

Course: Intellectual Property Law-Cambodia

Lecture 3: Trademarks and Geographical Indications (Part1)

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Law concerning Marks, Trade Names, and Acts of Unfair Competition

Promulgated by the head of state on February 07, 2002

Law on Geographical Indications

Promulgated by the head of state on January 20, 2014

Law concerning Marks, Trade Names, and Acts of Unfair Competition

72 Articles split into 16 Chapters

- Chapter 1: General Provisions
- Chapter 2: Registration and Rights Conferred by Registration
- Chapter 3: Invalidation and Removal
- Chapter 4: Collective Marks
- Chapter 5: Licensing of Marks
- Chapter 6: Trade Names
- Chapter 7: Acts of Unfair Competition
- Chapter 8: Infringement and Remedies
- Chapter 9: Provisional Measures
- Chapter 10: Border Measures
- Chapter 11: Change in Ownership
- Chapter 12: Maintenance of the Register of Marks
- Chapter 13: Agents
- Chapter 14: Application of International Treaties and Interpretation
- Chapter 15: Penalties
- Chapter 16: Final Provisions

Legal Snapshot

IP ENFORCEMENT IN CAMBODIA

Intellectual Property Enforcement Mechanism

Exclusive Rights	<ul style="list-style-type: none"> • Trademark Law: Article 3, 11 • Law on Patents, Utility Model Certificates and Industrial Designs: Articles 10 and 14 • Law on Copyrights and Related Rights: Article 19
Administrative Measures	<ul style="list-style-type: none"> • TM Law: Articles 56 and 57 • Patents Law: Article 122
Border Measures	<ul style="list-style-type: none"> • TM Law: Articles 35, 36, 37, 38, 39, 40,41,42,43, 44, 45, 46 • Copyrights Law: Article 63
Civil Proceedings and Provisional Measures	<ul style="list-style-type: none"> • TM Law: Art. 27, 28, 29, 30, 31, 32, 33, 34 • Patents Law: Art. 125, 126 • Copyrights Law: Art. 57, 58, 59, 60, 61, 62
Criminal Proceedings	<ul style="list-style-type: none"> • TM Law: Art. 62, 63, 64, 65, 66, 67, 68, 69, 70 • Patents Law: Art. 132, 133, 134, 135 • Copyrights Law: Art. 63, 64, 65

Ministries



Responsible for **trademarks, acts of unfair competition, geographical indications, and undisclosed information including trade secret.**



responsible for **patents, industrial designs and utility models, layout designs, and plant variety protection.**



responsible for **copyrights and related rights**

responsible with **regards to audio-visual, and broadcasting materials**



Ministry of Commerce and Asian Development Bank, *Examples and Explanations Series: Intellectual Property Rights* (Phnom Penh: Ministry of Commerce, n.d.), 8-10.

Administrative bodies law enforcement agents



Intellectual Property Department
www.cambodiaip.gov.kh



Counter Counterfeits
Committee of
Cambodia
<https://cccc.gov.kh>



The Customs and Excise
Department (CED)
www.customs.gov.kh



Anti-Economic
Crime Police



Consumer Protection Competition and
Fraud Repression Directorate-General
(CCF) (previously, Camcontrol)
<https://www.ccf dg.gov.kh>

Ministry of Commerce and Asian Development Bank, *Examples and Explanations Series: Intellectual Property Rights* (Phnom Penh: Ministry of Commerce, n.d.), 8-10.

International Cooperation and Memberships

Cambodian became a member of WIPO on 25 July 1995 and acceded to the Paris Convention on 22 September 1998.

Paris Convention for the Protection of Industrial Property

Cambodia officially participated in the **ASEAN Framework Agreement on Intellectual Property Cooperation** on April 30, 1999.

The Memorandum of Understanding on Intellectual Property Cooperation between Cambodia and Thailand was also concluded on March 05, 1997.

Research Assignment

Research on all IP-related international agreements to which Cambodia a member.

Cambodian

TRADE MARKS LAW

Outline

Definition

What is a trade mark?

What are the grounds on which registration can be refused?

Registration

How can a trade mark be registered?

Infringement

What are the rights conferred?

What is the scope of protection?

ម៉ាក ពាណិជ្ជនាម

Article 1: This law has the objective to protect the marks and trade names duly registered in ^{បញ្ជីម៉ាក} the register of marks in the Kingdom of Cambodia and prevent the acts of unfair competition on the creation, the utilization of marks and trade names.

Chapter 14
**Application of International Treaties
and Interpretation**

Article 60: The provisions of any international treaties in respect of industrial property to which the Kingdom of Cambodia is a party shall apply to matters dealt with by this Law and, in case of conflict with provisions of this Law, shall prevail over the latter.

Examples of trade marks

Global Brand Database



[QUICK SEARCH](#) | [BY BRAND NAME](#) | [BY BRAND LOGO](#) | [BY GOODS AND SERVICES](#) | [ADVANCED SEARCH](#) | [EXPLORE](#) | [DATA COVERAGE - DIP \(KH\)](#) | [TOOLS](#)

Brand name : orthographically resembles 'brown'

Edit your search

TMview

Displaying 1-24 of 24 results (Most relevant first)

[Change layout](#) | [Sort results](#) | [Results per page](#) | [Download results](#)

Results view

Statistics view

Select all

BROWN



Owner Brown Coffee Co., Ltd. (Cambodia)
 IPR National Trademark Registration
 Designation country Cambodia
 Status Registered (April 6, 2016)
 Number KH/2016/59103
 Nice class 30

BROWN



Owner BROWN COFFEE CO., LTD (Cambodia)
 IPR National Trademark Registration
 Designation country Cambodia
 Status Registered (December 13, 2022)
 Number KH/2022/90004
 Nice class 30

BROWN



Owner BROWN COFFEE CO., LTD (Cambodia)
 IPR National Trademark Registration
 Designation country Cambodia
 Status Registered (December 12, 2022)
 Number KH/2022/89969
 Nice class 43

<https://www3.wipo.int/branddb/kh/en/>

What is a trade mark?

- Trade marks are signs which distinguish the goods and services of one business or company from those of another (Art. 2)

Article 2: សញ្ញាដែលមើលឃើញ

(a)-"mark" means **any visible sign** capable of distinguishing the goods (**trademark**) or services (**service mark**) of an enterprise;

- They have the following functions:
 - origin and distinguishing
 - quality
 - advertising

Where else the law explicitly state its clear objectives regarding the origin, quality, or advertising?

Conventional trade marks

- Words, letters and numerals, slogans

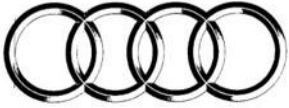
- *Colour marks*

PHILIPS

JUST DO IT



- **Figurative elements, logos**



Sunshine



- *Three-dimensional shapes*



Duracell battery

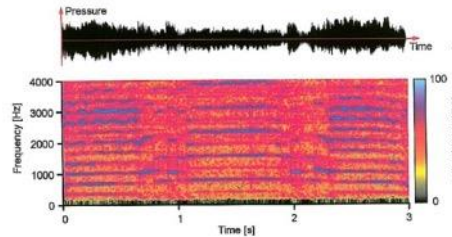


Perrier bottle

Unconventional trade marks

- Sounds, music, jingles
- Signs with movement
- Smells? Tastes?
- Other
 - holograms
 - position marks
 - tracer marks

Nokia movement mark



Article 3: The exclusive right to a mark, as conferred by this Law, shall be acquired by **registration** in accordance with the provisions thereof.

Article 5

(a)-The applications for registration of a mark, recordal of change of applicant address and endorsement of affidavit of use or non-use shall be filed with the Ministry of Commerce.

The application for registration of mark shall contain

- a request,**
- a reproduction of the mark and**

a list of the goods or services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification as mentioned in the annex.

តាមក្រុមមុខទំនិញ

ចំណាត់ថ្នាក់(ទំនិញ)

Trademark

LIST OF CLASSES

-  **Class 1**
Chemical Products
-  **Class 2**
Paints & Vernishes
-  **Class 3**
Cosmetic & Cleaning Substances
-  **Class 4**
Industrial Oils & Lubricants
-  **Class 5**
Medicines
-  **Class 6**
Common Metals & Alloys
-  **Class 7**
Machine Tools
-  **Class 8**
Hand Tools
-  **Class 9**
Scientific & Electric Devices
-  **Class 10**
Medical Instruments
-  **Class 11**
water supply & sanitary purposes
-  **Class 12**
Vehicles
-  **Class 13**
Firearms : Fire Works
-  **Class 14**
Jewellery: Precious Stones
-  **Class 15**
Musical instruments
-  **Class 16**
Papers & Stationery Goods
-  **Class 17**
Rubber Materials
-  **Class 18**
Leather & Imitation of Leathers

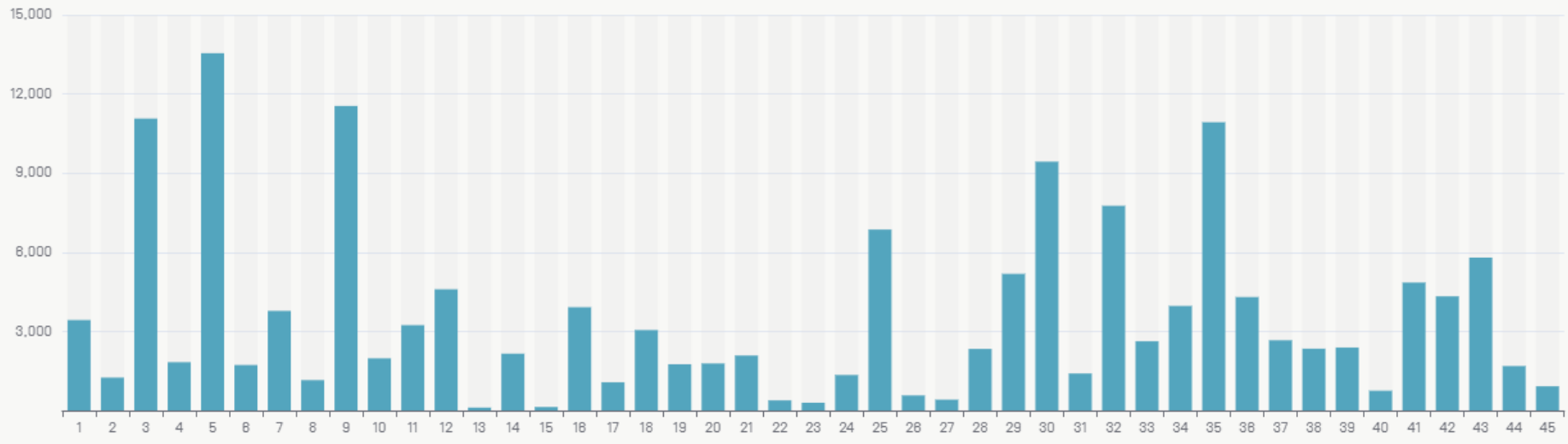
-  **Class 19**
Building Materials
-  **Class 20**
Furniture Goods
-  **Class 21**
Household Containers
-  **Class 22**
Ropes & Bags
-  **Class 23**
Yarns and Threads
-  **Class 24**
Textile Goods
-  **Class 25**
Footwear
-  **Class 26**
Pins & Needles
-  **Class 27**
Carpets & Mats

-  **Class 28**
Toys & Sporting Goods
-  **Class 29**
Meats & Food
-  **Class 30**
Staple Food including Coffee, Tea etc
-  **Class 31**
Agricultural Products
-  **Class 32**
Light Beverages including Beer
-  **Class 33**
Alcoholic beverages excluding Beer
-  **Class 34**
Tobacco Products
-  **Class 35**
Advertising & Business Services
-  **Class 36**
Financial Services
-  **Class 37**
Building construction
-  **Class 38**
Telecommunications
-  **Class 39**
Transportation
-  **Class 40**
Material Treatment Services
-  **Class 41**
Education & Culture Activities
-  **Class 42**
Scientific and technological services
-  **Class 43**
Restaurant & Food
-  **Class 44**
Medical Services
-  **Class 45**
Personal & Social Services

 info@taxzona.in



NICE CLASSIFICATION



WIPO. "Global Brand Database." WIPO. Accessed September 30, 2023. https://branddb.wipo.int/en/IPO-KH/explore/visu?sort=applicationDate%20desc&start=0&rows=30&asStructure=%7B%22boolean%22:%22AND%22,%22bricks%22:%5B%5D%7D&_id=1696080678213&office=KH.

Other categories of protection

Article 2:

(b)-"collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;

- Certification marks ម៉ាកវិញ្ញាតកម្ម
- Collective marks ម៉ាកសមូហភាព
 - Protected geographical indications (PGI)
 - Protected designation of origin (PDO) > PGI

=> Art. 4 of Cambodian GI Law ម៉ាកសម្គាល់តំបន់សាស្ត្រនៃផលិតផល

Geographical Indication refers to a distinctive name, symbol and/or any other sign which is a name or represents a geographical origin and identifies the goods as originating in such geographical area where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin.

Examination

Trademarks should be examined for **absolute, objective grounds** for refusal, that is, whether they are sufficiently distinctive, not deceptive, not immoral, etc.

It is important that nobody should be able to monopolize a descriptive or even a generic term.

Examination

Many countries examine also for so-called **relative grounds**, that is, they consider whether the rights applied for are **identical or similar to prior rights that have been applied for or granted for identical or similar goods**.

They leave it to the owners of prior rights to defend their interests, either by **opposing the trademark application in an administrative proceeding** or by bringing a **cancellation action against a trademark that has been registered and which they believe would infringe their prior rights**.

What cannot be a trade mark

Registration of a trade mark can be rejected based on ‘absolute grounds for refusal’. This applies to:

- **Signs that cannot be represented** => Art. 2- (a)-"mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise;

- **Signs devoid/lacking of any distinctive character** => Art. 4 – (a)
 - Signs which are descriptive
 - Signs which are generic

However, acquiring distinctive character through use is possible

Article 4: A mark cannot be validly registered:

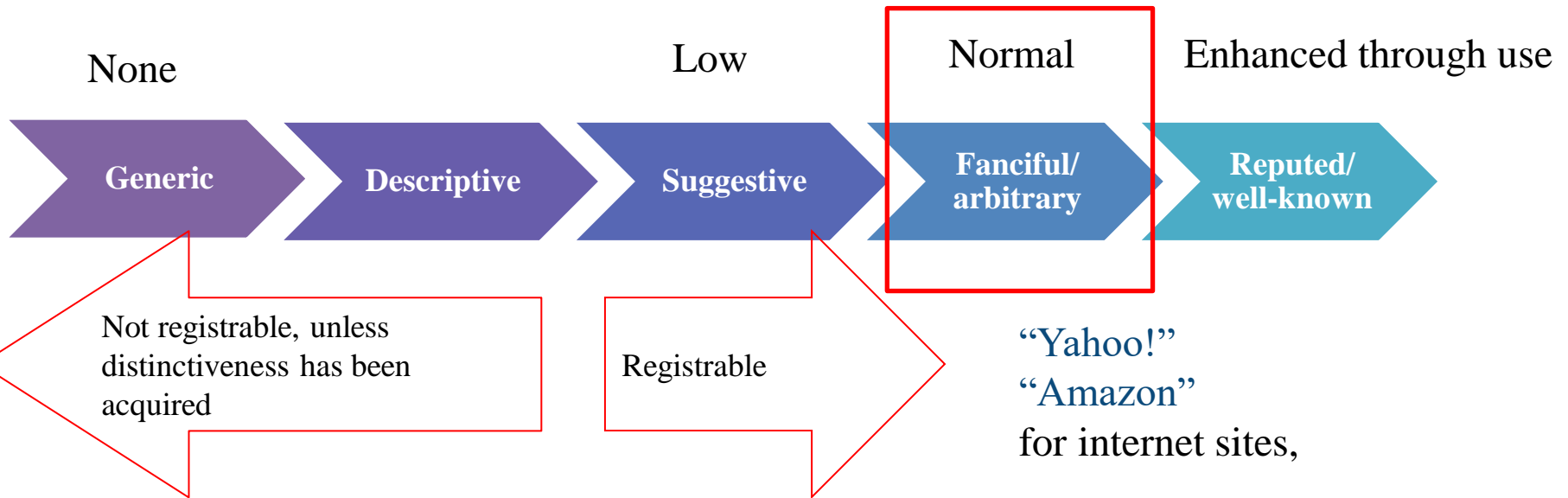
(a)-if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;

Scale or degree of distinctiveness

- The more distinctive the trade mark, the stronger the mark
 - Strong trade marks give wider protection

Level of distinctiveness:

‘Fruit’ for apples is generic. “Computerland” for a computer store “Playboy” for a men’s magazine.



Do you think the following words are distinctive or descriptive in relation to the goods named?

FRUMATO	A drink made from a mixture of fruit juice and tomato juice
MOOTEL	Portable cowsheds
RAPID RICE	Prepared dishes

Do you consider the following devices to be distinctive or descriptive for the goods concerned?

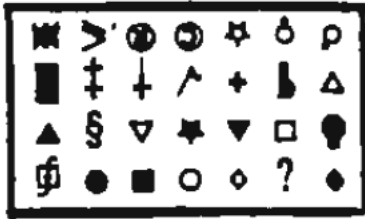


Baby Carriers (cl. 18)

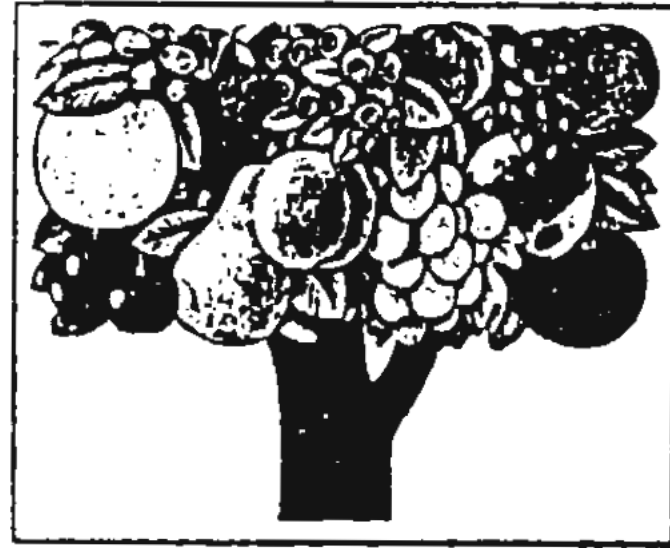


Books (cl. 16)

How would you judge the following devices?



Beverages



Beverages made from fruits: fruit juices

Absolute grounds for refusal

Article 4:

(b)-if it is contrary to public order or morality or good custom;

(c)-if it is 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;
(Deceptive trade marks)

(d)-if it is 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;

(Signs which consist of flags and other protected symbols)

Relative grounds for refusal

- The coexistence of two trade marks on the market can be an issue if:
 - an **identical** trade mark is already protected for identical goods and services
 - a **similar or identical** trade mark is already protected for identical or similar goods and services **and** there is a **likelihood of confusion** between the two signs
- Risk of confusion about the origin of the goods and services

Assessing the likelihood of confusion

- Similarity between signs
- Similarity between goods and services
- Overall assessment

In the assessment of a likelihood of confusion, both **direct confusion** and **confusion by association** must be covered, namely the cases where:

- A consumer would directly confuse the marks as used in trade (which could entail an erroneous purchasing decision), or
- A consumer would not confuse the marks but would assume that there is **some connection or association** between the commercial origin of the goods or services for which those marks are used, because they originate from the same undertaking or from two undertakings that **are economically linked**.

Article 4:

(e)-if it is 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**;

(f)-if it is 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

(g)-if it is identical with a mark belonging to a different proprietor (foreign) 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.



Subject mark
For tropical dried fruits (class 29)

SWEET VALLEY

Cited (earlier) mark
For tinned fruit and vegetables
(class 29); fresh fruit and
vegetables (class 31)





[Example provided by the Indonesia IP authorities]



[Example provided by the IP authorities of Thailand]

In Singapore, the case of *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941, considered the following marks:¹⁵

The Composite Mark	The Sign
	

ASEAN Secretariat, *Common Guidelines for the Substantive Examination of Trademarks*, 2nd Edition (Jakarta: The ASEAN Secretariat, 2020), 198.



[Example provided by the IP authorities of Indonesia]



[Example provided by the IP authorities of Thailand]



[Examples provided by the Philippines IP authorities]

**RED
SAMURAI**



[Image from: <http://www.dreamstime.com/royalty-free-stock-photo-samurai-warrior-cute-image12292605>]



Subject Mark

Class 9 - Telephone wires, soldering iron, electrical plugs, socket plugs, cable connectors, coaxial cable, computer cable, electrical cords, adapter plugs, door bells, outlets, switches, utility box, junction box, extension cords, electronic accessories, video cables, audio cables.

SYNERGY

Cited Mark

Class 9 - Optical glasses, sunglasses, and parts and fittings therefor.

References

- ASEAN Secretariat. *Common Guidelines for the Substantive Examination of Trademarks*. 2nd Edition. Jakarta: The ASEAN Secretariat, 2020.
- EPO, and EUIPO. *Intellectual Property Teaching Kit: IP Advanced Part II: Trade Marks*. 2nd Edition. EPO Munich: EPO, 2018.
- Law concerning Marks, Trade Names, and Acts of Unfair Competition, 2002 (Cambodia).
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- Ministry of Commerce, and Asian Development Bank. *Examples and Explanations Series: Intellectual Property Rights*. Phnom Penh: Ministry of Commerce, n.d.
- WIPO. *Introduction to Trademark Law and Practice: The Basic Concepts*. 2nd Edition. Geneva: WIPO Publication, 1993.