

No. 11/2015/TT-BKHCH

Hanoi, June 26, 2015

CIRCULAR

**DETAILING AND GUIDING A NUMBER OF ARTICLES OF THE
GOVERNMENT'S DECREE NO. 99/2013/ND-CP OF AUGUST 29, 2013, ON
SANCTIONING OF ADMINISTRATIVE VIOLATIONS IN THE FIELD OF
INDUSTRIAL PROPERTY**

Pursuant to the 2012 Law on Handling of Administrative Violations;

Pursuant to the 2005 Intellectual Property Law; and the 2009 Law Amending and Supplementing a Number of Articles of the Intellectual Property Law (below referred to as the Intellectual Property Law);

Pursuant to the Government's Decree No. 81/2013/ND-CP of July 19, 2013, detailing a number of articles of and measures to implement the Law on Handling of Administrative Violations;

Pursuant to the Government's Decree No. 99/2013/ND-CP of August 29, 2013, on sanctioning of administrative violations in the field of industrial property;

Pursuant to the Government's Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding a number of articles of the Intellectual Property Law concerning industrial property; and Decree No. 122/2010/ND-CP of December 31, 2010, amending and supplementing a number of articles of Decree No. 103/2006/ND-CP (below referred to as revised Decree No. 103/2006/ND-CP);

Pursuant to the Government's Decree No. 105/2006/ND-CP of September 22, 2006, detailing and guiding a number of articles of the Intellectual Property Law concerning protection of intellectual property rights and state management of intellectual property; and Decree No. 119/2010/ND-CP of December 30, 2010, amending and supplementing a number of articles of Decree No. 105/2006/ND-CP (below referred to as revised Decree No. 105/2006/ND-CP);

Pursuant to the Government's Decree No. 20/2013/ND-CP of February 26, 2013, defining the functions, tasks, powers and organizational structure of the Ministry of Science and Technology;

At the proposal of the Chief Inspector and the Director of the Legal Department,

The Minister of Science and Technology details and guides a number of articles of the Government's Decree No. 99/2013/ND-CP of August 29, 2013, on sanctioning of administrative violations in the field of industrial property.

Chapter I

GENERAL PROVISIONS

Article 1. Scope of regulation and subjects of application

1. Scope of regulation:

This Circular details and guides a number of articles of the Government's Decree No. 99/2013/ND-CP of August 29, 2013, on sanctioning of administrative violations in the field of industrial property (below referred to as Decree No. 99/2013/ND-CP).

2. Subjects of application:

- a/ Organizations and individuals that commit administrative violations in the field of industrial property;
- b/ Organizations and individuals that are competent to sanction administrative violations in the field of industrial property;
- c/ Other subjects involved in the handling of administrative violations in the field of industrial property.

Article 2. Subjects to be sanctioned for administrative violations

1. Individuals that commit administrative violations in the field of industrial property, including:

- a/ Vietnamese citizens or foreigners;
- b/ Business households established and operating in accordance with the law on business registration.

2. Organizations that commit administrative violations in the field of industrial property, including:

a/ Public non-business units, political organizations, socio-political organizations, socio-political-professional organizations, social organizations, and socio-professional organizations;

b/ Economic organizations established in accordance with the Law on Enterprises, including private enterprises, joint-stock companies, limited liability companies and partnerships;

c/ Economic organizations established in accordance with the Law on Cooperatives, including cooperatives and unions of cooperatives;

d/ Economic organizations established in accordance with the Law on Investment;

dd/ Other lawfully established organizations.

Article 3. Additional sanctions

Confiscation of material evidence and means used for commission of administrative violations specified at Point a, Clause 2, Article 3, and Point a, Clause 12, Article 12, of Decree No. 99/2013/ND-CP, shall be applied to violations due to intentional fault when:

1. It is necessary to prevent material evidence and means used for commission of violations from being destroyed or dispersed or having their state changed, or to minimize the possibility of subsequent violations.

2. The goods cannot help identify the violators.

Article 4. Remedies

1. Remedies specified at Point a, Clause 3, Article 3 of Decree No. 99/2013/ND-CP shall be taken as follows:

a/ Forcible removal of infringing elements shall be applied to material evidence and means used for commission of violations which are products, goods, signboards, means of business, and transaction documents bearing signs of infringement upon industrial property rights or misleading trade indications.

One or more than one method, such as detachment, disassembly, cut-off, erasure, abrasion or other appropriate measures, may be used to remove infringing elements from material evidence and means used for commission of violations;

b/ Forcible change of information in domain name or return of domain name shall be applied to cases where the requester for infringement handling and the party requested to be handled for infringements cannot reach agreement under Clause 2, Article 27 of Decree No. 99/2013/ND-CP and the latter fails to terminate its act of registering, appropriating the domain name use right or using an infringing domain name;

c/ Forcible change of enterprise name or removal of infringing elements from enterprise name shall be applied to cases where the party requested to be handled for infringements fail to terminate its act of using an infringing enterprise name or fails to carry out procedures for changing an infringing enterprise name according to the notice of the business registry office or the agreement between the parties.

2. Forcible destruction of goods, material evidence and means used for commission of violations prescribed at Point d, Clause 3, Article 3 of Decree No. 99/2013/ND-CP shall be applied to:

a/ Goods bearing counterfeit marks or geographical indications; raw materials, materials and means used mainly for manufacture and trading of goods bearing counterfeit marks or geographical indications; stamps, labels and articles bearing counterfeit marks or geographical indications; stamps, labels and articles containing infringing elements;

b/ Goods which are no longer usable;

c/ Goods which are harmful to health of humans, livestock, plants and the environment;

d/ Goods from which infringing elements cannot be removed or from which the removal of infringing elements cannot lead to the thorough prevention of infringing acts or will render the application of other remedies impossible.

3. For infringing goods, raw materials, materials and means used mainly for manufacture of infringing goods, material evidence and means used for commission of violations, competent agencies shall base themselves on properties and characteristics of goods and specific circumstances and conditions of the cases to decide on appropriate handling measures after consulting rights holders,

requesters for infringement handling and the involved organizations and individuals.

After infringers remove infringing elements from goods, infringement handling agencies may:

a/ Allow infringers to use infringing goods, raw materials and materials as materials for manufacture of other goods or to distribute or use them for non-profit purposes without affecting rights holders' ability to exploit them, prioritizing humanitarian, charity or social service purposes; or,

b/ Auction infringing goods, raw materials and materials and pay proceeds into public funds or apply other measures as requested or agreed upon by the involved parties under Clause 4, Article 29 of revised Decree 105/2006/ND-CP.

4. Forcible payment of illicit profit amounts earned through the commission of administrative violations specified at Point h, Clause 3, Article 3 of Decree No. 99/2013/ND-CP shall be applied when there are valid invoices and documents proving that infringements were committed (stating the volume and value of infringing goods) and infringing goods were detected up to the time of inspection and examination.

Procedures for paying illicit profit amounts into the State Treasury are similar to those for paying fines under administrative sanctioning decisions. In case agencies with infringement handling competence have accounts for temporary collection opened at the State Treasury, these illicit profit amounts shall be paid into such accounts. Periodically, agencies with infringement handling competence shall remit such amounts into the State Treasury in accordance with law.

5. Violators shall bear all expenses for the application of the remedies under Article 85 of the Law on Handling of Administrative Violations.

Article 5. Valuation of infringing goods and services under Article 4 of Decree No. 99/2013/ND-CP

1. The total value of infringing goods and services at the time of commission of an administrative violation prescribed in Chapter II of Decree No. 99/2013/ND-CP shall be determined according to the following formula:

Total value of infringing goods and services is (=) the quantity of infringing goods or volume of infringing services multiplied by (x) the unit price of infringing goods or services at the time of commission of the administrative violation.

2. The valuation of infringing goods and services must comply with Clause 1, Article 4 of Decree No. 99/2013/ND-CP.

Where there are grounds to believe that listed prices or prices stated in contracts or sale and purchase invoices or import declarations specified at Point a, Clause 1, Article 4 of Decree No. 99/2013/ND-CP are untruthful, competent agencies shall apply the prices in the priority order prescribed at Points b and c, Clause 1, Article 4 of Decree No. 99/2013/ND-CP.

3. In case there are no grounds for application of Clause 2 of this Article, the competent person handling the case may issue a decision on temporary seizure of material evidence of infringements and set up a valuation council under Clause 3, Article 4 of Decree No. 99/2013/ND-CP.

4. In case at the time of inspection, no material evidence being infringing goods or services is detected to serve as a basis for determination of sanctions and sanctioning competence but there is evidence that some organization or individual has committed the infringement and the statute of limitations for sanctioning has not expired, the competent agency shall apply Clause 14, Article 11; Clause 11, Article 12; and Clause 14, Article 14, of Decree No. 99/2013/ND-CP for sanctioning the infringement.

Article 6. Determination of illicit profit amounts earned through the commission of administrative violations

1. Illicit profit amounts earned through the commission of administrative violations are benefits earned through committing such administrative violations, including:

a/ Money;

b/ Valuable papers;

c/ Other assets.

2. Determination of illicit monetary profit amounts:

a/ The monetary amount earned by a infringer through committing an administrative violation in the field of industrial property is (=) the quantity of goods or volume of services illegally transferred, sold, dispersed or destroyed multiplied by (x) the unit price.

The quantity of goods or volume of services provided shall be determined on the basis of declaration by the infringer and inspection and verification by the competent person.

The unit price shall be determined on the basis of dossiers and documents of the infringer or the market price of similar goods or services.

In case the quantity, volume and unit price cannot be determined, the illicit profit amount is total money amounts earned by the infringer from the infringement.

b/ In case of illegal transfer, sale, dispersal or destruction of banned, smuggled or counterfeit goods or provision of services subject to conditional business, the money amount earned by the infringer is (=) the quantity of goods or volume of services illegally transferred, sold, dispersed or destroyed multiplied by (x) the unit price.

c/ In addition to goods and services specified at Point b of this Clause, in case of illegal transfer, sale, dispersal or destruction of other goods or services, the money amount earned by the infringer is (=) the quantity of goods or volume of services illegally transferred, sold, dispersed or destroyed multiplied by (x) the unit price minus (-) direct costs of such goods or services (if the infringer has sufficient dossiers and documents to prove the legality and validity of such costs).

3. In case there are no grounds for determination of illicit monetary profit amounts under Clause 2 of this Article, illicit profit amounts shall be determined to be valuable papers or other assets.

Illicit profit amounts being valuable papers or other assets shall be determined under the the Ministry of Finance's guidance on illicit profit amounts earned through the commission of administrative violations for payment into the state budget.

Chapter II

INFRINGEMENTS SUBJECT TO ADMINISTRATIVE SANCTION

Section 1. INFRINGEMENTS OF REGULATIONS ON MANAGEMENT OF INDUSTRIAL PROPERTY ACTIVITIES

Article 7. Infringements of provisions on indications of industrial properly rights protection in Article 6 of Decree No. 99/2013/ND-CP

1. Act of false indication of legal status specified at Point b, Clause 1, Article 6 of Decree No. 99/2013/ND-CP shall be understood as the use of indicative information misleading that a subject enjoys the industrial property rights protection in Vietnam though he/she/it is not or has not been eligible for protection, including the case where he/she/it has filed a registration application but is not yet granted a protection title or his/her/its protection title has been revoked or invalidated, or the term of protection has expired, for example:

a/ Printing on his/her/its products, goods, goods packages, means of business or means of services an indication misleading that such products, goods or services bear protected marks, such as “mark registered for protection,” “protected mark,” “mark under exclusive right of...,” including the use of the symbol ® (indicating that a mark has been granted a mark registration certificate);

b/ Printing on his/her/its products, goods, product or goods packages an indication misleading that such products or goods are under patent or industrial design protection, such as “product/goods is under industrial design protection,” “product/goods is under patent,” “product is manufactured from the patented process of...,” including the use of the symbol “P” or the word “Patent” together with numbers (indicating that a product has been patented).

2. Act of false indication or failure to provide an indication of goods manufactured under an industrial property licensing contract under Point c, Clause 1, Article 6 of Decree No. 99/2013/ ND-CP shall be understood as:

a/ Act of false indication means an act of inscribing on goods the phrase “manufactured under the industrial property licensing contract of...” or an indication of similar meaning, regardless of whether it is in Vietnamese or a foreign language, while the manufacturer has not yet been lawfully licensed to use the industrial property subject matter;

b/ Act of failure to provide an indication means an act of failing to inscribe on goods or goods packages an indication that such goods are manufactured under a mark licensing contract.

Article 8. Infringements of provisions on industrial property representation in Article 7 of Decree No. 99/2013/ND-CP

1. Act of concurrently acting as representatives for industrial property rights disputing parties prescribed at Point a, Clause 2, Article 7 of Decree No. 99/2013/ND-CP shall be understood as either of the following:

a/ Providing one or more than one service of industrial property representation specified in Clause 1, Article 151 of the Intellectual Property Law to both the requester for handling and the party requested to be handled for an infringement upon industrial property rights in the same case;

b/ Providing one or more than one service of industrial property representation specified in Clause 1, Article 151 of the Intellectual Property Law to the party carrying out procedures for opposing, requesting revocation or invalidation of the protection title or handling the infringement while representing the protection title applicant or holder in carrying out procedures for establishing, enforcing or protecting industrial property rights in the same case.

2. Act of intentionally obstructing the establishment, enforcement and protection of industrial property rights, causing damage to persons with related rights and interests specified at Point h, Clause 2, Article 7 of Decree No. 99/2013/ND-CP shall be understood as one of the following:

a/ Intentionally delaying the filing of an industrial property registration application or a request for infringement handling and other documents in the course of establishment, enforcement and protection of industrial property rights of the represented party without plausible reason;

b/ Providing untruthful information on the legal status of a protection title, an industrial property registration application or a request for infringement handling and other documents in the course of establishment, enforcement and protection of industrial property rights, affecting the lawful rights and interests of the title holder;

c/ Filing groundless petitions or complaints related to the establishment and protection of industrial property rights in order to prolong the process of settlement by competent agencies, causing material and spiritual damage to persons with related rights and interests;

d/ Failing to perform or improperly performing the obligations of industrial property representatives.

3. Serious errors or infringements committed by industrial property representatives while practicing representation which cause damage to the interests of the State or society prescribed at Point b, Clause 4, Article 7 of Decree No. 99/2013/ND-CP shall be understood as one of the following:

a/ Registering a confidential invention overseas without permission of a competent agency;

b/ Disclosing information and documents not yet permitted for disclosure or information classified as state secret in the course of providing the service of industrial property representation;

c/ Renting or leasing an industrial property representation service practice certificate.

Article 9. Infringements of provisions on industrial property examination in Article 8 of Decree No. 99/2013/ND-CP

1. Act of disclosing information obtained while conducting examination without permission of related parties prescribed at Point b, Clause 3, Article 8 of Decree No. 99/2013/ND-CP shall be understood as either of the following:

a/ Disclosing confidential information or documents provided by an industrial property examination-soliciting competent agency or a requester for industrial property examination and related to a case in question;

b/ Disclosing information or documents not yet permitted for disclosure or information classified as state secret or trade secret provided by a competent agency or a requester for examination, for the examination.

2. Act of taking advantage of the examiner status and examination activities for self- seeking purposes prescribed at Point a, Clause 4, Article 8 of Decree No. 99/2013/ND-CP shall be understood as either of the following:

a/ Taking advantage of the status of an examination organization or examiner or the participation in examination activities to influence involved organizations and individuals in order to earn illicit profits;

b/ Conducting activities outside areas of examination stated in the business registration certificate or operation registration certificate in order to earn illicit profits.

3. Act of intentionally making untruthful examination conclusions prescribed at Point b, Clause 4, Article 8 of Decree No. 99/2013/ND-CP shall be understood as an act of intentionally making groundless examination conclusions not based on the information and documents provided for the examination.

Section 2. ACTS OF INFRINGING UPON INDUSTRIAL PROPERTY RIGHTS

Article 10. Acts of infringing upon industrial property rights on the Internet

1. Acts regarded as satisfying the conditions prescribed in Clauses 1, 2 and 3, Article 5 of revised Decree No. 105/2006/ND-CP and committed on the Internet against consumers or information users in Vietnam shall also be concluded as acts infringing upon industrial property rights and be administratively sanctioned under Articles 10, 11 and 12 of Decree No. 99/2013/ND-CP.

2. Owners of national domain names that hire other organizations and individuals to commit acts mentioned in Clause 1 of this Article shall also be regarded as having committed acts infringing upon industrial property rights and be sanctioned under Articles 10, 11 and 12 of Decree No. 99/2013/ND-CP.

Article 11. Acts infringing upon rights to inventions

The identification of acts infringing upon rights to inventions must comply with Articles 5 and 8 of revised Decree No. 105/2006/ND-CP and the following guidance:

1. A product/product part/process in question shall be regarded as identical or similar to a protected product/product part/process in a certain (independent and dependent) point of the protection request in an invention patent/utility solution patent if all basic technical specifications (features) stated in that point can be found in the product/product part/process in question in the identical or similar form, in which:

a/ Two technical specifications (features) are regarded as identical if they have the same nature, utility and method of utilization and share the same connection with other specifications stated in the protection request;

b/ Two technical specifications (features) are regarded as similar if they have similar or interchangeable natures and basically the same utility and method of utilization.

2. If a product/product part/process in question does not contain at least one basic technical specification (feature) stated in a certain point of the protection request, it shall be regarded as neither identical nor similar to any product/product part/process protected under that point.

Article 12. Acts infringing upon rights to industrial designs

The identification of acts infringing upon rights to industrial designs must comply with Articles 5 and 10 of revised Decree No. 105/2006/ND-CP and the following guidance:

1. A product/product part in question shall be regarded as a replication of a protected industrial design if it has a combination of visual shaping (external appearance) features incorporating all functional and non-functional shaping features of the protected industrial design.
2. A product/product part in question shall be substantially regarded as a replication of a protected industrial design if it has a combination of visual shaping (external appearance) features incorporating all functional shaping features of the protected industrial design and they are different from each other only in their shaping features that are not easily identified and remembered.
3. In case visual shaping features of a product/product part as a whole are regarded as a replication or substantially a replication of the combination of visual shaping features of at least one product in the set of products under a protected industrial design, the case shall also be regarded as an infringement upon rights to the industrial design.
4. Functional shaping features of a protected industrial design shall be understood as shaping features that can be easily identified or remembered and used to distinguish an industrial design as a whole from another. Functional shaping features may be configuration, pattern and correlation between configuration and/or pattern features, and color features identified on the basis of the set of photos/drawings enclosed with the industrial design patent.

Article 13. Acts infringing upon rights to marks

The identification of acts infringing upon rights to marks must comply with Articles 5 and 11 of revised Decree No. 105/2006/ND-CP and the following guidance:

1. Grounds for assessing confusability of a sign with a protected mark include:
 - a/ Scope of protection in whole and in each component of the mark; similarity between the sign and the mark in whole and in distinctive components, especially those making strong impression on consumers;
 - b/ Relevance of the goods or service by function, utility or composition; practice and custom of sale, purchase, distribution, selection and use of the goods or service; conditions, methods and places of display, distribution, marketing, promotion and sale and purchase of the goods or service;

c/ Characteristics and level of attention of consumers when selecting, purchasing and selling the goods or service;

d/ Other criteria such as practical use and protection of similar marks for the same goods; effect of other elements suggestive of the relation between the goods or service in question and the protected goods or service;

dd/ Evidence of consumer confusion consequences may be used to support the assessment of confusability of the use of the sign but does not constitute a compulsory condition for making a conclusion on confusability of the use of the sign.

2. Identification of elements infringing upon rights to marks:

a/ In case of use of a sign identical to a mark for a goods or service identical to that stated in a mark registration certificate or certificate of internationally registered mark protectable in Vietnam or the Official Gazette of international registration of marks of the World Intellectual Property Organization, it is unnecessary to examine the possibility of consumer confusion about the goods or service bearing the mark;

b/ In case of use of a sign identical to a mark for a similar or relevant goods or service; use of a sign similar to a mark for a goods or service identical or similar or relevant to that on the list of goods and services bearing marks as stated in a mark registration certificate or certificate of internationally registered mark protectable in Vietnam or the Official Gazette of international registration of marks of the World Intellectual Property Organization, it is necessary to examine the possibility of consumer confusion about the goods or service bearing the mark.

3. Identification of elements infringing upon rights to well-known marks:

a/ In case of use of a sign identical or similar to a well-known mark or sign in the form of definition or transcription from a well-known mark for any goods or service, including also goods or service neither identical nor similar nor relevant to that on the list of goods and services bearing well-known marks, it is necessary to examine the possibility of confusion about the origin of goods or service or the relation between the user of such sign and the owner of the well-known mark;

b/ In case the use of a sign identical or similar to a well-known mark specified at Point a. Clause 3 of this Article cannot cause a confusion about the origin of a goods or service but causes a misleading impression on consumers about the relation between the user of such sign and the owner of the well-known mark, it shall also be regarded as an act infringing upon industrial property rights;

c/ When filing a request for handling of an infringement against a well-known mark, a rights holder shall provide evidence that such mark is well known in Vietnam according to the criteria prescribed in Article 75 of the Intellectual Property Law, regardless of whether or not it has been registered for protection in Vietnam;

d/ Before deciding to carry out procedures for handling the infringement, the agency competent to handle infringements shall base itself on the criteria prescribed in Article 75 of the Intellectual Property Law to consider whether or not a mark is well known in Vietnam. It may exchange professional opinions with the National Office of Intellectual Property and/or consult an advisory council.

In case a well-known mark in Vietnam is recognized according to the civil procedures or under a recognition decision of the National Office of Intellectual Property, the infringement- handling agency may base itself on relevant documents to consider the recognition of the mark regarded as well-known in Vietnam if the recognition of well-known marks by the above-said agencies at the time of infringement handling request is still appropriate.

Article 14. Acts infringing upon rights to trade names

The identification of acts infringing upon rights to trade names must comply with Articles 5 and 13 of revised Decree No. 105/2006/ND-CP and the following guidance:

1. The ground for examining elements infringing upon rights to a trade name is the protection scope of such trade name determined on the basis of evidence of lawful use of such trade name, indicating business subjects, business establishments, business activities and products or services bearing the trade name, specifically as follows:

a/ Evidence that the trade name is used at the place of business (for example, at the place where there are customers or business partners or where exists reputation through advertising, marketing or distribution) in a lawful business sector (stated in the business household registration certificate, enterprise registration certificate, investment registration certificate, certificate of eligibility for business operation for conditional business sectors or lines, tax identification number registration and articles of incorporation registered with competent agencies, or other papers of legal validity);

b/ Time of starting the use and use course: The trade name has been known by business partners and customers through goods, services and business activities (for

example, the trade name is used on goods, sale and purchase contracts, goods orders, business transaction documents, advertising leaflets, customs declarations, tax payment documents and other transaction documents).

2. Business household registration certificate, enterprise registration certificate, investment registration certificate, certificate of eligibility for business operation, tax identification number registration and articles of incorporation are regarded as evidence proving the lawfulness of business activities conducted under the trade name. The name of a business establishment or an enterprise stated in the above papers may only be regarded as a trade name when there are documents proving that the name of the business establishment or enterprise is used in practical lawful business activities and satisfies the protection conditions prescribed in Articles 76,77 and 78 of the Intellectual Property Law.

3. In case the use of a mark, an industrial design, a trade name or a geographical indication causes a conflict and leads to a dispute, the settlement of such conflict and dispute must comply with Article 6 of the Intellectual Property Law, Article 17 of revised Decree No. 103/2006/ ND-CP, Article 27 of Decree No. 99/2013/ND-CP, and the following specific guidance:

a/ Based on documents and evidence proving the time of arising or establishment of rights on the principle that the right to a subject matter which arises or is established earlier shall be protected.

In case related parties all have evidence proving that their rights arise or are established lawfully, they may exercise their rights within the scope and term of protection and the exercise of their rights does not infringe upon the interests of the State, public interests, lawful rights and interests of other organizations and individuals and does not violate other relevant laws;

b/ Based on the protection title, certificate or written certification of the competent agency and relevant documents, contents of the contract or lawful agreement between the parties, the scope of protection of the subject matter concurrently protectable as different intellectual property subject matters shall be determined;

c/ In case the trade name or mark bearing a geographical name is used before a protection certificate is granted for a geographical indication or mark bearing the same geographical name and these subject matters satisfy the protection conditions prescribed by law, the bona fide use of such subject matters shall not be regarded as an infringing act under Points g and h, Clause 2, Article 125 of the Intellectual Property Law.

4. In case the concurrent use of the subject matters specified at Point c of this Clause affects rights and interests of third parties, consumers and society and there is a request for infringement handling, the agency with infringement handling competence shall request related parties to reach agreement and record in writing the agreed conditions and method of use of such subject matters according to the procedures prescribed in Clause 2, Article 27 of Decree No. 99/2013/ND-CP. Any party that continues the use which is regarded as an infringement upon of industrial property rights of other parties and does not join the agreement or fails to properly implement the recorded agreement shall be further sanctioned by the agency with infringement handling competence according to the procedures prescribed in Decree No. 99/2013/ND-CP.

Article 15. Acts infringing upon rights to geographical indications

The identification of acts infringing upon rights to geographical indications must comply with Articles 5 and 12 of revised Decree No. 105/2006/ND-CP and the following guidance:

1. The ground for assessing the confusability of a sign with a geographical indication may be applied in an appropriate manner like the ground for assessing the confusability of a sign with a protected mark.

2. Infringing products and goods may be:

a/ Products of the same type bearing a sign identical to a geographical indication and manufactured in a locality in the region bearing the protected geographical indication but not satisfying the condition of particular quality under such geographical indication;

b/ Products of the same type bearing a sign identical or similar to a geographical indication but not manufactured in a locality in the region bearing the protected geographical indication, even if such products have equal quality specifications and product manufacturing and management process;

c/ Products of the same type bearing a sign identical or similar to a geographical indication, manufactured in a locality in the region bearing the protected geographical indication, and satisfying the condition of particular quality, but their manufacturer is not permitted by the organization managing such geographical indication to use it;

d/ Similar products bearing a sign identical or similar to a geographical indication for the purpose of taking advantage of the popularity and reputation of such

geographical indication and/or misleading as to their geographical origin, regardless of whether or not their place of manufacture is located in the region bearing the protected geographical indication.

Article 16. Acts infringing upon stamps, labels and articles

1. Infringing acts prescribed in Article 13 of Decree No. 99/2013/ND-CP shall be applied in case where an organization or individual detects a stamp, label or article bearing a counterfeit mark or geographical indication not yet affixed on products and has sufficient grounds to believe that such stamp, label or article will be affixed on products to be marketed (for example, through a purchase and sale contract, printing contract, written declaration with a competent agency, package sample or product sample affixed with infringing stamp, label or article and currently in storage, transportation or on display for sale).

2. Other stamps, labels and articles specified in Article 13 of Decree No. 99/2013/ND-CP refer to stamps of all kinds of manufacturers, distributors and importers to be affixed on products, including quality control stamps containing infringing elements; goods labels; decals; product packages; product parts which can be detached but cannot be independently circulated, on which counterfeit marks or geographical indications are printed, molded or embossed.

Article 17. Transit of goods infringing upon industrial property rights

Competent agencies shall handle acts of transiting goods infringing upon industrial property rights in case industrial property rights holders have sufficient grounds to prove such transited goods cause damage to them or to consumers in Vietnam.

Article 18. Parallel importation

1. Parallel importation prescribed in Clause 2, Article 26 of Decree 99/2013/ND-CP means the importation by an organization or individual of a product which has been lawfully launched on the domestic or overseas market by its owner or the organization or individual with licensed use right, including the case of compulsory licensing, or a person with the right to prior use of industrial property subject matter, without permission of the industrial property right holder.

2. Parallel importation by organizations and individuals shall not be regarded as an infringement upon industrial property rights and parallel importers shall not be administratively sanctioned.

Article 19. Unfair competition in the field of industrial property

1. Act of using misleading trade indications:

a/ A rights holder that may request handling of the act of using a misleading trade indication is a business entity that has made prior use of a trade indication specified in Clause 2, Article 130 of the Intellectual Property Law in a public and stable manner in its lawful business activities in Vietnam and being known to consumers about the reputation of business entities and goods or services bearing such trade indications.

b/ Trade indications specified in Clause 2, Article 130 of the Intellectual Property Law include industrial property subject matters (marks, trade names and geographical indications) and the following subject matters:

- “Goods labels”, which are scripts, prints, drawings or photos of letters, pictures or images stuck, printed, attached, molded, carved or engraved directly on goods or commercial packages of goods or on other materials to be affixed on goods or commercial packages of goods.

- “Business mottos”, which are groups of words appearing beside enterprise names or marks affixed on products of enterprises to emphasize business purposes or guidelines of enterprises or customers targeted by such products.

- “Business symbols”, which are signs, letters, figures or configurations uniquely designed and used as symbols of enterprises in their business activities.

- “Package designs”, which are designs and decorations of goods packages, including shapes, patterns, figures, letters, numbers, colors, presentations, blending of colors, arrangements and combination of these elements to create a particular impression or typical feature of goods packages.

c/ A misleading trade indication is a trade indication containing signs (components, presentation, combination of elements, colors, overall impression on consumers) identical or confusingly similar to a corresponding trade indication of the rights holder requesting handling of an act of unfair competition used for identical or similar goods or services.

The use of such an indication aims to mislead consumers as to the business entity, business activities, commercial origin of goods or services, geographical origin, manufacturing method, function, quality, quantity or other features of goods or services or conditions of goods or service provision.

d/ A requester for handling of an act of unfair competition in using a misleading trade indication shall provide evidence to prove that:

- The business entity has used the trade indication in a public and stable manner to the knowledge of many consumers in Vietnam, which may include information on advertising, marketing, display and exhibition; sale turnover; number of products sold; system of distribution agents, joint ventures and associated parties; investment scale; appraisal by state agencies, the mass media, selection by consumers, and other information showing the reputation of the business entity associated with the trade indication in its business activities in Vietnam;

- The party requested to be handled has used the misleading trade indication on goods, goods packages, means of business, means of services or means of advertising.

2. Act of registering, appropriating the domain name use right or using domain names:

a/ A party that may request handling of an act of registering, appropriating the domain name use right or using domain names is the owner of a mark, geographical indication or trade name and has used the subject matter in a public and stable manner in its lawful business activities and has its reputation as an industrial property rights holder and goods or services bearing such mark, geographical indication or trade name known to the Vietnamese consumers in the related fields;

b/ Act of registering, appropriating the domain name use right or using domain names shall be regarded as an act of unfair competition in industrial property, except for domain names already distributed through auction or contest for selection under Point a. Clause 2, Article 48 of the Law on Telecommunications, falling in either of the following cases:

- Using Vietnamese national domain names “.vn” with sequences of characters identical or confusingly similar to marks, trade names or geographical indications currently protected or widely used for advertising, introduction of products, offer for sale, sale of identical, similar or related goods or services on websites which such domain names direct to; causing a confusion about and taking advantage or causing damage to the reputation of or material damage to owners of such marks, trade names or geographical indications; or,

- Registering or appropriating the right to use Vietnamese national domain names “.vn” with sequences of characters identical to reputable or well-known marks, trade names or geographical indications in Vietnam, while there are grounds to

believe that organizations or individuals register or appropriate the domain name use right only for resale to earn profits or to prevent owners of such protected marks, trade names or geographical indications from registering domain names.

c/ The party requesting handling of the act of registering, appropriating domain name use right or using a domain name regarded as an act of unfair competition in industrial property shall provide the following evidence to prove that:

- The rights holder has used the mark, geographical indication or trade name in a public and stable manner and has its reputation as an industrial property rights holder and goods or services bearing such mark, geographical indication or trade name (possibly information on advertising, marketing, exhibition; sale turnover; number of products sold; system of distribution agents, joint ventures and associated parties; investment scale; appraisal by state agencies, the mass media, selection by consumers, and other information showing the reputation of the business entity; goods or services bearing such mark, geographical indication or trade name) known to consumers in Vietnam.

- For the act of using a domain name regarded as an act of unfair competition in industrial property: The requesting party shall prove that the party requested to be handled has used the domain name on the Internet for advertising or introducing products, offering for sale identical, similar or related goods or services, causing damage to the reputation of or material damage to the owner of the protected mark, trade name or geographical indication; and the party requested to be handled continues to use the misleading mark, trade name or geographical indication through such domain name after being requested by the mark, trade name or geographical indication owner to stop using it.

For the act of registering or appropriating the domain name use right regarded as an act of unfair competition in industrial property: The requesting party shall prove that the party requested to be handled has registered but has not used the domain containing characters identical to a mark, trade name or geographical indication widely used and reputable in Vietnam; and there are grounds to believe that the party requested to be handled registers or appropriates the domain name use right only for resale to earn profits or to prevent the owner of the protected mark, trade name or geographical indication from registering a domain name;

- The party requested to be handled has no lawful rights to and interests from protected marks, geographical indications and trade names of the rights holder.

Article 20. Reuse, repair, recycling of products and product packages

The reuse, repair or recycling by organizations or individuals of products or product packages bearing marks, trade names or geographical indications marketed by rights holders to create other products shall also be regarded as an act of infringing upon industrial property rights or an act of unfair competition in case such act misleads consumers as to the commercial origin of products, business entity, business activities or properties of products under relevant provisions on acts infringing upon industrial property rights and acts of unfair competition.

This provision does not apply in case where products bear an explicit notification that products and product packages are reused, repaired or recycled and have no signs which may mislead consumers as to the commercial origin of products, business entity, business activities or properties of products under relevant provisions on acts infringing upon industrial property rights and acts of unfair competition.

Article 21. Means of business

Means of business specified in Clause 15, Article 11, and at Point b, Clause 15, Article 14, of Decree No. 99/2013/ND-CP shall be understood as any means bearing or containing a protected industrial property subject matter or trade indication and used to serve business activities (for example, websites, introduction documents, name cards, means of transport and utensils and decorations in business establishments).

Chapter III

INFRINGEMENT HANDLING PROCEDURES

Article 22. Power of attorney for requesting infringement handling

When being attached to a written request for infringement handling, a power of attorney for requesting infringement handling must satisfy the conditions prescribed in Article 23 of Decree No. 99/2013/ND-CP, with attention paid to the following cases:

1. In case the original power of attorney containing the authorization for carrying out procedures to protect industrial property rights has been filed in the previous dossier with the same infringement handling agency, the rights holder shall submit a copy of the power of attorney directing to the original.
2. In case the original power of attorney containing the authorization for carrying out procedures to protect industrial property rights has been filed with the National

Office of Intellectual Property or another competent agency, the rights holder shall submit a copy of the power of attorney certified by the agency keeping the original.

Article 23. Requests for infringement handling

1. Requests for infringement handling must satisfy the conditions prescribed in Article 24 of Decree No. 99/2013/ND-CP.

2. Documents and evidence attached to a request:

a/ Copies of written certifications, protection titles, certificates and other documents shall be considered valid if the rights holder show the originals for comparison or copies authenticated by a competent agency or copies certified by agencies granting the originals. The officer receiving the dossier shall sign for certification on copies already compared with the originals without requiring certification by notaries public or agencies that have granted such certificates;

b/ An explanatory report of the rights holder (on turnover, reputation, advertising, evidence on the wide usage, copies of certificates and protection titles in other countries) provided to the infringement handling agency shall be considered valid if there is a commitment to bear the legal responsibility for contents and information of the report and certification signature and seal (if any) of the rights holder or its lawful representative. If the report has multiple pages, the rights holder shall sign on each page and append a seal (if any) on every two adjoining pages.

This provision also similarly applies to documents provided by the party requested to be handled.

3. Documents proving the right to request infringement handling:

a/ Documents proving the owner of a trade name include documents and material evidence proving the prior and lawful use of the trade name in the business line and sector satisfying the protection conditions prescribed in Articles 76, 77 and 78 of the Intellectual Property Law;

b/ Documents proving the owner of a trade secret include documents proving that the organization or individual has lawfully held and taken measures to keep confidential information classified as trade secret under Articles 84 and 85 of the Intellectual Property Law;

c/ In case the contract on use of an industrial property subject matter, regulation on use of a collective mark, or license to use a geographical indication contains no agreement or provision restricting the right to request infringement handling of the

licensee, such licensee may carry out procedures to request infringement handling under Decree No. 99/2013/ND-CP, provided that the rights holder make no written opposition.

In addition to documents and evidence proving the status of the rights holder specified in Article 24 of revised Decree No. 105/2006/ND-CP, the rights holder may submit copies of documents proving his/her/its status and produce the originals for comparison.

4. In a request for infringement handling, the rights holder may request the handling of:

a/ One or more than one infringement related to one or more than one industrial property subject matter committed by the same organization or individual;

b/ One or more than one infringement related to one industrial property subject matter committed by more than one organization or individual;

c/ In case of requesting handling of one or more than one organization or individual committing an infringement in the same locality, the rights holder shall file only one request with the agency with handling competence in such locality;

d/ In case of requesting handling of one or more than one organization or individual committing an infringement in different localities, the rights holder may file a request with the agency with handling competence in each locality or file a request with a central agency with infringement handling competence in such localities.

5. In case different agencies are competent to handle an infringement, the rights holder may choose one from among those agencies to file his/her/its request.

Article 24. Consideration and settlement of requests for infringement handling

1. If a request for infringement handling has sufficient evidence of counterfeit goods or goods infringing upon rights to a mark, a geographical indication or an industrial design, the competent agency shall coordinate with the rights holder in inspecting, examining and handling the infringement under Point d. Clause 2, Article 25 of Decree No. 99/2013/ND-CP.

2. If a request for infringement handling has insufficient evidence of counterfeit goods or goods infringing upon rights to a mark, a geographical indication or an industrial design; in case of a request for handling of an infringement upon an invention, a layout design, a trade name or a trade secret; in case of a request for handling of an act of unfair competition in industrial property, the competent

agency may request the parties to provide information and evidence and make statements within 10 days after the date provided in the notice. In case there is a plausible reason, the requester may request in writing the competent agency to prolong the time limit for reply which, however, must not exceed 30 days from the date fixed in the initial notice under Point c. Clause 2, and Point a, Clause 3, Article 25 of Decree No. 99/2013/ND-CP.

a/ If the parties make their statements at the request of the competent agency but new circumstances or evidence are discovered in the case, the competent agency may request the parties to make statements, counter-statements and provide additional evidence under Clause 6, Article 26 of Decree No. 99/2013/ND-CP within the time limit prescribed above.

The parties may provide to the agency with infringement handling competence written expertise opinions of the state management agency in charge of industrial property, written conclusions of industrial property examination, dispute settlement decisions and decisions on handling of related or similar infringements of competent agencies and other documents and evidence to prove their requests, arguments and statements and clarify facts of the case.

b/ In case written statements of the parties cannot clarify facts of the case and when requested by one or all of the parties, the competent agency shall work directly with the parties. The written record of opinions of the parties made during working with the competent agency shall be used as a proof for settlement of the case;

c/ In case the parties reach an agreement on measures to settle the case in compliance with the intellectual property law and regulation without affecting rights and interests of third parties, consumers and the society, the competent agency shall record such agreement and announce to stop the settlement of the case under Clause 2, Article 27, and Point d, Clause 2, Article 28, of Decree No 99/2013/ND-CP.

3. If a request for infringement handling is filed with different agencies competent to handle the same infringement, the agency that first accepts the request is competent to settle it. The rights holder shall notify other competent agencies of that acceptance.

a/ Before accepting the case, if the agency receiving the request knows that another agency with handling competence or a court has accepted the case, it shall issue a notice of refusal to accept the request;

b/ After accepting the case and before inspecting, examining and handling the infringement, if the request-receiving agency knows that another agency with handling competence has inspected, examined and handled the infringement or a court is dealing with the case, it shall issue a notice of refusal to carry out procedures for infringement handling;

c/ After conducting inspection and examination, if the handling agency knows that another agency has conducted inspection and examination, it shall request the latter's coordination in the handling and agree to let either of them carry out sanctioning procedures. In case another agency has handled the infringement but at the time of inspection and examination, another organization or individual is detected to have committed such infringement, the handling agency shall handle the infringement with the aggravating circumstance of recidivism;

d/ In the course of handling the infringement, if signs of crime are detected, the handling agency shall transfer the case file to a competent investigative agency of the locality where the infringement is committed.

Article 25. Provision of information for infringement handling

1. When requested by the industrial property rights holder or the person with dispute settlement or infringement sanctioning competence of another agency or organization defined in Clause 5, Article 26 of Decree No. 99/2013/ND-CP, the agency with infringement handling competence shall provide copies of the written record, documents, samples and photos related to the infringement handling, provided the provision of such information and documents does not affect the effectiveness of the infringement handling and does not fall into any case of confidentiality keeping prescribed by law.

2. If there is a request for infringement handling prescribed in Article 24 of Decree No. 99/2013/ND-CP, the agency with infringement handling competence shall send written conclusions, the sanctioning decision and notice of refusal or suspension of infringement handling to the requester in accordance with law.

Article 26. Coordination in infringement handling

1. The National Office of Intellectual Property, the Intellectual Property Science Institute and agencies competent to handle infringements upon industrial property rights shall coordinate with one another in handling infringements when receiving requests for coordination in infringement handling under Clause 1, Article 29 of Decree No. 99/2013/ND-CP.

2. The coordination in handling of infringements related to enterprise names violating the intellectual property law must comply with the guidance in the joint circular of the Ministry of Science and Technology and the Ministry of Planning and Investment.

3. The handling of infringements related to domain names violating the intellectual property law must comply with the guidance in the joint circular of the Ministry of Science and Technology and the Ministry of Information and Communications.

Article 27. Coordination in the handling of infringements related to products and goods harmful to health, environment or social safety

1. Upon receiving a request for infringement handling or detecting an act infringing upon industrial property rights related to products and goods harmful to health, environment or social safety prescribed at Point b, Clause 3, Article 22 of Decree No. 99/2013/ND-CP, the infringement-handling agency may ask the party requested to be handled to provide information, documents and statements as evidence under Point a, Clause 3, Article 25 of Decree No. 99/2013/ND-CP, or shall coordinate with the rights holder in conducting inspection, examination, verification and collection of evidence. After examining documents and evidence, the infringement-handling agency shall issue:

a/ Written conclusions on infringement upon industrial property rights; and/or,

b/ A decision on sanctioning of administrative violation according to its competence.

2. In case the infringement-handling agency issues written conclusions on infringement upon industrial property rights specified at Point a, Clause 1 of this Article, it shall send such conclusions to the rights holder and infringer and create conditions for the parties to reach an agreement and negotiate within 30 days after receiving such conclusions.

a/ In case the parties reach an agreement and propose handling measures in compliance with the intellectual property law without affecting rights and interests of third parties, consumers and the society under Clause 2, Article 27 of Decree No. 99/2013/ND-CP, the infringement-handling agency shall issue a notice recording such agreement and stop the settlement of the case;

b/ In case the parties cannot reach an agreement within the prescribed time limit, the infringement-handling agency shall inspect, examine, and handle the infringement.

3. The infringement-handling agency shall send written conclusions on the infringement, notice recording the agreement between the parties or the decision on sanctioning of administrative violation to the state management agency in the relevant sector or field for coordinated infringement handling.

Article 28. Settlement of cases upon occurrence of disputes

1. In case a dispute occurs under Clause 1, Article 27 of Decree No. 99/2013/ND-CP, the competent agency accepting the case for settlement may request the state management agency in charge of intellectual property to clarify the legal status of industrial property rights, specifically as follows:

a/ Information on the ownership and use rights, licensing of the subject matter subject to a dispute, complaint or denunciation;

b/ Scope of protection of industrial property rights in question; scope and conditions of application of the provisions on cases not regarded as infringements upon industrial property rights;

c/ Possibility of invalidation or revocation of the protection title or change in the scope of protection of industrial property rights in question.

2. Stoppage of procedures for handling an infringement upon occurrence of a dispute under Point a, Clause 2, Article 28 of Decree No. 99/2013/ND-CP:

a/ The competent agency shall consider stopping the handling of an infringement after accepting the request for infringement handling in the following cases:

- When it receives a notice from the state management agency in charge of industrial property of its acceptance of a request for revocation or invalidation of the protection title, a complaint about the scope of protection of industrial property rights related to the subject matter in the request; or a notice from a court of its acceptance of the infringement case; or a complaint about or a dispute on industrial property rights related to the subject matter in the request;

- When it finds that the case involves contents related to a contractual dispute between the parties on the right to use the industrial property subject matter.

b/ A notice of stopping of the settlement of a case must clearly state grounds and reasons for stoppage, and rights and obligations of related parties, and shall be sent to the requester for infringement handling, the party requested to be handled for infringement and the agency competent to settle disputes and complaints.

3. The competent agency shall request the rights holder to make statements and commitments under Point b, Clause 1, Article 27 of Decree No. 99/2013/ND-CP and consider handling the infringement based on the grounds prescribed at Points a and c or Points a, b and c below:

a/ The party requested to be handled has filed a request for revocation or invalidation of the protection title which is not yet accepted by the competent agency;

b/ The party requested to be handled has filed an application for registration of protection of the subject matter stated in the request for infringement handling with the state management agency in charge of industrial property but there is no decision on grant of a protection title;

c/ The requester requests continued handling and commits to pay compensation under Point b, Clause 2, Article 32 of Decree No. 99/2013/ND-CP in case the decision on sanctioning of administrative violation is amended, cancelled or invalidated under a dispute settlement decision of the competent agency.

4. Refusal to handle infringements:

Before issuing a notice of acceptance of a request for infringement handling, if the infringement-handling agency receives a notice of acceptance of the request from a competent agency specified at Point a, Clause 2 of this Article, it shall issue a notice of refusal to handle the infringement under Point a, Clause 1, Article 28 of Decree No. 99/2013/ND-CP.

Article 29. Competence of heads of specialized science and technology inspection teams

Heads of specialized inspection teams of the Ministry of Science and Technology and provincial-level Departments of Science and Technology may use seals of agencies in charge of inspection when issuing documents on application of measures to perform the inspection tasks specified in Clause 1, Article 53 of the Law on Inspection.

Article 30. Assistance of industrial property rights holders in the inspection, examination, verification and handling of infringements

1. Industrial property rights holders that request infringement handling may propose cooperation and technical assistance, including information, documents, means of transport, technical equipment and manpower, for agencies competent to

investigate, verify, collect evidence and handle material evidence and means used for infringements under Point d, Clause 2, Article 25 of Decree No. 99/2013/ND-CP.

2. Expenses for assistance for the investigation, verification and collection of evidence and handling of material evidence and means for infringements in the field of industrial property mentioned in Clause 1 of this Article shall be regarded as reasonable expenses for industrial property rights protection and may be accounted as production expenses under revised Decree No. 103/2006/ND-CP.

Chapter IV

ORGANIZATION OF IMPLEMENTATION

Article 31. Effect

This Circular takes effect on August 11, 2015, and replaces the Minister of Science and Technology's Circular No. 37/2011/TT-BKHCHN of December 27, 2011, guiding a number of articles of the Government's Decree No. 97/2010/ND-CP of September 21, 2010, on sanctioning of administrative violations in the field of industrial property.

Article 32. Implementation responsibility

1. Heads of the units of the Ministry of Science and Technology, heads of related agencies and organizations, and related individuals shall implement this Circular.
2. Any problems arising in the course of implementation should be promptly reported to the Ministry of Science and Technology for study and settlement guidance.

**MINISTER OF SCIENCE AND
TECHNOLOGY**

Nguyen Quan