

Course: Intellectual Property Law-Cambodia

Lecture 4: Trademarks and Geographical Indications (Part2)

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How to obtain a trade mark through registration

Article 8: After receiving the application, the registrar shall :

(a)-**Examine whether the application** complies with the requirements of Article 5 and the Regulations pertaining thereto.

(b)-**Examine and determine whether the mark is a mark** as defined in Article 2.(a) and is unregistrable under Article 4 with the exception of item (g) thereof.

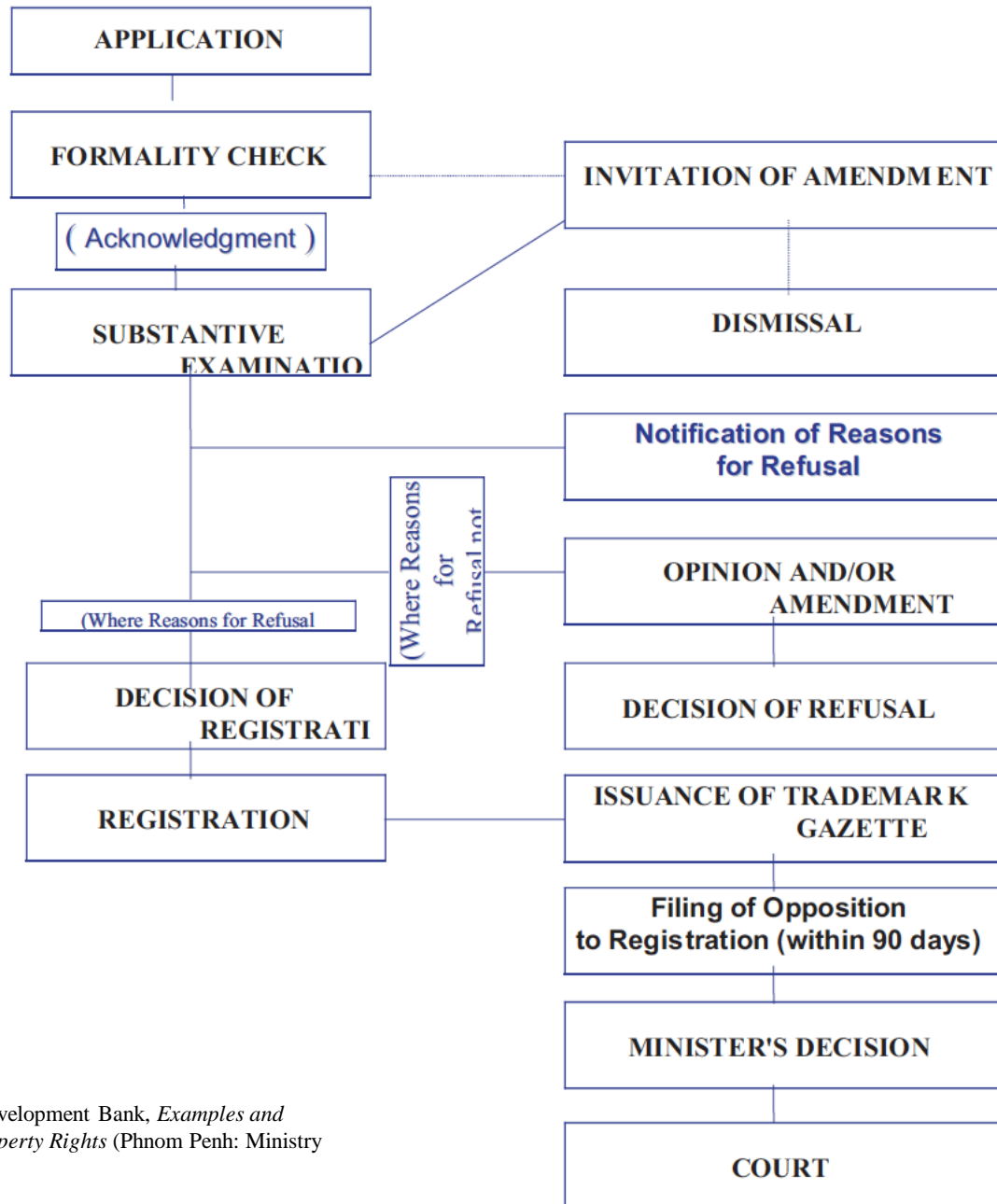
Reading and Lecture Note Assignment

How to obtain a trade mark through registration

Article 53: The Ministry of Commerce shall be entrusted with all functions relating to the procedure for the registration of marks and for the administration of registered marks as specified in this Law and the Regulations.

Article 55: The Ministry of Commerce shall publish in the Official Gazette all the Registrations, Renewals, Refusals, Removal of Marks from the Register and other works as indicated in the Sub-Decree

FLOW OF TRADEMARK APPLICATION PROCEDURES



Ministry of Commerce and Asian Development Bank, *Examples and Explanations Series: Intellectual Property Rights* (Phnom Penh: Ministry of Commerce, n.d.), 30.

The Madrid system for the international registration of marks

- International registration at International Bureau of WIPO
- **Basic trade mark** registration with office of origin
- Offices of designation examine application
 - Registration of national marks
- Simplification of subsequent management of trade mark

Reading and Lecture Note Assignment

Prakas (Declaration) on the Procedures for
International Registration of Marks under the
Madrid Protocol – 2016 (Khmer)

What happens after registration

Exclusive right to prevent use of:

- identical signs for identical goods and services
- identical/similar signs for identical/similar goods and services

Article 11:

(a)-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 the latter.**

What happens after registration

Article 11:

...

(b)-The registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, **have the rights to institute court proceedings** against any person who infringes the mark by using without his agreement, the mark as aforesaid or who performs acts which make it likely that infringement will occur. **The right shall extend to the use of a sign similar to the registered mark and use in relation to goods and services similar to those** for which the mark has been registered, where confusion may arise in the public.

(c)-The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in the Kingdom of Cambodia by the registered owner or with his consent.

Exhaustion of Rights or First Sale Doctrine (in relation to parallel import)

What happens after registration

- Duration of protection => Art. 12
 - initial period of **ten years**
 - unlimited renewal

Article 12:

(a)-The registration of a mark shall be for **a period of ten years** from the filing date of the application for registration.

(b)-The registration of a mark may, upon request, be **renewed for consecutive periods of ten years**, provided that the registered owner pays the prescribed renewal fee.

...

(d)-A period of **grace of six months** shall be allowed for the late renewal of the registration of a mark.

What happens after registration

- Cancellation => Art. 13 & 14
 - invalidity
 - revocation:
 - lack of genuine use
 - acquired generic character (maybe)
 - misuse

Article 13

(a)-Any interested person may request the Ministry of Commerce to **invalidate the registration of a mark**.

(b)-The Ministry of Commerce shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of Articles 2.(a) and 4 is not fulfilled;

(c)-Any invalidation of a registration of a mark shall be deemed to have been effective as of the date of registration, and shall be recorded and a reference thereto published as soon as possible.

What happens after registration

Article 14: The Ministry of Commerce has the right to order the cancellation to the registered mark where:

- (a)-The applicant does not apply for renewal of the registered mark within the period prescribed under Article 12.(b) and (d).
- (b)-The owner of the registered mark requests the removal.
- (c)-The owner of the registered mark has not complied, within 90 days, with the conditions or restrictions prescribed under Article 8.
- (d)-The owner of the registered mark ceases to have an address for service in the Kingdom of Cambodia.
- (e)-It is convinced upon evidence that the owner of the registered mark is not the legitimate owner.
- (f)-It is convinced that the registered mark is similar or identical to a well known mark owned by third party.

What happens after registration

- Requirement of genuine use; after five years of non-use => removal => Art. 15

Article 15: Any interested person may request the Ministry of Commerce to remove a mark from the Register, in respect of any of the goods or services in respect of which it is registered, 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, provided that a mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.

Principle of speciality: classification

- The scope of protection of a trade mark is limited to those goods and services applied for
- Similar trade marks can coexist peacefully in the market if they refer to different products
- Classification systems are used in order to easily identify the goods and services which a trade mark has been applied for



[Nice Classification:](https://webaccess.wipo.int/mgs/static/notes-en.html)

<https://webaccess.wipo.int/mgs/static/notes-en.html>



Infringing acts

Article 24: Subject to Article 12, an infringement of a registered mark shall consist of the performance of any act referred to in Article 11 in Cambodia by a person other than the owner of the mark and without the agreement of the latter.

- Infringing use includes:
 - offering or supplying
 - attaching the sign to goods
 - importing or exporting
 - use in advertising

Infringing acts

Article 24: Subject to Article 12, an infringement of a registered mark shall consist of the performance of any act referred to in Article 11 in Cambodia by a person other than the owner of the mark and without the agreement of the latter.

- Conditions:
 - the signs have to be identical or similar and used for identical or similar goods and services.
 - use as a trade mark
 - use in the course of trade
 - without consent

Trade marks with a reputation

- Broader scope of protection
 - beyond the limitations of the principle of speciality
 - without likelihood of confusion

- Requirements
 - identical or similar signs, but dissimilar goods and services
 - reputation in the relevant territory
 - likelihood of harm to the trade mark

Trade marks with a reputation

Article 25: An infringement of a registered well-known Mark in the Kingdom shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the sign is used :

(a)-in relation to goods and services identical with or similar to the goods and services for which the well-known mark has been registered, or

(b)-in relation to goods and services which are not identical with or similar to those in respect of which the well-known mark has been registered and the use of the sign in relation to these goods or services would indicate a connection between those goods and services and the owner of the well-known mark and that the interests of the owner of the well known mark are likely to be damaged by such use.

Article 26: An infringement of an unregistered well-known mark shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the sign is used in relation to goods or services identical with or similar to the goods or services for which the mark is well-known.

Article 27: On the request of **the owner of the mark** or of a **licensee** if he has requested the owner of the mark to institute court proceedings for specific relief and the owner of the mark has refused or failed to do so, **the court may grant an injunction** to prevent infringement, an imminent infringement, or an unlawful act referred to Articles 21, 22, 23, award **damages and grant any other remedy** provided for in the general law.

Article 28: On the request of any competent authority or any interested person, association or syndicate, in particular of producers, manufacturers or traders, the court may grant the same relief **in case of an act of unfair competition** referred to in Articles 22 and 23.

Allowed uses

- Mere private use
- In the course of trade:
 - use of own name
 - indication of characteristic or intended purpose
 - on condition that it is in accordance with honest practices
- Licences
- Exhaustion (Art. 11-c)

The registered proprietor of the trademark BUBBLES sells carbonated drinks in returnable and refillable bottles which bear the mark embossed on them.

He discovers that these bottles are being used by a competitor who is filling them with his own carbonated drinks and refuses to stop doing this, claiming that, because the mark was placed on the bottles by its owner, he is doing nothing unlawful. Is he right?

Do you regard the following trademarks applied to identical goods as confusingly similar?



For clothing, shoes

Provisional Measures

Article 29: On the request of the applicant, the Court shall order prompt and effective **provisional measures** to prevent an infringement, an imminent infringement or to preserve relevant evidence in regard to the alleged infringement.

Article 31: Where a provisional measure has been ordered, the defendant shall be given notice of the decision at the time of the execution of the measures.

[Reading and Lecture Note Assignment](#)

Chapter 9 and 10 of the Trademark Law

Border Measures

Article 35: The owner of any registered trademark may make application to the customs or the competent authorities or court to suspend clearance of goods suspected of being counterfeit by proving that he is the owner of the registered mark.

Article 43: The customs may, on its own initiative, suspend the clearance of goods in respect of which it has acquired prima facie evidence that importation of counterfeit trademark goods is taking place or is imminent.

[Reading and Lecture Note Assignment](#)

Chapter 9 and 10 of the Trademark Law

Chapter 5
Licensing of Marks

Article 19:

(a)-Any license contract concerning the registration of a mark, or an application therefor, shall provide **for effective control** by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used. If the license contract does not provide for **such quality control or if such quality control** is not effectively carried out, the license contract shall not be valid.

(b)-The registration of a collective mark, or an application therefor, may not be the subject of a license contract.

Prakas (Declaration) on the Procedure of Recordal of License and Franchise Agreement - 2020

Prakas (Declaration) to Record Imported Goods Bearing Exclusive Trademarks - 2016

Chapter 6
Trade Names

Article 2: (c) "**trade name**" means the name or/ and designation identifying and distinguishing an enterprise.

Article 20: A name or designation may not be used as a trade name if by its nature or the use to which it may be put, is **contrary to public order or morality** and if, in particular, it is liable to **deceive trade circles or the public** as to the nature of the enterprise identified by that name.

Chapter 6
Trade Names

Article 21:

(a)-Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b)-Any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

Chapter 7

Acts of Unfair Competition

Article 22: Any act of competition contrary to honest practices in industrial, commercial, service matters shall be considered as act of unfair competition.

Article 23: The following acts, in particular, shall be deemed to constitute acts of unfair competition :

(a)-all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial, commercial or service activities of a competitor;

(b)-false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial, commercial or service activities of a competitor.

(c)-indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods.

Chapter 11
Change in Ownership

Article 48: Any change in the ownership of the registration of a mark or collective mark, shall be in writing and shall, at the request of any interested party, to the Registrar, be recorded and, published by the Registrar. Such change shall have no effect against third parties until such recording is effected.

Article 49: Any change in the ownership of the registration of a collective mark, shall require previous approval of the Minister of Commerce.

Article 50: Any change in the ownership of a trade name must be made with the transfer of the enterprise or part thereof identified by that name and shall be in writing.

Article 51: Any change in ownership of the registration of a mark or a collective mark shall, however, be **invalid** if it is likely to **deceive or cause confusion**, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the mark or collective mark is intended to be used or is being used.

Article 52: Any **license contract** concerning a registered mark, or an application therefore, shall be submitted to the Registrar who shall keep **its contents confidential** but shall record it and publish a reference thereto. The license contract shall **have no effect against third parties** until such recording is effected.

Article 6: **Right of priority** in the mark registration shall be granted based on the following conditions :

(a)-The applicant may require the filing priority by attaching to the application a declaration claiming the priority of an earlier national or regional application filed by the applicant or his predecessor in title in any country member of the Paris Convention.

(b)-The effect of the said declaration shall be as provided in the Paris Convention.

Article 62: **Any decision** taken by the Ministry of Commerce may be the **subject of an appeal** by any interested party before the Courts and such appeal shall be filed within three months of the date of the decision.

Article 64: Whoever counterfeits a trademark, service mark, collective mark or trade name registered under Article 11.(b), in the Kingdom of Cambodia by another enterprise shall be liable to a fine of from one to twenty million riels, or to imprisonment from one to five years, or both.

Article 68: In the event an offender liable under this Law is a juristic person, the managing director, manager or representative of such juristic person shall also be liable to the penalty prescribed for such offence unless he can prove that he had neither knowledge or nor consented to the commission of the offence by the juristic person.

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

Chapter 4
Collective Marks

Article 16: Subject to Articles 17 and 18, Articles 3 to 15 shall apply to **collective marks.**

Article 17:

(a)-An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulations governing the use of the collective mark.

(b)-The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in paragraph (a).

Chapter 4
Collective Marks

Article 18:

In addition to the grounds provided in Article 13.(a) and (b), the Registrar shall invalidate the registration of a collective mark if the person requesting the invalidation proves that **only the registered owner uses the mark**, or that he uses or permits its use in contravention of the regulations referred to in Article 17.(a) or that he uses or permits its use **in a manner liable to deceive trade circles** or the public as to the origin or any other common characteristics of the goods or services concerned.

Law on Geographical Indications

41 Articles split into 17 Chapters

- Chapter 1: General Provisions
- Chapter 2: Competent Authority
- Chapter 3: Procedure for GI Registration
- Chapter 4: Appeal
- Chapter 5: Registration of Foreign GI
- Chapter 6: Effect of Registration
- Chapter 7: Compliance Control of Book of Specifications in GI Registration
- Chapter 8: Amendment, Invalidation, and Cancellation of GI Registration
- Chapter 9: GI and Recognition or Rejection of Mark
- Chapter 10: Provisional Measures and Border Measures
- Chapter 11: Agent
- Chapter 12: Regulations and Administrative Instructions
- Chapter 13: Application of International Treaties and Interpretation
- Chapter 14: Detention and Confiscation
- Chapter 15: Penalties
- Chapter 16: Provisional Provision
- Chapter 17: Final Provision

Article 1: Purpose

The purpose of the his law is to protect consumers and the intellectual property rights of producers and operators, in addition to preserving and strengthening the traditional know-how, national identity and to reduce poverty.

Article 3: Scope

Pursuant to the provisions of this law, agricultural goods, foodstuffs, handicraft goods or any other goods produced in the geographical area or transformed shall be under the scope of geographical indication registration and protection in the Kingdom of Cambodia.

{ What is Geographical Indication (GI)? }

Article 4 of the Cambodian GI Law

“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”

“A geographical indication is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin”

Article 24: Duration of Protection

The registration of geographical indication shall be valid from the date of the filing of the application provided that its registration is not cancelled or invalidated according to this Law.

Article 36: Application

The provisions of any international treaties in respect of the geographical indications, to which the Kingdom of Cambodia is a party, shall apply to matters dealt with by this Law.

In case of conflict with provisions of this Law, the provisions of any international treaties shall be considered as principal provisions.

Article 10: Geographical Indication Unable to be Registered

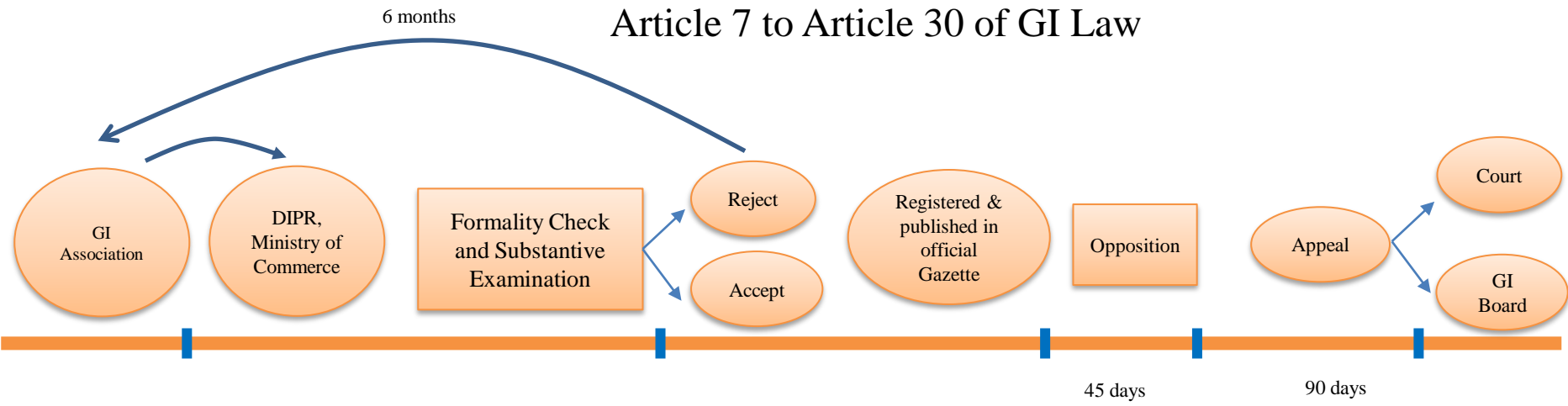
A geographical indication cannot be validly registered:

- a. If it is contrary to laws and regulations, morality, religion, good custom or public order;
- b. If it is likely to mislead or confuse the public with respect to **the characteristics, the nature, the quality, the place of origin, the production process** of the goods and/or its use;
- c. If it is used as **a name of a plant variety or animal breed**;
- d. If it is a generic term;

{ Five Pillars of a GI }

1. A "**GI ORGANIZATION**", generally an inter-professional organization which bring together all kind of operators.
2. A **BOOK of SPECIFICATIONS** describes the good and the production methods. The GI name shall be used only for goods produced in compliance with these specifications.
3. A **CONTROL and TRACEABILITY** system guarantee that all the goods sold with the GI name have been produced within the delimited area and according to the Book of Specifications.
4. A **DELIMITATION** of the GI production area.
5. A **PROVEN LINK** between the specificity of the good and its origin, based on natural, geographical, historical or human factors.

{ GI Registration and Appeal Process in Cambodia }



Article 23: Protection of Cambodian and Foreign Geographical Indication

The Cambodian and foreign geographical indications registered in the Kingdom of Cambodia shall be protected against any:

- a. Direct or indirect commercial misuse of a registered geographical indication in respect of **identical or comparable goods** to those of the registered geographical indication where **the misuse benefited or would benefit from the reputation of the geographical indication**;
- b. unauthorized use, imitation, evocation or translation of the geographical indication even if the true origin of the goods is accompanied by the expression such as **"style", "type", "method", "manner", "imitation"**, or translations of such expressions, or of similar expressions likely to **mislead the public**;
- c. false or misleading indication as to origin, nature, or specific quality of the goods **appearing on packaging, or in advertising materials** or on other documents concerning the goods that are likely to mislead its origin;
- d. other practices likely to mislead the public as to the true origin of the goods.

Article 31: Geographical Indication and Mark

The Ministry of Commerce shall refuse any application for registration of a mark which is identical with or confusingly similar to a geographical indication which applied before the filing date of application for mark registration as defined in the Article 23 of this law;

...

The **use of a mark corresponding** to one of the situations defined in Article 23, and which **has been registered, in good faith**, before either the date of protection of the geographical indication or the filing date of the application for geographical indication registration in the Kingdom of Cambodia, the mark **may continue to be used if there are no grounds for invalidation.**

Article 14: National Logo for Certifying Geographical Indication Goods



- In 2010, **Kampot Pepper** and **Kampong Speu palm sugar** were the first two protected GIs
- In 2016, **Kampot pepper** received GI protection in **Europe**
- In 2019, **Kampong Speu palm sugar** got protection in **Europe**
- The EU, the main market for Kampot pepper, accounts for **50%**
- The US, Japan, and South Korea account for another **20%**
- The domestic market accounts for **30%**



- Black pepper is priced at **\$15,000** per ton
- Red pepper is priced at **\$25,000** per ton
- White pepper is priced at **\$28,000** per ton

Vireak, Thou. "Kampot Pepper Suffering as Supply Exceeds Demand." Accessed September 30, 2023. <https://phnompenhpost.com/business/kampot-pepper-suffering-supply-exceeds-demand>.

Chea, Vannak. "80-Tonne Export Goal for Pepper - Khmer Times," August 20, 2017. <https://www.khmertimeskh.com/78935/80-tonne-export-goal-pepper/>.

KAMPOT & epper



Article 38: Offences of Counterfeiting Geographical Indication

Offenders shall be liable to imprisonment from one to five years and to a fine of two million to twenty million Riels for the following offences:

- misuse of a registered geographical indication for direct or indirect commercial purposes in respect of identical or comparable goods to those of the registered geographical indication where that misuse benefits or could benefit from the reputation of the geographical indication;
- unauthorized use, imitation, or evocation or translation of the geographical indication even if the true origin of the goods is accompanied by the expression such as "style", "type", "method", "manner", "imitation", or translations of such expressions, or of similar expressions likely to mislead the public;
- false or misleading indication as to the origin, nature, or specific quality of the goods appearing on packaging, or in advertising materials or on other documents concerning the goods that are likely to mislead as to its origin;
- other acts likely to mislead the public as to the true origin of the goods.

References

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