



International Journal of Multidisciplinary Research and Growth Evaluation.

Vietnam's intellectual property laws on the protection of trademarks

Dr. Le Thi Minh

Thu Dau Mot University, Vietnam

* Corresponding Author: **Dr. Le Thi Minh**

Article Info

ISSN (online): 2582-7138

Impact Factor: 5.307 (SJIF)

Volume: 05

Issue: 01

January-February 2024

Received: 06-01-2024;

Accepted: 08-02-2024

Page No: 912-918

Abstract

Completing legal regulations in the field of intellectual property in general and legal rules on intellectual property for trademarks, in particular, is one of the most critical stages in perfecting the intellectual property system, serving socio-economic development. This article explores Vietnamese legal regulations on protecting industrial property rights for trademarks. Thereby, the article analyzes and clarifies these regulations, learning specifically about their advantages and disadvantages as well as their limitations through assessing the inadequacies and limitations of current legal practice. The article can contribute solutions to perfect the current law on trademark protection, enhancing the effectiveness of protecting industrial property rights for trademarks.

DOI: <https://doi.org/10.54660/IJMRGE.2024.5.1.912-918>

Keywords: intellectual property, industrial property rights, trademark

1. Introduction

Nowadays, intellectual property plays an increasingly important role in the development of each country and is becoming a common concern of the world. Intellectual property promotes creativity and innovative technology, creating a healthy competitive environment, thereby promoting investment and technology transfer activities while actively and effectively supporting research - development, production, and business activities. In international integration, intellectual property has become one of the most critical issues, a direct content in international investment and trade agreements, including international trade and investment agreements that Vietnam has been, is, and will participate in negotiating and signing. This poses requirements for completing, amending, and supplementing legal regulations on intellectual property for trademarks in Vietnam.

2. Scope, objects, and research methods

This article focuses on researching theoretical and regulatory issues in protecting industrial property rights for trademarks under the Intellectual Property Law 2005, amended and supplemented in 2009, 2019, and 2022 (from now on referred to as Intellectual Property Law).

This article only focuses on researching current legal regulations on protecting industrial property rights for trademarks proposing recommendations and solutions to improve legal regulations on this issue.

The article is researched based on applying Marxist-Leninist views on the state and law, the guidelines, views, and orientations of the Communist Party of Vietnam, and the State of Vietnam's views on the construction and development of the market economy. The primary research method of the article is to analyze current legal regulations in Vietnam. In addition, the article also uses a technique combining theory and practice, using theory to interpret the provisions of the Intellectual Property Law.

3. Overview of trademarks and industrial property rights to trademarks

3.1. Overview of trademarks

3.1.1. Definition of trademarks

There are many different definitions of trademarks in the world, and the legal regulations of other countries specify the concept

of trademarks according to sure signs. Clause 1, Article 15 of the Agreement on Commercial Aspects of Intellectual Property Rights (TRIPS Agreement) stipulates that the concept of trademarks most generally covers issues related to trademarks, containing the nature and functions of trademarks, constituent elements, and protection conditions of a trademark.

The definition of trademarks in the TRIPS Agreement does not limit the types of signs that can constitute a trademark, only requiring that the signs forming a trademark must have a "distinctive capacity." With this definition, all signs recognizable by any sense, as long as they meet the standard of "distinctiveness," can constitute a trademark^[1].

The World Intellectual Property Organization's (WIPO) concept of trademarks is as follows: "A trademark is a sign capable of distinguishing goods or services from others." Any distinctive word, letter, number, drawing, image, shape, color, logo, mark, or combination thereof used to distinguish goods or services. WIPO's above definition stipulates the essential elements and nature of a trademark.

Thus, a trademark is a sign that distinguishes products and services produced or provided by different businesses. A brand is a factor in identifying and quickly conveying information to consumers, helping consumers make the right purchasing decisions based on expressions and signs related to products and services. The service is stored in their memory^[2].

Based on the spirit of signed international treaties, Vietnam has also concreted the trademark concept in Clause 16, Article 4 of the Intellectual Property Law: "A trademark is a sign used to distinguish goods, services of different organizations and individuals."

3.1.2. The role of trademarks

Trademarks distinguish goods and services of the same type. Consumers are constantly faced with choosing products of the same type, with similar shapes from different manufacturers. Consumers can recognize and distinguish these goods and services from others using trademarks. Since their inception, trademarks have been considered the most condensed and general form of providing consumers with information about products and services. A trademark is the first and easiest sign to help consumers distinguish goods and services^[1].

Trademarks provide information about the origin of products.

Although not a product, a trademark has excellent commercial significance because it is a tool to assure customers of the origin and quality of the product.³ Trademarks help consumers easily recognize products and services they have known and used from reputable manufacturers and suppliers whose quality and effectiveness they have placed their trust in. of those goods, products, and services. That shows the trademark's close connection with

the product's origin and manufacturer information, supplier and business, and business^[2].

- Trademarks ensure the quality of goods and services.

When a product is brought to the consumer market, its quality and reputation will be confirmed through the label. In essence, the actual value of a brand is the quality of products and services bearing that brand. To build consumer trust and support for the brand, brand owners must constantly progress, improve, and develop their products and services to meet their needs. When choosing a product through a reputable brand, consumers can be completely assured of the product's origin. Furthermore, they can also identify the entity responsible in case of a dispute^[3].

- The economic and advertising role of the brand.

Trademarks help promote the competitiveness of businesses because when a brand becomes popular and of interest in the market, it means that the products and services of that business have advantages in quality and price.^[4] To maintain the brand's position, reputation, and trust in the market, manufacturers must constantly improve and develop their products, services, and goods. Besides, manufacturers must continuously improve, innovate, and invest in technology, human resources, and labor to improve production, productivity, and quality, reduce product costs, and offer high-value products.

At the same time, trademarks also have an advertising role. A trademark can be considered a characteristic sign, an identifying sign of a business.^[54] A product of good quality, recognized for its quality and gaining the trust of many consumers. If produced by a reputable manufacturer, the brand is an advertisement for the product.

Nowadays, trademarks play an irreplaceable role in advertising, manufacturing, and product marketing industries. Manufacturer information is provided to consumers through trademarks, logos, and business slogans of manufacturers and service providers. Trademarks are one of the most valuable intellectual assets that are decisive to the success of a business, which is why trademark protection must be given top priority.

3.1.3. Trademarks classification

Trademarks can be classified according to different criteria such as classification by form of expression, classification by level of popularity, classification by the number of subjects of the brand, classification by nature and function. Some basic types of trademarks can be summarized as follows:

Trademarks for goods and trademarks for services.

A trademark is a sign that distinguishes the goods of different individuals and business organizations. Manufacturers can attach trademarks directly to their products or on goods packaging and business vehicles to advertise or distribute those products.

Service marks are signs used to distinguish services provided by different business entities; in other words, service marks

¹ Nguyen Linh (2023), "The phenomenon of trademarks becoming common names of goods and services," *Vietnam Journal of Science and Technology*, <https://vjst.vn/vn/tin-tuc/7395/current-tuong-nhan-hieu-tro-thanh-name-call-thong-thuong-cua-hang-hoa-dich-vu.aspx>, accessed February 18, 2024.

² Nguyen Ngoc Bao Tran (2023), "Conflict of rights between geographical indications and trademarks - Experience from practical cases," *Industry and Trade Magazine*, <https://tapchicongthuong.vn/bai-viet/xung-dot-quyen-giua-chi-dan-dia-ly-and-nhan-hieu-economic-nghiem-tu-vu-viec-thuc-tien-105473.htm>, accessed February 18, 2024.

³ Hoang Van Thanh (2018), "Factors affecting consumers' decisions to choose beer products in the Hanoi market," *Industry and Commerce*

Magazine, <https://tapchicongthuong.vn/bai-viet/cities-to-he-huong-den-dinh-lua-chon-san-pham-bia-cua-nguoi-use-tai-thi-truong-han-noi-53824.htm>, transcribed updated February 18, 2024.

⁴ Finance Magazine (2019), *Establishing ownership and brand management of Vietnamese businesses*, <https://tapchitaichinh.vn/xac-lap-quyen-so-huu-va-quan-tri-nhan-understanding-of-businesses-nghiep-viet-nam.html>, accessed February 18, 2024.

⁵ Nguyen Thi Thuy (2018) *Trademark protection under intellectual property law in Vietnam*, Master Thesis, Academy of Social Sciences, Internal Affairs Association, 10.

are determining signs for products and services provided by various businesses, such as insurance companies, car rental companies, and airlines. Businesses often attach service marks on business vehicles, such as tools, signs, and equipment used in service provision, helping consumers identify and find services when needed.

- *Collective trademark.*

Clause 17, Article 4 of the Intellectual Property Law stipulates, "A *collective mark* is a mark used to distinguish the goods and services of the members of the organization that is the owner of that mark from the goods and services of the organization." Accordingly, a collective trademark is usually the trademark of an association, cooperative, manufacturer, or corporation in which the collaborative organization develops standard regulations, and association members can use this trademark if they fully meet the requirements specified in the rules related to collective marks. The function of a collective mark is to provide the public with information about the specific characteristics of the product using the collective mark. Collective trademarks are considered an effective method to market a group of businesses' products jointly.

The characteristic of a collective mark is that many entities have the right to use it. However, it should also be noted that when a joint uses a trademark on behalf of the collective, it is not considered a collective trademark but will only be an ordinary trademark because it is only used by one subject.^[6]

- *Certification mark.*

Clause 18, Article 4 of the Intellectual Property Law stipulates that "A *certification mark* is a mark that the mark owner allows other organizations and individuals to use on the goods and services of that organization or individual to certify Recognize the characteristics of origin, raw materials, materials, method of producing goods, method of providing services, quality, accuracy, safety or other characteristics of the goods or services provided."

Accordingly, certification marks can only be used by specified standards. Certification marks are not used to distinguish the origin of products, goods, or services like regular trademarks. Still, certification marks help identify a brand that meets the owner's specific standards. The entity applying must have the authority to certify the relevant products. Certification marks and collective marks are different in that collective marks can only be used by members of that collaborative organization. In contrast, anyone can use certification marks with products or services that meet predetermined standards^[7].

- *Associated brands.*

Clause 19, Article 4 of the Intellectual Property Law stipulates that "Associated trademarks are registered by the same entity, identical or similar, used for products or services of the same or similar type or related to each other." Accordingly, the owner of the associated mark has the exclusive right to use a distinguishing sign for many types of goods and services. In addition, using related trademarks creates peace of mind for users of new products and services of the business because it is linked to products and services that have been known and appreciated by consumers.

- *Famous trademarks.*

The Paris Convention for the Protection of Industrial Property of 1883 was the first international treaty regulating well-known trademarks. This protection mechanism was later inherited in international treaties related to trademarks, such as the TRIPs Agreement.

According to Vietnamese law, Clause 20, Article 4 of the Intellectual Property Law stipulates, "A *famous trademark* is a trademark widely known to consumers throughout the territory of Vietnam." For a trademark to be considered a famous trademark, it must meet the criteria in Article 75 of the Intellectual Property Law as follows: The number of relevant consumers who know the trademark through purchasing, selling, and using the goods branded goods or services or advertising; Territorial scope in which goods and services bearing the mark have been circulated; Revenue from the sale of goods or provision of services running the trademark or the quantity of goods sold, the number of services provided; Time of continuous use of the brand; Wide reputation of goods and services bearing the mark; Number of countries protecting trademarks; The number of countries in which the trademark is recognized as famous; Transfer price, transfer price of use rights, investment capital contribution value of the brand. Famous trademarks are assets with high economic value for trademark owners when they have built a solid and reputable brand that is widely known. Therefore, well-known trademarks are protected under special regulations such that ownership rights are established regardless of registration procedures^[8].

3.2. Overview of industrial property rights to trademarks

3.2.1. Definition of industrial property rights to trademarks

Industrial property rights are civil rights in a broad sense often associated with production and business activities. The purpose of civil relations regarding industrial property rights is the economic benefits obtained from production and business activities using industrial property objects.

According to Vietnamese law, industrial property rights are stipulated in Clause 4, Article 4 of the Intellectual Property Law: "Industrial property rights are the rights of organizations and individuals to inventions, industrial designs, and designs. Semiconductor integrated circuit layout designs, trademarks, trade names, geographical indications, business secrets created or owned by them, and rights against unfair competition". Accordingly, the concept of industrial property rights to trademarks can be understood as the ownership rights of individuals and organizations to trademarks and the right to apply legal measures to prevent and handle violations due to unfair competition in registration activities and in the process of using trademarks.

3.2.2. Characteristics of industrial property rights for trademarks

Industrial property rights to trademarks have the following characteristics:

- Industrial property rights to trademarks associated with production and business activities. According to the provisions of Article 1 of the Paris Convention for the

⁶ Nguyen Thi Thuy (2018) *Trademark protection under intellectual property law in Vietnam*, Master Thesis, Academy of Social Sciences, Internal Affairs Association, 16–17.

⁷ Legal Journal (2021), *Distinguishing collective marks and geographical indications*, <https://phapluatbanquyen.phaply.vn/phan-biet-nhan-hieu-tap-the-va-chi-dan-dia-ly-a268.html/>, accessed February 18, 2024.

⁸ Ha Thi Nguyet Thu (2018), "Protection of intellectual property rights for trademarks in the market economy", *Vietnam Science Magazine*, <https://vjol.info.vn/index.php/LLCT/article/download/13388/12276/>, accessed February 18, 2024

Protection of Industrial Property, "*Industrial property must be understood in the broadest sense, not only applicable to industry and commerce in their own right but also to all manufacturing industries and natural products such as wine, grain, tobacco, fruit, mineral livestock, mineral water, beer, flowers, and flour,*" one of the conditions for trademark protection is to contain commercial directives, thereby connecting the manufacturer or service provider to the consumer. Establishing industrial property rights over trademarks is a prerequisite for businesses, manufacturers, or service providers to compete in today's market economy.

- Industrial property rights to trademarks arise under certain conditions. Industrial property rights for ordinary trademarks only occur when a competent state agency grants that trademark a Protection Title. The law will not protect industrial property rights for trademarks that have not registered industrial property rights.
- Industrial property rights to trademarks are limited in time. According to the provisions of Clause 6, Article 93 of the Intellectual Property Law, "*A trademark registration certificate is valid from the date of issue until the end of ten years from the date of application, can be renewed many times in a row, each time ten years.*" Thus, during that specified period, industrial property rights to the trademark will be protected according to the Protection Certificate issued by a competent state agency. Owners of industrial property rights to trademarks need to pay a fee to renew the validity of the Trademark Registration Certificate if they want to keep their trademark registration certificate valid.
- Industrial property rights to trademarks are limited in space.

Industrial property rights over trademarks are only valid within the territory of a country in which legal regulations recognize the arising of industrial property rights over a specific trademark. Industrial property rights to trademarks can only be established based on the country's law that has recognized protection, and this right is only valid within the government that acknowledges protection. Through this, it can be seen that industrial property rights over trademarks are thoroughly territorial^[9].

3.3. Overview of industrial property rights protection for trademarks

3.3.1. Definition of protecting industrial property rights for trademarks

A trademark is one of the valuable assets that is decisive for the success or failure of a business in fierce competition with its competitors. A brand results from investment and development, creating a company's value, reputation, and competitiveness. Besides, trademarks also help protect the rights of consumers, ensuring development, civilization, and order in society. However, illegal trademark-related acts are becoming increasingly diverse and complex, causing

negative consequences for manufacturers, consumers, and society.

Industrial property rights protection is understood as protecting intellectual products, rights, and legitimate interests of industrial property rights holders such as authors, protection title owners, and legal users of industrial property^[10].

Trademark protection is part of industrial property rights protection. Protection of industrial property rights for trademarks is understood as the state and the holder of industrial property rights for trademarks using legal tools to ensure trademark ownership rights are enforced while preventing and Handling any infringement of trademark rights. Protecting industrial property rights for trademarks is always a top concern in most countries worldwide, and Vietnam is no exception.

3.3.2. Content of industrial property rights protection for trademarks

Industrial property rights protection for trademarks includes three main contents:

First, the state promulgates legal regulations on the ownership of trademarks.

Second, the content of establishing rights: The competent authority grants trademark protection certificates to different subjects when their trademarks meet the prescribed requirements.

Third, content on rights protection: The State protects the legitimate rights and interests of industrial property rights holders over trademarks by applying different methods and measures.

4. Vietnam regulations on the protection of industrial property rights for trademarks

4.1. Conditions for Trademark Protection

Subjects of trademark protection are signs used to distinguish goods and services of different organizations and individuals. Regulations on signs that can be used as trademarks in countries worldwide have many significant differences. Recent trademark law accepts a more open definition of trademarks, which emphasizes the recognizable function of the trademark, not the trademark itself. In other words, any sign that performs the function of a trademark in distinguishing the goods or services of one undertaking from those of another based on the commercial origin of the goods can be registered as a trademark^[11].

Vietnamese law stipulates that signs protected as trademarks must be expressed in graphic form. Sound signs can be registered for trademark protection if they are described in visual form. Vietnamese law does not yet protect flavor trademarks.

According to the provisions of Article 72 of the Intellectual Property Law, a protected trademark must meet the following two conditions:

First, the sign must be visible, meaning people can only perceive them through visual abilities. At the same time, red trademarks exist in words, letters, images, drawings, and even three-dimensional images or combinations of such

⁹ Nhi Anh (2023), "New features of the Intellectual Property Law will promote innovation activities," *Vneconomy*, <https://vneconomy.vn/nhung-diem-moi-cua-luat-so-huu-tri-tue-se-thuc-day-hoat-dong-doi-moi-sang-tao.htm>, accessed February 18, 2024.

¹⁰ Nguyen Thi Thuy (2018) *Trademark protection under intellectual property law in Vietnam*, Master Thesis, Academy of Social Sciences, Internal Affairs Association, 16–17.

¹¹ National Office of Intellectual Property (2017), *Summary report on the topic Research on the theoretical basis and practice of sound and smell trademark protection*, Hanoi.

elements expressed in one or more colors. Sound signs may be protected if they can be expressed in graphic form.

Signs identical or confusingly similar to certification marks, inspection marks, or warranty marks of international organizations cannot be registered as trademarks unless the organization registers those marks as trademarks^[12].

Signs that mislead, confuse, or deceive consumers about the origin, features, uses, quality, value, or other characteristics of goods or services are also prohibited^[13].

Second, the sign must distinguish the goods, products, and services of the trademark owner from those of other entities. According to the provisions of Clause 1, Article 74 of the Intellectual Property Law, a trademark is considered distinctive if it is made up of one or several easily recognizable and memorable elements or from many elements combined into one. Clause 2, Article 74 of the Intellectual Property Law provides relatively detailed regulations on cases where signs are indistinguishable for trademark use.

Determining whether a trademark is distinctive depends on the perception of the relevant consumer. A trademark will be considered unique when it is recognized or capable of being recognized by relevant consumers who can identify the goods or services as coming from a separate entity^[14].

4.2. The basis for establishing industrial property rights over trademarks

Industrial property rights to trademarks are established based on the decision to grant a protection title by a competent state agency (Intellectual Property Office) according to the registration procedures prescribed in the Intellectual Property Law, or recognize international registration according to the provisions of international treaties to which Vietnam is a member. Particularly for famous trademarks, according to the requirements of Point A, Clause 3, Article 6 of the Intellectual Property Law, industrial property rights of well-known trademarks are established based on use and do not depend on registration procedures. A trademark is considered famous; even if it is not registered, the owner still has the right to prevent others from committing acts of copyright infringement.

In addition, according to the provisions of the Intellectual Property Law, Vietnamese individuals and organizations that have registered trademarks in Vietnam have the right to apply for trademark registration in member countries of the Madrid Agreement on International Registration. For trademarks of foreign entities registered for protection in Vietnam, according to the provisions of the Madrid Agreement on international registration of trademarks, industrial property rights to trademarks are established based on a decision. Accept protection or certificate of internationally registered trademark protected in Vietnam issued by the National Office of Intellectual Property at the trademark owner's request.

4.3. Procedures for establishing industrial property rights over trademarks

4.3.1. Right to register trademarks

¹² Tang Duc Khuong (2024), "Determining signs of "confusingly similar, likely to confuse" trademarks protected under Vietnamese intellectual property law," *Journal of Democracy and Law*, <https://tcdcl.moj.gov.vn/qt/tintuc/Pages/thi-hanh-phap-luat.aspx?ItemID=1028>, accessed February 18, 2024.

¹³ Tuong Vy (2022), "Trademarks and the importance of trademark protection for business activities of enterprises," *Industry and Trade Magazine*, <https://tapchiconghuong.vn/bai-viet/nhan- understanding-and-three-important-in-cua-how-to-manage-understanding-of-voi-hoat-dong->

The right to register a trademark is stipulated in Article 87 of the Intellectual Property Law, which lists subjects with the right to register a trademark. Accordingly, production entities and commercial entities have the right to register goods trademarks, service providers have the right to register service trademarks, collective organizations have the right to register collective trademarks, and collective organizations have the right to register collective trademarks. An organization that controls or certifies the quality, characteristics, origin, or other criteria related to goods or services can write a certification mark if it does not produce or trade those goods or services. In addition, Article 87 also stipulates the conditions for two or more individuals and organizations to jointly register to become co-owners of a trademark, the right to transfer registration rights of rights holders and conditions for individuals and organizations receiving transfer of registration rights.

4.3.2. Submit an application

The method of filing a trademark registration application is specified in Article 89 of the Intellectual Property Law. The only application-receiving agency is the Intellectual Property Office, which has 03 application-receiving points at Hanoi's Intellectual Property Office headquarters, the Representative Office in Ho Chi Minh City, and the Representative Office in Da Nang. Application methods include submitting the application directly or sending it by post to the application receiving point (headquarters of the Intellectual Property Office or 02 Representative Offices) or submitting the application online with the condition of having a digital certificate and digital signature and an account on the Online Application Receiving System.

4.4. Content of industrial property rights for trademarks

Article 123 of the Intellectual Property Law regulates the rights of the owner of industrial property objects, according to which the owner of industrial property rights to a trademark has the following fundamental rights:

- Right to use trademark

According to the provisions of Clause 5, Article 124 of the Intellectual Property Law, the right to use a trademark is the performance of acts of attaching a protected trademark to goods and services.

Trademark owners have the right to use the trademark in the way they want to bring certain benefits. Using a trademark is considered the most essential right of a trademark owner. The owner exploits the uses of the trademark by attaching the protected mark to goods, goods packaging, business means, service means, and transaction documents in business activities. This form is prevalent. Protected trademarks are attached to goods by businesses to help customers and consumers easily recognize and choose the products and services of that business. By exercising these rights, trademark owners can distinguish their goods and services from those of other companies^[15].

economics-business-cua-doanh-nghiep-101680.htm, accessed February 18, 2024.

¹⁴ Dam Thi Diem Hanh (2016), "The ability to distinguish trademarks through the process of use - comparison of Vietnam's trademark law with the laws of the European Union and the United States," *Journal of Procuracy Science*, 04, 49.

¹⁵ Luu Duc Anh (2016), *Scope of industrial property rights protection for trademarks under Vietnamese law*, Master's Thesis, Faculty of Law, Hanoi National University, Hanoi, 29.

The products and services of enterprises bearing the trademark can be brought to the market for circulation and sale, bringing economic and commercial benefits to the trademark owner. Trademark owners also have the right to advertise goods and services bearing the protected mark to sell those products. In addition, the owner also has the right to import goods and services bearing that protected mark. Thus, during the term of protection, the owner has the exclusive right to use the trademark in its production and business activities to enjoy its benefits. Everyone is obligated to respect and refrain from obstructing or infringing upon the trademark owner exercising their right to use.

- *The right to prevent others from using the trademark*

Clause 1, Article 125 of the Intellectual Property Law regulates the right to prevent others from using industrial property objects and trademarks. At the same time, Clause 2, Article 125 of the Intellectual Property Law stipulates exceptions—the trademark owner's right to prevent others from using their industrial property. Accordingly, products' circulation, import, and exploitation are legally brought to the market, including foreign markets, except for products not produced by the trademark owner or authorized person. Products lawfully put on the market, including foreign markets, are understood to be owned by the owner. This person has transferred the right to use, including the transfer of use rights under a mandatory decision, the person who has the right to use the trademark in advance on the domestic or foreign market. Once the trademark owner has placed the goods on the market, they will not have the right to prevent the circulation of goods in the course of commerce.

- *Right to dispose of trademarks:*

The trademark owner exercises the right to dispose of his trademark through the assignment or transfer of the right to use the trademark according to the provisions of the Intellectual Property Law. According to the requirements of the Intellectual Property Law, transfer of industrial property rights is the transfer of the owner of industrial property rights to another organization or individual and the transfer of the right to use the object of ownership. Industrial property means the owner changes the industrial property object to allow other organizations and individuals to use the industrial property object within the scope of their use rights.

The Intellectual Property Law regulates the transfer conditions for trademarks in Article 139 of the Intellectual Property Law. Transferring a trademark must not confuse the characteristics and origin of the goods or services bearing the mark. Rights to trademarks can only be transferred to organizations and individuals that meet the conditions for those with the right to register that trademark. Industrial property transfer contracts can be freely entered into. However, the Intellectual Property Law sets conditions that limit the transfer of industrial property rights to help ensure the rights and interests of rights holders and consumers.

Restrictions on transferring trademark use rights when concluding a contract are specified in Article 142 of the Intellectual Property Law. When entering into a contract to transfer use rights, the parties are bound as follows:

- + The right to use a collective mark may not be transferred to organizations or individuals not members of that cooperative mark owner.
- + The licensee is not allowed to sign a secondary contract with a third party unless permitted by the licensee.
- + The party licensed to use the trademark must write

instructions on the goods and packaging that the goods are produced according to the trademark use contract before transferring industrial property rights. When signing a transfer contract, each business needs to consider and choose the form of transfer of industrial property rights or transfer of trademark use rights based on its purpose and needs. In reality, in many cases, businesses have suffered unnecessary damages when transferring industrial property rights. Each form brings businesses certain benefits. However, companies need to consider limitations when entering into contracts.

5. Some recommendations to improve Vietnamese law on the protection of industrial property rights for trademarks

First, complete regulations on trademark registration rights. Regulations on trademark registration rights in Article 87 of the Intellectual Property Law on certification marks require research and amendments to be more appropriate or have specific instructions in the documents under the law; all issues related to This issue need to be unified in the understanding and application of the law among state management agencies, especially between the Ministry of Justice, the Ministry of Science and Technology and the People's Committees of provinces and centrally run cities to ensure the rights of producers of local specialties, and strengthen the protection of geographical indications in Vietnam. In addition, other problems regarding the right to register a collective trademark of the applicant as a "*cooperative group*" must be thoroughly researched to have specific instructions or amend relevant legal regulations and create an unambiguous legal basis for trademark registration subjects.

Second, improve the law to ensure complete and severe implementation of Vietnam's international commitments on intellectual property protection during the integration process.

Third, amend regulations on trademark protection subjects: Stipulates whether a separate sound trademark can be registered or a trademark that combines sounds with other signs (such as words and images) to form a composite trademark. Because sound trademarks are a new issue, yet to be practical in Vietnam, preparing facilities and human resources for appraisal requires time for functional operation, drawing on experience and protection policies appropriate to Vietnam's development level.

Article 4 of the Intellectual Property Law needs to define applicable trademarks to protect sound trademarks: "*A sound trademark is a trademark made up of sound elements used to distinguish goods, services of various organizations and individuals.*"

+ Termination of trademark registration due to misleading use:

To meet the obligations specified in Clause 3, Article 12.22, Chapter 12 on Intellectual Property of the Vietnam - EU Free Trade Agreement (EVFTA), we need to amend the Intellectual Property Law to supplement regulations on termination of trademark registration due to the use of a protected mark for goods or services by the trademark owner or a person authorized by the owner to mislead the public about the nature and quality of the trademark. The quantity or geographical origin of those goods or services in Clause 1, Article 95 of the Intellectual Property Law regulates cases where the protection title is invalidated.

+ Regulations on exporting or distributing/selling counterfeit trademark goods:

Criminal penalties for intentionally importing or exporting goods bearing counterfeit trademarks must be imposed to implement the commitment in Article 18.77.2 of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP). Counterfeiting or stealing copyright on a commercial scale, the author proposes to supplement regulations on the act of exporting or distributing/selling counterfeit trademark goods, which is also an act of infringement of intellectual property rights to the basis for criminal handling according to the provisions of Article 226 of the 2015 Penal Code amended and supplemented in 2017 through the amendment of Article 124 regulating the act of "*using a trademark*."

Besides, to ensure consistency with legal regulations on commerce, the term "*circulation*" at Point b, Clause 5, Article 124 should be changed to "*sale, display for sale, transportation*."

6. References

1. Dam Thi Diem Hanh. The ability to distinguish trademarks through the process of use - comparison of Vietnam's trademark law with the laws of the European Union and the United States. *Journal of Procuracy Science*. 2016; 4:49.
2. Finance Magazine. Establishing ownership and brand management of Vietnamese businesses. <https://tapchitaichinh.vn/xac-lap-quyen-so-huu-va-quan-tri-nhan-understanding-of-businesses-nghiep-viet-nam.html>. Published 2019. Accessed February 18, 2024.
3. Hoang Van Thanh. Factors affecting consumers' decisions to choose beer products in the Hanoi market. *Industry and Commerce Magazine*. <https://tapchicongthuong.vn/bai-viet/cities-to-he-huong-den-dinh-lua-chon-san-pham-bia-cua-nguoi-use-tai-thi-truong-han-noi-53824.htm>. Published 2018. Accessed February 18, 2024.
4. National Assembly of the Socialist Republic of Vietnam. Intellectual Property Law 2005, amended and supplemented in 2009, 2019 and 2022.
5. National Office of Intellectual Property. Summary report on the topic Research on the theoretical basis and practice of sound and smell trademark protection. Hanoi, 2017.
6. Nhi Anh. New features of the Intellectual Property Law will promote innovation activities. *Vneconomy*. <https://vneconomy.vn/nhung-diem-moi-cua-luat-so-huu-tri-tue-se-thuc-day-hoat-dong-doi-moi-sang-tao.htm>. Published 2023. Accessed February 18, 2024.
7. Legal Journal. Distinguishing collective marks and geographical indications. <https://phapluatbanquyen.phaply.vn/phan-biet-nhan-hieu-tap-the-va-chi-dan-dia-ly-a268.html/>. Published 2021. Accessed February 18, 2024.
8. Luu Duc Anh. Scope of industrial property rights protection for trademarks under Vietnamese law [Master's Thesis]. Hanoi National University, Hanoi; 2016, 29.
9. Nguyen Linh. The phenomenon of trademarks becoming common names of goods and services. *Vietnam Journal of Science and Technology*. <https://vjst.vn/vn/tin-tuc/7395/current-tuong-nhan-hieu-tro-thanh-name-call-thong-thuong-cua-hang-hoa--dich-vu.aspx>. Published 2023. Accessed February 18, 2024.
10. Nguyen Ngoc Bao Tran. Conflict of rights between geographical indications and trademarks - Experience from practical cases. *Industry and Trade Magazine*. <https://tapchicongthuong.vn/bai-viet/xung-dot-quyen-giua-chi-dan-dia-ly-and-nhan-hieu-economic-nghiem-tu-vu-viec-thuc-tien-105473.htm>. Published 2023. Accessed February 18, 2024.
11. Nguyen Thi Thuy. Trademark protection under intellectual property law in Vietnam [Master Thesis]. Academy of Social Sciences, Internal Affairs Association, 2018, 10.
12. Ha Thi Nguyet Thu. Protection of intellectual property rights for trademarks in the market economy. *Vietnam Science Magazine*. <https://vjol.info.vn/index.php/LLCT/article/download/13388/12276/>. Published 2018. Accessed February 18, 2024.
13. Tang Duc Khuong. Determining signs of "confusingly similar, likely to confuse" trademarks protected under Vietnamese intellectual property law. *Journal of Democracy and Law*. <https://tcdcp.l.moj.gov.vn/qt/tintuc/Pages/thi-hanh-phap-luat.aspx?ItemID=1028>. Published 2024. Accessed February 18, 2024.
14. Tuong Vy. Trademarks and the importance of trademark protection for business activities of enterprises. *Industry and Trade Magazine*. <https://tapchicongthuong.vn/bai-viet/nhan-understanding-and-three-important-in-cua-how-to-manage-understanding-of-voi-hoat-dong-economics-business-cua-doanh-nghiep-101680.htm>. Published 2022. Accessed February 18, 2024.