

Protecting sound marks in Vietnam

Vietnam has protected sound marks from fulfilling its commitment to the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (“**CPTPP**”). With the signing of the CPTPP Agreement, besides the protection of traditional trademarks as “visible signs,” Vietnam has accepted the protection of non-traditional trademarks “sound signs presented in the graphic form” from the date of entry into force of this Agreement – 14th January 2022, while this subject matter has not been recognized and protected under the current law at that time. With the promulgation of the Law Amending and Supplementing several Articles of the Intellectual Property Law in 2022 (“**Amended IP Law 2022**”), this commitment has been internalized, whereby the protection of sound marks is formally recognized in this act.

What is sound mark?

Intellectual Property Law 2005 introduced concepts of types of trademarks protected in Vietnam, such as collective marks, certification marks, associated marks or well-known marks. Sound marks are a new type of trademark protected under the amended IP Law 2022. Still, this Act does not introduce the concept of a sound mark but only recognizes the general condition protection of such mark, that is “sound sign presented in the graphic form.”

Conditions for protection of sound marks in Vietnam?

A sound mark is a type of trademark. Accordingly, regarding provisions of the amended IP Law 2022, to be protected as a trademark, a sound sign must also meet the protection conditions of a mark as follow:

- Sound signals must be present in graphic form.
- Not the national anthem of Vietnam and other countries, the international anthem (absolute grounds for refusal).
- Capable of distinguishing the goods and services of the trademark owner from those of other subjects (relative grounds for refusal).

How is the sound mark represented?

In the case of a traditional trademark, the document to identify a trademark is a sample of the mark presented in a “visible” form, which can be letters, words, drawings, images, holograms, or a combination of those elements represented by one or more colors. The document to identify the sound mark is an audio file and a graphic representation of that sound. It can be seen that the provisions on the requirements for trademark samples of the amended IP Law of 2022 have harmonized the traditional element of the general protection

condition for traditional marks as "visible" in the form of a "graphical representation of the sound" with a non-traditional characteristic of the type of sound mark that is the file containing the sound.

Issues

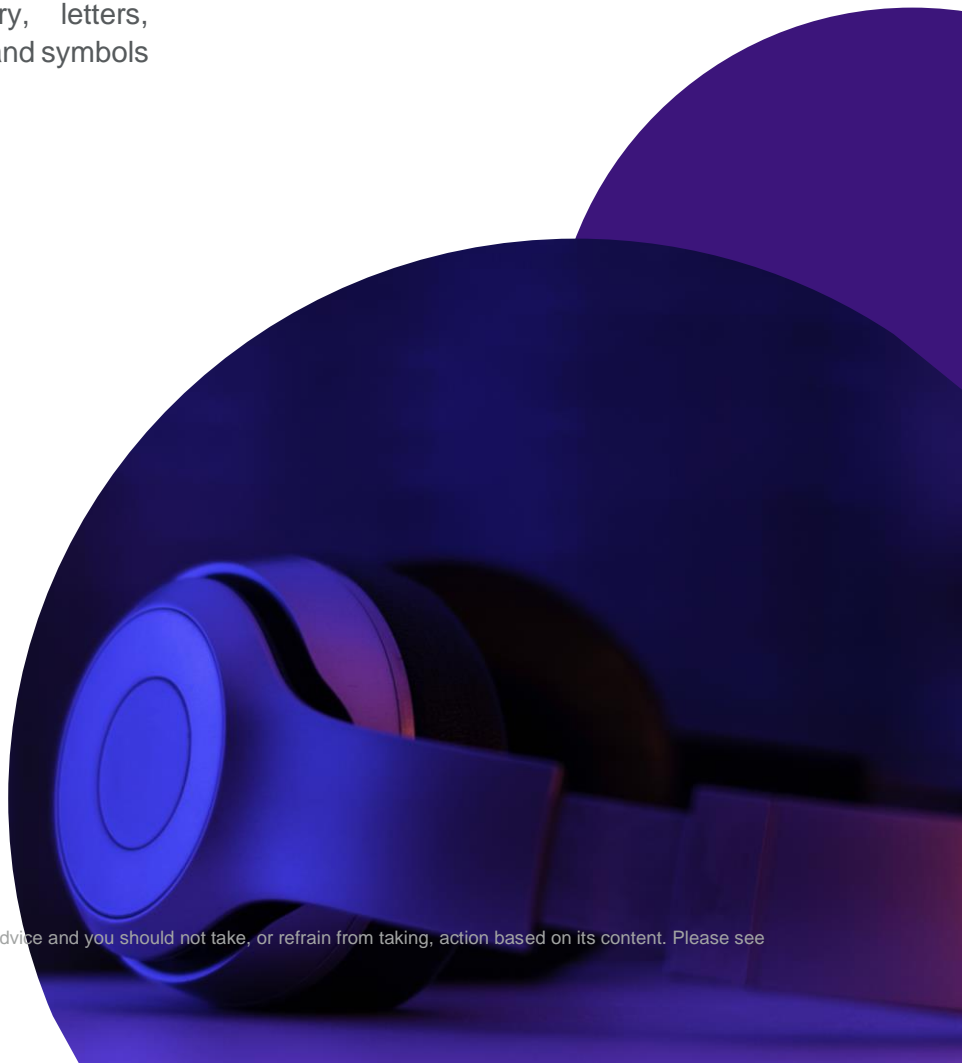
For a trademark, the requirement of distinctiveness is essential to ensure that the function of the mark indicates the origin of goods and services of different business and production entities and sound marks are no exception. The distinctiveness of a trademark manifests in two aspects: (i) the capacity of distinguishing itself, according to which the sound mark itself is not a functional sound of the product or the typical sound of people, animals, things, phenomenon; and (ii) distinctiveness of the trademark from any prior sound marks for the same goods or services.

Provisions on the assessment of distinctiveness of trademarks, stipulated in Article 74 of the Intellectual Property Law and Point 39 of Circular No. 01/2007/TT-BKHCN of the Ministry of Science and Technology that are amended and supplemented by Circular No. 16/2016/TT-BKHCN, are only applicable to traditional marks that are "visible" signs. For example, there are geometrical signs, simple geometry, letters, numbers, common names of products and symbols

indicating location, type, quantity, etc. Accordingly, these provisions cannot be applied to assess the distinctiveness of sound marks.

Particularly the assessment criteria of "the mark is identical or confusingly similar to a registered mark for identical or similar goods or services based on an application with the earlier filing date or priority date" is related to the database of sound marks as well as the specific criteria for assessing/examining the confusing similarity between those two signs. The database of sound marks and the legal provisions on examination criteria are two important tools to conclude whether there is a "cited mark" in the examination process of sound marks.

Therefore, the problem for Vietnam in the coming time in the protection for sound marks is to build a database of the sound marks (how to store, access and classify) and develop and train human resources of examiners on the sound marks. And it is essential that Vietnam issue detailed guidance legal documents on this problem as soon as possible to enforce the provisions on sound mark protection in the CPTPP Agreement and the amended IP Law 2022.



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