

Course: Intellectual Property Law-Cambodia

Lecture 6: Patents, Utility Models, and Industrial Designs (Part 2)

Lecturer: PHAN Daro

darophan@puc.edu.kh



Rights Conferred by Patent

- Right to prevent others from making, using, offering for sale, selling or importing infringing products in the country where the patent was granted

Exception: non-commercial purposes (private use, academic research)

- Right to assign, sell or license these rights
- These rights belong to the patent holder

Article 41.-

The exploitation of the patented invention in the Kingdom of Cambodia by persons other than the owner of the patent shall require the latter's agreement.

What is infringement?

Article 42.-

For the purposes of this Law “exploitation” of a patented invention means any of the following acts:

1. when the patent has been granted in respect of **a product**:

(a) making, importing, offering for sale, selling and using the product;

(b) stocking such product for the purposes of offering for sale, selling or using;

2. when the patent has been granted in respect of **a process**:

(a) using the process;

(b) doing any of the acts referred to in items (a) and (b) of the subparagraph (1) of this Article in respect of a product obtained directly by means of the process.

What is infringement?

Article 43.-

The owner of the patent shall have the right, subject to Article 44 and Articles 47 to 55 of this Law, to institute court proceedings against any person who infringes the patent by performing, without his agreement, any of the acts referred to in Article 42 of this Law or who performs acts which make it likely that infringement will occur.

- Making use of a patented product or process without the consent of the patent owner
- Making, offering, putting on the market, importing or stocking the product
- Making, offering, putting on the market, importing or stocking a product directly obtained from a protected process
- Using a process or offering the process for use

What is infringement?

- Infringement is determined by the **national courts**
- What constitutes infringement in one country may differ from other countries
- Patent proprietors can **claim damages and other remedies from alleged infringers**

Article 44.-

The rights under the patent shall not extend:

International exhaustion

a. to acts in respect of articles which have been put on the market by the owner of the patent or with his consent;

in the Kingdom of Cambodia or outside the Kingdom of Cambodia

b. to the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally *enter the airspace, territory or waters of the Kingdom of Cambodia*;

c. to acts done only *for experimental purposes* relating to a patented invention;

d. to acts performed by any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted and in the Kingdom of Cambodia, was using the invention or was making effective and serious preparations for such use.

The right of prior user referred to in item (d) of the 1st paragraph of this Article may be transferred *only together with the enterprise or business, or with that part of the enterprise or business*, in which the use or preparations for use have been made.

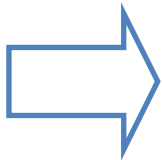
How is infringement determined? (I)

Claims

- Define the features of the invention = matter for which protection is sought
- Description and drawings are used to interpret the claims

Extent of protection

- Everything that is literally covered by the claims
- May also encompass equivalents



Infringement occurs when the infringing product possesses all the features of the claimed invention

How is infringement determined? (I)

Example:

Are PAPER-FIX infringing HAIRY-CUT's patent?



PAPER-FIX produce scissors with eye rings covered by plastic in Italy and sell them in the UK



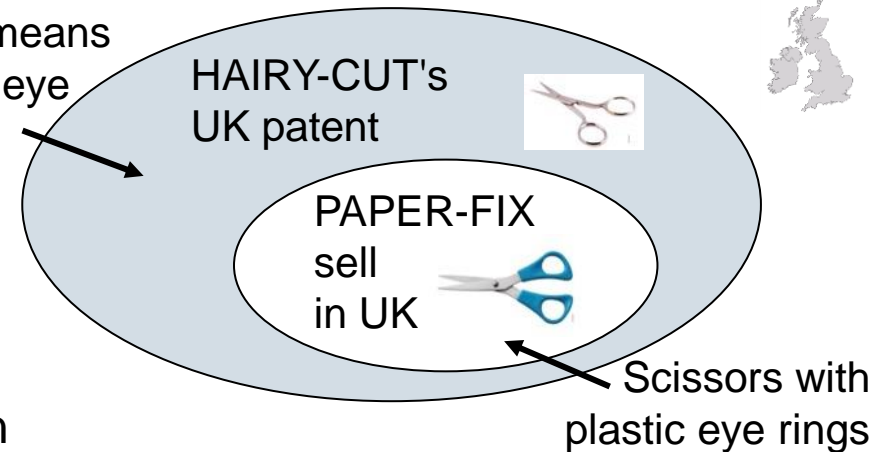
HAIRY-CUT have a UK patent claiming cutting means with two eye rings



How is infringement determined? (II)

Are PAPER-FIX infringing HAIRY-CUT's patent?

Cutting means
with two eye
rings



1. Generally speaking, production and sale are acts of infringement.

2. UK: Yes. The scissors are within the extent of protection.

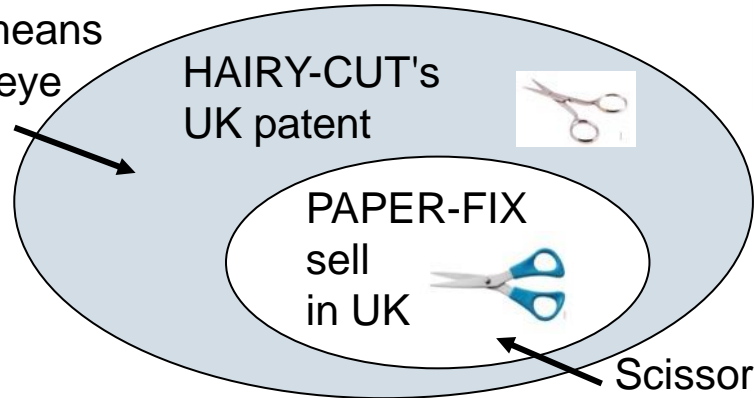
3. Italy: No. HAIRY-CUT do not have a patent in Italy. PAPER-FIX and others can freely produce insulated scissors (provided no one else has a patent there → perform patent search!)

How is infringement determined? (II)

What about the garden shears imported into the UK by SHEAR-MAN?



Cutting means with two eye rings



Scissors with plastic eye rings

UK: No. The shears do not have eye rings. They are outside the extent of protection.

Article 47.-

The Minister may decide that, even without the agreement of the owner of the patent, a Government agency or a third person designated by the Minister may exploit the invention where:

1. the **public interest**, in particular, **national security, nutrition, health** or the development of other vital sectors of the national economy so requires; or
2. a competent judicial body has determined that **the manner of exploitation**, by the owner of the patent or his licensee, **is anti-competitive**.

The exploitation of the invention shall **be limited to the purpose for which it was authorized** and shall be **subject to the payment to the said owner of an adequate remuneration** therefor, taking into account the economic value of the Minister's authorization, as determined in the said authorization.

The Minister shall take his decision after hearing the owner of the patent and any interested person.

Article 50.-

Where a third person has been designated by the Minister, the authorization may only be transferred with the enterprise or business of that person or with the part of the enterprise or business within which the patented invention is being exploited.

Article 51.-

The authorization shall not exclude:

1. the conclusion of license contracts by the owner of the patent or the continued exercise, by the owner of the patent, of his rights under Article 42 of this Law;
2. the issuance of a non-voluntary license under Section 12 of Chapter 2 of this Law.

Article 53.-

The exploitation of the invention by the Government agency or third person designated by the Minister shall be predominantly for the supply of the market in the Kingdom of Cambodia.

Article 55.-

The decisions of the Minister under Section 11 of Chapter 2 of this Law may be the subject of an appeal before the competent Court.

Non-Voluntary Licenses

Article 56.-

On the request, made to the Minister after the expiration of a period of four (4) years from the date of filing of the patent application or three (3) years from the date of the grant of the patent, whichever period expires last, the Minister may issue a non-voluntary license if he is satisfied that the patented invention is not exploited or is insufficiently exploited in the Kingdom of Cambodia.

Notwithstanding the 1st paragraph of this Article, a non-voluntary license shall not be issued if the owner of the patent satisfies the Minister that circumstances exist which justify the non-exploitation or insufficient exploitation of the patented invention.

Article 57.-

The decision issuing the non-voluntary license shall fix:

- (i) the scope and the function of the license;
- (ii) the time limit within which the licensee must begin to exploit the patented invention; and
- (iii) the amount of the adequate remuneration to be paid to the owner of the patent and the conditions of payment

Article 58.-

The beneficiary of the non-voluntary license shall have the right to exploit the patented invention in the Kingdom of Cambodia according to **the terms set out in the decision** issuing the license, shall commence the exploitation of the patented invention **within the time limit fixed** in the said decision and, thereafter, shall exploit the patented invention **sufficiently**.

Article 59.-

Where the invention claimed in the later patent involves **an important technical advance of considerable economic importance** in relation to the invention claimed in the earlier patent, the Minister, upon the request of the owner of the later patent, may issue a nonvoluntary license **to the extent necessary to avoid infringement of the earlier patent.**

Article 60.-

Where a non-voluntary license is issued under Article 59 of this Law, the Minister, upon the request of the owner of the earlier patent, shall **issue a non-voluntary license** in respect of the later patent.

Invalidation មេឃុនតាព

Article 65.-

Any interested person may request the competent Court to invalidate a patent.

Article 66.-

The competent Court shall invalidate the patent if the person requesting the invalidation proves that any of the requirements of the 2nd and 3rd paragraph of Article 3, Articles 4 to 9 and Articles 18 to 20 of this Law is not fulfilled or if the owner of the patent is not the inventor or his successor in title.

Invalidation មេឃុតាត

Article 67.-

Any invalidated patent, or claim or part of a claim, shall be regarded as null and void from the date of the grant of the patent.

Article 68.-

The final decision of the competent Court shall be notified to the Registrar who shall record it and publish a reference thereto as soon as possible.

Advantages and disadvantages of getting a patent

Advantages

- Exclusivity enables investment and higher returns on investment
- Strong, enforceable legal right
- Makes invention tradable (licence, sale)

Disadvantages

- Reveals invention to competitors (after 18 months)
- **Can be expensive**
- Grant may take 3-5 years
- Patent enforceable only after grant; proceedings can be costly

Alternatives to patenting

Disclose (publish) the information

- Cheap
- Prevents others from patenting the same invention

- Does not offer exclusivity
- Reveals the invention to competitors

Keep it a secret

- Cheap (but there is the cost of maintaining secrecy)
- Does not reveal the invention

- No protection against reverse-engineering/duplication of invention
- Difficult to enforce
- Secrets often leak quite fast

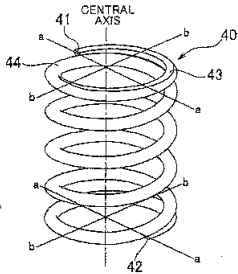
Do nothing

- No effort required

- Does not offer exclusivity
- Competitors will often learn details

... but a basic knowledge of patent jargon is needed!

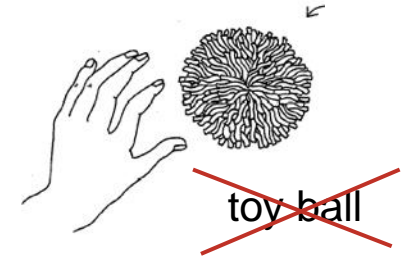
~~spring~~



"energy-storing means"

Patent jargon is used to broaden scope of the patent.

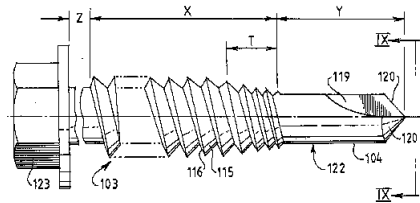
Beware of "naïve" keyword searches!



"spherical object with floppy filaments"

Sometimes the applicant simply doesn't want his application to be found.

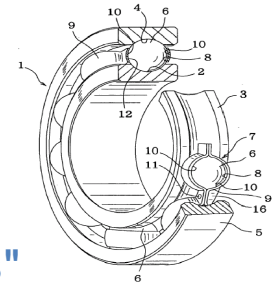
~~nail, screw, rivet~~



"fastening means"

~~ball bearing~~

"plurality of balls"



វិញ្ញាបនបត្រម៉ូដែលមានអត្ថប្រយោជន៍

Utility Models

Article 69.-

For the purposes of this Law, a **utility model certificate** means a certificate which is granted for the protection of a utility model. **Utility model** means **any invention which is new and industrially applicable and may be, or may relate to, a product or process.**

Article 70.-

With the exclusion of Articles 71 to 74 of this Law, the provisions of Chapter 2 of this Law shall apply, *mutatis mutandis*, to utility model certificates or applications therefor, as the case may be.

Where the right to a patent conflicts with the right to a utility model certificate in the case referred to in Section 2 of Chapter 2 of this Law, the said provision shall apply as if the word “patent” were replaced by the words “**patent or utility model certificate**”.

Scope of protection of utility models compared with patents

Utility models

- Registered territorial IP right
- Available in limited number of countries
- Protection for up to 7 (Cambodia) or 10 years (others)
- Search report in some countries only
- Registered and published after a few months
- Generally no substantive examination (novelty, inventiveness, industrial applicability)
- Reviewed only in invalidation or infringement proceedings

Patents

- Registered territorial IP right
- Available in most countries
- Protection for up to 20 years
- Search reports standard
- Application published after 18 months
- Substantive examination (novelty, inventive step, industrial applicability)
- Grant or refusal after substantive examination procedure

Different names for utility models and patents

- Austria and Germany
 - Gebrauchsmuster
- Australia
 - innovation patent
- China
 - invention patent
(~ regular patent)
 - utility model patent
- Indonesia
 - simple patent
- Ireland
 - short-term patent
- Japan
 - utility model
- USA
 - utility patent
(~ regular patent)
 - no utility models available
- Malaysia
 - utility innovation

Scope of protection and exclusions

Article 4.- based on Article 70

The following inventions, shall be **excluded** from patent protection:

1. discoveries, scientific theories and mathematical methods;
2. schemes, rules or methods for doing business, performing purely mental acts or playing games;
3. methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body. **This provision shall not apply to products for use in any of those methods;**
4. pharmaceutical products as provided in Article 136 of this Law;
5. plants and animals other than **micro-organisms**, and essentially biological processes for the production of plants or animals;
6. Plants varieties.

Scope of protection and exclusions

- Utility models offer protection for technical inventions, including:
 - apparatus and devices
 - chemical substances
 - medicinal products

- The following **do not qualify** for utility model protection:
 - discoveries, scientific theories, mathematical methods
 - blueprints, patterns, teaching methods, rules for playing games, accounting systems, programs for computers
 - process inventions (e.g. manufacturing and working processes)
 - biotechnological inventions
 - animal and plant varieties

Scope of protection and exclusions

Article 9.-

The inventions, the commercial exploitation in the Kingdom of Cambodia of which would be contrary to **public order** or **morality**, or would not be protected **human, animal or plant life or health**, or would cause serious prejudice to the environment, or prohibited by law, are excluded from patentability

- Utility models cannot be granted for inventions the publication or exploitation of which would be contrary to public policy or morality.

Article 71.-

Articles 5 and 7 of this Law shall not apply in the case of inventions for which **utility model certificates** are requested.

Substantive requirements

Novelty

Inventiveness

Industrial applicability

Article 73.-

A utility model certificate shall expire, without any possibility of renewal, at the end of the **seventh (7th) year** after the date of the filing of the application.

Important requirements for utility model applications

Article 72.-

Articles 36 and 45 of this Law shall not apply in the case of applications for utility model certificates.

~~■ Further requirements~~

~~— Sufficiency of disclosure~~

~~— Claims must be clear and concise~~

~~— Amendments of application only within limitations~~

~~—~~

~~■ The substantive requirements are normally not examined when the utility model is registered and published.~~

Refusal

Article 74.

In proceedings under the Articles 65 to 67 of this Law, the competent Court shall invalidate the **utility model certificate** on any the following grounds:

- (i) That the claimed invention did not qualify for a utility model certificate, having regard to Article 6, 8, 9, and 69 of this Law;
- (ii) That the description and the claim do not comply with requirements prescribed by Article 18 and 19 of this Law and the Registrations pertaining thereto;
- (iii) That any drawing which is necessary for the understanding of the invention has not been furnished;
- (iv) That the owner of the utility model certificate is not the inventor or his successor in title.

Conversion of Patent Applications or Applications for Utility Model Certificates

Article 75.-

At any time before the grant or refusal of a patent, an applicant for a patent may, upon payment of the prescribed fee, as referred to in Article 130 of this Law, convert his **application into an application for a utility model certificate**, which shall be accorded the filing date of the initial application.

At any time before the grant or refusal of utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee, as referred to in Article 130 of this Law, **convert his application into a patent application**, which shall be accorded the filing date of the initial application.

Article 76.-

An application may not be converted under Article 75 of this Law more than once.

Utility models: for and against

- + Utility model applications can be filed as a strategic IP right
- + Procedural fees may be lower than for national patent applications
- +/- Utility models are registered, but are normally not examined
- Utility models offer less legal certainty than patents
- Utility model litigation proceedings may be costly

References

EPO, and EUIPO. *Intellectual Property Teaching Kit: IP Advanced Part I: Patents, Utility Models and Designs*. EPO Munich: EPO, 2014.

Law on Patents, Utility Model Certificates and Industrial Designs, 2003. (Cambodia).