

INVENTIONS & UTILITY MODELS IN CAMBODIA

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1. What Is An Invention In Cambodia?

An invention is protected under the Law on Patents, Utility Model Certificates and Industrial Designs dated 22 January 2003 ("[Cambodia Patent Law](#)"). The procedures for the grant of Patents and Utility Model Certificates are detailed in Cambodia Prakas (Declaration) No. 766 MIME.DIP.PRK dated 28 May 2007.

An invention is defined as "*the idea of an inventor which permits in practice the solution to a specific problem in the field of technology*". The Cambodia Patent Law further clarifies that an invention may either be, or relate to, both a **product** and a **process**.

- A product patent (*i.e., a patent giving protection to the product as such*) gives the patent holder the exclusive right to make, import, sell, offer for sale, use, and stock the product for the purpose of sale or use.
- A process patent (*i.e. a patent granted for a process or a method*) gives the patent holder an exclusive right to prevent others from using that process/form.

2. Patentable Inventions In Cambodia

An invention is patentable in Cambodia if it satisfies 3 requirements as follows:

- (i) It is new (or novel);
- (ii) It involves an inventive step; and
- (iii) It is industrially applicable.

Requirements of Novelty: Novelty is the primary criterion for patentability of any invention. No invention is patentable if the subject matter as described and claimed was disclosed prior to the filing date, or prior to the priority date, as the case may be, unless certain exceptions apply. The novelty criterion is judged under Article 6 of Cambodia IP Law. Accordingly, "*an invention is new if it is not anticipated by prior art*". In other words, an invention meets novelty requirements for patent protection in Cambodia if it is not disclosed to the public anywhere in the world, prior to the date of filing the application or the priority date (where applicable).

Disclosure Exceptions: An invention which is not deemed to have lost its novelty falls into 2 circumstances:

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

Requirements of Inventive Step: Inventive step is decided in accordance with the provisions of Article 7 of Cambodia Patent law. Accordingly, "*an invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the invention, it would not have been obvious to a person having ordinary skill in the art*". In other words, an invention is considered to involve an inventive step if the invention is not obvious to a person skilled in the art

Generally, the concept of "obviousness" must be strictly and objectively judged. It is critical to consider the invention in its entirety. It must be ensured that the inventive step is not an excluded subject in and of itself.

Otherwise, the patentee may insist on the grant of a patent for any of the excluded subjects by citing economic significance or technical advance. Therefore, this technical advance comparison should be done with the subject matter of invention and it should be found unrelated to any of the excluded subjects. Thus, this technical advance comparison should be made with the invention's subject matter and it should be determined that it is unrelated to any of the excluded subjects.

As a result, the following points must be objectively evaluated to determine whether the invention possesses inventive step or not when viewed in its entirety:

- (i) *Distinguish between a "person skilled in the art" and a "mere artisan";*
- (ii) *Determine the extent to which that person's common general knowledge was relevant at the time of the priority date;*
- (iii) *Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;*
- (iv) *Identify any discrepancies, if any, between the matter cited as part of the "state of the art" and the claim's inventive concept or claim as construed;*
- (v) *When viewed in isolation from the alleged invention as claimed, do those distinctions constitute steps that would have been obvious to a person skilled in the art or do they necessitate any degree of inventive ingenuity?*

Requirements of Industrial Applicability: In the patent sector, industrial applicability or industrial application is a patentability requirement according to which a patent can only be granted for an invention. Under Article 8 of Cambodia Patent Law, an invention is deemed industrially applicable “*if it can be made or used in any kind of industry*”. In general, workability and usefulness are deemed to be synonymous with industrial applicability. If an invention is not workable, it means that it is also not industrially applicable. The patent specification must include a description of the claimed invention's practical application and industrial use, with a concrete benefit derivable directly from the description and common general knowledge. A purely speculative use or a vague and speculative indication of a possible objective does not satisfy the industrially applicable requirement.

3. Exceptions To Patentability

The Cambodia Patent Law sets out 6 types of unpatentable inventions, in detail:

- (i) Discoveries, scientific theories and mathematical methods;
- (ii) Schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (iii) 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;
- (iv) pharmaceutical products;
- (v) Plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals;
- (vi) Plants varieties.

For “pharmaceutical products”, following the Council for Trade-Related Aspects of Intellectual Property Rights’ decision on November 06, 2015, pharmaceutical products are excluded from patent protection in Cambodia until January 01, 2033, or when Cambodia ceases to fall within the least developed category, whichever comes earlier.

In addition, the Cambodia Patent Law provides that “*inventions, the commercial exploitation in the Kingdom of Cambodia of which would be contrary to public order or morality, or would not protect human, animal or plant life or health, or would cause serious prejudice to the environment, or would be prohibited by law, are excluded from patentability*”.

4. Software-related Inventions In Cambodia

Invention related to computer software in Cambodia shall be executed as follows:

Under paragraph (3) of Article 3 of the Cambodia Patent Law stating “*an invention may be, or may relate to, a product or a process*”, the invention shall include:

- Process inventions which, in whole or in part, consist of steps that are performed by computer and are directed by a computer; and
- Product inventions consisting of elements of a computer-implemented invention, including in particular: (i) machine-readable computer program codes stored on a tangible medium such as a floppy disk, computer hard drive or computer memory; and (ii) a general purpose computer whose novelty over the prior art arises primarily due to its combination with a specific computer program.

Applicants who have filed patent applications for computer programs and computer-related inventions in Cambodia shall be considered as having waived their right of seeking copyright protection, if available, under Article 10(1) of TRIPS Agreement.

5. Utility Model In Cambodia

Utility Model Certificates are, similarly to patents, intellectual property rights that protect the technical aspects of inventions. The Cambodia Patent Law defines utility models as any invention which is new and industrially applicable and may be, or may relate to, a product or process. Thus, unlike patented inventions, utility models do not need to involve an inventive step. This is the key difference between utility models and patented inventions; whereas utility models may be obvious to a person skilled in the art, patented inventions may not.

6. Conversion Of Patent Applications

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 the Cambodia Patent Law, convert his application into an application for a utility model certificate, which shall be accorded the filing date of the initial application.

Upon payment of the prescribed fee, as specified in Article 130 of the Cambodia Patent Law, an applicant for a utility model certificate may convert his application into a patent application at any time prior to the grant or refusal of the utility model certificate.

Any decision made by DIP or MHI on 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 appealed by any interested party before the competent Cambodia Court. An appeal shall be filed within three (3) months of the date of the decision.

7. First-To-File System

Cambodia employs a first-to-file system, meaning that the person whose application has the earliest filing date – or, if priority is claimed, the earliest priority date – he/she is granted the patent or utility model certificate. Here the priority date is the date when an application was first made for the patent or utility model certificate in a foreign country. The period of priority starts from the filing date of the first application (the day of filing shall not be included in the period) and is then twelve (12) months for patents and utility models.

8. Where To File And What Must Be Included In An Application For Patent In Cambodia

A patent 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 a patent or utility model certificate in Cambodia must contain the following:

1. A formal request and application form containing the name, address, nationality and residence of each applicant;
2. If the applicant is the inventor, the application dossier must also contain a Statement of the Applicant’s Right. If the applicant is not the inventor, the application must clearly state each inventor’s name and address, and be accompanied by a statement justifying the applicant’s right to the patent;
3. A description of the invention;
4. One or more clearly stated claims defining the matter for which protection is sought;
5. Drawings, if necessary to understand the invention;

6. An abstract outlining the technical information (the abstract does not affect the scope of protection);
7. Power of Attorney certified by notary public in case of foreign applicant; and
8. Foreign filing information of the patent application or utility model certificate application, if filed internationally, and upon request by MSTI.

A patent application may claim priority based on an earlier national, regional, or international application. If priority is claimed, DIP may request the applicant to submit the following:

- (i) Any search or examination reports *relating to the foreign application: a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;*
- (ii) *A certified copy of the granted foreign patent or utility model certificate: a copy of the patent granted on the basis of the foreign application;*
- (iii) *Foreign office action: a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application. The applicant shall, at the request of the Registrar, furnish him with a copy of any final decision invalidating the patent granted on the basis of the foreign application.*

Requirement of a patent specification in Cambodia: The specification shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art, and shall, in particular, indicate the best mode known to the applicant for carrying out the invention, at the filing date or, where priority is claimed, at the priority date of the application.

Requirement of a claim: The claim or claims shall define the matter for which protection is sought. The description and the drawings may be used to interpret the claims. Claims shall be clear and concise. They shall be fully supported by the description.

Requirement of a drawing: Drawings shall be required when they are necessary for the understanding of the invention.

Requirement of an abstract: The abstract shall merely serve the purpose of technical information; in particular, it shall not be taken into account for the purpose of interpreting the scope of the protection.

9. Requirement Of Unity Of Invention In Cambodia

A patent application can only claim one invention or a group of closely related inventions. In conformity with Rule 13.1 of the Patent Cooperation Treaty, under the Cambodia Patent Law, “*the patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept*”. Of note, the fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation of the patent in Cambodia.

10. Amending or Dividing A Patent Application in Cambodia

A Cambodia patent application can be amended before the grant of patent, but there are restrictions on amendments to prevent a new subject matter being introduced and to prevent any extension of the scope of protection given by a patent after grant. Article 24 of the Cambodia Patent Law provides that “*the applicant may, up to the time when the application is in order for grant, amend or divide the patent application, provided that the amended or divisional patent application shall not go beyond the disclosure in the initial application*”.

The following should be taken into account when amending a patent application in Cambodia:

- Whether the amendment leads to substantive changes to the content of the technical solution, or,
- Whether the substantial content of the technical solution requested for protection is changed.

Theoretically, if the protection scope of the amended claim has been narrowed, but the content of the technical solution has been substantially changed, such amended technical solution shall be regarded as a new technical solution different from that of the original claim, and such amendment made by the applicant shall not be accepted.

11. Examination Of A Patent Application In Cambodia

An application for a patent or utility model certificate filed with DIP shall be subject to 2 phases of examination, i.e. formality and substantive examination.

Formality Examination of Patent Application In Cambodia/Formality Office Action:

Prakas (Declaration) on the procedure for the grant of patents and utility model certificates dated 28 May 2007 does not provide for a timeline under which DIP must issue a formality examination Notice. However, upon receipt of DIP's formality examination Notice, a response must be filed by the applicant within two (2) months from the date thereof.

In the course of formality examination, DIP's examiner shall examine compliance of requirements as provided under Article 16, 17, 30 and 31 of the Cambodia Patent Law. In detail, the following matters will be examined to determine compliance of formality requirements for a patent application in Cambodia:

- *whether a patent application filed in Cambodia contains a request, a description, one or more claims, one or more drawings (where required), and an abstract).*
- *whether the request in the filed application contains a petition to the effect that a patent be granted, the name of and other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention.*
- *Whether a statement justifying the applicant's right to the patent has been provided in case the applicant is not the inventor.*
- *whether the applicant has furnished DIP with the date and number of any application for a patent filed abroad relating to the same or essentially the same invention as that claimed in the application filed with DIP.*
- *whether the applicant has provided DIP with (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application; (ii) a copy of the patent granted on the basis of the foreign application; (iii) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.*

In addition, DIP's examiner will examine if Rules 11, 12, 14, 15 and 16 in Prakas (Declaration) on the procedure for the grant of patents and utility model certificates have been complied with. Thus, the following issues will be examined to determine compliance of formality requirements for a patent application in Cambodia:

- *Whether any document forming part of a patent application or any documents submitted to DIP are in Khmer.*
- *Whether the applicant has submitted the filing documents in Khmer or English translation of the documents within six (6) months from the filing date for searching and examination.*
- *Whether the applicant has submitted translation into Khmer of the applications and documents (writing in languages other than Khmer language) within six (6) months from the filing date for the purpose of judging, protection and law enforcement.*
- *Whether the requirements of indication of name, address, nationality and residence have been met.*
- *Whether the requirements of executing signature related issues have been satisfied. DIP may, whenever he deems it necessary, request evidence of authorization to sign.*
- *Whether the requirements of measures, terminology and signs have been met.*
- *Whether the number of documents and physical requirements have been met.*

Substantive Examination of Patent Application In Cambodia:

Basically, during substantive examination, DIP's responsible examiner will assess the patentability of subject matters claimed in the application under the requirements under Article 3, Articles 4 to 9, Articles 18 to 20 and Articles 23 to 26 of Cambodia Patent Law. In detail, the following matters will be examined to determine patentability for an invention to be patented in Cambodia:

- *Whether an invention in a patent application fall outside the scope of patentable subject matters;*
- *Whether an invention in a patent application meets legal requirements for patentability (i.e. novelty, inventive step and industrial applicability);*

- *Whether requirements of patent specification, claim, drawing and abstract in patent document have been met.*
- *Whether the requirement of unity of invention is met, etc.*

DIP may, at its discretion, request the applicant to provide the below documents to enable itself to check compliance of statutory requirements for patent protection in Cambodia:

- (i) The results of any international search report and any international preliminary examination report established under the PCT in relation to the application; and/or
- (ii) a search and examination report submitted under item (i) of the 1st paragraph of Article 31 of the Cambodia Patent law relating to, or a final decision submitted under item (iii) of the 1st paragraph of Article 31 of this Law on the refusal to grant a patent on, a corresponding foreign application; and/or
- (iii) A search and examination report which was carried out upon his request by an external search and examination authority.

If the requirement of unity of invention is not met, DIP's examiner will raise a unity of invention objection during substantive examination of a patent application if they believe more than one invention is being claimed. When a patent application in Cambodia is objected to for lack of unity, the application may still proceed to grant. Upon receipt of the DIP's Notification, the applicant may submit his observations and, where applicable, to amend or divide his application, within a period not more than five (5) months from the date of the Notice.

12. Hearing

As statutorily required, before exercising adversely to any person any discretionary power given to the Registrar by the Law or this Declaration, DIP shall notify such person, in writing, of the opportunity to be heard thereon, and indicating a time limit, which shall not be less than one (1) month, for filing a request for a hearing.

The request for a hearing shall be in writing. Upon receiving such request, DIP shall give the person applying, and any other interested persons, at least two (2) weeks before hearing, in writing, of the date and time of the hearing

13. Expediting Procedures For Obtaining Patent Rights In Cambodia

To accelerate the procedure for obtaining patent rights in Cambodia, MSTI signed various patent validation agreements with the following patent offices:

- Intellectual Property Office of Singapore (IPOS).
- Japan Patent Office (JPO),
- European Patent Office (EPO),
- China State Intellectual Property Office (SIPO),
- Korean Intellectual Property Office (KIPO).

As a general requirement, in order to validate a Singaporean, Japanese, European, Chinese and Korean patents in Cambodia, the patentee must basically submit DIP a certified copy of the parent patent issued by the relevant national patent offices and a Khmer translation of the patent.

14. Grant Of Patent In Cambodia, Refusal Of Patent In Cambodia

Where DIP finds that the conditions referred to in Articles 35 and 36 of the Cambodia Patent Law are fulfilled, he shall proceed to grant the patent. Otherwise, he shall refuse the application and notify the applicant of that decision.

Upon granting a patent in Cambodia, DIP shall:

- (i) publish a reference to the grant of the patent;
- (ii) issue to the applicant a certificate of the grant of the patent and a copy of the patent;
- (iii) record the patent;
- (iv) make available copies of the patent to the public, on payment of the prescribed fee.

15. Term of Patent Rights In Cambodia

The validity term of patents lasts for a period of twenty (20) years from the filing date. Utility Model Certificates are valid for only seven (7) years, and there is no possibility for renewal.

16. Post-grant amendment of Patents In Cambodia

In Cambodia, granted patents can be amended under provisions found in Article 40 of the Cambodia Patent Law. Under Article 40, a patent owner has the right to ask DIP to amend the text or drawings of the patent in order to limit the extent of the protection conferred thereby, provided that the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

17. Compulsory Licensing of Patent in Cambodia

It should be noted that MSTI has the right to allow a government agency or a third party to exploit an invention or utility model on certain public interest grounds. Such grounds include, for example, national security, nutrition, health and development. Moreover, a government agency may also grant a third party the right to exploit the patent if the patent holder has acted anti-competitively.

18. Rights Conferred To A Patented Invention In Cambodia

A patent granted by DIP provides the patent holder the exclusive right over the exploitation of the invention. Thus, the patent owner (patentee) can prevent others from making, using, offering for sale, selling or importing for those purposes the patented invention without the patentee's permission. A patent holder in Cambodia, in case of alleged patent infringement, may initiate a civil lawsuit thereagainst.

19. Challenging the Validity of Patents In Cambodia – Patent Invalidation in Cambodia

Entitlement and Where To File A Patent Invalidation Action in Cambodia

During the life of a patent, any interested person may request the competent Cambodia Court to invalidate a patented invention. No particular legal interest is required. Specifically, it is not necessary that the invalidity plaintiff has been sued for infringement of the patent, or threatened to be sued.

The substantive and procedural requirements on patent invalidation proceedings against a patented invention are provided for and governed by Articles 65-68 of the Cambodia Patent Law and Rule 31 of Prakas (Declaration).

Grounds for Patent Invalidation in Cambodia

Substantive grounds:

- Ineligible for patent protection: whether the invention described in the application is the right subject matter for protection under Article 3 of the Cambodia Patent Law.
- Excluded Patentable subject matter: The following are excluded from patent protection:
- Patentability requirement: An invention which does not possess novelty, inventiveness, or industrial applicability will be a subject for patent invalidity in Cambodia.
- The patent owner is not the inventor or his successor in title. Statutorily, the employer owns an invention made by his employee if the invention was made in the performance of the employment contract, unless the employment contract stipulates otherwise.

Technical grounds:

- Insufficient disclosure of specification: the specification describes the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is

communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. Thus, insufficient disclosure of the invention to enable the skilled person to carry out the "invention" may result in patent invalidity under the laws of Cambodia.

- Lack of clarity of claims: This lack of clarity may only constitute a ground for patent invalidity in Cambodia.
- Lack of drawings to make it possible to understand the patented invention may make the patent at risk of invalidity.

Generally, a majority of patent invalidation cases have an infringement litigation behind them. In another scenario, a competitor monitors the patenting activity of the patent owner, because he is developing a similar technology or wishes to develop one in the future. The competitor may already have, but at a later point in time, applied for a patent on a similar invention. The competitor is, of course, interested in destroying the earlier patent as soon as possible. Among the various grounds, the concerned party often focuses their attack on the lack of novelty (in some other cases, inventiveness) during invalidation proceedings which probably carries the most weight because novelty is the foremost requirement to determine the patentability of any invention.

Patent invalidation proceedings in Cambodia

Cambodia does not have specialized IP court. Thus, it is expected to take a long time for an invalidation action to be resolved by the Cambodian court. The decision would be one of (a) patent totally invalidated, (b) patent partially invalidated, or (c) patent valid.

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.

Appeal proceedings:

A patent invalidity proceeding is heard by the competent first instance court in Cambodia. The losing party may appeal against the decision of the first instance court to a higher court in Cambodia based on the following categories:

- (a) Uttor appeal against a judgment rendered by a court of first instance, or Satuk appeal if the parties have agreed as set forth in Item (a), Paragraph 1 of Article 260 (Judgments subject to Uttor appeal);
- (b) Satuk appeal against a judgment rendered by the Uttor appellate court; or
- (c) Chomtoah Appeal against a ruling.

An Uttor appeal shall be filed within one month from the day on which service of the written judgment was received or the day of notification for a ruling denying or dismissing [without prejudice] a motion to set aside a default judgment.