

Validating Chinese patents in Cambodia: Understand clearly when to pay maintenance fees to avoid losing patent rights

Patent validation, based on the Memorandum of Understanding on the registration of patents signed between China National Intellectual Property Administration (**CNIPA**) of China and Ministry of Industry, Science, Technology & Innovation (**MISTI**) of Cambodia, refers to the process by which a Chinese patent application, once granted, can also be recognized and enforced in Cambodia. Validation significantly benefits patent holders by allowing them to extend their patent protection to Cambodia without having to go through the entire patent application process again in the country.

KENFOX IP & Law Office would like to provide below considerations to help patent owners avoid risks of losing their patent rights resulting from false understanding of Cambodian patent law, especially the rules about paying maintenance fees to keep patents valid in Cambodia, especially for those patents protected through the "validation" procedure

1. Paying Annuities: Why must unvalidated patents still pay the annuity?

Not a few Chinese patent owners feel confused and concerned when they need to pay fees to maintain the validity of their patents in Cambodia, even though that patent has not been officially recognized by MISTI.

However, paying patent maintenance fees is codified in [Cambodian legal documents](#). Specifically, on November 14, 2023, MISTI issued Joint Prakas No. 837, setting out regulations on the application of penalties for late payment of annual maintenance fees for patents, utility solutions, plant varieties and industrial designs. Accordingly, for each day of late payment within a period of 06 months, there will be a fine of 500 riel. This measure is intended to encourage timely payment of fees for maintaining patents, utility models, industrial designs and plant varieties, with a grace period of six months.

However, the annuity payment for patent is codified in the sub-law document of Cambodia. In detail, on November 14, 2023, MISTI issued Joint Prakas No. 837 which regulates an annuity late attendance penalty fee for patent, utility model, plant variety, and industrial design for six (06) months late payment by charging 500 riel per day. If the annuity is not paid before the end of the grace period, the patent application will be considered withdrawn and invalid. However, the patent owner still has the right to request restoration of his application at any time during the remaining term of the patent (20 years counted from the original filing date). The official restoration fee is about USD25, as well as daily late fees and annuity amounts that would normally be due.

The requirement for paying annuities on an unvalidated patent, even when the validation of the patent application in Cambodia is still pending, stems from a combination of legal, procedural, and practical considerations. In detail:

Legal grounds: The MoU between SIPO and MISTI aims to simplify and facilitate the process of recognizing Chinese patents in Cambodia. However, it does not exempt patent owners from the legal requirements in Cambodia. This means that once a patent application for validation is filed in Cambodia, it enters Cambodia's jurisdiction and is subject to Cambodian laws and regulations, including those regarding annuities. To ensure that these patents are treated equitably and to maintain the integrity of Cambodia's intellectual property system, it is necessary to align with Cambodian laws. This includes adhering to the standard procedures and obligations, such as annuity payments, that apply to all patents, whether initially filed in Cambodia or entering through the validation process.

Maintenance of patent rights: Annuity fees are essentially maintenance fees required to keep a patent in force. Even during the validation process, maintaining the patent's potential rights necessitates these fees. This ensures that once the patent is validated, it enjoys uninterrupted protection from the filing date, in line with the principle of legal certainty and continuous protection for patent holders.

Administrative and practical reasons: Requiring the payment of annuities from the outset simplifies the administrative process and avoids the accumulation of unpaid fees that could complicate the finalization of the patent validation. It also discourages the filing of validation requests for patents that the holders may not be genuinely interested in maintaining, thus streamlining the process and focusing resources on patents of actual interest to their owners.

Ensuring fairness and non-discrimination: By subjecting all patents, including those pending validation, to the same annuity requirements, Cambodia ensures a level playing field. This policy treats domestic and foreign patents equally, in adherence to international principles of non-discrimination in intellectual property rights.

2. Deadline for paying annuities: When?

Under Article 46 of the Cambodia Law on Patents, Utility Model Certificates, and Industrial Designs “*In order to maintain the patent or patent application, an annual fee shall be paid in advance to MISTI for each year, starting one (1) year after the filing date of the application for grant of the patent*”. This means that the patent owner must start paying the validity maintenance fee to MISTI from the second year after the filing date the application for validation. But for which specific year of the patent's validity should the maintenance fee be paid? The example provided below will clarify the timing for these maintenance fee payments.

Example:

Let's assume a patent application was filed in China on 15 January 2018, then, the patent was granted on 15 January 2022. After that the Chinese patent owner filed a patent validation in Cambodia in 10 January 2024.

- Annuity Payment Calculation:
- Original Filing Date in China: 15 January 2018
- Patent Grant Date in China: 15 January 2022
- Patent Validation Filing Date in Cambodia: 10 January 2024

From the above, it is seen, under Article 46 that:

- The first annual fee was due on 15 January 2019 (*one year after the original filing date*), with subsequent fees due on January 15 of each following year.
- By the time the validation is filed in Cambodia, 6 years have elapsed since the original filing date (*from 15 January 2018*). The Chinese patent owner does not need to pay the annuity from 15 January 2018 to 15 January 2024.
- Under Article 46, “*In order to maintain the patent or patent application, an annual fee shall be paid in advance to MISTI for each year, starting one (1) year **after** the filing date of the application for grant of the patent*”. The Chinese patent owner filed a validation in Cambodia on 10 January 2024 and one year after the filing date, no annuity payment is needed, meaning that the payment will start on 2025. The year 2025 marks the 8th anniversary from its original filing date on 15 January 2018. Therefore, an annuity payment for the period from 15 January 2025 to 15 January 2026 is required to maintain the patent's validity, and so on for each year the patent holder wishes to maintain their patent or application status in Cambodia.

Steps to calculate the deadline for paying the annuity:

[1] **Original filing date:** Identify the specific date the patent application was filed in China. This date is the reference point for starting the annuity payment calculations.

[2] **Anniversary date:** The annuity is payable annually, beginning from the first anniversary of the application's filing date for the patent's grant.

[3] **Patent validation in Cambodia:** Validating the [patent in Cambodia](#) does not alter the initial basis for calculating the annuities. Thus, the payment deadlines for the annuities are still determined by the original filing date.

[4] **Grace period:** A six-month grace period is provided for late annual fee payments, subject to a penalty as specified in Article 130 of the Law.

Final thoughts

Even without official validation of their patents' validity by MISTI, Chinese patent owners are required to comply with Cambodian regulations concerning the annuity payment. This compliance not only fulfills

the legal regulations of Cambodia but also guarantees that their patents are comprehensively protected and legally enforceable upon validation. One of the most critical requirements is to use the “original filing date” of your patent in China as the baseline for calculating annuity payments to be paid to MISTI.

Contact KENFOX IP & Law Office for advice on validating your patents in Cambodia. KENFOX's team, with its extensive practical experience and expertise in intellectual property law, is committed to providing you with dedicated and accurate advice, helping your patents overcome all legal barriers and ensure full protection in Cambodia.

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