

LEGAL
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Myanmar
24 August 2017

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Draft Industrial Design Law 2017

As part of its efforts to improve its intellectual property laws and to make Myanmar a more attractive destination for foreign investors, the Myanmar government recently published its Draft Industrial Design Law (“Draft Law”) in July 2017.

We summarise the key provisions under the Draft Law below:

1. What is an “industrial design”?

“Industrial design” is defined as the appearance of the whole or a part of any industrial or handicraft product resulting from the features and its ornamentation or in particular, the features of lines, contours, colours, shapes, texture, handwoven cloth, materials of the products or its ornamentation.

2. What industrial designs are protected?

An industrial design is eligible for protection if it is new and independently created.

An industrial design is deemed to be new if it has not been disclosed to the public inside or outside the country whether by oral disclosure, writing, use, publication, display or any other way, before the filing date of the application for registration of industrial design in Myanmar or before the date in respect of which the right of priority is claimed (if applicable).

3. What industrial designs are excluded from protection?

The following types of industrial designs are excluded from protection:

- a. industrial designs that are only differentiated by technical or functional creation; and
- b. industrial designs that are contrary to public order, morals, faith or the cherished culture of Myanmar

4. Who is entitled to register an industrial design?

- **The creator of an industrial design** or his legal successor in title or legal transferee is entitled to register an industrial design. If an industrial design was jointly created by more than one person, they shall both be entitled to register such industrial design.
- **The employer** has the right to register where an industrial design is created by an employee in the course of or as a consequence of an employment contract between such employer and employee, unless otherwise provided in the contract.

However, if the employer fails to file an application for registration of industrial design within six months from the date that such employer is informed of the creation of a new industrial design by the employee, the employer shall be deemed to have waived such right in favour of the employee.

Further, if an industrial design is created by an employee within one year after expiry of the employment contract, and such design was created by the employee within the scope of work of his former employer, it shall be presumed that the employer has the right to register the industrial design.

An employee who creates a new industrial design that is relevant to his scope of work but which he was not instructed to create by the employer shall have the right to register such industrial design, unless otherwise provided in the employment contract. Such employee is entitled to register the



industrial design, even though the employee uses the employer's data, tools and technical functions.

It is therefore advisable for employers and employees to consider carefully the issues relating to ownership of intellectual property rights and to reflect the parties' intentions properly when negotiating or entering into employment contracts.

5. What are the filing requirements?

Any person who is entitled and desires to have the right of a registered industrial design, shall file an application for registration with the Registrar. An applicant may file the same application for two or more industrial design that is related to the same class of the international classification as stated in the Locarno Agreement.

An application of industrial design should include a request for registration; the applicant's name or organisation name; power of attorney if an applicant has a representative; clear description of industrial design and indication of types of products that apply the industrial design. If the Registrar requires a translation of application from Myanmar language to English or English to Myanmar language, the application is to be translated accordingly. An applicant of industrial design from outside or inside Myanmar who desires to use the international registration system can do so after Myanmar is included in the Agreement of International Industrial Design Registration System as a member.

6. How to claim priority rights?

If an applicant claims priority rights over an industrial design in Myanmar, an applicant would need to provide a request of priority right with supporting evidence.

Further, if an applicant claims priority rights over an industrial design relating to an exhibition, an applicant would need to provide a request of priority rights with supporting evidence that relates to the display of goods in exhibition.

If two or more applications for registration of industrial design which are identical or similar are filed on the same date, only the person who files the earliest application shall be registered.

The Draft Law allows an applicant for an industrial design in Myanmar or a transferee of the applicant to claim priority to a first-filed application of a Paris Convention country or member state of the World Trade Organization (WTO) if the application in Myanmar is filed within 6 months of the first-filed application.

7. Opposition

Any third party may file an opposition to a registration of an industrial design with the Registrar within 60 days from the publication date of industrial design application, together with a payment of the prescribed fee.

The Registrar shall make a decision whether or not to register if there is no objection from any third party within 60 days of the publication date.

8. Deferment of Publication

An applicant for registration of an industrial design may request to defer the publication of the industrial design and the period of deferment. Such period of deferment shall not exceed 18 months from the filing date of the application for registration or if right of priority is claimed, from the date of priority. The Registrar shall record and shall keep confidential the file relating to the industrial design. After the expiry of the period of deferment of publication, the Registrar shall then publish the application of industrial design.



9. Registration term and exclusive rights

The initial term of a registered industrial design will be 5 years from the filing date of registration and is renewable for two consecutive periods of 5 years each. The renewal fees is payable within 6 months before the expiry of the term of each period. The total maximum term is 15 years. The owner of the registered industrial design will have the exclusive right for the protection of the registered industrial design relating to making, selling or importing any products which use the registered industrial design. The owner shall also have the right to transfer, assign or license the registered industrial design to any other person according to the provisions of the law.

The owner of a registered industrial design can file a civil action against the infringer of an industrial design.

10. Appeals

Under the Draft Law, any person dissatisfied with any decision made by the Registrar may appeal to the Director General within 60 days from the date of publication of such decision. The Director General may confirm, set aside or revise the decision of the Registrar, or give directions to take further evidence.

Any person dissatisfied with the decision made by the Director General may appeal to the Court with jurisdiction and powers conferred by the Supreme Court of Union within 90 days from the date of receiving notice of such decision.

11. Infringement

Where there has been an infringement of a registered industrial design, the injured party may take civil action in Court against the infringer. The Court may decide on the following temporary actions:

- a. passing an order to prevent the entry into the channels of commerce, the goods involved in the infringement of registered industrial design; and
- b. passing an order to preserve the evidence of the infringement of the right of registered industrial design;

Temporary injunctions are also available as a remedy if an application is made and as decided by Court.

12. Miscellaneous

Disputes between the owner and the infringer may be resolved by way of negotiation, arbitration or litigation in Court.

Notwithstanding anything contained in any other existing laws, any offence relating to the industrial design contained in this new law (when it comes into force) shall be acted upon in accordance with the provisions of the new law.

If you have any questions or require any additional information, please contact [Geraldine Oh](#) or [Thit Thit Kyaw](#).

This alert is for general information only and is not a substitute for legal advice.