

## Avoiding Descriptiveness Refusal in Laos: Key Considerations for Trademark Owners

*A trademark is a source identifier denoting that a product/service belongs to a certain company or person, and distinguishes it from the products/services of others so that it is eligible to be protected by law. Thus, a sign that has no source-indicating significance must be refused registration to ensure that all other individuals or entities are free to use such it.*

*In Laos, not a few trademark applications are [denied](#) on the grounds that the proposed trademarks fail to meet the protection requirement as they are considered descriptive of the goods or services in question or common names the designate the goods/service they represent. This is because common names or descriptive signs are used widely in everyday language and cannot be exclusively attributed to one particular source. As a result, those signs cannot function as a trademark and are not protected. If such signs were allowed to be registered as a trademark, it would unfairly prevent competitors from using the same or similar descriptive terms to describe their own goods or services.*

*What can you do if your trademark is rejected for registration by [the Lao Department of Intellectual Property](#) despite not being descriptive? Below, we have outlined some key takeaways to help you understand the reasons for trademark refusal based on descriptive grounds in Laos and how to address it.*

### What if your trademark is deemed descriptive in Laos?

Under [Laos IP Law No. 38/NA dated 15 November 2017](#), marks are categorized into 04 (four) types for examination and registration purpose, i.e. “**trademark**”, “**service mark**”, “**certification mark**” and “**collective mark**”. If your trademark contains a word that is considered a “**common name**” or a “**descriptive sign**”, it will be refused protection. In case your trademark is a combination of verbal and device elements, and the verbal element is considered descriptive while the device element meets the protection conditions, there is still a chance that your mark can be protected as a whole. In this case, the verbal element would be excluded from the scope of protection, but the device element would still be eligible for trademark protection.

A “**common name**” is a word that is widely used in everyday language to refer to a particular thing, concept or product. Common names are generic terms that are not specific to any one brand or company. For example, the word “apple” is a common name for a type of fruit, and therefore cannot be registered as a trademark for a company that sells apples. The same goes for words like “book”, “chair”, “table”, etc. If a trademark consists solely of a common name, it will likely be refused registration because it does not serve as a distinctive identifier of the goods or services offered by a particular company or individual.

A “**descriptive sign**” is a type of trademark that directly describes the goods or services it represents, such as a word or phrase that is commonly used to describe a particular product or service. Examples of descriptive trademarks include “Fresh Baked Bread” for a bakery, or “Sunny Day” for a sunscreen product.

Descriptive signs are generally refused registration as trademarks because they lack distinctiveness and are not capable of serving as a unique identifier of the source of the goods or services.

### Why are descriptive trademarks refused or excluded from protection?

Descriptive trademarks are typically refused or excluded from protection because they lack the distinctiveness required to function as a source identifier. A trademark's main purpose is to identify the source of a particular good or service, and a descriptive trademark does not do that effectively because it simply describes the good or service it is associated with.

For example, if a company tried to register the trademark “**Delicious Apples**” for their apple orchard, the trademark would be refused because the phrase is merely a description of the product, rather than a unique identifier of the source of the apples. Other apple orchards should be free to use the phrase “Delicious Apples” to describe their own products.

Allowing descriptive trademarks to be registered would unfairly give the trademark owner a monopoly over commonly-used words or phrases, making it more difficult for other businesses to describe their own products and services in a straightforward manner. Additionally, if a descriptive trademark were allowed, it would not be effective in distinguishing the goods or services of one entity from those of another, which would undermine the entire purpose of trademarks. As a result, descriptive trademarks are generally considered to be weak, and the law does not offer them as much protection as more distinctive trademarks.

For this reason, trademarks must have some level of distinctiveness, either inherently or through acquired distinctiveness, in order to be eligible for protection. This ensures that consumers are able to identify and distinguish the goods or services of one entity from those of another, and promotes fair competition in the marketplace.

### How to overcome trademark refusal based on descriptive grounds in Laos?

To overcome a trademark refusal based on descriptive grounds in Laos, you need to consider whether your trademark is truly descriptive or suggestive, and evaluate whether it conveys direct information about the related goods or services. If it is only suggestive, you can argue that it indirectly connects to the characteristics of the related goods or services, making it self-distinguishing and deserving of protection. Additionally, you can focus your argument on the perceptions of consumers in Laos and how they view the trademark, particularly if it is a foreign term. Providing evidence of the trademark's wide use in commerce and association with specific goods and services in Laos can also strengthen your case. Furthermore, demonstrating that the trademark has been accepted for protection in other countries can also support your argument. Lastly, looking for similar trademarks that have been granted protection by the DIP can serve as good precedents to convince the examiner to grant your trademark protection.

In more details, to answer the above question, you should find satisfactory answers to the following questions:

#### 1. Does your trademark really describe the goods/services?

Upon first glance, many trademarks may seem descriptive to the public. However, in actuality, they are often only suggestive and do not directly describe any features of the related goods or services. Rather, such trademarks merely suggest or hint at certain qualities, which the public can associate with the product or service upon reading or seeing the trademark. Therefore, if you receive a notice from DIP indicating that your trademark cannot be protected due to it being descriptive, there is no need to panic.

Firstly, consider whether the trademark directly conveys information about the goods or services or if it is merely suggestive of certain attributes. Your analysis will help you to establish a case that proves your trademark to be suggestive of the features of the product or service or an indirect connection with their characteristics. Thus, your trademark will not be considered descriptive, and you will be eligible for protection.

#### 2. Can you provide documents to prove your trademark has been widely used in commerce?

In many countries, a sign may be considered descriptive, but if it has been extensively used in commerce and has created a strong association with a particular type of goods or services among the public and relevant consumers in Laos, it may be deemed to have acquired distinctiveness through use. In such cases, DIP may revoke the notice of refusal for that mark.

To prove that your trademark has acquired distinctiveness through use, you must provide relevant documents and evidence that show your trademark has been used continuously and is widely known to Lao consumers. You must also demonstrate that your trademark has created a link in the consumer's mind with specific goods and services in Laos. Relevant documents and evidence may include:

- (i) Evidence of long and continuous use of the mark in commerce, particularly in Laos;
- (ii) Sales figures, market share, and other evidence of the mark's commercial success.
- (iii) Evidence of advertising and promotional efforts, including the amount and type of advertising and promotional materials used to promote the mark.

- (iv) Consumer surveys, including evidence of consumer recognition of the mark as a source identifier.
- (v) Testimonials from customers or other third parties attesting to the mark's secondary meaning.
- (vi) Evidence of media coverage or other public recognition of the mark.
- (vii) Evidence of exclusive use of the mark by the applicant or other evidence of control over the mark.
- (viii) Affidavits or declarations from individuals familiar with the use and reputation of the mark
- (ix) Evidence of registration or use of the mark in other countries or jurisdictions.
- (x) Any other evidence that may be relevant to establishing the mark's secondary meaning, such as awards, certifications, or industry recognition.

### 3. Has your trademark been protected in many other countries?

It is not uncommon for a trademark to be deemed descriptive of goods and services in one country but not in another. This is because different countries have different legal standards and criteria for determining the distinctiveness of a mark.

If a trademark is considered descriptive in Laos and is refused registration, but is accepted for protection in multiple countries, especially those where English is a common language or the primary language, this could be valuable evidence to support the argument that the mark is not merely descriptive. In such cases, this documentation could aid in establishing that your trademark is not descriptive in nature. This evidence can be used to persuade the examiner to overturn the disapproval decision or notice.

However, it is important to note that the Lao IP Office does not rely solely on foreign trademark conclusions to grant protection for trademarks in Laos. While evidence of acceptance in other countries can be helpful, the Lao IP Office still requires evidence specific to Laos to establish that a mark has acquired distinctiveness through use in that country.

### 4. Have there been any trademarks that you deemed descriptive but were still granted protection by DIP?

In order to strengthen your argument for trademark registration in Laos, it is advisable to search for cases in which a trademark similar to your own has been approved for protection by the DIP. These cases can serve as persuasive precedents and carry significant weight in convincing the examiner to grant your trademark similar protection. By citing such cases, you are demonstrating that similar marks have been recognized and registered, which supports your argument that your mark is also eligible for protection. It is important to note, however, that each case is unique and the final decision ultimately rests with the examiner. Therefore, it is crucial to present a well-supported argument that clearly highlights the distinctiveness and non-descriptiveness of your mark.

#### The bottom line

Trademarks are inherently territorial, which means that their legal protection and recognition depend on the specific jurisdiction where they are registered. A trademark that may be considered descriptive in one country, such as the United States, may not necessarily be deemed descriptive in another country, like Laos. Therefore, it is important to evaluate the distinctiveness and consumer perception of a trademark in each country where it is intended for use or registration. It would be inappropriate and contrary to the principles of trademark law to reject a trademark application in Laos solely based on its descriptive nature in another country.

In determining whether a trademark is descriptive in Laos, it is crucial to assess how consumers perceive and associate the mark with the specific goods or services offered under that mark. The degree of distinctiveness of a trademark is a key factor to consider, as a highly distinctive mark is more likely to be protected than a descriptive one. The distinctiveness of a mark can be evaluated through a range of factors, including the level of consumer recognition, the duration of use, and the marketing and advertising efforts behind the mark.

#### KENFOX IP & Law Office in Laos

Navigating the trademark registration process can be a daunting task, particularly when refusals are made on descriptive grounds. At **KENFOX IP & Law Office**, we understand that each trademark case

is unique, and the specific circumstances surrounding the mark will play a pivotal role in determining its registrability. As a leading intellectual property firm in Laos, we are committed to helping our clients achieve their business goals by providing high-quality intellectual property services, including trademark registration and protection.

Our team of qualified and experienced intellectual property attorneys can guide you through the trademark registration process, from [conducting comprehensive searches](#) to filing and prosecuting applications. In addition, we can assist you in addressing refusals on descriptive grounds by leveraging our knowledge of the relevant legal frameworks and consumer perceptions.

As a testament to our commitment to excellence, Asia IP has recognized us as a **first-tier firm** in the field of patents for two consecutive years, and as a leading firm in the field of trademark in 2021. We have also been honored with the "**Intellectual Property Company of Laos in 2021**" award. If you need a professional intellectual property service provider to help guide your business towards success, please do not hesitate to contact **KENFOX IP & Law Office** today. We are dedicated to providing exceptional service and support to all our clients.

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