

QUESTION 1

Allegations:

- XBC may refer to A B C M registered trademark certificate granted by IP authority
- Three YBCM's marks are so similar or confusingly similar that buyers may wrongly assume their originality or producer

The claims XBC raise against YBCM

- Civil, Administrative or Criminal remedies. and provisional injunctions

QUESTION 2

Defenses and allegations might be raised by YBCM:

- Is A B C M a well-known trademark?
- XBC unfaithfully registered this trademark in its country without YBCM's consent;
- May request for expert assessment
- How long has XBC not used this trademark
- It falls into circumstance sufficient to terminate the validity of registered trademark license ?

QUESTION 3

The court of my country shall consider the following:

-The protected trademark license is valid, invalidated or not effective.

-If the court accept that license of XBC is lawfully recognized and requests raised by YBCM are rejected

+ Shall determine if YBCM has infringing act against XBC's protected trademark.

+ The claims and injunctions raised by XBC shall be considered by the court,

QUESTION 3. Cont.

3.1. In order to determine the similarity among marks

- Request for expert assessment to verify if such similarity

3.2. Factors are taken into account

- The same category with products protected by IPR license

QUESTION 4

Infringement theories

Article 129: Trademark infringing act

- Using signs identical with a protected mark for goods or services with those in the list registered with the mark;
- Using signs identical with or similar to a well-known mark, or signs in the form of translation or transliteration of a well-known mark

QUESTION 4.Cont

-Using is likely to cause confusion as to the origin of the goods or services or wrong impression as to the relationship between the user of such signs and the well-known mark owner.

Damage theories:

Article 204: Principles of damage determination

- Physical and spiritual damages

-The level of damage shall be determined on the basis of the actual losses suffered

QUESTION 4. Cont

Article 203: Rights and burden of proof of involved parties

- The plaintiff shall prove that the intellectual property right holder
- The plaintiff shall produce evidence of the infringement of intellectual property rights

QUESTION 5

How to calculate damages

Article 205:

- The total physical damage determined in an amount of money plus the profits gained by the as a result of infringement ;
- Where it is impossible to determine the rate of compensation that rate shall be fixed by the court but not exceeding VND 500 million.

QUESTION 5.Cont

- **Spiritual damage, the rate of compensation ranging from VND 5 million to VND 50 million.**
- **To pay reasonable costs of hiring attorneys.**

QUESTION 6

If XBC only registers without using the trademark

-XBC sufficiently constituting unfaithful, unwillingly and abusive act of trademark registration

-When the license is not valid or terminated, XBC shall not have protected rights on the trademark and obviously have no right against the use of such mark.

QUESTION 7

- Firstly, the legality of application for trademark registration by XBC is the fact that XBC gets no consent from YBCM.
- Secondly, whether XBC's non-use of protected trademark for its products or no products containing such trademark produced in certain period of time can make the license invalid.
- Thirdly, it need to prove the confusing similarity basing on the conclusion of assessment experts.
- Fourthly, it shall prove that the plaintiff did not produce any goods in the same category, so that there is no damage incurred.

QUESTION 8

-Vietnam has amended and supplemented IPR as well as issued sub-law legislation protection of trademark to ensure that its regulation is similar and consistent with laws of developed countries and relevant international agreements.

-The use of trademark for goods and services gets high attention from enterprises, but Vietnamese enterprise do not pay much attention on trademark protection in comparison with those in other ASEAN countries.

-The registration of trademark shall be made in accordance with provisions in chapter VIII of IP Law.

THANK YOU