



WEBINAR

Intellectual Property in Laos

“Trademarks & Trademark Enforcement”

Thursday, 18th June 2020

10:00 - 11:00 (CET) | 15:00 - 16:00 (GMT+7)



Mr. Dino Santaniello
Tilleke & Gibbins Laos

SUPPORTED BY:



Welcome to the Webinar

Moderator:

Nora Bihari
Project Manager
South-East Asia IPR SME Helpdesk



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IPR SME HELPDESK

Webinar Interaction Tool

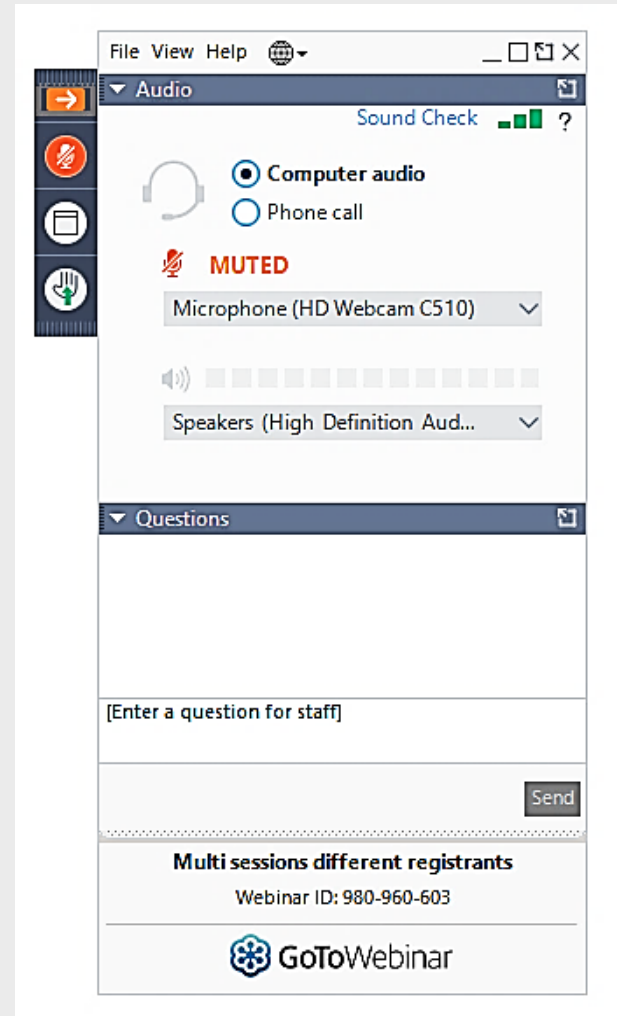
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Speakers



Ayaka Nyna VU

Executive Director

**European Chamber of Commerce
in Laos (ECCIL EuroCham Laos)**



Dino Santaniello

External Expert

South-East Asia IPR SME Helpdesk

Overview (CEST)

TIME	OVERVIEW	SPEAKER(s)
10:00 – 10:05	Introduction to the SEA IPR SME Helpdesk and its Core Service	Nora Bihari, SEA IPR SME Helpdesk
10:05 – 10:15	Introduction to the ECCIL EuroCham Laos	Ayaka Nyna VU, ECCIL EuroCham Laos
10:15 – 10:50	Intellectual Property in Laos – Focus on Trade Marks and Trade Mark Enforcement	Dino Santaniello, SEA IPR SME Helpdesk
10:50 – 10:55	Q&A session	All speakers
11:00	Closing	Nora Bihari, SEA IPR SME Helpdesk

Core Services – What We Offer

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Guides and factsheets



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Intellectual Property in Laos

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Mr. Dino Santaniello
Tilleke & Gibbins Laos

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ECCIL EUROCHAM LAOS

WHO WE ARE

- Established in 2011
- Only official representative of the European Business Community in Lao PDR
- Aim to "Make Europe the preferred business partner of Lao PDR"
- More than 80 members

WHAT WE DO

- Advocacy
- Publications
- Trade & Business support services
 - ✓ Market studies
 - ✓ Business matching
 - ✓ Organisation of delegations
- Networking
- Advertising
- Trainings & Seminars

Speaker's Bio

Name: Dino Santaniello
Firm: Tilleke & Gibbins
Location: Vientiane, Laos



Dino Santaniello is the head of Tilleke & Gibbins' office in Laos. He has broad experience across many fields of law, including patents and trademarks, privacy and data protection, corporate establishment, licensing, and other commercial transactions. Dino advises both domestic and international companies on legal matters in Laos and Thailand, and, based on the strengths of his client service and legal expertise, is recognized as a "Distinguished Practitioner" in Asialaw Leading Lawyers 2019, and as a "Leading Lawyer" in The Asia-Pacific Legal 500 2019.

Prior to joining Tilleke & Gibbins, Dino worked as an in-house counsel in the insurance and oil and gas industries. During this time, he advised on corporate and commercial issues, as well as intellectual property matters such as trade secrets and restrictive covenants.

Dino has spent significant time in studying foreign languages with the aim of helping inbound investors enter Asian markets. He is fluent in French, English, Lao, and Thai, and is conversant in Korean.



Webinar: Intellectual Property in Laos – Focus on Trade Marks and Trade Mark Enforcement

Dino Santaniello

External Expert of South-East Asia IPR SME Helpdesk

Head of Tilleke & Gibbins' office in Laos

18 June 2020

Agenda

- Overview of the Intellectual Property Framework in Laos
- Concept of a Trademark in Laos
- Trademark Registration
- Trademark Enforcement Rights and Case Studies

Laos at a Glance

- Capital: Vientiane
- Population: 7,061,507*
- Land Area: 230,800 sq. km.*
- GDP Growth: 6.48% (average 2015-2019)*
- Political System: One-party socialist republic
- GDP per sector:
 - Agriculture (about 20.9%)
 - Industry (about 33.2%)
 - Services (about 45.9%)**
- Top FDI: China, Thailand, and Vietnam

Source: *World Bank: <https://data.worldbank.org/country/lao-pdr> ; **CIA : <https://www.cia.gov/library/publications/the-world-factbook/geos/la.html>



Poll Question

Question: Are you the owner of a trademark in Laos?

- A. Yes
- B. No
- C. Not yet, but I intend to.

Overview of the Intellectual Property Framework in Laos

Lao IP Regulatory Framework

- Very nascent; however, Laos is catching up
- Authority in charge: Department of Intellectual Property (DIP), Ministry of Science and Technology.
- Current laws/regulations in place:
 - **Law on Intellectual Property no.25/NA, dated November 15, 2017. In force since June 2018. It has amended the previous Law on Intellectual Property of 2011.**
 - **Subsequent “Decisions” issued by the Ministry of Science and Technology:**
 - Decision on Trademarks and Trade Names no.2822, dated December 17, 2019
 - Decision on New Plant Varieties no.2823, dated December 17, 2019
 - Decision on Copyrights and Related Rights no.2824, dated December 17, 2019
 - Decision on Geographical Indication no.2221, dated October 2019
 - Decision on Registration through the Madrid Protocol Agreement regarding IR no.0142, dated February 13, 2017
 - Decision on Patent and Petty Patent no.0752, dated September 20, 2012
 - Decision Industrial Design no.0755, dated September 20, 2012

International Treaty/Commitment

Convention Establishing the World Intellectual Property Organization (WIPO)	January 1995
Paris Convention for the Protection of Industrial Property	October 1998
Patent Cooperation Treaty (PCT)	June 2006
Berne Convention for the Protection of Literary and Artistic Works	March 2012
Agreement Establishing the World Trade Organization (WTO)	February 2013
Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)	February 2013
Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks	March 2016

Bilateral Agreements

Singapore	Cooperation on Examination of Patent Application
Japan	Cooperation for Facilitating Patent Grant
Cambodia	Cooperation in the Field of Trademarks and Geographical Indications
China	Cooperation for Facilitating Patent Grant
South Korea	Cooperation for Facilitating Patent Grant (pending)
Vietnam	Cooperation in the field of New Plant Variety (pending)

Intellectual Property

- **What is intellectual property?**

- ☐ According to the Law on Intellectual Property no.25/NA, dated November 15, 2017:

"Intellectual Property is the work of the human mind through Inventions and creations."

- ☐ According to the World Intellectual Property Organization (WIPO):

"Intellectual property refers to creations of the mind: inventions; literary and artistic works; and symbols, names and images used in commerce."

Intellectual Property Protected in Laos

Trademarks and Trade Names

Geographical Indications

Patents and Petty Patents

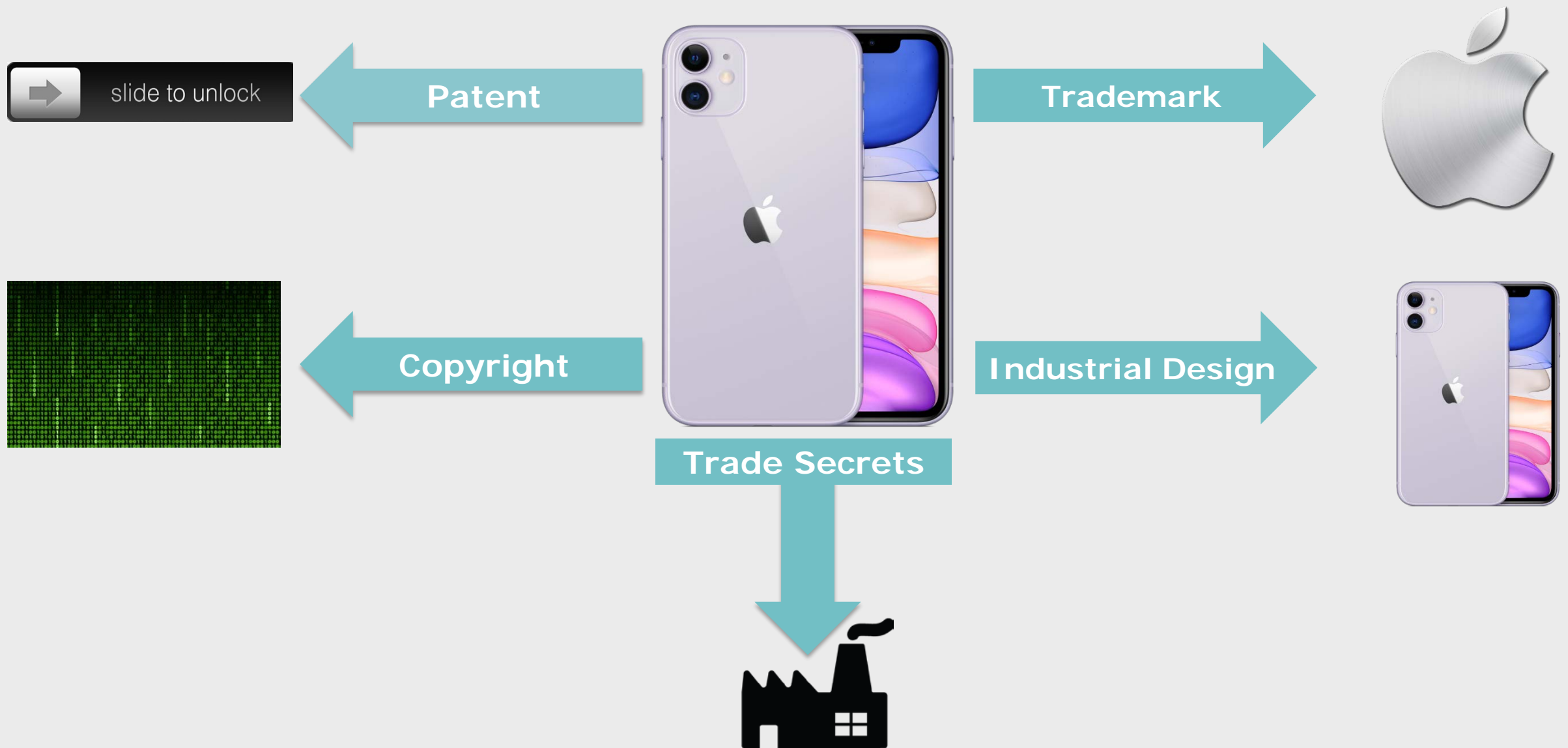
Industrial Designs

Copyrights and Related Rights

Layout Designs of Integrated Circuits

Plant Varieties

Trade Secrets



Registration of IP in Laos

- (STATISTICS TO ELABORATE/UPDATES)**

IP	2016	2017	2018	2019	2020 (June included)
Trademark	1,894	1,881	1,667	1,873	565
Trademark (Madrid)	520	1,334	1,523	2,192	882
Patent	65	101	59	71	18
Petty Patent	7	16	7	14	4
Industrial Design	2	2	6	5	22
GI	-	-	1	2	5

Focus on Geographical Indication

Foreign Geographical Indication



Scotch Whisky
(pending)



Champagne

Domestic Geographical Indication

- | | |
|--|--|
| <ul style="list-style-type: none">- Khao Kai Noi (small chicken rice, sticky rice)- Bolaven Coffee (pending)- Pakson Tea (pending) | <ul style="list-style-type: none">- Silk from Houaphan (pending)- Komen Tea (pending)- Silk from LouangPrabang (pending) |
|--|--|

Concept of a Trademark in Laos

Definition of a Trademark – Lao Perspective

- **What is a trademark ?**

- ☐ Law on Intellectual Property (Article 3):

"A trademark, refers to a mark, any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings."

- ☐ Decision on Trademarks and Trade Names (Article 2):

"A Trademark is a symbol or a combination of symbols used to distinguish the goods or services in order to distinguish the goods or services of individuals, legal entities, and organizations from the symbols of others [individuals, legal entities, and organizations]."

- ☐ WIPO:

"A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises."

Definition of a Trademark – Lao Perspective

- What a Trademark may include ?

- ☐ Law on Intellectual Property (Article 16):

It “may include words, including personal names, letters, numerals, figurative elements, 3D image, motion/animated pictures, product packaging, or combinations of colors, as well as any combination of such signs.”

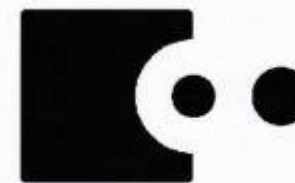
- How a trademark may be eligible ?

- ☐ Law on Intellectual Property (Article 16, 23):

- Not identical/similar to a trademark/GI previously registered, or to a well-known mark for the same class/goods.
- Not descriptive (designate the type, quality, intended purpose, place of origin of the goods, etc..).
- Not generic.
- Do not contain prohibited item.

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Trademark Registration

Reasons to Register a Trademark

- Obtain a certificate of ownership over a mark and monopoly over a mark.
- Right to prevent others from using the mark without authorization.
- Right to prevent others from using a mark of confusing similarity.
- More effective IP enforcement measures are possible.
- Registering the trademark enhances the value of the trademark.
- Trademark can be used as collateral or be licensed.

Trademark Registration

- Two possibilities:
 1. National application – the application is filed directly with the DIP; and
 2. Application through the Madrid System – the application is filed with the WIPO, on the Internet.

Trademark Certificate - National Application



Timeframe: 10 to 15 months in average

Filing

- Application form
- Power of Attorney
- Specimen
- The Class(es), along with the list of the goods or services.
- Receipts of the official fees:
 - **Official Fee: LAK 800,000 (EUR 78)**
 - **Service Fee: LAK 320,000 (EUR 31)**

Remark: Laos has a multiple-class system.

*The official fee will add LAK 800,000 for each additional class

Formality Examination

- Complete within 60 days.
- Verification that the documentation/requirements are complete.
- If the documentation is incomplete, the applicant will have 60 days to provide the missing information to the DIP.
- If complete, publication in the Official Gazette will be available.

Formality Acceptance and Publication

- If successful, publication in the Official Gazette in 15 days.
- Opposition possible within 60 days from the date of publication of the mark.
- 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 Consideration** within 60 days of the decision issued.

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.
- 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.

Registration and Publication

- 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.
- 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
- A trademark remains under potential cancellation request from third parties for a period of five years after the publication in the Official Gazette.

Trademark Certificate

- The Trademark Certificate is valid for 10 years, **from the filing date**, and can be renewed.



LAO PEOPLE'S DEMOCRATIC REPUBLIC

THE PRIME MINISTER'S OFFICE
SCIENCE, TECHNOLOGY AND ENVIRONMENT AGENCY

GRANTS

CERTIFICATE OF REGISTRATION OF TRADEMARK

Nº: 5150

TO: Tilleke & Gibbins International Ltd.

ADDRESS: 64/1 Soi Tonson, Ploenchit Road, Bangkok 10330, THAILAND.

FILING Nº: 5195

FILING DATE: January 02, 1997

PRIORITY DATE:

THIS CERTIFICATE ENTERED INTO NATIONAL REGISTRY OF TRADEMARK AND HAS LEGAL FORCE IN TERRITORY OF LAO PDR FOR THE DURATION OF 10 YEARS FROM THE DATE OF January 02, 1997 WITH POSSIBILITY TO BE RENEWED.

VIENTIANE, 28 DEC 2004
DEPARTMENT OF INTELLECTUAL PROPERTY,
STANDARDIZATION AND METROLOGY



Nheune SISAVAD
DIRECTOR GENERAL



1. **NOTE:** The words " TILLEKE & GIBBINS " and Device are Protected.
2. **COLOR:** All colors.
3. **DATE OF EXPIRATION:** January 02, 2007
4. **GOODS ACCORDING TO INTERNATIONAL CLASSIFICATION:**
- All services in International Classification: 35 and 42.

Official Gazette of Industrial Property



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LAO PEOPLE'S DEMOCRATIC REPUBLIC

ກະຊວງ ວິທະຍາສາດ ແລະ ເຕັກໂນໂລຊີ
ກົມຊັບສິນທາງບັນຍາ

MINISTRY OF SCIENCE AND TECHNOLOGY
DEPARTMENT OF INTELLECTUAL PROPERTY

ຈົດໝາຍເຫດທາງລັດຖະການ
ກ່ຽວກັບການເສີຍແຜ່ຜົນຂອງການຈົດທະບຽນ
ຊັບສິນອຸດສາຫະກຳ ຢູ່ ສປປ ລາວ
OFFICIAL GAZETTE OF INDUSTRIAL PROPERTY

ລະບັບທີ (Vol.) 79

CONTENT

- Part I: New Application of Trademark
- Part II: Registration of Trademark
- Part III: Madrid New Application of Trademark
- Part IV: Madrid Registration of Trademark
- Part V: Renewal of Trademark

Part I
New Application of Trademark

Introduction of Codes

- (540) Trademark
- (511) Classification of goods and services (Nice Classification)
- (210) Number of the application
- (220) Date of filing of the application
- (732) Name and Address of applicant

II

Official Gazette of Industrial Property Vol. 95, 12/06/2020

(540)



(511) 06
(210) No. 44341
(220) 02/03/2020
(732) ທ່ານ ເຈີນ ວັນດົງ ບ້ານ ປາກເຊືອງ
ນະຄອນຫຼວງລະບາງ ແຂວງຫຼວງລະບາງ,
Louangphrabang, Lao People'S
Democratic Republic

Part II
Registration of Trademark

Introduction of Codes

- (540) Trademark
- (511) Classification of goods and services (Nice Classification)
- (210) Number of the application
- (220) Date of filing of the application
- (732) Name and Address of applicant
- (111) Number of the registration
- (180) Expiration date of the registration/renewal

II

Official Gazette of Industrial Property Vol. 95, 12/06/2020

(540)



(511) 09
(210) No. 25606
(220) 03/01/2012
(732) ROYAL COUNTY OF BERKSHIRE
POLO CLUB LTD. North Street,
Winkfield, Windsor, Berkshire, SL4 4TH,
United Kingdom
(111) No. 46526
(180) 02/06/2030

Trademark Enforcement Rights and Case Studies

Trademark Owner Rights

- Law on Intellectual Property provide the following rights:
 - "To prevent all third parties from using [...] identical or similar signs for goods or services identical/similar of the Trademark is registered."
 - "To prevent the sale or advertising of goods bearing the Mark or the use of the Mark in connection with services, or the importation or export of goods bearing such a Mark."
- Law on Intellectual Property also expressly prohibits unfair competition and counterfeits of goods.

Remedies towards IP Infringement

Different remedies, different objectives:

- Cease-and-Desist Letter
- Civil Action
- Criminal Action
- Border Control: Customs
- Administrative Remedy
- Raid Action

Cease and Desist Letter

Objectives:

- ☐ To inform a party of its infringement activities;
- ☐ To stop the illegal activity of the infringing party;
- ☐ To inform the infringing party of the IP owner's rights to take further legal action; and
- ☐ To start negotiations – if at all possible.

Civil Action

Objectives:

- ❑ Permanent injunction – stop infringement
- ❑ Monetary damages:

Based on actual proven damages, i.e. loss of sales revenue, which is difficult to prove to the satisfaction of the Court

Criminal Action

Objectives:

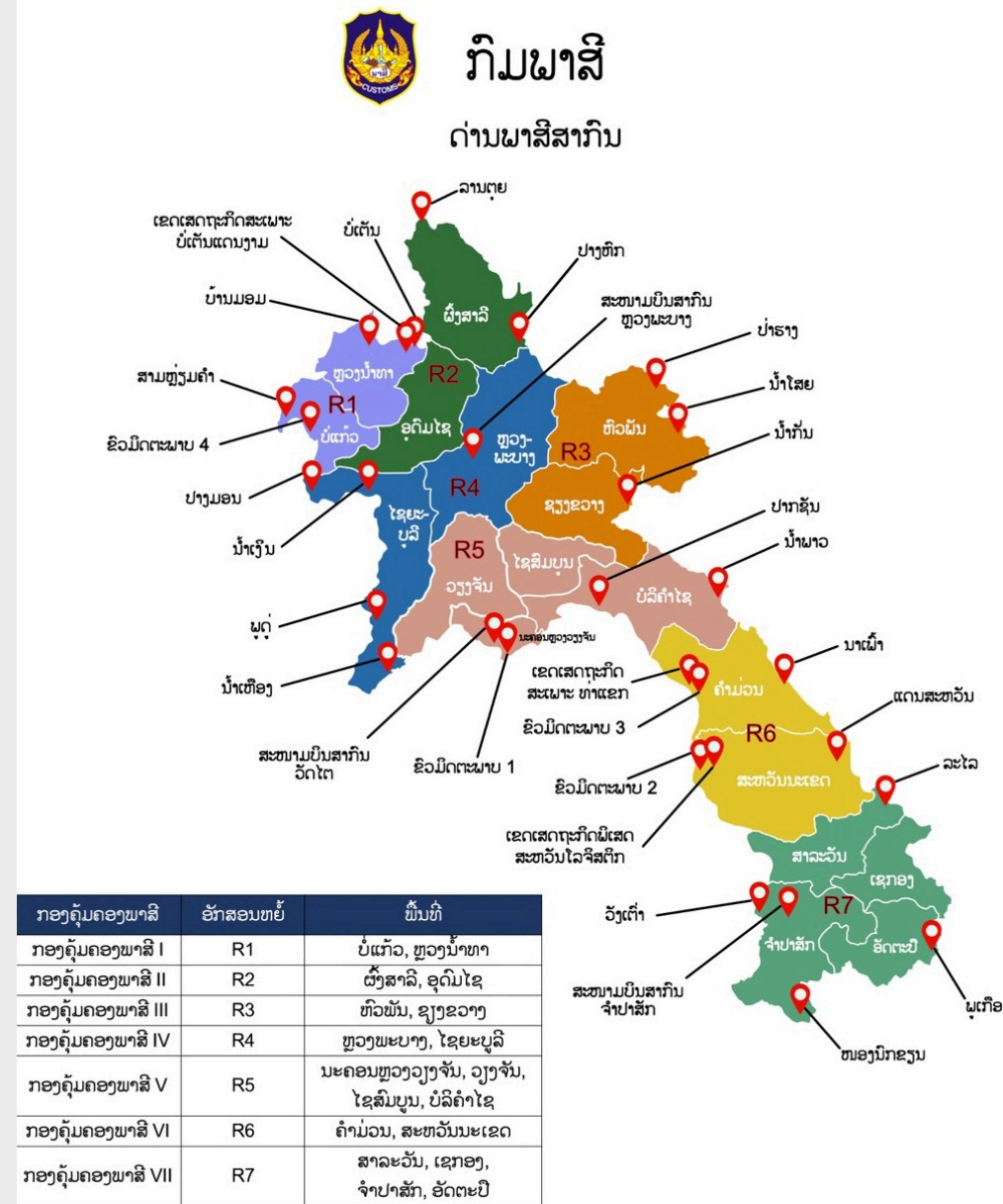
- ☐ Payment of fines
- ☐ Imprisonment
- ☐ Destruction of infringing goods

Border Control – Customs Recordal

Customs officers have the authority and responsibility to inspect any suspected goods, seize suspected infringing goods.

Objectives:

- Stopping infringement before reaching the Lao marketplace; and/or
- Destruction of infringing goods.



Administrative Remedy

- A brand owner can file a complaint with the DIP if it notices that its rights are being infringed in Laos

Objective:

- Starting the mediation process under the supervision of the relevant authorities.

Administrative Remedy – Raid Action

- With the cooperation of officers from various ministries and the police force, retail/wholesale shops, markets, or warehouses can be inspected. If evidence is found, the following can be performed:

Objectives:

- Seizure of counterfeit goods;
- Destruction of infringing goods; and/or
- Gathering of evidence (supplier/manufacturer) for further legal action.



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Thanks for your attention

Questions?

SEA Helpdesk – Upcoming Webinars

Date	Upcoming Webinar	Speaker
Mon 22 June	<u>COVID-19 Impact on IP Protection in South-East Asia</u>	Franck Fougere, Ananda Intellectual Property (Thailand- Hong Kong)
Wed 24 June	<u>The Impact of the Pandemic on Brand Protection and IP in China and South-East Asia</u>	Simon Cheetham, Erinyes International Ltd.
Fri 3 July	<u>Webinar: Counterfeiting and Brand Protection during COVID-19 in Myanmar</u>	Yuwadee Thean-ngarm, Tilleke & Gibbins in Myanmar

Thank you for your attention!
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