



Industrial Designs in Cambodia

September 2012

A No 64, St 111
PO Box 172
Phnom Penh
Cambodia

T +855 23 217 510
+855 23 212 740

F +855 23 212 840

E info@bnglegal.com

W www.bnglegal.com

INTRODUCTION

Cambodia's Law on Patents, Utility Models and Industrial Designs provides a set of exclusive rights to a designer or his assignee for a fixed period of time in exchange for disclosure of their industrial design. Enacted in 2003 to comply with Cambodia's WTO obligations, the Law was supplemented in 2006 by a decree detailing procedures.¹ Although the Law is relatively new and untested, it specifically provides that any international IP treaty to which Cambodia is a party² will trump the national legislation in case of conflict.

This guide couples a synthesis of the legal provisions with practical advice and interpretation. While all the major topics are discussed, the reader should consult the text of the law itself, or ideally an experienced attorney, before relying on this guide for legal advice.

PROTECTABLE SUBJECT MATTER

An industrial design may be any composition of lines or colors, or any three-dimensional form, or any material, so long as it gives a special appearance to a product of industry or handicraft. This special appearance must appeal and be judged by the eye, hence non-visual characteristics – such as the smell or touch of a material – are not protected. Industrial designs do not cover the technical features of a product, nor do they extend in a way that leaves no freedom as to arbitrary features of appearance.

REGISTRABLE INDUSTRIAL DESIGNS

An industrial design must be new to be registered. This means that it has not been disclosed to the public, anywhere in the world, by publication, use, or other disclosure, prior to the filing or priority date. Disclosures made within twelve months of filing or the priority date, by the applicant, his predecessor in title, or a third party by abuse, do not bar registration. Industrial designs contrary to public order or morality are not registrable.

RIGHT TO AN INDUSTRIAL DESIGN REGISTRATION

The right to a industrial design registration belongs to the creator. Like most countries, Cambodia is a “first-to-file” system. Thus, where two or more persons have independently arrived at the same design, the registration is awarded to the applicant with the earliest filing or priority date. Where two or more people have jointly made a design, they jointly have the right to the registration. Unless otherwise agreed by contract, the employer has the right to any design made in execution of an employment contract. Even though the employer has the right to the registration, the employee has the right to be named as the creator on the application.

¹ Prakas No 707 on the Procedure of Industrial Design Registration (2006)

² Cambodia is presently a party to the Paris Convention for the Protection of Industrial Property (1883), the WIPO Convention (1967), Agreement on Trade-Related Aspects of Intellectual Property Rights (1994), and the Convention on Biological Diversity (1992).

APPLICATION PROCEDURE

Industrial designs are registered with the Department of Industrial Property of the Ministry of Industry, Mines, and Energy. Foreign applicants must be represented by an agent residing and practicing in Cambodia. An applicant must submit the following documents:

- **Application Form:** including the name, address, nationality, and residence of each applicant.
- **Statement of Applicant's Right:** Where the applicant is the inventor, the filing must include a statement to that effect. Where the applicant is not the inventor, the filing must indicate each inventor's name and address, and be accompanied by a statement justifying the applicant's right to the registration.
- **Power of Attorney:** Certified by a notary public, granting an agent the authority to act on behalf of the applicant in the registration process.
- **Drawings or photographs** representing the industrial design, no more than 10 cm x 20 cm, on A4 format paper:
 - 4 examples of the drawing or photograph, if the industrial design is two dimensional; or
 - 4 examples of the drawing or photographic for each of the six views (top, bottom, left, right, front, back), if the industrial design is three dimensional;
- **A scale model**, if available, representing the figure of the industrial design, having a maximum dimensions of 20 cm x 20 cm x 20 cm.

As provided for in the Paris Convention, the application may claim priority based on an earlier national, regional, or international application. If priority is claimed, the Registrar may request the applicant to furnish a certified copy of the earlier application. The applicant may choose, at the time of filing, to postpone publication of the application for up to twelve months from the filing or priority date.

RIGHTS, DURATION, AND RENEWAL

The owner of a registered industrial design has the right to exclude others from exploiting the design in Cambodia. Exploitation is defined as the making, selling, or importation of articles incorporating the design.

Registrations are valid for a period of five years from the filing date, renewable for two further consecutive five-year terms, for a total of fifteen years. The renewal filing must be accompanied by payment of a renewal fee, which can be paid up to six months late with payment of a surcharge.

INVALIDATION

Any interested party may request a competent court to invalidate an industrial design registration on the grounds that:

- The design is not new;
- The registration was granted on a design of improper subject matter;
- The design is against public order or morality; or
- The registered owner is not the creator or his successor in title.

Any invalidation renders the registration null and void from the date of registration.

ASSIGNMENTS & LICENSES

Registered industrial designs may be freely assigned and licensed. All changes in ownership (assignments) must be in writing and must be recorded by the Registrar. Unless recorded, assigned registrations are unenforceable against third parties. License contracts, whether oral or written, also need to be registered in order to be enforceable. The Registrar will publish a reference to the recordation, while keeping the license terms confidential.

INFRINGEMENT AND CRIMINAL PENALTIES

A civil infringement suit may be brought by the industrial design owner, or by a licensee, following an unsuccessful request to the owner to do so. The court has wide discretion to award monetary damages and order injunctive relief. Further, the Law provides for criminal penalties for infringement of five million to twenty million Riels (approx. US\$1,250 to US\$5,000), or one to five years imprisonment, or both. If a repeat offense is committed within five years of the previous conviction, penalties for the subsequent infringement can be up to double the fine and imprisonment term.