



Industrial Design Law: A Comprehensive Guide



INTRODUCTION

Significant progress has been made in intellectual property updates in Myanmar, marking 2023 as a milestone for enforcing all IP laws (excluding the Patent Law) and establishing respective implementing rules and procedures. This article offers comprehensive coverage of these developments, specifically focusing on the registration process and the legal aspects of criminal and civil proceedings related to industrial designs.

Industrial Design Law

On 18 October 2023, the **Industrial Design Law 2019** ("Law") officially took effect following a notification from the State Administration Council ("**SAC**"), which declared 31 October 2023 as the designated enforcement date for the Law. Myanmar's new industrial design law marks the country's first recognition of design protection. It establishes a comprehensive framework for safeguarding rights in visual object design, emphasizing domestic and international novelty. The Law grants five years of protection, extendable for two additional five-year terms, totaling a maximum of 15 years. Priority is given to applications filed within six months in the Paris Convention or WTO member states. Owners, heirs, and assignees can enforce protection through civil action, with criminal offences carrying penalties of up to one-year imprisonment and MMK 2 million fines for fraudulent registrations and unauthorized disclosures.

Industrial Design Registration Rules

The Ministry of Commerce ("**MOC**") issued the **Industrial Design Registration Rules** ("**Rules**") on 29 September 2023. These Rules provide detailed guidelines and procedures related to industrial design registration, including description, classification, the appointment of representatives,



examination, opposition processes, registration and recording, waiver of rights, amendment protocols, renewal procedures, transfer processes, and industrial rights protection in Myanmar. These Rules recently came into effect concurrently with the enforcement of the Law on 31 October 2023.

Priority Rights:

These Rules incorporate two important mechanisms: the right of priority and exhibition priority. To claim the right of priority, applicants must specify the date of application initially filed in any Paris Convention or WTO member country, providing relevant details. Similarly, the right of exhibition priority can be claimed by indicating the date of the first display at a recognized international exhibition held in a Paris Convention or WTO member country. Within three months of the current application, applicants must furnish a certificate from exhibition authorities confirming the design's display and its alignment with the application. If the start date of the exhibition differs from the initial public display date of the industrial design in that exhibition, evidence for both dates is required. If the applicant is not an original exhibitor, proof of transferring the right of exhibition priority from the initial exhibitor must be provided.

Application Submission:

Applicants can use Application Form ID-1 in either Myanmar or English and submit it through the electronic system, in person, or via recognized postal services. The application should include details such as the applicant's name and address, citizenship, representative's details if appointed, creator's information if different

from the applicant, product details, and a brief description.

Design Descriptions:

Applicants must submit industrial design descriptions through drawings, photographs, or graphic representations on white A4 paper. Electronic submissions in JPG format with specified resolution are accepted. Designs should be presented independently without mixing with others, with a background colour that enhances the product's shape. According to the International Industrial Design Classification (Locarno classification), all products to be applied must belong to a single class, and the total number of industrial designs must not exceed 100. A single application can cover multiple designs in the same Locarno classification. If various designs are in one application, they can be separated into new applications for a fee.

Registration Process:

The industrial design registration process involves an initial examination by examiners, who forward compliant applications to the registrar. Non-compliant applications are notified for amendments within 30 days, and failure to comply results in abandonment. The registrar then takes action by rejecting non-compliant applications and making public announcements for compliant ones. The initial registration for an industrial design is five years and can be renewed twice, each for five years. The total duration of an industrial design registration is 15 years.

Re-Application and Corrections:

If an applicant fails to comply within 30 days of receiving a notice to amend an industrial design registration application, leading to the loss of associated rights, they can submit a re-application within 60 days of abandonment using Application Form ID-3. The registrar will review the re-application; if information is incomplete, the applicant has an additional 30 days to make amendments.

Multiple Designs and Classification:

Applicants seeking to withdraw multiple industrial design registrations can use Application Form ID-5 before the approval or denial of registration for all or specific industrial designs within the application for multiple industrial design registrations. The process of dividing an application containing multiple industrial designs into separate applications is outlined in Rules 26 to 30. To initiate this division, applicants must use Application Form ID-6 and ensure that the requested divisions align with the original application's scope and quantity without surpassing the industrial design description.

Objections and Appeals:

Section 31 of the Law permits objections to industrial design registration by submitting an objection letter using Application Form ID-7 within 60 days of the announcement. Rule 32 outlines the required information, including application details, applicant and objector information, legal grounds for objection, and relevant design details. Upon receiving the objection letter, the registrar checks for timely submission and completeness.

Approval or Rejection:

The industrial design registration process involves various stages. If there are no objections to the application for industrial design registration or if such objections are withdrawn or refused, the registrar notifies the applicant to pay the registration fee within 60 days, or the registration is considered abandoned. Upon approval, the registrar records and publicly announces it. In case of refusal, the rejection is recorded and announced. If registration is granted, an industrial design registration certificate is issued.

Renewal, Waiver, and Corrections:

Owners of registered industrial designs can waive their rights, wholly or partially, by submitting Application Form ID-9 to the registrar. To request corrections, they can use Application Form ID-10 for typographical errors, nationality/address updates, or other inaccuracies, excluding certain details. Rule 43 outlines the application process, requiring information such as the registration number, owner's details, representative information (if applicable), amendment details, and fee payment proof.



Transfer and Authorization:

To record the transfer of industrial design rights ownership, the owner or transferee can use Application Form ID-12. The application must include the industrial design registration number, current owner's information, recipient's details, evidence of transfer, and proof of fee payment. The announcement related to the application for recording the ownership transfer includes registration details, product category, recipient information, and design description.

Cancellation of Authorization:

The owner of an industrial design or an authorized person can request the cancellation of the recordation of a license by submitting Application Form ID-14 before the specified expiration period prescribed in Rule 60 (i). The cancellation announcement must contain essential information, including the industrial design registration number, owner's name and address, representative details if applicable, authorized person's name and address,

representative details if applicable, and product category details for the design to be cancelled from the register.

Invalidity and Cancellation:

This section outlines the process for declaring the invalidity and cancellation of an industrial design registration. Application Form ID-15 must be submitted to the registrar to initiate this process, accompanied by the necessary fee. The application must include the design registration number, owner's information, grounds for invalidity, and evidence. If the application is complete, the documents are forwarded to the design owner, who has 60 days to respond with a defence.

Appointing Representatives:

The Application Form ID-2 is for the appointment of a representative, and the applicant must sign it. Foreign applicants must notarize the forms with a Notary Public in their respective countries. Multiple representatives can be appointed. Cancellation of a registered representative can be requested through Application Form

ID-17, including specific details and an effective cancellation date.

Dispute Settlement:

If any dispute arises from these registrations, the concerned parties must settle the dispute amicably or with alternate dispute resolution, such as arbitration or legal proceedings at a relevant court in the Union.

Notifications on Jurisdiction of Industrial Design Courts

Establishment of Jurisdiction for Intellectual Property Courts:

The Law grants the Union Supreme Court of Myanmar ("**Supreme Court**") the power and authority to establish Intellectual Property Courts ("**IP Courts**") for handling criminal and civil cases related to intellectual property rights. On 27 October 2023, the Supreme Court issued a significant ruling, creating procedures and empowering the relevant courts to resolve industrial design cases through multiple notifications. These notifications were enacted on 31 October 2023 when the Law was enacted.

Judicial Power for Industrial Design-Related Criminal Cases:

Criminal cases under the Law will be heard by IP Courts and judges authorized by the Supreme Court through notifications. These notifications specify the following Courts with the jurisdiction to handle criminal cases related to industrial designs:

- (i) Under Section 66(c) of the Law, the Courts of the Self-Administered Divisions/States and respective District Courts have the authority to handle the original criminal cases that fall under the jurisdiction of the IP Courts and
- (ii) Under Section 66(d) of the Law, the High Courts of Regions and States can hear appeals and revision cases against criminal judgments, orders, and decisions issued by the Courts of the Self-Administered Divisions/States and respective District Courts.

Judicial Power for Industrial Design-Related Civil Cases:

The Supreme Court notifications further granted IP Courts the power to handle civil cases, consider applications for provisional measures, address applications for ex parte orders of provisions measures, and hear appeals against decisions made by the **Intellectual Property Agency** ("**Agency**") (an intra-departmental body overseeing appeals from the industrial design registrar). The IP Courts granted the civil adjudication power under the notifications are:

- (i) Under Section 66(d) of the Law, the Yangon High Court is authorized to handle appeal and revision cases against judgments, orders, and decisions made by the IP Courts in civil cases; and
- (ii) Under Section 66(c) of the Law, the Kyauktada District Court has been given the original civil jurisdiction and authority to handle civil cases involving industrial design infringements and applications for provisional measures.

Furthermore, under Section 66 (e) of the Law, the Yangon Region High Court has been granted jurisdiction and authority to decide on appeals against decisions made by the Agency per Section 65 of the Law.

Lawsuit Adjudication Procedures

On 27 October 2023, the Supreme Court issued the **Procedures for Adjudicating Lawsuits under the Industrial Design Law ("Procedures")**, which are to be followed when resolving lawsuits related to industrial design infringement.

Criminal and Civil Proceedings under the Law:

When dealing with criminal cases related to Law, the IP Court will follow the Code of Criminal Procedure provisions. On the other hand, civil suits for infringement of intellectual property rights must adhere to the Code of Civil Procedure and Limitation Act provisions. Chapters III and IV of the Procedure outline the prosecution of criminal and civil charges. Chapters IV and V of the Procedures guide various issues, such as cancelling industrial design registration, appealing the registrar's decision to the Agency, and challenging the Agency's decisions in the IP Court. To file a complaint, one must present clear arguments on industrial design infringement, the amount of monetary damages claimed, and the calculation method used to arrive at the claimed amount.

Appeal to Intellectual Property Court against Agency Decision:

An individual dissatisfied with an Agency's decision can appeal to the IP Court within 90 days of receiving the decision. Eligibility to appeal to the IP Court requires participation in the appeal filed with the Agency. When initiating an appeal against the Agency's decision to the IP Court, the Agency and any interested party affected by its decision will be included as respondents, as the court's ruling becomes binding on the Agency. The Code of Civil Procedure must be followed for a representative appointment. The IP Court records applications under the Law in its register. The appeal process involves submitting the Agency's decision, supporting affidavits, and initiating civil miscellaneous proceedings. The applicant

delivers a summons to the respondent and confirms the delivery within a deadline. Failure leads to rejection or rescheduling. The respondent submits response letters before the hearing, accompanied by supporting affidavits and documents. Failure to respond may result in the case being treated as undefended. Revised responses require court permission and an accompanying affidavit. The court does not admit new evidence, but exceptions may be made if necessary. The court's decision is binding, either upholding the Agency's decision or annulling it with possible additional orders. If annulled, the court's order is sent to the Agency.

Notifications Regarding Application Forms and Fees

Under the MOC, the Intellectual Property Department (IPD) issued notifications on 27 October 2023 and 29 December 2023 to prescribe essential application forms and service fees for industrial design registration. Refer to the table below for detailed information.



Application Form No	Type of Application	Services to be Applied	Fees (MMK)
ID - 1	Application for registration of industrial design	Examining the application for registration of industrial design	120,000
ID - 1a	Statement justifying the applicant's right to the registration of industrial design	-	-
ID - 2	Appointment of representative for industrial design	-	
ID - 3	Request for the reinstatement of an application for industrial design	Examining the request for the reinstatement of an application of industrial design	65,000
ID - 4	Request for correction of an application for industrial design	Screening and correcting the request for correction of an application	35,000
ID - 5	Request for withdrawal of an application for industrial design registration	-	-
ID - 6	Request to divide the application	Screening and dividing the request to divide the application	100,000
ID - 7	Opposition to the registration of industrial design	Examining the opposition for registration of industrial design	100,000
ID - 8	Request to issue certified copies of the registration certificate	Screening and allowing the request to issue certified copies of the registration certificate	35,000
ID - 9	Request for surrender of rights over industrial design registration	-	-
ID - 10	Request for amendment of registration of the industrial design	Screening and amending the request for amendment of registration of the industrial design	35,000
ID - 11	Request for the renewal of industrial design registration	Screening and recording the request for the renewal of industrial design registration	220,000
ID - 12	Request for recordation of transfer of rights of industrial design	Screening and recording the request for recordation of the transfer of the rights of industrial design	80,000
ID - 13	Request for recordation of a license of registered industrial design	Screening and recording the request for recordation of a licensed registered industrial design	80,000

Application Form No	Type of Application	Services to be Applied	Fees (MMK)
ID - 14	Request for cancellation of the recordation of a license of the registered industrial design	-	-
ID - 15	Request for the invalidation of the registered industrial design	Reviewing the request for the invalidation of the registered industrial design	150,000
ID - 16	Request for changing the representative	Screening and approving the request for change the representative	20,000
ID - 17	Request for the removal of the representative	-	-
ID - 18	Request for a time extension	Screening and allowing the request for a time extension	35,000
ID - 19	Application for appeal	Reviewing the application for appeal	300,000
ID - 19a	Request for the appointment of a representative for appeal for industrial design	-	-
		Recordation of industrial design registration	100,000
		Requesting to postpone the announcement	35,000

Notification Regarding Industrial Design Registration Procedure

On 31 January 2024, the IPD officially announced that 1 February 2024 will be the official date for accepting industrial design applications, both online and in person, per the Law and Rules. As of 5 February 2024, the IPD has once again released an announcement detailing the application process for filing industrial design registrations by the owners.

Application Forms:

Application Forms ID-1 are available for download on the IPD website. It is imperative to fill out the form completely and accurately to obtain the filing date.

Representative Applications:

If filing through a representative, Application Form ID-2 must be submitted. Representatives must have completed the representative training course and obtained the representative certificate from the MOC.

Guidelines:

Detailed guidelines for filling out forms are provided on the IPD website.

Payment Methods:

Application payments can be made using the Point of Sale (POS) system. Accepted payment methods include:

- MPU Card issued by any bank in Myanmar
- CB Pay
- AYA Pay
- Visa/Master/JCB/UPI Card issued in Myanmar or various foreign countries.

Fees:

The initial fee for industrial design registration varies based on the number of registered designs. Furthermore, an additional fee is applicable if you request to postpone the announcement. Here's a breakdown:





- For one quantity of industrial design: 120,000 MMK- (35,000 MMK/- for postponement).
- For two quantities of industrial design: 240,000 MMK- (70,000 MMK/- for postponement).

Key Points to Note When Applying for Industrial Design

Application Period:

Starting 1 February, applications can be submitted to the IPD.

Priority Rights:

Applicants can apply for priority rights as per Sections 39 and 40 of the Law and priority rights related to trade fairs.

Application Methods:

Applications can be submitted manually or electronically through the WIPOFile system. It will be necessary to visit the IPD in Nay Pyi

Taw or its branch offices in lower and upper Myanmar for manual submissions.

Number of Designs:

Up to 100 industrial designs can be included in a single application submitted manually, while the electronic system allows one design per application.

Fees:

A fixed fee must be paid based on the number of designs applied. Additional fees apply for the postponement of the announcement.

Electronic Application Requirements:

- Complete all information in the WIPOFile System.
- Submit the prescribed fee via electronic payment.
- Fill out Application Form ID-2 for the appointment of a representative.
- Provide necessary evidence as specified.

Manual Application Requirements:

- Fill out Application Form ID-1 completely.
- Submit Application Form ID-2 if applicable.
- Pay the specified fee via the POS system.
- Provide necessary evidence as specified.

Language Requirement:

All documents must be submitted in Myanmar or English. Non-English documents must be translated with a signed declaration of accuracy.

Representative Qualifications:

Representatives must be at least 18 years old, be Myanmar residents, and hold a national identity card. They must also complete the industrial design registration representative course.

International Representatives:

If a representative is appointed residing outside Myanmar, a certified copy of Application Form ID-2 by a Notary Public is required.

Filing Requirements:

To secure a filing date, ensure that all specified fees are paid and meet basic requirements, including providing a clear design description, labelling products appropriately, and submitting necessary documents.

Are you seeking assistance with Myanmar's recent changes to industrial design laws? Our law firm provides comprehensive legal support, including industrial design registration, protection strategies, and advisory services to help you navigate the new laws effectively. Whether you require assistance with an application process or personalized legal advice tailored to your specific needs, our team of legal experts is available to assist you. We are committed to safeguarding your intellectual property rights in Myanmar's ever-changing legal landscape. Schedule a consultation today to discuss your industrial design requirements.

The information provided here is for information purposes only and is not intended to constitute legal advice. Legal advice should be obtained from qualified legal counsel for all specific situations.