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TRADEMARK USE IN CAMBODIA

In Cambodia, a trademark is defined as any visible sign capable of distinguishing the goods or services of an enterprise¹.

In a competitive economy, trademarks are essential as they provide buyers with opportunities to make an informed choice. The trademark is ultimately used to identify and distinguish the source of the goods of one enterprise from those of others. It shows the public that the standard of quality they have come to associate with a product or service is met. Yet, if the mark is not used, the true source-identifying function of a mark cannot arise. Once the mark has been created, it must be used to maintain its legal protection.

1. What Constitutes “Trademark Use”?

A trademark is used to distinguish goods or services of an enterprise through different formats. The mark is normally affixed directly to the goods or products. Products bearing a mark allow customers to identify their source. This is direct use of the mark. The use of a trademark is often somewhat different from the use of the service mark. A service mark is generally used on the advertising of the service. As services do not have a package like goods, direct use of the mark becomes more complicated. While the Trademark Law does not define trademark use, the Registrar does follow the international principles and standard rules of WIPO. General uses of a mark that the Cambodian Registrar usually considers may include²:



¹Law concerning Marks, Trade Names and Acts of Unfair Competition (Trademark Law), Article 2 (a).

²Extract from Trademark Manual used by the

Department of Intellectual Property Rights, Ministry of Commerce 2002. Use by an authorized user (eg. Licensee);

- Use by a predecessor in title of the owner of the mark;
- Use on goods or services for distribution and exportation;
- Use through advertisement and promotional materials etc.

Based on practical experience in dealing with the trademark matters in Cambodia, the actual use of the mark by affixing it on the products and/or products’ packages can be most simply recognized as the use of the mark itself in the commerce. This kind of use is easy to assess and the evidence of such use is easily to reproduce. It may happen that two or more mark applications relating to identical or similar mark which are to be used on identical or similar goods or services are filed on different dates. In this case, the registrar may refuse to register any of them until the rights of those applicants have, upon application in the prescribed manners, been determined by him, or have been settled by agreement in a manner approved by him³.

There are many other methods that can be used as evidence of use of the mark. The mark whether it is a trademark or service mark can be used in many different types of trade documentation of the owner such as in the letterhead of the company, invoices and purchase orders etc.

In addition, advertisement and promotional materials can also serve as evidence of use before the Cambodian Registrar. The mark also be used or advertised through electronic means such as the internet.

The mark can be posted online as an electronic advertisement, including using Google or YouTube, or presented the company website.

There is no restriction on the evidence of use submitted as long as the owner of the mark can demonstrate.

³Law concerning Marks, Trade Names and Acts of Unfair Competition (Trademark Law), Article 9. Anyway, where two or more mark applications relating to identical or similar marks which are to be used on identical or similar goods or services are filed on the same date, only one applicant, agreed upon after mutual consultation among all the applicants, may obtain a registration for the mark

2. Legal Effects of the Use of Trademark

The use of the trademark has been moderately taken into the consideration of the Registrar during the registration procedure and trademark use is a key element to protect the registered mark against any unauthorized use by third party. The provisions are applicable to both the use of mark and the use of collective mark⁴.

A. Roles of Trademark Use During the Registration

Process

The use of a mark is not required when filing an application in Cambodia⁵. The mark can be filed on the basis of "Propose to Use". It is not required to use the mark prior its registration in Cambodia. While "use" is a requirement for registration of the mark in some other countries, in Cambodia, as long as the mark does not fall under the conditions listed in Article 4 of the Trademark Law, it will be accepted for registration.

However, this provision is not absolute as trademark use can be relevant to registration where the applicant (the owner of the mark) is relying on the use of the trademark to overcome any objection under Article 4 (a) of the Trademark Law which provides that the descriptive mark is not distinctive and cannot be registered. In this regard, evidence of use of the mark prior to filing the application can be submitted to the Registrar to warrant registration.

From the practical experience of appeal against rejection for trademark registration on the basis of a descriptive mark, it is recommended to submit as much as possible of the evidence of use of the mark in Cambodia and in other countries where the mark has been accepted for registration.

Evidence of long and extensive use will be sufficient to register many trademarks which do not initially appear capable of distinguishing the designated goods or services.

From this perspective, the Cambodian Registrar may accept the mark for registration on the basis of evidence of use. If it is the case, the following endorsement will be entered on the Register: "The trademark is registered on the basis of evidence of use."

B. Trademark Use to Protect the Registration

Under the Trademark Law, the use of Trademark use is vital to secure the validity and protection of the mark itself. Trademark use plays a very essential role to protect the registration of the mark against cancellation or opposition filed.

Article 15 of the Trademark Law provides that any interested person may request to Ministry of Commerce for removing any registered mark on the ground that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of five years. Under this provision, non-use of the mark for five years can lead to the invalidation of the registration of the mark unless the owner of the registered mark can provide the evidence or any special circumstance which blocks the use of the mark. Besides, the law requires the filing of an Affidavit of Use or Non-Use of the mark within one year following the fifth anniversary of the date of the registration of the mark⁶. The filing must be made at the Ministry of Commerce by paying the application fee⁷.

⁴Law concerning Marks, Trade Names and Acts of Unfair Competition (Trademark Law), Article 17

⁵Sub-Decree on the Implementation of the Law concerning Marks, Trade Names and Acts of Unfair Competition, Article 20 paragraph 2.

⁶Sub-Decree on the Implementation of the Law concerning Marks, Trade Names and Acts of Unfair Competition, Article 21.

⁷Law concerning Marks, Trade Names and Acts of Unfair Competition (Trademark Law), Article 5.

A trademark registration may be cancelled or invalidated on a non-use basis upon the request of a third party on the grounds that the registered mark has not been used by its owner or the licensee for a five consecutive year period⁸.

Cancellation on non-use basis can be requested by the owner of the registered mark or any third party. Where the owner of the mark has no further intention to use the mark, s/he can request for trademark removal.

Moreover, a registered mark may also get cancelled in the case where the registered mark is similar or confusing similar or identical to any unregistered well-known mark or registered foreign mark. However, the law does provide the possibility to invalidate such registration if the owner of the unregistered well-known mark can provide sufficient evidence to support their cancellation request including the extensive use of the mark prior the registration of the mark in question. The Registrar will examine all the evidence of use submitted and decide whether or not to invalidate the registration in question.

Details of the use of the trademark are also very useful throughout the enforcement process against any infringement or counterfeiting. If the mark has been actively used, it is very clear that the public can easily recognize and strongly associate with the mark. It might be more difficult for any third party trying to infringe the mark through imitation. The use of trademark is the rights of the registered owner. Therefore, the use of a registered mark, in relation to any goods or services for which it has been registered, by any person other than the registered owner shall require the agreement of that owner. The registered owner can institute court proceedings against any person who infringes the mark by using without his agreement⁹.

CONCLUSION

The specification and modality of the "use" of trademark in Cambodia is currently not defined by any specific legal provisions. In this regard, the use is defined under the discretion of the Registrar by referring to the international standards or conventions related thereto. Generally, as long as the mark is clearly presented to the public by the owner of the mark or the licensee, in connection with the goods or services offered, it can be considered as the use of the mark. Such use or non-use of the mark may affect the registration process of the mark and also the validity of the registration.

Trademark use, both prior to registration and post- registration is useful to gain protection for the mark. Therefore, once the mark is created, it should be used as such use can create brand value to the owner of the mark and even if use of the mark is not required for filing a trademark registration application, use may be helpful to get the mark registered if there will be any objection to registration. In order to gain protection, the mark must be registered. In conclusion, the use of the mark plays a crucial role in registration, protection, cancellation and enforcement of the trademark rights in Cambodia.

⁸Sub-Decree on the Implementation of the Law concerning Marks, Trade Names and Acts of Unfair Competition, Article 24 (6).

⁹Law concerning Marks, Trade Names and Acts of Unfair Competition (Trademark Law), Article 11. Sub-Decree

ABOUT US

BNG Legal is a leading regional law firm providing comprehensive legal services to foreign and local clients in Cambodia and Myanmar.

Registered with the Bar Association of the Kingdom of Cambodia, our legal professionals combine international standards with local expertise.

We differentiate ourselves by coupling a deep understanding of the local business environment with international professionalism and integrity.

We facilitate business, investment and trade between Cambodia, Myanmar, and the rest of the world through innovative and cost-effective legal services.

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Conducting daily business in Cambodia and Myanmar, BNG Legal is up to date with the newest procedures and requirements, helping clients efficiently and successfully complete any project.

CAMBODIAN LAW BLOG

cambodianlaw.wordpress.com

BNG Legal believes expanding access to legal information is crucial to rule of law. To that end, several of our legal professionals write a blog discussing recent developments in the legal landscape.

LEGAL DATABASE

The laws and regulations in our database are based upon the Official Gazettes, law compendiums and other collections from the ministries and institutions of the Royal Government of Cambodia. These are available to the public through our partner site, www.bnglaw.net.

LEGAL UPDATE

No 42 on Urbanization of Capital City, Towns and Urban Areas, dated April 03, 2015

The Royal Government of Cambodia has issued a Sub-Decree that elaborated in detail the technical and political process of urban planning focused on land using and the design of urban environment. The scope of the Sub-Decree covers all types of land (State Owned Land and Private Owned Land).

Urban Planning according to the Sub-Decree are divided into two main types:

1. Buildable Land: Housing Area, Commercial Area, Industrial Zone etc.
2. Restricted Buildable Land: Agricultural Zone, Forest, Water Reserved Zone etc.

The provisions set forth in this Sub-Decree seem to impose many requirements for land user, both public and private sector. It contains articles that limit buildable area on a land plot, restrict building's height, define space between buildings and space between streets and buildings etc. It even determines space for garden, the amount of tree required on a land plot as well as space for car parking.

For example:

- A flat: buildable space cannot exceed 75% of land plot
- A commercial building: buildable space cannot exceed 60% of land plot
- A tree per 150 spm of a land plot Parking Space:
- Super market: space for one car per 20 spm
- Night Club: space for one car per 1 spm of dance floor

To enforce this Sub-Decree, penalties are also defined such as construction permit removal, reconstruction, construction suspension, and fine.

Notification No.1182 of the Ministry of Commerce Dated April 22, 2015

In respect of the provision of the Cambodia Law on Trademark and Unfair Competition, all applications in relevant to the Intellectual Property under the authority of the MOC are available on the web page of the www.cambodiaip.gov.kh and to be thumbprint or signed and stamped by the applicant or the legal trademark agent.

All application forms shall be made in the original forms enclosed with the proof of payment on the official fee and the original form or certified documents.

This notification will come into force from September 01, 2015.

Circular No. 064/15 of the Organizing and Functioning of the Department of Standard and Study Program Dated February 23, 2015

The Department of Standard and Study Program is under the Ministry of Labor and Training. This department works on the short skill training and has its role to prepare the national policy and strategies in various forms to strengthen the vocational training skills and the capacity. The Department of Standard and Study Program consists of 7 offices and their functions are varied to achieve its Department purposes.