

Guide to Industrial Design Law in Cambodia

Abacus IP, 2018

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Introduction

An industrial design registration is a form of intellectual property that protects a new, special visual aspect of a product. In Cambodia, industrial designs are protected under the Law on Patents, Utility Models and Industrial Designs of 2003, along with a Prakas (Declaration) on the Procedure for Registration of Industrial Design of 2006. Industrial designs are registered with the Department of Industrial Property of the Ministry of Industry and Handicraft. In addition, through a special agreement with the Intellectual Property Office of Singapore, industrial designs covering Cambodia may be registered through the Singaporean authority, and vice versa.

Most recently, Cambodia acceded to The Hague System for the International Registration of Industrial Designs, effective February 25, 2017. The system provides a practical solution for registering up to a hundred designs in over 65 territories through

one single international application. Together with Cambodia's recent accession to the Patent Cooperation Treaty and the Madrid System for International Registration of Trademarks, this development radically simplifies the procedures and reduces the cost for foreign IP holders protecting their rights in Cambodia. By number of registrations, industrial designs are the second most important form of IP in Cambodia, after trademarks.

Registerable Industrial Designs

An industrial design is defined in the law as “any composition of lines or colors or any three-dimensional form, or any material, whether or not associated with lines or colors, [...] provided that such composition, form or material gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft, and appeals to and is judged by the eye.”¹ Thus, aspects that pertain to other senses, such as touch or sound, are not protectable. Protection does not extend to parts of a design which serve solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.²

Industrial designs must be “new” to be registered, meaning they cannot have been disclosed to the public, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date.³ Disclosures to the public shall not be taken into consideration if a) it occurred within twelve months preceding the filing date or, where applicable, the priority date of the application or, b) by

¹ Law on Patents, Utility Models and Industrial Designs, Art. 89

² Law on Patents, Utility Models and Industrial Designs, Art. 90

³ Law on Patents, Utility Models and Industrial Designs, Arts. 91 & 92

reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party.⁴ Industrial designs that are contrary to public order or morality cannot be registered in Cambodia.⁵

Application Process

Industrial design applications are filed with the Department of Industrial Property of the Ministry of Industry and Handicraft. The application form and any documents forming a part of an application must be submitted in the Khmer.⁶ The required information for filling in the application form are as follows:

- Name, address, nationality and contact details of the applicant and inventor;
- Title of the industrial design;
- International classification of the industrial design;
- Indication of the kinds of products for which the industrial design is to be used;
- Indication of novelty and protectable points of industrial design;
- Short description of industrial design;

⁴ Law on Patents, Utility Models and Industrial Designs, Art. 92

⁵ Law on Patents, Utility Models and Industrial Designs, Art. 93

⁶ Prakas (Declaration) on the Procedures for Registration of Industrial Design, Art. 7

The application form must be submitted with drawings, photographs or other adequate representation of the article. As soon as the required documentation is submitted and an official fee is paid to the Department of Industrial Property, the Registrar will provide an application number and filing date to the applicant.⁷

Unless otherwise agreed in the employment contract, works created by an employee will belong to the employer. In this situation, an original notarized statement justifying the applicant's right to this registration would be required. Where an applicant's ordinary residence or principal place of business is outside Cambodia, the applicant must be represented by an agent residing and practicing in the Kingdom of Cambodia⁸. The applicant must provide an original notarized power of attorney to the Registrar within two months from the filing date.⁹

As Cambodia is a member of the Paris Convention and World Trade Organization, applications may claim priority based on an earlier national, regional or international application.¹⁰ The period of priority is six months from the date of filing of the first application.¹¹ In such case, the Department of Industrial Property will request a certified copy of the priority application. The period for furnishing the certified copy of the earlier application is three months from the date of the request by the Registrar.¹² A Cambodian translation of the certified copy of the

⁷ Law on Patents, Utility Models and Industrial Designs, Art. 101

⁸ Law on Patents, Utility Models and Industrial Designs, Art. 116

⁹ Prakas (Declaration) on the Procedures for Registration of Industrial Design, Art. 18

¹⁰ Law on Patents, Utility Models and Industrial Designs, Arts. 100 & 27

¹¹ Paris Convention, Art. 4

¹² Prakas (Declaration) on the Procedures for Registration of Industrial Design, Art. 11

earlier application must be submitted to the Registrar within six months from the date of the request.¹³

The current processing time is approximately four to six months from application to obtaining the registration certificate, assuming all the requirements are fulfilled.¹⁴ This estimate is based on past experience and may take longer depending on the workload of the Registrar. Decisions of the Ministry of Industry and Handicraft regarding the registration or refusal of an industrial design may be appealed to the competent court within three months of the decision.¹⁵

Re-registration of Singaporean Industrial Designs

The Intellectual Property Office of Singapore (IPOS) and Cambodia's Ministry of Industry and Handicrafts concluded a Memorandum of Understanding permitting for the re-registration of Cambodian industrial designs through the Singaporean authority, and vice versa. The Memorandum of Understanding is valid for five years from 20 January 2015 and may be renewed upon the consent of both parties. The implementation of the MOU is currently waiting for enactment of enabling regulations, and thus applications are not yet accepted for re-registration.

¹³ Id.

¹⁴ Law on Patents, Utility Models and Industrial Designs, Art. 103

¹⁵ Law on Patents, Utility Models and Industrial Designs, Art. 124

Rights, Duration and Renewal

The core industrial design right is the right to prevent others from exploiting the registered industrial design.¹⁶ “Exploitation” means the making, selling or importing of articles incorporating the industrial design.¹⁷ The owner of the registered industrial design can initiate court proceedings against any person who infringes the industrial design by performing such acts without agreement or consent, or who makes infringement more likely to occur.¹⁸ Cambodia follows the principle of national exhaustion, meaning that parallel imports, also known as grey market goods, are held to be infringing.¹⁹

The registration of an industrial design is valid for five years from the filing date of the application for registration. The registration can be renewed for two further consecutive periods of five years through payment of the official fee, for a total of fifteen years.²⁰ The renewal application form must be submitted, along with the original registration certificate, within six months preceding expiration of the registration.²¹ The notarized original power of attorney is required if the owner of the industrial design is represented by an agent. There is a grace period of six months following the expiration date, subject to payment of a surcharge, after which the registration will be deemed abandoned.²²

¹⁶ Law on Patents, Utility Models and Industrial Designs, Art. 105

¹⁷ Law on Patents, Utility Models and Industrial Designs, Art. 106

¹⁸ Law on Patents, Utility Models and Industrial Designs, Art. 108

¹⁹ Law on Patents, Utility Models and Industrial Designs, Art. 107

²⁰ Law on Patents, Utility Models and Industrial Designs, Art. 109

²¹ Prakas (Declaration) on the Procedures for Registration of Industrial Design, Art. 16

²² Id.

Invalidation

Any interested party may request the invalidation of a granted industrial design to the competent court.²³ The request will be granted if it can be shown that the industrial design's subject matter is improper, if it does not meet the definition of an industrial design, if it is not new, if the owner is not the creator or successor in title, or if it is contrary to public order, morality, or prohibited by law.²⁴ An invalidated registration is deemed null and void from the date of registration.²⁵ The competent court has to notify the Department of Industrial Property for their record and publication.²⁶

Change in Ownership and License Contract

Any interested party to the registration or application of an industrial design can request the Registrar for change of ownership. The request for change in ownership must be in writing and be recorded and published by the Registrar. Such change will have no effect against third parties until such recording is completed.²⁷ Similarly, license contracts need to be recorded in the registry, or else are ineffective against third parties.²⁸ The Registrar will keep their contents confidential. A request for change in ownership or recordal of license contract is subjected to payment of official fees.

²³ Law on Patents, Utility Models and Industrial Designs, Art. 110

²⁴ Law on Patents, Utility Models and Industrial Designs, Art. 111

²⁵ Law on Patents, Utility Models and Industrial Designs, Art. 112

²⁶ Law on Patents, Utility Models and Industrial Designs, Art. 113

²⁷ Law on Patents, Utility Models and Industrial Designs, Art. 114

²⁸ Law on Patents, Utility Models and Industrial Designs, Art. 115

Infringement, Remedies & Penalties

The owner of a registered industrial design enjoys the exclusive right to prevent others from making, selling or importing articles incorporating the industrial design. Infringement occurs when a registered industrial design has been exploited by any person without the agreement or consent of the owner.²⁹ Upon the request of the owner, the competent court may grant an injunction to prevent infringement or an imminent infringement, award damages and grant any other remedy provided for in the general law.³⁰ A licensee whose license contract has been recorded with the Registrar may also request the competent court to take immediate action when the owner has refused or failed to do so.³¹

Criminal penalties for infringement are a fine of five million Riels (approx. USD 1,250) to twenty million Riels (approx. USD 5,000), imprisonment from one year to five years, or both. Double fine and/or imprisonment will be imposed if the offense occurred within five years from the date of previous conviction.³²

The applicant and their agent are under a duty to provide correct statements in the application and documents to the Registrar, or may be subject to a fine and/or imprisonment.³³

²⁹ Law on Patents, Utility Models and Industrial Designs, Art. 125

³⁰ Law on Patents, Utility Models and Industrial Designs, Art. 126

³¹ *Id.*

³² Law on Patents, Utility Models and Industrial Designs, Art. 133

³³ Law on Patents, Utility Models and Industrial Designs, Art. 132

Quick Reference: Industrial Design

Applicable Laws & Regulations (selected)

- Law on Patents, Utility Model Certificates and Industrial Designs, 2003
- Prakas (Declaration) on the Procedure for Registration of Industrial Designs, 2006
- Prakas on Registration of Singaporean Patents and Industrial Designs, 2016

Filing Requirements

- Name, address, nationality and contact details of the applicant and inventor;
- Title of the industrial design;
- International classification of the industrial design;
- Indication of the kinds of products for which the industrial design is to be used;
- Indication of novelty and protectable points of industrial design;
- Short description of industrial design;
- Drawings, photographs or other adequate graphic representation of the article;

- An original notarized Power of Attorney, if applicable;
- An original notarized statement justifying the applicant's right, if applicable;
- A certified copy of the priority documents and English translation thereof, if claimed.

Duration & Renewal Requirements

- Initial term of five years from filing of application
- Two renewal terms of five years each, for a total of 15 years

Official Fees

- Application Filing: USD 20
- Issuance: USD 50
- 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.