



Patent Law in Cambodia

February 2010

A No 64, St 111
PO Box 172
Phnom Penh
Cambodia

T +855 23 217 510
+855 23 212 740

F +855 23 212 840

E info@bnglegal.com

W www.bnglegal.com

INTRODUCTION

Cambodia's Law on Patents, Utility Models and Industrial Designs provides a set of exclusive rights to an inventor or his assignee for a fixed period of time in exchange for disclosure of an invention, utility model or industrial design. Enacted in 2003 to comply with Cambodia's WTO obligations, the Law was supplemented in 2006 by a decree detailing procedures.¹ Although the Law is relatively new and untested, it specifically provides that any international IP treaty to which Cambodia is a party², will trump the national legislation in case of conflict. While Cambodia is not a party to the Patent Cooperation Treaty, the Law provides a procedure for registering foreign applications in Cambodia.

This guide couples a synthesis of the legal provisions with practical advice and interpretation. While all the major topics are discussed, the reader should consult the text of the law itself, or ideally an experienced patent attorney, before relying on this guide for legal advice.

PATENTABLE SUBJECT MATTER

Patents may be granted only for certain types of inventions. The Law defines an invention as "an idea of an inventor which permits in practice the solution to a specific problem in the field of technology"; it may relate to either a product or a process. Six types of inventions are categorically excluded from patent protection :

- Discoveries, scientific theories and mathematical methods;
- Schemes, rules or methods for doing business, performing purely mental acts or playing games;
- 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, excluding products for use in any of these methods;
- Certain pharmaceutical products (until January 1, 2016)³;
- Plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals;
- Plant varieties.⁴

The law specifies that certain types of computer processes and products are patentable:

- Process inventions which, in whole or in part, consist of steps that are performed by computer and are directed by a computer;
- Product inventions consisting of elements of a computer-implemented

1 Prakas No 706 on The Procedure to Issue Patent and Utility Model Certificate

2 Cambodia is presently a party to the Paris Convention for the Protection of Industrial Property (1883), the WIPO Convention (1967), Agreement on Trade-Related Aspects of Intellectual Property Rights (1994), and the Convention on Biological Diversity (1992).

3 According to the Declaration on Agreement on Trade-Related Aspects of Intellectual Property Rights and Public Health of the Ministerial Conference of the World Trade Organization dated November 14, 2001 in Doha, Qatar; Patent Law, Art. 136; Prakas Rule 45

4 Plant varieties are protected under a separate law, Royal Kram No NS/RKM/0508/015 on Seed Management and Plant Breeder's Right

invention, including in particular:

- Machine-readable computer program codes stored on a tangible medium such as a floppy disk, computer hard drive or computer memory; and
- A general purpose computer whose novelty over the prior art arises primarily due to its combination with a specific computer program.

Patenting of software products and processes automatically waives any copyright protection in the code.

NOVELTY, INVENTIVE STEP, AND UTILITY

To be patentable, an invention must be new, involve an inventive step, and be industrially applicable.

An invention is new if it is not anticipated by prior art. Prior art consists of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the date of filing or the priority date. The only exclusion to this broad definition are disclosures made by the applicant or his predecessor in title, or an abuse by a third party (e.g. divulging the applicant's trade secret), made within twelve months of filing or the priority date.

For an invention to involve an "inventive step", it must not have been obvious to a person having ordinary skill in the art, considering the prior art.

To be industrially applicable, an invention must simply be capable of being made or used in any kind of industry. The law vaguely excludes certain inventions on public policy grounds:

- Those which the commercial exploitation in the Kingdom of Cambodia would be contrary to public order or morality,
- Harmful to human, animal, or plant life or health,
- Seriously prejudice the environment, or
- Prohibited by law.

INVENTOR'S RIGHT TO A PATENT

The right to a patent belongs to the inventor. Like most countries, Cambodia is a "first-to-file" system. Thus, where two or more persons have independently arrived at the same invention, the patent is awarded to the applicant with the earliest filing or priority date. Where two or more people have jointly made an invention, they jointly have the right to the patent. Unless otherwise agreed by contract, the employer has the right to any invention made in execution of an employment contract. Even though the employer has the right to the patent, the employee has the right to be named as the inventor on the application.

APPLICATION PROCEDURE

Patent applications are filed with the Department of Industrial Property of the Ministry of Industry, Mines, and Energy (MIME). Foreign applicants must be represented by an agent residing and practicing in Cambodia. The applicant must submit the following documents:

- **Application Form:** Including the name, address, nationality, and residence of each applicant.
- **Statement of Applicant's Right:** Where the applicant is the inventor, the

filing must include a statement to that effect. Where the applicant is not the inventor, the filing must indicate each inventor's name and address, and be accompanied by a statement justifying the applicant's right to the patent.

- **Power of Attorney:** Certified by a notary public, granting an agent the authority to act on behalf of the applicant in the registration process.
- **Business License/Certificate of Incorporation:** A certified copy of the applicant's business license or certificate of incorporation, if the applicant is a legal entity;
- **Foreign Filing Information:** Information regarding any previous international registration of the patent, and evidence setting out such registration (including all registration numbers and priority claim/first use dates).

For 2010, subject to change without notice, the official fees are as follows:

Patent Registration - Official Fees (US\$)	
Application (1-10 claims)	\$170
Each claim in excess of 10	\$5/claim
First publication (18 months from filing)	\$30
Second publication (36 months from filing)	\$30
Issuance of the patent certificate of registration	\$150
Change of ownership or licensee	\$60
Official Translation – English to Khmer	\$19/page

As provided for in the Paris Convention, the application may claim priority based on an earlier national, regional, or international application. If priority is claimed, the Registrar may request the applicant to furnish a certified copy of the earlier application. Further, the Registrar may request the applicant to submit any search or examination reports relating to the foreign application, a copy of the granted foreign patent, or foreign office action.

The application must contain a request, a description of the invention, one or more claims, drawings, and an abstract. The written description must 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 must indicate the best mode known to the applicant for carrying out the invention. Claims must be clear and concise, and fully supported by the description. If necessary to understand the invention, drawings must be provided. The abstract merely provides technical information, it does not affect the scope of protection.

Any decision of the Registrar, such as the refusal to grant a patent, may be appealed to the competent court within three months of the decision.

RIGHTS CONFERRED BY A PATENT

The owner of a product patent has the right to exclude others from making, importing, selling, offering for sale, and using the product, and from stocking the product for the purpose of sale or use. As for process patents, the owner has the right to prevent others from using the process and from doing any of the acts covered by a product patent where the product is obtained directly by means of the process. The patent owner may institute court proceedings against anyone who performs such acts, or who makes such acts more likely to occur.

The law provides for four affirmative defenses to an infringement claim:

- The patent owner has consented to the allegedly infringing act;
- The articles were used on aircraft, land vehicles, or vessels of other countries temporarily or accidentally entering Cambodian airspace, territory, or waters;
- The acts were done for experimental purposes; and
- The acts were performed by someone who in good faith, before the filing or priority date, was using the invention or was making effective and serious preparations for such use.

GOVERNMENT EXPLOITATION

The Ministry has the right to allow a government agency or third party to exploit the invention on public interest grounds (national security, nutrition, health, or development) or where a court has determined that the patent owner or licensee has acted anti-competitively. Such a non-voluntary license may only be made after a hearing, and with adequate compensation to the patent owner. The patent owner is allowed to request modification or termination of such a license, and can appeal to the competent court.

NON-VOLUNTARY LICENSES

Patent owners who delay in exploiting their inventions risk having the government grant others licenses without their permission. Four years from filing, or three years from issuance, whichever comes later, anyone may request the Ministry to issue them a non-voluntary license. The request will be granted where the Ministry is satisfied that the patented invention has been insufficiently exploited in Cambodia, except if the owner can show this was justified.

The Ministry must fix the license's scope and function, time limit for the licensee to begin exploitation, and compensation to the patent owner. Where a non-voluntary license has been issued on a patent involving an important technical advance of considerable economic importance over an earlier patent, the law provides a process for issuance of a non-voluntary license on the earlier patent too. Finally, the rules for the modification, termination, and appeal of government exploitation licenses, also apply to non-voluntary licenses.

INVALIDATION

Any interested party may request a court to invalidate a patent after its issuance. The following are the sole grounds for invalidation:

- The invention does not permit in practice the solution to a specific problem in the field of technology;
- The invention is not, or does not relate to, a product or a process;
- Improper subject matter;
- Lack of novelty, inventive step, or industrial application;
- The invention is against public policy;
- Insufficient written description or best mode;
- Unclear, verbose, or unsupported claims;

- Lack of drawings necessary to understand the invention;
- The owner of the patent is not the inventor or his successor in title.

ASSIGNMENTS & LICENSES

Both registered patents and applications may be freely assigned and licensed. All changes in ownership (assignments) must be in writing and must be recorded by the Registrar. Unless recorded, assigned patents are unenforceable against third parties. License contracts, whether oral or written, also need to be registered in order to be enforceable. The Registrar will publish a reference to the recordation, while keeping the license terms confidential.

DURATION AND ANNUAL MAINTENANCE FEES

The term of a patent is twenty years from the application's filing date. Although the Law states that payment of an annual maintenance fee begins one year from filing, in practice the Registrar requires payment beginning in the fifth year. A six-month grace period is allowed for the late payment of the annual fee, with an additional surcharge. Failure to pay the annual fee results in the withdrawal of the patent application, or lapse of the granted patent.

For 2010, subject to change without notice, the official fees are as follows:

Patent Annual Maintenance Fees (US\$)	
5th Year	\$120
6th Year	\$160
7th Year	\$200
8th Year	\$240
9th Year	\$280
10th Year	\$320
11th Year	\$370
12th Year	\$420
13th Year	\$470
14th Year	\$520
15th Year	\$570
16th Year	\$630
17th Year	\$690
18th Year	\$760
19th Year	\$830
20th Year	\$910

INFRINGEMENT AND CRIMINAL PENALTIES

A civil infringement suit may be brought by both the patent owner or by a licensee, following an unsuccessful request to the owner to do so. The court has wide discretion to award monetary damages and order injunctive relief. Further, the Law provides for criminal penalties for infringement of five million to twenty million Riels (approximately US\$1,250 to US\$5,000), or one to five years imprisonment, or both. Repeat offenders are subject to up to double the fine and imprisonment term.