

How to respond to pharmaceutical trademark refusals in Cambodia?

Introduction

The increasing number of trademarks, especially pharmaceutical trademarks, and the excessively stringent examination of trademarks are the primary reasons for various trademark refusals in Cambodia. Examiners from the Cambodian IPO frequently cite prior marks that appear to be quite similar to applied-for marks at first glance, but are distinguishable when examined more closely. However, if an applicant's trademark application is refused and the applicant chooses to abandon/ do not pursue a trademark application, continuing to use the refused trademark in commerce is a risky decision. Utilizing a trademark that is found to be confusingly similar to another party's trademark may expose you/your company to potential legal risks, as it is highly likely that the other party will initiate legal action against you once they learn that you are using a trademark that has been refused by DIP due to being confusingly similar to their mark. Thus, registering a trademark successfully in Cambodia is the initial and most critical step before commercializing your trademarked products.

For trademarks that have been rejected, it is clear that overcoming the IP Office's trademark refusal is akin to fighting a battle. Along with efforts to pursue the trademark applications, IP attorneys in this market must be familiar with the law and practice of trademark registration in Cambodia, possess extensive expertise and take a righteous and creative approach. It is not uncommon for trademark applications to be refused registration after the applicant submits a response/complaint at least twice, yet their trademarks are ultimately denied protection by the Cambodian IPO. Meanwhile, customers do not want and tolerate wasting their time and money on actions/measures that will ultimately result in a negative outcome that jeopardizes their business development objectives.

KENFOX IP & Law Office is pleased to announce that we have won two consecutive victories for EURODRUG, a prestigious pharmaceutical group from the Netherlands.

Two rejected pharmaceutical trademarks “SPASMOPRIV” and “PUROXAN”

EURODRUG Laboratories B.V. was founded in the 1980s in the Netherlands. The EURODRUG quickly expanded into Asia and different continents. Currently, EURODRUG has commercial presence in 4 continents, providing a wide range of pharmaceuticals for human health through the development of innovative pharmaceutical products.

In July 2020, EURODRUG applied to register some of their pharmaceutical trademarks in Cambodia, but the Cambodian IPO rejected two marks “**SPASMOPRIV**” and “**PUROXAN**” due to their confusing similarities to prior marks of others. Specifically, the trademark “**SPASMOPRIV**” was refused protection because it was deemed




Nguyen Vu QUAN, Partner

Résumé

Nguyen Vu QUAN is working as a partner with KENFOX IP & Law Office in the Litigation Department. Since 2004, QUAN has worked in the field of intellectual property, focusing on the different aspects of obtaining, defending, and enforcing IPR in Vietnam, Laos, and Cambodia. For over a decade of litigation experience, QUAN has assisted a diverse range of clients with developing efficient, cost-effective strategies to uncover and stop third parties from illegally using or registering IPRs. He has extensive experience working and coordinating with the law enforcement agencies to ensure focused solutions for IP infringement. QUAN has coordinated with enforcement authorities to conduct raids and successfully deal with large scale infringement cases for Lacoste, Charles & Keith, Yonex, Dihon Pharmaceutical, and Engelhard Arzneimittel, among others.

confusingly similar to the cited mark " SPASMOMEN" for the designated goods in Class 05, whereas the trademark "PUROXAN" was denied protection due to its similarity to three registered cited marks for

pharmaceutical products in Class 05: (i) trademark “” (Japanese word, Latin

transliteration as “**Purofiru**”); (ii) trademark “PUROFEX” and (iii) “”. Disagreeing with the Cambodian IPO's refusals, KENFOX IP & Law Office filed responses on behalf of EURODRUG, presenting arguments and evidence establishing the trademarks' dissimilarity. Convinced by the analysis, arguments and proofs, the Cambodian IPO withdrew its refusals and accepted registration of EURODRUG's trademarks "SPASMOPRIV" and "PUROXAN" in Cambodia.

What implications for EURODRUG?

Cambodia is an emerging market, attracting a lot of foreign investment, while EURODRUG is directing their investment to Southeast Asia such as Vietnam, Laos, Cambodia, and Myanmar. Acceptance of protection of the above two trademarks has significant implications for EURODRUG's investment/business activities in Cambodia as it acts as:

- ✓ a legal certificate ensuring the safety of pharmaceutical business conducted under protected trademarks; and
- ✓ a legal tool against illegal acts committed by a third party who uses identical/similar signs for competing products without permission from EURODRUG in Cambodia.

Key Takeaways

“Numerous pharmaceutical trademarks appear to be structurally and phonetically similar at first glance, but are actually distinguishable from each other due to the unique nature of trademarks in pharmaceutical industry.”

Like many other IP offices, examiners at Cambodian IPO will issue a refusal if an applied-for mark is deemed to be confusingly similar to prior mark/s. The refusal is intended to avoid confusion among the relevant purchasing public/consumers. However, the Cambodian IP Law does not set forth specific provisions on criteria (e.g. structure, pronunciation, meaning of marks, form of presentation...) or the correlations between the goods/services that must be compared in order for an examiner to evaluate and draw conclusions on the registrability/similarity of the marks. This ends up causing two problems: first, examiners are given considerable authority to refuse trademark applications in that, as long as the marks sound or look somewhat similar to other marks, the examiner will immediately issue a refusal, while the examiner is under no obligation to provide evidence to support a finding of likelihood of confusion; and second, examiners are inconsistent in adjudging similar trademark cases of similar nature. As a result, the applicant is forced to spend money pursuing the case, with an unclear outcome.

Numerous pharmaceutical trademarks appear to be structurally and phonetically similar at first glance, but are actually distinguishable from each other due to the unique nature of trademarks in pharmaceutical industry. However, when it comes to pharmaceutical trademarks, the Cambodian IPO examiners are often inclined to believe that the examination of confusing similarity should have a more exhaustive study and analysis, and it is best not to allow trademarks with similar names to be registered in order to protect consumers' health and safety.

This is understandable, given that, like many underdeveloped countries, Cambodia has a strong culture of "self-medication", whereby a large number of patients self-medicate after hearing about a product commercial or oral recommendations from a third person. The majority of average consumers in the underdeveloped countries are often unaware of the ingredients or properties of pharmaceutical products offered on the market, and/or due to imperfect recollection (*many consumers "may have hazy memories of having previously seen or heard of one or*

more of the related trademarks), they can easily fall into confusion when purchasing the pharmaceutical products. Frequently, consumers may purchase a pharmaceutical product in a pharmacy in the belief that they are buying another item. This risk of confusion is possible if the phonetic similarities between the marks are so high that consumers are unable to identify one product from another. Not only the consumer, but occasionally the pharmacist, is perplexed in this case due to the trademarks' phonetic and/or visual/appearance similarities.

Therefore, overcoming pharmaceutical trademark refusals in Cambodia is a challenge. It requires an IP attorney to be well-prepared, to present credible and persuasive arguments, and to guarantee that those arguments are always backed up by documentation.

Taking pharmaceutical trademarks into account, it can be seen that most trademark owners tend to create pharmaceutical trademarks by combining a part of their active ingredient, intended uses, characteristics or international nomenclature with other elements. Many trademark owners simply add additional letters to a generic pharmaceutical name or tweak a few letters in the original name, resulting in trademark names that are quite similar to the active ingredient's name or international nomenclature. This trend has existed for a long time, occurring in a variety of countries and growing in popularity for two reasons: **(i) assisting health professionals in instantly identifying a drug's pharmacological properties through the name given by a trademark owner**, and **(ii) assisting relevant consumers in quickly associating the pharmaceutical product they are looking for with the active ingredient, or with the disease that needs to be treated, or with the part of the body that needs the medicine**. As a result, pharmaceutical trademarks frequently include common components that are descriptive, suggestive, or imply a characteristic, intended application, or active ingredient of the pharmaceutical product carrying those designations.

In the trademark case **"SPASMOPRIV"** v. **"SPASMOMEN"**, the Cambodian IPO refused registration of the mark **"SPASMOPRIV"** because it was judged confusingly similar to the cited trademark **"SPASMOMEN"**. At first glance, the two trademarks seem very similar because they share the first two syllables **"SPASMO"**. However, in reality, **"SPASMO"** is a word used in medical dictionaries to refer to *"a combination of contractions"*. **"SPASMO"** is the name for a condition that causes *"sudden involuntary spasms of a muscle, a group of muscles, or a hollow organ such as the heart"*. As such, this constituent in both trademarks is a generic name in the pharmaceutical industry; as such, it is descriptive as applied to pharmaceuticals and so has no source-indicating significance. If the shared element/s of trademarks is of weak distinctiveness (*it is generic, descriptive or highly suggestive of the goods and is therefore commonly used in commerce*), the public/relevant consumers will look to other elements to distinguish the source of the goods or services. In other words, consumers and/or medical professionals will pay increased attention to unusual or novel components added to the marks to memorize them. In some countries, a slight variation or additions between pharmaceutical marks may also be regarded adequate to avoid a likelihood of confusion (*i.e., threshold of distinctiveness and non-descriptiveness in the pharmaceutical trademarks is lower than trademarks used in other fields*). The preceding argument clarifies why the two marks are similar and highlight the applicant's right to freely use the similar element/s.

1 To reinforce the persuasive value of the argument that granting the trademark owner exclusive use of a common element is unjust and irrational, you should consider referencing previous marks of a similar nature. To this end, you should conduct searches on the Cambodian IPO's trademark database and quote (or cite) the marks sharing the same prefix/suffix or element, then argue that the marks in question all share the same prefix/suffix or element, in addition, they are all used for pharmaceuticals by different entities. As a result, there is no basis for asserting the possibility/risk of confusion regarding the commercial origin of the goods bearing those trademarks where the prefix/suffix or element already appears in pharmaceutical trademarks registered by different trademark owners. If feasible, you should indicate where the prefix/suffix or element originates in the pharmaceutical industry via printed materials from the website or pharmacopoeias, and conclude that the shared element is not intrinsically distinctive. In other words, concluding that two marks are similar solely on the similarity of an element that has lost its inherent distinctiveness is not suitable.

2 Documents attesting to the applied-for mark's use in commerce in Cambodia may assist in reinforcing the persuasiveness of arguments regarding the marks' distinctiveness.

In addition, if possible, you should provide documents demonstrating that the alleged similar marks co-exist in several countries. Other jurisdictions' judgments in similar cases may be provided in type of reference documents for the Cambodian IPO examiners in order to bolster your position regarding the distinctiveness of the marks at issue.

3 By narrowing the list of the designated goods, you can also distance your mark from a cited mark. The more similar your mark is to another, the less similar the goods/services bearing those marks must be for an examiner to determine that no likelihood of confusion exists. A specialized medicine that is used to treat a specific ailment is quite distinct from a general medicine. You should be able to make multiple arguments for trademark distinguishability based on an analysis of the differences in the characteristics, intended uses, functions, channels of consumption, and consumers of pharmaceutical products, in order to highlight the distinctions between products bearing the marks in question, leading to a conclusion on unlikely confusion of the product origin to relevant consumers.

4 In general, pharmaceutical trademarks, despite their high degree of similarity, are unlikely to cause origin confusion if the mark is used for drugs that are (i) expensive, (ii) used strictly by hospital doctors and (iii) only sold by doctor prescription. In common sense, the quantity of goods acquired in bulk by hospitals and clinics (as opposed to the usual over-the-counter customer) is a critical factor for the IPO in evaluating the likelihood of confusion or deception between rival marks. If your brand fits within one of these categories, you should employ data to demonstrate how items are approached/consumed differently, even if the goods bearing the marks in question all fall inside Class 05. Of course, if the marks in question cover a broad range of goods/services, the possibility of confusion between goods bearing those marks cannot be eliminated simply by restricting the scope of goods covered by the applied-for mark.

5 If the trademark continues to be rejected following a response, you still have the option of pursuing it in Cambodia by submitting additional documents/evidence. In fact, the examiner's adamance is principally motivated by the notion that consumers will be confused as a result of the trademarks under examination's similarities. So two questions arise here: **(i) Who are the intended consumers of those trademarked goods?** and **(ii) Is there any evidence that those consumers can't not get confused?** To answer the first question, you might examine the distinct characteristics of relevant Cambodian consumers during their purchasing behavior. The following inquiries should be made: How do Cambodian customers refer to/pronounce those trademarks, what is the product's business condition in Cambodia, how do consumers make purchasing decisions, and how are the goods delivered to consumers? Are these purchasers active or passive in their behavior? For the second question, a market survey may be necessary, with appropriately worded questions and responses that enable you to analyze/evaluate the data acquired from those surveys and so give your case significant weight.

6 In other cases, you may need to take stronger measures to advance this issue. Proposing and conducting a meeting with the Cambodian IPO or the responsible examiners to discuss and resolve unsatisfied concerns should be considered and carried out. Of course, you must properly prepare the topics to be discussed, as this meeting is similar to a face-to-face debate, but it takes place in an informal setting, unlike the [oral hearings](#) for resolving IP complaints / IP appeals in Vietnam. This move is not without cost, but if it aids you in overturning an unconvincing rejection to register your trademark following a lengthy battle, it is well worth it!

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