

Overcoming Notification of Provisional Refusal against an IR designating Cambodia – what should be taken into account?

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:

SELECTIS - PRODUTOS PARA A AGRICULTURA, S.A. (“**SELECTIS**”), a Portugal-based legal entity, filed an application for international registration seeking protection for a mark under Int’l Registration No. 1414590 designating Cambodia. The Department of Intellectual Property of Cambodia (“**Cambodia IP Office**”) issued a Notification of Provisional Refusal No. 2019/23930 dated 18 October 2019 against the IR No.1414590. The ground for rejecting International Registration Designating Cambodia (“**IRDC**”) exists under the provision of Article 4 (g), the Law concerning Marks, Trade Names and Acts of Unfair Competition of Cambodia. In detail, the proposed mark is deemed substantially identical with or deceptively similar to a prior mark, and is for similar or closely related goods and/or services. Details of the proposed mark and cited mark are as follows:

Proposed trademark under IR. No. 1414590	Cited mark under IR. No. 1302325	Cited National Reg. No. KH/72175/19	Cited National Reg. No. KH/69039/18
<p>ASCENZA</p>			
<p><i>Class 01: Culture media, manure and chemical products for use in agriculture, horticulture and forestry; fertilizers and chemical products for use in agriculture, horticulture and forestry; Chemical additives for use in agriculture; chemical additives for use in horticulture; chemical additives for use in forestry; fertilizers; fertilizers for the soil; Soil fertilizers; fertilizing preparations; chemical products for use in agriculture, horticulture and forestry; chemical products intended for herbicides; chemical products intended for pesticides;</i></p>	<p><i>Class 01: Chemical additives for lubricants, oils, fuels and greases; chemical additives for use in the production of lubricants, oils, fuels and greases; chemical additive concentrates for use in lubricants, oils, fuels and greases; transmission oil; transmission fluids; antifreeze; coolants; radiator flushing chemicals; chemical products for use in radiators; leak sealing additives for radiators and cooling systems; sealant preparations for motor vehicle radiators; brake fluids; hydraulic fluids; hydraulic oils; power</i></p>	<p><i>Class 01: Industrial chemicals; Chemical preparations for the protection of metallic and painted surfaces, chrome, fabric, leather, plastic materials as part of automobiles; Chemicals and chemical preparations for use in cleansing and polishing automobiles; Chemical compound for removing coatings, paints, putty, greases, waxes, dust, dirt and pollution; Chemical preparations for removing carbons and sludge in engines of automobiles; Coating agents [chemicals], other than paint; Chemical preparations for repelling water; Water repellents (chemicals); Chemical preparations for preventing the tarnishing of glass; anti-</i></p>	<p><i>Class 06: Keys of metal; Metal ceilings; Aluminium foil; Metal door hardware; Roll doors of metal; Doors of metal; Door fittings of metal; Door bolts of metal; Door knobs of common metal; Door knockers of metal; Door guards of metal; Door handles of metal; Door hinges of metal; Door holders of metal; Non-electric door locks of metal; Door holding devices of metal; Hinge clamps of metal; Hinges of metal; Assemblies of metal doors adapted to slide; Hand rails of metal; Wheel clamps (boots); Pins of metal for</i></p>




chemical products for use in horticulture; chemical products for use in forestry; plant growth regulating preparations; chemical products for use in agriculture” Class 05: “Preparations and articles for pest control; fungicides; herbicides; insecticides; pesticides for agricultural use; preparations for repelling vermin; products for destroying vermin; veterinary products; veterinary preparations	steering fluids; suspension fluids; adhesives for industrial purposes; adhesives for automotive use	tarnishing chemicals for windows; Chemicals and chemical preparations for use in de-icing. Class 35: Online retail or wholesale services for a variety of goods for use in cleaning and polishing automobiles; Retail or wholesale services for a variety of goods for use in cleaning and polishing automobiles; Business management assistance; Professional business consultancy; Operation and management of franchise business; Business Consultancy to franchisee.	wheels; Seals of metal for shock absorbers; Wire rope; Metal ropes; Window stops of metal; Door stops of metal; Gate stops of metal; Stops of metal; Metal Louver.
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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 marks into consideration, as instructed by **SELECTIS**, we filed a response to the Cambodia IP Office, rendering arguments and analysis on dissimilarities on trademark representation, trademark structure, trademark pronunciation, trademark meaning and also to conduct a comparison of goods or services bearing the applied-for mark to those bearing the cited marks. Detailed analysis on different visual impression given by the four marks in question has been particularly made and stressed in our response. Based on our arguments and analysis on non-similarity between the cited marks and the applied-for mark, we emphasized that likelihood of confusion on the commercial origin of services bearing the said marks cannot be established.

In details:

	Applied-for trademark under IR. No. 1414590	Cited mark under IR. No. 1302325	Cited National Reg. No. KH/72175/19	Cited National Reg. No. KH/69039/18
Marks	ASCENZA			
Pronunciation	/as- cen - za/	/es-sen-za/	/sen - sa/	/cen - za/
Structure and presentation	Comprises of the letters “ASCENZA”	Comprises the verbal element “e”, in white, placed in a circle with a black background. Below is the word “esscenza” in lowercase	Comprises the verbal element “SENSHA”, represented in green capitalized letter and there is a figurative element before the verbal element.	Comprises of the letters “CENZA”
Goods bearing	The goods are	The goods are	The goods are	The goods bearing

the trademarks	chemicals or chemical additive intended for “agriculture, horticulture and forestry” and they can be “manure”, “soil fertilizers”, “herbicides, pesticides”	chemical additives for lubricants, oils, fuels and greases.	chemical preparations used in automobile sector.	the cited mark in Class 06 (accessories made of metal for houses and doors) are completely different from the goods in Class 01 and 05
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Outcome:

Having reviewed our response, the Cambodian DIP found that our arguments are rooted and convincing, as such, annulled Provisional Refusal Notification No. 2019/23930 dated 18 October 2019 and approved protection for the mark “ASCENZA” under International Trademark Registration No. 1414590 in the name of SELECTIS - PRODUTOS PARA A AGRICULTURA, S.A. in Cambodia.

Takeaway:

1. The Cambodia IP Office tends to conduct a quite stringent examination and does not take sufficient account of all factors and circumstances relevant in each particular case, resulting in excessive and unconvincing refusal against applied-for trademarks.
2. As a matter of principles, to determine the relevance of an earlier trademark right as a ground for refusal, the examiner must necessarily consider both (i) the marks in conflict and (ii) the specifications of goods/ services covered by those marks. In this regard, it is necessary 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. In case the goods/services bearing the marks in question are identical or similar, arguments and analysis should focus on standing out (distinguishing) 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 (*e. verbal and figurative elements*) in the marks. The likelihood of confusion must therefore be assessed globally, taking into account of all factors relevant to the circumstances of the case. That global assessment of the *visual, aural or conceptual* similarity of the marks in question, must be based on the overall impression provided by the marks, bearing in mind 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. When comparing marks at issue to determine 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*), 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 pivotal role in memorizing 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 sense, despite similarity in certain aspects found in a purely figurative mark and with a mixed mark, such similarity cannot sustain a finding of likelihood of confusion.

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