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Laos Clarifies Trademark Registration Process under Its IP Law

The intellectual property framework in Laos continues to evolve with the recent Decision on Trademarks and Trade Names No. 2822/MOST, dated December 7, 2019, which was published in January and took effect on February 11, 2020. The decision brings more clarity to the mark registration process, and it had been particularly anticipated since the May 2018 publication of the Amended Law on Intellectual Property No. 38/NA dated November 15, 2017 (the “IP Law”).

The decision provides important clarifications, as the IP Law introduced major changes into the Lao trademark legal framework but lacked specific details on implementation. Below are some of the key procedural items laid out in the decision.

Expansion of Mark Types

The decision formally recognizes service marks, which were already being accepted in practice but had not been clearly indicated along with trademarks, collective marks, and certification marks.

As for unconventional marks, the IP Law had already introduced the possibility of registering 3D marks or moving pictures as trademarks, but the exact requirements were not specified until the publication of this decision.

Registration Process

According to the decision, submission of a trademark application will be followed by four main stages, ending in publication in the official gazette of intellectual property.

1. Formality Examination

The formality examination, which must be completed within 60 days, consists of the examiner verifying that the minimum requirements to file a trademark registration are met. If the documentation is deemed complete, the Department of Intellectual Property (DIP) will publish the application in the official gazette and on the website of the DIP to inform third parties of the pending registration. If the documentation is incomplete, the applicant will have 60 days to provide the missing information to the DIP.

2. Publication and Opposition

The IP Law formalized the possibility of opposing a pending trademark registration but did not provide details beyond noting that owners have 60 days from the date of publication to oppose the mark. Now, the decision clarifies that if the formality examination is successful, the application will be published in the official gazette of intellectual property within 15 days. Note that the DIP now relies on the gazette in electronic format (PDF), which renders publication faster than when gazette had to be printed.

After an opposition application is filed, the DIP’s

Department of Dispute Resolution will handle the review. The opposing party will be required to pay the relevant official fees at the time of filing.

After being notified by the DIP that the trademark registration is being contested, the applicant has 60 days to respond. Meanwhile, the DIP may request further information from either party, again within 60 days. If a party is not satisfied with the ultimate decision and explanation provided by the DIP, an appeal may be filed with the newly created Committee of Final Appeal within 60 days (see below for more details).

3. Substantive Examination

This examination, for which no timeframe has been given, focuses on the characteristics of the trademark. The examiner checks the mark’s composition, uniqueness, and eligibility under the IP Law.

With regard to geographic indications (GIs), the decision notes that it covers GIs registered abroad as well as those registered in Laos. Nonetheless, if a GI has not been registered locally, the DIP may refuse the registration of a trademark using that GI as a component of its mark.

If the DIP issues an office action with respect to substantive examination, the applicant may respond and provide supporting documents or further information to the DIP, usually within 60 days, plus a possible extension of 30 days for valid reasons.

4. Registration and Publication

Once the substantive examination has been completed, the DIP will proceed with the registration of the trademark and its publication in the official gazette of intellectual property.

Cancellation Procedure

The decision reiterates the possibility of asking for cancellation of a trademark within five years of its publication in the official gazette of intellectual property. With regard to non-use, a cancellation may be requested when a trademark has not been used for a five-year period, has only been given token use, or has not been used in good faith by the owner. The DIP will notify the owner of the request, and the owner will have 60 days to respond.

Renewal

The decision clarifies that the renewal of a trademark is possible starting from six months before the end of its term (a reduction from the previous one-year period).

Assignment

The decision provides that the transfer of rights from one entity to another must first be registered with the DIP and published in the official gazette of intellectual property. If there is a change of proprietorship of a legal entity, the trademark rights will be deemed transferred along with the proprietorship, unless the agreement states otherwise.

Authorization to Use a Trademark

The question of authorized use of a trademark may particularly interest franchisors looking to expand in Laos. Though the decision does not provide exhaustive details, it does stipulate that authorization to use a trademark must be registered with the DIP. Registration of the authorization (or a franchise agreement) will render it enforceable, whereupon the franchisee can act on behalf of the franchisor to protect the trademark in Laos.

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Trademark Representatives

Trademark owners based abroad must use a local trademark representative (such as a registered attorney or recognized IP agent) to register their trademarks in Laos. Though the decision does not mention different requirements for international registrations, it is understood that the local agent requirement does not apply to international registrations.

The decision requires trademark owners to update their standing power of attorney (POA) with their local IP representative if the POA does not mention a time period for validity (in which case it would be considered valid for one transaction only). This is a change from previous regulations and practices, which allowed POAs to exist in perpetuity.

Administrative Remedies

The decision dedicates a chapter to administrative remedies (whereby an applicant files a complaint directly with the administration in charge), which are common in dispute resolution in Laos.

In line with the IP Law, administrative remedies now focus only on issues pertaining to the registration of trademarks, and should be triggered within 90 days of the issuance of a notice from the DIP to the applicant. By means of administrative remedy, an applicant may ask the DIP:

1. To correct mistakes that may have been made by the DIP and that triggered an office action (e.g., name misspelled on the trademark certificate);
2. To correct mistakes made by the applicant; and

3. To reconsider the whole application if it is believed that the DIP has not correctly applied the law with regard to the registration of the trademark.

These requests are managed by the DIP's Department of Dispute Resolution. If desired, the applicant may appeal the department's remedy to the Committee of Final Appeal within 30 days.

Committee of Final Appeal

This is one of the main additions of the decision. The Committee of Final Appeal, which is the last recourse for a trademark owner with respect to administrative remedies, is intended to provide guidance to the DIP on contentious cases.

The committee is appointed on an ad hoc basis and is to be independent of the DIP. It cannot include people who have taken part in the registration process of the trademark in question. It is not yet known whether DIP officials who have not been involved in the registration process may be appointed, although this may be addressed in an upcoming regulation on dispute resolution of IP issues.

Conclusion

The decision is in line with other IP-related achievements over the past year, such as the modernization of the DIP website, which now provides information on the status of trademark applications and registrations. Despite some shortcomings, such as a lack of guidance on international registrations, this decision reflects the commitment of local authorities to protecting intellectual property as part of their efforts to meet internationally accepted legal standards, and is a very positive move forward for the Lao IP system. 🍷