

Course: Intellectual Property Law-Cambodia

Lecture 7: Patents, Utility Models, and Industrial Designs (Part 3)

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គំនូរឧស្សាហកម្ម

DESIGNS

Promulgated by the head of state on January 22, 2003

Entry into force through out the country on February 12, 2003

136 Articles split into 9 Chapters

Chapter 1: General Provisions

Chapter 2: Patents (Articles 3-68)

Chapter 3: Utility Model Certificates (Articles 69-76)

Chapter 4: International Applications under the Patent Cooperation Treaty

Chapter 5: Industrial Designs (Articles 89-113)

Chapter 6: Common Provisions (Articles 114-131)

Chapter 7: Offenses

Chapter 8: Transitional Provision

Chapter 9: Final Provision

Article 2.-

The objective of the Law is:

1. to encourage innovation, scientific and technological research and development;
2. to stimulate and promote increased internal and external commerce and investment;
3. to promote the transfer of technology to the Kingdom of Cambodia in order to facilitate industrial activity and the development of the economy; and
4. to provide protection for industrial property rights and to combat the infringement thereof, as well as illegal business practices.

Core concepts

- **Definition**
 - What designs are and what they protect
- **Protection**
 - How to obtain design rights
 - Requirements for protection
- **Enforcement**
 - Scope of protection
 - Design infringement/allowed uses

Example of a design



What is a design?

Article 89.-

For the purposes of this Law, any composition of lines or colours or any three dimensional form, or any material, whether or not associated with lines or colors, is 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.

មាត្រា ៨៩.-

គំនូរឧស្សាហកម្ម ក្នុងន័យនៃច្បាប់នេះ គឺជាការផ្គុំនៃបន្ទាត់ ឬពណ៌ ឬទម្រង់ បីខ្នាត ឬសម្ភារៈណាមួយ ទោះបីជាមានឬពុំមានការផ្គុំជាមួយបន្ទាត់ ឬពណ៌ក៏ដោយ ឱ្យតែការផ្គុំទម្រង់ ឬសម្ភារៈទាំងនោះរំលេចឡើងជារូបរាងពិសេសរបស់ផលិតផល ឧស្សាហកម្ម ឬសិប្បកម្មនិងដែលអាចធ្វើជាគំរូផលិតផលឧស្សាហកម្ម ឬសិប្បកម្ម និងអាចសម្គាល់បានដោយចក្ខុ ។

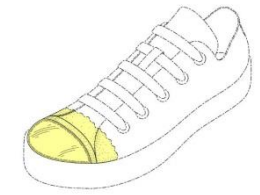
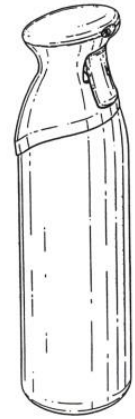
What is a design?

- The outward appearance of the whole or parts of a product
- Resulting from the features of the product, such as:
 - lines
 - colours
 - shapes
 - textures
 - contours
 - materials
 - ornamentation

What is a product?

- Any industrial or handicraft item, including:
 - packaging
 - normal single products
 - parts of products
 - graphic symbols (and logos)
 - get-ups (interiors of rooms or shops)
- Complex products

More examples of designs



What cannot be classed as a design?

- Functions of the product
- Any item that does not comply with the definition of a design
 - lack of outward or visible appearance
 - not an industrial or handicraft item
- Computer programs

Article 90.-

The protection under this Law does not extend to anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.

For example, the following surface patterns could not be claimed as industrial designs for tyres if their shape and appearance were determined *solely* by function:



Why designs should be protected

- Designs enhance the attractiveness and value of products
 - but this is not a legal requirement for protection
- Without protection, others can benefit from the company/designer's investment
- Differences over other IP rights:
 - trade marks
 - patents

How to obtain design rights

- Two possibilities:
 - with registration: registered design rights (Cambodia)
 - without registration: unregistered design rights

Article 95.-

The application for registration of an industrial design shall be filed with the Ministry in charge of industry and shall contain a **request, drawings, photographs** or other **adequate graphic representations of the article** embodying **the industrial design** and an **indication of the kind of products** for which the industrial design is to be used. It may be accompanied by a specimen of the article embodying the industrial design, where the industrial design is two-dimensional. The application shall be subject to the payment of the prescribed application fee, as referred to in Article 130 of this Law.

Article 96.-

Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design.

Article 97.-

Two or more industrial designs may be the subject of the same application, provided they relate to the same class of the **International Classification** or to the same set or composition of articles.

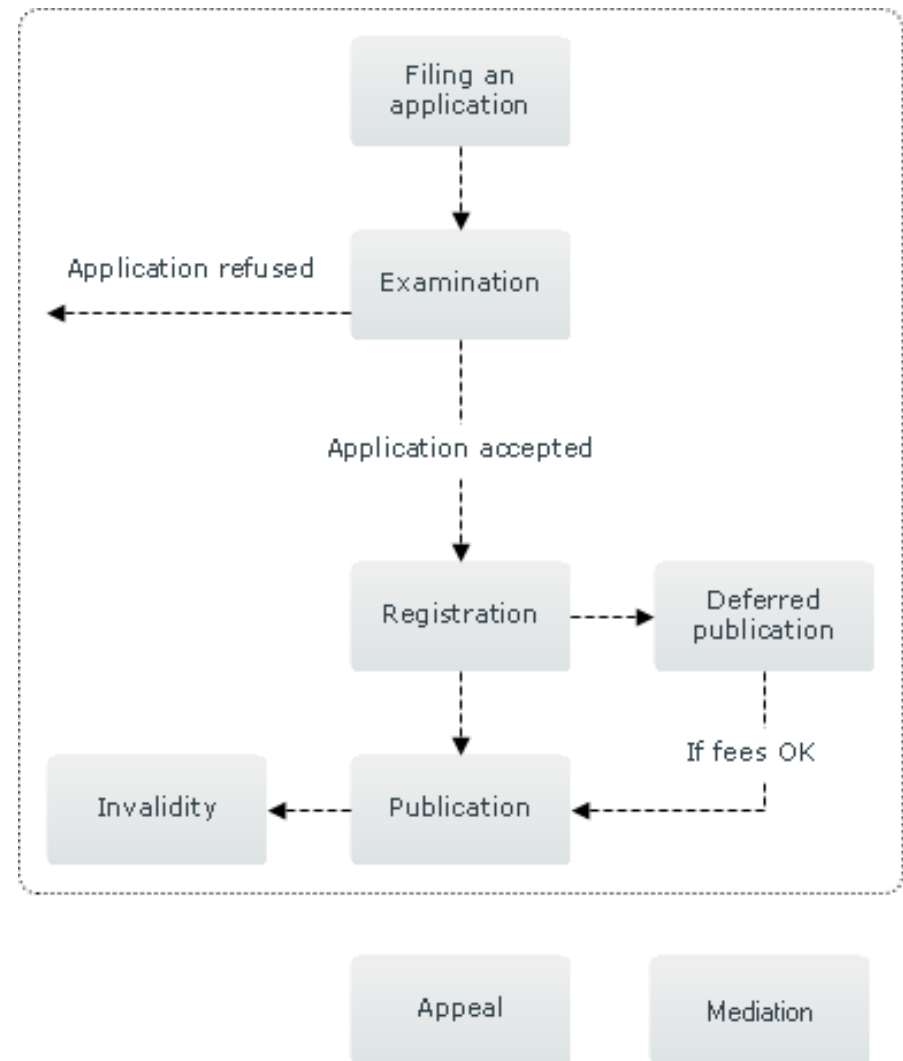
Article 98.-

The application, at the time of filing, may contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding twelve (12) months from the date of filing or, if priority is claimed, from the date of priority, of the application.

<https://www.wipo.int/classifications/locarno/locpub/en/fr/>

The registration procedure for Design

- Articles 101-104
- Examination of:
 - formalities
 - grounds for refusal
 - not a design
 - against public policy or morality



Requirements for protection

- Protection only if the following requirements are fulfilled:
 - novelty

Article 90.-

The protection under this Law **does not extend to** anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.

Article 91.-

An industrial design is registrable if it is **new**.

Article 92.-

An industrial design shall be considered as **new** if it **has not been disclosed to the public**, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

For the purpose of the 1st paragraph of this Article, disclosure to the public of the industrial design shall not be taken into consideration:

- (i) If it occurred within twelve (12) months preceding the filing date or, where applicable, the priority date of the application;
- (ii) If it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

Article 93.-

Industrial designs that are contrary to public order or morality shall not be registrable.

Novelty (I)

- No identical design has been made available to the public
 - includes designs that differ in immaterial details only
- No disclosure of own design
 - however, 12-month grace period
- Relevant date to assess novelty
 - registered designs: date of filing

Novelty (II)

- Considered to have been made available to the public after:
 - exhibition
 - use in trade
 - publication
 - disclosure in any other way
- Not considered disclosed if:
 - not known in specialised circles
 - disclosed only under condition of confidentiality

Article 89.-

For the purposes of this Law, any composition of lines or colours or any three dimensional form, or any material, whether or not associated with lines or colors, is 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.

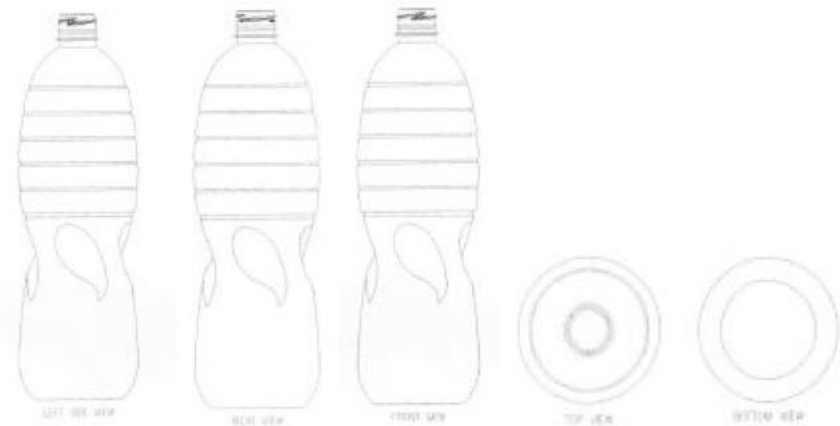
Filed design: Application No: 3-2006-01570
 Filing Date: 25 December 2006

"Fish sauce bottle" – LCL: 09-01



The filed design was rejected due to lack of novelty. The filed design was anticipated by the cited design. The differences in the cap, the bottom, the shoulder and the leaf-shaped pattern on the body were deemed to be insignificant.

Cited design: Registration No.: HK 0211665.5M004
 IP Office: Hong Kong
 Publication date: 8 November 2002
 "Plastic bottle" LCL: 09-01

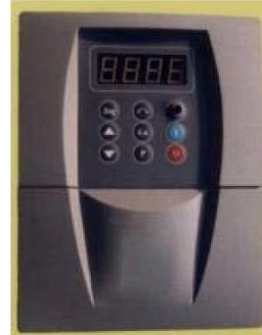


Filed design: Application No.: 3-2006-00347 – “Lighting Controller”

Filing Date: 27 March 2006 LCL: 13-03

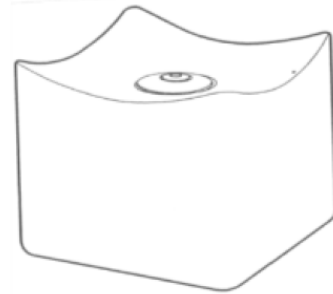
Cited design: Application No.: 3-2004-00180 – Patent No.: 8695

“Inverter” – LCL: 13-02

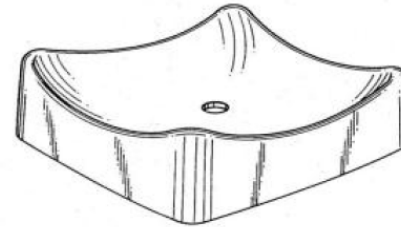


The filed design was rejected for lack of novelty. The filed design is not identical with the cited design (the cited design has buttons and LCD screen which do not appear on the filed design) but **its main features are totally disclosed** in the cited design.

Application for a patent for the design of a “sink”, filed 2 December 2005.



Filed Design



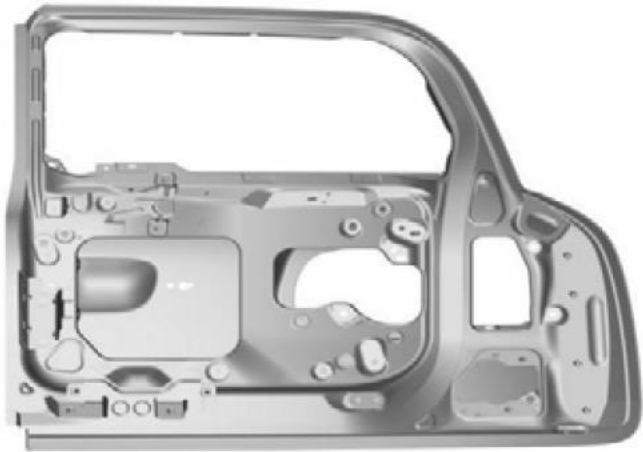
Cited Design

A search of existing designs found an earlier “sink” in the database of the United States Patent and Trademark Office.

The designs are both squares with significant content in design as the slope in the middle of the sink, while the top edges are curved upwards. The difference is in the dip of the filed design, which is shallower and is taller than the cited design.

The filed design has the same shape of top edges as the cited design, even though they are different in height. **The difference in height does not make the shape of the applying design different from the existing design and, therefore, is not considered new.**

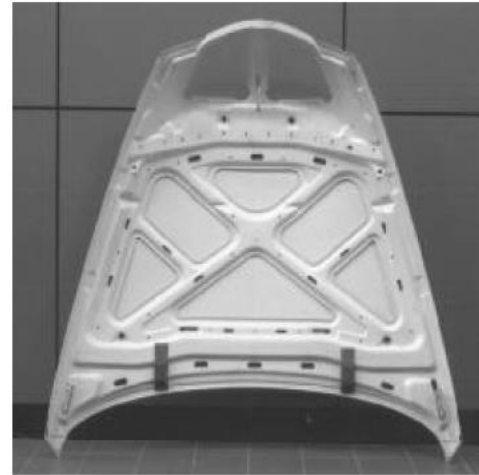
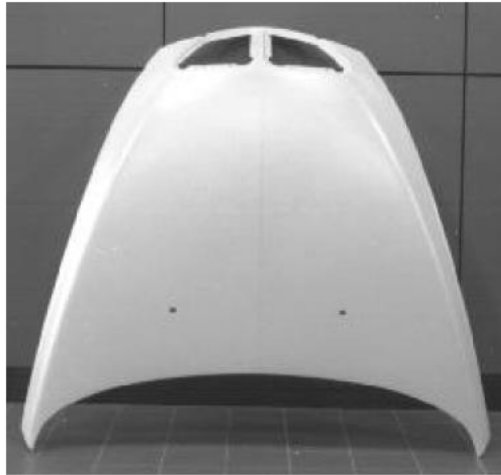
Visibility => Industrial designs must be perceptible by the sense of sight.



Interior of door for motor vehicles⁴⁴

Non-technical aspect => Industrial designs concern only the visible appearance of a product, and not the technical or functional features thereof.

The following examples illustrate designs of spare parts that could be acceptable for registration but could be subject to the 'must fit' or 'must match' limitation, where such limitation is applicable.⁵²



The following examples of running shoes illustrate designs that combine functional features required to provide grip, stability and ergonomic advantage with aesthetic features incorporated to make the product pleasing to the eye:



Embodiment in a utilitarian article. Industrial designs are conceived to be embodied in utilitarian articles, i.e., in products that have a useful, functional purpose.



Application Number: 3-2012-01727 Filing Date: 27/11/2012

Title: Stone panel – LCL: 25-01

The filed design was rejected due to the lack of industrial applicability. The design is created by joining pieces of natural stone in random shapes, sizes, patterns and colours. These pieces of stone are arranged randomly so that they make a roughly square panel. Hence, there are not two panels with the same shape and pattern, and therefore, the same aesthetic impression. Accordingly, the design cannot be applied in mass production of an article embodying it.

Exclusion from protection

- Contrary to public policy and morality
- Design exclusively dictated by its technical function
- Component parts of complex products not visible during normal use
- Designs of interconnection
 - "must-fit" exemption

What happens after registration (I)

- Lifespan of a registered design right:
 - five years
 - renewable
 - maximum 15 years

Article 109.-

The registration of an industrial design shall be for a **period of five (5) years** from the filing date of the application for registration. The registration may be renewed for **two further consecutive periods of five (5) years** through the payment of the prescribed fee, as referred to in Article 130 of this Law. A period of grace of six (6) months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge, as referred to in Article 130 of this Law.

What happens after registration (II)

- Invalidity claims can arise because:
 - the design fails to meet the definition of a design
 - the requirements for protection are not fulfilled
 - the design is excluded from protection
 - the holder is not entitled to the design
 - the design is in conflict with a prior right

Article 110.-

Any interested person may request the competent Court to invalidate the registration of an industrial design.

Article 111.-

The competent Court shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of Section 1 and Section 2 of this Chapter is not fulfilled or if the registered owner of the industrial design is not the creator or his successor in title.

What rights does the designer have?

Article 105.-

The exploitation of a registered industrial design in the Kingdom of Cambodia by persons other than the registered owner shall require the agreement of the latter.

Article 106.-

For the purposes of this Law, “exploitation” of a registered industrial design means the **making, selling or importation** of articles incorporating the industrial design.

Article 107.-

The rights under the registration of industrial design **shall not extended to acts in respect of articles which have been put on the market in the Kingdom of Cambodia or outside the Kingdom of Cambodia** by the owner of the industrial design or with his consent.

Article 108.-

The registered owner of an industrial design shall have the right to **institute Court proceedings against any person who infringes the industrial design by performing, without his agreement,** any of the acts referred to in Article 106 of this Law or who performs acts which make it likely that infringement will occur.

What rights does the designer have?

- Full protection for registered design rights
- Exclusive right: protects the design from unauthorised use
 - protection covers the design itself
 - not the product
- Prevents others from using the design

Infringement and allowed uses

- An infringement is any act of use of the design by a third party without the authorisation of the designer
- Allowed uses
 - private acts for non-commercial purposes (No in Cambodia)
 - acts for experimental purposes (No in Cambodia)
 - academic citations (No in Cambodia)
 - must-match exemption (No in Cambodia)
 - exhaustion of rights in the internal or external market (Art. 107)

CHAPTER 6 COMMON PROVISIONS

Article 115.-

Any license contract concerning a patent or utility model certificate or a registered industrial design, or an application therefor, 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 122.-

The Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretionary power vested in him by this Law or the Regulations.

Article 124.-

Any decision of the Ministry in charge of industry under this Law, in particular the grant of a patent or the grant of a utility model certificate or the registration of an industrial design, or the refusal of an application for such a grant or registration, may be the subject of an appeal by any interested party before the competent Court and such appeal shall be filed within three (3) months of the date of the decision.

Article 125.-

An infringement shall consist of the performance of any act referred to in Section 9 of Chapter 2 and Section 7 of Chapter 5 of this Law in the Kingdom of Cambodia by the person other than the owner of the title of protection and without agreement of the latter

Article 126.-

On the request of the owner of the title of protection, or of a licensee if he has requested the owner to institute Court proceedings for a specific relief and the owner has refused or failed to do so, the competent Court may grant an injunction to prevent infringement or an imminent infringement, award damages and grant any other remedy provided for in the general law.

Article 127.-

Where the subject matter of the patent or of the utility model certificate is a process for obtaining a product, the burden of establishing that a product was not made by the process shall be on the alleged infringer if the product is new, and the alleged infringer proves that the process to obtain an identical product is different from that process.

Article 128.-

In requiring the production of evidence, the competent Court before which the proceedings referred to in Article 127 of this Law take place shall take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.

Article 129.-

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.

Article 133.-

Any person who knowingly performs an act which constitutes an infringement as defined in Article 125 of this Law hereof shall be guilty of an offence punishable by a fine from five million (5,000,000) Riels to twenty million (20,000,000) Riels or by imprisonment from one (1) year to five (5) years, or by both. The maximum penalty for a repeated offense committed within five (5) years from the date of previous conviction, shall be doubled in both of fine and imprisonment.

Article 134.-

Where a person is found guilty of an offense under this Law, the competent Court may order the seizure of which is deemed as state asset and destruction of the infringing goods and of any materials and implement the predominant use of which has been in the commission of the crime.

Article 135.-

The competent official, who committed guilty in implementation of own 's duty provided by this Law, shall be punished in according with administrative offences, which are not considering yet to the others criminal offences.

References

ASEAN Secretariat. *Common Guidelines for the Substantive Examination of Industrial Designs*. Jakarta: The ASEAN Secretariat, 2018.

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).