in the home country may seek registration of that appellation for use for his or their products in Vietnam. The right to apply for registration of a geographical indication may not be assigned or transferred.

For documents required for filing applications for appellations of origin, please see Filing Requirements in Vietnam.

Each application can be filed for one geographical indication that used for one product only. All applications for geographical indications shall be examined by the NOIP in terms of formality within 1 month from the filing date. Upon expiry of this period if the application is accepted as to proper, the appellation will be then subject to substantive examination which takes place within 6 months from the date of acceptance of the application. The certificate shall be issued if the geographical indication in question is found to be registrable.

CANCELLATION AND INVALIDATION OF CERTIFICATE OF GEOGRAPHICAL INDICATION REGISTRATION

A certificate of geographical indication registration may be cancelled by any third party's request, if (i) the application for registration neither has right to registration; or (ii) the geographical indication under the certificate does not meet the protection criteria as stipulated.

The validity of the certificate of geographical indication registration may be also suspended on the grounds that the geographical conditions attributable to the reputation, quality or characteristics of the product bearing a geographical indication have changed resulting in a loss of the reputation, quality or characteristics of the product.

LAYOUT DESIGNS OF SEMICONDUCTOR INTERGRATED CIRCUITS

DEFINITION AND REGISTRABILITY

Layout Designs of Semiconductor Integrated Circuits (hereinafter referred to as “Layout Designs”) are defined as “three-dimensional disposition of circuitry elements and interconnections of such elements in a semiconductor integrated circuit” in which the integrated circuits are prescribed as product, in its final form or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on a piece of semiconductor material and which is intended to perform an electronic function. “Integrated circuit” is synonymous with “IC”, “chip” and “microelectronic circuit”. A layout-design shall be eligible for protection if it is originality and commercial novelty.

Originality
A layout design shall be considered as original if it is resulted from its author's own creative effort and not to be widely known among creators of layout-designs or manufacturers of semiconductor integrated circuits at the time of its creation. In addition, a layout design that is a combination of common general elements and interconnections shall be considered as original if such a combination as a whole is original.

**Commercial novelty**

The commercial novelty of layout design is understand as the layout design has not been commercially exploited anywhere in the world prior to the filing date of the application for registration. A layout-design shall be considered as lacking of commercial novelty if the layout design registration application is filed within 2 years from the date such layout design was commercially exploited for the first time anywhere in the world by the person who has the right to register or his/her licensee. Commercial exploitation of a layout-design means any act of public distribution for commercial purposes of a semiconductor integrated circuit produced by incorporation of the layout-design, or an article incorporating such a semiconductor integrated circuit.

The subject-matters excluded from layout designs protection in Vietnam include (i) principles, processes, systems or methods operated by semiconductor integrated circuits, and information or software contained in semiconductor integrated circuits.

**WHO MAY FILE AND WHERE TO FILE LAYOUT DESIGN APPLICATIONS**

The right to file a layout design application belongs to inventors who have created the layout design by his/her own efforts and expenses. In case a layout design is created by the inventors during the course of employment or hire, the entitlement to file layout design applications for such layout design shall belong to the entities or individuals who have invested finance and material facilities to the inventors through employing or hiring. In addition, persons entitled to file an application may assign that right to other organizations or individuals through written contract or inheritance in accordance with the law. The right to file layout design applications for layout design made by using the State budget belongs to the State.

All applications must be lodged with the NOIP, which has been entrusted to be the State administrative authority under the jurisdiction of the Ministry of Science and Technology. Vietnamese entities and individuals, foreign individuals permanently residing in Vietnam, and foreign entities having an industrial or commercial establishment in Vietnam may file patent applications directly or through an IP agency licensed to practice before the NOIP. Foreign individuals not permanently residing in Vietnam and foreign entities having no legal presences in Vietnam shall file applications through a licensed IP agency. i.e IP Consult LLC.

**LAYOUT DESIGN APPLICATIONS**

Each application can be filed for one layout design only. Applications for registration of layout designs shall be subject to the formality examination within one month from the filing date. After duly accepted as to form, applications for registration of layout designs shall be published in IP Gazette for opposition within three months in the manner of allowing direct access at the NOIP without reproduction of such published layout design. The certificate of layout design of semiconductor integrated circuit registration shall be granted to the applicant if no opposition is filed within the duration of publication of the application.

For documents required for filing applications of layout designs, of domestically filed applications for inventions, please see Filing Requirements in Vietnam.

**PROTECTION TERM**

A certificate of layout design of semiconductor integrated circuit registration shall have validity from the granting date and expiring at the earliest date among the following:

- The end of 10 years as from the filing date;
- The end of 10 years as from the date the layout-designs were first commercially exploited anywhere in the world by the person having the right to registration or his or her licensee;
- The end of 15 years as from the date of creation of the layout-designs.

**RIGHTS OF OWNER OF A LAYOUT-DESIGN**

The owner of a layout-design has the right to exploit the layout-design or prevent any person from performing the following acts: (i) reproducing the layout-design; or making a semi-conductor integrated circuit in accordance with the protected layout-design; (ii) distributing, leasing, advertising, offering or storing a copy of the protected layout-design; (iii) importing a copy of the protected layout design, a semi-conductor
CANCELLATION OR SUSPENSION OF LAYOUT DESIGNS

At any time after a layout design is granted, any party may file a written request with the NOIP to cancel such patent. The grounds for cancellation include (i) the applicant was not entitled to apply for the layout design, nor assigned that right from the entitled person; or (ii) the layout design did not meet the protection conditions at the time the certificate of layout design registration was issued.

The certificate of layout design semiconductor integrated circuit registration may be suspended at the request of any party, based on the grounds that (i) the owner fails to pay the prescribed annuity or renewal fee as prescribed; (ii) the owner declares a disclaimer of the rights conferred by the layout design; or (iii) the layout design owner no longer exists, and there is no lawful successor.

TRADE NAMES, TRADE SECRETS AND UNFAIR-COMPETITION

TRADE NAME

Trade names mean the name of the organizations, individuals which are used in business activities to distinguish the business entity bearing such a name from other business entities engaging in the same field and locality of business and which satisfy the following criteria:

- It is consists of a proper name, except where it has been widely known as a result of use; and
- It is not identical with or confusingly similar to another person’s trade name prior used in the same field and locality of business; and
- It is not identical with or confusingly similar to another person’s trademark or a geographical indication having been protected prior to the date such trade name is used.

Name of administrative, political, social, professional agencies and organizations or of the subjects which do not relate to the business activities shall not be protected as trade name.

The holders of the trade names are the organizations, individuals that legally uses such trade names in the course of business. The holders are entitled to use the trade names for the business purposes, reflecting the trade names in the transaction papers, documents, signboards, products, goods, commodities, package and advertisement.

The trade names are protected when the holders of such names still maintain their business activities under such names.

The IP Law also stipulates the acts of using commercial indications identical with or similar to another person’s trade name prior used for the same or similar goods/services that causes confusion as to business entities, business premises or business activities under the trade name shall be considered as infringement of the rights to the trade name. The holder of such trade name thereby shall have the right to request the infringers to stop the infringement acts, apologize, publicly rectify and pay for damage compensation and/or to request the competent state agencies to handle acts of infringement or initiate a lawsuit at a competent court or an arbitrator for protection their legitimate rights and interest.

TRADE SECRETS

Trade secrets are defined as information obtained from financial or intellectual investment activities, which has not been disclosed and is applicable in business, when they satisfying full the following criteria:

- The information is neither common knowledge nor easily obtained; and
- They can be applied in business and, when used, will enable the holders of such information to have more favorable advance than other people who do not have or use such information in production, business; and
- They are confidentially kept by the holders with necessary measures so that such information will neither be disclosed nor easily accessible.

Under IP Law, the following confidential information shall not be protected as trade secrets:

- Personal status secrets;
- State management secrets;
The holders of the trade secrets are all organizations and individuals who have legally acquired the trade secrets and keep it confidential. A trade secret acquired by an employee or a party carrying out the assigned duty during performance of assigned duties shall belong to the employer or the duty assignor, unless otherwise agreed by the parties. The holders of the trade secrets are entitled to use their trade secrets by applying them to manufacture products, supplying services or trade in goods or selling, advertising for sale, storing for sale and importing a product obtained by applying the trade secret. Such rights shall be protected during the time such trade secrets still satisfy the said criteria of the trade secrets.

Under the IP Law, the following acts shall be considered as an infringement of the rights to a trade secret:

- Accessing or acquiring information embodied in a trade secret by taking acts against security measures taken by the lawful controller of the trade secret;
- Disclosing or using information embodied in a trade secret without permission of the holder the trade secret;
- Breaching security contracts or deceiving, inducing, bribing, forcing, seducing or abusing the trust of persons in charge of security in order to access, acquire of disclose a trade secret;
- Accessing to or acquiring information embodied in a trade secret, that is submitted by another person under procedures for granting a license of business or marketing in respect of a product, by actions against security measures taken by competent agencies;
- Using or disclosing trade secret, while knowing or being obliged to know that it has been acquired by another person;
- Failure to perform the obligation of security.

For the first time, limitations of the rights of an owner of a trade secret has been introduced in the law, including exemption from rights for (i) disclosure or use of a trade secrets acquired without knowing or having reason to know that it has been illegally acquired by others; (ii) disclosure of the trade secrets in order to protect the public; (iii) use of secret data for non-commercial purposes; (iv) disclosure or use of a trade secrets created independently; and (v) disclosure or use of trade secrets generated by analyzing or evaluating a legally distributed products; unless otherwise agreed between the analyzers or evaluators and the owner of the trade secret or the sellers of the product.

The IP Law also introduces the obligations to maintain secrecy of date of tests during the course of work of the competent authorities to maintain secrecy of the date submitted thereto by the applicant.

**ANTI-UNFAIR COMPETITION**

Unfair competition acts related to the industrial property as defined under IP Law include the acts:

- Using commercial indications that cause confusion as to business entities, business activities or commercial origins of goods or services.
- Using commercial indications that cause confusion as to the origin, production method, feature, quality, quantity or other characteristics of goods or services; or as to the conditions for the provision of goods and services;
- Using a trademark protected in a country that is a member of an international treaty, to which the Socialist Republic of Vietnam is a party, which prohibits the representative or agent of the owner of the trademark from using the owner’s trademark, if the user is such a representative or agent and the use is without the owner’s authorization and without reasonable grounds;
- Registering or possessing the right to use or using a domain name identical with or confusingly similar to another person’s protected trademark or trade name, or a geographical indication that one does not have the right to use, for the purpose of possessing the domain name, taking advantage of or prejudicing the reputation and goodwill or the respective trademark, trade name or geographical indication.

Apart from the IP Law, Law on Competition of Vietnam also introduces unfair competitive acts including any of the following:

- Misleading instructions;
- Infringement of trade secrets;
- Coercion in business;
- Defamation of another enterprises;
- Causing disruption to the business activities of another enterprise;
- Advertisement aimed at unfair competition;
Organizations, individuals which suffer damage or would be damageable due to unfair competition acts in the field of industrial property are entitled to request the competent State authorities to compel the person having unfair competition acts to stop conducting such acts, pay compensation for damage, or to impose administrative or criminal measures upon such person.

**COPYRIGHTS**

**AUTHORS AND COPYRIGHT OWNERS**

Copyright authors to be protected are persons who either directly create or a part or the whole of literary, scientific works, or artistic. They include:

- Vietnamese citizens whose works are copyright protected;
- Foreign citizens whose works are created and expressed in a certain material form in Vietnam;
- Foreign citizens whose works are first published in Vietnam;
- Foreign citizens whose works are protected in Vietnam under international treaties in which Vietnam is a member.

Copyright owners are the persons who hold the property right over literary, scientific works, or artistic. They include:

- Vietnamese organizations and individuals;
- Foreign organizations and individuals whose works are created and expressed in certain material forms in Vietnam;
- Foreign organizations and individuals whose works are published for the first time in Vietnam;
- Foreign organizations and individuals whose works are protected in Vietnam under international conventions on copyright in which Vietnam is a member.

**COPYRIGHTED WORKS**

Copyright protection is given to literary, artistic or scientific works which fall within any of the following categories:

- Literary works, scientific works, textbooks, teaching courses and other works expressed in written language or other characters;
- Lectures, addresses and other speeches;
- Press works;
- Musical works;
- Stage works;
- Cinematographic works and works created by a process analogous to cinematography;
- Plastic art works and applied art works;
- Photographic works;
- Architectural works;
- Sketches, plans, maps and drawings related to topography or scientific works;
- Folklore and folk art works;
- Computer programs and data collections.

To qualify for protection, a work must be original. Copyright protection will be established over the works to be created and expressed in certain material forms which are various in accordance with requirement for each type of work. As for folk literary and artistic works, their copyright protection is not subject to fixation.

Pursuant to Vietnam’s obligations under international treaties and conventions and corresponding provisions of the IP Law, protection is also provided to “related rights”, including rights in performances of musical, choreographic, theatrical, literary and other artistic works, sound and video recordings, as well as broadcasts and satellite signals carrying coded programs.

**EXCLUSIONS FROM COPYRIGHT PROTECTION**
The current rules deny protection to the following works in term of copyright:

- News of the day as mere items of information.
- Legal instruments, administrative and other documents in the judicial domain, and official translations of such documents.
- Processes, systems, operational methods, concepts, principles and data.

News is daily short press information without creative character. As for administrative documents, they include documents issued by State agencies, political organizations, socio-political organizations, economic entities, professional socio-political organizations, social organizations, socio-professional organizations, people’s armed units and other entities stipulated by law.

**PROPERTY AND PERSONAL RIGHTS**

An author and/or copyright owner shall be entitled to certain personal/moral right, and property/economic right, as the case may be.

Personal rights include (1) to give titles to the work, (2) to attach his/her real name or pseudonym to the work, (3) to have his/her real name or pseudonym acknowledged when the work is published or used, (4) to publish his/her work or to authorize other persons to publish the work, (5) to protect the integrity of the work; and (6) to forbid other persons to modify, edit or distort the work in whatever form, causing harm to the honour and reputation of the author.

Property rights include (1) to make derivative works; (2) to display their works to the public; (3) to reproduce their works; (4) to distribute or import the original or copies of their works; (5) to communicate their works to the public by wireless or landline means, electronic information networks or other technical means; and (6) to lease the original or copies of cinematographic works and computer programs.

The scope of copyright related right protection includes rights of performers; rights of producers of audio/visual records; rights of broadcasting organizations. These rights comprise of the right to directly copy; the right to indirectly copy; and the right to transmit to the public.

**FAIR USE**

An individual or organization may use a published copyright work for “non-commercial purposes” without the permission of the author and without paying royalties provided such use does not adversely affect the normal exploitation of the work and does not cause any detriment to the author’s enjoyment of copyright in the work. The author’s name and the origin of the work must, however, be mentioned.

“Non-commercial purposes” are defined to include the following acts:

- Making one copy of the work of an author for scientific research or teaching purposes;
- Reasonable quoting from a work in order to comment on or illustrate one’s own works, without misrepresenting the author’s views;
- Quoting from a work in order to write an article published in a newspaper or periodical, in a radio or television broadcast or in a documentary, without misrepresenting the author’s views;
- Quoting from a work in school or university for lecturing purposes without misrepresenting the author’s views and not for commercial purposes;
- Copying of a work by a library for archival and research purposes;
- Performing a stage work or other art work in mass cultural, communication or mobilization activities without collecting fees in any form;
- Audio-visual recording of a performance in order to report current events or for teaching purposes;
- Photographing or televising plastic art; or an architectural, photographic, or applied art work displayed at a public place in order to present images of such work;
- Transcribing a work into braille or into characters of other languages for the blind;
- Importing copies of another’s work for personal use.

However, such acts as copying architectural works, plastic works and computer programs shall are not considered to be used for non-commercial purposes.

As for related right exceptions, temporary copies of broadcasting organizations having the broadcasting rights are the specified time fixations made by the broadcasting organizations with their own devices and facilities to serve the subsequent broadcasts of the broadcasting organizations. In some special cases, those replicas shall be kept at official archives.
TERM OF PROTECTION

Economic rights in copyrighted works (and the moral right to publish or authorise others to publish the work) are protected for the life of the author plus fifty (50) years, except for cinematographic, photographic, stage as well as applied artworks and anonymous works which are protected for seventy five (75) years from the date of first publication. The IP Law also provides specific terms of protection for owners of "related rights" such as performers, producers of audio and visual fixations and broadcasting organisations.

COPYRIGHT REGISTRATION

Though registration of a work is not required for the work to be protected, registration provides proof of authorship or ownership. In order to register a work, an author or copyright owner must file an application for registration with the Vietnam Copyright Office ("VCO") which is based in Hanoi Capital City. The application must follow the form specified by the Ministry of Culture, Sports and Tourism and contain papers proving the authorship/ownership of the work, and pay a registration fee. In case the VCO approves the application for registration, the individual who or organization which holds the registration certificate for the work will be assumed to be the legal owner of the work in case any dispute regarding the ownership of the work arises.

CONTRACT FOR USE OF COPYRIGHTED WORKS

Any person or organization willing to use a work must enter a contract with the author or the copyright owner of that work, unless the use is for “non-commercial purposes” as mentioned above. A contract for use of a copyrighted work must include provisions which specify the following matters: how the work is to be used, the scope and duration of the use, the royalty fee and mode of payment, and the liability of the parties in the event of a breach, and other provisions as agreed upon between the parties. Such contract is not subject to registration to be legally effective.

INFRINGEMENT AND ENFORCEMENT

An author or owner of a copyrighted work has the right to claim for protection if any of the following acts is conducted in respect of that work without his/her consent and/or without paying royalties:

- Appropriating copyright in a literary, artistic or scientific work;
- Impersonating an author, publishing or distributing a work;
- Modifying, editing or distorting a work in any way which prejudices the honour and reputation of the author;
- Copying a work, making a derivative work, using a work, easing out a work, and publishing a work;
- Duplicating, producing copies of, distributing, displaying or communicating a work to the public via a communications network or digital means;
- Deliberately destroying or de-activating the technical solutions applied by the copyright holder to protect copyright in his or her work;
- Deliberately deleting or modifying electronic information in a work regarding management of the rights to such work;
- Manufacturing, assembling, transforming, distributing, importing, exporting, selling or leasing out equipment when knowing, or having grounds to know, that such equipment may de-activate technical solutions applied by the copyright holder to protect copyright in his or her work;
- Making and selling a work with a forged signature of the author of such work; and
- Importing, exporting or distributing copies of a work.

Where his/her copyrights are infringed, the author or owner of the work shall be entitled to demand the right to self protection, including the right to apply technological measures to prevent acts of infringement; the right request any organization or individual who commits an act of infringement to terminate such act, make a public apology or rectification, and pay damages; the right to request the competent State body to deal with acts of infringement; and the right to initiate a lawsuit at a court or a claim at an arbitration centre to claim for compensation.

ASSIGNMENT AND LICENSING OF INDUSTRIAL PROPERTY RIGHTS

GENERAL

Under the current rules, the assignment or license of an IP object shall be subject to certain conditions. As a pre-requisite, to assign or license an IP object in Vietnam, such object must be already protected in Vietnam,
i.e. it has been granted patents or certificates of registration. Those IP objects not yet registered in Vietnam cannot be assigned or licensed.

The scope of assignment/license can not be broader than that of protection granted under the respective patent or certificate. For example, for trademarks, the assignor can only assign the rights conferred by the certificate of registration, i.e. assignment is only possible for the trademark, exact goods and/or services claimed under the registration valid at the time of assignment.

The assignor or licensor must guarantee that he or she is the registered owner of the assigned/licensed object and that the assignment/license must not result in dispute with a third party. If dispute arises from the assignment/license of an IP object, the assignor/licensor shall be responsible for settlement.

Particularly, for appellations of origin, it should be noted that the rights to appellations of origin may not be assigned or licensed. In addition, the assignment/license of a trademark must not cause confusion in terms of properties or origin of goods and/or services bearing the trademark.

**ASSIGNMENT AND LICENSE AGREEMENTS**

Assignment or license agreements of IP objects must be made in writing, and contain prescribed statutory provisions applicable to each kind. Oral agreements, letters or telegrams shall not be accepted and have no legal effect. If the assignment or license of an IP objects is included in another agreement (such as technology transfer contract, service contract, etc.), it should be made in a part separate from the other parts.

The assignment or license agreement must include the followings:

- The identity of the parties (assignor and assignee, or licensor and licensee)
- The basis of the assignment/license (i.e. patent or certificate of registration granted and, in case of license, the exclusive license already granted to the licensor);
- The IP object(s) to be assigned, or in case of license, the scope of license granted including: kind of license (exclusive or non-exclusive), the IP object(s) to be licensed, license territory, license term (within the balance of protection term granted by the respective patent or certificate of registration);
- Assignment price or license royalty (it must be stated if the assignment/license is granted free of charge);
- The rights and obligations of the parties as stipulated;
- Conditions for amendment, termination or invalidation of the agreement;
- Dispute settlement;
- Signatory date and place;
- The signatures of the parties.

The current licensing rules mandate that the license agreement must not contain the following provisions which are considered as unreasonably restricting the rights of the licensee:

- Provisions prohibiting the licensee from improving the industrial property object other than marks; compelling the licensee to transfer free of charge to the licensor improvements of the industrial property object made by the licensee or the right of industrial property registration or industrial property rights to such improvements;
- Provisions directly or indirectly restricting the licensee from exporting goods produced or services provided under the industrial property object license contract to the territories where the licensor neither holds the respective industrial property right nor has the exclusive right to import such goods;
- Provisions compelling the licensee to buy all or a certain percentage of raw materials, components or equipment from the licensor or a third party designated by the licensor not for the purpose of ensuring the quality of goods produced or services provided by the licensee;
- Provisions prohibiting the licensee from complaining about or initiating lawsuits with regard to the validity of the industrial property rights or the licensor's right to license.

**RECORDAL OF ASSIGNMENT/LICENSE AGREEMENTS**

The registration with the NOIP is compulsory for all assignment agreements to make them legally effective and enforceable in Vietnam. The agreements take legal effect upon their recordal with the NOIP. For recordal of license, the current rules provides that a licensing agreements shall be valid as agreed upon by the parties involved but shall be legally effective as against a third party upon recordal only.

Any amendment of, extension or early termination of validity of a registered agreement shall be recorded at the NOIP. Validity of a licensing agreements shall be terminated ex-officio upon the termination of the licensor’s respective IPRs.
For both recordals of assignment and license agreements, the NOIP is the receiving office which in fact will consider the agreement for registration. As regards documents required to be submitted to the NOIP for recordal of assignment/license agreements, please see Filing Requirements in Vietnam.

The NOIP will examine the application as filed and issue a decision on recordal of the agreement or refuse registration, within 2 months from the date of receipt.

Royalties and Taxation

The royalties or price for assignment of IP objects will be agreed upon between the parties. However, where one of the parties to the assignment/license is a State organization or has part of its capital contributed by the State, the price shall not be lower than the minimum level if that party is the assignor/licensor, or not exceed the maximum level if that party is the assignee/licensee. The levels are determined by the Ministry of Finance and the MOST.

Under Circular No. 134/2008/TT-BTC dated 31 December 2008 guiding the tax regime applicable to foreign organizations without Vietnamese legal person status and foreign individuals doing business or earning incomes in Vietnam, the assignment/license of IP objects in Vietnam shall be subject to the royalty or withholding tax of 10 percent of the royalties paid.

Enforcement of Intellectual Property Rights

The procedures and remedies available for holders of intellectual property rights (IPR) to enforce their rights are amicable settlement, administrative measure, civil proceedings and criminal proceedings.

Amicable Settlement

If the infringement is not serious, amicable settlement is usually the best option against the adverse party(ies). A warning letter can be sent demanding that the infringer(s) cease its/their infringing acts and sign a written undertaking to this effect. If the undertaking is written in the form of a settlement agreement, it should be enforceable in court.

Administrative Measure

If amicable settlement fails, the infringement can be settled through administrative procedures. The IP holder may request various State agencies to apply administrative remedies and penalties to the infringement.

Being one of primary administrative remedies, raid is likely to be taken to deal with IP infringement at the request of the IPR holder, or of the entity suffering loss and damage thereof, or of any entity detecting the act of infringement or of a competent body which on its own initiative or routine inspection detected the infringement.

Depending on the nature and seriousness of the infringement, the authorities to be involved may include the Economic Police; Market Management Department; Specialized Inspectors; Customs; People’s Committees of various levels; or co-ordination amongst these competent bodies. Nevertheless, the role and power of these agencies are unclear and in many cases overlap, thus somewhat causing difficulties for enforcement in practice.

Civil Proceedings

Civil proceedings in court may be commenced to claim monetary damages resulting from the infringement. An injunction may also be obtained and the plaintiff has the burden of proof. However, this approach is time consuming, taking approximately two years to obtain a judgment. In the course of civil litigation, mandatory conciliation is required between the parties with the involvement of the presiding judge. Although a successful conciliation is deemed a valid court judgment/award which can be enforced, the inexperience and other weaknesses of Vietnamese judges in IP matters may affect the results of the conciliation.

Criminal Prosecution

IP infringement may also rise to the level of a criminal offence
Upon the raid result, if the infringement satisfies all requirements or constituents of an IPR criminal offence, the administrative to be involved in the raid action will automatically transfer the matter to the competent Economic Police for prosecution.

From the standpoint of authorization, the Economic Police is usually assigned to handle an infringement showing a token of criminal offence.

The token of criminal offence is defined to include (i) the infringer has been administratively sanctioned for the same infringement, (ii) or the infringer causes serious consequences (loss or damage which ranges from 50 to 500 million dong) or is administratively sanctioned. Without evidence of these, criminal prosecution is impossible.