

## INDUSTRIAL DESIGN PROTECTION IN CAMBODIA

Copyright © 2021 KENFOX

*All other rights are reserved. This document and its contents are made available on an "as is" basis, and all implied warranties are disclaimed. The contents of this document do not constitute, and should not be relied on as, legal advice. You should approach a legal professional if you require legal advice.*

### What Is An Industrial Design In Cambodia?

An Industrial Design is protected under the Law on Patents, Utility Model Certificates and Industrial Designs dated 22 January 2003. An industrial design in Cambodia means “any composition of lines or colours or any three-dimensional form, or any material, whether or not associated with lines or colors”. For an industrial design to be protected in Cambodia, it must be “new” or “novel”. An industrial design is considered new “if it has not been disclosed to the public, anywhere in the world, prior to the filing date or the priority date”. In addition, an industrial design in Cambodia must “give 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”.

In light of the foregoing, for an industrial design to be eligible for registration in Cambodia, it should be characterized by the following:

- (i) It must include aesthetic features or features that 'appeal to the eye' that are the result of one or more factors such as shape, lines, colors, or combinations thereof;
- (ii) It must be capable of being embodied in a product or article; and
- (iii) such product or article must be manufactured in industry or handicraft.

Therefore, registration of an industrial design is not permitted if the application is not for an industrial design as defined by Cambodian law. If an application relates to subject matter that does not meet the legal definition of 'industrial design', or if it is established that the object of the application is not a design, the examiner shall propose that the registration be refused. In this case, no further examination of the application for additional grounds of refusal will be necessary.

### Parts Of Products – Whether Eligible For Registration As An Industrial Design In Cambodia

It is not explicitly provided in Cambodian law on whether a part/s of a product/s is eligible for registration as an industrial design in Cambodia. Thus, generally, subject to the features of a part of a product, it may (or may not) be registered as an industrial design. The part that embodies the design may be (i) an integral, inseparable part of a larger article, or (ii) a separable piece that may be replaced as a spare part or an accessory of a complex product. Cambodian Department of Intellectual Property (**DIP**) does not register industrial designs for parts or features that are integral with a product (inseparable part of a larger product). However, if such parts are separable, they may be available for registration as an industrial design in Cambodia.

### Eligibility requirement:

An industrial design is eligible for registration in Cambodia if it meets two requirements: (i) novelty and (ii) industrial applicability.

**Novelty:** An industrial design cannot be validly registered in Cambodia if it is not new. Absolute worldwide novelty is required in order that a design may be registered or maintained on the register in Cambodia. The novelty of a design is determined by reference to everything that has been made publicly available prior to the relevant date with respect to that design. To this effect, the novelty requirement will be satisfied if the design is not identical or substantially identical to any previously disclosed design to the relevant public prior to the applicable date.

*Principles of assessing novelty of an industrial design:* Novelty is assessed by comparing the design in question to any other design that has been disclosed before the filing date or the date of priority of the design being examined. In principle, the requirement of novelty is satisfied if no identical prior design can be found that anticipates the design under examination. However, *minor, insignificant or imperceptible* differences, and immaterial details, should be ignored when comparing a design against an earlier disclosure or citation. Such minor differences should not impact the relevance of the earlier disclosure for novelty purposes.

A difference or variation of appearance should be regarded as minor, insignificant, imperceptible or immaterial if it would normally go unnoticed by the average consumer of the product that embodies the design, or if the relevant feature can only be perceived upon close examination. The average consumer may exercise varying degrees of caution and attention depending on the nature of the product. This should also be considered when determining novelty in a particular case.

Significant variations in the features of a design under examination as compared to an earlier design disclosed or cited in opposition to the examined design can render the later design perceptibly different and thus novel in comparison to the earlier design.

**Industrial applicability:** This condition is complied with to the extent that the product or article that embodies the design may be manufactured industrially or produced by handcraft. To be registered as a design, the product that embodies the design must be capable of being mass produced in such a way that each individual item produced resembles the original model. Products, articles, and objects that do not meet this requirement for repeatability, either because they cannot be manufactured in identical copies or because they cannot be manufactured industrially or in the context of handcraft activity, are ineligible for design registration in Cambodia.

#### **Disclosure Exceptions - Circumstances Where Novelty Of An Industrial Design Is Not Deemed To Have Lost in Cambodia**

An industrial design is not deemed to have lost its novelty if it falls into 2 circumstances:

- (i) If the industrial design was disclosed to the public within twelve (12) months before the filing date or, where applicable, the priority date of the application;
- (ii) If the industrial design was disclosed to the public 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.

#### **Exceptions Of Registrability As An Industrial Design In Cambodia**

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, is not eligible for protection in Cambodia. In addition, industrial designs that are contrary to public order or morality shall not be registrable.

#### **Who can register an industrial design in Cambodia?**

The owner of the design is entitled to register it, which could be the designer or employer depending on the circumstances. Any other party may register the industrial design if they hold rights over it (e.g assignment).

#### **Where To File And What Must Be Included In An Application For Industrial Design In Cambodia**

An industrial design application must be filed with Department of Intellectual Property of Cambodia (“DIP”) under Ministry of Science, Technology and Innovation of Cambodia (formerly Ministry of Industry and Handicrafts) (“MSTI”).

An application for registration of an industrial design in Cambodia must contain:

- (i) A formal request and application form containing the name, address, nationality and residence of the applicant;
- (ii) If the applicant is not the creator, the request must be accompanied by a statement justifying the applicant's right to the registration of the industrial design;
- (iii) Drawings, photographs or other adequate graphic representations which embody the industrial design;

- (iv) A statement indicating the kinds of products for which the industrial design is to be used;
- (v) If the design is two-dimensional, the application should be accompanied by a sample which embodies the industrial design;
- (vi) A Power of Attorney certified by notary public in case of foreign applicant; and
- (vii) Foreign filing information of the industrial design application if filed internationally and upon request by DIP.

A single application for industrial design registration in Cambodia may cover two or more industrial designs as long as they are related to the same International Classification or set or composition of articles.

### Claiming Priority for An Industrial Design Application In Cambodia

Since Cambodia is a member of the Paris Convention, a priority claim is affordable and the priority date is the date of first filing or first claim. This means that if the applicant files a design application in one of the Contracting States under the Paris Convention, he may, within 6 months computed from the first filing date, apply for protection of his industrial design in Cambodia. The subsequent application in Cambodia will be regarded as if it had been filed on the same day as the first application. In other words, such design application will have priority over applications filed by others during the said period of time for the same industrial design. Moreover, the subsequent application, being based on the first application, will not be affected by any event that takes place in the interval, such as the publication of the design or the sale of articles incorporating an industrial design.

### Deferment Of Publication Of An Industrial Design In Cambodia

At the time of filing, the application for registration of an industrial design in Cambodia may include a request that the publication of the industrial design, upon registration, be deferred for a period not more than twelve (12) months from the date of filing or, if priority is claimed, from the date of priority of the application.

Upon registration of the industrial design, neither the representation of the design nor any file relating to the application shall be open to public inspection. In this case, DIP shall publish a mention of the deferment of the publication of the industrial design and information identifying the registered owner, and indicating the filing date of the application, the length of the period for which deferment has been requested and any other prescribed particulars.

At the expiry of the period of deferment, DIP shall publish the registered industrial design.

### Examination Of An Industrial Design Application In Cambodia

Like other trademark or patent applications, industrial design applications in Cambodia are filed under the e-filing system or online. DIP shall treat the date of receipt of an industrial design application as the filing date provided that the application contains indications establishing the applicant's identity and the required graphic representation of the article embodying the industrial design at the time of receipt.

**Formality examination:** If DIP determines that an industrial design application did not meet the formality requirements at the time of receipt (*e.g. lack of the required documents*), he shall invite the applicant to file the required correction and shall use the date of receipt of the required correction as the filing date. If no correction is filed, the application shall be treated as if it had not been filed.

**Substantive examination:** In Cambodia, an industrial design application will be examined substantively (or as to substance) to determine compliance pertaining to:

- (i) Adequacy of the required documents as set out in Article 95 and availability of statement justifying the applicant's right to the registration of the industrial design if the applicant is not the creator as provided in Article 96.
- (ii) Payment of the application fee;
- (iii) Unregistrability of an industrial design as set out in Articles 89 and 90 and unprotectability of an industrial design as provided in Article 93.

If DIP determines that the conditions for registering an industrial design in Cambodia are fulfilled, he shall register the industrial design, publish a reference to the registration and shall proceed to issue to the

applicant a certificate of registration of the industrial design; otherwise, he shall refuse the industrial design application.

### **Rights Conferred By Registration Of An Industrial Design In Cambodia**

Possessing an Industrial Design Certificate in Cambodia entitles the holder to exploit his registered industrial design, to grant others permission to exploit his design, and to bring those who exploit his design without permission before a Cambodian competent court.

### **Exhaustion of design rights in Cambodia**

The rights under the registration of an industrial design in Cambodia shall not extend 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.

### **Term of Design Rights In Cambodia**

An industrial design registration in Cambodia is valid for a period of five (5) years from the filing date of the application for registration. The registration may be renewed for 2 additional consecutive five-year periods by paying the prescribed fee. 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.

### **Invalidating Design Rights In Cambodia**

Any interested person may petition a competent Cambodian Court to invalidate the registration of an industrial design.

An industrial design registration in Cambodia may be invalidated if the person seeking invalidation establishes that:

- (i) Any of the eligibility requirements for an industrial design to be registered and protected in Cambodia have not been met, or
- (ii) If the registered owner of the industrial design is not the creator or his successor in title.

Any industrial design registration invalidated by the competent Cambodian Court shall be deemed null and void from the date of the registration thereof.

### **Defences Available To An Alleged Infringer In An Industrial Design Dispute In Cambodia**

Alleged infringers can defend themselves in infringement proceedings claiming that:

- The plaintiff's design rights are exhausted;
- The design embodied in the defendant's product is significantly different and thus, dissimilar and there is no likelihood of confusion;
- The plaintiff's registered design lost novelty due to similarity to a prior product embodied the industrial design.