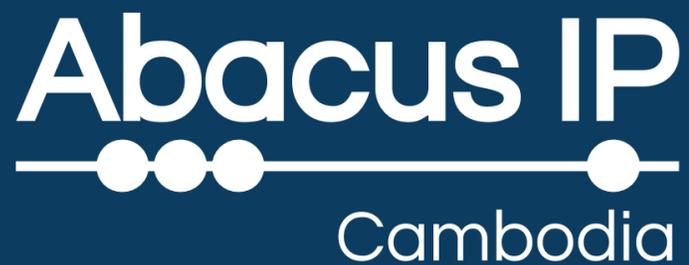


Trademark Law in Cambodia



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Historical Background

Intellectual property rights have existed since the 1960s and 1970s in the Kingdom of Cambodia.¹ A number of trademarks had been registered during this period, such as "PERTUSSIN" and "RIBENA" for pharmaceutical products. Unfortunately, in the early 1970s Cambodia fell into civil war and the Cambodian legal system and property rights were all but destroyed.

In 1991, the External Relations and Trademark Office of the Foreign Trade Division of the Ministry of Commerce was established and began accepting and registering hundreds of international trademarks. Foreign mark applications were applied for and registered under the External Relations and Trademark Office the Foreign Trade Division, the Ministry of Commerce while domestic mark applications were applied for and registered under the Ministry of Industry, Mines and Energy, despite a lack of law or regulation in force.

In 1997, the Intellectual Property Division (IPD or D/IPR) replaced the previous structure, and was established under the supervision of the Director General of Technical Affairs of the Ministry of Commerce. Two years later, the Ministerial Committee Governing the Three Areas of IP was established to prepare laws relating to Cambodia's accession to the WTO.

Shortly thereafter, the National Assembly promulgated the Law Concerning Marks, Trade Names and Acts of Unfair Competition on February 7, 2002. This Law was followed by the Sub-Decree on its Implementation in 2006.

Definition of Mark

Cambodian Trademark Law defines a "mark" as any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise.² Such signs include specifically words, names, letters, numerals, logos, devices, labels, signatures, slogans, colors (and colors combinations), shapes, three-dimensional signs, and holograms.

A collective mark is a trademark owned by an organization, whose members use it to identify themselves with a level of quality or geographical origin or other characteristics set by the organization. The "collective mark" must be a visible sign capable of distinguishing origin or any other common characteristic, including the quality of goods or services of different enterprise which use the sign under the control of the registered owner of the collective mark.³

Trade name means a name or/and designation identifying and distinguishing an enterprise.⁴ It follows the same concepts of trademark, and will not be protected if it is contrary to the public order or

¹ Cambodia D/IPR Website

² Trademark Law, Article 2

³ Id.

⁴ Id.

morality or if it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.⁵

Application Process

All trademarks are applied for and registered with the Ministry of Commerce's Department of Intellectual Property Right. D/IPR accepts a single mark application with multi-classes, but the official filing fee must be paid for each class. Foreign mark applicants must be represented by a Cambodian trademark agent residing and practicing in the Kingdom of Cambodia.⁶

A Cambodian trademark agent must be appointed by the applicant to represent them in filing and registering their trademarks and service marks in Cambodia. The Power of Attorney (POA) must be notarized by a notary public or certified by a lawyer. The notarized or certified POA can be submitted on filing or it can be submitted within two months of the application date.⁷

Although Cambodia is not a signatory of the Nice Agreement nor the Vienna Agreement; it still follows these two classification systems. Class headings are not acceptable. If the mark consists of, or contains figurative elements, these must be described using the Vienna Classification. When the mark consists of or contains non-English words, the transliteration and the meaning are required.

For the mark application claiming a priority date under the Paris Convention, it must be made within six months from the date of the earlier application. The application must contain the name of office of priority filing, priority filing date, and application number and name of the country. A certified copy of the priority document must be submitted within three months from the date of the request by the Registrar.⁸

The minimum requirements for filing are as follows:⁹

- full name of applicant;
- full address of applicant;
- 15 specimens of mark for each class;
- international classification, and goods and/or services specification; and
- official fee for each class.

With the above information, the Registrar will issue the Acknowledgement of Filing Instruction and the mark information will be published on an online database of the D/IPR and WIPO. Further required information and documents must be submitted thereafter. The process for registering trademarks in Cambodia usually takes around six to nine months, although longer waiting times may be encountered depending on the nature of the mark, the applicant and the Registrar. The Ministry of Commerce will issue the certificate of mark registration when the mark application is deemed to comply with the requirements of the Trademark Law.

Cambodia became a member of the Madrid System for the International Registration of Mark on June 5, 2015. The system facilitates the filing of applications in multiple countries. Rather than having to file a trademark application in each country, a brand owner can file a single application with their national or regional IP office, and then select which other countries it wants to register in. This greatly simplifies and reduces the cost of the process, as more than 110 countries are part of the system.

⁵ Trademark Law, Article 20

⁶ Trademark Law, Article 58

⁷ Sub-Decree on the Implementation on the Trademark Law, Article 7

⁸ Sub-Decree on the Implementation on the Trademark Law, Article 13

⁹ Sub-Decree on the Implementation on the Trademark Law, Article 16 and Announcement No. 0016

Prohibitions on Registration

A mark cannot be validly registered if it is:¹⁰

- Incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- Contrary to public order or morality or good custom;
- Likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- Identical with, or is an imitation of, or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organization or organization created by an international convention, unless authorized by the competent authority of that State or organization;
- Identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in the Kingdom of Cambodia for identical or similar goods or services of another enterprise;
- Identical with, or confusingly similar to, or constitutes a translation of a mark or trade name which is well-known and registered in the Kingdom of Cambodia for goods or services which are not identical or similar to those in respect of which registration is applied for, provided that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark that the interests of the owner of the well-known mark are likely to be damaged by such use; or
- Identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

Should the application not comply with one of these points, the D/IPR will issue a Notice of Preliminary Rejection of Mark Registration. The applicant or appointed mark agent has to reply to D/IPR within 60 days. If the D/IPR does not receive a response within this period, the mark application will be lapsed and the application fee will not be refunded.

Maintaining a Mark

In order to maintain or renew the registration, the request for endorsement of affidavit of use or non-use must be submitted to D/IPR within one year following the fifth anniversary of the date of registration of the mark, or the date of registration of renewal when the registered mark has been renewed.¹¹ The Registrar will remove the registered mark from the registry if the owner of the registered mark or his/her legal representative fails to comply with this provision.¹² In current practice however, the Registrar rarely removes the registered mark from the registry, but it may be a ground for cancellation if a third party submits a request.

¹⁰ Trademark Law, Article 4

¹¹ Sub Decree on the Implementation on the Trademark Law, Article 21

¹² Id.

The certificate of mark registration is valid for ten years from the date of filing mark application and it may be renewed for consecutive periods of ten years.¹³ The renewal mark application may be submitted to D/IPR within six month preceding the expiry of the registration.¹⁴ In case the owner of the registered mark or his/her legal representative fails to submit the renewal mark application within six month preceding the expiry of the registration, they can still be submitted in a grace period of another six months with payment of a late fee.

Any changes in the mark application or certificate of mark registration must be made in writing to D/IPR. The Registrar will amend the mark application or records in the certificate of mark registration as soon as the request and other supporting documents are in order, and will then issue a certificate of recordal of change. All changes will be published into an online database of the D/IPR and WIPO. Changes have no effect against third parties until they are properly recorded.

Recordal of License or Franchise Contract

License and franchise contracts for the registered trademark, or pending mark application, may be registered and recorded with D/IPR. License contracts must provide for effective control by the licensor of the quality of the goods or services of the licensee. If the license contract does not provide for quality control or the quality control is not effectively enforce, the license contract will be invalid.¹⁵ License contracts of collective mark are not allowed.

License and franchise contracts are recorded and registered with D/IPR. The contents of license contracts will be kept confidential, but the name of both parties and details of registered mark will be published. Any unrecorded and unregistered license contract has no effect against third parties.¹⁶ License contracts in English language must be translated into Khmer and certified by a Cambodian mark agent or professional translation entity authorized by the Ministry of Commerce.¹⁷

Recordal of Exclusive Rights

The application for recordal of exclusive rights follow similar procedures to the recordal of license or franchise contract. The beneficiary must be a legal person who concluded a contract or exclusive right agreement with the registered owner of a mark. The contract or exclusive right agreement must be notarized by the notary public or certified by a lawyer. The beneficiary may submit a request for recordal of their exclusive right along with other supporting documents to D/IPR. If the documents are in order, the D/IPR will issue a recognition letter to the beneficiary within 60 days. Regardless of the term in the contract or exclusive right agreement, the recognition letter is valid for two years and takes effect three months after the date of registration. The beneficiary must publish this recognition letter in a well-known newspaper in three consecutive days.

Invalidation, Removal and Cancellation

The D/IPR may invalidate, remove or cancel a registered mark from the Registry if one or more

¹³ Trademark Law, Article 12

¹⁴ Trademark Law, Article 22

¹⁵ Trademark Law, Article 19

¹⁶ Trademark Law, Article 52

¹⁷ Announcement No. 0738

requirements of Articles 2, 4, 10, 13, 14 and 15 of the Trademark Law are not fulfilled.

Invalidation allows any interested person to, at any time, submit a request in writing for invalidation of the registered mark to the D/IPR on the grounds that it is indistinguishable or it is contrary to public interest as prescribed in the Article 2(a) and Article 4(a-g) of Trademark Law.¹⁸ The Registrar will issue a notice to his/her representative with the grounds of invalidation. Failure to submit a counter statement within 45 days from the date of receipt, will result in the registered mark being invalidated and published in the Official Gazette. The Registrar's decision is subject to appeal to the Appeal Board of the Ministry of Commerce or competent court within three months from the date of the decision.¹⁹

Removal allows for any interested person to submit a request in writing for removal of the registered mark on the ground that up to one month prior to filing the request or after its registration, the mark has not been used by the registered owner or a licensee during a continuous period of five years. However, the registered mark may not be removed from the Registry if the registered owner or licensee provides that special circumstance prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.²⁰ In addition, the registered mark still can be removed if the registered owner or his/her representative fails to submit the request for endorsement of affidavit of use or non-use.²¹

Finally, the D/IPR has the right to cancel a registered mark on the following conditions:²²

- The applicant does not apply for renewal of the registered mark within the period prescribed under the Article 12(b) & (d);
- The registered owner requests the removal;
- The registered owner has not complied, within 90 days, with the conditions or restrictions prescribed under the Article 8;
- The registered owner ceases to have an address for service in the Kingdom of Cambodia;
- It is convinced upon evidence that the registered owner is not the legitimate owner;
- It is convinced that the registered mark is similar or identical to a well-known mark owned by third party.

Although the Trademark Law provides the right to D/IPR to cancel a registered mark on the above conditions on its own initiative, an interested person can also use those conditions as grounds for his/her request for cancellation. One or more conditions as provided above must be included in a request for cancellation or a notice of cancellation of D/IPR.

Unfair Competition

The Trademark Law also contains provisions on acts of unfair competition. The law states a broad prohibition on unlawful acts of competition that are contrary to honest practices in industrial, commercial, service matters.²³ The following acts are deemed to constitute acts of unfair competitions:²⁴

- all acts of such a nature as to create confusion by any means whatever with the establishment, the good, or the industrial, commercial or service activities of a competitor;
- false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial, commercial or service activities of a competitor;

¹⁸ Trademark Law, Article 13

¹⁹ Sub-Decree on Trademark Law, Article 24(7)

²⁰ Trademark Law, Article 15

²¹ Sub-Decree on Trademark Law, Article 21(4)

²² Trademark Law, Article 14

²³ Trademark Law, Article 22

²⁴ Trademark Law, Article 23

- indications or allegations, the use of which in the nature of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of goods.

Although, there are only three clauses of acts of unfair competition in the Trademark Law, these provisions may be good grounds for competitors if they aware of any unfair acts or dishonest practices which affect their industrial, commercial or service activities.

Infringement and Remedies

The registered owner of a registered trademark enjoys the exclusive right to prevent others from marketing products and services with identical or confusingly similar marks. The exclusive rights are guaranteed in Article 11 of the Trademark Law.

Trademark infringement occurs when a sign which is identical with or confusingly similar to a registered trademark has been used by any person other than the registered owner without their agreement, in relation to the goods or services which are identical or similar to the registered goods or services. The Trademark Law defines three acts which are considered as act of infringements:

- **Infringement of Registered Mark:** An unauthorized use of a registered mark or a sign which is identical with or confusingly similar to a registered mark, in relation to any goods or services for which it has been registered.²⁵
- **Infringement of Registered Well-Known Mark:** Use of a sign which is identical with or confusingly similar to a well-known mark have been used without the agreement of the owner of the well-known mark. Such use must be in relation to goods and services identical with or similar to the goods or services for which the well-known mark has been registered or in relation to goods and services which are not identical with or similar to those in respect of which the well-known mark has been registered and the use of the sign in relation to these goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner are likely to be damaged by such use.²⁶
- **Infringement of Unregistered Well-Know Mark:** Use of a sign which is identical with or confusingly similar to an unregistered well-known mark without the agreement of the owner provided that the sign is used in relation to goods or services identical with or similar to the goods or services for which the mark is well-known.²⁷

The owner of a registered mark can seek remedies from a court of competent jurisdiction or from D/IPR. Upon the request from the owner, the court will issue an injunction to prevent infringement, imminent infringement, or other unlawful act, to award damages and/or to grant any other remedy provided in the general law.²⁸

In practice, remedies for any acts of unfair competition obtained through court proceeding are costly, slow, expensive, and complicated. Conversely, D/IPR of the Ministry of Commerce can act as mediator in settling any infringement disputes. Any party to a mark or unfair competition dispute can initiate a mediation process by requesting in writing to D/IPR. A hearing will typically be arranged, if either party requests it or at the D/IPR's own discretion. If a settlement is reached, it is binding on both parties. If no settlement is reached, either party may bring action in a competent court.

²⁵ Trademark Law, Article 24

²⁶ Trademark Law, Article 25

²⁷ Trademark Law, Article 26

²⁸ Trademark Law, Article 27

Penalties

Use of a registered trademark, service mark, collective mark or trade name without consent from the registered owner will be considered as an act of infringement. Infringers of trademark, service mark, collective mark or trade name are subject to a fine from 1,000,000 to 20,000,000 million Riels (approximately US\$250 to US\$5,000) and to imprisonment from one to five years, or either one.²⁹ Acts of unfair competition will be subject to a fine from 5,000,000 to 10,000,000 million Riels (approximately US\$1,250 to US\$2,500) and to imprisonment from one month to one year, or either one.³⁰ Repeat offenders will be subject to double in both fine and imprisonment. Managing directors, managers and representatives of juristic persons may be liable to criminal prosecution, unless they can prove that they had neither known nor consented to the commission of the offence.³¹

²⁹ Trademark Law, Article 64

³⁰ Trademark Law, Article 65

³¹ Trademark Law, Article 68