

PATENT AND PETTY PATENT IN LAOS

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Legal grounds:

- (i) Lao IP Law No. 38/NA of 2017, which replaced the Law on Intellectual Property of 2011;
- (ii) Decision No. 1714/MOST of 2020 on Patents and Petty Patents.

International IP Agreements to which Laos is a Contracting Party

Laos has been a Contracting Party to the Paris Convention for the Protection of Industrial Property (**Paris Convention**) since October 8, 1998. It has also been a Contracting Party to the Patent Cooperation Treaty (PCT) since June 14, 2006.

Under the Paris Convention to which Laos is a member, patent applicants are entitled to a right of priority if the same filing has been made within **12 months** in any other other nation that is also a member of the Paris Convention. This is extremely advantageous for patent owners since, after filing the initial application in their home country, they have a year to pick which other countries they wish to register in prior to initiating international filings.

Under the PCT to which Laos is a member, foreign businesses may obtain patents in Laos quite easily as formal examinations, searches and publications are conducted at the WIPO's International Bureau. This mechanism allows for a longer period of 'wait and see' before the applicant decides which nations require a patent. Using the PCT approach, you have up to 31 months from the date of priority (see *Article 6.4 of Decision No. 1714/MOST*) to determine whether to file a patent application in Laos or other countries.

Critical notes:

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

7. Examination Of A Patent Application In Laos

An application for a patent or petit patent filed with DIP shall be subject to 2 phases of examination, i.e. formality and substantive examination.

Formality Examination of Patent Application In Laos /Formality Office Action:

It takes 60 (sixty) days for the Department of Intellectual Property of Laos (**DIP**) to complete a formality examination of a patent application in Laos. In the course of formality examination, DIP's examiner shall examine the completeness, accuracy and conformity with requirements as set forth in Article 31 of the Law on Intellectual Property. In case that the patent application is in conformity with the preliminary examination requirements, DIP shall publish the application in the official gazette for registration of industrial property, meaning that, no Notice of Formality Acceptance is issued. 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.

If the patent application is incomplete, incorrect, or not in accordance with the requirements set forth, DIP shall notify the applicant to provide documents or correct the application to meet the requirements within 60 (sixty) days from the date of notification. In case that the applicant cannot provide or correct the application within the given time limit, DIP shall notify the applicant that the application has not been considered and that the application shall be deemed abandoned.

Substantive Examination of Patent Application In Laos /Substantive Office Action:

After the formality examination, DIP will conduct a substantive examination of the patent application to determine whether it meets the requirements for patentability. The substantive examination for patents and petty patents is based on a search of existing technical knowledge.

In the case where the patent application had previously been subject to a search or examination by another authority (*in another country*), the applicant can submit a copy of that report and request that it be accepted in lieu of conducting a search in Laos.

If there are no previous examination reports (*or the applicant is otherwise unable to provide such report*), the applicant must request DIP to examine the application as to its substance. Notably, MOST is required by law to undertake this examination within 32 months for an invention (*patent*) and 12 months for a utility innovation (*petty patent*) from the filing date of the application or the priority date (*if priority is claimed*). All of DIP's expenses to examine the invention or utility innovation are charged to the applicant.

After consideration and examination of the registration for a patent and/or petty patent application in Laos, if it is considered to meet the requirements provided by the Lao's IP Law, DIP will issue a patent and/or petty patent.

Substantive examination report from foreign patent office or international IP Office on patent examination shall provide the following information:

- ✓ Be relevant to the invention or the utility innovation filed in Laos;
- ✓ Specify complete information on the search and examination;
- ✓ Specify information on approval or refusal of claims, partly or wholly, and which aspects meet or do not meet the requirements of patentability.

In the event that the applicant for patent or petty patent rights provide patent examination report that has been approved and issued with a certificate by the foreign patent office or international IP Office on patent examination, he must submit the copy of communication and modification (*if any*) that he received during the examination as well as the final decision along with reasons.

In the event that there is a modification of the rights claimed, it shall not exceed the scope of the rights claimed specified in the application. If the modification exceeds the scope of the rights claimed, the applicant for a patent or petty patent shall provide additional information on the search and examination based on the rights claimed that exceed the scope of rights claimed, or request DIP for an examination as set forth in Article 41 of the Law on Intellectual Property.

DIP shall issue a notification by specifying the reasons for refusal of the application if it is found that the application does not meet the requirements of patentability. The applicant is entitled to modify the application according to Article 24 and 27 of Decision No. 1714/MOST within 60 (sixty) days from the date of notification. If the applicant is unable to provide information or response within the given time limit, the application shall be deemed to be abandoned.

In the event that the applicant for patent or petty patent rights has provided information and responded, yet DIP has considered that the informative document or explanation provided does not meet the requirements of patentability, it shall make final rejection to the application and notify the applicant. DIP can provide an extension of thirty days, from the expiry date of the first notification if there is sufficient justification.

8. Patent opposition in Laos - What types of patent opposition procedure are available in Laos?

Laos operates a pre-grant opposition system which is available to both invention patent and utility innovation petit patent. Under Article 13 of Decision 1714/MOST, any interested party may oppose the grant of an invention (patent) or a utility innovation (petit patent) within 90 days of the application being officially published in the official gazette for the registration of industrial property.

Time-limit: You may file a Notice of Opposition to a patent or petty patent application in Laos 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. An opposition must comprise the following documents: (i) A Notice of Opposition to a patent or petty patent application; (ii) supporting documents and evidence clarifying the opposition; and (iii) Payment receipt of service charges.

Opposition proceedings: DIP will handle a Notice of Opposition to a patent/petit patent application in the following processes:

- (i) DIP shall promptly notify the applicant for a patent or petty patent of the opposition upon the receipt of the opposition request;
- (ii) The applicant shall submit his/her explanation along with information and evidence supporting its invention or utility innovation with the Department of Intellectual Property within sixty days from the date of the notification regarding the opposition request;
- (iii) DIP shall also make a copy of the notification to the proposer of the objection;
- (iv) DIP shall consider the explanation, information and evidence submitted;

- (v) In the event that 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 application for patent or petty patent rights if it is considered that the opposition is reasonable and has sufficient supporting evidence;
- (ix) DIP shall continue to examine the application for patent or petty patent rights if it is considered that the opposition is not reasonable and does not have sufficient supporting evidence;
- (x) In the event that any party does not satisfy the consideration, he/she can make a request to the Committee of the Department of Intellectual Property of Final Consideration within sixty days from the date of notification.

Apart from oppositions, are there any other ways to challenge a patent in Laos?

After the 90-day opposition period post publication, any interested party may need to wait until the grant of patent and/or petty patent to file a cancellation/invalidation action. A third-party observation is not available in Laos like some other countries.

9. What are the requirements for patent specification to be filed in Laos?

A patent specification: A patent specification must include 10 pieces of information as follows:

- (i) Subject matter of invention or utility innovation;
- (ii) Areas related to the invention or utility innovation;
- (iii) Background of the invention or utility innovation;
- (iv) Objective of the application of the invention or utility innovation;
- (v) Brief summary of the invention or utility innovation;
- (vi) Detailed description of the invention or utility innovation as set forth in Article 17 herein;
- (vii) Rights claimed as set forth in Article 18 of this Decision;
- (viii) Abstract as set forth in Article 19 of Decision No. 1714/MOST;
- (ix) Drawings as set forth in Article 20 of Decision No. 1714/MOST;
- (x) Other related documents, if any.

Subject matter of an invention or a utility innovation shall specify the type of invention or utility innovation, such as chemical components, machines, chemical products or process or combination of various types. Subject matter of invention or utility innovation shall be short, concise and descriptive.

Background of the invention or utility innovation shall describe technical problems to be solved or improved, and what currently exists, along with explanation about related technology and research that cannot be solved. Such a description shall be in conformity with the existing technology. In case the description refers to an invention or utility innovation or a patent or petty patent that has already been disclosed to the public, the information shall be specified.

Brief summary of an invention or a utility innovation shall briefly describe the type of invention or utility innovation, areas of technology and technical problems to be solved or improved.

Claims: Claims aim at identifying the legal scope of rights of the applicant towards the patent or petty patent. Therefore, claims must be carefully drafted to specifically identify only components of invention or utility innovation.

Claims shall be in conformity with the invention or utility innovation as specified in the description, terms and wordings used in the claim application shall be included in the description in order to be able to refer to the definitions of the terms and wordings in the claim and description.

Claims can be made for more than one subject matter, in which each subject matter must be different as much as possible, and adding incorrect subject matter is not allowed. The related fees, if any, have to be paid, and if the claim has more than one subject matter, the serial number is required. In the event that the claim has many components or procedures, it shall separate each component or procedure into rows by indenting to make it easy for application examination.

A claim with one or more subject matter can be made in an independent way or by referring to other claims in the same application. The independent claim means the scope of all rights of the related claims in an independent way.

In case more than one claim is made, the claim with the least scope limit shall be the first claim and shall sort independent claims into the same class.

The claim shall be presented in a more polite or request manner, such as “*I would like to make a claim*” or “*invention or utility innovation that are claimed are as follows:*” The terms used shall not be deemed as part of the claim.

Basic form for independent claim is a claim that is not related to other claims as described below:

- (i) Preface presents the subject matter that is claimed. In case the invention or utility innovation is related to improvement, the preface may contain the overall explanation that make it easy to understand all the components or procedures in the claim;
- (ii) Terms used to present the components of invention or utility innovation. For invention or utility innovation that is related to improvement, the claim may include the terms, such as “*the improvement consist of*”;
- (iii) Description of components of machines or electric appliances, steps in the process or chemical ingredients or bio-mass materials, as well as the description of relation between components. In case that the invention or utility innovation is related to improvement the claim shall specify the component, steps and relation with the claim that the applicant considers as part of the invention or utility innovation that is new or shall be improved.

Generally, one application for a patent or petty patent can have three independent claims and fifteen dependent claims. In the event the improvement or modification of the application causes additional claims which are more than the number of claims specified in the original application, the applicant shall pay the related fees for the additional claims.

The applicant for a patent or petty patent can modify the claim at any time during the application is under the consideration process.

The modification shall not be beyond the scope of information disclosure specified in the description. The claim in the original application is deemed to be a part of the information disclosure.

Abstract: The abstract shall contain technical information, but it shall not be deemed to be a part of the information disclosure or be a scope of rights to protect. Generally, the abstract relates to the claim and is for the Department of Intellectual Property and the public to understand the concept of the inventor by way of disclosure of technical information.

Drawings: The applicant for a patent or petty patent shall provide drawings when necessary to create an understanding about the invention or utility innovation. The drawings shall not have only a picture of the invention or utility innovation, or part of it, but it shall have other pictures to help the understanding of the invention or utility innovation, such as an electric design of the invention, a drawing of the chemical structure of the chemical components, graphics, or measurement of operation of the invention or utility innovation. The drawing shall draw after the principles of drawing to be used in each area.

The applicant for a patent or utility patent shall choose the drawing based on the detail of the invention or utility patent, but he/she shall provide different angles as necessary to show the detail of the invention or utility innovation. The general angles that are accepted are as follows:

- (i) Expanded view angle showing the relationship or order of the parts;
- (ii) For some areas, zooming is required to show greater details with an angle evidencing the overall design, and other angles indicating position of each part;
- (iii) Sectional views, together with an indication of the plane view, which illustrates the characteristic of the component seen in a cross section.
In the event that the application has many drawings, it shall briefly explain about the different angles of the drawings.

The detailed description of the invention or utility innovations shall be based on the different angles of the drawing by indicating the number at each point.

Generally, it shall follow the principles of drawing for each area of technology, such as symbols and components of drawing in line with common principles applied in various sectors such as chemical, electronic, mechanical and bio-technological principles.

In the event that the substance of the application relates to an improvement of the invention or utility innovation, the drawing shall show the improvement and relationship between the improvement and the existing technology.

10. Amending A Patent Application in Laos

It is statutorily possible to modify a patent application in Laos at any time during the period where the patent application is examined; however, it shall be done before approval, abandonment, final refusal or termination of the consideration of the application.

The modification must not present new technical information that has not been provided in the original application. New technical information is defined as “*the presentation of information that has not yet been disclosed in the original application for a patent or petty patent submitted*”. The information may consist of adding, scope setting or substantive modification of the description, claims or drawings that are presented in the application.

11. Dividing A Patent Application in Laos

Any application for a patent or petty patent can be divided into two or more applications at any time by submitting a request before registration, abandonment, final refusal, or before the end of the considerations of the application and shall mention in a request that the application is divided from the original application.

Each divided application shall refer to the original application by identifying the number and filing date of the original application.

The original application shall be modified but not beyond the scope of substantive disclosure before the division. The divided application shall be submitted along with the modified original application. Each divided application is entitled to obtain the date of filing based on the original application and shall pay the relevant official fees and service charges.

Divided application can be modified from the application for a patent to the application for a petty patent or vice versa. The application that has modified the type of protection is entitled to obtain the date of filing or priority date (*if any*). In the event that the application has been changed from a patent to petty patent.

The paid fees and service charges will not be refundable. For changing from application for a petty patent to the application for a patent shall have to pay additional fees and service charges the same as the fees and service charges of a general application for a patent.

12. 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.

13. 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.

14. 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.

15. Post-Procedures of the Grant of Patent or Petty Patent Rights in Laos

15.1. Recordal of patent holder's name/address change in Laos:

In case the patent holder's name/address has been changed, it is possible to request DIP to record such change. To this end, a Statutory Statement which must be notarized is required. DIP shall record all changes in the database, document the registration and publish in the official gazette for the registration of industrial property.

15.2. Duplicate (re-issuance or re-grant) of the Patent or Petit Patent:

The patent or petty patent owner can request DIP to issue a duplicate of their Patent or Petit Patent in two circumstances as follows:

- (i) When the patent owner needs a duplicate in legal proceedings in the court or the application for the patent or petty patent abroad;
- (ii) When the original patent/petit patent is damaged or lost, the owner can submit a request with DIP for a duplicate of such patent/petit patent and pay the service charges.

Further, DIP can also request the applicant of the dossier/document which has been damage or lost to send a copy of the relevant documents or records of correspondences with DIP as well as to verify the accuracy and completeness of such copies, including the documents or dossier related to correspondence with DIP that has not been recorded but of which the patent and petty patent registration applicant or a dossier owner is aware so that DIP will duplicate a dossier/document.

15.3. Patent cancellation in Laos:

Grounds for cancelling validity of patents and petty patents in Laos:

- (i) The term of protection is expired;
- (ii) The patent/petit patent owner fails to renew his patent/petit patent and pay the applicable fees and service charges;
- (iii) The patent or petty patent is invalidated based on a finding that one or more requirements for protection have not been satisfied; where such finding applies to only a portion of the industrial property, the termination shall apply only to such portion as is invalidated. In such case, the invalidation shall be effective as from the grant of the patent, petty patent, or registration;
- (iv) Failure to the commercial exploitation, the industrial property rights will be terminated after the final decision by the competent court.

Special attention should be paid to the 4th ground of patent cancellation/invalidation. After registration, you should use your patent or petty patent in commercial activities in Laos. Otherwise, third parties can submit a cancellation request (*within 5 years of the publication date of the registration*) to terminate your patent or petty patent on the grounds that you have failed to exploit it commercially.

A patent and/or petty patent in Laos may be cancelled in two circumstances as follows:

Proactive patent cancellation by DIP: If DIP has considered that existing or provided information by a third-party evidence that the patent or petty patent information is false or misleading, conceals information or shows any actions that violate or contradict the law during the application review, if the information is confirmed, DIP shall undertake administrative cancellation of the patent or petty patent.

The DIP shall notify the applicant for a patent or utility patent, the assignee of a patent or utility patent, immediately about the cancellation procedure. If the applicant disagrees with the cancellation of DIP, the applicant can submit a request to the Committee of Final Consideration for final administrative consideration, or the applicant can submit a request to the Lao People's Court.

DIP will not provide any recommendations on the possibility that any application will be cancelled or on any other procedure and DIP will not give any legal advice to the applicant for reason or certain evidence to support the application.

Patent cancellation at the request of a third party: A third party can submit a request for cancellation or elimination with DIP within 05 (five) years from the date of publication in the official gazette on the registration of industrial property. Submitting the request for cancellation or elimination of the patent or petty patent shall follow the template of DIP and the service charges must be paid.

DIP shall notify the owner of a patent or petty patent when it has received the request for cancellation or demolition from the third party.

The owner of a patent or petty patent can submit clarification to DIP within sixty days from the date of notification of the DIP.

DIP shall issue a patent or petty patent cancellation or demolition certificate and shall notify the owner of the patent or petty patent. If the owner has no clarifications, it is considered that the owner consents to the cancellation or demolition of his/her patent or petty patent.

How does a court in Laos involve in a patent cancellation?

After five years from the date of publication, the third party can submit a request for cancellation or demolition with the People's Court to proceed with the request.

DIP shall cancel or demolish the patent or petty patent if the third-party files a lawsuit with the Lao People's Court and the court makes a final judgment to cancel or demolish the patent or petty patent.

DIP shall notify the owner and the requesting person the cancellation or demolition certificate of the patent or petty patent.

16. 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 petit 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 petit 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.

17. 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/petit 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.

18. 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:

18.1. 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.

18.2. 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 intellectual 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.

18.3. 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.

18.4. 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>

19. 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 petit patent.

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

20. Patent enforcement in Laos

20.1. What are the most effective ways for a patent owner to enforce its rights in Laos?

Generally, a patent infringement or disputes may be settled in Laos under 6 ways as provided under Article 127 of Lao IP Law as follows:

- (i) Reconciliation;

- (ii) Mediation;
- (iii) Administrative remedies;
- (iv) Remedy through Economic Dispute Resolution Committee;
- (v) Judicial actions to People's Courts;
- (vi) International dispute settlement

Reconciliation: In Laos, the parties may reconcile with regard to IPR violations. The agreement resulting from the reconciliation shall adhere to contracting principles as provided for in the Law on Contract and Tort.

Mediation: In Laos, the parties may choose the mediation form to resolve their dispute at any time in accordance with laws and regulations.

Administrative Remedies: In Laos, the parties may purpose to the intellectual property administration authority for dispute resolution relating to intellectual property in accordance with laws.

A dispute that can be remedied in administrative mean shall be any dispute relating to registration of industrial properties, new plant varieties and provision of information related to copyright and related rights.

Remedy through Economic Dispute Resolution Committee: In Laos, the parties may request the economic Dispute Resolution Committee at any time to resolve their intellectual property dispute in accordance with the Law on Economic Dispute Resolution and other relevant laws and regulations.

Judicial Actions to People's Court: In Laos, the parties may file an action to the People's Court to decide on intellectual property dispute in accordance with laws and regulations.

International Dispute Settlement: In Laos, the intellectual property dispute settlement of international nature shall be proceeded in accordance with international conventions and agreements to which the Lao PDR is a party.

In practice, most patent infringement cases in Laos can be settled firstly by sending a cease and desist letter or proposing a patent licence to the infringer.

Alternatively, a patent owner can enforce its patent rights through criminal and civil proceedings. However, up to now, no patent infringement cases heard by Laotian courts have been reported.

20.2. What are the stages in the litigation process leading up to a full trial?

In general, the following stages occur before a full trial:

- The patent owner conducts a private investigation to collect evidence of infringement.
- The patent owner sends a cease and desist letter to the alleged infringer informing the party of patent validity, ownership and requesting that the infringer ceases infringing the patent. If no reply is received, a follow-up letter may be sent to the infringer after expiry of the prescribed period.
- Both parties enter into direct negotiation or mediation to settle the infringement case.
- If no settlement is reached within the deadlines, the patent owner initiates a civil action against the infringer by filing a petition with a competent Laotian Peoples' court and serving it to the infringer. Kindly note that the People's Court shall have jurisdiction over all violations of intellectual property rights in accordance with the procedures as provided for in the Law on Civil Procedures and the Law on Criminal Procedures as the case may be.
- The court, upon finding the petition grounded, will summon the infringer. In return, the infringer must file an answer to the petition with the court and serve a copy of the answer to the **patent** owner.
- The court sets a hearing date in order to determine whether both parties are committed to litigation. During the hearing the court will set out the issues to be tried.
- Both parties prepare and submit written testimonies, supporting documents and evidence for submission to the court.
- A decision is usually made within one month from the hearing date.

20.3. How easy is it for defendants to delay proceedings in Laos and how can plaintiffs prevent them from doing so?

The defendant may attempt to delay proceedings by requesting extensions of individual deadlines or unreasonable postponements of hearing, or by raising procedural issues concerning the handling of the case

that require decisions by the court. The plaintiff can oppose any such request, and the court will then consider whether the request is reasonable.

20.4. How might a party challenge the validity of a patent through the courts in anticipation of a potential suit for infringement being issued against it?

A party anticipating an infringement suit would typically attempt to challenge the validity of the **patent** at issue before DIP by filing a **patent** invalidity case and become a plaintiff. While this would not prevent an infringement suit, the Laotian court would usually consider the invalidity case first before making a decision in the infringement suit.

In case an infringement suit has already been initiated, the defendant can claim in **its** defence that the **patent** is being considered for invalidation/cancellation. The defendant can file a counterclaim for **patent** invalidity with the court alongside the answer to the infringement complaint, and serve a copy of the counterclaim on the plaintiff. The plaintiff must file an answer to the counterclaim with the court and serve a copy of the answer on the defendant. Alternatively, the defendant may file an invalidity action against the plaintiff's **patent** to bring about a new suit. The judge appointed in the infringement case is usually also appointed in the invalidity case and, after consulting with the parties, may decide to merge the cases.

20.5. Does Laos apply a doctrine of equivalents and, if so, how?

At present, there is no statutory provision concerning the application of the doctrine of equivalents in Laos. In addition, no precedent case on patent infringement has been heard. As such, the doctrine of equivalents may not be adopted to handle patent infringement in Laos.

20.6. Is it possible to obtain preliminary injunctions? If so, under what circumstances?

Preliminary injunctions are available under Article 144 of Laotian IP Law. A **patent owner** may apply to the court for an injunction if there is clear evidence that a person has committed or is about to commit an infringing act. In detail, an individual, legal entity or organization may file a complaint requesting the People's Court to order prompt and effective provisional measures to:

- (i) prevent an infringement of any intellectual property right from occurring;
- (ii) prevent the entry into the channels of commerce of goods, including imported goods immediately after customs clearance;
- (iii) preserve relevant evidence in regard to the alleged infringement.

To request a court in Laos to award a preliminary injunction, an application for a preliminary injunction (*i.e. a provisional measure*) shall be required to:

- (i) provide any reasonably available evidence in order to satisfy the Court with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent;
- (ii) provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse;
- (iii) supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

20.7. Will Laotian courts consider decisions in cases involving similar issues from other jurisdictions?

Foreign court decisions in similar cases are generally unenforceable in Laos, but may be recognised as proof of a claim adjudicated abroad.

20.8. Can the successful party in Laos obtain costs from the losing party?

Yes; however, the value of the costs is at the judge's discretion. A defendant may request the Laotian People's Court to order a party at whose request measures were taken and who has abused enforcement procedures to provide to a party wrongfully enjoined or restrained with compensation including expenses in connection with the legal action, which may include attorney's fees for the injury suffered because of such abuse.

20.9. What are the typical remedies granted to a successful plaintiff?

In the court proceedings in Laos, the plaintiff may request the People's Court to:

- (i) Order the infringer to desist from an infringement;
- (ii) Order the suspension of Customs procedures;
- (iii) Order the seizure of goods to prevent the entry into the channels of commerce of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods;
- (iv) Order a declaratory judgment of infringement;
- (v) Order the infringer to pay damages adequate to compensate;
- (vi) Order the infringer to pay the right holder expenses, which may include appropriate attorney's fees;
- (vii) Order that goods that have been found to be infringing, be destroyed or otherwise disposed of in such a manner that such goods will not enter channels of commerce;
- (viii) Order that materials and implements the predominant use of which has been in the creation of the infringing goods be disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements.

In considering requests under items 7 and 8 above, the People's Court shall take into account for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties.

20.10. How are damages awards calculated? Are punitive damages available?

The court generally awards only the actual damages suffered as a result of the infringing activities. Per Article 141 of Laotian IP Law, the People's Court shall set damage awards in an amount sufficient to compensate the party making the claim for its losses and to deprive the infringer or other violator of any profit from its unlawful act. The People's Court may order recovery of profits and/or payment of damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.

Punitive damages are not available in Laos.

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.

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