


How did “DING TEA” milk tea win the brand battle in Cambodia?

1. Cambodia is an emerging market that attracts substantial foreign investment in Southeast Asia. Every year, tens of thousands of trademark applications are filed directly in Cambodia or through the Madrid system, and millions of registered trademarks have been published in the national register. Therefore, securing a trademark registration in Cambodia is not a simple course of action, because it is very easy for a mark to be deemed confusingly similar to an earlier mark, not to mention the fact that many trademark applications may be rigidly refused by the examiner. Then, without the support of IP attorneys with extensive practical expertise in responding to the Cambodian IP Office’s refusal, business owners will not be able to enter the market, simply because their trademark has been refused protection.
2. Your trademark application may be refused by an examiner, but not all doors are shut down. IP attorneys with extensive experience and knowledge of IP law will assist you in developing effective strategies for winning the trademark battle to bring your trademark mature into registration in Cambodia. KENFOX IP & Law Office, with nearly 20 years of experience in providing intellectual property solutions for businesses, is very proud to have won the refusal to protect the trademark “DING TEA” - a world famous milk tea brand. We believe that the trademark "DING TEA" granted with a protection title will be an important and indispensable legal tool to ensure the business activities of the trademark owner in Cambodia.


[Background]

3. "DING TEA" milk tea is no longer unfamiliar to customers and the community of milk tea enthusiasts. In China, it is one of the most popular Taiwanese beverage brands. The "DING TEA" brand is rapidly spreading around the world like a storm. Particularly in Asia, "DING TEA" has more than 350 outlets spread from North to South of China. The number of stores that DING TEA owns worldwide is up to 650 outlets. “DING TEA” currently has branches in Taiwan, Japan, China, Hong Kong, Indonesia, Singapore, Vietnam, Myanmar and Brunei.



4. CHU YU HSIANG CO., LTD, the owner of the trademark “” (DING TEA, Chinese characters), with **KENFOX IP & Law Office** as its IP agency, has applied to register their mark for the services in Class 43 in Cambodia. The trademark “DING TEA” was refused by the Department of Intellectual Property of Cambodia because it was judged confusingly similar to the following cited mark:



Trademark:  (Din Tai Fung, Chinese characters)
 Class: 43 (Services for providing food and drink, including restaurants, self-service restaurants, snack bars, cafeterias, cafes and catering services.)
 Application No: 31844
 Application date: 01 September 2008
 Registration No: 31281
 Registration Date: 29 April 2009
 Owner: DIN TAI FUNG CO.,LTD
 Address: No.194, Sec. 2, Shin-yi Rd. Taipei
 Status: Being valid until 2028

[Action and results]

5. Based on the refusal decision of the Department of Intellectual Property of Cambodia ("DIP"), it can be seen that the examiner considered that the word "**DING TEA**" has a similar pronunciation to "**DIN TAI**," which could lead to consumer confusion regarding the origin of goods/services..
6. With nearly 20 years of experience in providing intellectual property solutions for businesses, KENFOX IP lawyers determined that "**DING TEA**" and "**DIN TAI**" had some similarities. However, this similarity is insufficient to pose a danger of confusion. Accordingly, KENFOX IP & Law Office filed an appeal against the Department of Intellectual Property of Cambodia’s trademark denial judgment. The arguments analyze the registered mark’s and the cited mark’s differences in structure, meaning, pronunciation, and commercial impression. Although the two trademarks share some similarities, there are so many distinguishing characteristics that the similarities are insufficient to confuse the public or consumers.

7. In addition to arguments and analysis to illustrate the dissimilarity between the two trademarks in question, KENFOX IP & Law Office provides highly useful evidence to demonstrate the distinctiveness of the two trademarks. Specifically, the trademarks "DING TEA" and "Din Tai Fung, Chinese characters" have been granted protection in numerous nations, including Australia, Brunei, Canada, the European Union, Japan, Korea, Malaysia, and the United States. This indicates that the two trademarks are different and exist concurrently in many countries. This evidence has significantly strengthened the arguments and analyses on the capacity to distinguish between the two trademarks.
8. Being convinced by the analysis, valid arguments and evidence submitted by KENFOX IP & Law Office, the Department of Intellectual Property of Cambodia has revoked the decision on trademark refusal and then granted a protection title for the trademark "DING TEA" in Cambodia, opening a bright door for a safe and legal business development of the brand "DING TEA" in this "pagoda land".

[Key takeaways]

9. **Conduct a trademark search before filing a trademark application:** Trademark registration is very important to conduct business activities in Cambodia. However, as the number of trademark applications filed in Cambodia rises, there is a greater chance that the applied-for trademarks would be rejected for being too similar to or in conflict with an existing brand. Prior to filing a trademark application, we recommend conducting a trademark search in order to detect potential issues and seek solutions. Attorneys at KENFOX can assist you in conducting searches, recognizing potential issues, and offering specific advice.
10. **File a trademark application as soon as possible:** Your trademark may be famous, even gain reputation somewhere, or even be registered in many countries around the world, but this may become meaningless. Keep in mind that trademark rights are territorial in nature and that the majority of countries around the world apply the "first-to-file" principle, which means that the mark is granted a protection title for the earliest applicant, not the earliest user, even if you used it earlier or more widely than the applicant. The more well-known a trademark is, the more likely it is to attract the attention of speculators (or squatters). Trademark speculation (or trademark squatting) will block all paths for goods to reach customers and the public. Numerous costly life lessons have been learnt as a result of being slow, careless, and subjective when registering trademarks, so allowing your trademark to fall into the hands of others. Registering your trademark as soon as possible is the most effective strategy that you can't undervalue or forget.
11. **Consult with attorneys with extensive IP experience:** Success in appealing the DIP's refusal, to any trademark owner, is akin to winning a battle. If it's a battle, you must have the proper strategy, tactics, combat experience, and quick response to all situations, otherwise sooner or later you will fail. If this trademark represents the cornerstone of your marketing strategy, losing this battle might be quite costly. It's not just about the money you spent to register your trademark or the time you had to spend on pursuing the application, more seriously, you lose market access, lose business opportunities, lose market share and lose customers. That's the end of your product and your business plan. Basically, when the DIP of Cambodia sends a refusal notice because your mark is deemed similar to other trademarks, you need to carefully consider and analyze the ability to distinguish your mark from the citation. The arguments and analysis should focus on the differences in the characteristics of the mark (such as *structure, pronunciation, connotation, form of presentation, commercial impression...*), thereby, asserting that although the two trademarks are similar in some way, the similarity is insufficient to deceive consumers. But these should only be considered as necessary and basic understandings. What you need more than that is to choose an IP law firm with a team of IP lawyers with practical experience and in-depth knowledge to rely on. The attorneys of KENFOX IP & Law Office, who have extensive practical experience, clearly understand what points to analyze, emphasize or highlight to strengthen your position, strengthen your arguments, point of view and help you win the brand battle in Cambodia.
12. **Collect important evidence to support the analysis and arguments:** Evidence that two trademarks have coexisted on the market in different countries and/or both marks have been accepted for protection by different IP offices will be valuable and weighty evidence, reinforcing the arguments and analysis about the dissimilarities of the two trademarks. The Cambodian DIP places a high value on these evidences. These evidences are the basis for persuading the examiner at DIP of Cambodia to grant trademark protection. We have been successful in many similar cases, if needed, you can visit our website <https://kenfoxlaw.com/> for quick and specific support.
13. **Take caution if you continue to use a trademark that has been rejected:** If you dare to engage in recklessly use of the refused trademark, you expose yourself to a series of legal risks. One day, you are

suddenly accused of infringing on another person's trademark, the police will knock on your door, the Court summons will be sent to you, the goods will be seized and destroyed and you will be surrounded by the media, which will be enough to drown you. Therefore, keep in mind that, if your trademark is not granted a protection title, you should stop using it in commerce in Cambodia to avoid possible legal consequences.

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