

## ST25 and building up a protected trademark

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**ST25 rice - also known as Soc Trang fragrant rice, yielded from the ST25 rice variety - is the creative result of the hard researching process of agricultural engineer Ho Quang Cua and his team for the past 12 years.**



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The ST25 rice variety is the latest generation of the famous “ST” fragrant rice line with many outstanding qualities classified as “top class”. The quality of ST25 rice has been recognised internationally after being named “World’s Best Rice” at a contest of the same name in 2019 held in the Philippines; it also won second prize in the 2020 edition in the US.

The new rice variety ST25, created by Cua and his research team, was registered as a new plant variety under Decision No.45/QD-TT-VPBH issued by the Department of Crop Production at the Ministry of Agriculture and Rural Development in March last year.

Recently, it was reported that Cua’s ST25 rice was registered for trademark protection in the US by a number of American enterprises. The news spread widely and received a lot of attention from the public, with many fearing that it could lead to a risk of losing the trademark of ST25 rice, considered a national trademark. As a result they also fear it would

fall into American businesses’ hands, leading to the failure of Vietnamese enterprises to export this type of rice to the US market.

Based on a preliminary search result at the trademark published database of the National Office of Intellectual Property of Vietnam (NOIP), there are currently about 10 trademark applications containing the “ST25” mark that have been filed for rice products (Class 30). Among the found trademark applications containing the element ST25, there is not any application filed by the name of Ho Quang Cua, the creator of the ST25 rice variety as shown in the aforementioned March 2020 registration. These applications are now in the process of being substantively examined at the NOIP and no-one has been granted a trademark registration certificate up to now.

At the same time, from a preliminary search result at the published trademark database of the US Patent and Trademark Office (USPTO), there were currently five trademark applications containing the element ST25 that have been filed for trademark registration as to applied goods of rice (in Class 30) in 2020.



*ST25 rice*

## Legal issues

Currently, the ST25 rice variety has only been granted a plant variety protection certificate in Vietnam for Cua, co-creators Tran Tan Phuong and Nguyen Thi Thu Huong, and owner Ho Quang Tri Private Enterprise. Apart from the plant variety protection certificate in Vietnam, no trademark protection certificate has been issued for the trademarks containing ST25 as the name of the new rice variety in Vietnam for rice products in Class 30.

Because the Law on Intellectual Property of Vietnam (Article 163) stipulates the obligation to use the name of the variety stated in the plant variety protection certificate, organisations and individuals that offer for sale or market productive material of ST25 rice for planting must use the name ST25 rice as written in the protection certificate even after the expiration of the term of protection.

Therefore, “ST25 rice” is considered as a common name of the goods, just like the names of “Sticky rice/Gao nếp”, “Bac Huong rice”, and “Tam rice/Gao tam”. They are not able to register for a trademark according to Article 72.2.b of the Law on Intellectual Property. Therefore, in this particular case, no one, including Ho Quang Tri Private Enterprise, can have exclusive trademark protection of the name ST25 for rice products (in Class 30) in Vietnam.

Similarly, US trademark law also stipulates that a common name of the goods shall not be protected as a trademark for the applied goods because it does not have a distinctive function of a trademark.

According to the USPTO’s opinion, the goods are listed as rice, so the wording “RICE” in the mark merely denotes the nature of the goods and “ST25” refers to a particular strain or varietal of rice. Thus, “ST25 RICE”

denotes the goods. They are generic and cannot be registered as a trademark because they are common descriptive names of plants or seeds by which such varieties are known to the US consumer.

Hence, in the US, the element “ST25 rice” also does not meet the requirement for exclusive trademark protection because it does not have the required function of the trademark. Therefore, in principle, if the owner of the ST25 rice variety and other businesses trading in this product wish to protect the trademark, they need to design a new trademark, possibly by adding additional distinctive sign(s) with the current “ST25” mark, such as “ST25 Ho Quang Cua”, “ST25 Ho Quang Tri” or “Quang Minh ST25”.

## **Lessons for businesses**

Trademarks as well as other objects of intellectual property (IP) rights such as plant varieties are the IP of the individuals and businesses that created them, and can only be established on the basis of registration. Therefore, it is important to register for protection of IP rights as soon as possible.

Registration for protection of such rights for the purpose of establishing ownership is the most important step in building up a brand/trademark. Thus, registration for protection of IP rights must be the responsibility of business owners, not anyone else.

In order to avoid usurped trademarks or other intellectual property by a third party, business owners need to search and register for protection of their trademarks before bringing their products bearing the mark to domestic and foreign markets.

Finally, registration for protection of trademark and IP rights is the essential establishment of ownership rights to intangible assets, creating tools to protect market share and have an effective marketing tool to compete in markets, especially foreign ones.

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