

Industrial Design Registration in Cambodia: How to Overcome Refusal for Successful Protection

Today's product appeal is not limited to quality issues. A product with good quality, but the design is not beautiful or sophisticated, is no longer the top priority choice of consumers. Gone are the days when consumers only preferred something that was sturdy, durable, or had better wood than good paint. High quality, but without creativity in design, the product will be less attractive, losing its advantage over a sea of similar offerings. Uniqueness and novelty in design are the keys to helping products stand out, strengthening their position and increasing profits for businesses in the market.

Creating a product with an eye-catching and sophisticated appearance requires businesses to invest in financial resources and establish an R&D team. Only after numerous rounds of testing, evaluation, discussion, and revisions can they finalize the design.

However, many businesses make mistakes that lead to costly consequences. The process of registering industrial design protection for products has never been easy and smooth in Cambodia. Difficulties or mistakes can originate from the product owners themselves. A lack of understanding about industrial design protection, coupled with the naive belief that launching a product and then reconsidering protection, can undermine efforts to secure exclusive rights to industrial design - a form of intellectual property that requires significant time and resources to develop. A question that many product owners are interested in is: What valuable lessons need to be learned to successfully register an industrial design in Cambodia?

Background

Recognizing the potential market in Cambodia, despite the complex and uncertain intellectual property laws in this country, VietC Production Co., Ltd. (**VietC Company**), a pioneering and innovative manufacturer of "water purifiers" in Vietnam, still aims to protect the Industrial Design of their product from the risk of imitation and unauthorized use. In February 2022, VietC contacted and requested advice from KENFOX IP & Law Office to consult and represent them in registering industrial design protection for their product in Cambodia.

Search: Based on the preliminary review and assessment of the customer's water purifier design, and receiving consulting opinions, VietC Company has agreed to conduct a search on the ability to protect the industrial design of the product "water purifiers" before applying for registration in Cambodia. The Cambodian Department of Intellectual Property (**DIP**), after more than 2 months of searching, issued a search conclusion that the industrial design of VietC Company's water purifier product is capable of being registered in Cambodia.

Filing application and reason for refusal of protection: However, after waiting for more than a year, VietC Company was taken aback to receive a substantive examination notification from the DIP. The notification stated that their "water purifier" industrial design, applied for registration, was deemed indistinguishable from a pre-existing design. Remarkably, this cited design was an earlier version of the "water purifier" product that VietC had also registered. This previous version had been launched nearly a year prior to the filing date of the latest application in April 2022.

Response: Upon examining the cited industrial design, KENFOX attorneys identified distinguishing features between it and our client's design, notably in shape and decorative elements. A comprehensive response, formulated after professional analysis and consultations with VietC's designers, was submitted to the DIP. This document highlighted the designs' significant differences, using parallel comparisons and annotated images for clarity. It also argued that, under Article 92 of Cambodia's Patent Law, the similarity to the cited design did not constitute a violation, given both designs were owned by the same entity and filed within 12 months of each other's publication date. Convincing in its detail and argumentation, our response led the DIP to retract its initial refusal, granting industrial design protection for VietC's water purifier.

Result: Nearly 02 years after the initial application in April 2022, and following a rigorous examination and an initial refusal, our client's water purifier product's Industrial Design was granted protection in February 2024

Exclusive rights and business development opportunities in Cambodia: After submitting their Industrial Design application, VietC quickly launched its product in Cambodia. The company announced not only did it secure exclusivity and bolster its brand value, positioning itself as a leader in the water purifier industry, but it also attracted a capital cooperation offer from a Japanese investor. This proposal aims at joint ventures to further expand and develop their product, offering VietC opportunities for investment recovery, product development, and enhanced R&D in Cambodia

Key Takeaways

1. Register industrial design as soon as possible: Industrial Design is a crucial component of a product, defining its identity and distinguishing it in the market, thus enhancing brand recognition and adding value for businesses. However, its appeal also attracts illicit entities that produce 'counterfeits,' leading to consumer confusion about the origins of goods. In practice, products with attractive designs are frequently copied and imitated. Some illicit entities even systematically and professionally surveil products from other companies to replicate them. Therefore, it is imperative to protect Industrial Design as early as possible, before market introduction. Exclusive Industrial Design rights are essential legal tools that confirm lawful ownership of the design by the manufacturer. With Industrial Design protection granted, the owner is entitled to use the registered design exclusively (i.e., manufacture, commercialize, or import products featuring the design) and to take legal action against infringement in the competent Cambodian court.

2. Search before filing an industrial design application: Conducting a search and evaluation before filing an application is very important to assess the registrability and protectability of an industrial design. Such pre-application searches pinpoint potential hurdles, equipping applicants with crucial insights into the uniqueness and eligibility of their design for protection. Valuable lessons that intellectual property rights holders can draw from this case include: **(i)** Conducting pre-application searches is an integral part of the industrial design protection registration process, helping determine whether the industrial design meets the registration requirements. However, even if the search results indicate that the industrial design meets the registration criteria, the formal search report does not guarantee that the industrial design will definitely be registered; **(ii)** Despite the official search report showing that the industrial design meets the registration requirements, the industrial design may still be refused protection upon application submission. Therefore, applicants should be prepared to deal with unforeseen circumstances in the registration process and devise effective solutions to address potential challenges.

3. Refusal of Industrial Design application: Industrial design registrations are mainly rejected for not meeting the protection standards outlined in several specific articles: Article 89 (which describes protectable industrial designs), Article 90 (which details industrial designs that cannot be protected), Article 91 (covering the novelty requirements of industrial designs), Article 92 (listing exceptions for announcing industrial designs), and Article 93 (pertaining to designs contrary to public order and morality).

Under Cambodian law, an industrial design is at risk of being denied registration if it lacks distinctiveness from pre-existing designs. Specifically, if the design seeking registration is fundamentally similar to any design already registered or made public, it may be refused protection. The examination process involves comparing the new design's basic shaping characteristics, overall impression, and features with those of existing designs. Examiners use these comparisons to determine whether the new industrial design meets the requisite standards for protection.

The experience from the aforementioned case highlights the importance of constructing a detailed and persuasive analysis table to highlight the differences between the applied industrial design and the contrasting industrial design. Firstly, it is essential to categorize and clearly identify the main shaping characteristics of the applied industrial design and the contrasting industrial design, including shape, lines, colors, layout, and any other visual elements. Secondly, lawyers and clients should collaborate to create a detailed comparison table, describing each feature of the applied industrial design compared to the contrasting industrial design. This table should include illustrated images and textual descriptions. Next, it is necessary to analyze the differences in the overall impression that the two industrial designs create for ordinary consumers, emphasizing that these differences are significant enough to create a distinct overall impression. Finally, arguments, analysis, and the use of annotations on images should be employed to demonstrate that the differences in the applied industrial design are not merely minimal but also reflect creativity and uniqueness that do not overlap with the contrasting industrial design.

4. Novelty - a common and serious mistake from industrial design owners: Believing that one can first conduct a market test to gauge consumer reaction before registering for industrial design protection is a common but serious mistake. Unlike trademarks, where owners can label their products, test them in the market, and apply for registration at any time, this approach does not apply to industrial designs. Attempting to test a product with an industrial design in the market before applying for registration can jeopardize the design's protectability. The foremost requirement for industrial design protection is that the product must possess "novelty".

Under Article 92 of Cambodia's Patent, Utility Solution, and Industrial Design Law, an industrial design is deemed new only if it has not been disclosed to the public anywhere in the world before the application date or priority date (if applicable). Disclosure can occur through publication in tangible form, use, or any other

means. Therefore, launching a product in the market before submitting the registration application will compromise the design's novelty, which is a crucial criterion for securing industrial design protection.

In this case, if the applicant sells water purifier products with an industrial design similar to their application but does so earlier and beyond the novelty grace period, the likelihood of VietC's water purifier industrial design application being rejected due to a loss of novelty significantly increases.

However, Cambodia's industrial design law also accounts for exceptional circumstances to protect creators' intellectual property rights. Specifically, an industrial design will not be deemed to have lost its "novelty" under two exceptions: **(i)** if the use, publication, or disclosure of the industrial design occurs within 12 months before the registration application is submitted, it retains its "novelty"; and **(ii)** if the disclosure results from the applicant's actions or their predecessor's, or from a third party's abuse related to the applicant or their predecessor

Final thoughts

Obstacles and unforeseeable difficulties may arise during the process of registering Industrial Designs in Cambodia. Industrial design applications may face the risk of rejection from the DIP, even if the formal search results indicate that the industrial design meets the protection standards. However, it is evident that by understanding and effectively applying the legal provisions, the applicant has the opportunity to change the situation and overturn the refusal notices/decisions, ensuring that their created industrial design is legally protected and gains the benefits from the law's protection mechanisms.

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