

Overcoming Relative Ground Refusal Against International Registration Designating Cambodia

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Overview of the Madrid System of International Registration:

The Madrid system of international registration is governed by two treaties: **(i)** the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and **(ii)** the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on 01 December 1995, and came into operation on 01 April 1996. Cambodia is party only to the Protocol, not to the Agreement. The Madrid Protocol became effective in Cambodia on 05 June 2015.

Therefore, trademark protection in Cambodia can now be obtained through national and international channels.

Background:

SIC Holdings Co., Ltd. ("**SIC Holdings**"), a Japan-based legal entity, filed an application for international registration seeking protection for a device mark under Int'l Registration No. 1386767 designating Cambodia. The Department of Intellectual Property of Cambodia ("**Cambodia IP Office**") issued a Notification of Provisional Refusal against the IR No. 1386767. 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. 1386767	Cited National Reg. No. KH/ 51782/14
 <p>Class 44: <i>Hairdressing and beauty salon services; providing bath houses; massage; chiropractic services for adults and children; moxibustion; treatment of dislocated joints, sprains or bone fractures; acupuncture; medical care; provision of medical information; health clinic services; dental clinic services; dispensing of pharmaceuticals; dietary and nutritional guidance; rental of machines and apparatus for use in beauty salons or barbers' shops</i></p>	 <p>Class 44: <i>Providing medical information; Providing information regarding pharmaceutical preparations</i></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 SIC Holdings, we filed a response to the Cambodia IP Office, rendering arguments on dissimilarities on trademark constituents/structure, colors and overall impression made by each mark. Detailed analysis on different visual impression 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. 2019/9969 dated 07 May 2019 and



approved protection for the mark “” under International Trademark Registration No. 1386767 in the name of SIC Holdings in Cambodia.

Comments:

- (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 (*i.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 two marks 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.

KENFOX IP & LAW OFFICE was successful in this trademark case. If you wish to receive more information, please contact:



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Chu Thanh TU is a partner in the IP litigation and investment consultancy practice of KENFOX.

TU concentrates his practice on IP litigation and transactions and on counseling startup companies on new business formations and structure. TU has represented clients at all levels of litigation and his clients range from emerging companies to leading generic pharmaceutical companies, medical device manufacturers, optical and laser technology companies, publishers and media companies, major universities, and information services and technology companies.

TU has represented his clients in complex litigation and appellate courts, in alternative dispute resolution forums and before the IP Office of Vietnam, Intellectual Property Departments of Laos, Cambodia and other Asian jurisdictions. He has resolved many disputes without the costly involvement of litigation and has settled many litigated matters to avoid protracted proceedings and related costs. TU has presented both legal and technical issues in a manner easily understood by the enforcement authorities. He also provides expert legal opinions for clients who have been accused of patent infringement.

TU also provides legal advice in areas of foreign investments pertaining to setting up a 100% foreign invested or joint venture enterprise, joint stock company in Vietnam, registration and de-registration of branches, businesses and representative offices, finding partnerships, settling negotiations, reviewing and drafting of legal documents, etc. His commercial advice also encompasses overseeing and handling corporate and real estate mergers and acquisitions, restructurings, securities offerings for clients in the automotive, machinery, banking and finance, chemicals, pharmaceuticals, computer software, energy, real estate development and management, commercial and industrial construction, and entertainment industries.

Experience

- Established a non-infringement position for a Vietnamese corporation when threatened with litigation.
- Offered counseling on patentability issues at every stage of the product cycle, including its genesis to clients.
- Provided clients with evaluations of the strength and scope of patents and related intellectual property in valuing businesses and technologies for acquisition purposes.
- Counseled to clients on patent infringement likelihood, provided patent opinions for both offensive and defensive purposes.
- Conducted patent infringement enforcement actions, prosecution and defense, including litigation when necessary.
- Provided clients with alternative dispute resolutions, both before and during litigation, including party-to-party negotiations, court assisted mediation, the use of mediators and arbitration proceedings.
- Represented clients with preparation of dossiers and documents and liaised with competent authorities for implement of procedures of investment registration and investment project evaluation the laws.
- Represented clients on negotiation with their partners with regard to their needs of investment cooperation, assignment/receipt of assignment of project.