

INDUSTRIAL DESIGNS IN LAOS

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LEGAL BASIS

Law on Intellectual Property No. 38/NA dated 15 November 2017;

Decision on Industrial Design No. 35/MOST dated 20 January 2021.

DEFINITION

1. What is an industrial design in Laos?

The Law No. 38/LA on Intellectual Property (amended) dated 15 November 2017 (Lao IP Law) defines an industrial design as the form or shape of a product that needs to be created (including patterns, lines, colors, etc.). Specifically, an industrial design certificate protects a product's special appearance which covers a pattern, a form, or an external feature of a novel product developed in Lao PDR, or elsewhere in the world, that includes a shape, motif, line, color or an ornamental form used in an object or attached to an object.

REGISTRATION

2. What are Eligibility Requirements for protection of industrial designs In Laos?

An industrial design is patentable in Laos if it satisfies 2 following required characteristics:

- (i) **New** (or novel) – the industrial design is deemed novel if it has never been disclosed to the public via a publication journal, or via actual use, or during exhibition, or via other modalities, in Lao PDR or elsewhere in the world before the filing date or priority date of the application. Therefore, the novelty required for an industrial design must be worldwide novelty.
- (ii) **Ornamental** - the industrial design shall be considered as ornamental if it gives a special appearance to the object to which the design is applied or in which it is embodied;

3. Are there any types of designs that cannot be registered in Laos?

An industrial design is ineligible for registration under Article 22 of Lao IP Law if it falls into one of the following two categories:

- Its appearance is dictated by the technical features of the object to which the design is applied or in which it is embodied; or
- It disregards traditions and/or disturbs the social order of Laos.

Besides, a technical feature related to an industrial design such as a material used, a production procedure, or implementation of work operation, shall not be protected as an industrial design.

4. Computer programs and layout-designs – Eligible for design registration in Laos or not?

Computer programs are creations that cannot, as such, be visibly embodied in a physical article. This is the case despite the fact that they can be operated on physical devices (computers, telephones, etc.) and can be recorded in physical supports (memory chips, CD disks, etc.). As they cannot be visibly embodied as such in an industrial product, they cannot constitute an industrial design. Computer programs and software may be assimilated to literary works and protected under copyright law.

Layout designs of integrated circuits are a *sui generis* intellectual property object of protection. Layout designs may be embodied in physical products, namely integrated circuits or electronic chips. However, a layout design cannot be perceived by the naked eye during normal use of an electronic circuit and therefore would not meet the visibility requirement. Layout designs of integrated circuits are normally protected under specialized legal statutes and not under industrial design law.

5. Is industrial design registration mandatory in Laos?

Industrial design registration is not mandatory, but it is required if you wish to protect your designs in Laos. The Lao Department of Intellectual Property (**DIP**) is the competent authority to examine your application for registration.

6. Who can register an industrial design in Laos?

Any individual, legal entity, or organization may apply for an industrial design. An individual, a legal entity, or an organization residing in a foreign country wishing to register industrial designs, however, must be represented by an authorized representative in Laos (i.e., an IP agent).

7. What are principles for consideration of application in Laos?

Lao PDR employs a **first-to-file system**, meaning that the person whose application has the earliest filing date – or, if priority is claimed, the earliest priority date – is granted the industrial design certificate.

Where there are several industrial design registration applications of the same nature or similar nature at the same time, a review should be granted to the industrial design of the same nature or similar nature that has a priority date. Where DIP has completed the review of the application, it shall register such an application with a priority date as well as issuing the letter of refusal to the application that has a later priority date. Where the review of the application with later priority date is completed first and where such an application meets registration requirements, DIP shall suspend its review of such an application until the review of the application with a prior priority date has concluded.

8. How can I determine the priority date of my application in Laos?

Laos is a party to the Paris Convention; applicants for industrial designs in Laos are entitled to a right of priority claim if the same filing has been made within 6 months in any other country that is also party to the Paris Convention.

The priority date is the date when an application was first made/filed for the industrial design in Laos or in a foreign country. The period of priority starts from the filing date of the first application and is then six (6) months for industrial designs.

An application may contain a declaration claiming priority based on one or more earlier national, regional or international applications filed by the applicant, either in Laos or in another country, which is a party to the Paris Convention (or another international treaty to which Laos is a signatory). Therefore, applications from Convention countries will be granted the same priority date in Laos.

A right of priority can only be validly invoked in respect of industrial designs that are *identical* in both the priority application(s) and the application filed with DIP. If the designs contained in the application under consideration present perceptible variations or differences, the right of priority will not operate.

9. Is it possible to conduct an availability search for an industrial design in Laos before filing a design application in Laos?

An applicant is able to submit its request with DIP to search for an industrial design that is in the database of DIP to identify whether such an industrial design subject to the search has already been registered or not, by identifying the classification of industrial design that needs to be searched, and by paying the relevant service charge.

DIP, however, conducts the search based on its preliminary database only, and the search result does not mean that such an industrial design may be registered or not because there needs to be an additional search in the international database. Therefore, approaching an IP agent in Laos for a comprehensive search seems to be a strategic way available to many applicants noting that the search result be for reference source which shall not anticipate the registration of the application.

10. Where to file and What must be included in an industrial design application In Laos?

An industrial design application must be filed with DIP under the Ministry of Science and Technology. The application dossier must contain the following:

- (i) A formal application form (a request form) defined by DIP;
- (ii) Power of Attorney certified by notary public and the name and address of the applicant's representative in the Lao PDR in case of foreign applicant;

- (iii) Deed of Assignment if the applicant is not the inventor, which must be duly signed by related parties and notarized by notary public;
- (iv) Drawings, photos, or images that indicate an industrial design clearly in order to demonstrate a feature in all angles of the design;
- (v) Brief description of a product category or a goods related to the industrial design;
- (vi) A receipt of official fee and service charges;

An application for an industrial design may also contain a claim for priority. If priority is claimed, the applicant must submit a copy of the application on which the priority claim is based, certified as correct by the authority which received the application and showing the filing date. Such documents do not require any authentication, and may be filed, without fee, at any time within three (3) months of the filing date of the application in Laos.

Each application for industrial design registration in Laos must apply to a single industrial design or a series of related designs for a single class (as per the international classifications).

Requirements for drawings, photos or images:

A drawing, a photo or an image shall clearly show the industrial design in order to demonstrate how the use or the feature of such an industrial design are related to each other, namely, details in all angles necessary to be able to indicate a feature of such an industrial design.

The drawing, photo, image and model clearly indicating an industrial design with a feature in all angles shall at least show a minimum of 7 different angles including front, back, top, bottom, left, right and overall angles. For an industrial design that comes as a set, there shall be 7 different angles of each component of such a set;

The drawing, a photo, or an image shall not include other articles that are not a component of the industrial design or other components of a product not related to an industrial design.

The drawing, a photo, or an image shall be displayed in a quality and non-glossy paper by showing an industrial design clearly. Lines or motifs shall be clear, bold, and not exceeding 20 x 28 centimeter or not under 14 x 20 in size per item. A registration applicant may provide a drawing, a photo, or an image of an industrial design in an electronic form.

Requirements for description of industrial design

A brief description of an industrial design submitted with a registration application shall indicate all components that indicate unique features of the design clearly, indicate a novelty distinct from earlier industrial designs, match the drawing, photo or image submitted with an application dossier, and indicate with which type of product or goods it will be used.

Where an industrial design is ornamental, a description shall indicate the relation between the design and such an object with which it is used or to which it is attached that gives a special appearance.

Where an industrial design is a set of products or goods, a description shall indicate the characteristics of each part of a set of such products or goods clearly.

11. Which languages are used for design application in Laos?

An industrial design application can be filed in either English or Lao. However, application documents submitted in English must be translated into Lao within 90 days from the application filing date. The translation must be certified to be a correct translation.

12. How is an industrial design application examined in Laos?

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

Formality Examination and Publication

Within sixty (60) days since the date of receiving the application for an industrial design, DIP shall conduct a formality examination of the application regarding the completeness, accuracy and conformity with prescribed requirements.

In case that the 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 sixty (60) 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.

In case that the application is in conformity with the preliminary examination requirements, the application will be accepted for substantive examination. DIP shall publish the application in the official gazette for registration of industrial property **within fifteen (15) days** after completing the formality examination of the application.

Substantive Examination:

An application for an industrial design registration that has satisfied formal requirements shall be subject to substantive examination in Laos, without request by the applicant and without the necessity to furnish copies of examination from another office, to determine whether the application meets the requirements for protection set forth in the Intellectual Property Law.

The substantive examination shall be undertaken with a basis on the database of DIP and international database according to Article 40 (*Substantive Examination of Industrial Property Applications*) and Article 41 (*Claim to Carry out Substantive Examination of Industrial Property Applications*) of Lao IP Law to determine whether the industrial design meets the requirements of patentability under Article 15 of the law and do not fall within the ineligible subject matters under Article 22 (*Exclusions from Registration*) of the law.

The procedure of substantive examination shall be taken in accordance with the following conditions:

Substantive examination shall include a search to identify any earlier industrial designs or other disclosures that may create a bar to the grant of an industrial design pursuant to Article 15 of the Intellectual Property Law. Substantive examination for novelty shall be based on a comprehensive search of information that is already known. In determining whether an industrial design is new, DIP shall compare the industrial design that is the subject of the application with available information from industrial design registrations in the Lao PDR and abroad and with other information that is publicly available.

(i) where all the prescribed requirements of the application are fulfilled upon completion of the application's substantive examination, DIP shall register the industrial design, enter the registration in the registrar and publish the registration on the official industrial property gazette.

(ii) where the application file does not meet the requirements for a registration, DIP shall prepare a written report identifying any grounds for refusal of the application, any objections to registration, and any conditions or restrictions thereon. DIP shall promptly provide this report to the applicant, who shall have an opportunity to respond to such objections and, if desired, to amend the application under the law.

The time for responding to any communication from DIP is **60 days** from the issuing date of such communication unless otherwise provided. DIP may extend the deadline for an additional 30 days from the end date of the first notification, upon sufficient justification. If an applicant fails to respond satisfactorily to any requirement or ground for refusal within the stated time for action, DIP will take final action on the application 90 days from the date of the requirement or other communication unless the applicant files an appeal within this period. DIP shall refuse the industrial design registration application as a finality and inform the industrial design registration applicant when it is found that information, documents or the explanation provided do not meet the requirements for registration.

Lao IP Law also retains special discretion to refuse an industrial design application for registration where it is considered that the commercial exploitation of the design patent shall adversely impact on the culture and fine traditions of Lao PDR or where it is necessary for the protection of essential security and peace interests of Lao PDR. A design will be regarded to be contrary to social order and the fine traditions of the nation where it consists of, comprises, or includes material that is scandalous or obscene or otherwise offensive, where it includes disparaging material, or where publication of the design would constitute a violation of the national law.

13. When and to what extent can applicant amend the industrial design application in Laos?

As provided in Article 42 of the Intellectual Property Law, at any time an application is pending with the Department but before DIP has granted an industrial design thereon, and before the abandonment, final rejection, or other termination of proceedings on the application, the applicant may amend/divide the

application, provided that any such amendment/division shall not change the essential appearance of an industrial design, that is, within the disclosure in the initial application.

An application may be divided into one or more divisional applications by filing one or more subsequent applications that make reference to the application being divided. The second or subsequent application shall be identical to the application on which it is based and shall be accompanied by a statement that the newly filed application is a division of such earlier application, which shall be identified by its filing number, title, name of designer, and filing date. Both the newly-filed application (or applications) and the earlier application shall be amended to restrict their claims to contain only a single industrial design, as appropriate, or a group of such related items as to meet requirements for the relevant form of intellectual property such as unity of industrial design. Such amendment may be filed with the divisional application or within 60 days thereafter.

14. How can I file an opposition to an industrial design application in Laos?

Entitlement: Any third party is statutorily entitled to file a Notice of Opposition to a pending design application in Laos after such design 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 60 (sixty) days from the publication date on 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 design 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: An opposition to an industrial design application shall be treated as a separate procedure which consists of various actions taken by DIP in a prescribed order, namely:

- Notifying the applicant of the opposition;
- Receiving the opponent's counter response together with relevant information/evidence within sixty (60) days from the date of the notification regarding the opposition request and then send the counter response to the third party/opposing party;
- Inviting the opposing party and/or applicant to clarify or to present evidence/additional information, if necessary;
- Examining the opposition based on evidence in hand;
- Notifying the applicant or the opponent of the examination result of the opposition along with the reasons.
- The rejection or continued consideration of the opposed application shall rely on the examination result of the opposition.

If the opponent or the opposed is not satisfied with the result of DIP's decision, either of them can request a final consideration through an administrative procedure to DIP in order to appoint a Committee of Final Consideration to issue a decision where such a request shall be submitted within 60 days since the date of a notification from DIP.

No matter how long the opposition procedure takes, the pending status of an application opposed by a third party shall drag out the examination process of the application. Therefore, the issue implies that the applicant had better conduct an availability search prior to registration for actively preparing a strategic plan to cope with the possible risks.

15. How is the qualified application granted design patent rights in Laos?

If the application is in conformity with the requirements for registering the industrial design as set forth in the Law on Intellectual Property and this Decision, DIP shall grant the design patent, document the related information in the register and database of DIP.

The design patent shall be published in the official gazette on the registration of industrial property, the incorrect information of which can be revised, free of charge, under the owner's request within sixty (60) days from the first date of publication.

POST-REGISTRATION OF INDUSTRIAL DESIGN IN LAOS

16. Can an industrial design be amended after registered/granted in Laos?

The Lao IP Law only permits the correction of errors related to name, address or the applicant's name and address according to the template form provided by DIP found in the publication of a patent after it has been granted. Correction requests must be made within 60 days of the date of publication and DIP shall record all changes in the database, document the registration and publish in the official gazette for the registration of industrial property.

After the industrial design has been registered, an industrial design owner may submit a request to modify partial information in the documents related to the registration. As for the modification of some errors in the registration application file due to the applicant by filing a request according to the template form from DIP as well as paying the service charge, DIP may allow for a minor modification only. DIP shall publish the information related to such a modification on the official gazette for industrial property registration.

17. Can I file a request for duplication (re-issuance or re-grant) of the Design Patent in Laos?

Yes, you can request a copy of an industrial design registration certificate to be used as an evidence in a judicial proceeding before the Lao People's Court and for an industrial design registration abroad and to be used as a substitute to a registration certificate or for a renewal of a certificate that has been damaged or lost.

18. How can I file a cancellation action against an industrial design in Laos?

Entitlement: You or any third party has the right to submit a cancellation or elimination request of an industrial design registration within **05 (five)** years as of the registration date in the publication in an official gazette for an industrial property registration with DIP.

Grounds: Grounds for cancelling validity of industrial designs are provided in Article 45 of Lao IP Law as follows:

- (i) The term of protection is expired;
- (ii) The design owner fails to renew his design patent and pay the applicable fees and service charges;
- (iii) The design 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 design 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 design cancellation/invalidation. After registration, you should use your industrial design 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 industrial design on the grounds that you have failed to exploit it commercially

Procedures to handle a design cancellation request in Laos:

- (i) DIP shall notify an industrial design owner when receiving the cancellation request from a third party.
- (ii) An industrial design owner is able to submit an explanation within 60 days from the issuance date of DIP's notification.
- (iii) DIP shall issue the cancellation or an elimination letter of such an industrial design and inform the industrial design owner where an industrial design owner has not provided any explanation, which will be considered that the industrial design owner has consented to such a cancellation of their industrial design registration.
- (iv) DIP shall cancel or eliminate the industrial design registration where a third party has filed a complaint with the Lao People's Court and that the Court's judgement has been passed to cancel or eliminate such an industrial design registration according to the provisions of Article 139 of Lao IP Law.
- (v) DIP shall notify the result of a cancellation of such to the industrial design owner or the petitioner/requester of the design cancellation.
- (vi) DIP shall make a record in the database and publicize such cancellation in the official gazette for an industrial property registration.

19. How long does design registration in Laos take?

The registration process for an industrial design may take 6-12 months from the date of filing.

20. What is the term of protection for design patent In Laos?

The term of protection for an industrial design shall be **fifteen (15) years** beginning from the filing date of the application for registration in the Lao PDR.

To maintain the industrial design registration in effect, the owner of industrial design shall pay in advance to DIP a fee to maintain the registration or application in effect. The period for paying the fee shall begin five (05) years from the filing date of the application for industrial design registration and shall be payable every five (05) years thereafter.

In measuring the term, the day of filing shall be counted and the final anniversary of such date shall be excluded.

21. What is the scope of protection for design patent in Laos?

Upon the issuance of the design patent, the holder is granted the exclusive rights to exploit and protect its industrial design in Laos under Article 47 of the IP law, namely:

- To enjoy the benefits derived from the exploitation of the industrial property;
- To transfer fully or partially its industrial property rights by will, sale exchange, rent, or assignment;
- To authorize another person to exploit all or part of its rights; and
- To take legal actions to protect its rights from violation by other parties.

A design patent granted by DIP provides the holder the exclusive right over the exploitation of the industrial design. Thus, the owner can prevent others from making, using, offering for sale and posesion of the protected designs without the owner's permission.

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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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