



WEBINAR

# Intellectual Property in Laos

## “Trademarks & Trademark Enforcement”

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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**



# Webinar Interaction Tool

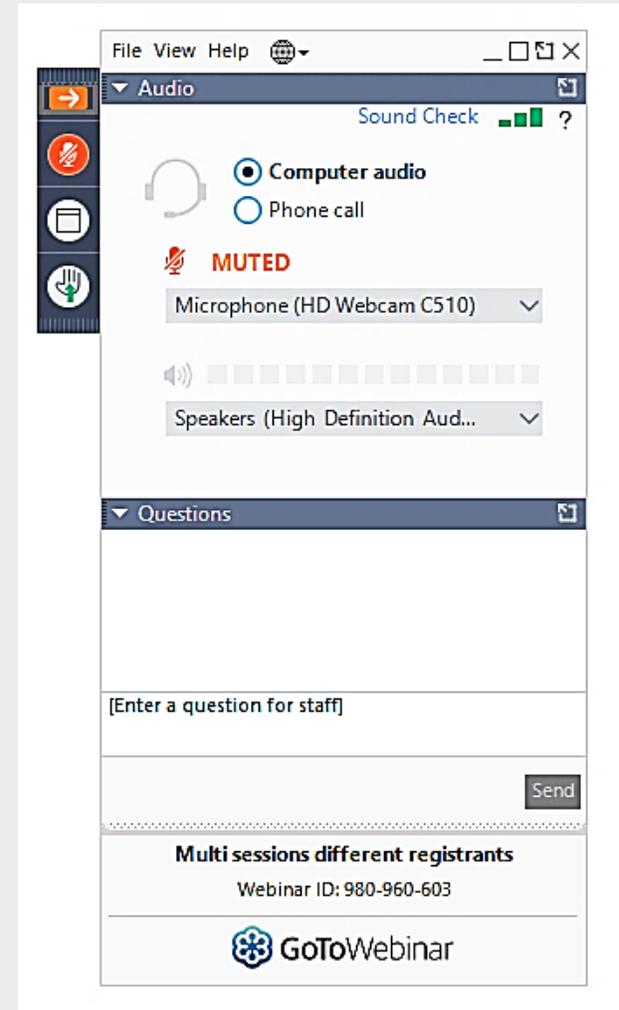
*Hide Control Panel here* →

*View in Full screen mode here* →

*Raise your hand here* →

*Send the IP expert a question here* →

**Webinar 24 hour technical support number:**  
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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)

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

# Core Services – What We Offer

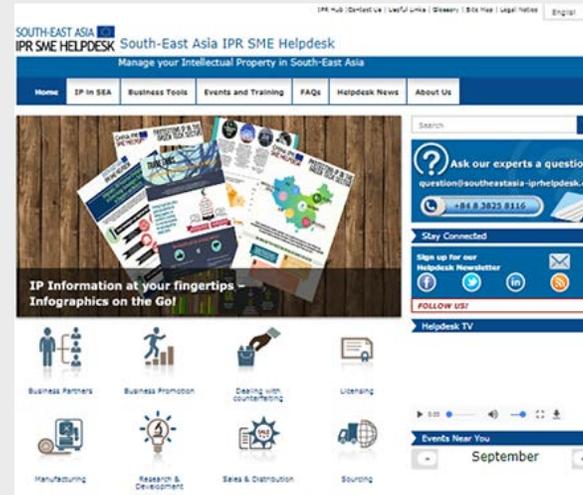
## Enquiry Helpline



## Training Workshops



## Website & Blog Newsletter, E-Bulletin



## Webinars and E-learning modules



## Guides and factsheets



**SOUTH-EAST ASIA  
IPR SME HELPDESK**



WEBINAR

# Intellectual Property in Laos

## “Trademarks & Trademark Enforcement”

Thursday, 18th of June 2020

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



**Mr. Dino Santaniello**  
Tilleke & Gibbins Laos

SUPPORTED BY:



# 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

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

# Bilateral Agreements

|                    |   |
|--------------------|---|
| <b>Singapore</b>   | Cooperation on Examination of Patent Application                    |
| <b>Japan</b>       | Cooperation for Facilitating Patent Grant                           |
| <b>Cambodia</b>    | Cooperation in the Field of Trademarks and Geographical Indications |
| <b>China</b>       | Cooperation for Facilitating Patent Grant                           |
| <b>South Korea</b> | Cooperation for Facilitating Patent Grant (pending)                 |
| <b>Vietnam</b>     | 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<br>(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

- Khao Kai Noi (small chicken rice, sticky rice)
- Bolaven Coffee (pending)
- Pakson Tea (pending)

- 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):

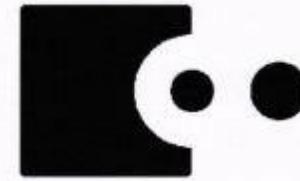
- Not identical/similar to a trademark/GI previously registered, or to a well-known mark for the same class/goods.
- Not descriptive (designate the type, quality, intended purpose, place of origin of the goods, etc..).
- Not generic.
- Do not contain prohibited item.

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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**

N°: 5150

**TO:** Tilleke & Gibbins International Ltd.

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

**FILING N°:** 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



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

# Official Gazette of Industrial Property

**SOUTH-EAST ASIA  
IPR SME HELPDESK**

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ສາທາລະນະລັດ ປະຊາທິປະໄຕ ປະຊາຊົນລາວ  
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

ສະບັບທີ (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

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II

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

(540)



(511) 06  
(210) No. 44341  
(220) 02/03/2020  
(732) ທ່ານ ເຈີນ ວັນຕິງ ບ້ານ ປາກເຊືອງ  
ນະຄອນຫຼວງລາວ ແຂວງຫຼວງລາວ,  
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

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II

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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.

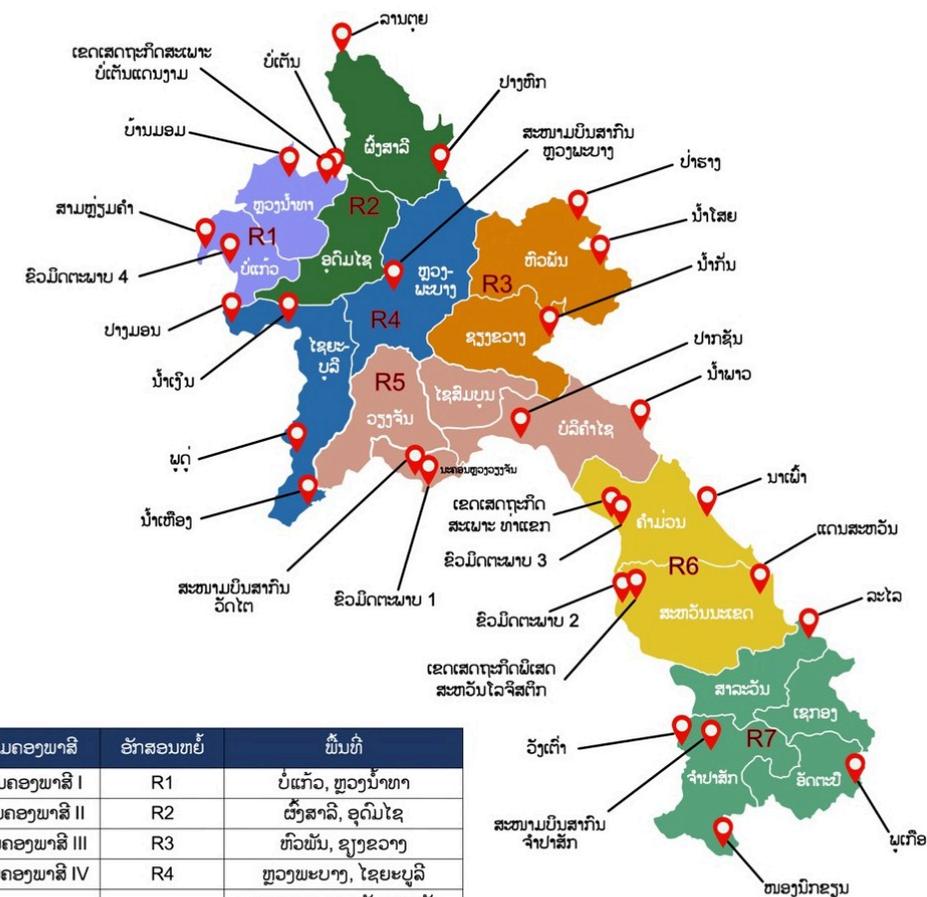
## Objectives:

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



ກົມພາສີ

ດ່ານພາສີສາກົນ



| ກອງຄຸ້ມຄອງພາສີ     | ອັກສອນຫຍໍ້ | ພື້ນທີ່                                      |
|--------------------|------------|--|
| ກອງຄຸ້ມຄອງພາສີ I   | R1         | ບໍ່ແກ້ວ, ຫຼວງນໍ້າທາ                          |
| ກອງຄຸ້ມຄອງພາສີ II  | R2         | ຜົ້ງສາລີ, ອຸດົມໄຊ                            |
| ກອງຄຸ້ມຄອງພາສີ III | R3         | ຫົວພັນ, ຊຽງຂວາງ                              |
| ກອງຄຸ້ມຄອງພາສີ IV  | R4         | ຫຼວງພະບາງ, ໄຊຍະບູລີ                          |
| ກອງຄຸ້ມຄອງພາສີ V   | R5         | ນະຄອນຫຼວງວຽງຈັນ, ວຽງຈັນ, ໄຊສົມບູນ, ບໍລິຄໍາໄຊ |
| ກອງຄຸ້ມຄອງພາສີ VI  | R6         | ຄໍາມ່ວນ, ສະຫວັນນະເຂດ                         |
| ກອງຄຸ້ມຄອງພາສີ VII | R7         | ສາລະວັນ, ເຊກອງ, ຈໍາປາສັກ, ອັດຕະປື            |

# 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?**

**SOUTH-EAST ASIA  
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# SEA Helpdesk – Upcoming Webinars

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

**Thank you for your attention!**  
**Stay connected!**



Channel: <http://www.ipr-hub.eu/desk TV>



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