Vietnam Joins the Hague System: What’s New in the Protection of Industrial Design?

South-East Asia IPR SME Helpdesk
27 November 2019
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Moderator:

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Agenda

1. Overview of Vietnam, IP Law and Treaty Membership

2. Protection of Industrial Designs in Vietnam
   - Conditions for protection
   - Options for protection
   - Registration procedures and protection
   - Project of amendment of IP Law to comply with International standards


4. Watch-out and Tips

5. Q&A
Speaker’s Bio

Name: Son Doan  
Firm: IPMAX Law Firm  
Location: Hanoi, Vietnam

Son Doan is the Founder and Managing Partner of IPMAX Law Firm with more than 22 years of experience practicing Intellectual Property Law in Vietnam. Son has extensive experiences in handling various contentious and non-contentious matters, from securing protection and licensing to enforcement of intellectual property rights in Vietnam, including patents, trademarks, industrial designs and copyrights. He has also assisted multinational corporations in devising enforcement strategies and organizing nationwide enforcement programs. He has been continuously ranked as one of the leading individuals in WTR 1000, Chambers Asia Pacific, Legal 500 etc.

Son received a Master’s Degree in Intellectual Property Law from the George Washington University Law School under the Fulbright scholarship. Son has joined the Helpdesk network since October 2013.
Overview of Vietnam

- Total area: Approx. 331,210 km²
- Length: 1,650 km
- Border countries: China (N), Laos (NW), Cambodia (SW)
- Population: Approx. 96.5 mill. (2019)
- Hanoi: Capital (IP Office)
  HCMC: Biggest commercial center
- Official language: Vietnamese. Also spoken French, English, Korean, Japanese and Chinese is getting more popular.
Overview of IP system

- Before 1954: IP legal system influenced by the French civil law (IP right is recognized as civil right)
- 1954 – 1975: South: IP system; North: No IP system
- After unification in 1975: no IP system until early 1980s – A number of IP regulations promulgated with technical support from the Soviet Union
- 1986: Doi Moi (Renovation) policy launched (transforming the country from a centrally planned to a free market economy)
- The 150th member of WTO in 2007 (applied in 1995).

Multilateral Treaties:
- Paris Convention (March 8, 1949)
- Patent Cooperation Treaty (March 10, 1993)
- Madrid Agreement (March 8, 1949) and Protocol (July 11, 2006)
- Berne Convention (October 26, 2004)
- Hague Agreement Concerning the International Registration of Industrial Designs (December 30, 2019)

Recent Free Trade Agreements:
- CPTPP (entered in force in Vietnam on 14 January 2019)
- EVFTA (signed on June 30, 2019, expected to be approved by EU Parliament beginning 2020)
Vietnam
Industrial Design Protection
Vietnam - Industrial Design Protection

- **Appearance of a product** expressed in **dimensional configurations, lines, colors** or a combination of them.
  - Absolutely new (worldwide)
  - Creative
  - Mass production (Can be used as a prototype for manufacturing on a commercial scale)
- Drawings and Photos are **not enough**. What you claim for protection must be **specified** in the **description**
- **Term** of protection: 5 years, renewable twice
If you have a registered design in Europe since 2015, can you register in Vietnam?

A. YES

B. NO
Vietnam - Industrial Design Protection

- **Appearance of a product →** must be visible when used

![Diagram of industrial design protection](image)
Vietnam - Industrial Design Protection

Novelty (worldwide):

Significantly differs from other industrial designs that are already disclosed by way of use or description in writing or in any other forms inside or outside the country prior to the filing date or the priority date, as applicable, of the industrial design registration application (Article 65 – IP Law)

Exception: Under the following circumstances, the design shall not be considered as losing novelty if application for the same is filed by the owner within 6 months from the date on which it is disclosed:

- It was published by another person without permission;
- It was published in the form of a scientific presentation by the person having the right to apply;
- It was exhibited at a national exhibition of Vietnam or an officially recognized Int exhibition by the person having the right to apply.
Vietnam - Industrial Design Protection

**Novelty (worldwide):**

Two industrial designs **shall not** be considered as **substantially different from each other** if they are only different in features which are not easily noticeable and memorable and which cannot serve to distinguish these industrial designs as whole.
Vietnam - Industrial Design Protection

Creativeness

An industrial design shall be considered as creative if it cannot be easily created by a person with ordinary skill in the art, on the basis of an industrial design already publicly disclosed before the filing date or the priority date, as applicable, of the industrial design registration application.
Vietnam - Industrial Design Protection

Creativeness

**Person with ordinary skill in the art has:**
- substantial special knowledge and skill in the field the industrial design is applied;
- sufficient information about designs which have been applied for manufacturing products in the respect field or used in the market

**Considered as being easily created**
- a design fully or partly imitates simple shapes such as square, circle or available objects in nature such as animals, plants, flowers
- if appearance of product is purely a collection of known design features
- known design features are purely arranged/combined with each other without any change, meaning that there is not any creation
Vietnam - Industrial Design Protection

Designs that are purely functional (attributable to technical characteristics or for a technical purpose) cannot be protected.
# CPTPP and EVFTA: What Needs To Be Done To Comply

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<tr>
<th>CPTPP</th>
<th>EVFTA</th>
<th>Vietnam</th>
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<td>Art. 12.55: protection for industrial designs: (a) embodied in a part of an article; or, alternatively, (b) having a particular regard, where appropriate, to a part of an article in the context of the article as a whole.</td>
<td>Art. 12.35.2: A design of a component part of a complex product shall only be considered to be new and original: (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and (b) to the extent that those visible features of the component part fulfill in themselves the requirements as to novelty and originality</td>
<td>No such disposition in Vietnam IP Law. Proposal to amend IP Law in order to include the dispositions of Article 12.35.2 of EVFTA.</td>
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Vietnam - Industrial Design Registration

Each application must ensure the **unity requirement** per Article 101.3 of IP Law:

- An industrial design of a product;
- More than one embodiments of an industrial design
- Industrial designs of a set of products
Vietnam - Industrial Design Registration

An industrial design of a product

- must be applied to a particular product (design feature(s) not attached to a product is not protected as industrial design

US Design Patent D543348
Vietnam - Industrial Design Registration

Part of product:
- can be assembled with each other to form a complete product which again can be disassembled (by any means);
- can be circulated independently
Vietnam - Industrial Design Registration

Unity requirement

• More than one embodiments (alternatives) of an industrial design
Vietnam - Industrial Design Registration

- A set of products
Industrial Design Registration

- Filed through agents.

- **Government fee from EUR 82-EUR 154** (depending on number of drawing and embodiments). Agent’s fee is from EUR 200 excluding fee for drafting specification (EUR 91).

- Need **clear drawings/photos** showing perspective views, front, back, rear, side, bottom views, top view, base view, closed, open, etc.

- Specification and claims.

- **Priority claim:**
  - In a country that is a member of Paris Convention/ Bilateral Agreement
  - The applicant is a citizen/legal entity of a country that is a member of Paris Convention/Bilateral Agreement
  - < 6 months
# Designs, Trademarks, Copyrights

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<th>Trademarks</th>
<th>Industrial Designs</th>
<th>Copyrights</th>
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| Should be highly distinctive (not popular shape of product or product container) and/or has acquired distinctiveness through use | • Novel to the world; and  
• Some creativeness, and eye-appeal | • Original works of authorship fixed in any tangible medium of expression  
• Some aesthetic value |

| Registration for 10 years, can be renewed indefinitely | Design Patent for 05 years, renewed twice (maximum 15 years) | Protected upon creation of work, for 75 years from publication (or 100 years if it has not been published within 25 years)  
Registration can be made with the Copyright Office. It is not required but will be helpful in enforcement. |

| Most enforceable | Enforceable, some difficulties | Enforcement is possible but less straightforward |
Case study

- SUNGAZ was applied in Nov 2000, granted design patent in Oct 2003;
- MISA BEAR obtained copyright registration in July 2002;
- In this particular case, Design Patent should prevail copyright registration
- However, BENGAY of Pfizer was granted design patent in 1994 (renewed in 1999)
Service supplier – Watch out

- **IP Clause:**
  - Rights of 3rd party
  - Ownership
  - Application
  - Improvement
  - Remuneration
  - Moral rights

- **Non-disclosure**
Service supplier – Watch out

Check service supplier’s contracts with employees/third parties to make sure that they include provisions regulating new IP rights, ownership of works/improvements made by employees, rights and obligations of employees as designers:

• Moral right of the designer may be problematic;

• Employee’s designers will be entitled to minimum rates of remuneration (unless otherwise provided):
  + 10% of revenue gained by patent owner from the use of the invention/industrial design/layout design;
  + 15% of total amount of money received by patent owner on each payment upon the granting of a license of the invention/industrial design/layout design.
Poll Question 2

Have you considered to register your industrial design in multiple countries?

A. YES
B. NO
International Design System: Vietnam Joins the Hague Agreement
Protecting a Design Overseas: The Hague System

• Centralized acquisition and maintenance of industrial design rights by filing a single international application for a single international registration with effect in one or more designated Contracting Parties

• Operates on a similar basis to the Madrid System (i.e. one application, in one language, paying one set of fees in one currency)

• Provides a practical business solution for registering designs in over 73 territories through filing one single international application.
The International Design System
The Hague Union

73 contracting parties
The Hague System: Going Global

- 73 contracting parties

- Recent major accessions: Korea (2014), Japan and USA (2015)

- ASEAN Countries: Singapore, Brunei, Cambodia and Vietnam
Vietnam Accession to Hague System


• Viet Nam is the 71st member of the Hague Union.

• The Hague Agreement will enter into force in Vietnam on December 30, 2019.
Independent Filings vs. Hague Route

### Direct/Paris Route

1. **Industrial designs**
2. **Industrial design applications**
3. **National/Regional IP Office(s)**
4. **Registrations**

### The Hague System

1. **Industrial designs**
2. **Industrial design application**
3. **International registration**
4. **International Designs Bulletin**
5. **National/Regional IP Office(s)**
Application procedure – National Route

- Filing of application
- Formality examination (1 month)
- Publication of valid applications (1 month)
- Substantive examination (7 months)
- Grant of or refusal to grant certificates of protection
- Official registration and publication (1 months)
Application procedure – Hague Route

Filing of application

International Phase: Formality Examination (6 months)

Publication of application in the International Designs Bulletin

National phase: Substantive Examination and or Opposition (6-12 months from the date of publication)

Protection (becomes definitive if no refusal is notified)

In the event of notification of a refusal, the holder has the same remedies as he would have if he had filed the application in question directly with the national Office concerned.
Main Features of the Hague System

**Simplicity**
The Hague System enables holders to obtain protection for their designs with a minimum of formality.

**Cost-effectiveness**
Payment of a single set of fees in one currency.

**Efficiency**
Considerable facilitation of the subsequent management of the registration.

**Flexibility**
Right holders have more opportunities in targeting national, regional or global markets.
## Advantages of the Hague System

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<th>Hague System (International route)</th>
<th>National/Regional route</th>
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<tr>
<td><strong>One</strong> application: one Office for filing, one set of drawings</td>
<td><strong>Many</strong> applications: many offices for filing, many sets of drawings</td>
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<tr>
<td><strong>One</strong> language</td>
<td><strong>Many</strong> languages</td>
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<td><strong>One</strong> currency</td>
<td><strong>Many</strong> currencies</td>
</tr>
<tr>
<td><strong>One</strong> international registration</td>
<td><strong>Many</strong> registrations</td>
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<td><strong>One</strong> renewal</td>
<td><strong>Many</strong> renewals</td>
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<tr>
<td><strong>One</strong> modification</td>
<td><strong>Many</strong> modifications</td>
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<tr>
<td>Certain time frame (will be protected if no refusal within 6 months from date of publication)</td>
<td>Uncertain time frame: Statutory time frame for substantive exam is 7 months from date of publication but may well be prolonged due to heavy workload</td>
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Disadvantages of the Hague System

• Must consider the laws and regulations of each designated country, in particular in regard to:
  – Filing requirements
  – Requirements regarding reproductions

• Unable to monitor the process of substantive examination at the National IP Office

• National applications refused by designated country will require local counsel

• May be more expensive if filing in one country only
  (direct filing in Vietnam CHF470-490 vs. Hague reg. designating Vietnam only: CHF504)
## Filing Requirements: Minimum Documents

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<tr>
<th>Vietnam</th>
<th>Hague System</th>
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<tr>
<td>• 02 Declaration for registration;</td>
<td>• International application on the relevant official form (form DM/1) or through the electronic filing (E-filing). One application may include up to 100 industrial designs in the same Class of Locarno Classification</td>
</tr>
<tr>
<td>- One application may only claim for one industrial design (or additional embodiments/ or industrial design of a set of products)</td>
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<tr>
<td>- Full names, address, citizenship of designer(s)</td>
<td></td>
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<tr>
<td>• 04 sets of photos or drawings of an industrial design.</td>
<td>• Reproductions of the industrial designs in the form of photographs and/or graphic representations of the industrial designs, or of the products which constitute the industrial designs.</td>
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<tr>
<td>- drawings must be presented with unbroken lines i.e. dotted or broken lines are not accepted</td>
<td>- Disclaimed part of the product must be indicated by means of dotted or broken lines or coloring</td>
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<tr>
<td>• Detailed description/ Claims</td>
<td></td>
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<td>• Power of Attorney to agent</td>
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Filing via Hague Route – TIP

Checking design Novelty using International Search Database
Filing via Hague Route – TIP

Checking design Novelty using International Search Database
Filing via Hague Route – TIP

• Checking conditions for protection in designating countries

• Countries of interest, Fee calculation

• Filing application forms, checking specific requirements by some contracting parties regarding application documents, information required, reproductions
Filing Application - Hague Route

Fee calculator: [https://www.wipo.int/hague/en/fees/calculator.jsp](https://www.wipo.int/hague/en/fees/calculator.jsp)
Filing Application - Hague Route

https://www.wipo.int/hague/en/forms/
Filing Application - Hague Route

E-filing: https://www3.wipo.int/login/en/hague/index.jsp
Watch outs and Tips

- Keep everything **confidential** until application is filed.
- IP Clause and Non-disclosure agreement.
- Confidential information can be leaked easily by casual conversation with family and friends. Your product design may be shown on Facebook.
- Consider options for protection/ registering your **packaging design** as trademark or industrial design.
- What are claimed for protection.
- **Monitor and watch**: On-site inspection, Market watching, Gazette watching.
Watch outs and Tips (Cont.)

- National applications must be filed through agents and must be filed asap
- Consider filing via **Hague route** if filing in more than one countries
- Check design novelty using Global Design Database, ASEAN DesignView, National IP Offices Databases
- Checking specific requirements by some contracting parties regarding application documents, information required, reproductions
- Monitor registrations, managing registrations, modifications and renewal using Hague e-services
Vietnam – Enforcement Of Design Rights

- **Cease & Desist letter:** Served to the infringer to request cessation of infringements, provision of undertaking, removal/destruction of infringing elements, etc.;

- **Administrative Raid action:** Carried out by Economic Police, Market Surveillance Agency, Inspectorate of Ministry of Science and Technology and other specialized inspectorates. This is most common route due to its quick and easy processes for authorities, but not strong enough;

- **Border Control:** Deployed at all sea ports, international airports, domestic Customs control points. Customs can implement measures against the import of infringing goods;

- **Civil litigation:** Courts are not generally used for infringement actions, at least not as a first step. The first hearing is opened within 3-4 months (or 6 months in complicated cases).
Thanks for your attention

Questions?
Thank you for your attention!
Stay connected!