



Ministry of Science and Technology
Vietnam Intellectual Property Research Institute
(VIPRI)

**Strengthening IP Protection through
Expert Evidences: Insights from VIPRI
Vietnam**

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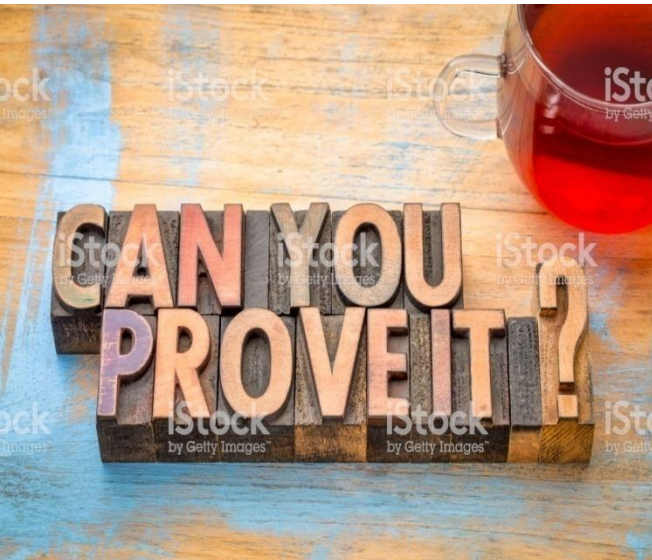
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- What is the Expert Evidence?
- **What for is the Expert Evidence?**
- Who need the Expert Evidence?
- **Who provides the Expert Evidence?**
- How to provide the Expert Evidence?
- **Characteristics of the Expert Evidence**
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What is the Expert Evidence?



“You can’t just believe something that you don’t have proof or supporting evidence of”.





What is the Expert Evidence?

IP Law (2022), Civil Procedure Code (2015):
The written “expert opinion conclusion” shall be considered as a **source of evidence** used by competent authorities for the purpose of handling or adjudicating the case.



What is the Expert Evidence?

IP Law (2022), Civil Procedure Code (2015):

Expert opinion conclusions: to be considered as **evidence**, they must be: (i) true; (ii) lawfully provided or obtained; and (iii) related to the issue or event under consideration





What is the Expert Evidence?

IP Law (2022), Decree 65/2023:

The Expert Evidence provides proofs of:

- Scope of IP protection
- Similarity between the protected and accused subject
- Infringement of the protected subject
- Value and/or damages caused by the infringement





What for is the Expert Evidence?



The Expert Evidence is mainly used for:

- Settling disputes between parties
- Adjudication performed by IP enforcement agencies
- IP management (FTO, TM Clearance, Due Diligence...)



Who need the Expert Evidence?

- IP Disputed parties
- IP Enforcement agencies: courts, customs, market controls, inspectorates, police...
- Firm managers, in-house counsels, IP attorneys...





Who provides the Expert Evidence?

- **VIPRI is the unique governmental authority to provide objective IP expert evidences.**

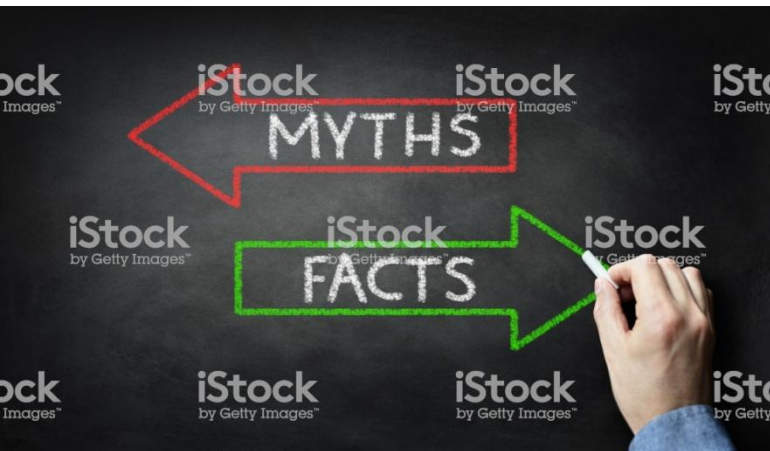
(IP Law, 2022) IP expert evidences *[provided by VIPRI]* means the use of professional knowledge and expertise to analyze and make determination on matters related to intellectual property rights.





How to provide the Expert Evidence?

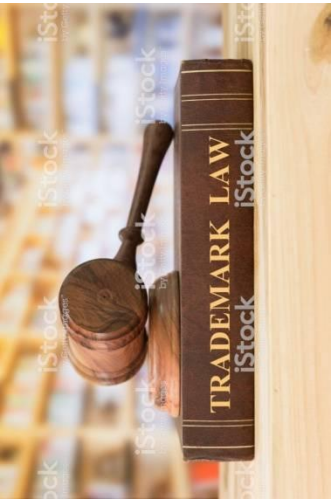
“The process of reaching a goal is always more important than the goal itself”



TRADEMARK:

VIPRI's Four-step Test for Infringement Analysis

IP Law 2022; Decree 65/2023; Circular 23/2023



- **Step 1:** Construction of the scope of trademark protection
- **Step 2:** Determination if an accused sign infringes the construed scope (similarity with the registered mark; proximity with the registered good/service)
- **Step 3:** Determination if likelihood of confusion exist
- **Step 4:** Determination if accused activities being infringement

TRADEMARK:

VIPRI's Four-step Test for Infringement Analysis

- **Step 1:** Construction of the scope of trademark protection
 - Easily noticeable and memorable element(s)
 - The combination of elements
 - Disclaimer(s)
 - Good/service
 - Strength of the mark:
The spectrum test: suggestive/descriptive/generic?

TRADEMARK:

VIPRI's Four-step Test for Infringement Analysis

- **Step 2:** Determination if an accused sign infringes the construed scope → Identical? Similar?
 - Similarity analysis between the accused sign and the registered mark:

The three-factor test: Visual (appearance, structure) + Aural (pronunciation, sound) + Conceptual (meaning)

- Proximity analysis between good/service bearing the registered mark and the accused sign: function, utility, distributing/marketing channel...

The “good used by service” test

TRADEMARK:

VIPRI's Four-step Test for Infringement Analysis

- **Step 3:** Determination if likelihood of confusion exists:

The multi-factor test:

- Dominant element(s) makes the global appreciation (combination) similar?
- Actual use?
- Degree of care of hypothetical relevant public (consumer)?
- Good - service relatedness?
- Density of similar marks in the market?
- Wrongful intent? bad faith?
- Evidence(s) of actual confusion? etc...

TRADEMARK:

VIPRI's Four-step Test for Infringement Analysis

- **Step 4:** Determination if accused activities being infringement:
 - Define accused infringing activities
 - Define the person/entity engaged in accused activities
 - Define if the accused activities is permitted or authorised by the trademark holder
 - Define if the accused activities are permitted by laws (exceptional circumstances: parallel import, honest use...)

INDUSTRIAL DESIGN:

VIPRI's Three-step Test for Infringement Analysis

IP Law 2022; Decree 65/2023; Circular 23/2023:

- **Step 1:** Construction of the scope of protection
- **Step 2:** Determination if accused product infringes the construed scope
- **Step 3:** Determination if accused activities being infringement



INDUSTRIAL DESIGN:

VIPRI's Three-step Test for Infringement Analysis

- Step 1
 - Define non-functional features
 - Define all substantive features:
 - + Prior art
 - + Overall impression
 - + Ordinary observers (person with average knowledge in the art)
 - + Without looking at the accused design(s)

INDUSTRIAL DESIGN:

VIPRI's Three-step Test for Infringement Analysis

■ Step 2

- Define the nature of the accused product design (all substantive features)
- Compare all substantive features of the patented designs and those of the accused design
- Similarity determination: overall impression
 - + Identical: for same product; same combination all features
 - + Not significantly different: for same product; some similar substantive features
 - + Different: different product; or all substantive features of the protected designs are not appeared on the accused product.

INDUSTRIAL DESIGN:

VIPRI's Three-step Test for Infringement Analysis

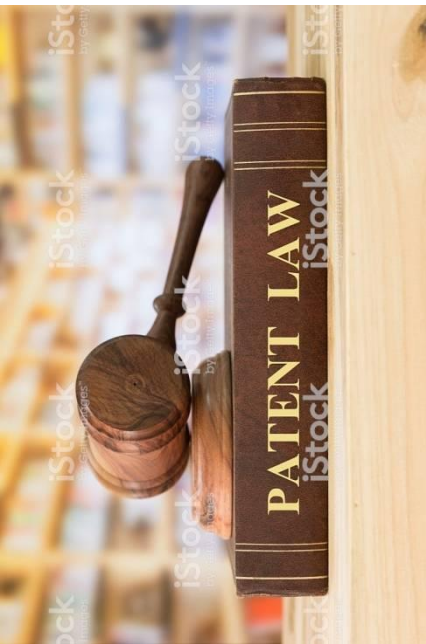
- Step 3
 - Define accused infringing activities
 - Define the person/entity engaged in accused activities
 - Define if the accused activities are permitted or authorized by the patented design holder
 - Define if the accused activities are permitted by laws (exceptional cases)

INVENTION:

VIPRI's Three-step Test for Infringement Analysis

IP Law 2022; Decree 65/2023, Circular 23/2023

- **Step 1:** Construction of the scope of protection (Claim Construction)
- **Step 2:** Determination if the accused product/process infringes the construed scope
- **Step 3:** Determination if the accused activities being infringement



INVENTION:

VIPRI's Three-step Test for Infringement Analysis

- Step 1
 - Define the essential elements of the claim
 - The “all-elements” Rule
 - The “element-by-element” Rule
 - In the views of the person of ordinary skilled in the art: who has ordinary technical practice skills and is acquainted with publicly available general knowledge in the art.

INVENTION:

VIPRI's Three-step Test for Infringement Analysis

■ Step 2

- Define the nature of the accused product/process (all essential elements)
- Compare all and individual essential elements of the patented invention (claim) and those of the accused product/process
- Similarity determination:
 - + Identical (literal): if a claim, as properly interpreted, reads on the alleged product/process
 - + Equivalent: the differences between the claimed and accused product/process are insubstantial
 - + Different: any essential element of the claimed product/process is not appeared on the accused product/process.

INVENTION:

VIPRI's Three-step Test for Infringement Analysis

- Step 2
 - The Tripartite Test, or the “function-way-result” Test
 - Doctrine of Equivalence: the accused product/process and the claimed invention perform substantially the same function in substantially the same way to yield substantially the same result.

INVENTION:

VIPRI's Three-step Test for Infringement Analysis

- Step 3
 - Define accused infringing activities
 - Define the person/entity engaged in accused activities
 - Define if the accused activities are permitted or authorized by the patent holder
 - Define if the accused activities are permitted by laws (exceptional cases)

INVENTION/DESIGN:

VIPRI's Three-step Test for Infringement Analysis

- Step 2

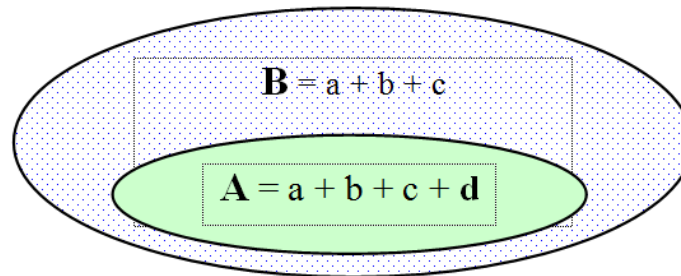


Fig. 1: B is NOT infringing A

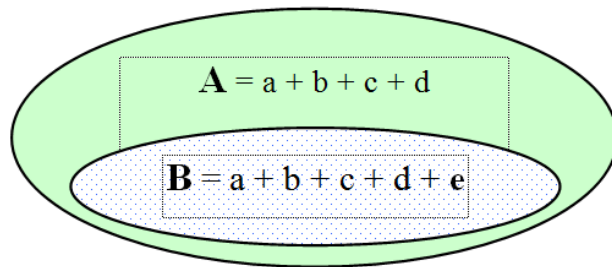


Fig. 2: B is infringing A (literally)

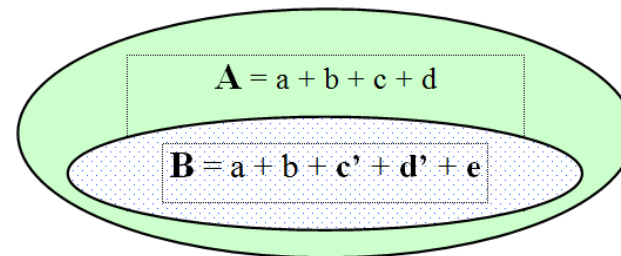


Fig. 3: B is infringing A (equivalently)

Characteristics of the Expert Evidence



- Professional opinions in nature
- Objective validity
- Source of reliable evidence
- Non-binding legal validity (not administrative decisions)
- Input information-based determination
 - without investigation (applicant's responsibility)
- Multi-purposes



Characteristics of the Expert Evidence

- For making infringement analysis and providing expert opinion conclusions, VIPRI have to search the invention, design and trademark information and data in every and each case.





Characteristics of the Expert Evidence

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Hugo Boss Trade Mark Management GmbH & Co. KG v. Domain Admin / Personal, Luong Dinh Dung

Case No. D2011-0564

1. The Parties

The Complainant is Hugo Boss Trade Mark Management GmbH & Co. KG of Metzingen, Germany, represented by Baker & McKenzie (Vietnam) Ltd., Vietnam.

The Respondent is Domain Admin / Personal, Luong Dinh Dung of Moergestel, the Netherlands, and of Hanoi, Vietnam, respectively.

2. The Domain Name and Registrar

The disputed domain name <highboss.com> is registered with Directi Internet Solutions Pvt. Ltd. d/b/a PublicDomainRegistry.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center on 29, 2011, the Center transmitted by email to Directi Internet Solutions Pvt. Ltd. a request for registrar verification in connection with the domain name.

(iv) the Vietnam Intellectual Property Research Institute (the "VIPRI"), a subordinate agency under the Ministry of Science and Technology of Vietnam, issued a Conclusion of Assessment in which it concluded that the "HIGH BOSS" sign was confusingly similar to the BOSS trade mark which is a protected mark of the Complainant in Vietnam. The VIPRI was of the view that the word "high" was a weak element in the "HIGH BOSS" sign, being descriptive in nature;



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Characteristics of the Expert Evidence

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Federal Express Corporation v. Domain Admin, Domain Whois Protection Service / Hoang Van Thang

Case No. D2018-2243

1. The Parties

The Complainant is Federal Express Corporation of Memphis, Tennessee, United States of America (“US”), represented by BMVN International LLC, Viet Nam.

The Respondent is Domain Admin, Domain Whois Protection Service of Viet Nam / Hoang Van Thang, Hoang Van Thang of Thanh Hoa, Viet Nam.

2. The Domain Name and Registrar

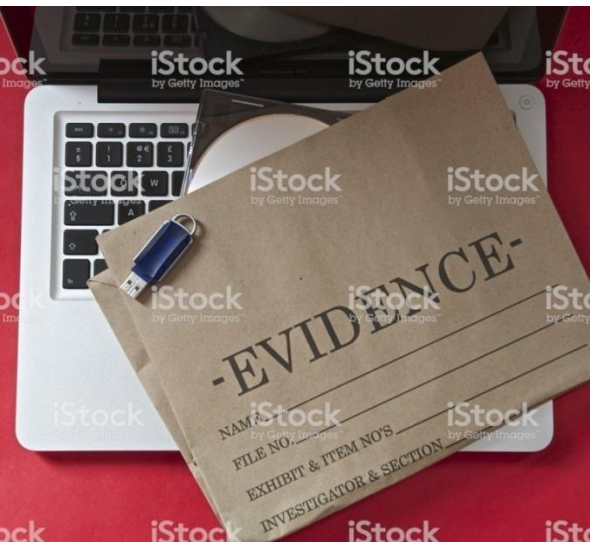
(c) According to the Conclusion of Assessment No. NH220-18YC/KLGD dated May 17, 2018 issued by the Viet Nam Intellectual Property Research Institute (VIPRI), the indication “FedEx VIETNAM.COM”, as shown on the website under the Disputed Domain Name at the time of making the bailiff record, is confusingly similar to the Complainant’s FEDEX Trademark under International Registration No. 1147004, which is protected in Viet Nam. > is registered with P.A. Viet Nam Company Limited (the “Registrar”).

Finally, the Complainant submits that the addition of the generic Top-Level Domain (“gTLD”) suffix “.com” in the Disputed Domain Name does not add any distinctiveness to the Disputed Domain Name. >O Arbitration and Mediation Center (the “Center”) on October 3, ed by email to the Registrar a request for registrar verification in October 4, 2018, the Registrar transmitted by email to the Center its



Some statistics and comments

“ Facts are stubborn, but statistics are more pliable”



Some statistics and comments

**Table 1. Number of All-IP Cases
(Sep. 2009-Oct.2024)**

Year	IP Types				Total
	IV	ID	TM	GI	
Sep. 2009	26	59	107	0	192
2020	48	140	904	2	1094
2021	16	110	938	0	1064
2022	23	129	826	2	980
2023	25	147	1103	6	1281
Oct. 2024	20	112	727	1	860

Some statistics and comments

**Table 2. Purposes of the requests for VIPRI's expert evidences
(Sep.2009-Oct.2024)**

	Purposes	Number of Cases				Total
		IV	ID	TM	GI	
1	Scope of protection	10	4	17	0	31
2	Infringement	229	1287	7164	7	8687
3	Counterfeits	0	0	1023	1	1024
4	Similarity	42	208	1143	7	1400
5	Damages	0	0	0	0	0
6	Others (FTO, TM Clearance, Due Diligence...)	62	130	430	0	622
Total		343	1629	9777	15	11764

Some statistics and comments

**Table 3. IP Enforcement Agencies
(Sep.2009-Oct.2024)**

	Agencies	IP Types				Total
		IV	ID	TM	GI	
1	Courts	7	1	7	0	15
2	People's Committee	0	0	0	0	0
3	Customs	0	0	208	0	208
4	Inspectorates	7	4	46	1	58
5	Market Controls	2	77	482	1	562
6	Polices	2	23	484	3	512
	Total	18	105	1227	5	1355

Some statistics and comments

**Table 4. Purposes of using VIPRI's expert evidences
(Sep.2009-Oct.2024)**

	Purposes of using	IP Types				Total
		IV	ID	TM	GI	
1	Accusation and Handling Infringements	273	1054	7996	7	9330
2	Accusation and Prevent Counterfeits	0	0	919	1	920
3	Opposition of Infringement Accusation/Counterfeits	10	35	127	0	172
4	Opposition of Protection Validity/Scope					
5	Others (TM clearance, due diligence...)	10	5	17	0	32

Some statistics and comments



Some statistics and comments



Some statistics and comments



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Some statistics and comments

- **Summary:**

The involved parties have the right to request the Court and other IP enforcement agencies to solicit expert evidence or to request expertise by themselves. At the request of the involved parties or when deemed necessary, the judge shall issue a decision to solicit expertise (Article 102 of the Civil Procedure Code). Thus, IP expert opinion conclusions (*provided by VIPRI*) are provided at the request of one or more parties to an IP right dispute or as designated by an IP enforcement agencies in order to serve the process of settling IP disputes and infringement cases.

Some statistics and comments

- **Summary:**

Statistics for the period 2009-2024 in VIPRI's perspective show that the demand for industrial property expertise services is increasing at an average of 15% per year, and mainly from businesses and individuals, accounting for 85% of requests for expert opinion conclusions provided by VIPRI.

Some statistics and comments

- VIPRI's expert evidences are used to considering as binding decisions in practice, even as administrative decisions;
- VIPRI's expert evidences become the prerequisite for various IP enforcement procedures;
- VIPRI's expert evidences play a important role as interpretation of IP laws and regulations, as well as construction of IP scope of protection and enforcement analysis in prosecution and/or litigation; in plenty of civil disputes adjudicated by the Courts, they become the source of case laws.
- VIPRI's IP Platform and Data capacity need to be updated and strengthened. **ASEAN IP Register is the essential tool to support the provisions of IP expert opinions.**



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Thank you for your attention!



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