

OVERVIEW OF THE PATENT LAW AND REGULATIONS IN MYANMAR



Introduction

In 1945, the Myanmar Patents and Designs Act was drafted but was never brought into force. The Act was repealed in 1993, leaving Myanmar without legal protection for patents and designs. This situation persisted until a pivotal moment in 2019 when the Ministry of Commerce ("MOC") introduced the highly anticipated Patent Law ("Law"), marking a significant milestone in the intellectual property landscape. This comprehensive legislation was enacted on 1 June 2024, under Notification No. 106/2024 issued by the State Administration Council ("SAC"). Shortly after, on 4 June 2024, the MOC released the Patent Rules ("Rules"), providing detailed guidelines for

implementing the new Law. These developments signal a new era of innovation and protection for inventors and businesses.

What is a Patent?

A patent is a legal document granted by a government that gives an inventor exclusive rights to make, use, sell, and distribute an invention for a specified period, typically 20 years from the filing date. This right is provided in exchange for the public disclosure of the invention's details. Under the Law, a patent is defined as an intellectual property right granted to protect an invention. The Law also introduces the concept of a utility model, which refers to a technical creation that enhances a product's

form, structure, utility, or performance. Patents encourage innovation by allowing inventors to recoup development costs and potentially profit from their inventions while eventually contributing to the public domain. An invention must be novel, non-obvious, and valuable to be patentable.

Governing Bodies

The MOC is the primary authority responsible for implementing the Patent Law and its regulations. Other vital ministries involved include the Ministry of Information, the Ministry of Industries, the Ministry of Agriculture, Livestock and Irrigation, and the Ministry of Education. The Intellectual Property Department ("**Department**"), operating under the MOC, handles all matters related to intellectual property rights, encompassing patents, copyrights, industrial designs, trademarks, and other intellectual property types. The Law also established the Intellectual Property Agency ("**Agency**"), which oversees intellectual property rights enforcement and regulation.

Patent Eligibility and Exclusions

According to the Law, an invention eligible for patent protection must satisfy several criteria. First, it must be novel, meaning it cannot have been previously disclosed to the public in any form before the patent application date. Second, it must involve an

inventive step that is not obvious to experts in the relevant technical field. Third, the invention must be industrially applicable and capable of being produced or used in various industrial enterprises.

However, certain inventions are explicitly excluded from patent protection, including discoveries, scientific theories, mathematical methods, business methods, pure computer programs, and specific biological processes and products. Additionally, pharmaceutical products and processes were ineligible for patent protection until 1 January 2033 unless otherwise specified by the Myanmar Government, and agricultural chemicals, food products, and microbiological materials were ineligible until 1 July 2021, unless specified otherwise by the Union Government in accordance with TRIPS Council policy under the WTO. Thus, the period for patenting agricultural chemicals, food products, and microbiological materials has expired. However, there is a lack of clarity on whether this period will be extended or whether the patent for these inventions will begin shortly. We believe it will be clarified in due course.

Eligible Applicants

Eligible applicants for patent rights include inventors, licensees, and transferees, with joint inventors able to apply together. The earliest applicant is entitled to the patent if multiple inventors independently create the same invention. Co-inventors can jointly submit a patent application.

The Law also outlines the employer's and employee's rights regarding patent applications. When an invention is made under an employment agreement, the employer can apply for the patent unless the agreement states otherwise. Suppose the employer fails to apply within six months of being notified in writing by the employee that the invention has been completed. In that case, it is presumed that the employer has abandoned the claim, allowing the employee to apply for the patent. Additionally, suppose the employee applies for a patent within one year after the employment agreement expires, and the invention relates to the former employer's field. In that case, it is considered to have been made under the expired agreement. The employer can apply for the patent unless the agreement contradicts this, and the employee can prove the contradiction.

The employee has the right to apply for the patent under certain conditions: if the former employer agrees not to apply for the invention, if the employer cannot refute the employee's evidence, or if the employer fails to apply for the patent within the specified time. Additionally, suppose an employee invents something not assigned by the employer but uses the employer's materials or data, and the invention relates to the employer's business. In that case, the employee can apply for the patent unless the employment agreement states otherwise. The employee can apply for the patent for any other inventions not covered by these

conditions, provided there is no contrary agreement.

Application Process

Eligible applicants must apply to the Registrar (the Director-General of the Department that is handling matters related to the registration of intellectual property rights) to obtain the rights to patents or utility models by submitting their applications using the prescribed form, accompanied by proof of fee payment through the specified electronic system, in person, or by post to the Registrar.

Applications can be completed in Myanmar or English and may require translation upon the Registrar's request, accompanied by a signed statement of accuracy. Applicants must provide detailed information, including their identity, the invention's description, and any additional required details as requested by the Department and Agency. The date the Department receives the patent application will be considered the filing date, provided the fees are paid. If the applicant is not the inventor, they must describe that such an applicant is eligible for filing the application and inventor information. Applicants may claim priority rights or exhibition priority rights with supporting documentation.

Furthermore, before any decision is made regarding patent rights, applicants can correct typographical errors using the prescribed form and proof of payment.

Amendments must specify the changes and must not exceed the original description. Examiners will notify applicants to amend incomplete information, if any, within 60 days. The Registrar will approve or reject amendments based on the Examiner's opinion, recording the decision and notifying the applicant.

In addition, the patent examination, opposition, and registration process involve several steps under the Law and Rules: An Examiner initially categorizes patent applications based on international classifications and assesses compliance with statutory provisions under the Law. Applications meeting the requirements proceed to the Registrar with the Examiner's remarks, while those not meeting the criteria are notified to amend within 60 days; failure to do so results in withdrawal. The Examiner then re-examines amended applications.

The Registrar reviews the Examiner's remarks on the patent application and, if it meets the requirements, publishes it after 18 months from the filing date or sooner if early publication is requested. Anyone who wants to oppose the patent application has 90 days from the publication date to do so. Upon receipt of objections, the Registrar notifies the applicant for defense and then decides to continue, amend, or revoke the application based on the opposition and the Examiner's reports.

Finally, the Registrar grants or refuses patents, records decisions, issues certificates for granted patents, handles international filings, allows amendments for errors, and ensures confidentiality if national security concerns arise. Under the Rules, the Registrar may verify the Examiner's remarks to approve or reject patents. Approved applicants must pay a registration fee within 60 days; failure results in abandonment. Rejected applicants are informed of the reasons. True copies of damaged or lost certificates can be applied using the prescribed form with proof of payment.

Moreover, a utility model can be applied if the invention is novel and industrially applicable, excluding procedures, substances, or compounds (chemical, pharmaceutical, biological, metallurgical), items not patentable under this Law, and natural sculptures, architectures, or ornaments. The application must clearly describe the invention's utility and performance improvements. The utility model term is ten years. The application process involves examination, possible amendments, public announcements, and an opposition period. If no opposition is received or the opposition is resolved, the Registrar grants the utility model application. The Registrar can also revoke the utility model application if it does not meet the requirements. The applicant shall not apply for both a patent and a utility model certificate for the same invention simultaneously or separately.

The Rules outline the procedures for filing objections against patent and utility model applications. Objectors must submit their objection letters using the prescribed form within specific timeframes (90 days for patents and 60 days for utility models) from the announcement date. If the objection involves publicly accessible publications and detailed descriptions, copies of such documents must be provided. The Examiner will review the completeness of the objection, request amendments if necessary, and submit findings to the Registrar. The applicant will be notified and given a chance to defend, followed by possible rebuttals from the objector. The Examiner may request further clarifications or summon the parties. The Registrar will scrutinize the findings and decide whether to amend or withdraw the application, notifying all parties involved. An objector can withdraw their objection before a decision is made by submitting the prescribed form, ceasing any further action on the objection.

Under the Rules, any person who wishes to register as a patent agent can apply to the Registrar using the prescribed form and proof of payment of fees. The Rules detail convictions and statutes that disqualify applicants. The applicants for patent agent registration must be citizens, at least 18, with relevant qualifications and training. Approved agents are recorded and issued certificates valid for three years. A patent agent can renew their registration certificate by paying the renewal fees and completing

refresher courses. Agents can be removed from the register for specific violations.

Rights and Responsibilities of Patentees

Patent rights under the Law grant a patentee exclusive privileges during the patent term. These rights include preventing others from manufacturing, using, offering for sale, selling, or importing patented products without authorization and controlling patented production processes. The patentee has the right to pursue legal action against infringement, transfer or license their patent rights. Exceptions to patent rights include non-commercial or experimental use, temporary importation due to unforeseen events, and prior use in good faith before the patent application date.

When a patent is owned jointly by more than one person, unless otherwise agreed upon, each co-owner retains an equal and undivided share in the patent rights and can independently transfer, license, or enforce these rights against infringers.

Furthermore, transferring patent rights involves applicants and patentees applying to the Registrar to record such transfers to individuals or legally formed organizations, subject to specified regulations. Upon payment of prescribed fees, the Registrar publicly records the transfer and announces it. It is essential to note that the

transfer of patent ownership only becomes effective upon application and recording by the Registrar. Additionally, concerning inventions derived from genes, biological resources, or traditional knowledge of the Union, the Agency may require patentees to transfer profits from patent-related activities to relevant organizations. If issues concerning public interest or morality arise after such transfers, the Agency may withdraw the patent application or instruct the relinquishment of the patent.

A patentee may license their patent to others, subject to the Registrar's approval and recording. The Registrar ensures the license doesn't abuse rights, harm competition, or negatively impact national interests before publicizing it. License effectiveness requires official recording. Compulsory licenses can be issued under specific conditions, such as urgent public need, anti-competitive practices, or insufficient production. These licenses must primarily serve national market needs and cannot be transferred except within the licensee's business. The granting and cancellation of compulsory licenses are overseen by the Agency, with provisions for appeals to an Intellectual Property Rights Court if disputes arise. Under the Rules, patent applicants can apply for a compulsory license by showing they requested a license from the patentee and did not receive it within six months. This evidence is unnecessary in state emergencies, public non-commercial use, or

anti-competitive issues determined by legal proceedings.

A patentee may voluntarily surrender their patent to the Registrar, who will examine, record, and announce it. Patents can be revoked if they fail to meet eligibility requirements, involve fraud, misrepresentation, or unauthorized amendments, or if the patentee is ineligible. Additionally, patents may be canceled for confidentiality violations, non-payment of fees, or incorrect descriptions of genetic or biological resources. The Registrar records and publicly announces any revocations.

Patents have a duration of 20 years from their application submission date, and to maintain them, annual fees must be paid as prescribed. These fees are due six months before each anniversary of the patent's filing and can be paid with a grace period of six months, albeit with penalties for late payment. The Registrar records payments and cancels patents if fees are not paid within the grace period. A cancelled patent can be restored within a year if the non-payment is justified, and third-party rights are not harmed. Applicants or patentees can request the Registrar to restore their rights if they miss fee payments, provided they meet the prescribed conditions.

International Considerations

If a patent applicant who has applied in a Member State of the Paris Convention or the

World Trade Organization or their successor files the same invention with the Department within one year of the first application date, they will have the right to use that initial filing date as the priority date.

Similarly, suppose a person applies to register the same invention with the Department within one year of its display at an international exhibition recognized by the relevant government in a Member State of the Paris Convention or the World Trade Organization. In that case, they will have the right to use the exhibition date as the priority date.

However, exhibition priority does not extend the priority period. If the applicant fails to submit the necessary documents within the prescribed period, they may request the Registrar to restore the priority right per the relevant provisions.

Furthermore, after Myanmar joins the International Patent Cooperation Treaty, patent applicants can use the international registration system by applying to the Registrar, who will treat the international application date as the application date in the Union. The Department will be the receiving office for international applications from Myanmar citizens or residents. It will handle processing these applications for patents or utility models per the Law.

Law Enforcement and Dispute Resolution

Any person dissatisfied with the Registrar's decision can appeal to the Agency within 60 days. The Agency can confirm, revoke, amend the decision, or request further evidence. Upon receiving further evidence, the Agency will again decide to confirm, cancel, or amend the Registrar's decision. If dissatisfaction persists, an appeal can be made to the Intellectual Property Rights Court within 90 days of the Agency's decision. On 3 June 2024, the Supreme Court of the Union issued several notifications defining the jurisdiction of the Intellectual Property (IP) Courts and the procedures for adjudicating lawsuits under the Law. Please see our write-up on the Establishment of Intellectual Property Rights Courts [here](#).

The IP Court can handle patent infringement cases through provisional measures, civil actions, and orders to prevent infringement, preserve evidence, and compensate for damages. Provisional measures, which the right holder can request, may include preventing infringing goods from entering the market and preserving evidence. The court may require sufficient proof from the applicant and can withdraw these measures if civil litigation does not commence promptly. Additionally, provisional measures can be issued in urgent cases without the respondent's presence.

In cases of infringement, the court can order to prevent infringing goods' entry, compensation for damages, and coverage of legal expenses. The court can also mandate the destruction of infringing goods and materials used to produce them, considering factors such as the deterrent effects of the injunction, the proportionality of destruction to the infringement's seriousness, the environmental impact of the destruction method, and any adverse effects on the legitimate interests of third parties. Existing laws, such as the Evidence Act and Civil Procedure Code, may be used to issue orders in patent infringement cases where this Law lacks specific provisions.

Individuals convicted of issuing false patent or utility model certificates, making false entries in the register, unauthorized disclosure of patent applications or invention details, or allowing public use without permission are subject to penalties. These penalties include imprisonment for up to one year and fines of up to two million kyats. Misrepresentation of patent application status can result in imprisonment for up to six months, fines of up to two million kyats, or both.

The Law exclusively governs patent-related offences. The Registrar must provide hearings for affected parties, and authenticated patent documents are admissible as evidence in court. Applicants residing outside the Union must engage a registered patent attorney. Government

bodies' non-commercial use of patents for public benefit during emergencies is exempt from infringement. Disputes can be resolved through negotiation, arbitration, or litigation.

Conclusion

Myanmar's introduction of the Patent Law in 2019 and its recent implementation in 2024, accompanied by the Patent Rules, marks a significant milestone for intellectual property rights in the country. The Law establishes a comprehensive framework covering patent eligibility, application procedures, rights, and enforcement, while the Rules provide detailed guidelines for its implementation. This legal framework grants patentees' exclusive rights over their inventions, supported by robust registration procedures, dispute resolution mechanisms, and international cooperation initiatives. With strict penalties for infringements and provisions for both administrative and judicial review, Myanmar's Patent Law and its regulations aim to foster innovation while balancing the interests of inventors, businesses, and the public.

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.