

Guide to Patent Law in Cambodia

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Introduction

The Law on Patents, Utility Models and Industrial Designs, enacted in 2003 as part of Cambodia's accession to the World Trade Organization, provides inventors with a set of exclusive rights, in exchange for disclosure of their invention to the public. The Law on Patents, Utility Models and Industrial Designs has been amended on the article 37, 38, 109 and 136 on 24 November 2017. The Law is complemented by a Prakas (Declaration) on the Procedure for the Grant of Patents and Utility Model Certificates, dated June 29, 2006.

Patents are registered with the Department of Industrial Property of the Ministry of Industry and Handicraft (MIH). While several hundred applications have been filed in the years since the enactment of the law, none had been granted. In 2015, the MIH concluded a Memorandum of Understanding on the Co-Operation in Industrial Property with the Intellectual Property

of Singapore Office (IPOS), resulting in the first patent being granted in 2015 through cooperation with the IPOS. Similarly, the MIH also signed a Joint Statement of Intent on Cooperation for Facilitating Patent Grant of Cambodia-related Patent Application with the Japan Patent Office (JPO) on May 04, 2016, which allows for a further option for filing through the JPO. In order to implement the Memorandum and the Joint Statement, the Ministry of Industry and Handicraft issued two new Prakas (Declarations) on July 25, 2016 on the procedures for accelerating, registering and granting the patent in Cambodia.

Looking forward, similar agreements were signed with the European Patent Office and the State Intellectual Property Office of China in 2017. On 8 December 2017, the Ministry of Industry and Handicraft issued one Prakas (Declaration) on the procedures of validation of European Patent in Cambodia. In addition, the implementing regulation with the State Intellectual Property Office of China will be detailed in our next edition..

Finally, Cambodia became a member of the Patent Cooperation Treaty, per Instruction of Accession dated August 24, 2016 and deposited with WIPO on the September 8, 2016, which came into force on December 8, 2016.

Patentable Inventions

An invention is defined in the law as “an idea of an inventor which permits in practice the solution to a specific problem in the field of technology” and may be, or relate to, a product or a

process.¹ Any invention can be the subject of a patent, except for:²

- Discoveries, scientific theories and mathematical models;
- Schemes, rules or methods for doing business, performing purely mental acts or playing games;
- Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body; this provision does not apply to products for use in any of these methods;
- Pharmaceutical products;
- Plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals;
- Plant varieties.³

Computer software is patentable if it is a:⁴

- Process invention, which in whole or in part, consists of steps that are performed by computer and are directed

¹ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 3

² Law on Patents, Utility Model Certificates and Industrial Designs, Art. 4

³ Plant varieties are protected under the Law on Seed Management and Plant Breeder's Right (Royal Kram No NS/RKM/0508/015)

⁴ Prakas on the Procedure for the Grant of Patents and Utility Model Certificates, Rule 44

by a computer; or

- Product invention consisting of elements of a computer-implemented invention, including in particular:
 - o Machine-readable computer program codes stored on a tangible medium such as a floppy disk, computer hard drive or computer memory; and
 - o A general-purpose computer whose novelty over the prior art arises primarily due to its combination with a specific computer program.

Novelty

The first requirement for an invention to be patentable is that it be a *new* invention, meaning it is not anticipated by prior art.⁵

Prior art consists of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or, where appropriate, the priority date, of the application claiming the invention. Disclosure to the public of the invention shall not be taken into consideration:⁶

- If it occurred within twelve months preceding the filing date or, where applicable, the priority date of the application; and

⁵ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 6

⁶ Id.

- If it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

Inventive Step

Second, an invention must involve an “inventive step.”⁷ An invention involves an inventive step if, having considered the prior art, it would not have been obvious to a person having ordinary skill in the art.

Industrial Applicability

Third, an invention must be industrially applicable, meaning it can be made or used in any kind of industry.⁸ However, if the commercial exploitation of the invention would be contrary to public order or morality, or would be harmful to human, animal, or plant life or health, or would seriously prejudice the environment, or is prohibited by law, then it cannot be patented.⁹

Utility Model Certificates

⁷ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 7

⁸ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 8

⁹ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 9

Utility model certificates are a special form of patent, with a lower standard of registerability and shorter duration term. Whereas a patent must be new, involve an inventive step and be industrially applicable, a utility model need only be new and industrially applicable.¹⁰ Whereas a patent expires twenty years after filing, a utility model certificate expires after seven years, with no possibility of renewal.¹¹ Applicants may, prior to grant or refusal, apply for their patent application to be converted into a utility model application, and vice versa.¹² The conversion may only be done once.¹³

Right to Patent & Naming of Inventor

Only the inventor or inventors have a right to a patent.¹⁴ When two or more persons have independently arrived at the same invention, the person whose application is filed first, or if priority is claimed, the earliest priority date, has the right to the patent.¹⁵ Unless agreed otherwise, the right to patents of inventions made pursuant to an employment contract belong to the employer.¹⁶ The inventor's name will be stated on the patent, unless the inventor opts to remain anonymous.¹⁷

¹⁰ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 69

¹¹ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 73

¹² Law on Patents, Utility Model Certificates and Industrial Designs, Art. 75

¹³ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 76

¹⁴ Law on Patents, Utility Model Certificates and Industrial Designs, Arts. 10 & 11

¹⁵ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 12

¹⁶ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 14

¹⁷ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 15

Application Process

Patent applications can be filed with the Department of Industrial Property of the Ministry of Industry and Handicraft.

Applications may claim priority based on an earlier national, regional or international patent application, according to the Paris Convention¹⁸ and the Patent Cooperation Treaty. In such case, the Department of Industrial Property will request a certified copy of the priority application, as well as any search or examination reports or foreign office actions.

The patent application form must be made in Khmer and be accompanied by a description of the invention, one or more claims, one or more drawings when necessary to understand the invention, and an abstract, and be accompanied by payment of the official fee.¹⁹ The descriptions must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person having ordinary skill in the art.²⁰ If the application claims a prior filing date, a certified copy of the priority application is required²¹ and must be submitted within three months from the request's date by the Registrar.²² Where a certified copy of the priority documents is in a language other than Khmer, it must be translated into Khmer and be submitted to the Registrar within six months from the request.²³ In addition, an English translation for non-English language documents is also required by the Registrar for the purpose of searching and

¹⁸ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 27

¹⁹ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 16

²⁰ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 18

²¹ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 28

²² Prakas (Declaration) on the Procedure for the Grant of Patents and Utility Model Certificates, Art. 20 (5)

²³ Prakas (Declaration) on the Procedure for the Grant of Patents and Utility Model Certificates, Art. 20 (6)

examination, and must be submitted to the Registrar within six months from the filing date.²⁴

The Department of Industrial Property will require the original notarized power of attorney, in case the Cambodian patent agent is appointed to undertake the filing.²⁵ Further, a notarized statement justifying the applicant's right is required where the applicant is not an inventor of the claimed invention.²⁶ The original notarized power of attorney, the statement justifying the applicant's right and a certified copy of the priority application must be submitted with the application or at a later date. The Registrar will issue a letter requesting these documents within two weeks of filing.

Acceleration of Patent Application with Japanese Patent Office

An applicant for a Japanese patent that has been filed in Cambodia may request for acceleration of their Cambodian patent application under the Cooperation for Facilitating Patent Grant (CPG). According the Prakas (Declaration) on the Implementation of the CPG, the request for acceleration of patent decision based on the CPG must be submitted to the Department of Industrial Property of the Ministry of Industry and Handicraft along with a certified copy of the patent gazette in the corresponding Japanese Patent Office patent application and its English translation, a translation of claims and

²⁴ Prakas (Declaration) on the Procedure for the Grant of Patents and Utility Model Certificates, Art. 11

²⁵ Prakas (Declaration) on the Procedure for the Grant of Patents and Utility Model Certificates, Art. 33 (1)

²⁶ Prakas (Declaration) on the Procedure for the Grant of Patents and Utility Model Certificates, Art. 6 (3)

specifications in English and Khmer, and a claims correspondence table. The applicant must submit a translation in Khmer to the Department of Industrial Property within six months of the date on which the request was filed for the CPG.²⁷

Re-Registration of a Singaporean Patent

The Intellectual Property Office of Singapore (IPOS) and Cambodia's Ministry of Industry and Handicrafts concluded a Memorandum of Understanding permitting for the filing of Cambodian patents through the Singaporean authority, and vice versa. The Memorandum of Understanding is valid for five years from January 20, 2015 and can be renewed upon the mutual consent of both parties.²⁸ After the Ministry of Industry and Handicraft issued a Prakas (Declaration) on implementation the Memorandum on July 25, 2016, applicants are allowed to file for Cambodian patents through the IPOS.

In order to register, the applicant must have first been granted a patent in Singapore. The Singaporean patent must be in-force at the time of filing a request for registration in Cambodia. In addition, the patent must have a filing date on or after February 11, 2003.²⁹

The request for registration of a Singaporean patent must be made to the Department of Industrial Property of the Ministry of Industry and Handicraft, and accompanied by a payment of the filing fee, a certified copy certificate of grant of the Singaporean patent, a certified copy of final specifications, a copy

²⁷ Prakas on the Acceleration of Patent Grant under the CPG, Art. 5

²⁸ Memorandum of Understanding on the Co-Operation in Industrial Property, Art. 10

²⁹ Prakas on the Registration of Singapore Patent in Cambodia, Art. 5

of abstract and a copy of original notarized POA if a local patent agent is appointed.³⁰ Although, a certified copy of the Certificate of Grant of Singapore patent is required to be submitted, the Registrar still examines this based on the Patent Law and its related declaration. Cambodian translations must be submitted to the Patent Office within six months from the date of filing a request for registration.³¹ The registration fee and annual fee must be paid within three months from date of Registrar's notification.³²

Patent rights received under this declaration may not be enforced against any prior rights which already existed before the date of filing a request for registration of Singapore patent in Cambodia. A person who has been using or exploiting that patented invention in Cambodia may continue to use or exploit it, even though the Singapore patent was granted by the Cambodia Department of Industrial Property.³³

Decisions of the Ministry of Industry and Handicraft regarding the granting of a patent may be appealed to the competent court within three months of the decision.

Validation of European Patents

Under the Agreement between the President of the European Patent Office and the Cambodian Minister of Industry and Handicraft, signed January 23, 2017, holders of European patent applications may apply to have their patents validated, thereby extending their rights to the Kingdom of Cambodia. The

³⁰ Prakas on the Registration of Singapore Patent in Cambodia, Art. 4

³¹ Id.

³² Prakas on the Registration of Singapore Patent in Cambodia, Art. 10(3)

³³ Prakas on the Registration of Singapore Patent in Cambodia, Art. 11

Agreement was ratified by Royal Kram on November 24, 2017³⁴ and the validation procedures set forth in a Prakas (declaration) dated December 8, 2017.³⁵

Validation must be specifically requested, and is available for both applications directly filed with the EPO, as well as European PCT applications.

The European application must have been filed on or after March 1, 2018, the date of entry into force of the validation agreement. Further, pharmaceutical product patents are excluded from protection under Cambodian patent law, and therefore cannot be validated.

The first step in the validation process, is to pay the validation fee of EUR 180 within six months from publication of the search report in the European Patent Bulletin, or for European PCT applications, within the period for performing acts required to enter the European phase. This payment must be done by the agent representing the applicant before the EPO. There is a two-month grace period following expiration of the six-month window, subject to a 50% surcharge.

Second, assuming the validation fee was properly paid, within three months of the EPO granting the application, request for validation must be submitted to the Cambodian Ministry of Industry and Handicraft.

The patent title, abstract and claims will need to be translated from English into Khmer, the national language of Cambodia. A publication fee and a certificate fee will be due upon acceptance.

³⁴ Royal Kram No. NS/RKM/1117/017 on the Ratification of the Agreement on Validation of European Patents

³⁵ Prakas (declaration) No. 282 MIH/2017 on the Regulation and Procedures for the Validation of European Patents in Cambodia

Following successful validation, the patent owner will be issued an official patent certificate from the Ministry of Industry and Handicraft.

Patent Duration and Annual Fees

A patent is valid for 20 years from its filing date, subject to payment of the following annual maintenance fees³⁶:

Year	Official Fee (USD)	Year	Official Fee (USD)
1st	-	11th	350
2nd	20	12th	400
3rd	20	13th	450
4th	40	14th	500
5th	100	15th	550
6th	140	16th	610
7th	180	17th	670
8th	220	18th	740
9th	260	19th	810

³⁶ Joint Prakas (Declaration) on Public Service Fees, dated July 8, 2015

10th	300	20th	890
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Unity of Invention, Amendment & Division

A patent must relate to only one invention, or a group of inventions so linked so as to form a general inventive concept.³⁷ Up until the application is ready to be granted, the application may be amended, so long as it does not go beyond the original disclosures.³⁸ Similarly, the application may be divided into two or more applications.³⁹

Patent Rights

The core patent right is the right to prevent others from exploiting the patented invention.⁴⁰ “Exploitation” of a patented product means the making, importing, offering for sale, selling, stocking, using, or using of it. For patented processes, exploitation means using the process, or exploiting any product obtained directly by means of the product.⁴¹

The patent owner can institute court proceedings against any infringer, or anyone who performs acts which make infringement likely to occur.⁴²

³⁷ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 23

³⁸ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 24

³⁹ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 25

⁴⁰ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 41

⁴¹ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 42

⁴² Law on Patents, Utility Model Certificates and Industrial Designs, Art. 43

Certain limitations to patent rights exist, namely:⁴³

- Acts with respect to articles put on the market by the patent owner or with their consent;
- Articles on vehicles temporarily or accidentally entering Cambodia;
- Experimental purposes;
- Users of the invention, or those making effective and serious preparations for use, prior to the priority date.

Upon request of the patent owner, or by a licensee in certain circumstances, a court may grant an injunction to prevent infringement or imminent infringement, award damages, or any other remedy provided for by law.⁴⁴ Further, anyone who knowingly infringes a patent shall be criminally punished by a fine of 5-20 million Riels (approx. USD 1,250-5,000), and/or imprisonment from one to five years.⁴⁵ Repeat infringers are subject to double fines and imprisonment.⁴⁶

Government Exploitation & Non-Voluntary Licenses

Patent rights are not absolute, but subject to important limitations for government exploitation and non-voluntary licenses. The Government of Cambodia may decide, even without the agreement of the patent owner, that a government

⁴³ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 44

⁴⁴ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 126

⁴⁵ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 133

⁴⁶ Id.

agency or a designated third-person may exploit the patent for the public interest in particular, national security, nutrition, health or development of vital economic sectors.⁴⁷ Further, if a court decides the patent owner's or licensee's use of the patent has been anti-competitive, they may permit government or third party-exploitation.⁴⁸ In either case, the patent owner has a right to a hearing and the payment of adequate remuneration.⁴⁹

In addition to government and third-party exploitation, the law allows for the granting of non-voluntary licenses. Four years after the filing of the patent, or three years from its granting, whichever comes later, anyone may submit a request to the Minister for a non-voluntary license. This will be granted if it can be satisfactorily shown that the patented invention is not exploited, or is insufficiently exploited in Cambodia.⁵⁰ However, the patent owner may prevent the issuing of the non-voluntary license if they can show justifying circumstances.⁵¹ As with government and third-party exploitation, the patent owner is entitled to compensation.⁵²

Invalidation

Any interested party may request the invalidation of a granted patent.⁵³ The request will be granted if it can be shown that the patent's subject matter is improper, it is not novel, does not involve an inventive step, is not industrially applicable, or if its

⁴⁷ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 47

⁴⁸ Id.

⁴⁹ Id.

⁵⁰ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 56

⁵¹ Id.

⁵² Law on Patents, Utility Model Certificates and Industrial Designs, Art. 57

⁵³ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 65

exploitation is contrary to public order, morality, or prohibited by law.⁵⁴ Further grounds for invalidation include insufficient description, improper claims or insufficient drawings.⁵⁵

⁵⁴ Law on Patents, Utility Model Certificates and Industrial Designs, Art. 66

⁵⁵ *Id.*

Quick Reference: Patent

Applicable Laws & Regulations (selected)

- Law on Patents, Utility Model Certificates and Industrial Designs
- Law on Amendment of the Article 37, 38, 109 and 136 of Patents, Utility Model Certificates and Industrial Designs
- Prakas (Declaration) on the Procedure for the Grant of Patents and Utility Model Certificates
- Prakas (Declaration) on Acceleration of Patent Registration for Japanese Patent Applications
- Prakas (Declaration) on Registration of Singaporean Patent

Filing Requirements

- Full name, address, and nationality of applicant and inventor;
- International classification of the patent
- Priority claim information and certified copy of application, if applicable
- Patent specifications (title, description, claims, abstract,

and drawings)

- Notarized power of attorney
- Notarized statement justifying applicant's right

Duration & Renewal Requirements

- 20 years from filing date, subject to annual maintenance fees

Official Fees

- Application Filing: USD 80 for up to 10 claims + USD 5 per additional claim
- Granting of Certificate: USD 150
- Publication: USD 30

Pheng Thea

Pheng Thea is the co-founder and principal of Abacus IP, a full-service intellectual property agency in the Kingdom of Cambodia. A seasoned IP professional, Mr. Pheng is licensed by the Cambodian Ministry of Commerce's Department of Intellectual Property and certified by the World Intellectual Property Organization.

Prior to founding Abacus IP, Mr. Pheng lead the IP prosecution practice at a leading Cambodian law firm. His practice involved the registration and maintenance of hundreds of trademarks, patents, industrial designs and other forms of IP on behalf of innovators and businesses from around the globe.

Mr. Pheng is a graduate of the faculty of law of Pannasastra University of Cambodia. In addition, he holds a Certification in Intellectual Property Specialization from the World Intellectual Property Organization and the University of South Africa.

David Haskel

David Haskel is a co-founder and director of Abacus IP, a full-service intellectual property agency in the Kingdom of Cambodia. A member of the State Bar of California, David maintains a broad practice across all areas of intellectual property in Cambodia

Prior to founding Abacus IP, David served as managing partner of a leading Cambodia law firm in Phnom Penh, representing clients in a wide range of commercial and IP matters. He has further legal experience with law firms in Silicon Valley, San Francisco and Berlin. Before entering the legal profession, David worked as a research associate with a non-partisan think tank in San Francisco.

David holds a Juris Doctor from the University of California, Berkeley, with a specialization in law and technology, as well as a Bachelor of Arts in political economy from the same institution. Having also studied at Sciences Po in Paris and Tsinghua University in Beijing, he speaks English, French, German and Mandarin.