

# Enforcement

## An International Litigation Guide

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### VIETNAM

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This material is only intended to provide an introduction to and simplified profile of an area of this jurisdiction's trademark law and practice and has primarily been prepared for practitioners considering the merits of filing an opposition in this jurisdiction. This material does not take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of this jurisdiction such as might be provided by a local trademark attorney.

For more information about particular areas of practice, please see INTA's companion online publications: [International Opposition Guide](#), [Trademark Cancellations](#), [Practitioner's Guide to Madrid Agreement and the Madrid Protocol](#), [Global Portal](#).

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#### I. PRE-FILING REQUIREMENTS/DEMAND LETTERS

- Although it is not mandatory to send a demand letter before instituting proceedings in this jurisdiction, it is common to send such a letter. Sending a demand letter (cease and desist letter) to an infringer before taking a raid under administrative measures or bringing the case before a court under civil measures in Vietnam is quite dependent on the opinion/decision of the IP owners. Typically, for cases with relatively low amounts of damages caused by infringement and in cases where the infringement is not clear and obvious, the rights owner will wish to send a letter to the infringer before taking further legal action.
- It is neither mandatory nor common to attempt to settle with the other party before instituting infringement proceedings in this jurisdiction.
- It is neither mandatory nor common to engage in mediation or other alternative dispute resolution proceeding with the other party before instituting infringement proceedings in this jurisdiction.
- Before initiating an infringement proceeding, a party may take the following actions: It is advisable, but not required, that the IP owner obtain an assessment conclusion from the Vietnam Intellectual Property Research Institute (VIPRI) confirming the IP infringement of the infringer over the IP owner being protected in Vietnam. It is also advisable to verify that the infringer does not have any IP rights as to the goods/services containing IP infringement element(s).
- The name for such a letter is: in Vietnamese, "THƯ ĐỀ NGHỊ" hoặc "THƯ YÊU CẦU" (in English, a "demand letter" or "request letter").
- Such a letter should be sent at the following time:
  - after obtaining (i) evidence of trademark infringement and (ii) an assessment conclusion from the Vietnam Intellectual Property Research Institute (VIPRI) confirming the infringement; or
  - after obtaining evidence of trademark infringement.
- Such a letter can be sent by:
  - the owner of the mark;
  - a licensee;
  - an attorney for the owner of the mark;
  - an attorney for the licensee of the mark.
- Specific rules/customary practices applicable to such letters include:
  - the reasonableness of the demand;
  - allowing sufficient time for response.
- With regard to the form or content of the letter, the following details are commonly included:
  - identification of claimant;

- details of alleged rights infringed;
- identification of any trademark registrations owned by the objecting party;
- time for response;
- threat of legal action;
- request for undertaking, including obligation to pay contractual penalty for future infringement.
- The consequences of not following the particular rules/customary practices listed above when drafting the letter are: that the demand letter will not be strong or persuasive and it may not be effective.
- The length of time within which to allow the recipient to respond to the letter that is considered reasonable is: normally, two or three weeks from the signing date of the demand letter.
- The following factors are taken into consideration when determining the length of time that is considered reasonable: (i) the nature or complexity of the case; (ii) the time it takes to send the demand letter by registered post.
- The benefits of sending a demand letter before initiating infringement proceedings rather than immediately initiating proceedings without sending a demand letter include:
  - may help ascertain that infringement was inadvertent;
  - may help ascertain that alleged infringer is impecunious and not worth suing;
  - may help ascertain whether alleged infringer has meritorious defenses;
  - results may be achieved more quickly and at lower cost;
  - may provide a basis for a claim of willful infringement;
  - may be viewed favorably in litigation by decision maker;
  - may lead to negotiations and avoid the need to commence proceedings;
  - results may be achieved more effectively, immediately and at lower cost without carrying out the procedure of enforcement of the court's verdict/decision.
- The potential consequences of sending such a letter include:
  - provides grounds for an action for declaration of invalidity or non-infringement;
  - the possibility of the recipient's initiating infringement proceedings based on alleged prior rights;
  - the possibility of the recipient's initiating proceedings for unjustifiable threat of infringement;
  - unlawful restraint;
  - destruction of evidence;
  - loss of the element of surprise, giving the infringer time and opportunity to prepare a defense;
  - the infringer may run away, or close or dissolve its company/business.
- Factors to consider if a demand letter is sent and proceedings for infringement are not initiated include:
  - claims for tortious interference or restraint of trade may arise;
  - loss of credibility in enforcement actions.

## **II. CLAIM FOR INFRINGEMENT OF A REGISTERED TRADEMARK**

- There is more than one court system or administrative body that has jurisdiction over claims for infringement of a registered trademark (see below). Besides civil courts, the Market Management Authorities, the Inspectorate of Ministry of Science and Technology, and Customs Offices of Vietnam have the right to handle trademark infringement activities in Vietnam. The Information and Communications Inspectors have the right to handle domain names that infringe registered trademarks.
- The court system or administrative body that most frequently hears claims for infringement of a registered trademark is: Administrative procedure and civil proceedings are both possible. For administrative measures, the Market Management Authorities, the Science and Technology Inspectors, the Customs Offices, and the Information and Communications Inspectors are competent authorities; for civil proceedings, the Civil Courts under People's Courts at the provincial level are competent authorities. More than 90 percent of IP infringement cases in Vietnam are handled by administrative procedures. The Market Management Authorities at the provincial level (of 63 provinces and cities of Vietnam) are the administrative bodies that handle more than 90 percent of trademark infringement cases under administrative procedures.
- The other court system or administrative body that can also hear claims for infringement of a registered trademark is: Besides civil courts, the Market Management Authorities, the Science and Technology Inspectorates and the Customs Offices have the right to handle trademark infringement activities in Vietnam. The Information and Communications Inspectors of the Ministry of Information and Communications have the right to handle domain names that infringe registered trademarks.

- The following factors determine which court or administrative body can hear a case:
  - place of alleged infringement (Under the IP regulations of Vietnam, for legal action to be taken against a trademark infringer, the alleged trademark infringement must occur within the scope of the territory of Vietnam.);
  - residence of defendant (Residence or address of defendant is a compulsory condition for bringing a case before a court under civil proceedings of Vietnam. Without the address of the defendant, the correct court to hear a trademark infringement case cannot be determined.).
- The following parties have standing/authority to institute proceedings for infringement of a registered trademark:
  - the registered proprietor of a mark;
  - an exclusive licensee (accepted by the Market Management Authorities and the Inspectorate of Ministry of Science and Technology of Vietnam under administrative procedure only).
- If there is more than one registered proprietor/owner, they must all join in instituting the proceedings.
- Trademark infringement is determined by: At the first instance hearing, trademark infringement is determined by a judge and a committee of two People's Jurors. At the appeal hearing, trademark infringement is determined by three judges.

"People's Jurors" are elected by the People's Committee at the same level as the People's Court (at the district or provincial level) based on the recommendation of the Vietnamese Fatherland Front Committee (at the same level as the People's Committee). A person who meets the required criteria can be elected as a People's Juror. The term of office of a People's Juror is five years (according to the term of the People's Committee, which elects the People's Juror). At the trial, in principle, a People's Juror has rights equal to a judge's. However, in practice, a judge will hold decision at a trial, since the opinion of People's Jurors normally follows the judge's opinion/decision.

- The time limit for initiating trademark infringement proceedings is: three years from the date that the trademark owner is aware of or realizes that its trademark rights have been infringed by a third party (under Article 588 of the Civil Code).
- Once infringement proceedings are initiated, the stages of the proceedings include:
  - filing of claim (including presentation of facts and legal arguments);
  - filing of reply/defense to claim;
  - filing of counterclaim;
  - filing of evidence (filing additional evidence or filing additional claims for damages, or filing change of claims for damages);
  - mediation;
  - expert discovery;
  - dispositive motions;
  - filing of briefs/written arguments;
  - oral hearing;
  - oral testimony/examination of witness (the court may require an expert witness, if necessary);
  - trial;
  - judgment/decision;
  - hearing to determine appropriate remedies;
  - damages (or other financial relief) assessment.
- The average amount of time from the instituting of infringement proceedings through the trial/final hearing is:
  - between one and two years.
- The average amount of time from the end of the trial/final hearing to the issuance of judgment is:
  - between one and two weeks.

### **III. CLAIM FOR INFRINGEMENT OF AN UNREGISTERED TRADEMARK/UNFAIR COMPETITION/PASSING OFF**

- Unregistered trademarks are not protected in this jurisdiction.

### **IV. CIVIL ENFORCEMENT-- EMERGENCY MEASURES**

#### **A. Ex Parte Injunctions**

- Ex parte injunctions are available to claimants seeking emergency relief.

- When applying for an ex parte injunction, it is necessary to institute infringement proceedings at the same time.
- The types of ex parte injunction available include:
  - prohibitory (to prohibit the defendant from performing certain acts);
  - mandatory (to require the defendant to perform certain acts);
  - freezing a bank account;
  - freezing the assets of the defendant individual/organization;
  - prohibiting the defendant from leaving the country;
  - temporarily suspending putting in a bid (joining a bid) and other activities relating to bids by the defendant;
  - temporarily seizing the defendant's airplanes or ships to ensure the handling of the court case (under Article 114 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- There is no specified statutory or court-determined deadline for seeking an ex parte injunction. During the pendency of the litigation or at the time of instituting the proceedings, the plaintiff has the right to seek an ex parte injunction (under Article 111 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- A delay in applying for an ex parte injunction after becoming aware of the alleged infringing activities cannot prevent the applicant from obtaining the desired relief.
- The purpose of an ex parte injunction is:
  - to restrain further infringing activities until trial or a further hearing;
  - to prevent the consequences of an infringement or violation;
  - to obtain or preserve evidence;
  - to ensure the effectiveness of the eventual remedy;
  - to preserve the status quo;
  - to prevent irreparable injury;
  - to protect the public interest;
  - to ensure that the court's verdict/decision is effectively implemented/enforced thereafter.
- The strategic benefits of obtaining an ex parte injunction include:
  - it may put an end to the infringement and litigation quickly;
  - it may save costs;
  - putting the defendant at a strategic disadvantage at the beginning of the case;
  - obtaining or preserving evidence;
  - ensuring the availability of the requested remedy;
  - ensuring the availability of compensation for damages;
  - getting an assessment of the merits by the court;
  - reducing potential damage caused by infringement.
- The risks of seeking an ex parte injunction (if it is not granted) are:
  - increased costs of the proceedings;
  - early adverse determination;
  - potential for a damages claim under a bond or a cross-undertaking (i.e., an undertaking in damages);
  - resolution of potentially dispositive issues on an incomplete or not-well-developed record.
- An ex parte injunction remains in place:
  - until further order by the court or until a further order is made by the Committee of Judgment based on an application submitted by the defendant.
- The defendant is notified of the grant of an ex parte injunction:
  - by the court.
- The procedure for applying for an ex parte injunction includes the following:
  - motion (This is a required document (under Article 133.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).);
  - supporting documentary evidence (This is a required document (under Article 133.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).);
  - posting bond, cross-undertaking or other security:
    - freezing a bank account;
    - freezing the assets of the individual who has an obligation in the case;
    - temporarily suspending putting in a bid (joining a bid) and other activities relating to bids by the defendant;
    - temporarily seizing the defendant's airplanes or ships to ensure the handling of the court case.

The bond or deposit amount must be equal to the possible damage or loss that may be caused by the ex parte injunction, to protect the interest of the defendant

and to prevent the plaintiff from abusing this measure (under Article 136.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

- The amount of the bond or the cross-undertaking is determined based on:
  - the potential damage/losses to the defendant caused by an improvidently entered injunction (A bond or deposit amount must be equal to the possible damage or loss that may be caused by the ex parte injunction, to protect the interest of the defendant and to prevent the plaintiff from abusing this measure (under Article 136.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).);
  - the value or importance of the trademark (The Civil Procedure Code 2015 is silent on this matter; however, in practice, this matter may be considered when the Judge/Committee of Judgment issues an injunction.).
- The factors considered in the granting of an ex parte injunction are:
  - inadequacy of damages as a remedy;
  - whether the status quo should be preserved;
  - urgency (The purpose of granting an ex parte injunction is to temporarily solve the urgent needs of the involved person (plaintiff), to protect life, health and property/assets, to collect evidence and to preserve evidence, to preserve the status quo, to avoid damage that is irreparable, and to ensure the resolution of the case or the enforcement of the court's judgment/decision (under Article 111.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).);
  - defendant's ability to pay awarded damages.
- The following forms of evidence are admissible in support of an ex parte injunction application:
  - written witness statements;
  - oral testimony of witnesses;
  - documents;
  - affidavits
  - samples of infringing product(s);
  - original/certified copy of the assessment conclusion on the trademark infringement of the defendant issued by the Vietnam Intellectual Property Research Institute (VIPRI).
- If the court later finds that the ex parte injunction was granted in error, the applicant will be required to:
  - compensate the defendant for damages suffered from the injunction;
  - compensate the defendant pursuant to a cross-undertaking;
  - forfeit its bond, which is paid to the defendant.
- The cost of obtaining an ex parte injunction, including attorney fees and court costs (but not including the cost of a bond), is approximately:
  - between USD 10,000 and 50,000 or more. This is an estimated amount because, in principle, the bond or deposit amount for obtaining ex parte injunction must be equal to the possible damage or loss that may be caused by the ex parte injunction, to protect the interest of the defendant and to prevent the plaintiff from abusing this measure (under Article 136.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- The costs of an ex parte injunction are recoverable as follows: The fees spent on requesting an injunction can be recovered by the successful party.
- On average, an ex parte injunction is issued within the following time period (counting from the filing of the application to the issuance of the injunction):
  - between 2 and 10 days (under Article 133.2 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- In an ex parte proceeding, a party may not request an order to enter the premises of another party and to search for property/documents/items that may become evidence (i.e., a "search order" or "search and seizure order").
- In an ex parte proceeding, a party may request an order to freeze the assets of another party to prevent dissipation of the assets before conclusion of the proceedings (i.e., a "freezing order" or "freezing injunction").
- The grant of an ex parte injunction can be appealed.
- Appeal of a decision granting an ex parte injunction can be expedited. The Chief Judge of the court handling the case must consider and resolve the appeal or opposition against a decision by application, refusal, change or cancellation of the ex parte injunction within three working days from the date of receipt of the appeal or opposition.
- The denial of an ex parte injunction can be appealed. The Chief Judge of the court handling the case must consider and resolve the appeal or request/complaints by application, change, cancellation or non-application of the ex parte injunction within three working days from the date of receipt of the appeal or request/complaints (under Article 141.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

- Appeal of a decision denying an ex parte injunction can be expedited. The Chief Judge of the court handling the case must consider and resolve the appeal or request/complaints by application, change, cancellation or non-application of the ex parte injunction within three working days from the date of receipt of the appeal or request/complaints (under Article 141.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

## **B. Interim Inter Partes Injunctions**

- Interim inter partes injunctions are available to claimants seeking emergency relief.
- When applying for an interim inter partes injunction, it is necessary to institute infringement proceedings at the same time.
- The types of interim inter partes injunction available include:
  - prohibitory (to prohibit the defendant from performing certain acts);
  - mandatory (to require the defendant to perform certain acts);
  - freezing a bank account;
  - freezing the assets of the defendant individual/organization;
  - prohibiting the defendant from leaving the country;
  - temporarily suspending putting in a bid (joining a bid) and other activities relating to bids by the defendant;
  - temporarily seizing the defendant's airplanes or ships to ensure the handling of the court case (under Article 114 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- There is no specified deadline for seeking an interim inter partes injunction. During the time of handling of the case or at the time the proceedings are instituted, the plaintiff has the right to seek an /interim inter partes injunction (under Article 111 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- A delay in applying for an interim inter partes injunction cannot prevent the applicant from obtaining the desired relief.
- The purpose of an interim inter partes injunction is:
  - to restrain further infringing activities until trial or a further hearing;
  - to prevent the consequences of an infringement or violation;
  - to obtain or preserve evidence;
  - to ensure the effectiveness of the eventual remedy;
  - to preserve the status quo;
  - to prevent irreparable injury;
  - to protect the public interest;
  - to ensure that the court's verdict/decision is effectively implemented/enforced thereafter.
- The strategic benefits of obtaining an interim inter partes injunction include:
  - it may put an end to the infringement and litigation quickly;
  - it may save costs;
  - putting the defendant at a strategic disadvantage at the beginning of the case;
  - ensuring the availability of the requested remedy;
  - ensuring the availability of compensation for damages;
  - getting an assessment of the merits by the court;
  - reducing potential damage caused by infringement.
- The risks of seeking an interim inter partes injunction (if it is not granted) are:
  - increased costs of the proceedings;
  - potential for a damages claim under a bond or a cross-undertaking (i.e., an undertaking in damages).
- An interim inter partes injunction remains in place:
  - until a decision is made in the main proceedings.
  - until further order by the court.
- The procedure for applying for an interim inter partes injunction includes the following:
  - motion, with notice to all parties (This is a required document (under Article 133.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).);
  - supporting documentary evidence (This is a required document (under Article 133.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).);
  - posting bond, cross-undertaking or other security:
    - freezing a bank account;
    - freezing the assets of the individual who has an obligation in the case;
    - temporarily suspending putting in a bid (joining a bid) and other activities relating to bids by the defendant;
    - temporarily seizing the defendant's airplanes or ships to ensure the handling of

the court case.

The bond or deposit amount must be equal to the possible damage or loss that may be caused by the interim inter partes injunction, to protect the interest of the defendant and to prevent the plaintiff from abusing this measure (under Article 136.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

- The amount of the bond or cross-undertaking is determined based on:
  - the potential damage/losses to the defendant caused by an improvidently entered injunction (The bond or deposit amount must be equal to the possible damage or loss that may be caused by the interim inter partes injunction, to protect the interest of the defendant and to prevent the plaintiff from abusing this measure (under Article 136.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).).
- The factors considered in the granting of an interim inter partes injunction are:
  - whether the status quo should be preserved;
  - urgency;
  - timeliness with which plaintiff sought the injunction;
  - defendant's ability to pay awarded damages.

The purpose of granting an interim inter partes injunction is to temporarily solve the urgent needs of the involved person (plaintiff), to protect life, health and property/assets, to collect evidence and to preserve evidence, to preserve the status quo, to avoid damage that is irreparable, and to ensure the resolution of the case or the enforcement of the court's judgment/decision (under Article 111.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

- The following forms of evidence are admissible in support of an interim inter partes injunction application:
  - written witness statements;
  - oral testimony of witnesses;
  - documents;
  - affidavits;
  - samples of infringing product(s).
- If the court later finds that the interim inter partes injunction was granted in error, the applicant will be required to:
  - compensate the defendant for damages suffered from the injunction;
  - forfeit its bond, which is paid to the court;
  - forfeit its bond, which is paid to the defendant.
- The cost of obtaining an interim inter partes injunction, including attorney fees and court costs (but excluding the cost of a bond), is approximately:
  - between USD 10,000 and 50,000.
- The costs of an interim inter partes injunction are recoverable as follows: The plaintiff's fees spent on requesting an injunction can all be recovered.
- It takes approximately the following length of time to obtain an interim inter partes injunction (counting from the filing of the application to the issuance of the injunction):
  - less than 10 days.
- In an interim inter partes proceeding, a party may not request an order to enter the premises of another party to search for property/documents/items that may become evidence (i.e., a "search order" or "search and seizure order").
- In an interim inter partes proceeding, a party may request an order to freeze the assets of another party to prevent dissipation of the assets before conclusion of the proceedings (i.e., a "freezing order" or "freezing injunction").
- The determination on an application for an interim inter partes injunction cannot be made into a final decision on the merits (i.e., an interim inter partes injunction cannot be made permanent).
- The hearing on an interim inter partes injunction cannot be consolidated with the trial or final determination on the proceeding.
- The grant of an interim inter partes injunction can always be appealed without waiting for final disposition of the case. The Chief Judge of the court handling the case must consider and resolve the appeal or opposition against a decision by application, refusal, change or cancellation of an interim inter partes injunction within three working days from the date of receipt of the appeal or opposition.
- Further appeal of the grant of an interim inter partes injunction is not available. The decision on settlement of the appeal or request/complaints by application, change, cancellation or non-application of an interim inter partes injunction of the Chief Judge is the final decision (under Article 141.2 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- Appeal of a decision granting an interim inter partes injunction can be expedited. The Chief Judge of the court handling the case must consider and resolve the appeal or request/complaints by application, change, cancellation or non-application of an

interim inter partes injunction within three working days from the date of receipt of the appeal or request/complaints (under Article 141.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

- The denial of an interim inter partes injunction can always be appealed without waiting for final disposition of the case. The Chief Judge of the court handling the case must consider and resolve the appeal or request/complaints by application, change, cancellation or non-application of an interim inter partes injunction within three working days from the date of receipt of the appeal or request/complaints (under Article 141.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).
- Further appeal of the denial of an interim inter partes injunction is not available.
- Appeal of a decision denying an interim inter partes injunction can be expedited. The Chief Judge of the court handling the case must consider and resolve the appeal or request/complaints by application, change, cancellation or non-application of an interim inter partes injunction within three working days from the date of receipt of the appeal or request/complaints (under Article 141.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

### **C. Standards for Obtaining Inter Partes and Ex Parte Injunctions**

- The standard for obtaining an interim inter partes injunction is the same as the standard for obtaining an ex parte injunction.

## **V. EARLY RESOLUTION OF LITIGATION**

### **A. Interim Applications Available for Ending Proceedings Early**

- A party can seek to end proceedings prior to trial or final determination by interim applications for:
  - summary judgment (judgment as a matter of law when facts are undisputed);
  - determination of preliminary issue by trial or hearing;
  - striking out or dismissing a party's case on the pleadings.

### **B. Summary Judgment**

- A party can conclude proceedings early by obtaining summary judgment in the following circumstances:
  - there are no material factual disputes;
  - there is no arguable case or defense (i.e., there is no reasonable prospect of the party's succeeding in the proceedings).
- Summary judgment can be requested by the following parties:
  - plaintiff;
  - defendant.
- The applicant for summary judgment must:
  - make an application to the court;
  - file a written statement containing the appropriate facts, argument and legal support;
  - file supporting documents or other evidence;
  - obtain permission of the court;
  - file a statement of undisputed facts.
- A ruling on a motion for summary judgment may always be appealed.
- A summary judgment may be appealed on the following grounds:
  - the court improperly resolved disputes about material facts;
  - the court made an error of law;
  - new evidence is found after the issuance of summary judgment.

### **C. Trial of Preliminary Issue**

- Proceedings cannot be expedited through an early trial or hearing on a preliminary issue. With the exception of an agreed settlement, there are no procedures to expedite a matter to an early trial. However, in very simple and straightforward cases, it may be possible to apply for a shortened summary procedure (under Article 317.1 of the Civil Procedure Code 2015, effective as of July 1, 2016).

## **VI. EVIDENCE**

- The following forms of evidence can be relied upon in support of a claim in trademark infringement proceedings in this jurisdiction:
  - documentary evidence (including samples/photos of allegedly infringing items);
  - expert evidence;



- oral testimony;
- survey evidence;
- assessment conclusion on trademark infringement issued by the Vietnam Intellectual Property Research Institute (VIPRI).
- The following forms of evidence can be relied upon in defense of a claim in trademark infringement proceedings in this jurisdiction:
  - documentary evidence;
  - expert evidence;
  - oral testimony;
  - survey evidence.

Under Article 94 (sources of evidence) of the Civil Procedure Code 2015, evidence shall be collected from the following sources: (i) documents that are readable, audible, seen, in the form of electronic data; (ii) exhibits; (iii) testimony of the parties; (iv) testimony of witnesses; (v) assessment conclusions; (vi) written minutes that verify results on the spot; (vii) results of the valuation of assets, verification of assets; (viii) documents recording legal events, legal acts made by competent persons; (ix) notarized, certified documents; (x) other sources stipulated by law.

- A claimant must present or give notice of any evidence on which it will rely at a time set by the tribunal. Under Articles 96.1 and 96.4 of the Civil Procedure Code 2015, the parties (plaintiff and/or defendant and/or person who has related interests and obligation) have the right and obligation to submit documents and evidence to the court. The time limit for submission of documents and evidence is fixed by the assigned judge, but it shall not exceed the period of preparation for the trial of first instance procedures and time limit for the preparation of a civil settlement under the provisions of the Code.
- A defendant must present or give notice of any evidence on which it will rely at a time set by the tribunal. Under Articles 96.1 and 96.4 of the Civil Procedure Code 2015, the parties (plaintiff and/or defendant and/or person who has related interests and obligation) have the right and obligation to submit documents and evidence to the court. The time limit for submission of documents and evidence is fixed by the assigned judge, but it shall not exceed the period of preparation for the trial of first instance procedures and time limit for the preparation of a civil settlement under the provisions of the Code.
- A party to the proceedings may obtain information that is within the possession or control of another party to the proceedings:
  - at the request of the tribunal.

## VII. TRIAL/ORAL HEARING

- Evidence may be presented at the trial or oral hearing in the form of:
  - written witness statements (including, e.g., affidavits, depositions, or statutory declarations);
  - oral testimony of witnesses;
  - deposition;
  - documents;
  - surveys;
  - physical objects;
  - expert testimony.

Under Article 94 of the Civil Procedure Code 2015, evidence shall be collected from the following sources: (i) documents that are readable, audible, seen, in the form of electronic data; (ii) exhibits; (iii) testimony of the parties; (iv) testimony of the witnesses; (v) assessment conclusions; (vi) written minutes verifying results on the spot; (vii) results of the valuation of assets, verification of assets; (viii) documents recording legal events, legal acts made by competent persons; (ix) notarized, certified documents; (x) other sources stipulated by law.

- It is possible to introduce surveys in evidence for the following issues:
  - secondary meaning/acquired distinctiveness;
  - whether a mark is famous or well known;
  - likelihood of confusion;
  - dilution;
  - genericness;
  - functionality.
- The use of survey evidence is subject to the following requirements: The order and procedure for carrying out a survey and the use of the survey as evidence must be accepted by the assigned judge before carrying out the survey. The parties (plaintiff and/or defendant) may request that the court carry out the survey.

- The length of an average trial or final hearing in a civil action for trademark infringement is: in practice, normally from one to three working days.
- The nature of the proceedings is:
  - adversarial, i.e., the proceedings are driven by the parties and their representatives (e.g., the litigants control and present evidence) and the decision maker plays a relatively passive role.
- A trial or final hearing includes the following:
  - opening statements by counsel for each party;
  - plaintiff's case through examination of witnesses by plaintiff;
  - defendant's case through examination of witnesses by defendant;
  - plaintiff's case through examination of witnesses by judge;
  - defendant's case through examination of witnesses by judge;
  - plaintiff's rebuttal case;
  - cross-examination of witnesses by parties;
  - closing argument by counsel for each party.
- Witnesses are examined by:
  - the judge;
  - the lawyers.
- As part of trial preparation, the parties do the following:
  - provide draft findings and conclusions if the proceeding is to be decided by a judge;
  - provide a skeleton/outline of argument;
  - submit marked exhibits;
  - provide stipulations of fact;
  - stipulate as to the authenticity of the documents;
  - identify trial witnesses;
  - consider possibility for settlement;
  - attempt to mediate the dispute.

#### **VIII. JUDGMENT/FINAL ORDERS**

- It takes approximately the following amount of time for a decision to be handed down after trial or final hearing: Normally, it takes about seven days/one week for a decision to be handed down after the trial.
- The decision may be appealed within the following time frame: Under Article 273.1 of the Civil Procedure Code 2015, the time limit for appeal against the judgment of the court of first instance is 15 days from the date of judgment.
- Appealing a decision is of right; no permission is needed.
- There is only one court to which an initial appeal can be made, which is: The appeal must be submitted to the court of first instance that has conducted the trial within 15 days from the date of judgment.
- The appeal court reviews:
  - both the facts of the case and legal issues. The Court of Appeal shall review only part of the first instance verdict/judgment or the decision of the court of first instance that has been appealed (under Article 293 of the Civil Procedure Code 2015, effective as of July 1, 2016). The content (scope) of appeal may be the facts of the case or legal issues or both the facts of the case and legal issues.
- Further appeal is possible to the following court:
  - The Judges' Committee of the People's High Court (shall reconsider the legally effective judgments or decisions of the provincial-level people's courts or district-level People's Courts according to their competence within the protested territory);
  - The Judges' Council of the Supreme People's Court (shall reconsider the legally effective judgments or decisions of the People's High Courts).
- Further appeal is granted as a matter of right; no permission is needed.

#### **IX. POST-JUDGMENT MATTERS**

- A defendant has the following length of time to comply with an order issued in a judgment: The period of time to comply will be specified in the judgment, as per Article 483 of the Civil Procedure Code 2015.
- A judgment may be enforced by way of the following proceeding(s): A plaintiff who wins a case must file a request for enforcement of the judgment to a competent civil enforcement authority within five years from the effective date of the judgment under civil enforcement procedures.

#### **X. COSTS OF LITIGATION**

## A. General

- The types of costs that may be recovered by the prevailing party during/after legal proceedings include:
  - attorney fees;
  - court fees;
  - bond or security for costs.
- A range for the all-inclusive cost of a typical action for trademark infringement from the filing of the claim through the trial is as follows:
  - less than USD 20,000.
- The successful party in a trademark infringement claim can expect to recover a portion of the attorney fees incurred (as distinguished from damages awarded). See below.
- The average percentage of attorney fees incurred in a trademark infringement claim that a successful party can expect to recover is:
  - 50 percent. Only those attorney fees that are considered as reasonable and accepted by the court can be recovered.
- Attorney fees are assessed using the following method(s):
  - proof of attorney fees actually paid by the prevailing party.

## B. Security for Costs

- When initiating proceedings, a plaintiff is not required to provide security for any costs that may eventually be awarded against it.
- A defendant is not required to provide security for costs after proceedings are initiated.

## XI. REMEDIES

- The following monetary remedies are available for trademark infringement:
  - accounting of defendant's profits and actual damages. See below.
- Actual damages are assessed using the following methods:
  - lost profits of plaintiff;
  - damages to plaintiff;
  - constructive license fee/reasonable royalty;
  - Under Articles 205.1 and 205.2 of the Law on Intellectual Property of Vietnam, the bases for determination of damages caused by IP infringement, including trademark infringement, are as follows:

"1. Where the plaintiff succeeds in proving that an infringement of intellectual property rights has caused physical damage to him or her, he or she shall have the right to request the court to determine the rate of compensation on one of the following bases:

- a) The total physical damage determined in an amount of money plus the profits gained by the defendant as a result of infringement if reduced profits of the plaintiff have not yet been included in the total physical damage;
- b) The value of the transfer of the right to use the intellectual property subject matter, with the presumption that the defendant was given the right by the plaintiff to use that intellectual property subject matter under an agreement to an extent equivalent to the act of infringement committed;
- c) Where it is impossible to determine the rate of compensation in accordance with subparagraphs a) and b) of this paragraph, that rate shall be fixed by the court depending on the loss level but not exceeding VND 500 million.

2. Where the plaintiff succeeds in proving that the infringement of intellectual property rights has caused spiritual/moral damage to him or her, he or she shall have the right to request the court to determine the rate of compensation ranging from VND 5 million to VND 50 million, depending on the level of damage." (This kind of damage includes loss to honor, dignity, prestige, reputation and other similar losses caused to the authors of literary, artistic and scientific works; to performers, authors of inventions, industrial designs, layout designs; and breeders (under Article 204.1.b of the Law on Intellectual Property of Vietnam). Only individual authors of IP rights (i.e., natural persons) can claim spiritual/moral damage. not legal entities, such as companies.)

- Where both damages and an accounting of profits are available and a party proves both, the party will receive both.
- Determination of the type and amount of remedy is part of the trial on liability.
- The following non-monetary remedies are available for trademark infringement (under Article 202 of the Law on Intellectual Property of Vietnam):
  - compelling termination of the trademark infringement acts;

- compelling the public apology and rectification;
- compelling the performance of civil obligations;
- compelling destruction or distribution or use for noncommercial purposes in respect of goods, materials and implements the predominant use of which has been in the creation or trading of trademark-right-infringing goods, provided that such distribution and use does not affect the exploitation of rights by the trademark holder.

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