

**KINGDOM OF CAMBODIA
NATION RELIGION KING**

**Ministry of Commerce
No.368, MOC/ KSB.BrK**

**Ministerial Regulation (Prakas)
on
Implementing the Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks**

**Senior Minister
Minister of Commerce**

- Having seen the Constitution of the Kingdom of Cambodia;
- Having seen the Royal Decree No. NS/RKT/0913/903 dated September 24, 2013 on the Appointment of the Royal Government of Cambodia;
- Having seen the Royal Kram No.02/NS/94 dated July 20, 1994 promulgating the law on the Organization and Functioning of the Council of Ministers;
- Having seen the Royal Kram No. NS/RKM/0196/16 dated January 24, 1996 promulgating the Law on the establishment of the Ministry of Commerce;
- Having seen the Royal Kram No. NS/RKM/0202/006 dated February 07, 2002 promulgating the Law Concerning Marks, Trade Names and Acts of Unfair Competition;
- Having seen the Sub-Decree N0.131 RNKR.BK dated March 19, 2014 on the Organization and Functioning of the Ministry of Commerce;
- Having seen the Sub-Degree N0.64 RNK.BK dated July 12, 2006 on the Implementation of the Law Concerning Marks, Trade Names and Acts of Unfair Competition;
- Having seen the Instrument of Accession of the Government of the Kingdom of Cambodia to the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (Madrid Protocol) that was signed by Samdech Akka Moha Sena Padei Techo **Hun Sen**, Prime Minister of Cambodia on 15 January 2015 and deposited with the World Intellectual Property Organization on 05 March 2015;
- Pursuant to the necessity of the Ministry of Commerce.

Hereby Decides

**Chapter I
General Provisions**

Article 1: *Objective and Purpose*

The objective of this Ministerial Regulation (Prakas) is to implement Madrid Protocol and promulgate the legal procedures for the protection and registration of marks through the Madrid Protocol.

Article 2: Definition of Terms

For the purpose of this Prakas, the following terms are defined as follows:

(1) “Madrid Protocol” means the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*, adopted in Madrid, Spain on June 27, 1989; ^[L]_[SEP]

(2) “Common Regulations” refers to the Common Regulations under the Madrid Agreement ¹ and Madrid Protocol promulgated by the World Intellectual Property Organization (WIPO);

(3) “Contracting Party” refers to any country or intergovernmental organization that is a party to the Madrid Protocol or any country party to both the Madrid Agreement and the Madrid Protocol;

(4) “DIPR” means the Department of Intellectual Property Rights, Ministry of Commerce, and shall pertain to its relevant bureaus when reference is made to the processing of international applications and international registrations under the Madrid Protocol;

(5) “International application” means an application to obtain registration of a mark under the Madrid Protocol and filed through DIPR as the Office of origin; ^[L]_[SEP]

(6) “International registration” means a trademark registration effected under the Madrid Protocol designating Cambodia and processed by DIPR as Designated Contracting Party;

(7) “Applicant” refers to the natural person or legal entity in whose name the international application is filed;

(8) “Holder” refers to the natural person or legal entity in whose name the international registration is recorded in the International Register;

(9) “Subsequent designation” means the extension of protection of a mark in Cambodia or in any designated contracting party that is made subsequently to or after the original international registration;

(10) “Law on Marks” refers to the *Law Concerning Marks, Trade Names and Acts of Unfair Competition* which was promulgated on 07 February 2002; ^[L]_[SEP]

(11) “Sub-Decree on Marks” refers to *Sub Decree No. 46 dated 12 July 2006 on Implementation the Law concerning Marks, Trade Names and Acts of Unfair Competition*;

¹ Madrid Agreement means the *Madrid Agreement Concerning the International Registration of Marks* of April 14, 1891, as revised in Stockholm on July 14, 1967, and amended on September 28, 1979. The Government of the Kingdom of Cambodia is not a party to the Madrid Agreement.

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(12) “International Bureau” refers to the International Bureau of the World Intellectual Property Organization (WIPO); []
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(13) “International Register” pertains to the official collection of data concerning international registrations of marks maintained by the International Bureau; []
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(14) “Basic application” means an application for the registration of a mark, filed with DIPR, and which is used as the basis for the filing of an international application under the Madrid Protocol;

(15) “Basic registration” means a mark registered with DIPR under its Law on Marks, and which is used as the basis for the filing of an international application under the Madrid Protocol; []
[SEP]

(16) “Official Gazette” refers to the publication issued and maintained by DIPR concerning marks registered in Cambodia; []
[SEP]

(17) “Office of origin” means the intellectual property office of the Contracting Party where the international application originates; []
[SEP]

(18) “Designated Contracting Party” is the contracting party to the Madrid Protocol that is designated in the international application or in the subsequent designation. []
[SEP]

Article 3: Scope and Application the Common Regulations and the Prakas on Madrid Protocol

The relevant provisions the Common Regulations pertaining to Madrid Protocol are hereby adopted and applied together with the Prakas on Madrid Protocol. This Prakas applies to the processing of international applications filed through the DIPR as Office of Origin and international registrations in which Cambodia is a Designated Contracting Party.

Article 4: Language

International applications and any communication for transmission to the International Bureau through the DIPR shall be in English. All other documents required to be submitted by the applicant directly to the DIPR may be either in English or in Khmer language.

Article 5: Entitlement to file an international application

Any individual or legal entity in whose name an application was filed or a mark is registered with DIPR may file an international application, provided that the individual or entity–

- (1) is a national of Cambodia; or
- (2) is domiciled in Cambodia; or
- (3) has a real and effective industrial or commercial establishment in Cambodia.

Chapter II

International Applications Originating from Cambodia

Article 6: Requirements for Filing an International Application

The following minimum requirements shall be contained in the international application form:

- (1) Name, address and contact details of the applicant as well as the name, address and contact details of his representative, if any; ^[1]_[SEP]
- (2) Designated Contracting Parties; ^[1]_[SEP]
- (3) Reproduction of the mark following the requirements in the international application form; and ^[1]_[SEP]
- (4) Indication of the goods and services for which registration of the mark is sought.

Article 7: Handling Fee

Upon filing of the international application form, a non-refundable handling fee shall be paid according to Join Prakas of Ministry of Economy and Finance and Ministry of Commerce.

Article 8: Examination of International Applications

Where an international application is filed with the DIPR, the DIPR shall verify that the DIPR may be considered as the Office of Origin in respect of that application, and that the relevant particulars appearing in the international application correspond to those appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

Article 9: Certification

- (1) Where the international application complies with the prescribed requirements, the DIPR shall so certify in the international application, indicating also the date on which the international application was received, and shall forward the international application to the International Bureau. ^[1]_[SEP]
- (2) Where the international application does not meet the prescribed requirements, the DIPR shall not forward it to the International Bureau, and shall inform the applicant accordingly.

Article 10: Ceasing of Effect of the Basic Application or Basic Registration

Where, in accordance with Article 6 of the Madrid Protocol, the basic application, the registration resulting from such application, or the basic registration, ceases to have effect in Cambodia, the DIPR, as the Office of Origin, shall inform the International Bureau accordingly, and shall request the cancellation of the international registration in respect of the goods and services affected.

Chapter 3

International Registrations Designating Cambodia

Article 11: Examination and Scope of Protection of Marks in Cambodia

Where Cambodia has been designated in an international registration, the DIPR shall conduct the substantive examination of marks according to the Law on Marks and the Sub-Decree on Marks. Where the DIPR, upon completion of the substantive examination, has granted protection to the mark, the mark shall be published in the Official Gazette. Post-grant opposition proceedings shall be governed by the Law on Marks and the Sub-Decree on Marks.

Article 12: Ex-Officio Provisional Refusal of Protection

Where the DIPR finds that, in accordance with the Law on Marks and the Sub-Decree on Marks, the mark that is the subject of an international registration designating Cambodia cannot be protected, the DIPR shall, before the expiry of the refusal period under Article 5(2)(b) of the Madrid Protocol, notify the International Bureau of a provisional refusal of protection following the requirements of the Madrid Protocol and the Common Regulations. The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the DIPR.

Article 13: Provisional Refusal based on an Opposition

Where an opposition is filed with the DIPR in respect of an international registration designating Cambodia, the DIPR shall, before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, notify that fact to the International Bureau as a provisional refusal based on an opposition, in accordance with the provisions of the Madrid Protocol and the Common Regulations. The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the DIPR.

Article 14: No Grounds for Refusal; Statement of Grant of Protection

Where all procedures before the DIPR have been completed and there is no ground for the DIPR to refuse protection, the DIPR shall, as soon as possible and before the expiry of the refusal period under Article 5(2)(b) of the Madrid Protocol, send to the International Bureau a statement to the effect that protection is granted to the mark in Cambodia.

Article 15: Final Decision Following the Notification of a Provisional Refusal

(1) *Statement of Grant of Protection.* Where the DIPR has notified to the International Bureau a provisional refusal of protection in accordance with either Article 14 or 15, with all the procedures before the DIPR having been completed and such provisional refusal has been either totally or partially withdrawn, the DIPR shall send to the International Bureau either

(a) a statement to the effect that the provisional refusal is withdrawn, and that protection of the mark is granted in Cambodia for all the goods and services for which protection has been requested; or

(b) a statement to the effect that the provisional refusal is partially withdrawn, and that protection of the mark is granted in the Cambodia for some of the goods and services for which protection has been requested, and specifying therein the goods and services for which protection is granted.

(2) *Confirmation of Total Refusal.* Where the DIPR has sent to the International Bureau a notification of total provisional refusal in accordance with Articles 15 or 16, with all the procedures before the DIPR having been completed, and the DIPR has decided to confirm such total refusal of protection of the mark in Cambodia for all the goods and services, the DIPR shall send to the International Bureau a statement to that effect.

Article 16: *Further Decision Affecting Protection of a Mark*

Where, following the sending of a statement in accordance with paragraphs (1) or (2) of Article 15, there is a further decision which affects the protection of a mark in Cambodia, the DIPR shall to the extent that the DIPR is aware of that decision or as soon as it is informed of such decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in Cambodia.

Article 17: *Effects of an International Registration*

(1) An international registration designating Cambodia shall have the same effect, from the date of the international registration, as if an application for the registration of the mark had been filed directly with the DIPR under the Law on Marks and the Sub-Decree on Marks.

(2) If no refusal is notified by the DIPR to the International Bureau in accordance with the Madrid Protocol and the Common Regulations, or if a refusal has been so notified but has been subsequently withdrawn, or if a statement of grant of protection is sent by the DIPR, the protection of the mark in Cambodia shall be the same as if the mark had been registered directly by the DIPR on the date of the international registration.

Article 18: *Collective Marks*

Where an international registration designating Cambodia is a collective mark, the holder shall submit a certified copy of the regulations governing the use of the mark, to the DIPR. Failure to submit the regulations shall be a ground to refuse protection of the collective mark. The provisions on collective marks in the Law on Marks and the Sub-Decree on Marks shall apply accordingly.

Article 19: *Invalidation*

Where the effects of an international registration are invalidated in Cambodia, and the invalidation is no longer subject to appeal, the DIPR shall, as soon as it is informed of that decision, notify accordingly the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations.

Article 20: *Recordings in the International Register*

Any recording made in the International Register in respect of an international registration, shall, to the extent that it applies to Cambodia as a Designated Contracting Party, have the same effect as if it had been recorded by the DIPR in its register of marks.

Article 21: *License Contracts*

Where Cambodia is designated as a Contracting Party in an International Registration and a license in respect of such registration is recorded by the International Bureau, such recording shall have no effect in Cambodia. The holder must comply with the provisions on the recording of license contracts stipulated in the Law on Marks and the Sub-Decree on Marks and shall pay the required fees directly to DIPR.

Article 22: *Affidavit of Use or Non-Use*

- (1) All holders of international registrations designating Cambodia shall file, directly with the DIPR, an Affidavit of Use or Non-Use within one (1) year from the fifth anniversary of the date of the international registration or the date of the subsequent designation extending protection of the international registration to Cambodia or the date of renewal of the international registration. The holder must use the prescribed form and comply with the requirements under the Law on Marks and the Sub-Decree on Marks.
- (2) In the event that the holder fails to submit the Affidavit of Use within the prescribed period, the mark will no longer be protected in Cambodia and the DIPR shall inform the holder and the International Bureau accordingly.

Article 23: *Replacement*

- (1) (a) The holder of an international registration may request the DIPR to take note of that international registration in the register where
 - (i) a mark registered in Cambodia is also the subject of an international registration, and the protection resulting therefrom extends to Cambodia; and
 - (ii) the same person is recorded as holder of the registration in Cambodia and of the international registration; and
 - (iii) all the goods and services listed in the registration in Cambodia are also listed in the international registration in respect of Cambodia; and
 - (iv) the extension of that international registration to Cambodia took effect after the date of registration of the mark in Cambodia.

(b) The request for replacement filed with DIPR in accordance with paragraph (a), shall be made in the prescribed form and shall be subject to the payment of the prescribed fee.

(c) The replacement of the national registration by the international registration is without prejudice to any rights acquired by virtue of the earlier national registration.

(2) Where the DIPR has taken note of an international registration in accordance with paragraph (1)(a), the DIPR shall notify the International Bureau accordingly. Such notification shall indicate the following:

(a) the number of the international registration;

(b) where only some of the goods and services listed in the international registration are concerned, those goods and services;

(c) the filing date and number of the application for registration of the mark in Cambodia;

(d) the registration date and number of the registration in Cambodia; and

(e) the priority date, if any, of the registration in Cambodia.

Article 24: Transformation

(1) (a) Where an international registration designating Cambodia is cancelled at the request of the Office of Origin, in accordance with Article 6(4) of the Madrid Protocol, in respect of all or some of the goods and services listed in the international registration, an application may be made to the DIPR, within three months from the date on which the international registration was cancelled, by the person who was the holder of the international registration at the date of its cancellation, for registration of the same mark (“an application resulting from transformation”), in respect of goods and services covered by the list of goods and services contained in the international registration for which protection has been requested in Cambodia.

(b) Subject to paragraphs (2) and (3), the provisions applicable to a trademark application filed directly with the DIPR shall apply *mutatis mutandis* to an application resulting from transformation.

(2) (a) An application resulting from transformation shall be made in the prescribed form and shall, in addition, include the following:

(i) a statement that the application is made by way of transformation;

(ii) the international registration number of the international registration which has been cancelled;

(iii) the date of such international registration, or the date of recording of the territorial extension made subsequently to the international registration, as appropriate;

(iv) the date on which the cancellation of the international registration was recorded; and

(v) where applicable, the date of any priority claimed in the international application and recorded in the International Register;

(b) An application resulting from transformation shall be subject to the payment of the prescribed transformation fee.

(3) (a) Where a mark that is the subject of an international registration has become protected in Cambodia on or before the date on which the international registration was cancelled and, provided that all the requirements relating to an application resulting from transformation have been met, that mark shall be registered by the DIPR without need to undergo another substantive examination. The date of registration shall be the date of the cancelled international registration, or the date of recording of the territorial extension to Cambodia made subsequently to the international registration, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.

(b) Where a mark that is the subject of an international registration has not yet become protected in Cambodia on or before the date on which the international registration was cancelled, any procedures or measures already undertaken on or before the date on which an application resulting from transformation is filed for the purpose of the international registration shall be considered as having been undertaken for the purposes of the application resulting from transformation. The filing date of the application resulting from transformation shall be the date of the international registration or the date of recording of the territorial extension to Cambodia made subsequently to the international registration, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.

Chapter 4 Final Provisions


Article 25: Conflict between the provisions

In the event of conflict between the provisions of the Madrid Protocol and its Common Regulations and the Law on Marks (Article 60), the Sub-Decree on Marks, and this Prakas on Madrid Protocol, the provisions of Madrid Protocol and the Common Regulations shall prevail, except as concerns the substantive aspects of the registration of marks.

Article 26: Effective date of this Ministerial Regulation (Prakas)

Director of Cabinet, Director General, Inspector General, Director of Department of Intellectual Property and all Directors of Departments under the Ministry of Commerce shall effectively implement this Ministerial Regulation from the date of its effectively on 05 June 2015. [L]
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Senior Minister
Minister of Commerce 

[Signature and Seal] 

Sun Chanthol

CC :

- Office of the Council of Ministers
- Cabinet of Prime Minister
- Relevant Ministries-Institutions
- Municipality and all Provinces
- Document – Archive.