

Important Notes on Patents and Petty patents in Laos

1. What Patents & Petty Patents in Laos?

In Laos, there exist two types of Patents, (i) Patents and (ii) Petty Patents. **Patents** are defined as the “official certificate from the state Organisation issued to protect **inventions** that are **new**, involve an **inventive step**, and are capable of **industrial application**”. Meanwhile, **petty patents** are defined as “the official certificates issued to protect **utility innovations**”.

2. Patentable Inventions and Utility Innovation In Laos

To be patentable in Laos, an invention or utility innovation must meet 03 requirements, (i) novelty (new), (ii) inventive step and (iii) industrial applicability. Meanwhile, to be patented as a Petty Patent, a utility innovation must be derived from technical improvements and involves simpler techniques than an invention in order to improve products or a new production method. In detail:

An **invention** must satisfy 3 requirements as follows to be patented in Laos:

Requirements of Novelty: The invention must not be created, published to the public through magazine or actual usage, or other forms in the Lao PDR or any place in the world before filing the application for registration or before the priority date of the patent application.

Requirements of Inventive Step: The invention must not be obvious to a person with ordinary levels of knowledge and skills in the concerned field of technology. The level of inventiveness for a petty patent is less than that required for a patent. In detail, an invention must involve increased inventive steps compared to previous invention while a utility innovation needs to have new technical improvement that involves an inventive step which has easier inventive steps than required for a patent.

Novelty assessment shall be conducted based on whether or not the information on the invention or utility innovation has been previously disclosed to other individuals or the public and needs to be based on each claim in the application.

Disclosure Exceptions (Does Laos have a grace period? If so, how does it work?)

An invention and/or utility innovation is not deemed to have lost its novelty (*i.e. it is not considered to destroy the novelty of the invention and/or utility innovation*) in Laos if the information related to the invention and/or utility innovation is communicated or sent under binding of confidentiality or under condition unintentionally made that leads to the disclosure of the information to the public, unless such a communication leads to the public disclosure. Communication to which disclosure exceptions are adopted are as follows:

- (i) Under a confidentiality agreement in writing;
- (ii) Within an organization or an enterprise of a the right holder;
- (iii) Within a family, relatives, or appointed acquaintances;
- (iv) To an attorney or a representative;
- (v) To a third party for the purpose of assignment of rights to receive supportive funds for development of the invention or utility innovation that has not been yet commercially used.

Of note, filing a patent or petty patent application in Laos or anywhere in the world shall not be considered as information disclosure until such patent application is published, reviewed or received patent or petty patent.

In light of the foregoing, Lao IP Law does not A 12-month grace period relating to patent applications like some countries, but the conditions for not being regarded to have lost the patent novelty are limited to the five stated in Article 21 of Decision No. 1714/MOST.

Requirements of Industrial Applicability: Any invention or utility innovation shall be considered industrially applicable if it can be used an industrial setting (agriculture, fishery, services, handicraft, etc.)

3. Exceptions To Patentability

The Lao Patent Law (Article 21) sets out 4 types of unpatentable inventions, in detail:

- (i) Inventions or utility innovations that are not novel, if they are discovered exists, including living organisms or parts of living organisms that exist in nature;
- (ii) Subject matter that is not an invention does not constitute a technical solution because it is merely a scientific principle or theory, a mathematical algorithm, or a set of rules for doing business or playing games, provided however, that such subject matter may constitute an element of an invention or utility innovation;
- (iii) Diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
- (iv) Plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals provided, however, that such subject matter may constitute an element of an invention or utility innovation.

A patent or petty patent shall be refused, in any case, if:

- (i) It is contrary to culture and fine traditions of the nation, social orders and morale, damage human, animal or plant life or health or cause serious prejudice to the environment;
- (ii) It is contrary to security and peace of the Lao PDR.

4. Patent or Petty Patent Application in Laos – What to contain?

A patent or petty patent application in Laos must comprise 07 documents as follows:

- (i) Application template form as provided by the Department of Intellectual Property;
- (ii) Power of Attorney, in the event that the submission is made via a representative;
- (iii) A clear and complete description that discloses the invention or utility innovation;
- (iv) A clear description for claim that clearly specifies the subject matter to be protected;
- (v) Drawings;
- (vi) Abstract;
- (vii) Receipt of official fees and service charges payment.

Of note, if the patent application and supporting documents are in English, they shall be translated into Lao language as provided under Article 37 of the Law on Intellectual Property. If such requirements are not met, the application will not be taken into consideration and be deemed to be abandoned.

The applicant to patent and petty patent rights does not need to translate parts of the application content such as name and address of individuals, legal entity or organization.

5. Minimum Requirements to Obtain the Filing Date of Receipt

You may still file a patent application in Laos, and it will be accepted, even if you do not have all the required documents, if you provide the following minimum requirements together with your patent application:

- (i) Name, address, nationality of the applicant;
- (ii) Description that discloses the invention and utility innovation in clear and complete terms;
- (iii) Power of Attorney specifying the name and address of the applicant's representative, in the event that the submission is made via a representative.
- (iv) Receipt of official fees and service charges payment.

Of note, the patent application submitted under the minimum requirements must be complete within 15 (fifteen) days from the date of notification.

6. First-To-File System

Laos employs a first-to-file system, meaning that when two or more applications are filed for the same invention, the right to the patent

7. Grant of Patent or Petty Patent Rights in Laos

If a patent application meets requirements for granting patent or petty patent in Laos, DIP shall notify the applicant thereabout, as well as notify the applicant to pay relevant fees. After all the fees are paid, DIP shall grant the patent or utility patent, and document the related information in the register and database of DIP.

8. Publication of the Patent or Petty Patent

Publications of patents in Laos has been made in two times, in detail:

First, after the patent application is accepted as to form, DIP shall publish the application in the official gazette for registration of industrial property. Per Article 12 of Decision No. 1714/MOST, the publication of a patent application in Laos will be made in the 19th (nineteenth) month from the date of filing or date of priority.

Second, after the patent or petty patent is granted, DIP will enter the registration in the registrar and publish the registration on the official industrial property gazette. If the publication contains incorrect information from the applicant or the Department of Intellectual Property, the applicant can request DIP to publish the revised information. The request shall be made within 60 (sixty) days from the first date of publication and be free of service charges. If beyond the period, DIP will not take it into consideration.

9. Patent Opposition in Laos

Entitlement: Any third party is statutorily entitled to file a Notice of Opposition to a pending patent application in Laos after such patent application is published in the official gazette for registration of industrial property in Laos.

Deadline: A Notice of Opposition must be filed with DIP within 90 (ninety) days from the publication date in the official gazette for the registration of industrial property.

Required documents: The documents shall be completed according to the form template provided by DIP and service charge paid, and the request for opposition to a patent or petty patent application shall comprise the following documents:

- (i) A Notice of Opposition to a patent or petty patent application;
- (ii) Supporting documents and evidence clarifying the opposition;
- (iii) A notarized Power of Attorney, if a Notice of Opposition is filed through an IP agent;
- (iv) Payment receipt of service charges.

Opposition handling processes: The opposition to a patent or petty patent application shall be taken into consideration as follows:

- (i) DIP shall promptly notify the applicant for a patent or petty patent of the opposition upon the receipt of a Notice of Opposition.
- (ii) The applicant shall submit his response along with information and evidence supporting its invention or utility innovation with DIP within 60 (sixty) days from the date of DIP's notification regarding the opposition;
- (iii) DIP shall also make a copy of the notification to the opponent/opposer;
- (iv) DIP shall consider the response, information and evidence submitted;
- (v) If the information and evidence of the proposer of the opposition or the applicant for patent or petty patent rights are not complete or unclear, DIP shall invite both parties to clarify or show additional evidence or information;
- (vi) DIP shall examine the opposition based on evidence in hand, if the applicant for patent or petty patent rights or the proposer of the opposition does not come to clarify or show their evidence or give more information within 60 (sixty) days from the date of the invitation;
- (vii) DIP shall notify the applicant for patent or petty patent rights or the proposer of the opposition the result of examination along with the reasons;
- (viii) DIP shall reject the patent or petty patent application if it is considered that the opposition is reasonable and has sufficient supporting evidence. Hence, DIP shall continue to consider the patent or petty patent application if it is considered that the opposition is not reasonable and does not have sufficient supporting evidence;
- (ix) If any party is not satisfactory with DIP's ruling, he/she can make request to the Committee of the Department of Intellectual Property of Final Consideration within 60 (sixty) days from the date of notification.

How can patent office decisions be appealed in Laos?

If DIP rejects an invention patent or utility innovation petty patent application, the applicant may appeal the rejection to DIP within 60 days of the office action.

will belong to the applicant who has the earliest filing or priority date.

10. Term of Protection and Maintenance of the Protection Period for Patents and Petit Patents in Laos

A patent in Laos has a protection period of 20 (twenty) years from the filing date of the application.

In order to maintain the protection period of the patent, the patent owner must pay annual advance fees and service charges. Fee for maintaining the protection period of the patent for the first 04 (four) years is included in the fee and service charge when filing a patent application.

The owner shall pay an official fee and service charge for maintaining the protection period from the 5th (fifth) year onward.

A petty patent has a protection period of 10 (ten) years from the filing date of application.

In order to maintain the protection period of the petty patent, the petty patent owner must pay annual advance fees and service charges. Fee for maintaining the protection period of the petty patent for the first year is included in the fee and service charge when filing a petty patent application.

The owner shall pay a fee and service charge for maintaining the protection period from the second year onward.

Before expiry date each year, the patent or petty patent owner can pay official fee and service charges for maintaining the advance protection period within 06 (six) months. DIP will not issue the notification to the owner to pay the official fee and service charge. DIP will only notify the owner that the patent or petty patent is expired as no advance official fee and service charge has been paid.

If the owner does not pay official fee and service charge within the given time, DIP can extend the time for 06 (six) months from the expiry date of the protection period, but the owner has to pay fines for the delay.

11. Patent assignment in Laos

The patent or petty patent owner in Laos can transfer his/her rights, partly or wholly, to individuals, legal entity or organization through entering agreements, inheritance or as gift.

If the patent or petty patent right is assigned, the assignor or the assignee must file a request for recordal of patent/petity patent assignment with DIP. If the assignee is a person who notifies the assignment, he/she shall send the document to the assignor.

Information on right transfer to publish in the Official Gazette for the registration of industrial property are as follows:

- Name and address of the assignee;
- Number of the certificate of transfer;
- Number of the Application for a Patent or Petty Patent;
- Date of the assignment.

If there is a transfer of ownership of a legal entity or an organization related to the patent or petty patent, it shall comply with the requirements set forth in the transfer document. If not otherwise specified, the transfer of such an ownership of a legal entity or an organization is considered a transfer of a total right of such a patent and petty patent of such a legal entity or organization.

Where there is a need for clarification or a doubt, DIP may notify the person, the legal entity or the organization that notifies an assignment to provide additional information and documents. An assignment will not take effect against the parties unless the parties have notified a transfer of such a right and such a right has been registered with DIP.

12. How long should an applicant expect to wait before being granted a patent and what level of cost should it budget for?

In a straightforward case, the period from filing to grant is approximately 03 (three) to 05 (five) years for an invention patent, and 02 (two) to 03 (three) years for a utility innovation petty patent.

The entire process from filing to grant may cost up to \$2,000-5,000 or more subject to various factors.

KENFOX IP & LAW OFFICE, one of the professional IP service providers with the strongest and fastest growth in patent services, offers a comprehensive range of IP services in Vietnam, Laos, Cambodia, Myanmar, and other Asian nations. KENFOX entered the list of the top ten patent filing companies at IP Vietnam in 2019. In 2020 and 2021, KENFOX ranked among Vietnam's top 20 patent filing firms. KENFOX is proud to be consistently voted "Boutique Trademark Law Firm of the Year in Vietnam" by major international organizations in 2021-2022 by Global Law Experts and "Laos IP Firm of the Year for the 2021 Asia IP Awards" by Asia IP.

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.

By **Nguyen Vu QUAN**
Partner & IP Attorney
quannv@kenfoxlaw.com

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com