


Overcoming Trademark Rejection in Cambodia: Winning Strategy from the "DING TEA" Milk Tea Case

As foreign investment in Southeast Asia continues to surge, Cambodia is emerging as a top destination for businesses looking to expand their reach. However, obtaining trademark registration in this market is no walk in the park. With a vast number of trademark applications filed annually, it's easy for a mark to be deemed too similar to an earlier one or refused altogether by the examiner. This is where IP attorneys with extensive experience and knowledge of IP law can provide effective strategies for winning the trademark battle to obtain registration in Cambodia. KENFOX IP & Law Office, with nearly 20 years of expertise in intellectual property solutions, has successfully won the refusal to protect the world-renowned milk tea brand "DING TEA" in Cambodia. In this article, we'll delve into the complexities of obtaining trademark registration in Cambodia and share key takeaways if your trademark faces a refusal.

Background

The Taiwanese milk tea brand "DING TEA" has gained immense popularity among milk tea enthusiasts worldwide. With over 350 outlets across Asia and a total of 650 branches worldwide, "DING TEA" has become a household name in the beverage industry. The brand's presence can be felt across several countries, including Taiwan, Japan, China, Hong Kong, Indonesia, Singapore, Vietnam, Myanmar, and Brunei.

However, the trademark "DING TEA" faced a setback when the owner, CHU YU HSIANG CO., LTD,

applied to register their “” mark for services in Class 43 in Cambodia, and it was refused by the Department of Intellectual Property of Cambodia. The reason cited was the mark's potential confusion with another registered mark with particulars as follows:

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

How to win a trademark refusal in Cambodia

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..

Apparently, the trademarks "DING TEA" and "DIN TAI" shared some similarities, but not enough to cause confusion. As a result, KENFOX IP & Law Office appealed the Department of Intellectual Property

of Cambodia's decision to deny the trademark. The appeal arguments thoroughly analyzed the differences in structure, meaning, pronunciation, and commercial impression between the registered and cited marks. Despite some similarities, the arguments emphasized that there were significant distinguishing characteristics between the two trademarks, making it unlikely for consumers to be confused.

Alongside presenting arguments and analyses to highlight the dissimilarities between the two trademarks, KENFOX IP & Law Office has offered highly valuable evidence to showcase the uniqueness of both trademarks. For instance, the trademarks "DING TEA" and "Din Tai Fung, Chinese characters" have been safeguarded in several countries such as Australia, Brunei, Canada, the European Union, Japan, Korea, Malaysia, and the United States. This is clear proof that the two trademarks are distinctive and coexist independently in many countries. This evidence has significantly bolstered the arguments and analyses regarding the capability to differentiate between the two trademarks.

After reviewing the compelling analysis, valid arguments, and evidence presented by KENFOX IP & Law Office, the Department of Intellectual Property of Cambodia has overturned its decision to refuse the trademark and granted protection for the "DING TEA" brand in Cambodia. This decision has opened a new door for safe and legal business development for the "DING TEA" brand in Cambodia, providing a bright future for the brand's expansion in this region known as the "pagoda land."

Key takeaways

- 1. Conduct a trademark search before filing a [trademark application](#) in Cambodia:** Trademark registration plays a crucial role in conducting business activities in Cambodia. However, as the number of trademark applications increases, there is a greater likelihood that the applied-for trademarks could be rejected for being too similar to an existing brand or in conflict with it. To avoid such issues, we suggest conducting a trademark search before filing a trademark application. Our team of attorneys at KENFOX can assist you in conducting searches, detecting potential issues, and offering specific advice to overcome them. This proactive approach can save you time and money in the long run, ensuring a smooth and successful trademark registration process.
- 2. File a trademark application in Cambodia 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 and valuable strategy that should not be underestimated.
- 3. Consult with attorneys with extensive IP experience in Cambodia:** Successfully appealing the refusal of your trademark by the Department of Intellectual Property in Cambodia is like winning a battle. To emerge victorious, you need a proper strategy, tactics, combat experience, and quick response to all situations; otherwise, you risk losing market access, business opportunities, market share, and customers. This loss can be devastating to your business plan, and it's not just about the money and time invested in the application. When facing a refusal notice, you must carefully analyze the ability of your mark to distinguish itself from the citation, focusing on differences in structure, pronunciation, connotation, form of presentation, commercial impression, and more. However, having a basic understanding is not enough, and you need an experienced IP law firm with a team of lawyers to rely on. KENFOX IP & Law Office's attorneys have extensive practical experience and a clear understanding of the points to analyze, emphasize or highlight to strengthen your position and arguments. With their help, you can win the brand battle in Cambodia.

4. **Collect important evidence to support the analysis and arguments:** Evidence that two trademarks have coexisted in various countries and/or have been granted protection by different IP offices can be compelling evidence to reinforce arguments and analyses demonstrating the differences between the two trademarks. The Department of Intellectual Property in Cambodia places significant weight on such evidence, which can be instrumental in persuading examiners to grant trademark protection. Our law firm, KENFOX, has a successful track record in similar cases, and we invite you to visit our website, <https://kenfoxlaw.com/>, for prompt and tailored assistance.
5. **Take caution if you continue to use a trademark that has been rejected in Cambodia:** Using a refused trademark recklessly can expose you to various legal risks. In the event that you are accused of infringing on someone else's trademark, you may face legal action, including police investigation, court summons, and seizure and destruction of goods. This could result in negative media attention and significant harm to your reputation. As such, if your trademark is not granted protection in Cambodia, it is recommended that you cease using it in commerce to avoid any potential legal consequences.

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