

Some takeaways on overcoming provisional refusals against International Registration designating Cambodia


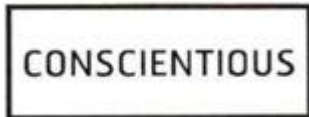
Overview:

As you know, Cambodia became a member of the Madrid System for the International Registration of Mark on 05 June 5 2015. The system facilitates the filing of applications in multiple countries around the globe. Rather than having to file a trademark application in each country, a trademark owner can file a single application with their national or regional IP office, and then designates protection of their mark in Madrid member countries. This greatly simplifies and reduces the cost of the process, however in case your trademark faced a provisional refusal by the Department of Intellectual Property of Cambodia, what do you have to do to protect your trademark in that case? Our firm, KENFOX IP & LAW OFFICE has succeeded in the event that an IR designating Cambodia faced a provisional, via filing a response to the Provisional Refusal issued by Department of Intellectual Property of Cambodia (“DIP”).

Background:

HB Global Co., Ltd. (“**HB Group**”), a Korea-based legal entity, filed an application for international registration seeking protection for a word mark under IR No. 1393221 designating Cambodia. The DIP issued, after its substantive examination, a Notification of Provisional Refusal against IR No. 1393221. The ground for rejecting International Registration Designating Cambodia (“**IRDC**”) exists under the provision of Article 12 the Cambodian trademark law and another is the confusing similarity to the cited trademark “CONSCIENTIOUS, device” under trademark application No. KH/75275/17.


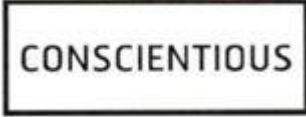
Details of the cited mark are as follows:

Proposed trademark under IR. No. 1393221	Cited National Reg. No. KH/75275/17
	
<p>Class 03: Cake flavorings [essential oils]; food flavorings [essential oils]; flavorings for beverages [essential oils]; ... cosmetic creams; perfume;....</p> <p>Class 05: Deodorants for clothing and textiles; ...).</p>	<p>Class 03: Cosmetics;...</p>

Actions taken:

Statutorily, the applicant is entitled to file a response to the Cambodia IP Office’s refusal within 60 days (*extendable one time only for another 60-day period*) upon receipt of the Notification of the refusal thereof from the International Bureau by submitting a petition to the Cambodia IP Office to request this office to revoke its refusal. Generally, the applicant of an IRDC may overcome a provisional refusal based on a prior mark by taking the following options: (i) arguing on the dissimilarity between the mark at issue and the citation, (ii) seeking for a Letter of Consent from the owner of the citation or (ii) taking 5-year non-use cancellation against the citation in case the citation is found non-used in Cambodia for the past 5 years.

Taking the proposed mark and the cited one into consideration, as instructed by **HB Group**, we filed a response to the Cambodia IP Office, rendering arguments on dissimilarities on trademark structure/representation, trademark pronunciation and trademark meaning made by each mark. In details:

The applied-for trademark	The cited trademark
<p style="text-align: center;">  </p> <p>The word “consensus” has only 9 letters, i.e. /c-o-n-s-e-n-s-u-s/, is pronounced into 3 syllables as follows: /kənˈsen - səs/</p>	<p style="text-align: center;">  </p> <p>The word “CONSCIENTIOUS” has 13 letters, i.e. /C-O-N-S-C-I-E-N-T-I-O-U-S/, is pronounced into /kən - ʃiː - en - ʃəs/</p>

From the above table, it can be seen that the client’s mark is different from the cited mark in (i) trademark structure and presentation; (ii) trademark pronunciation and (iii) trademark meaning. In addition, our further analysis is made on the designated goods in Classes 03 and 05 as compared to the goods bearing the cited mark. In respect of this, it is widely known that, the main purpose of the goods (cosmetic related products) in Class 03 is to make the users becomes more beautiful. Meanwhile, the goods in Class 05 which are mainly “pharmaceutical products” are used to cure, treat, or prevent disease/illness which relates to the “patient health”. Further, our client’s mark comprises the “Korean characters”, making it be more distinctive from the cited mark. Detailed analysis on different structure/representation, trademark pronunciation and trademark meaning given by the two marks in question has been particularly made and stressed in our response. Based on our analysis on dissimilarities of the marks in question, we emphasized that likelihood of confusion on the commercial origin of services bearing the said marks cannot be established.

Outcome:

Having reviewed our response, the Cambodian DIP found that our arguments are rooted and convincing, as such, annulled Provisional Refusal Notification No. 2020/16591 dated 23 July 2020 and approved protection for the mark “” under IR No. 1393221 in the name of HB Global Co., Ltd. in Cambodia.

Takeaways:

- (1) The Cambodia IP Office has a propensity to perform a relatively stringent analysis and does not take adequate account of all relevant factors and circumstances in each particular case, resulting in unnecessary and unconvincing refusal of trademarks.
- (2) Generally, to assess the relevance of an earlier trademark right as a ground for refusal, the examiner must take into account both (i) the marks in conflict and (ii) the specifications of goods/ services covered by those marks. In this regard, it is critical to compare the marks and the corresponding goods/services to ascertain whether they are close enough to cause prejudice to the holder of the earlier right and confusion to the buying public. When comparing the similarity of the marks, the question of confusion must be answered by comparing the marks as wholes. This requires that all the relevant circumstances be taken into consideration in a single global assessment, meaning all factors need to be weighed.
- (3) If the goods/services bearing the marks in question are identical or similar, arguments and analysis should center on working out the differences between the applied-for mark and the citation to refute the finding of confusion by the examiner. Comparison should include all the elements (i.e. verbal and figurative elements) in the marks. The likelihood of confusion must therefore be assessed globally, taking into account of all factors applicable to the circumstances of the case. That global assessment of the visual, aural or conceptual similarity of the marks concerned must be predicated on the overall impression provided by the marks, being mindful that the particular distinctive and dominant components contained in this mark may prevail over others, thus making the marks at issue be perceived and memorized in different ways by the consumers.
- (4) While comparing two marks to assess likelihood of confusion, the distinctive strength of the elements (the prominent element) contained in the marks must be taken into account. In assessing a purely figurative mark with a composite mark (including words and device), it is significant that more emphasis should be placed on the word element. Words are naturally more memorable. In such perspective, the word element in a composite mark always plays a key role in helping customers memorize such mark and prevails over the

figurative element because consumers will tend to read and retain the word(s) rather than the accompanying visual elements. In this context, despite similarities in certain aspects found in a purely figurative mark and with a composite mark, such similarity cannot sustain a finding of likelihood of confusion.

**By Nguyen Vu QUAN
Partner & IP Attorney**

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com