

## Resolving disputes over domain names in Vietnam



**By Nguyen Thi Hong Anh**

This article focuses on resolving disputes over domain names which are identical or confusingly similar to registered trademarks/trade names in Vietnam. According to the current Law on Information Technology and regulations guiding the implementation thereof, such domain name disputes can be resolved in three ways: through negotiation or conciliation; arbitration; or litigation at the competent court. Meanwhile, according to the current Law on Intellectual Property and relating regulations, acts of registering or appropriating the right to use, or using domain names identical or confusingly similar to protected trademarks of other parties in order to appropriate domain names, taking advantage of or harming reputation of those marks, trade names shall be considered as acts of unfair competition, and therefore, can be resolved through administrative proceedings.

In order to initiate a domain name dispute case at the competent court, the plaintiff must provide evidence satisfying the following conditions: (i) the disputed domain name is identical or confusingly similar to the name of the plaintiff, or to the trademark or service mark to which the plaintiff has lawful rights or interests; (ii) the defendant has no lawful rights or interests related to the domain name; and (iii) the domain name is used by the defendant with a malicious intent toward the plaintiff. Thus, a defendant is considered as having lawful rights and interests related to the domain name if he has used or has proof that he is going to use this domain name concerning the actual supply of goods or the provision of services before the dispute arises; or is known to the public for this domain name though he does not have rights to the trademark or service mark; or is lawfully using this domain name in non-commercial activities, legitimately using this domain name for non-commercial purposes or this domain name causes public misunderstanding or confusion, affecting the plaintiff's trade name, trademark or service mark; or has other proof evidencing the lawfulness.

The use of a domain name is considered malicious in the case of, among other circumstances: leasing or transferring a domain name to the plaintiff being the proprietor of a trade name, trademark or service mark identical or confusingly similar to this domain name; leasing or transferring the domain name to the plaintiff's competitors for self interests or illicit profits; appropriating, or preventing the proprietor of a trade name, trademark or service mark from registering a domain name corresponding to the trade name, trademark or service mark:

defaming the plaintiff or hindering the plaintiff's business operation or causing public confusion about or distrust in the plaintiff's trade name, trademark or service mark. It may take from six to twelve months from the date of acceptance of the petition for the court to consider the case. Based on a valid judgment of the court, the disputed domain name will be revoked by the VNNIC, and the plaintiff will have fifteen days from the effective date of such judgment for the registration of the domain name.

Under the administrative proceedings, evidence provided by the claimant shall include, but not be limited to, relevant registration certificates, conclusion on the identicalness or confusing similarity between the domain name and protected IP objects, and other evidences for proving the purpose of appropriating domain names, taking advantage of or harming the reputation of the protected IP object by the holder of the domain name. The revocation of the domain name may be imposed as a measure for remedying the consequence of the infringement. Unfortunately, the revocation of the domain name under the administrative proceedings can be implemented for the National code domain names '.vn', but not for international domain names. In addition, because of inconsistencies between IT Law and IP Law, there are conflicts between the views of the VNNIC and the Inspectorate of the Ministry of Science and Technology – the competent authority for handling domain name disputes under the administrative proceedings, so that certain domain name cases get stuck in implementing the administrative decision of the said Inspectorate by VNNIC.

In order to overcome the said inconsistency of regulations, at present, the Ministry of Information Technology and the Ministry of Science and Technology are drafting a joint circular for providing a mechanism of cooperation of competent authorities in handling the domain name disputes in Vietnam. It is expected that the joint-circular will be issued soon.

### **Indochine Counsel**

#### *Ho Chi Minh City Office*

Unit 305, 3rd Floor, Centec Tower  
72-74 Nguyen Thi Minh Khai, Ward 6, District 3  
Ho Chi Minh City, Vietnam

Tel: (84) 8 3823 9640 / Fax: (84) 8 3823 9641

**Email: anh.nguyen@indochinecounsel.com**

#### *Hanoi Office*

Unit 705, 7th Floor, CMC Tower, Duy Tan Street  
Cau Giay District, Hanoi, Vietnam

Tel: (84) 4 3795 5261 / Fax: (84) 4 3795 5262

**Email: hanoi@indochinecounsel.com**

**www.indochinecounsel.com**