

## How to Successfully Appeal a Trademark Refusal in Cambodia: 6 Essential Questions

*Has your international trademark application designating Cambodia been provisionally refused? Are you concerned about the potential risks and unsure of your next steps? A provisional refusal of protection for your trademark in Cambodia can jeopardize your brand's global expansion strategy. However, this is absolutely not the end of the road. Refusal of protection in Cambodia does not mean you have to abandon this market. With extensive expertise in intellectual property, KENFOX IP & Law Office will provide an analysis of six critical questions to help you understand the legal issues, develop an appropriate strategy, and ensure your brand is fully protected.*

### 1. What constitutes a provisional refusal in the Cambodian trademark registration process, and on what grounds can a provisional refusal be issued in Cambodia?

In the Cambodian trademark registration process, a **provisional refusal** is the initial notification by the Cambodian Department of Intellectual Property (**DIP**) to deny the registration of a trademark. This refusal is not final and can be overcome through a response or appeal process.

#### Grounds for Provisional Refusal in Cambodia:

[Provisional refusals](#) in Cambodia can be issued on several grounds, which can be categorized into absolute and relative grounds:

#### 1. Absolute grounds for refusal:

- **Lack of distinctiveness:** The trademark is considered too generic, descriptive, or lacks the ability to distinguish the goods or services of one enterprise from those of others.
- **Deceptiveness:** The trademark is misleading or deceptive about the nature, quality, or geographical origin of the goods or services.
- **Contrary to public order or morality:** The trademark is considered offensive, immoral, or contrary to public policy.

#### 2. Relative grounds for refusal:

- **Confusing similarity to a prior mark:** The trademark is similar to an earlier registered or pending trademark for similar goods or services, and there is a likelihood of confusion among consumers. The DIP assesses similarity based on visual, phonetic, and conceptual aspects of the marks, as well as the nature of the goods/services.
- **Identical or similar to a well-known mark:** The trademark is identical or similar to a well-known mark, even for dissimilar goods or services, and its use would take unfair [advantage](#) of or be detrimental to the reputation of the well-known mark.

#### 3. Additional considerations:

- The DIP may also issue a provisional refusal if the trademark application contains errors or omissions that need to be corrected.
- The DIP may require the applicant to disclaim exclusive rights to certain elements of the mark that are considered descriptive or generic.

It's crucial to understand that a provisional refusal is not the end of the road. Applicants have the opportunity to respond to the refusal, providing arguments and evidence to overcome the objections raised by the DIP.

### 2. How does the Cambodian Department of Intellectual Property (DIP) assess similarity between trademarks?

The Cambodian Department of Intellectual Property (DIP) assesses similarity between trademarks using a multi-faceted approach, taking into account various criteria to determine if there is a likelihood of confusion among consumers. While there isn't an explicitly stated set of rules, the following factors generally play a role in the DIP's assessment:

**Visual similarity:**

- The DIP examines the overall appearance of the marks, including the use of similar fonts, colors, designs, or other visual elements.
- Even minor differences in appearance may not be sufficient to avoid a finding of similarity if the overall impression is similar.

**Phonetic similarity:**

- The DIP considers how the marks sound when spoken.
- The DIP will consider the similarity of syllables, sounds, and overall pronunciation.
- Similar pronunciation can contribute to a likelihood of confusion, especially if the goods or services are marketed orally.

**Conceptual similarity:**

- The DIP examines the meaning or idea conveyed by the marks. It will consider whether the marks evoke similar concepts or associations in the minds of consumers
- Even if marks look or sound different, they may still be considered similar if they evoke the same idea or concept in the minds of consumers.

**Nature of Goods or Services:**

- The DIP examines the similarity of the goods or services associated with the marks.
- Marks for similar or related goods/services are more likely to be considered confusingly similar.

**Target Consumers:**

- The DIP considers the level of attention and sophistication of the average consumer of the goods or services.
- Marks targeting similar consumer groups are more likely to be considered confusingly similar.

**Overall Impression:**

- The DIP takes into account the overall impression created by the marks, considering all factors together.
- Even if marks differ in some aspects, the overall impression may still be similar, leading to a finding of confusion.

In addition to these criteria, the DIP may also consider other factors such as the degree of distinctiveness of the earlier mark, the extent of use and reputation of the earlier mark, and any [evidence](#) of actual confusion in the marketplace.

It's important to note that the DIP's assessment is ultimately a matter of subjective judgment, and there is no guarantee that a particular mark will be considered similar or dissimilar to another. However, by understanding the criteria used by the DIP, you can better assess the risk of your trademark being considered similar to existing ones and develop strategies to mitigate this risk.

In the case of DOUBLESTAR, the DIP initially focused on the visual and conceptual similarity between "CrossLeader" and "CROSS," particularly the shared element "cross". However, KENFOX successfully argued that "cross" is a weak element in Class 12 due to its widespread use, and that the overall impression of the two marks was different due to the addition of "leader" and other distinctive elements. This demonstrates the importance of a comprehensive approach to assessing similarity, taking into account all relevant factors and providing a compelling argument to the DIP.

### 3. How does the inclusion of common or generic elements in trademarks (like "CROSS" in this case) affect the likelihood of registration in Cambodia?

The inclusion of common or generic elements in trademarks, like "CROSS" in the mentioned case, can significantly affect the likelihood of registration in Cambodia in that:

- **Weak distinctiveness:** The distinctiveness of a trademark is its ability to help consumers differentiate the goods or services of one business from those of other businesses. A highly distinctive trademark makes it easier for consumers to recognize and remember the brand, thus building trust and driving purchase decisions.
- Common or generic elements, by their very nature, lack inherent distinctiveness (they are not inherently capable of distinguishing). They are words or symbols that are widely used and understood to describe a product or its characteristics. Consumers would have difficulty

associating a trademark containing these elements with a particular brand. For example, if many motorcycle products all use the word "CROSS" in their trademarks, consumers would have difficulty distinguishing which manufacturer the product belongs to.

- **Limited protection:** If a [trademark](#) contains a common or generic element, the protection afforded to the trademark may be limited to its distinctive elements, or it may be protected as a whole, including the common or generic elements. This means that others may still use those common or generic elements in their trademarks, as long as it does not cause confusion with the distinctive elements of the protected trademark.
- **Increased likelihood of refusal:** The DIP, like most IP offices in other countries, often does not approve the registration of trademarks containing common or generic elements. This is because such trademarks are less likely to function as source identifiers and may cause confusion among consumers.
- **Risk of genericization:** If a trademark incorporating a common element becomes too widely used to refer to the product or service itself, it risks becoming generic. This means the mark loses its trademark protection altogether and becomes part of the public domain.
- Typical examples include trademarks such as "Aspirin" (pain reliever), "Escalator" (moving staircase), and "Zipper" (fastener). Initially, these were registered trademarks, but due to their widespread use, they have become generic names for the products themselves.

#### Strategies to overcome refusal:

- **Combination Marks:** Combining a common or generic element with a distinctive element can enhance the overall distinctiveness of the mark. For example, the DIP might accept "CrossCountry" for tires, recognizing the combination of a common element with a more distinctive word.
- **Secondary Meaning:** If a mark has acquired secondary meaning through extensive use and advertising, it may be granted registration even if it contains a common or generic element.
- **Disclaimer:** As seen in the "crossleader" case, disclaiming the exclusive right to the common or generic element can help secure registration for the remaining distinctive parts of the mark.

While the inclusion of common or generic elements in trademarks presents challenges for registration in Cambodia, it is certainly not an insurmountable obstacle. With a thorough understanding of the regulations and potential risks, along with the implementation of appropriate strategies, you can confidently achieve success in registering and protecting your trademark.

To optimize your chances of success and ensure your rights are protected, it is advisable to seek professional advice from reputable Intellectual Property lawyers in Cambodia. With their extensive practical experience and in-depth knowledge of [Cambodian intellectual property law](#), they will be invaluable partners, helping you overcome any obstacles and achieve your brand protection goals comprehensively and effectively.

#### 4. What are effective strategies for responding to provisional refusals in Cambodia from the "CrossLeader" case?

The successful registration of the "CrossLeader" trademark in Cambodia, despite initial refusals, offers valuable lessons for [businesses](#) facing similar challenges. KENFOX IP & Law Office would like to share some effective strategies for responding to provisional refusals, drawing from the arguments and evidence used in the "CrossLeader" case as follows:

##### [i] Thorough analysis of the refusal:

- Carefully examine the DIP's reasons for refusal.
- Identify the specific grounds (absolute or relative) and the evidence cited.
- Understand the DIP's concerns and tailor your response accordingly.

##### [ii] Distinguishing features:

- Emphasize the unique and distinctive elements of your mark.
- Highlight differences in the visual appearance, phonetic sound, and conceptual meaning compared to the cited mark.

- Use side-by-side comparisons, expert opinions, and consumer surveys (if available) to demonstrate these differences.

**[iii] Evidence of coexistence:**

- If your mark coexists peacefully with similar marks in other jurisdictions, including the home country of the cited mark's owner, present this evidence.
- This demonstrates that consumers are not confused by the marks and that they can coexist in the marketplace.

**[iv] Global Acceptance:**

- If your mark has been registered in multiple countries, highlight this as evidence of its distinctiveness and international recognition.
- This can be particularly persuasive if the mark is registered in countries with similar trademark laws or consumer demographics to Cambodia.

**[v] Arguments of weak distinctiveness:**

- If the cited mark contains common or generic elements, argue for their weak distinctiveness.
- Provide evidence of widespread use of these elements in the industry, citing examples of other registered marks containing similar elements.

**[vi] Legal precedents:**

- Research and cite relevant case law or legal precedents that support your arguments.
- This can demonstrate that your position is consistent with established legal principles and interpretations.

**[vii] Engagement with the DIP:**

- Consider requesting a hearing or meeting with the DIP to discuss the refusal and present your arguments in person.
- This can be an effective way to build rapport and clarify any misunderstandings.

**[viii] Professional Assistance:**

- Engage a qualified trademark attorney in Cambodia with expertise in handling trademark refusals.
- They can provide valuable insights, draft persuasive arguments, and navigate the legal process effectively.

The implementation of the aforementioned strategies can significantly enhance the likelihood of successful appeals against notices or decisions of trademark refusal, thereby safeguarding trademark rights in Cambodia. The "CrossLeader" case serves as a clear demonstration that even in complex legal situations, persistence, robust legal arguments, and compelling evidence can ultimately lead to a favorable outcome for trademark owners.

## 5. How does the Cambodian DIP view international trademark registrations, particularly those registered under the Madrid system, and their acceptance in other countries?

The Cambodian Department of Intellectual Property (DIP) generally recognizes and accepts international trademark registrations, including those registered under the Madrid System. Cambodia became a member of the Madrid Protocol in 2015, allowing trademark owners to seek protection in Cambodia through a single international application.

However, while the DIP recognizes international registrations, it does not automatically grant protection to them. Each international registration designating Cambodia undergoes a formal examination by the DIP to ensure compliance with Cambodian trademark law and regulations. This examination process is similar to that of national trademark applications.

### Factors influencing acceptance:

- *Compliance with local laws:* International registrations must comply with all aspects of Cambodian trademark law, including distinctiveness, non-deceptiveness, and not being contrary to public order or morality.
- *Prior rights:* The DIP will check for any conflicting prior trademarks registered or applied for in Cambodia. If a conflict is found, the international registration may be refused or limited in scope.
- *Absolute and relative grounds for refusal:* The DIP will assess the international registration based on both absolute and relative grounds for refusal, as with any other trademark application. This

includes factors such as the mark's distinctiveness, potential for confusion with existing marks, and compliance with public order and morality.

- *Evidence of use in other countries:* While not mandatory, evidence of use of the mark in other countries can be beneficial in demonstrating the mark's distinctiveness and acquired distinctiveness through use.

#### **Specific considerations for Madrid system registrations:**

- *Central attack principle:* Under the Madrid System, a successful central attack on the basic registration within five years can affect the protection of the mark in all designated countries, including Cambodia.
- *Refusal period:* The DIP has 18 months to refuse an international registration designating Cambodia. If no refusal is issued within this period, the mark is considered protected in Cambodia.

**Overall, the DIP views international trademark registrations, including those under the Madrid System, as a valid and efficient way to seek trademark protection in Cambodia.** However, it is crucial to understand that these registrations are subject to the same scrutiny and legal requirements as national applications. Applicants should be prepared to address any objections or refusals raised by the DIP to secure protection for their marks in Cambodia.

### **6. How persuasive is evidence of trademark co-existence in other countries, including the home country of the cited trademark owner, in influencing the Cambodian DIP's decision?**

Evidence of trademark coexistence in other countries, including the home country of the cited trademark owner, can be a persuasive factor in influencing the Cambodian DIP's decision on a trademark refusal. This is especially true in cases where the refusal is based on the likelihood of confusion with a prior mark.

#### **How persuasive is such evidence?**

While not definitive, evidence of coexistence can be a strong indicator that consumers are not confused by the marks and that they can coexist in the marketplace without causing any issues. This is particularly persuasive when the coexistence occurs in the cited mark owner's home country, as it suggests that the owner is aware of the coexisting mark and has not taken any action against it.

Coexistence suggests that consumers in other markets can distinguish between the marks, implying they are not confusingly similar. This strengthens the argument for the inherent or acquired distinctiveness of the applicant's mark.

Coexistence in the cited mark owner's home country is particularly persuasive as it suggests that the owner itself does not perceive a likelihood of confusion in a market where both marks are known.

The Cambodian DIP has demonstrated in past cases, such as the "CrossLeader" case, that it considers evidence of coexistence as a relevant factor in assessing the likelihood of confusion. By demonstrating that the mark has peacefully coexisted with similar marks in other jurisdictions, including the home country of the cited mark owner, the applicant can strengthen their argument for distinctiveness and overcome the refusal.

#### **How to present evidence of coexistence effectively?**

- *Gather comprehensive evidence:* Collect evidence from various countries, including the cited mark owner's home country, showing that the mark has been used and registered without conflict.
- *Focus on relevant markets:* Prioritize evidence from countries with similar market conditions or consumer demographics to Cambodia.
- *Highlight peaceful coexistence:* Emphasize that there have been no legal disputes or consumer confusion issues arising from the coexistence of the marks.
- *Use credible sources:* Provide evidence from official trademark databases, court decisions, or other reliable sources.

Overall, evidence of trademark coexistence can play a significant role in overcoming provisional refusals in Cambodia. By presenting compelling evidence and crafting persuasive arguments, applicants can

leverage this factor to convince the DIP that their mark is distinctive and can coexist peacefully with similar marks. However, it's important to note that the weight given to such evidence may vary depending on the specific circumstances of each case.

## Final thoughts

While the provisional refusal of your trademark in Cambodia may cause initial concern, it is important to remember that it is not the final decision. With a thorough understanding of the Cambodian trademark system and the implementation of appropriate strategies, it is entirely possible to overturn the refusal and obtain the protection your trademark deserves.

With 15 years of practical experience in successfully resolving numerous complex trademark disputes, KENFOX IP & Law Office is confident in partnering with you. We understand the challenges you are facing. We will assist you in developing effective strategies, providing sharp arguments, and strengthening your position in intellectual property disputes, thereby maximizing your chances of success in trademark appeals in Cambodia.

If you are seeking a reliable partner to address trademark refusal notices and decisions, don't hesitate to contact KENFOX today.

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