**PROCEDURES FOR TRADEMARK TRANSFER WHEN THERE WAS PROTECTIVE CERTIFICATE**

***Legal basis:***

*Intellectual Property Law 2005 to amend and supplement 2019*

*Circular 01/2007/TT-BKHN is amended and supplemented by Circular 16/2016/TT-BKHCN.*

1. **What are trademark transfers?**

is defined in Clause 1 Article 138 Intellectual Property Law 2005 to amend and supplement 2019 (“**Intellectual Property Law”)** as follows:

Trademark transfer is the transfer of ownership rights for other individuals and organizations.

1. **How to transfer a trademark?**

According to the Intellectual Property Law, the transfer of trademark ownership must be established in the form of a written contract (hereinafter referred to as the trademark transfer contract).

1. **Are there any restrictions on trademark transfer?**

According to Article 139 of the Intellectual Property Law, Conditions restricting the transfer of trademarks include:

* Trademark owners may only assign their rights within the scope of protection;
* The transfer of rights to trademark must not cause confusion about the characteristics and origin of goods or services bearing the trademark;
* Rights to label effects are transferable only to the organization, individuals who meet the conditions for trademark registration holders.
1. **What is the procedure for trademark transfer?**

In Circular 01/2007/TT-BKHN the order and procedures for trademark transfer are as follows:

**Step 1:** The parties agree and establish the trademark transfer contract.

**Step 2:** Submit a set of transfer contract registration documents at the National Office of Intellectual Property to register the transfer contract.

**Step 3:** The NOIP receives and processes the application for registration of a trademark transfer contract.

* In case the registration dossier is valid, the NOIP shall:
* Make a decision to recognize the transfer of trademark ownership rights to individuals and organizations.
* Proceed to record in the new protective certificate, recognition of the transfer of ownership rights to the trademark and National register of industrial property rights transfer.
* Announce the decision to recognize the transfer of industrial property rights on the Industrial Property Official Gazette within 2 months from the date of signing the decision.
* In case the registration dossier is invalid, the NOIP:
* Issue a notice of intention to refuse to sign the contract, highlight any deficiencies in the record. The applicant has a time limit of 2 months from the date of signing the notice to correct errors or give comments;
* Make a decision to refuse to sign the contract if the applicant does not correct or there is an error correction but not satisfactory or no other opinion.

1. **What does a trademark transfer dossier include?**

Trademark Transfer Dossier are specified in Article 149 of the Law on Intellectual Property, include:

* The registration form according to the prescribed form;
* The original or valid copy of the transfer contract;
* The original of the protection certificate in case of transfer of industrial property rights;
* The written consent of the co-owners, the written explanation of the reasons for the disagreement of any of the co-owners on the transfer of rights if the industrial property rights are jointly owned;
* Proof of payment of fees and charges;
* Power of attorney (if any).
* For an application file for registration of a contract for assignment of a collective mark or a certification mark, in addition to the above documents, the following documents are required: (i) Regulations on the use of collective marks, regulations the use of the transferee's certification mark in accordance with regulations; (ii) Documents proving the transferee's right to file an application for a certification mark or collective mark as prescribed.
1. **What are the contents of a trademark transfer contract?**

The main contents of a trademark assignment contract are specified in Article 140 of the Intellectual Property Law, specifically:

* Full name and addresses of the assignor and assignee;
* Grounds for assignment;
* Assignment price; and
* Rights and obligations of the assignor and assignee.

In addition, the parties may agree on other terms that are not contrary to the provisions of law.

Above are some basic contents related to procedures for trademark transfer when there was a protective certificate.

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