



JPO/WIPO/MOC National Workshop  
on  
Effective Utilization of the Madrid System for  
Trademark Agents and Specialists

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# Issues and Perspective on Trademark Systems in Cambodia and ASEAN Regions From Offices 'Point of View

- I. OVERVIEW OF TRADEMARK SYSTEM IN CAMBODIA
- II. ISSUES TO BE CONSIDERED IN INTERNATIONAL TRADE
- III. PERSPECTIVE OF TRADEMARK SYSTEM IN CAMBODIA & ASEAN REGION

# OVERVIEW

## Trademark System in Cambodia

- Existing IP System
- Laws & Regulations
- Membership & International Cooperation

# Existing IP System

- Department of Intellectual Property of Ministry of Commerce is a designated responsible agency of the Government of Cambodia solely in charge of the administration of Trademark Registration in the country
- National Committee for Intellectual Property Rights (NCIPR)
- Search, examination, registration, Publication for dissemination of Trademark related information
- Handling the cases related to the infringement of trademark
- Organizing IP related meetings, seminars in cooperation with various Int. and national organization

# SOURCE OF LAWS & REGULATIONS

- Law on Marks, Trade Name and Acts of Unfair Competition, 07th February 2002,
- Law on Geographical Indications, 2014
- Sub-Decree on the Implementation of the Law Concerning Marks, Trade Names and Acts of Unfair Competition, 12th July 2006
- Sub-Decree on the Establishment of National Committee for Intellectual Property Rights (NCIPR)-14 Ministries involved

# Ministerial Declarations

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- Ministerial Declaration on Legal IP Attorney, 1<sup>st</sup> February 2011
    - Ministerial Declaration on Madrid Protocol
    - Ministerial Declaration on GI
    - Ministerial Declaration on Certification Mark
    - Ministerial Declaration on Trademark Manual
    - Ministerial Declaration on the correction of Common Fee Service
    - Ministerial Declaration on Exclusive Right

# MEMBERSHIP & INTERNATIONAL COOPERATION

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- WIPO : July 25, 1995
- Paris Convention: September 22, 1998
- WTO/TRIPS :October 13, 2004
- Madrid Agreement: June 05<sup>th</sup> , 2015
- Trade Related & IPR Protection Agreement Cambodia-USA: Oct. 04, 1996
- MOU Cambodia-Thailand: March 05, 1997
- ASEAN Frame Work Agreement on IP Cooperation: April 30, 1999
- EC-ASEAN Intellectual Property Right Program (ECAPII/ECAP III): February, 2003
- ASEAN-China IP Cooperation in 2009
- ASEAN-Australia NZ FTA in 2010
- Cambodia- China on IP Cooperation in 2011
- ASEAN-Japan IP Cooperation in 2012
- ASEAN-EU IP Cooperation in 2014
- Cambodia-Japan on IP Cooperation in 2014

# Trademark Issues to be considered in International Trade

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- Trademark Rights are Territorial
- Freedom to Operate
- Respect Deadlines
- Working with Partners
- Select appropriate Trademark



# Trademark Rights are Territorial

- Obtain TM Rights
  - + National/Regional/ International Route
- Apply in each country,
- OHIM, Office of Harmonization of the internal Market (Trademark and Design)
- EPO, European Patent Office
- WIPO, World Intellectual Property Organization, Madrid Protocol

# Secure Freedom to Operate

- Analyzing & evaluate in any way infringing trademark of other
- An evaluation by conducting a search in trademark database
- Must search National or regional offices before filling
  - + the particular trademark in question is not protected in the territories of interest
  - + same or confusing similar trademark may already exist in the export market
- Same issues nationally as for international
  - + Search for similar trade name or domain name that may lead to a future dispute

# Respect Deadlines

- Priority Period (Art. 6 of TM Law )
  - + Right of Priority shall be claimed of an earlier national or regional application
  - + The filing in Cambodia was made within six months following the first filing
  - + The benefit of International Application
  - + A filing has been lapsed
- For example TM 1 was filed in Cambodia on 05 Jan 2016, the applicant has 6 months from that date to claim the priority of that application in another national application filed in another country or in a Madrid application filed in Cambodia as office of origin or in another Madrid member country.

# Working with Partners

- Ownership of Trademark
  - + Crucial to provide Exclusive Rights
  - + Access new markets
- Create problems if registered in a Partners name
- Create differentiation and add value
  - + Assignments/licenses for ownership
  - + quality sustain brand image



# Choosing Appropriate Trademark

- Suitability of Trademarks
  - + Check mark before apply
  - + Example: “PAJERO” means “wanker” in Spanish
  - + “Ford NOVA” means “no go in Spanish”
  - + “CocaCola” means “happiness in the mouth”

# PERSPECTIVES on TRADEMARK Systems in CAMBODIA

- Future Directions of Trademark System
- Improvement of Trademark System



# Future Direction Trademark System in Cambodia

- **Strategy:** To change into full automation system
- Development and expansion of IT automation and modernization schemes, including e-filing for trademark
- Cooperate in the exchange of statistical data regarding trademark
- Data to be integrated into the online information and classification systems, TMview and TMclass

# Future Direction Trademark System in Cambodia

- Focus on awareness program for entrepreneur with the participation of private attorney
  - + to raise the level of awareness and interest/ knowledge about IP issue
  - +Capacity building to develop more IP practitioners
- Support for Private Sector
  - + Protecting consumers in the marketplace
  - + Encouraging merchants to develop their trade market
- Accession on endeavor basis to other IP treaties and instruments such as Singapore Treaty on the Law of Trademarks (STLT).



# Improvement of the National Trademark Registration Process

- Harmonization of National Laws and Regulations
- Improve their operation-reduction of average turnaround time
- Publicized how trademark application contribute to national development and build up public awareness
- Better workload management in Office
- Maintain and improve the quality of work on trademark and to look beyond including the protection of Trade Secrets and know how to facilitate the adoption and use of a given technology
- Develop and manage the electric journal of IP registration on the website of our center
- Improve protection of IP achievement through increase registration of TM rights



# PERSPECTIVES on TRADEMARK Systems in ASEAN REGION

# Perspective on Trademark System in ASEAN Region

## ➤ ASEAN Common Form For Trademark Application:

- + aims to facilitate the completion of the ASEAN Trademark Common Filling Form for national applications
- + The online form is available at [www.aeanip.org](http://www.aeanip.org)
- + The form is available in English, Khmer, Bahasa Indonesia, Lao, Myanmar, Thai, and Vietnamese

## ➤ Common Guidelines on Substantive Examination:

- + The Common Guidelines on Substantive Examination was endorsed by the 45<sup>th</sup> AWGIPC Meeting in November 2014
- + The Common Guidelines are considered in some AMS as being complementary to the national guidelines. It were found to be beneficial as a reference or guide in the examination process in some AMS.

# Perspective on Trademark System in ASEAN Region

- Diagnostics for trademarks in order to ascertain issues and the extent of their impact on delivery of IP services.
- Assessment on harmonizing formality requirements for trademarks including a feasibility study for an ASEAN Trademark System.
- Development of online filing for trademarks including automated systems for electronic correspondence.

# Perspective on Trademark System in ASEAN Region

- Implementation of the Regional Classification of Goods & Services
- Exchange best practices and experiences on ISO certification for the IP Office
- Streamline of the trademark workload to reduce pendency periods in the ASEAN Region
- Continue to assist in ASEAN Region to accede to the Protocol relating to Madrid Agreement Concerning the International Registration of Marks



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