

## TABLE OF CONTENTS

- Protection of Well-Known Marks in Cambodia

## AUTHORS

- Mr. Tok Thavsothaly  
Legal Advisor

After the adoption of the Law concerning Marks, Trade Names, and Acts of Unfair Competition (Cambodian Trademark Law), in 2002, a legal framework for trademark protection was developed. Of particular note, Cambodia successfully became a member of the Madrid Protocol in the mid-2015, which means Cambodia is now able to accept international trademark applications.

Although Cambodia is now part of the Madrid System for international trademark registration, protection of well-known marks is still a challenge. As a result, the following questions need to be addressed:

### 1. What is a well-known mark?

The definition of a well-known trademark cannot be found, in the Paris Convention for the Protection of Industrial Property of the World Intellectual Property Organization, or in Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). Joint Recommendation concerning Provisions on the Protection of Well-Known Marks, adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999 (the Joint-Recommendation), neither provide the definition of a well-known mark.

There are no particularly helpful definitions of a well-known mark in either Article 6 bis of the Paris Convention or Article 16 of TRIPS. So the interpretation of whether a trademark can be considered well-known is interpreted on an independent, national scale. However, these three international legal instruments do make a provision that well-known marks must be protected. Protection of well-known marks is therefore internationally recognized, in particular by all member states of WIPO.



In the absence of an international definition of a well-known mark, each member state of WIPO is free to define its own definition to which they see fit with their national regulations and practices. However, the Cambodian Trademark Law is silent on this matter. A well-known mark definition is found neither under this Law nor any other legislation. Yet, the Law particularly provides that well-known mark must be protected against any trademark infringement. The legal provisions governing such protection are very limited. There are only four articles (Articles 4, 14, 25 and 26) in the Law that mention about well-known mark while there is only one article (Article 24-4) mentioning about the well-known mark in the Sub-Decree No. 64 on the Implementation of Law concerning Marks, Trade Names and Acts of Unfair Competition. Unlike some other countries, the definition of well-known mark, therefore, remains absence under the laws and regulations of Cambodia.

### 2. What elements constitute a well-known trademark?

As a member of WIPO, Cambodia has integrated most of the intellectual property protection standards and rules into its national legislations and/or practices.

While an absence of the definition of well-known mark remains a challenge, in practice, this fact does not take away the protection of well-known marks; as stipulated in the Cambodian Trademark Law.

A Trademark Manual developed in 2002, as an information resource designed for use by both Trademark Office personnel and members of the public, contains detailed notions of what constitutes a well-known mark and are being used as rules of practice, pursuant to the provisions of the Cambodian Trademark Law.

Having incorporated international standards, the manual gives a comprehensive list of elements to be taken into consideration in the determination of a well-known mark. Under Cambodian Trademark practice, to be considered as a well-known mark, the following elements must be taken into account<sup>1</sup>:

- The degree of knowledge or recognition of the mark in the relevant sector in Cambodia;
- The duration, extent and geographical area of any use of the mark;
- The duration, extent and geographical area of any

<sup>1</sup>Trademarks Manual, Intellectual Property Division, Ministry of Commerce, Kingdom of Cambodia, published on November 2002 (version 1.0)

**A** No 65B, St 111  
PO Box 172  
Phnom Penh  
Cambodia

**T** +855 23 217 510  
+855 23 967 450

**F** +855 23 212 840

**E** cambodia@bnglegal.com

**W** www.bnglegal.com

## 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.

Superior knowledge of local protocol, local procedure, and local people is necessary for any business to succeed.

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](http://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](http://www.bnglaw.net).

promotion of the mark;

-The duration of any registration and/or application for registration in Cambodia;

-A record of successful enforcement of rights to the mark;

- The value associated with the mark.

In line with international practices, on the determination of a well-known mark, it is not a requirement that all of the above elements be met for a mark to be qualified as a well-known mark. This will vary from case to case.

### 3. What are the different types of protection for a well-known mark?

While the definition of well-known mark is absent, the protection of a well-known mark is recognized under the Cambodian Trademark Law in accordance with the international legal instruments of Intellectual Property.

As long as a mark meets any or all of the above-mentioned elements, the Registrar will consider the mark to be well-known. Recognized well-known mark will enjoy broader protection, as stipulated in the Cambodian Trademark Law.

Under Cambodian Trademark Law, a well-known trademark is protected, even if it is not registered in Cambodia. A well-known mark is protected against registration, and/or any use by a third party, without proper consent from the owner of the well-known mark.

The scope of protection of a registered well-known mark differs from an un-registered one.

In accordance with Article 4 (e) of Cambodian Trademark Law, a mark cannot be validly registered in the Kingdom of Cambodia if it is identical with, or confusingly similar to, or constitutes a translation of a mark which is well-known in the Kingdom of Cambodia, with identical or similar goods or services of another enterprise.

This means an un-registered well-known mark is protected against any attempt at registration of an identical or similar mark, for identical or similar goods or services, by a third party, without consent from the owner of the un-registered well-known mark.

Pursuant to Article 26 of the Cambodian Trademark Law, concerning an act of trademark infringement, the unregistered well-known mark is protected against any use of a sign identical with, or confusingly similar to it, for goods or services identical with or similar to the goods or services for which it is well known without the agreement of its owner.

As a result, the protection of an unregistered well-known mark is limited to identical or confusingly similar signs for identical or similar goods or services.

On the other hand, if a well-known mark is registered in the Kingdom of Cambodia, the owner of the

mark has the exclusive right to prevent a third party from the registration or use of any identical, confusingly similar, or translated conflicting mark. This equally applies to goods or services, which are not identical or similar to those for which registration has been applied if the interests of the owner of the mark are likely to be damaged by such registration or use.<sup>2</sup>

As stated in Article 25 of Cambodian Trademark Law, an infringement of a registered well-known mark happens in two cases if there is:

- any use of a sign identical with or confusingly similar to the registered well-known mark, without the agreement of the owner of the registered well-known mark, in relation to goods and services identical with or similar to the goods and services for which the registered well-known mark has been registered; or

- any use of a sign identical with or confusingly similar to the registered well-known mark, without the agreement of the owner of the registered well-known mark, in relation to goods and services that are not identical with or similar to the goods and services for which the registered well-known mark has been registered but the interests of the owner of the registered well-known mark are likely to be damaged by such use.

It is interesting to note that any registered mark can be removed from the Registry if it is certain that such registration causes confusion to the public<sup>3</sup> as it is identical or similar, to a well-known mark already owned by a third party, either with or without registration in Cambodia,

Similar to other jurisdictions, a registered well-known mark gains broader protection compared to an unregistered well-known mark.

Furthermore, there are no special procedures for registration of a well-known mark in Cambodia. Registration of a well-known mark follows the same procedures as a normal mark.

As prescribed in the Cambodian Trademark Law, in order to enjoy protection, as a registered or unregistered well-known mark, all of the above mentioned elements must be met. Furthermore, the owner of an international well-known mark is strongly recommended to have it registered in Cambodia so that they can fully enjoy protection provided under the Cambodian Trademark Law.

Every trademark owner needs to gather concrete evidence in support of their application, if they wish to be successful in obtaining broad protection status, for their well-known mark, under Cambodian Trademark Laws.

<sup>2</sup> Article 4 (f) of Law concerning Marks, Trade Names and Acts of Unfair Competition 2002

<sup>3</sup> Article 14 of Law concerning Marks, Trade Names and Acts of Unfair Competition and Article 24-4 of the Sub-Decree No. 64 on the Implementation of Law concerning Marks, Trade Names and Acts of Unfair Competition.