

Tilleke
& Gibbins

Intellectual Property in Cambodia _____

Registration

Protection

Commercialization



Overview

— IP Rights

What is intellectual property?

Intellectual Property involves “creations of the mind,” according to the World Intellectual Property Organization. Examples of intellectual property include inventions, books, works of art, designs, symbols, and more. As businesses and technologies advance, new types of intellectual property are being recognized, such as geographical indications, sound trademarks, three-dimensional trademarks, and holograms.

Intellectual assets, as much as physical assets, hold the potential to generate profits for businesses, but they also risk being stolen or unlawfully used by others. The full protection of intellectual property rights is therefore an essential step to legally ensure that businesses can maximize the value of their IP.

This handbook is intended to provide a brief introduction to IP registration, protection, and commercialization in Cambodia.

What are the main types of IP that can be protected in Cambodia?

Cambodian law provides protection for:

- Trademarks
- Patents
- Industrial designs
- Utility models
- Copyrights
- Geographical indications

It does not, however, offer a specific law on the protection of trade secrets.

Trademark

— Definition

What is a trademark?

A trademark is a mark that is used on, or in connection with, goods or services for the purpose of indicating that they are the goods or services of the proprietor of the trademark, and that they are different from goods or services bearing the trademarks of others.

In Cambodia, a trademark must be in the form of a visible sign, such as a photograph, drawing, brand, name, word, text, letter, numeral, signature, group of colors, shape, figurative element, three-dimensional object, invented picture, or any combination of these.

— Protection

Do I need to register my trademark?

Exclusive rights to a trademark are only granted through registration. In addition, Cambodia has a “first-to-file” trademark system, meaning that registering a trademark as soon as possible will offer the most effective protection against infringement.

Cambodian law does provide limited protection to unregistered marks that are well known in Cambodia. Unregistered well-known marks may be enforced against applications for marks that are identical or confusingly similar and that cover identical or similar goods or services to the unregistered well-known mark.

What types of marks can be registered?

A trademark may be eligible for registration if the mark:

- is visually capable of distinguishing the goods or services in the market;
- is not contrary to public order, morality, or good custom;

- is not misleading in respect of the geographical origin, nature, or characteristics of the goods or services;
- is not an imitation of flags, emblems, or names of states or intergovernmental organizations; and
- is not likely to deceive or cause confusion and is not identical or confusingly similar to another mark, whether registered or unregistered.

It is also possible to register collective marks, trade names, geographical indications, and occasionally three-dimensional marks.

How long does registration take?

A straightforward registration process usually takes nine to twelve months from filing an application to receiving registration certification.

How long does a trademark registration last?

A trademark registration is valid for ten years from the filing date of the application, and can be renewed. Applications to renew trademark rights can be filed six months before the expiration date, and a period of six months is also allowed for late renewal of a mark.

Will a mark be canceled if it isn't used in Cambodia?

A trademark needs to be used in Cambodia once it has been registered. At the end of each period of five years from the date of registration or expiration, an affidavit of use/non-use must be lodged with the Trademark Office. If no affidavit is lodged, the trademark will not be automatically deemed abandoned but will be vulnerable to cancellation at a third party's request.

Can a trademark be licensed in Cambodia?

Trademark owners may grant a license to other businesses or individuals to use their registered trademark, separately or as part of a franchise agreement, for any or all of the goods or services for which it is registered.

Owners can apply to record their license or franchise agreement with the Department of Intellectual Property Rights (DIPR) under the Ministry of Commerce (MOC) in Cambodia. A license or franchise agreement that is not recorded has no effect against third parties. Recording the agreement has evidentiary value in the event of a dispute, allowing the owner, licensee, or franchisee to enforce the trademark rights against third parties. Cambodian courts place substantial weight on officially recorded agreements compare to unrecorded agreements.

Are well-known marks protected in Cambodia?

Cambodian law prevents the registration of a mark that is identical to, confusingly similar to, or a translation of an unregistered mark that is well known in Cambodia for identical or similar goods or services of another enterprise. If the well-known mark has been registered, it may even be possible to prevent registration of a confusingly similar mark even if the goods or services are not identical or similar.

A registered mark that is similar or identical to a well-known mark owned by a third party can be canceled by the Ministry of Commerce.

Using a sign that is identical or confusingly similar to a registered or unregistered well-known mark without permission constitutes infringement, provided that the sign is used in relation to goods or services identical or similar to the goods or services for which the mark is well known.

If a well-known mark is registered, infringement can potentially also concern a sign used in relation to goods and services that are not identical or similar to those for which the well-known mark has been registered.

Is there a system to record a well-known mark in Cambodia?

There is no system to record a well-known mark in Cambodia. The burden of proof to demonstrate the well-known status of a mark is on the party claiming the well-known status. There is no official definition to determine whether a mark is well known, but guidelines are provided in the Cambodia Trademark Manual.

In deciding whether a mark qualifies as “well known,” the DIPR considers:

- how well known or recognized the mark is among the relevant sector of the public in Cambodia;
- how widely the mark has been used;
- how much the mark has been promoted;
- how long the mark has been registered in Cambodia;
- how the owner has enforced its rights to the mark; and
- how valuable the mark is.

Enforcement

How can owners enforce their trademark rights in Cambodia?

An owner of a registered trademark can bring criminal charges against anyone who counterfeits or imitates the mark or who imports, sells, offers for sale, or has for the purpose of sale goods bearing counterfeited or imitated marks.

Infringers are subject to penalties, including fines of up to KHR 10 million (approximately USD 2,400), imprisonment for up to one year, or both, for imitation offenses. For counterfeiting a trademark, the penalties increase to fines of up to KHR 20 million (approximately USD 4,900), imprisonment for up to five years, or both.

Trademark owners can also pursue civil remedies in the form of injunctions against infringers, awards, and monetary damages. Moreover, the court can order preliminary injunctions or temporary restraining orders to stop infringement or imminent infringement, or to preserve evidence.

Owners of unregistered well-known trademarks can petition the court for an injunction to prevent infringement, have damages awarded, and receive various other remedies.

Patent and Industrial Design

— Definition

What can be protected under Cambodian patent law?

Under Cambodia's patent law, protection exists for:

- **Inventions.** An invention is a product or process that provides a new and inventive way of doing something, or permits in practice the solution to a specific problem in the field of technology.
- **Utility models.** A utility model is any invention that is new and industrially applicable and may be, or may relate to, a product or process.
- **Industrial designs.** An industrial design is any composition of lines or colors, or any three-dimensional form or material deemed to be an industrial design 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.

— Protection

What are the requirements for registering a patent or design?

To be eligible for patent protection, an invention must:

- Be new;
- Involve an inventive step that would not be understood by people of average knowledge in the relevant technical field; and
- Be capable of industrial application.

To register an industrial design, it must be new, and it cannot serve solely to obtain a technical result and leave no freedom regarding arbitrary features of appearance.

Is patent registration mandatory?

Registration is mandatory in order to obtain exclusive rights over an invention or industrial design. Applications are filed with the Department of Industrial Property within the Ministry of Industry and Handicraft.

What is a patent's scope of protection?

The owner of a patented invention has exclusive rights to make, use, offer for sale, sell, or import into Cambodia the patented invention or process.

The owner of a protected industrial design has the right to produce and sell the design and can prevent unauthorized copying or imitating of the design by others.

How long does registration take?

The registration process normally takes 4–5 years from the filing date of the application.

How long does patent registration last?

The term of a patented invention is twenty years from the filing date of the application. The term of a protectable utility model certificate is seven years from the filing date of the application, and there is no possibility of renewal. The term of a protectable industrial design is five years from the filing date of the application, and it can be renewed twice.

Can a patent be licensed in Cambodia?

Patent owners may grant a license for their patent to another person. Patent license agreement need to be in writing and registered with the Department of Industrial Property. To have effect against third parties, patent license agreements must be recorded. The law requires license agreements concerning a patent to be recorded, and the content of these agreements will be kept confidential by the registrar's office.

— Enforcement

How can patent owners enforce their rights in Cambodia?

Patent owners can bring criminal charges against anyone who, without authorization, makes, imports, offers for sale, sells, or uses the patented products or any products obtained directly by means of the patented process, or uses the patented process. Owners can also take action against anyone who stocks the patented products for the purpose of offering for sale, selling, or using the product.

The owner of a patented design can bring criminal charges against anyone who, without authorization, makes, uses, offers for sale, sells, or imports articles incorporating the patented design, or performs any of the acts of exploitation, as defined by law, that are exclusive to the patent owner of a patented design. An infringing act can lead to fines of up to KHR 20 million (approximately USD 4,900), imprisonment for up to five years, or both.

In addition to these criminal penalties, owners can also pursue civil remedies for injunctions to stop infringement or imminent infringement, as well as for monetary damages and other remedies.

Copyright

— Definition

What is a copyright?

A copyright is a right granted to the author of a work, a performer, a phonogram producer, or a broadcasting organization. Copyright works under Cambodian law include the following:

- Books or other literary, artistic, scientific, and educational documents.
- Lectures, speeches, sermons, oral or written pleadings, and other works with the same characteristics.
- Dramatic works or musical dramas.
- Choreographic works, either modern or adapted from traditional works or folklore.
- Circus performances and pantomimes.
- Musical compositions.
- Audiovisual works.
- Works of paintings, engravings, sculptures, or other works of collages or applied arts.
- Photographic works or those realized with the aid of techniques similar to photography.
- Architectural works.
- Map plans, sketches, or works pertaining to geography, topography, or other sciences.
- Computer programs and the design encyclopedia documentation for those programs.
- Products of collage work in handicrafts, hand-made textile products, or other clothing fashions.

However, copyright protection does not extend to ideas, formalities, methods of operation, concepts, principles, discoveries, or mere data, even if expressed, described, explained, or embodied in any work.

— Protection

How are copyrights protected in Cambodia?

Owners of a copyright have exclusive moral and economic rights to the work, enforceable against all other parties.

Moral rights include deciding about the manner and timing of disclosure of the work; deciding about the name, title, and work for the purpose of relations with the public, and preventing distortion, mutilation, or modification of the content of the work.

Economic rights refer to the authorization of reproduction, communication to the public, and creation of derivative works. Specifically, copyright owners have the exclusive right to carry out or authorize someone else to do the following:

- Translate the work into a foreign language.
- Adapt and simplify or undertake any modifications of the work.
- Rent or publicly lend the original or a copy of an audiovisual work or a work embodied in a phonogram, computer program, database, or musical notation.
- Publicly distribute by sale or rental of the original or a copy of a work that has not already been sold or transferred to another authorized owner.
- Import reproduction copies of the work.
- Reproduce the work.
- Publicly perform the work.
- Publicly display the work.
- Broadcast the work.
- Otherwise communicate the work to the public.

— Do I need to register my copyright?

There is no requirement to register a copyright. According to the Cambodian Law on Copyrights and Related Rights (“Copyright Law”), works are automatically protected. However, copyright holders may voluntarily register their work with the Ministry of

Culture and Fine Arts, which can be useful in providing authoritative evidence of ownership when enforcing copyrights in Cambodia.

How long does copyright protection last?

Moral rights last perpetually, while economic rights generally last for the lifetime of the author plus an additional 50 years after the author's death. There are also some special cases:

- For a collaboration, the economic rights expire 50 years after the death of the last surviving co-author.
- For a work published anonymously or under a pseudonym, the economic rights are protected for 75 years from the end of the calendar year of the first publication of the work, with the right holder's authorization. If the work remains unpublished within 50 years of its creation, there is a 100-year period of protection beginning from the end of the calendar year of its creation.
- If the author's identity becomes known before the end of the protection period, the general copyright protection period applies (i.e., lifetime of the author plus 50 years).
- For a collective, audiovisual, or posthumous work, the economic rights are protected for 75 years from the end of the calendar year in which the work was first published. If the work is not made public within 50 years of its creation, there is a 100-year period of protection, beginning from the end of the calendar year of its creation.

Are there limitations and exceptions that apply to copyrights?

The Copyright Law allows importation of copyright works for personal use, subject to certain exceptions. The following acts cannot be prohibited by the author:

- Free and private representations made exclusively to a close circle of people, such as family members or friends.
- Arrangements to preserve in a library a copy of the work for the purpose of conservation or research.
- Noncommercial use of a work for educational purposes.

- Translation of a work from the Khmer language into the languages of ethnic minorities in Cambodia, or vice versa.
- If the author's name and the source of work are clearly indicated, the author cannot prohibit:
 - Analyses and short quotations justified by the critical polemical, pedagogical or informative nature of the work.
 - Broadcasting of press commentary.
 - Dissemination of speeches addressed to the public through press releases or television.
 - Adaptations (comical, stylistic, or caricatures) based on an original work.
 - Reproduction of graphic or plastic works in a public place, unless the reproduction is of the principal subject for subsequent reproduction.

An author who creates a work based on the true story of a person or family member must get permission from that person or their heir.

The following acts are also permitted without authorization of the copyright holder and without remuneration:

- Reporting of news events, on the condition that only short fragments are extracted from the performance, substance of a phonogram, or broadcast.
- Reproduction for the purposes of scientific research.
- Reproduction for educational purposes, except for a performance or phonogram which has been produced for educational purposes.
- Quotation, in the form of a short citation extracted from the performance, phonogram, or broadcast, provided that such quotation conforms to reasonable practices and justifies the proper informative objective.
- All other uses constituting exceptions concerning works protected under copyright by the virtue of this law.
- Picture and sound recording for the purpose of wholly or partly simultaneous broadcasting on the realization of a ceremony, meeting, or other national events from the broadcasting of the original station.

Do owners of foreign copyright enjoy automatic protection in Cambodia?

By law, a foreign work is not protected unless certain criteria are met, such as:

- The foreign author or right holder has a habitual residence in Cambodia or has a legal entity registered in Cambodia; or
- The work was first published in Cambodia or was published in Cambodia within 30 days of being first published abroad.

Following Cambodia's accession to the Berne Convention and its entry into force on March 9, 2022, works are to be automatically protected and do not depend on registration. However, there is not yet any domestic implementing legislation for this.

As foreign works enjoy very limited protection under Cambodia's current copyright legislation, foreign copyright holder may need to register the work to ensure that it meets the criteria for protection and to serve as evidence of ownership.

— Enforcement

How can I enforce my copyright in Cambodia?

Copyright owners can bring criminal charges against infringers. The penalties for infringement depend on the act of infringement and type of work. For example, infringement of production or reproduction of a work includes fines of up to KHR 25 million (approximately USD 6,100), imprisonment for up to 12 months, or both.

Infringement of importation or exportation of a product obtained from the infringing act of reproduction is punishable by fines of up to KHR 10 million (approximately USD 2,400), imprisonment for up to 12 months, or both.

Infringement of a performance or communication to the public is punishable by fines of up to KHR 5 million (approximately USD 1,200), imprisonment for up to 3 months, or both.

Double penalties are applied for repeat offenses.

In addition, the court may order the confiscation of all or parts of the revenue obtained through the acts of infringement and equipment specially installed for the purpose of committing this offense, the confiscation of materials or equipment to be returned to the copyright owner or related rights, or the destruction of the confiscated materials or equipment.

Civil remedies can also be pursued by filing a petition with the court to order a prohibition on the violation of rights, compensation for damages, redress for moral injury, the return of the disputed equipment or material, and the return of any benefits gained from the infringement.

Moreover, the court may order the confiscation or destruction of equipment or materials being produced, used, or made available in an illegal manner. The court also has the authority to seize all necessary evidence. It is important to note, however, that copyright owners who bring a suit can be held responsible for any injury caused to the defendant if the petition is deemed by the court to be unfounded.

Portfolio Management and Commercialization

For companies operating in multiple countries in Southeast Asia, a regional or global portfolio management strategy can yield benefits by centralizing the management of IP assets across multiple jurisdictions. In this way, companies can streamline the process of obtaining and enforcing IP rights, reduce costs, and ensure consistent protection of their IP assets. By considering the legal and cultural differences across different regions, companies can tailor their IP strategy to maximize protection and commercialization opportunities in each market.

Such a comprehensive program would typically include:

- Identification and recordal of IP, both registered and unregistered, and strengthening of legal title to these rights, both in Cambodia and elsewhere;
- Monitoring for third-party activities that could negatively impact your business;
- Monitoring of published trademarks for similar trademarks that could dilute the value of your IP;
- Development of systems to ensure that IP is relevant to your business, that it is properly protected and managed, and that maximum commercial advantage is being derived from it;
- Minimization of cost and risk associated with the acquisition, use, and misuse of IP; and
- Checking and managing of the validity of your IP.

Another important aspect of regional portfolio management in Southeast Asia is the ability to leverage the benefits of regional trade agreements, such as the ASEAN Free Trade Area and the Trans-Pacific Partnership. Under IP provisions of these agreements, companies may be able to take advantage of streamlined application procedures and enhanced IP enforcement measures.

In addition to managing IP portfolios, companies can also use regional commercialization strategies to monetize their IP assets. For example, licensing IP rights to third parties in different countries can provide a reliable source of revenue, while also allowing companies to expand their reach in new markets. Tilleke & Gibbins' practitioners across Southeast Asia have extensive experience in IP commercialization, including agreements related to franchising, licensing, distributorship, technology transfer, trade secrets, confidentiality, spinoffs, joint ventures, and business collaborations.

Many of the world's leading companies rely on Tilleke & Gibbins to help with the full range of IP matters in Cambodia, Indonesia, Laos, Myanmar, Thailand, and Vietnam—including the prosecution, enforcement, litigation, and commercialization of copyrights, industrial designs, patents, trademarks, and trade secrets. Our IP group includes lawyers and patent agents with backgrounds in chemistry, biology, computer science, food science, materials science, and physics; support personnel including investigators and government/police liaisons; and technical specialists in various scientific fields, on an as-needed basis.

Our clients' success under our guidance has led to global recognition of Tilleke & Gibbins' intellectual property department as a leading intellectual property practice by *Asia IP*, *Asian Legal Business*, *Asialaw Profiles*, *Chambers Asia-Pacific*, *IAM Patent*, *The Legal 500 Asia Pacific*, *Managing Intellectual Property*, *World Trademark Review*, and others.

— Contact

To learn more about how we can help you position, protect, and profit from your intellectual assets, please contact:

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