How to Register Trademark in Cambodia

15 August 2014

SIM Sokheng
Deputy Director of Department of Intellectual Property Rights
Ministry of Commerce
1. Legislation

- **Law** on Mark, Trade Name, and Act of Unfair Competition on 07 February 2002.
- **Prime Minister’s Sub-Decree** on the Implementation of the Law on Mark, Trade Name, and Act of Unfair Competition on 12 July 2006.
- **Ministerial Declaration** on Legal IP Attorney on 01 February 2011.
- **Draft Ministerial Declaration** on Trademark Procedure/Guideline.
2. International Cooperation

3. ASEAN Framework Agreement on IP Cooperation in 1999 → ASEAN Working Group/3 times per year
4. WTO/Trade-Related Aspects of IP Rights (TRIPS) 2004
5. ASEAN-Australia NZ FTA (IP Chapter) in 2010
6. ASEAN-China IP Cooperation in 2009
7. ASEAN-Japan IP Cooperation in 2012
8. ASEAN-EU IP Cooperation in 2014 (Cambodia)
9. Regional Comprehensive Economic Partnership (ASEAN+6) on negotiation (IP Chapter)
10. Cambodia-US on Trade Relations and IPR Protection in 1996
11. Cambodia-Thailand on IP Cooperation in 1997
12. Cambodia-China on IP Cooperation in 2011
13. To be member of Madrid Protocol
14. Using Nice Classification
3. Statistics (Trademark)

5,223 Japanese Trademark in Cambodia

<table>
<thead>
<tr>
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<th></th>
<th></th>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>Resident</td>
<td>298</td>
<td>408</td>
<td>464</td>
<td>530</td>
<td>544</td>
<td>578</td>
<td>806</td>
<td>840</td>
<td>806</td>
<td>906</td>
<td>885</td>
</tr>
<tr>
<td>Non-resident</td>
<td>1,556</td>
<td>1,669</td>
<td>1,912</td>
<td>2,035</td>
<td>2,322</td>
<td>2,521</td>
<td>2,271</td>
<td>3,129</td>
<td>3,653</td>
<td>4,234</td>
<td>5,099</td>
</tr>
<tr>
<td>Total</td>
<td>1,854</td>
<td>2,077</td>
<td>2,376</td>
<td>2,565</td>
<td>2,866</td>
<td>3,099</td>
<td>3,077</td>
<td>3,969</td>
<td>4,459</td>
<td>5,140</td>
<td>5,984</td>
</tr>
<tr>
<td>Japan</td>
<td>156</td>
<td>182</td>
<td>161</td>
<td>126</td>
<td>127</td>
<td>217</td>
<td>140</td>
<td>398</td>
<td>386</td>
<td>664</td>
<td>743</td>
</tr>
</tbody>
</table>
4. www.cambodiaip.gov.kh
ASEAN 600 Million people / 2.5 million TM

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5. Flow of Mark Registration Process

4-6 Months for Registration

APPLICATION FILED (1)

ACKNOWLEDGEMENT (2)
(Filing Requirement Meet)

FORMALITY CHECK (3)
(All Contained in Application Form
Must Be Fulfilled)

SUBSTANTIVE EXAMINATION
(4)

REGISTRATION (5)

PUBLICATION (6)

OPPOSITION, IF ANY (7)

APPEAL, IF ANY (8)

COURT(S), IF ANY (9)

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To allocate a filing date and an application number, the following minimum requirements must be met at the time of filing an application:

1) The name of the applicant;
2) An address to which communications can be directed, including local address for service;
3) A reproduction of the mark;
4) A Specification of goods or services;
5) The required filing fee.
7. Initial Processing

APPLICATION FILED (1)

Minimum Requirement for Giving Filing Date and Filing No.:
1. Name of Applicant
2. Local Address for Service
3. Specimens of Mark
4. Specification of Goods/Services
5. Filing Fees

ACKNOWLEDGEMENT (2)

FORMALITY CHECK (3)

Check all Parts Mentioned in Application Form:
I. Applicant: (from a to e)
II. Details of Mark Filed (from a to j)
III. Priority Claim (from a to c)
IV. Limitation/Condition
V. Signature of Applicant/Agent (from a to d)

Notice of Amendment/Correction, if any (45 days)

SUBSTANTIVE (4)
EXAMINATION

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8. Examination Procedure Under Art. 4 (a)

(1) Identify Applied Mark

(2) Identify Goods/Services

(3) Determine Composition of Applied Mark

(4) Determine Meaning of Applied Mark, if Any

(5) Determine Generic, Descriptive Element

(6) Decide whether the mark is capable of distinguishing or not:
- By it own, or
- Need to be used

(7) Advice to Overcome the Objection:
- Disclaimer/Condition/Limitation
- Amendment of Goods/Services
- Amendment of Mark, or
- Evidence of Use
9. Process for Overcoming Objection

First Preliminary rejection issued

Arguments or Amendment Filed (60 days)

Examine the argument or amendment

If not, Second Preliminary Rejection

Second or Third …… Arguments or Amendment Filed (60 days/each)

Examine the argument/amendment

If not, Final Rejection or hearing

If not, withdrawn, can be revival

Acceptance → Fee paid → Registration

Acceptance → Fee paid → Registration

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10. Applicant and Application Form

- The applicant is person who **claims to be the owner of the mark**. That person must:
  - *Use or intend to use the mark in Cambodia*, or
  - *Authorise or intend to authorise its use in Cambodia*, or
  - *Intend to assign* the mark to person that is about to be constituted who will use the mark in Cambodia.
Details of Applicant

(a): Name:

- Individual: Full name including family name
- Partnership: two or more “persons” using the mark under the provisions of Rule 6:
  - Must give names of each of the partners (individuals or corporate bodies) and each of addresses

(b): Address:

- Full address including name of country. An address is required for every applicant. This can be an address either within the Kingdom of Cambodia or outside the Kingdom of Cambodia.
(c): Nationality or Citizenship/Country of Incorporation: eg. China

(d): Name of Legal Agent and Address for Service:

- The address for service is an address in the Kingdom of Cambodia, to which all correspondence and notices must be sent.
- Email address and telephone number of legal agent must be included.
- When the applicant domiciled in Cambodia does not wish to use legal agent, the same address in (b) is stated.

(e): Local Agent Registration No.: When applicable
APPLICATION FOR MARK REGISTRATION

MARK APPLICATION NUMBER: ____________________________

DATE OF FILING: ____________________________

PART I: APPLICANT

(a) Name: Manchester United Limited
   Sir Matt Busby Way, Old Trafford, Manchester M16 0RA, England.

(b) Address: ____________________________ Country: England.

(c) Nationality or Citizenship/Country of Incorporation: ____________________________

(d) Name of Local Agent and Address for Service: KIMLY IP SERVICE
   Borey Piphup Thmey, Somrong Andeth No. 22, St. No. 3, Phum Raungchack,
   Sangkat Phnom Penh Thmey, Khan Sen Sok, Phnom Penh, Cambodia.
   (855-23) 6363975
   kimlyip@ezecom.com.kh, Fax: ____________________________, Email: ____________________________

(e) Local Agent Registration No. (when applicable) ____________________________
Specimen of Mark

- Must be durable graphic reproduction of the mark
- Size: not more than 8 cm by 8 cm
- Quantity: 15 additional reproductions (specimens)
- The specimens must clearly show all features of the mark to be protected, and
- Must be able to be clearly reproduced.

9th edition of Nice Classification is applied at this moment.
PART II: DETAILS OF MARK APPLICATION

NOTE: 15 specimens of the mark must be attached to this application.

(a) Name of Mark (if any):

(b) Description of Mark(s) (for figurative elements):

(c) Class(es) No. 36

(d) Details of Specification of Goods/Services (Class heading is NOT accepted):
Insurance; financial affairs; monetary affairs; real estate affairs; provision of financial services; credit card services; charitable fund raising services;

(e) If the mark is a combination of colours or coloured mark, please indicate the colours of the mark with colour codes.
Red, Black, Yellow and white

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(g)- **3D Mark**: Tick the box, if the mark is three dimensional sign

(h)- **3D Shape as Mark**: if the shape/packaging as a feature of the mark is claimed, the claimed particular feature in word must be given.

(i)- **Mark consists of word(s)**: Derivation of the word(s) and whether it is invented or not must be given.

(j)- **Mark consists of non-English word(s)**: Its or their transliteration(s) and meaning(s) must be given
(f) If the mark consists of figurative element(s), please give a description of the figurative element(s) below:

<table>
<thead>
<tr>
<th>Vienna Codes</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>3 1 1</td>
<td>Lions</td>
</tr>
<tr>
<td>26 4 11</td>
<td>Quadrilaterals containing one or more triangles or lines</td>
</tr>
<tr>
<td>26 4 16</td>
<td>Quadrilaterals containing other figurative elements</td>
</tr>
</tbody>
</table>

(g) Is the mark two or three-dimensional? [ ] Yes [x] No

(h) If 2 or 3-dimensional shape, aspect of packaging or colour as a feature of the mark is claimed for protection, please provide a description of your claim to the particular feature in words:

(i) If the mark contains or consists of word(s), please provide the derivation of the word(s) and state whether it is invented or not:

Manchester United is the name of the football team in England.

(j) If the mark contains or consists of non-English word(s) please provide the following details:

<table>
<thead>
<tr>
<th>Language</th>
<th>Word</th>
<th>Transliteration</th>
<th>Meaning</th>
</tr>
</thead>
<tbody>
<tr>
<td>English</td>
<td>United</td>
<td>Unit-ted</td>
<td>Name of City in England.</td>
</tr>
<tr>
<td>Aug 2014</td>
<td>SIM</td>
<td>Sokheng, DIP/MoC</td>
<td>to join, combine</td>
</tr>
</tbody>
</table>
PART III: PRIORITY CLAIMED

(a) Office of Priority Filing: OHIM

(b) Priority Filing Date: 05/10/2011 (dd/mm/yy)

(c) Application Number, and Country 78493103, England.

*A certified copy of the priority documents must be attached

PART IV: LIMITATIONS OR CONDITIONS

Insert below any conditions, disclaimers or other limitations to which the registration will be subjected.

________________________________________________________

PART V: SIGNATURE OF THE APPLICANT OR HIS REPRESENTATIVE

Note: If this portion is signed by a local agent on behalf of the applicant, the notarised Power of Attorney or/and Deed of Substitution must be attached.

(a) Signature: 
(b) Name of Signatory: Ms. Chea Sokmean
(c) Title: SIM Sokheng, DIP/MoC
(d) Date: Aug 2014
Court shall *order prompt and effective* provisional measures *to prevent*:

- an infringement,
- an imminent infringement, or
- to preserve relevant evidence in regard to the alleged infringement.
The Court may order a provisional measure *without* giving the other party an opportunity to be heard provided:

1. the Court deems the *circumstances are appropriate*, and in particular when any delay is likely *to cause irreparable harm* to the right holder or a risk that *evidence will be destroyed* can be demonstrated, and
12. Border Measures

- The border measures is intended to be a means by which the Registry (DIP), the Customs, and CamControl authorities can liaise and cooperate in the enforcement of marks that are crossing the border of the Kingdom of Cambodia.

- International companies will welcome a strong customs enforcement of marks crossing the border.
Use of the trademark by any person other than the owner of the mark, without the authority of the owner can amount to infringement. A person infringes a registered mark if the person uses as a mark a sign that is substantially identical with, or confusingly similar to, the mark in relation to goods or services in respect of which the trademark is registered (TM Law Art. 24).
14. Penalties

- Decisions of Ministry can be reviewed by Court(s) (Art. 62).
- Imprisonment from one to six months or fine of not more than 5 (five) million riels or both for false documents (Art.63).
- Imprisonment from 1 (one) to 5 (five) years or fine of from 1 (one) to 20 (twenty) million riels or both for infringement acts (Art.64).
- Counterfeit goods shall be confiscated and/or destroyed, whether or not anyone has been convicted of the offence (Art.69).
www.cambodiaiap.gov.kh
simsokheng@gmail.com