

Re-Registration Of Chinese Patents In Cambodia: What Should Be Noted?

Cambodia and China entered into the Memorandum of Understanding on Bilateral Cooperation on Intellectual Property (“**MOU**”). The Cambodian Ministry of Industry and Handicrafts (“**MIH**”) adopted Prakas (Declaration) No. 080 MIH/2018 dated 27 March 2018 on the re-registration of Chinese patent in Cambodia. This MOU is valid for 5 years from the date of signing. It has been renewed recently.

This MOU aims to strengthen their partnership and promote trade and investment. It allows Chinese patent holders to efficiently secure patent protection in Cambodia, boosting innovation and technology transfer between the two nations. This streamlines the process, saving time and resources compared to traditional patent applications in Cambodia.

Under the MOU, re-registration process requires only a request and essential patent documents, eliminating complex procedures and examinations. It involves lower costs compared to a standard patent application in Cambodia, saving on application fees and associated expenses. The re-registration process ensures a faster grant of [patent rights in Cambodia](#), enabling quicker market entry and protection against infringement. Re-registered patents enjoy the same strong protection as granted Cambodian patents, safeguarding inventions and facilitating enforcement against infringers. Chinese patents granted after January 22, 2003, are eligible for re-registration, allowing for retroactive protection of existing inventions in Cambodia.

KENFOX IP & Law Office aims to provide a comprehensive guide to the key aspects of re-registering Chinese patents in Cambodia, shedding light on the legal framework, procedural requirements, and practical considerations that Chinese applicants should be aware of.

1. The required documents for re-registering a Chinese patent in Cambodia

Under Article 6 of the Prakas (Declaration) on the re-registration of Chinese patent in Cambodia, the required documents for re-registering a Chinese patent in Cambodia are:

- A copy of the certificate of grant of the Chinese patent, certified by the State Intellectual Property Office of China (“**SIPO**”).
- A copy of the specification of the granted Chinese patent, certified by SIPO, including the description, claims, abstract, and drawings (if available).
- A Khmer translation of the documents listed in the specification.
- An original notarized Power of Attorney.

The request form for re-registration must include the following specific information:

- Applicant's name, address, nationality, and residence.
- Signature of the applicant.

Other three requirements for re-registration of a Chinese patent in Cambodia include:

- The Chinese patent must have a filing date on or after 22 January 2003 (*i.e., the date on which the Law on Patent of Cambodia took effect*).
- The Chinese patent is granted and in force.
- The Chinese patent must meet the Cambodian requirements for the patent protected matters.

2. Exceptions: Not eligible for patent re-registration in Cambodia

- Per Article 136 of the Cambodian Law on Patents, Utility Models and Industrial Designs, pharmaceutical products are excluded from patent protection. Cambodia currently benefits from the World Trade Organization waiver that allows Least Developed Countries (LDCs) to avoid granting and enforcing IP rights on pharmaceutical products until the end of **2033**. This waiver would also apply to Chinese patents that provide protection for pharmaceutical products, for which [validation](#) is sought in Cambodia.
- The MOU does not cover utility models and industrial designs. The MOU only covers invention patents that have been granted and sustained by SIPO, with a date of application later than January 22, 2003.

3. Examination of re-registered Chinese patents in Cambodia

As per Article 9 of the Prakas (Declaration) on the re-registration of Chinese patent in Cambodia, the Department of Intellectual Property of Cambodia (**DIP**) processes and examines the request form in the following manner:

- **Completeness check:** The DIP first examines the request to ensure it fulfills all the requirements outlined in the declaration.
- **Correction request:** If any corrections are needed, the DIP notifies the applicant and provides them with two (02) months to file the required corrections.
- **Registration and grant:** Once the DIP confirms that all conditions are met, they proceed to register the patent and grant the patent certificate to the applicant.
- **Patent Numbering:** The registered Chinese patent is assigned a unique registration number consisting of letters, slashes, the year of receipt, and sequential digits.

It normally takes about 1,5-2,5 years from re-registration to granting a patent in Cambodia.

4. Re-registering a Chinese patent in Cambodia: When to file?

Under Article 44 of Cambodian Law on the Patents, Utility Model Certificates and Industrial Designs, if a third party in Cambodia had begun using the invention or was making serious preparations for its use in good faith **before** the filing or priority date of the Chinese re-registration patent application in Cambodia, such a third party may acquire the status of a “prior” user. In this case, such a third party would be allowed to continue using the invention even after the Chinese patent is re-registered in Cambodia, without infringing upon the Chinese patent rights. However, the third party’s use right is **limited to** the scope of his prior use and cannot be expanded beyond what he was doing before the Chinese patent's filing date in Cambodia. To avoid any risk of third parties accruing prior user rights, it is advisable to re-register Chinese patents in Cambodia as soon as possible.

Further, as provided under Articles 13 and 10 of the Prakas (Declaration) on the re-registration of Chinese Patent in Cambodia, the key date for determining whether third parties are allowed to continue their activities is the “filing date” of the Chinese patent “in Cambodia”, which is the date on which the MISTI receives all required documents and payment of the prescribed fees. In a broader sense, the timing for calculating the provisional rights for a Chinese patent holder to take actions against a third party in Cambodia who uses a technical solution (invention) allegedly infringing his patent rights is from the “filing date” of his Chinese patent in Cambodia, not the filing date of his Chinese patent in China.

Therefore, it is significant to re-register the Chinese patent at the earliest to prevent the likelihood of a third party acquiring prior user rights before the filing date of the Chinese patent in Cambodia.

5. Prior use right of a third party in Cambodia

Under Article 44(D) of the Law on Patents, Utility Model Certificates and [Industrial Designs](#), as referenced in Article 13 of the Prakas (Declaration), it is important to note that the right to obtain a Chinese patent registration in Cambodia does not apply to acts performed by any person who, in good faith, was using the invention or was making effective and serious preparations for such use, having business before the filing date on which the patent is granted in the Kingdom of Cambodia.

The prior use rights of a third party who used the technical solution (invention) in Cambodia before the filing date of the Chinese patent have the following implications:

- **Non-infringement:** The third party is not considered to be infringing the Chinese patent, even though their use of the invention may fall within the scope of the patent's claims.
- **Continued use:** The third party is entitled to continue using the invention, despite the registration of the Chinese patent in Cambodia.
- **Transfer of rights:** The third party can transfer their prior use rights to another enterprise or company, but only together with the entire enterprise or company, or a part of it, that has been using the invention.

6. Chinese patent rights terminated in Cambodia

Chinese Patent rights in Cambodia can be terminated under the following circumstances:

- Unpaid fees: If the required fees for maintaining the Chinese patent are not paid, the patent rights in Cambodia will have no effect. In other words, if the original Chinese patent is terminated due to non-payment of annuity fees, the corresponding patent in Cambodia becomes ineffective.
- Notification of expiration: The termination of patent rights will be enforced after MIH receives notification from SIPO about the expiration of the Chinese patent.
- Changes to patent documents: If there are any changes to the patent documents (description, claim, and abstract) of the Chinese patent, SIPO shall notify MIH.
- [Dispute resolution](#): In the case of any disputes, the legality of the Chinese patent registered in Cambodia must be the same as the Chinese patent after the legal settlement procedure is completed.

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