

Did you know...?

Vietnam: The advantage of single class application in a multi-class system

Today, we discuss a case where a Germany company successfully overcame a citation raised against its Vietnam trademark application in Class 9, but risked the entire registration being refused because the application was a multi-class application.

The German company in question is in the business of producing and distributing eyewear, sunglasses, and protective helmets. This company applied to register its trademark, Brand "A", in Vietnam via the Madrid system. The trademark was applied for in several classes, including in Class 9 for the goods *"spectacles, sunglasses, spectacle cords, spectacle frames, spectacle cases, protective helmets, protective helmets for sportspersons, recorded sound storage media, recorded picture carriers, recorded audio-visual data carriers, recorded data carriers of many kinds, along with computer hardware and video games"*.

During examination, the trade mark application was refused registration as Brand A was considered to be confusingly similar to a prior national registration which was registered in Class 38 for services which included mobile phone services, message sending, and computer aided transmission of messages and images.

The NOIP examiner explained that the prior registration was cited against Brand A because the goods in Class 9 were very similar to the services listed in Class 38 of the prior trademark registration in Vietnam. Although only Class 9 of the trademark application for Brand X was being refused, the NOIP examiner had to refuse the entire application because it was a multi-class application.

To overcome the citation and to have the application proceed further, the German company decided to file an appeal and at the same time delete the relevant goods in Class 9 which were regarded as being similar to the Class 38 services of the earlier registered trademark. In doing so, the NOIP waived the citation and allowed this application to proceed further.

While we can agree that the German company played it smart in overcoming the citation by removing the root of the possible confusion, i.e. the similar goods in Class 9, they could have played it even smarter by:

1. conducting a trademark search prior to filing their application in Vietnam via the Madrid system; or
2. filing the trademark application in Vietnam nationally (instead of via the Madrid system) in separate classes, rather than multi-class. In doing so, the other classes would not have been refused or held back due to Class 9.



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Food for thought

A lot of brand owners tend to file trademark applications via the Madrid system or a multi-class application to save costs. While this is the smart approach sometimes, at other times, the brand owner may end up spending more money than anticipated.

IF a trademark search is done and the results reveal no major obstacles, then yes, the Madrid system or multi-class application might be the most sensible path to take. However, if a trademark search is not done, and there may be risks of citations, then the brand owner should consider filing their trademarks nationally as single class applications because this might be the more cost-effective choice in some countries, especially in Asia.