SPECIAL TOPIC: “PROTECTION OF PRODUCT SHAPE/CONFIGURATION”

Prepared by: Nguyen Hai Duong-T&T INVENMARK CO., LTD

PART II. SPECIAL TOPIC: “PROTECTION OF PRODUCT SHAPE/CONFIGURATION”

II.1. The “protection gap” in Viet Nam

Right holders often fall into a gap between two fences: **industrial designs** require novelty, which is lost unless an application is filed within six months of the product being disclosed (sold or advertised); **3D marks** require distinctiveness, which emerges only after years of use and promotion. The gap is more pronounced in Viet Nam because of three factors: a short (six-month) novelty grace period, near-total non-acceptance of 3D marks, and the unavailability of criminal sanctions for industrial designs.

II.2. First tool: industrial designs

Requirements (Article 63): novelty (Article 65), inventive step/creativity (Article 66) and industrial applicability (Article 67).

Novelty grace period (Article 65(4) and (5), as amended by Law No. 131/2025/QH15). From 1 April 2026, an industrial design is not deemed to lack novelty if it was publicly disclosed by the person entitled to register it (Article 86), or by a person who obtained information about the design directly or indirectly from that person, provided that the application is filed within six months of the disclosure; the same applies where the design was disclosed in an application or protection title published by the State authority in breach of the law, or in an application filed by a person not entitled to register. Before that date, the grace period applied only in three cases: unauthorised disclosure by a third party; disclosure in the form of a scientific presentation; and display at a national exhibition of Viet Nam or an official or officially recognised international exhibition. **Sales or advertising of the product by the right holder itself now benefit from the grace period, but only for six months** (compared with 12 months in the EU, Japan, Korea and the United States). The short grace period remains the main cause of the protection gap.

Excluded subject matter (Article 64): appearance dictated by the technical features of the product; the appearance of civil or industrial construction works; and shapes not

visible during use of the product. This exclusion removes many functional shapes from protection.

Term (Article 93): effective from the grant date until the end of five years from the filing date, renewable for two consecutive five-year terms, up to a maximum of **15 years**.

Determination of infringement (Article 126; Decree No. 65/2023/ND-CP). A product infringes if it contains all the essential design features of the protected design or is not substantially different from it. **Likelihood of confusion need not be proven, and affixing a different trademark is no defence.**

II.3. Second tool: 3D marks

(a) Legal basis. Article 72 of the IP Law allows visible signs "including three-dimensional shapes", provided they are distinctive. **The law does not exclude 3D marks in general; the main obstacle is distinctiveness.** Article 74 lists signs lacking distinctiveness (simple geometric shapes; common pictures and names of goods; common shapes of goods, parts of goods, packaging or containers; descriptive signs), with exceptions in certain cases where distinctiveness has been acquired through use before the filing date. In addition, since the 2022 amendment, Article 73(6) excludes signs that are shapes inherent to the goods or necessitated by the technical characteristics of the goods, comparable to the functional-shape exclusion under EU law; this is an absolute ground that cannot be overcome by evidence of use.

(b) National applications. In our experience, **virtually all 3D marks consisting of product shapes filed via the national route have been refused**, on two grounds: (i) the shape is a common, ordinary form for that type of product; and (ii) the shape has not acquired distinctiveness through use, because the applicant has failed to show that *the shape itself* (rather than a logo printed on the product) is recognised by Vietnamese consumers as a badge of origin.

(c) Views and drawings showing the 3D shape. For 3D marks, the IP Office of Viet Nam routinely requires the applicant to **submit additional views and drawings showing the three-dimensional shape of the product**, i.e. perspective views sufficient to define the shape completely, together with a description of the mark. A single flat image or a single view is not sufficient to define the sign to be protected. The views and drawings must be consistent with one another and with the description, and must show only the shape to be protected; other elements (words, patterns) distort the scope of protection. These views and drawings define only the *sign*; they do not replace evidence of distinctiveness.

(d) International (Madrid) applications designating Viet Nam. A significant number of international registrations designating Viet Nam cover 3D marks, but they commonly face two types of problem:

- **Defective representation:** the mark specimen does not properly represent a 3D mark (a single flat image, missing views, no description, or other elements included), so the mark is treated as a figurative mark or the applicant is asked to clarify and submit additional views and drawings.
- **Refusal for lack of distinctiveness despite protection elsewhere.** Reasons: the principle of independence of marks (Article 6(3) of the Paris Convention); Article 6quinquies B(2) permits refusal of marks devoid of distinctive character, and Article 6quinquies C(1) requires that all factual circumstances, in particular the length of use, be taken into account; and evidence of use abroad cannot substitute for evidence of perception by *Vietnamese* consumers.

On receipt of a provisional refusal, the holder must respond within the prescribed time limit through an industrial property agent in Viet Nam.

(e) Why is "acquired distinctiveness" hard to prove? The burden of proof lies with the applicant; the evidence (sales, advertising, geographical scope, duration, consumer surveys, awards, press coverage) must relate to the Vietnamese market, pre-date the filing date, and show that consumers identify the origin *from the shape alone, without the logo*. There is no established practice of using independent consumer surveys in examination.

(f) Well-known marks. Rights in a well-known mark are established through use (Article 6(3); criteria in Article 75). A product shape could in theory reach this threshold, but the threshold is very high and is typically considered only in disputes, so this is not a preventive tool.

II.4. Copying a product shape versus infringing an established IP right

Principle. An IP right is an exclusive right within a defined *scope, term and territory* (Articles 6 and 7). Outside those limits, imitating a shape is a matter of free competition. "Copying" is a factual act; "infringement" is a legal conclusion that arises only when four conditions are met:

1. **A right exists** and has been validly established *in Viet Nam* (rights obtained abroad have no effect in Viet Nam; an international registration takes effect only where Viet Nam has not refused it or has withdrawn its refusal);
2. **The right is in force**, and has not been terminated or invalidated (Articles 95 and 96);

3. **The conduct falls within the acts deemed to be infringement** (Article 28 for copyright; Articles 126–129 for industrial property rights; Article 130 for unfair competition);

4. **The specific infringement criteria** for that type of right are satisfied.

Basis	Ground of establishment	Infringement test	Confusion/reputation to be proven?
Industrial design	Registration	Contains all essential design features or is not substantially different	No
Trademark (including 3D)	Registration (well-known marks: use)	Identical or confusingly similar sign for identical or similar goods/services	Yes (for similar signs)
Copyright (works of applied art)	Automatic upon creation and fixation	Unauthorised reproduction of the work	No
Unfair competition	No exclusive right; conduct-based	Misleading commercial indications (Article 130(1)(a) of the IP Law)	Yes

Scenarios.

- *No right at all:* a competitor makes an identical product under a different brand. This is copying of the shape, but **no IP right is infringed**; the only remaining options are copyright or unfair competition.
- *A valid industrial design:* a knock-off that is "not substantially different" **infringes the design**, regardless of the trademark affixed to it.
- *A registered 3D mark, but the competitor affixes its own prominent mark:* infringement depends on whether the shape is used *as a badge of origin* and whether there is a likelihood of confusion.
- *A 3D mark registered in Japan, Singapore or Malaysia but not protected in Viet Nam:* knock-offs sold in Viet Nam **do not infringe any right in Viet Nam**.
- *A design that has expired or been invalidated for lack of novelty:* the shape is in the public domain; copying is lawful unless another basis exists.

"Counterfeit goods", "infringing goods" and "knock-offs". The law defines only counterfeit IP goods (Article 213) and goods infringing a specific right. "Knock-off" is a colloquial term with **no legal definition**; knock-offs can be acted against only if they also fall into one of those two categories or constitute unfair competition. Enforcement authorities therefore always require the right holder to first establish *the legal basis of its right*.

II.5. The six research questions of the Special Topic

1. Can shapes be protected by copyright, unfair competition or passing off?

Copyright. Works of applied art are protected (Article 14(1)(g); definition in Decree No. 17/2023/ND-CP). Rights arise automatically upon creation and fixation (Article 6(1) and Article 49), **with no novelty requirement, so there is no "grace period gap"**. Article 15 excludes processes, systems, methods of operation, concepts and principles; only the specific creative form of expression is protected. The term of protection is shorter than for ordinary works: 75 years from first publication or, if unpublished within 25 years of fixation, 100 years from fixation (Article 27(2)(a)). The law does not provide for a "separability" test between aesthetic and functional features; in practice, the question is whether the shape bears a creative imprint going beyond functional requirements. Designer chairs, handbags and distinctively shaped bottles have good prospects; building blocks, erasers and cool boxes have poor prospects. Ownership is determined under Article 39 and the relevant contracts; the absence of an assignment agreement with the designer is a common risk. A registration certificate (Copyright Office of Viet Nam; Decree No. 17/2023/ND-CP) is not a condition for the right to arise but is important evidence.

Unfair competition. Article 130(1)(a) of the IP Law prohibits the use of misleading commercial indications as to the business entity, business activities, commercial origin, origin or characteristics of goods or services; Article 130(2) defines commercial indications as including trademarks, trade names, business logos, business slogans, geographical indications, packaging designs of goods and goods labels. The Competition Law 2018 no longer contains the misleading-indications offence found in the Competition Law 2004; Article 45 of the Competition Law 2018 covers other conduct (for example, unlawfully enticing customers). A shape that has become a source identifier may, on a broad interpretation, be treated as a "business logo" or "packaging design"; **there is no provision directly addressing imitation of shapes**. The claimant must prove reputation, confusion and a competitive relationship.

Passing off. Viet Nam is a civil-law jurisdiction and **has no doctrine of passing off**. Equivalent functions are performed by three mechanisms: misleading commercial indications (Article 130 of the IP Law); unregistered well-known marks (Article 6(3), Article 75); and non-contractual liability for damages (Articles 584 and 585 of the Civil Code 2015). There is no general principle protecting "goodwill" as such.

2. Enforcement of copyright and unfair competition through administrative, civil and criminal measures

Basis	Administrative	Civil	Criminal
Copyright	Decree No. 341/2025/ND-CP; authorities commonly require an expert assessment for works of applied art	Article 202 (civil remedies), Article 205 (damages), provisional urgent measures	Article 225 of the Penal Code; difficult to apply to applied art
Unfair competition	Decree No. 99/2013/ND-CP (Article 14, as amended) for unfair competition in industrial property under Article 130 of the IP Law; Decree No. 75/2019/ND-CP (as amended by Decree No. 102/2026/ND-CP) for conduct under the Competition Law 2018; reputation and confusion must be proven	Civil action under the IP Law (Articles 198 and 202) and the Civil Code 2015; outcomes hard to predict	No specific offence, unless combined with counterfeiting of trademarks or goods labels (Articles 192, 226)

Where material damage cannot be quantified, the court determines the damages up to a maximum of VND 1 billion (Article 205(1)(d), as amended by Law No. 131/2025/QH15; previously VND 500 million).

3. Case precedents and prior decisions

Viet Nam applies case precedents under Resolution No. 04/2019/NQ-HDTP (replacing Resolution No. 03/2015/NQ-HDTP). To our knowledge, no published case precedent directly addresses protection of product shapes by copyright or unfair competition. For 3D marks, the de facto "precedent" is *the consistent examination practice of refusal*, not a case precedent. Members are invited to share specific judgments and decisions for comparison.

4. Customs and e-commerce platforms

What the right holder has	Customs	E-commerce platforms
Industrial design or trademark registration certificate (including international registrations protected in Viet Nam)	Sufficient basis to request supervision and suspension	Usually accepted; high takedown rate
Copyright only	Feasible with a registration certificate; limited effectiveness	Feasible with a registration certificate
No registration (unfair competition, unregistered well-known mark)	Virtually no basis for suspension	Usually rejected because the right cannot be verified

The new 2025–2026 tools (automated detection systems, domain-name blocking, platform operator obligations under the Law on E-commerce 2025) are all tied to registered rights; their direct value for unregistered shapes is very limited.

5. Strategy where the product has already been launched

Immediately: file an industrial design application at once if fewer than six months have elapsed since the first disclosure (Article 65(4)); register copyright in drawings and design models, and review contracts with designers and contract manufacturers; register word/logo marks (unlocking the full range of administrative, criminal and customs tools); register 2D figurative marks depicting the product together with distinctive elements; have a bailiff's record drawn up documenting evidence of the launch date, advertising and sales.

Medium term: build a file proving distinctiveness *in Viet Nam* (sales, advertising, independent surveys on shape recognition); file 3D mark applications **in the correct form**, with complete perspective views and drawings and a consistent description, showing only the shape to be protected; for Madrid applications designating Viet Nam, clearly indicate a 3D mark, appoint a local agent in advance and prepare a response to provisional refusal; register designs for new generations, variants and partial designs before launch (at the latest within the six-month grace period from disclosure), using the six-month Paris Convention priority when filing in other countries.

Proactive enforcement: monitor the market and platforms; record the right with Customs for supervision as soon as it is granted; bring proceedings on multiple bases in parallel; use communications to establish the shape as a brand identifier.

Comparison. Japan, Singapore and Malaysia have registered 3D marks upon evidence of acquired distinctiveness; Viet Nam has among the highest evidentiary thresholds, so strategy must rely on *copyright and industrial designs from the outset*, not on "a 3D mark later".

6. Enforcement difficulties, assuming the rights exist

Arising from differences in the basis of rights and infringement criteria:

- *Two different tests:* for industrial designs, "not substantially different", without confusion; for 3D marks, "confusingly similar" and use of the shape as a badge of origin. A knock-off bearing a different prominent mark may infringe the design but not the 3D mark; a right holder holding both rights may still face inconsistent findings.
- *Two different vulnerabilities:* designs are exposed to counter-attack by invalidation actions for lack of novelty (Article 96); 3D marks are exposed to attack for lack of distinctiveness at the time of grant or for falling under Article 73(6), for becoming

generic, or for non-use for five consecutive years (Articles 95 and 96); copyright often lacks evidence of date, authorship and ownership.

- *Different scopes of rights:* the scope of a design is limited by its set of photographs and drawings; the scope of a 3D mark is limited by the mark specimen and the list of goods. If the 3D views and drawings filed are incomplete or include other elements, the scope may not cover the copied shape.

Specific difficulties: determining the "essential" features and the degree of "substantial difference" remains subjective, and knock-offs vary minor details; expert assessments are time-consuming and costly; there is no clear mechanism for post-sale confusion; designs last at most 15 years; damages are not sufficiently deterrent; cross-border sales make it hard to identify sellers; and enforcement authorities differ in their understanding of the line between "copying" and "infringement".

II.6. Recommendations to the Committee

1. **Extend the novelty grace period** for industrial designs from six to twelve months (the 2025 Law has extended the grace period to all disclosures by the right holder, including sales, but the period remains only six months, shorter than the twelve months applicable to inventions under Article 60(3)).
2. **Publish examination guidelines for 3D marks** on acceptable types of evidence, in particular consumer surveys, and on requirements for views and drawings, to avoid refusals on formal grounds, especially for international applications.
3. **Exchange examination criteria and practice** among APAA jurisdictions on the distinctiveness of product shapes.
4. **A mechanism to protect shapes with an established reputation** through unfair competition law, with guidance on evidence of reputation.
5. **Minimum criteria for e-commerce platforms** to handle complaints regarding unregistered shapes (copyright registration certificates, dated design documents).
6. **A shared database of case law** and administrative decisions relating to product shapes.

CONCLUSION

Viet Nam's legal framework in 2026 has made significant progress against counterfeiting: a broader definition of industrial design, shorter procedures, online enforcement tools and clearer platform obligations. However, these tools mainly serve rights that **have already been established**. For shapes that have been commercialised without registration, the gap

in Viet Nam is wider than in many other countries: a short grace period, near-total non-acceptance of 3D marks, no passing off, limited customs intervention, and no criminal sanctions for industrial designs.

Three practical recommendations: **(i)** register industrial designs *before* disclosure, or at the latest within six months of disclosure; **(ii)** immediately build a layer of protection through copyright and word/figurative marks, and file 3D mark applications in the correct form only once Vietnamese market evidence is available; **(iii)** from the first day of commercialisation, proactively preserve evidence of consumer recognition of *the shape itself*. And one principle to remember: **copying a shape is infringement only where a right has been validly established in Viet Nam and the conduct falls within the scope of that right.**

APPENDICES

Appendix A. Tools for protecting and enforcing product shapes in Viet Nam

Tool	Key requirements	Term	Admin.	Civil	Criminal	Customs	E-commerce
Industrial design	Novelty, creativity, industrial applicability	Up to 15 years	Yes	Yes	No	Yes	Favourable
Trademark (including 3D)	Visible, distinctive	10 years, renewable indefinitely	Yes	Yes	Yes (Article 226; Article 192 for counterfeit goods)	Yes	Favourable
Copyright	Originality, fixation	75 years from first publication (Article 27)	Yes	Yes	Difficult (Article 225)	Limited	Feasible with a registration certificate
Unfair competition	Reputation, confusion	N/A (conduct-based)	Yes	Yes	No	No	Difficult

Appendix B. Legislation cited

IP Law No. 50/2005/QH11 (as amended in 2009, 2019 and 2022, by the Law on Science, Technology and Innovation No. 93/2025/QH15 and by Law No. 131/2025/QH15); Civil Code 2015; Penal Code 2015 (as amended in 2017); Competition Law 2018; Customs Law 2014; Law on Handling of Administrative Violations 2012 (as amended in 2020 and 2025); Law on E-commerce No. 122/2025/QH15; Decree No. 65/2023/ND-CP (as amended by Decrees No. 15/2026/ND-CP, 33/2026/ND-CP and 100/2026/ND-CP);

Decree No. 17/2023/ND-CP; Decree No. 99/2013/ND-CP (as amended by Decrees No. 126/2021/ND-CP, 46/2024/ND-CP and 186/2026/ND-CP); Decree No. 341/2025/ND-CP; Decree No. 75/2019/ND-CP (as amended by Decree No. 102/2026/ND-CP); Decree No. 98/2020/ND-CP (as amended by Decrees No. 17/2022/ND-CP and 24/2025/ND-CP); Consolidated Text No. 06/VBHN-BKHCN (Decree No. 65/2023/ND-CP as amended); Circular No. 23/2023/TT-BKHCN; Circular No. 10/2026/TT-BKHCN; Resolution No. 04/2019/NQ-HDTP; Paris Convention (Articles 6 and 6quinquies); Madrid Protocol and Common Regulations.