

Questions on trademark registration and protection in Laos

What types of trademarks can be registered in Laos?

Marks are categorized into 04 (four) types for examination and registration purpose as per Article 5 of Decision No. 2822/MOST dated 17 December 2019.

Type 1: “Trademark”: A trademark is defined as a symbol or a combination of symbols used to distinguish the goods of individuals, legal entities, or organizations from the symbols of others. Symbols may be words, including invented words, signatures, names, figures, shape elements, outlines, photographs, three-dimensional pictures, animated images or packaging of goods, or a combination of colors or symbols;

Type 2: “Service Mark”: A Service mark is a symbol or a combination of symbols used to distinguish the services of individuals, legal entities, or organizations from the symbols of others, which are the same as those specified in the type 1 above.

Type 3: “Certification Mark”: A Certification Mark is a mark established by a legal entity or organization that can be used to guarantee a standard or characteristic to certify said goods or service. The mark can be used by a third party in order to indicate the origin, raw materials, method of production of the product, method to provide the service that meets the quality standards, safety, cleanliness, which is produced by a person who has expertise in a certain area.

Type 4: “Collective Mark”: A Collective Mark is a mark that is endorsed by collective organizations, for example: associations, unions, other social organizations, cooperatives, chambers of commerce and industry, or other collective organizations. A Collective Mark is a Trademark that only a member of the organization can use to indicate that its goods or services are different from the goods of another party.

How to register a trademark in Laos?

To register a trademark in Laos, you are advised to follow the following steps:

- (i) **Conducting a pre-filing trademark search**: Before applying for trademark registration, it is important to search the trademark database to ensure that your proposed trademark is available and not already in use by another party.
- (ii) **Prepare the trademark application**: Your trademark application should include the following information: the name and address of the applicant, a clear representation of the trademark (in words and/or images), a list of the goods and services that the trademark will be used for.
- (iii) **File the trademark application**: The trademark application can be filed either directly with the Department of Intellectual Property of Laos (DIP) or through a local trademark agent. Kindly note that a foreign individual or entity must authorize a local IP agent in Laos to apply for trademark registration.
- (iv) **Examination of the trademark application**: Once the trademark application has been filed, it will be examined by the DIP to ensure that it meets the requirements for trademark registration. A trademark application in Laos undergoes 02 examination stages: Formality Examination and Substantive Examination. The examination may include a review of the trademark’s distinctiveness, similarity to existing trademarks, and compliance with the Trademark Law of Laos.
- (v) **Publication of the trademark**: If the trademark is approved, it will be published in the Official Gazette of Laos. This publication serves as notice to the public of the trademark’s existence and allows other parties to file an opposition to the trademark registration within 60 days from the publication.
- (vi) **Respond to any objections**: If the DIP raises objections to your trademark application, you will need to respond to them and provide additional information or clarification as needed.
- (vii) **Grant of trademark registration**: If there are no objections to your trademark application, unlike other national IP Office, DIP will NOT a Notice inviting the applicant to pay the registration fees. Instead, DIP will immediately issue a certificate of registration and return the original Certificate to the trademark applicant.

What are the requirements for trademark registration in Laos?

The following information and documents are required to provide us for trademark registration in Laos:

Requisite Information:

- (i) Full name, address and nationality of the applicant;
- (ii) Description of the trademark: meaning, colors claimed, translation or transliteration of characters into English if the mark contains foreign characters;
- (iii) List of goods/services to be covered by the trademark and if possible, the class(es) of the respective goods/services according to the International Classification (if known);
- (iv) If a priority is claimed: statement of country, application number and filing date of the original foreign application from which the priority is claimed.

Requisite Documents:

- (i) An original notarized Power of Attorney (**PoA**) from the applicant. A copy of the executed PoA can be accepted at the time of filing trademark applications, but the original one must be submitted **within 30 days** from the filing date
- (ii) Ten images of the mark (the size of each specimen is not smaller than 15mm x 15mm and not larger than 80mm x 80mm);
- (iii) If the Convention priority is claimed: a certified copy of the priority document(s) and the English translation thereof.

What are the fees for trademark registration in Laos?

A multi-class trademark application is acceptable in Laos, meaning that a trademark application can cover more than 01 class. The examination process for a multi-class application is more complex than for a single-class application, as the trademark office must review the mark in each class to determine if there are any conflicting marks. This can result in a longer examination process and a higher likelihood of objections or rejections. Therefore, it is advisable to file a single-class trademark application in Laos to avoid delays if a certain class of goods/services is refused registration.

The fees shall NOT increase if one class of goods/services has 10 or more goods/services. Thus, the trademark applicant may list as many goods/services as he likes.

Fees from filing a trademark application in one class of goods/services in Laos are roughly over US\$ 300.

How long does the trademark registration process take in Laos?

The Lao IP Law No. 38/NA of November 15, 2017 does not establish a time limit for the Department of Intellectual Property of Laos to conduct formality and substantive examination of trademark applications in Laos. In practice, it usually takes around **10-12 months** from the filing date to obtain a Trademark Registration Certificate in Laos in smooth cases (*i.e. without oppositions, office actions, etc.*).

What is the legal process for trademark protection in Laos?

The legal process for trademark protection in Laos is governed by the Lao IP Law No. 38/NA of November 15, 2017 and its sub-law document, i.e. Decision No. 2822/MOST dated 17 December 2019. These legislations provide the framework for the protection of trademarks in Laos and sets out the requirements for registering and enforcing trademarks in the country.

The following is a general overview of the steps involved in obtaining trademark protection in Laos:

- (i) **Search and clearance:** Before filing a trademark application in Laos, it is advisable to conduct a search of the trademark registry of the Department of Intellectual Property of Laos to ensure that your trademark is not already in use by someone else.
- (ii) **Filing a trademark application in Laos:** To apply for a trademark in Laos, you need to prepare a trademark application that includes the following information: a clear representation of the mark, the goods and services that it will be used for, the name and address of the trademark owner, and any relevant documents, such as priority documents if rights of priority is claimed and Power of Attorney to

a local IP agent if you are a foreigner. The trademark application must be filed with the Laos Department of Intellectual Property (DIP).

- (iii) **Examination of the trademark application:** After the trademark application is filed, the Laos Department of Intellectual Property will examine the application to ensure that it meets the requirements for registration, such as distinctiveness and lack of confusion with existing trademarks.
- (iv) **Publication of the trademark:** If the trademark application is approved, it will be published in the Official Gazette. This serves as a notice to the public that the trademark has been registered and provides an opportunity for anyone to object to the registration.
- (v) **Grant of the trademark:** If there are no objections to the trademark registration, the Laos Department of Intellectual Property will grant the trademark and issue a certificate of registration.
- (vi) **Maintenance of the trademark registration:** Once a trademark is registered, it is important to maintain the registration by renewing it within 06 months before the expiry date and using the trademark in commerce.
- (vii) **Enforcement of trademark rights:** Once a trademark is registered, the trademark owner has the right to use the trademark to identify their goods and services, and to enforce their trademark rights against any unauthorized use of the trademark. As a trademark owner, if someone infringes on your trademark rights in Laos, you may take legal action to enforce your trademark in Laos. This may involve filing a lawsuit or seeking a resolution through alternative dispute resolution, such as mediation or arbitration.

Generally, a trademark infringement or disputes may be settled in Laos under 6 ways as provided under Article 127 of the Lao IP Law No. 38/NA of November 15, 2017 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 trademark licence to the infringer.

How is a trademark application examined in Laos?

A trademark application in Laos undergoes 02 examination stages: Formality Examination and Substantive Examination.

Formality Examination:

After DIP issues a filing number for a trademark application, its examiner will conduct a formality examination for the trademark application. The formality examination must be carried out within 60 days, as of the date that the application is received.

The formality examination aims at determining the completeness, accuracy and compliance of the application to make sure that the trademark application complies with the administrative requirements or formalities (i.e. for compliance with the filing requirements; classification: i.e., to ensure that the goods or services fall within the class(es) listed in the application; clarity: i.e., that descriptions are clear and understandable) Articles 5, 7, 9, 10 and 11 of Decision No. 2822/MOST dated 17 December 2019.

Upon reviewing the trademark application during formality examination, DIP may issue either the following Notice/Decision will be issued:

- (i) *Notification of additional amendments:* If the trademark application is incomplete or incorrect or not in compliance with the requirements specified, DIP will issue a Notification requesting the applicant notify the applicant to provide documents, or amend in accordance with the requirements within 60 days, as of the date of notification.
- (ii) *Notification of abandonment of the application:* If the applicant fails to act within the time limit, DIP will issue a Notification that the application will not be considered and will be abandoned.

If the application is in compliance with the requirements of the formality examination, DIP will publish the application in the Official Gazette on the Registration of Industrial Property.

Publication of trademark application in Laos:

DIP will publish the trademark application in the Official Gazette of Registration of Industrial Property within 15 days after the formality examination is completed. The publication must contain the following information:

- (i) The trademark;
- (ii) The class of goods and/or services;
- (iii) The filing number and the filing date of the application;
- (iv) The name and address of the applicant; and
- (v) Any disclaimer of protection.

Substantive Examination:

The examiner of the Department of Intellectual Property will examine all aspects of a trademark application to find out whether the application violates any prohibitive provisions, as well as whether the application conflicts with any prior registered trademark right. The following will be examined to determine registrability of an applied-for mark in Laos:

- (i) **Descriptiveness:** i.e., to check whether a trademark functions solely to provide information about the goods and services affiliated with the trademark;
- (ii) **Distinctiveness:** i.e., to ensure that trademarks are capable of being represented graphically and of distinguishing the goods or services of one individual or organization from those of other individuals or organizations;
- (iii) **Deceptiveness:** i.e., to check whether a trademark is of such a nature as to deceive the public (for instance, as to the nature, quality or geographic origin of the goods or services);
- (iv) **Conflict** with prior registration, prior-filed application or earlier unregistered rights resulting from an official search.

Grounds for trademark refusal and/or opposition in Laos:

As a matter of principle, a trademark application in Laos may be refused on absolute or related grounds. Grounds of refusal of a trademark application are specified in Article 16 and 23 of the Lao IP Law.

Below are main grounds where a trademark application in Laos may be refused registration or opposed:

- (i) **Likelihood of Confusion:** This refers to the possibility that the trademark may be confused with an existing trademark that is already registered or in use. To assess if there is a likelihood of confusion, DIP's examiner will evaluate elements such as the resemblance of the marks, the relatedness of the goods or services, and the trade routes through which they are sold. If DIP's examiner determines that confusion is likely, the trademark application will be denied.
- (ii) **Descriptiveness:** The trademark is considered too descriptive or lacking in distinctiveness, meaning it simply describes a feature or characteristic of the goods or services it is associated with. Examples of descriptive trademarks include "Fresh-Baked Bread" for a bakery and "Soft-Touch Lotion" for a skin care product. Descriptive trademarks are ineligible for registration unless they have acquired a secondary meaning, meaning that the trademark has become distinctive through its use over time.
- (iii) **Merely Ornamental:** The trademark is used merely as an ornamental or decorative feature and not as a source identifier. Merely ornamental trademarks are not registrable because they do not function as trademarks to identify the source of goods or services.
- (iv) **Genericness:** The trademark is generic and cannot function as a source identifier because it refers to a class of goods or services rather than a particular source. Examples of generic trademarks include "Laptop" for computers and "E-book" for electronic books.
- (v) **Deceptive:** The trademark is misleading or deceptive and misrepresents the nature of the goods or services it is associated with.
- (vi) **Government Insignia:** The trademark is similar or identical to a symbol, emblem, or insignia that is protected by government regulations. Trademarks that are similar or identical to government insignia are not registrable because they may be confused with government symbols and may infringe on government rights.
- (vii) **Immoral or Scandalous:** The trademark is considered immoral or scandalous and is therefore not registrable. Trademarks that are immoral or scandalous are not registrable because they offend public morals and may be disrespectful to certain groups of people.
- (viii) **Similar to another's trade name:** The mark that is identical, or similar to a trade name for a business that provides the same, similar, or related goods and services.
- (ix) **Untrue origin:** The mark that consists of or bears a geographical indication which identifies a place other than the true origin of the products.
- (x) **True origin:** The mark that consists of or bears a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

Deadline to respond:

A response to a Substantive Examination Notification must be submitted within 2 months (computed from the date of the Notification). A 30-day extension of the deadline is extendable subject to a prescribed fee.

How is a trademark application refused registration in Laos?

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- (x) **True origin:** The mark that consists of or bears a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

Is it necessary to have a local representative for trademark registration in Laos?

You cannot register a trademark application directly with the Department of Intellectual Property of Cambodia if you are a foreign applicant. To file a trademark application with DIP, you must grant a Power of Attorney to a local IP agent in Laos (PoA). The PoA must be notarized by a public notary in the applicant's country, and the original PoA must be sent to DIP within 30 days of the filing date if only a scan was submitted.

Having a local agent in Laos can help guarantee that the trademark application is prepared and filed in accordance with all applicable laws and deadlines. A local agent can also provide essential assistance regarding the specific laws and regulations in Laos, as well as any potential issues or hurdles during the trademark registration procedure. In addition, having a local representation can be extremely beneficial in navigating any legal or regulatory challenges that may develop after the registration of the trademark, such as infringement or enforcement issues.

As per Article 34 of Decision No. 2822/MOST dated 17 December 2019, a local IP agent in Laos must be a person appointed by a PoA affixed with the signature of the applicant of the trademark registration or of the grantor.

The PoA for trademark registration in Laos must provide the following contents under Article 35 of Decision No. 2822/MOST dated 17 December 2019:

- (i) Requirements and scope of representation;
- (ii) The rights assigned to take actions in connection with DIP;
- (iii) Period of authorization (if any);
- (iv) The grantor can cancel at any time without affecting the rights of the representative to receive payments from the service and various costs incurred during the contact with DIP.

DIP will acknowledge that the requirements specified in the POA are in compliance, unless the requirements in the PoA do not comply with the laws and this Decision.

DIP will consider that a PoA can be used for one application only. In the event that the PoA does not specify the scope and period of authorization of the representation, or other procedures related to the POA, the validity of the PoA will be considered expired when the proceedings related to the application, or other procedures, have been completed.

The PoA must be made in writing and include the signature of the grantor(s). In the event that the person issuing the PoA is a legal entity or an organization, the PoA must have the signature of the authorized person of the legal entity or of the organization.

In the event that one of the co-owners of the mark refuses to sign the PoA, the PoA will be considered invalid.

How a goods/services is classied for trademark registration in Laos

Laos currently adopts the Nice Classification 11th Edition. The goods and services under any applications must be listed into specific items, preferably using the terms guided in the Alphabetical List of the Nice Classification.

The class heading of the goods or the services is not possible.

If it is not possible to identify the goods or services, or both, the applicant must provide complete information so that the Department of Intellectual Property of Laos can identify the class of the goods or services, or both.

Is Laos a first-to-file or first-to-use country?

The priority right belongs to the person who first files application for trademark registration in Laos, it is advised to file application for trademark registration in Laos as soon as possible. Trade mark applicants do not have to show prior use of the trade mark.

How can I claim right of priority for my trademark application in Laos?

As a Contracting Party to the Paris Convention for the Protection of Industrial Property since 08 October 1998, it is possible to claim right of priority for trademark applications filed with DIP. The applicant wishes to claim its priority rights from a foreign application, the national application must be filed with DIP within 6 months after the filing date of the foreign application.

The Paris Convention for the Protection of Industrial Property is an international treaty adopted in 1883, which provides for the protection of industrial property including trademarks. One of the provisions of the Paris Convention is the right of priority, which allows the owner of a trademark to file for protection in other member countries within a certain time period, and to claim the filing date of their original application as the filing date in the other countries.

This means that if a person has filed for trademark protection in their home country, they have a period of 06 (six) months to file in other member countries and claim the priority of their original filing date. The priority period applies to all members of the Paris Convention, regardless of whether they have a national registration system or not.

Claiming the right of priority is important because it provides the trademark owner with a number of benefits, including:

- (i) *Priority over later-filed applications:* If a trademark owner files in another country within the priority period, they will have priority over later-filed applications for the same trademark.
- (ii) *Simplified procedures:* In some cases, the right of priority can simplify the filing process in the foreign country.
- (iii) *Legal protection:* The right of priority provides legal protection for the trademark owner, as it can be used as evidence in any legal proceedings.

It is important to note that the right of priority is only available for trademarks that are identical to the original trademark and that are used in connection with the same goods or services. Additionally, the trademark owner must have filed their original application in good faith and without any fraudulent intent.

How long does a trademark registration last in Laos?

As per Article 51 of the revised IP Law of Laos enacted on November 15, 2017, the term of trademark protection in Laos is provided as follows: "*The term of protection of trademarks shall be 10 years from the date of filing*"

the application for registration. Upon expiry the term of protection may be indefinitely renewed and each period of renewal will be for 10 years. In order to maintain the term of protection the owner of the trademark shall pay fees and charges every 10 years in advance".

However, for trademark registration certificates issued before the amendment of the Laotian IP law, for example, trademark registration certificates issued in 2014, the term of trademark protection in Laos would be 10 years **from the registration date** (not the filing date).

How to enforce trademark rights in Laos?

Enforcement of a trademark means taking measures to prevent unauthorized use of the trademark. Depending on the jurisdiction and the circumstances, the particular processes for enforcing a trademark will vary, however some common strategies for enforcing a trademark include:

Monitor the use of your trademark: Regular monitoring of your trademark can help you detect any unauthorized use of your trademark, and take appropriate action to enforce your rights.

Send a cease and desist letter: If you become aware of someone using your trademark without your permission, you can send a cease and desist letter, which is a formal request to stop the unauthorized use. A cease and desist letter can often be effective in resolving trademark disputes without going to court.

File a lawsuit: If a cease and desist letter is not effective, you may need to file a lawsuit to enforce your trademark rights. This involves presenting evidence of your trademark rights and the unauthorized use of your trademark, and asking the court to issue an injunction to stop the infringing use, and/or to award **damages to compensate you for any harm caused by the infringement.**

Seek enforcement through government agencies: In some cases, you may be able to seek enforcement of your trademark rights through government agencies, such as the customs offices. These agencies can take action to prevent the import or sale of infringing goods, or to cancel the registration of an infringing trademark.

Generally, a trademark infringement or disputes may be settled in Laos under 6 ways as provided under Article 127 of the Lao IP Law No. 38/NA of November 15, 2017 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 trademark licence to the infringer.

How can one file a trademark opposition in Laos

After the formality examination for a trademark application is completed, DIP will publish the trademark application in the Official Gazette of Registration of Industrial Property within 15 days.

Third parties can submit a Notice of Opposition to a trademark application in Laos within 60 days as of the date of publication in the Official Gazette of Registration of Industrial Property. This timeline is non-extendable.

Required documents: A Notice of Opposition of a Trademark registration in Laos must include the following documents:

- (i) The application form for opposition of a Trademark registration;
- (ii) The documents and evidence clarifying the opposition;
- (iii) The fee service receipt.

Processes of handling a trademark opposition in Laos:

In Laos, the procedures and processes for handling a trademark opposition in Laos are provided under Article 17 of Decision No. 2822/MOST dated 17 December 2019. In brief, the procedures and processes for handling a trademark in Laos are comparable to those adopted by IP Offices in other jurisdictions, which generally include the receipt and examination of the opposition, notification to the trademark applicant, the submission of evidence and arguments by both parties, examination of the evidence, a decision by DIP and notification of the decision to the concerned parties.

The following is a general overview of the steps involved in a trademark opposition:

- (i) **Filing of a trademark opposition with DIP:** An opposition must be filed in writing with DIP within 60 days of the publication of the trademark application. The opposition must include evidence and arguments to support the grounds for opposition.
- (ii) **Examination of the opposition:** DIP will examine the opposition to ensure that it is complete and complies with the relevant requirements. If the opposition is deemed to be insufficient or lacks proper evidence, DIP may request additional information or clarification or even refuses the opposition.
- (iii) **Notification to the trademark applicant:** DIP will notify the trademark applicant that an opposition has been filed against his/her trademark application, and will provide them with a copy of the opposition.
- (iv) **Response from the trademark applicant:** Within 60 days as of the date of the notification regarding the opposition, the trademark applicant must file a response to the opposition and submit evidence or arguments to support their case.
- (v) **Examination of the evidence:** DIP will examine the evidence and arguments submitted by both the opponent and the trademark applicant, and may request additional information or clarification from either party in case the evidence submitted by the opposing party and/or the trademark applicant is incomplete or unclear. In such scenario, DIP will issue a letter to invite the parties to clarify discrepancies or provide additional evidence or information.

If the trademark applicant or the opposing party do not comply with the invitation letter issued by DIP within 60 days from the date of the invitation letter, DIP will consider the opposition based on the evidence available

- (vi) **Decision/Notification on settlement of the opposition by DIP:** Based on the evidence and arguments submitted, DIP will issue a decision/notification on the trademark opposition and notify it to the concerned parties. The decision/notification may be to allow the trademark application to proceed, to refuse registration of the trademark application, or to amend the trademark in some way to distinguish it from the opponent's trademark.

Appeal of the decision: If the parties are not satisfied with the results of the consideration, they are able to propose final administration remedies to the Committee of Final Consideration within 60 days from the date of DIP's notification.

How can applicant deal with a trademark disclaimer in Laos?

A trademark disclaimer is construed as a declaration issued by the owner of a trademark declaring that the trademark does not contain specific rights to certain terms or features included in the trademark. This statement is provided by the trademark owner. The purpose of a disclaimer is to clarify the scope of trademark rights and eliminate any potential for confusion with comparable trademarks.

Laos has disclaimer practice (i.e., a practice whereby the applicant must disclaim any exclusive right to an element of a trademark that is not distinctive). In practice, it is not mandatory to clearly indicate a disclaimer to the element that is not distinctive in the application form. The Department of Intellectual Property of Laos will automatically consider those non-distinctive elements disclaimed.

Upon examining trademark applications, if it is determined that a particular element of the applied-for mark cannot be granted monopoly protection, DIP will notify the applicant that such element cannot be protected exclusively so as not to prevent other manufacturers or providers from using the same element for goods or services indicating the same qualities or characteristics.

If a trademark application contains descriptive words or generic terms, DIP will ask the applicant to clarify whether or not they are included in the mark. If a term is a part of the mark, DIP must notify the trademark applicant to modify the mark by removing such term.

Reasons for a trademark disclaimer in Laos:

- (i) **Descriptiveness:** If a part of the trademark is found to be merely descriptive of the goods or services, it may be necessary to disclaim the descriptive element in order to obtain trademark registration.
- (ii) **Geographic Indication:** If a part of the trademark includes a geographic indication, such as the name of a city or state, it may be necessary to disclaim the geographic indication in order to obtain trademark registration.
- (iii) **Generic Terms:** If a part of the trademark is a common or generic term for the goods or services, it may be necessary to disclaim the generic term in order to obtain trademark registration.

How to overcome a trademark disclaimer in Laos?

If DIP's examiner requests a disclaimer, there are several steps that can be taken to overcome the disclaimer request:

- (i) **Modify the trademark:** If the reason for the disclaimer request is due to descriptiveness or a geographic indication, it may be possible to modify the trademark to make it more distinctive and overcome the disclaimer request.
- (ii) **Provide evidence of distinctiveness:** If the trademark has acquired distinctiveness through use, it may be possible to provide evidence of this distinctiveness to overcome the disclaimer request.

Can a trademark application be amended in Laos?

During the examination period, the trademark applicant can amend the application at any time, provided that such amendment is performed before the registration of the mark, final refusal, or at the end of other considerations of said application, without having to pay official fees and service fees. The amendment must not add a list, a class of goods, or a service, or make any changes to the original characteristics of the mark in the application.

Can the type of the mark be amended in Laos?

You can amend any mark type specified in an initial application to be a Trademark, Collective Mark, or Certification Mark. In the event that the mark has been amended to be a Collective Mark or a Certification Mark, the trademark applicant is required to file a new application together with the appropriate supporting documentation.

Is a trademark published after its registration in Laos?

The publication of a trademark in the industrial property gazette serves as public notice of the trademark registration and provides information about the trademark to the public. The post-registration publication of a trademark application provides potential infringers with notice of the trademark owner's rights. It also provides an opportunity for third parties to file a cancellation action against the trademark registration if they believe that it infringes on their rights or is otherwise inappropriate. This makes trademark registration fair and transparent.

After a trademark is registered, the Department of Intellectual Property of Laos must publish the trademark registration in the Official Gazette of Registration of Industrial Property.

If the publication contains errors, and it is within 60 days of the first publication, the trademark owner can propose to the Department of Intellectual Property of Laos to republish the registration, along with the updated information, without having to pay service fees

Can we file a request for recordal of changes for trademark registration in Laos?

Regularly reviewing trademark registration to ensure that it remains accurate and up-to-date is critical. After a trademark is registered, a requirement for recordal of change of the trademark registration may arise in the following scenarios:

- (i) **Change in the goods/services:** If the trademark owner may need to limit/delete some goods/services under the registered mark.
- (ii) **Change in the trademark use or the trademark image:** If the trademark owner has changed the way that they use the trademark, they may need to make changes to their trademark registration to reflect these changes in use. The change in the trademark image may be needed in case of a cancellation action.
- (iii) **Update Contact Information:** If the trademark owner's contact information has changed, they may need to make changes to their trademark registration to ensure that the IP office has their current contact information on file.
- (iv) **Change in the trademark owner's name and/or address:** If the trademark owner has changed their trade name and/or address, they may need to record such changes in the trademark registration.
- (v) **Mergers and Acquisitions:** If the trademark owner has undergone a merger or acquisition, they may need to make changes to their trademark registration to reflect the change in ownership.
- (vi) **Correction of Errors:** If the trademark owner has made a mistake in their trademark application or if there are errors in the trademark registration, they may need to make changes to correct these errors.

As a trademark owner, you can file a request to change the information relating to the name, address, or name and address of the Trademark owner by submitting an request with the Department of Intellectual Property of Laos for recordal of such change.

The Department of Intellectual Property of Laos must record all changes in the database, record the registration, and publish the changes in the Official Gazette of Registration of Industrial Property.

Can we obtain a duplicate of a Trademark Registration Certificate in Laos?

A trademark owner may obtain a copy of the Trademark Registration Certificate for use as evidence in legal proceedings before the Lao People's Court, for Trademark registration in foreign countries, or as a substitute for a damaged or lost Trademark Registration Certificate, or for renewal. The Trademark owner who has been granted registration by the Department of Intellectual Property must submit an application form and pay a service charge to the Department of Intellectual Property of Laos.

How to cancel/invalidate a trademark registration in Laos ?

A trademark cancellation in Laos is a legal proceeding that seeks to remove a registered trademark from the trademark register. This process can be initiated by anyone who believes that the trademark in question should not have been registered or that the trademark owner is no longer using the trademark in commerce.

Deadline for filing a trademark cancellation action in Laos: Third parties are eligible to file a request to cancel or eliminate a trademark registration within five (5) years, as from the date of publication in the Official Gazette of Registration of Industrial Property.

The authority competent to handle a trademark cancellation action in Laos: The Department of Intellectual Property of Laos.

Grounds for trademark cancellation/invalidation in Laos:

Per Article 65 of the Lao IP Law, a trademark may be subject to cancellation if it

- (i) has not been used for a consecutive period of five years;
- (ii) has been used merely token use or such use not been in goodfaith by the owner.

Steps involved in a trademark cancellation proceeding in Laos:

- (i) **Filing a petition for trademark cancellation:** The first step in the trademark cancellation process is to file a petition for cancellation with the appropriate trademark office. The petition should set out the grounds for cancellation and provide evidence to support the allegations.
- (ii) **Receipt of the petition:** DIP will receive the petition for trademark cancellation and determine its validity. If the petition is deemed complete and proper, it will proceed to the next step.
- (iii) **Review of the petition:** DIP will review the petition and the evidence provided to determine whether the grounds for cancellation have been properly established. If the petition is found to be deficient, DIP may reject the petition or request additional information or evidence from the petitioner.
- (iv) **Notification to the trademark owner:** If the petition is deemed valid, DIP will notify the trademark owner of the petition and provide them with an opportunity to respond within 60 days, as from the date of issuance of the notification. In the event that that the trademark owner is unable to provide clarification, it will be considered that the trademark owner has accepted the cancellation or elimination of the trademark registration
- (v) **Review of the Response:** If the trademark owner files a response, DIP will review it and any additional evidence submitted by the trademark owner.
- (vi) **Decision:** Based on the evidence and arguments presented by both parties, DIP will issue a decision on the trademark cancellation. If the trademark is cancelled, it will be removed from the trademark register.
- (vii) The Department of Intellectual Property of Laos must cancel or eliminate the trademark registration in the event that a third party has filed a lawsuit with the Lao People's Court, and that there is a decision, which cannot be subject to appeal, to cancel or eliminate the trademark registration.
- (viii) **Notification:** The Department of Intellectual Property of Laos must notify the owner and third party of the cancellation of the registration certificate
- (ix) **Appeal:** If either party is dissatisfied with the decision, they may have the right to appeal the decision to a higher court.
- (x) **Publication:** The Department of Intellectual Property must record the cancellation in the database and publish the cancellation in the Official Gazette of Registration of Industrial Property.

What are advantages of prior use of trademarks in Laos?

The use of an unregistered trademark comes with certain risks, such as the possibility of infringing on the trademark rights of others if the unregistered mark is deemed confusingly similar to a prior registered trademark. However, there are also some potential benefits to using an unregistered mark before applying for registration, for example:

- (i) **Increasing chance of success in registering marks of low distinctiveness:** In some cases, a descriptive trademark may become distinctive through widespread use prior to the filing date. In these situations, the trademark applicant can overcome objections related to lack of distinctiveness by

providing evidence that their trademark has acquired secondary meaning or distinctiveness through use. Secondary meaning is established when the consuming public recognizes that the descriptive name is a trademark that refers specifically to the products of the applicant

- (ii) **Filing oppositions and invalidation actions:** The genuine trademark owner may use their rights based on widespread use of their unregistered mark to file a Notice of Opposition and/or an invalidation action against a registered mark in Laos, relying on either or both of the following grounds: well-known trademark or widespread use
- (iii) **Defending against an alleged trademark infringement allegation:** owners of unregistered trademarks may also be able to defend against allegations of trademark infringement by establishing their entitlement to registration in their own name if they were to apply for registration of their mark. In such cases, the owner of the unregistered trademark may bring an invalidation action against the previously registered mark, which would remove the trademark from the official registry and allow the owner of the unregistered trademark to register it in their own name.

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