

Acceleration programmes to facilitate the granting of patent applications in Laos

Laos's patent system is at primitive stage, with Lao IP Law No. 38/NA of 2017 and Decision No. 1714/MOST of 2020 on Patents and Petty Patents. However, in recent years, Lao has built a solid reputation for itself when making efforts to accelerate patent examination for patent application in Laos.

A patent application in Laos can be accelerated in several ways as follows:

1. Accelerating patent examination by using the ASEAN Patent Examination Co-operation (ASPEC)

ASEAN Patent Examination Co-operation (ASPEC) is the first regional patent work-sharing programme among 9 (nine) participating ASEAN Member States (**AMS**) IP Offices of Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Vietnam. The purpose of this programme is to share search and examination results between the participating offices to allow applicants in participating countries to obtain corresponding patents faster and more efficiently. The programme will potentially reduce duplication on the search and examination work done, thereby saving time and effort. Additionally, search and examination work done on a corresponding application serves as a useful reference in producing quality reports.

You may consider using ASPEC if you have corresponding patent applications at any 2 participating IP Offices and one of the offices has issued an examination report indicating at least one allowable claim. The participating IP Office that issued the examination report is the "**first IP Office**". Under PCT-ASPEC, the ASEAN ISA/IPEA that issued the international preliminary examination report/written opinion is the first IP Office. The participating IP Office where the ASPEC Request Form is filed is the "**second IP Office**".

Applicants may use the search and examination ("S&E") reports of participating IP Offices to accelerate the patenting process in any one of the other participating IP Offices.

From 27 August 2019, applicants can enjoy 2 new features under ASPEC:

- **ASPEC AIM** - a committed turnaround time of 6 months to receive the first office action if an ASPEC request is made for Industry 4.0 patent applications; and
- **PCT-ASPEC** - additional choice of relying on a Patent Cooperation Treaty ("**PCT**") reports issued from an ASEAN International Searching Authority/International Preliminary Examining Authority ("**ISA/IPEA**").

As of 15 June 2021, as an alternative to the final search and examination ("**S&E**") reports, applicants may also use the written opinion (a non-final assessment of novelty, inventive step, and industrial applicability) established by the First IP Office to request ASPEC before the Second IP Office, provided that the Written Opinion acknowledges at least one allowable claim. The sole exception is the Thai IP Office, which continues to accept only final search and examination results in ASPEC requests. Applicants will no longer be required to address any objections raised by the First IP Office, wait for the final examination report to be issued, and then file an ASPEC request with the Second IP Office. Instead, they may file an earlier ASPEC request with the Second IP Office, accompanied by a Written Opinion from the First IP Office, even if not all of the claims are allowed.

A patent applicant may submit a request in Laos under the ASPEC program if:

- (i) A patent application in an AMS IP Office where the ASPEC Request Form is filed ("second IP Office") must correspond to a patent application in the other AMS IP Office ("first IP Office").
- (ii) The ASPEC Request must be accompanied by S&E documents of the corresponding application from the first IP Office.
- (iii) All claims submitted in subsequent IP Offices must conform sufficiently to allowable/patentable claims referenced in the S&E documents from the other participating patent office.

2. Accelerating patent examination by using the Cooperation for facilitating Patent Grant (CPG) between JAPAN and LAOS

CPG is a framework based on an agreement between the Japan Patent Office (JPO) and other foreign intelle

ctual property (IP) offices. In accordance with the CPG, when patent applications have been examined and granted at the JPO, patent rights will also be given to equivalent applications filed in other contracting offices without conducting substantive examinations if applicants so request.

Applicants who are rights holders of patents registered at the JPO might acquire patent rights for the identical inventions at other IP offices ratifying the CPG agreement earlier by utilizing the CPG.

In light of the foregoing, applicants who have patents granted by the Japan Patent Office (JPO) can request accelerated decisions on patents in Laos with the Department of Intellectual Property (DIP), Ministry of Science and Technology (from 28 April 2021, it has been renamed to MOIC – Ministry of Industry and Commerce), under the CPG of Laos-related patent applications that use examination results of patent applications filed with JPO.

Requirements for Making Requests (Eligibility Requirements):

- (a) Both the DIP patent application on which the CPG is requested and the Japanese patent application (hereinafter referred to as “the corresponding JPO patent application”) forming the basis of the CPG request shall have the same earliest date with a priority date or a filing date;
- (b) The corresponding JPO patent application has been granted by the JPO;
- (c) All the claims in the DIP patent application requesting accelerated patent decision based on the CPG have been amended as required, so that the claims are the same as one or more claims in the corresponding JPO patent application granted by the JPO.

Required documents:

The following documents (a) to (c) must be submitted when requesting the CPG:

- (a) Power of Attorney duly signed by Applicant and then notarized;
- (b) A copy of Certificate of patent by the JPO;
- (c) A translation of Claims and Specification described in the patent gazette in English and in Lao (Applicants must submit a translation in Lao within three (3) months of the date on which the request was filed for the CPG);
- (d) Amendment of the claims.

In the case where DIP patent application requesting accelerated patent decision based on the CPG does not meet item (c) of paragraph 1 (“Requirements for Making Requests”), applicants must submit the amendment of the claims to meet the requirement.

3. Accelerating patent examination by using the Memorandum of Understanding (MoU) on Intellectual Property Cooperation signed between China and Laos

The purpose of the MOU signed between the China National Intellectual Property Administration (**CNIPA**) and Lao DIP is to help patent applicants who own valid Chinese patents may request accelerated decisions on patents in Laos for patent applications which they have filed with Lao DIP. Under the MoU, Lao DIP would recognize the patent examination results made by CNIPA.

Requirements for Making Requests (Eligibility Requirements):

- a. The Chinese and the Lao patent applications are related, i.e. they have the same earliest priority date (whether this be a priority date or filing date).

Note: The Chinese patent and the Lao patent application are deemed related under many circumstances. For example, the Chinese patent is a priority claimed by the Lao patent application, the Lao patent application is a priority claimed by the Chinese patent, the Chinese patent and the Lao patent application claim a same priority, the Chinese patent and the Lao patent application are different national phases of a same PCT application, etc.

- b. The claims of the Lao patent application are the same as one or more claims in the corresponding Chinese patent application granted by the CNIPA.

Note: Applicants are allowed to delete a part of the claims that were granted by the CNIPA (*The rest claims will be still considered to be "the same"*). However, a claim in the Lao patent application which introduces a new/different category of claims to those claims granted by the CNIPA is not considered as being the same.

Required documents:

The following documents must be submitted to DIP when requesting an accelerating a Chinese patent in Laos:

- (i) A request for accelerated decisions on patents;
- (ii) A copy of the patent gazette of the corresponding Chinese patent application;
- (iii) A copy of patent register of the corresponding Chinese patent;
- (iv) A translation of Claims and Specification described in the patent gazette in English and in Lao;
- (v) claims correspondence table (*if the number of the claims granted by the CNIPA is different from the number of claims in the Lao patent application due to the deletion of claims, applicants are requested to state the claims in a way that clearly shows the correspondence between the claims granted by the CNIPA and the claims in the Lao patent application*); and
- (vi) Amendment to the claims.

4. Re-register a Singapore Patent in Laos by using the Memorandum of Understanding (MoU) on Intellectual Property Cooperation signed between Singapore and Laos

Lao DIP and the Intellectual Property Office of Singapore (IPOS) have signed a Memorandum of Understanding (MOU) on IP cooperation to allow Singapore-granted patents to be re-registered in Laos. In accordance with the MoU, DIP can now grant quality patents in Laos based on the search and examination done by IPOS, and Singapore-granted patents can now be re-registered in Laos without being subjected to a local search and examination.

Requirements for Making Requests (Eligibility Requirements):

- (i) The Singapore patent must be in force at the time of lodgement of re-registration request;
- (ii) The Singapore patent must meet the Laotian requirements for patentability.

Required documents:

The following documents must be submitted to DIP if a Singapore patent owner wishes to have his patent to be re-registered in Laos:

- (i) Power of Attorney duly signed by Applicant and then notarized;
- (ii) A certified copy of the Certificate of Grant for the Singapore patent;
- (iii) A certified copy of the final specifications of the Singapore patent;
- (iv) A copy of the abstract of the Singapore patent;
- (v) A certified Lao translation of the abstract and final specification of the Singapore patent within 6 months of the lodgement date.

For more details, please visit our article at: <https://kenfoxlaw.com/guidelines-to-re-register-a-singapore-patent-in-laos>

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Contact KENFOX IP & Law Office immediately if you need a professional intellectual property services firm to assist you in developing your business in the proper direction.

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