## 1. 3 Myanmar Trademark and Patent 法律事務所への質問書及び回答書

## ミャンマー現地事務所

## 1. 事務所概要

- [1]貴所の所員構成(人数・内訳)について、教えてください。
  - 全所員数
  - 資格別(弁護士総数、知的財産担当弁護士の人数、特許技術者、事務スタッフ、その他)
  - 業務別(発明特許・意匠、商標、著作権、その他)
  - 技術分野別 (機械系、電気通信系、化学系、バイオ系、その他)
  - 日本人スタッフ、日本語対応可能なスタッフ
  - 元審査官・審判官・裁判官
- [2]貴所の業務について、以下の内訳(%)とそのうちの日本企業の割合を教えてください。 また、発明特許の出願について、多い技術分野や得意な技術分野があれば教えてくだ さい。
  - 業務別(出願関連、訴訟関連)
  - 出願系(発明特許、意匠、商標)
  - 訴訟系(発明特許、意匠、商標、著作権)
- [3]貴所の業務について、2014年度の登記申請件数を教えてください。
  - 特許(国内企業)
  - 特許(外国企業)
  - 意匠(国内企業)
  - 意匠(外国企業)
  - 商標(国内企業)
  - 商標(外国企業)
- [4]ミャンマーで特許、意匠、商標で2000年以降で行われた訴訟件数がお分かりであれば、 御教示下さい。
- [5]2000年以降に貴所で扱ったケースはありますか?ある場合、件数を御教示下さい。
  - 特許
  - 商標
  - 意匠
  - 著作権
- [6]他の事務所と比較して、貴所の特徴があれば、教えてください。

## 2. 知的財産関連法(特許法、商標法等)の制定状況

- [7]2015年11月の総選挙後、知的財産関連法の制定時期はいつ頃が見込まれるでしょうか?
- [8]新しい知的財産関連法を制定する上で参考にしている国があれば教えて下さい。
- [9]登記法知的財産関連法が制定された後、既に登記法で登記済みの特許、意匠、商標はどのように取り扱われるのでしょうか?
- [10]知的財産関連法が制定された後、登記法による知的財産権の保護という制度は維持されますか?
- [11]特許法で保護の対象となるものは発明特許のみでしょうか?それとも、タイのように 発明特許だけでなく小特許及び意匠特許も含まれますか?

# 3. Patent Prosecution

- (1)審査制度について
- [12]知的財産関連法が制定された場合、ミャンマー特許庁の審査体制について教えて下さい。どこかの国に審査委託がされるのでしょうか?既に審査委託される国が決まってい

る場合、お知らせ下さい。

- [13] 最新の特許法案で、コンピュータプログラムは非特許時由に含まれておらず、登録され得ると理解して宜しいでしょうか?
- (2) 新規性の判断基準
- [14] 最新の特許法案では、特許出願日または優先日より前に、国外で発行された文献に記載された事項で新規性は否定されることになっているでしょうか?
- [15] 最新の特許法案では、特許出願日または優先日より前に、国内で実施された内容で新規性は否定されることになっているでしょうか?また国外で実施された内容で新規性は否定されることになっているでしょうか?
- [16] 最新の特許法案では、欧州特許法で規定されている様な所謂 self-collision の規定 (objected by a prior art non-published at the filing date and published after the filing date) はあるでしょうか?

## (3)翻訳

- [17]登記法では、特許について保護を受けるためには英語で書類を作成すれば良く、ミャンマー語への翻訳は不要であったと理解しています。最新の知的財産関連法案では、出願は英語で出願が可能でしょうか?更に、その後ミャンマー語への翻訳は必要でしょうか?
- [18]もし、ミャンマー語への翻訳が必要だとした場合、出願書類のミャンマー語への翻訳は貴所スタッフが行いますか?貴所スタッフが行う場合、そのスタッフはどの程度の技術への専門的知識を持っていますか?技術系の大学を出ている、技術系企業の勤務経験があるなど教えてください。
- [19] 英語からミャンマー語への翻訳が必要だとした場合、誤訳を減らすための手段があれば御教示下さい。また、英語書類からの誤訳補正は出願後に行うことは可能でしょうか? (4)期間
- [20] 最新の特許法案では、審査請求が必要でしょうか?必要な場合、いつからいつまでに 行うことが必要でしょうか?
- [21] 最新の知的財産関連法案では、審査官による office action の通知から応答する迄の期間はどの程度でしょうか?延長は可能でしょうか?
- (5) その他
- [22]ミャンマーで知財の保護を図る上で効果的なやり方を御教示下さい。登記、営業秘密の漏えいを防ぐ契約、及び法律制定後は特許権による保護と言った選択肢がある中で、保護の実効性を高めるにはどうしたら良いでしょうか?
- [23] 最新の特許法案では、特許出願するにあたり、留意すべき事項があれば教えてください。
- [24] 出願や権利を調べるデータベースの現時点や今後の整備状況についてお分かりであれば教えて下さい。

#### 4. Enforcement

- [25]訴訟を提起する際、企業側で侵害に関する証拠を収集する必要があります。これらの 証拠を収集する際、どういった資料が有効資料とされるのでしょうか?また、裁判審理を スムーズに進めるためには、どのような資料を集めるべきなのでしょうか?
- [26]侵害に関する証拠について、公証は必要でしょうか?
- [27] 貴所では、下記のケース(2件)があった場合、どのように権利侵害品を入手しますか? 具体的な手順を教えてください。調査会社の有無や仲裁人など有効な entity がいる場合、お知らせ下さい。
  - Case 1:被疑侵害品が店頭で販売されている場合(B to C)
- Case 2:被疑侵害品が店頭販売されておらず、企業同士で取引される場合(B to B) [28]訴訟の提起から判決までどれくらいの日数を要していますか?特許、意匠、商標で裁判期間に差は ありますか?

- [29]登記に基づく特許・意匠・商標といった知財保護には、現地新聞への警告通知が必要と理解しています。意匠や商標は外観が分かるので、権利の対象も分かり易いですが、 特許に関しては、何を現地新聞に掲載するべきでしょうか?
- [30] 第三者は、警告通知で主張される所有権に対し不服を申し立て、裁判所へ登録の取消を請求する権利を有すると理解しています。しかし、不服の内容はどの様なものでしょうか?非侵害主張、新規性・進歩性欠如による無効主張の両方が可能でしょうか?無効主張について、新規性や進歩性については、ミャンマー国内で発行されていない文献でも主張可能でしょうか?
- [31] 弁護士の立場からみて権利保護に積極的な企業、国はあるでしょうか?もしあれば、可能な範囲でお知らせ下さい。ある場合、権利保護のためにどう言うアクション(刑事訴訟など)を取っているかお知らせ下さい。
- [32]特許、意匠、商標の登記に基づいて侵害訴訟を扱ったことはある場合、貴所で取扱った事件の概要(権利者の国、裁判所、技術分野、侵害事実と具体的な対応など)を可能な範囲で教えてください。
- [33]特許や商標の登記に基づく裁判所での民事の侵害訴訟以外にどの様な権利行使の手続きがあるでしょうか?手続き(警察・検察、税関など)とそのメリット・デメリット(期間、費用、執行の実効性)をお知らせ下さい。
- [34]裁判において、裁判官は過去の判決をどの程度参考にしますか?
- [35] 最近の訴訟傾向や模倣の仕方など、何か目立つ兆候はありますか?
- [36]知的財産権の侵害者に対して権利行使する場合に、証拠の押収を含めて、想定される必要経費について教えてください。
- [37] 知的財産に携わる裁判官の数がどれくらいいるかお分かりであれば御教示下さい。
- [38]模倣品対策に有効な取り組み方を御教示下さい。
- [39]特許、意匠、商標の侵害事件についても仲裁による解決が利用されるケースもあるか、 ご存知であれば教えてください。

### 5. ライセンス・現地企業とのパートナシップ

- [40] 貴所において、ライセンス契約の作成や相談を受ける件数は年間何件くらいでしょうか? ライセンス契約において留意すべき事項があればお知らせ下さい。
- [41] 不正競争防止法は未制定ですが、営業秘密はどの様に保護されるのでしょうか? 契約で規定することが必要な場合、実効性を高めるために留意すべき事項などあれば御教示下さい。また、営業秘密の盗用に対し、刑事・民事上で救済を求めることは可能か?
- [42] ミャンマーの現地企業と協業した場合、現地企業を通じて第三者に情報が漏えいしたり、現地企業が勝手に登記したりすることはないでしょうか?また、現地企業の転職者を通じた営業秘密の漏えいについてはどの様に対処すべきでしょうか?

# 6. その他

- (1) 代理人資格
- [43]訴訟代理人となる「弁護士」、特許出願等の代理人となる「特許弁理士(Registered Patent attorney)」には、どのような人がなれるのですか?特許弁理士は、技術的背景は必要でしょうか?
- (2) その他
- [44]企業から受ける知的財産に関する相談内容で多いのはどのような内容でしょうか?
- [45]日本の企業に対して、要望・提案があれば教えてください。

以上

# 1. Office Overview

- [1] Could you tell us the following staff information in your firm?
  - Total number of the staff
  - Each number of *qualified* people (i.e. total number of *attorneys at law*, number of attorneys *at law in charge of intellectual properties*, *patent technicians*) and the number of support staff except for the above people
  - Each number of technical staff related to invention patents, design patents, trademarks, copyrights.
  - Each number of your staff who handle mechanical engineering, telecommunication, chemistry, bio-technology.
  - The number of Japanese staff or Japanese usable staff (if exists)
  - The number of Former judges (if exists)
- [2] As for the work in your firm, could you inform us of the following items and how amount Japanese companies account for in each item (%)? Could you also inform us of technical fields related to invention patent for which your firm handles most frequently and/or in which your firm has the strongest skills?
  - The work ratio of IP applications and IP litigations
  - Each proportion of invention patents, design patents, and trademarks in total IP applications in your firm
  - Each proportion of invention patents, design patents, and trademarks in total IP litigations in your firm
  - [3] As for the business of your firm, could you inform us of the number of applications in the 2014 fiscal year with regard to the register act (1908)?
    - Patents (from domestic companies)
    - Patents (from foreign companies)
    - Trademarks (from domestic companies)
    - Trademarks (from foreign companies)
    - Designs (from domestic companies)
    - Designs (from foreign companies)
- [4] Could you inform us of the number of IP litigation in Myanmar since 2000?
- [5] Could you inform us of the number of infringement litigations handled by your firm since 2000 with regard to following area?
  - Patents
  - Trademarks
  - Designs
  - Copyrights
- [6] Could you inform us of the strength of your firm as compared to other firm?

# 2. Legislation status of the intellectual property-related laws (patent law, trademark law, etc.)

- [7] When would IP-related laws will be legislated after the general election in November 2015?
- [8] Is there any country's IP law used as a model for establishing IP related law in Myanmar?

- [9] How will the current registered IPs under the Registration act be treated after the IP-related laws are enacted?
- [10] Will protection of intellectual property rights by the Registration Law still be maintained after the intellectual property-related laws are enacted?
- [11] In the latest version, will the patent law protect not only invention patents but also petty patents and design patents?

# 3. Patent Prosecution

- (1) Regarding examination system
- [12] Could you inform us of the expected examination system of the Myanmar Patent Office after the IP-related laws are enacted? Specifically, will the examination is handled by some other country's patent office? If yes, and it has already been determined, could you inform us of the country in which the examination is handled?
- [13] Are computer programs excluded as non-patentable subject in the latest patent bill?
- (2) Novelty criteria
- [14] Is novelty denied by the matters described in a literature issued only in a foreign country prior to the patent filing date or priority date in the latest patent bill?
- [15] Is novelty denied by a public use in Myanmar prior to the patent filing date or priority date in the latest patent bill? Is novelty also denied by a public use in a foreign country?
- [16] Does the latest patent bill include a provision so-called self-collision as provided in the European Patent Convention (i.e. objected by a prior art non-published at the filing date and published after the filing date)?
- (3) Translation
- In our understanding, under the Registration act, it is sufficient to create an application form in English in order to apply for protection of a patent, and not necessary to translate it into Myanmar language. Is it also possible to file an application in English under the latest intellectual property-related bill? If yes, is it also necessary to translate it into Myanmar language?
- [18] If the translation into Myanmar language is necessary, will the translation of the application documents from English into Myanmar language be done by your firm staff? If yes, we'd like to know the technical background of your translators (e.g. they all have a degree from technical university, etc.).
- [19] If the translation from English into Myanmar language is required, is there any way to reduce mistranslation? Is it possible to amend mistranslation based on the English document after filing an application document to Patent Office?
- (4) Period
- [20] Is a request for examination necessary to start the examination in the latest patent bill? If yes, we'd like to know when the request should be filed.

- [21] In the latest intellectual property-related bills, we'd like to know the period in which an applicant must respond to office action. A request for extension is acceptable?
- (5) Others
- [22] Could you inform us of any effective way to achieve protection of intellectual property in Myanmar? That is, to protect IP in Myanmar, there may exist choices e.g. registration under the Registration act, a contract like NDA, or protection by patent rights after the new legislation. What is the best way to protect IPs effectively?
- [23] If there exists any cautious issue for filing a patent application in the latest patent bill, please let us know.
- [24] With regard to database system, could you inform us of the current status and future development to search any applications and rights?

# 4. Enforcement

- [25] Generally, to file a lawsuit, companies will need to collect evidences of infringement. Upon collecting these evidences, what kind of material will be effective?
- [26] Is a notary required for evidences of the infringement, or strongly recommended?
- [27] For the following two cases, how does your firm obtain the infringing goods? Does your firm make use of an investigation companies usually? Also, please let us know if taking advantage of arbitrators is effective in Myanmar.
  - Case 1: If the suspected infringing goods are sold to customers directly in a market
  - Case 2: If the suspected infringing goods are not sold to customers in a market but only traded between companies
- [28] Generally, how long does it take from filing a litigation to decision from court? With regard to a period length for trial, is there any difference among patents, designs, and trademark?
- [29] In our understanding, a right owner of intellectual properties such as patents, designs, and trademarks based on the registration act needs to warn with a local newspaper for protection of the right.
  With regard to design and trademark, these are easier to understand the content of the right compared to patented invention. From the perspective, how should a right owner of an invention based on the registration act notify their content of the right to public?
- [30] <Defense to a litigation>
  In our understanding, a third party who received a warning letter from an intellectual property right owner can file a complaint against the owner.

  Also, the party has a right to request for the cancellation of the registration to court.
  - Totally, what type of measures can be taken by the third party, i.e. claiming both non-infringement and invalidation due to lack of novelty and inventive step are allowable, for instance? Furthermore, is it possible to claim invalidation regarding novelty and inventive step by any literature

- which has not been issued in Myanmar? (This question may be related to [14].)
- [31] Are there any companies or countries which are active for protection of intellectual property rights? If any, we'd be glad to let us know which companies and/or countries are. Also, we'd like to know companies or countries active for the protection take what type of action (i.e. criminal proceedings, civil court, and so on).
- [32] If your firm has experience of infringement lawsuits based on a registration of a patent, design or trademark, could you let us know the outline of the case(s) (i.e. nationality of the right holder, which court is used?, technical field?, how was infringement proved?, and specific defensive measures from the suspected infringer), if possible.
- [33] What kind of measures can be taken for an intellectual property owner based on the registration except for a civil infringement lawsuit in court? (i.e. make use of police, prosecutors, customs, etc.). Also, we'd like to know comparison (advantage and disadvantage from a view of cost, period, and effectiveness of enforcement) among those measures.
- [34] We'd like to know how amount any former judicial decision affects latter decision.
- [35] We'd like to know any trends of litigation cases and remarkable example(s) in which invention patents are involved?
- [36] Could you inform us of expenses including seizure of evidences for intellectual property rights' enforcement?
- [37] Would you please teach us about the number of judges involved in intellectual properties in court?
- [38] Would you please teach us about effective measures against anti-counterfeiting goods?
- [39] We'd like to know whether a resolution procedure through arbitration is used for infringement cases of a patent, design or trademark.

# 5. License and partnership with local companies

- [40] How many cases per year does your firm drafts and/or is your firm asked for advices on License Agreement?
- [41] Competition Law has not yet been legislated. How can any trade secrets be protected? If a stipulation must be made in a contract for protection, we'd be glad to know how the contract should be drafted and what type of stipulation should be contained based on Myanmar's legal practice or culture. Also, is it possible to seek for a remedy based on criminal or civil laws against theft of trade secrets?
- [42] When we work together with a Myanmar local company, does it happen frequently that trade secrets flow away through the local company or employee's job change? Besides, what measures can we take against leakage of trade secrets through a former employee of the local company? Furthermore, is there any case in the past such a local company or employee of the company filed for registration without any consent.

## 6. Others

- (1) Attorney qualification
- Is a technical background necessary (for example, doctorate of science or engineering is required?) for being a "lawyer at law" who works as a counsel in litigations or a "Registered Patents Agent" who works as an agent for filing a patent application?
- (2) Others
- [44] What contents is your firm frequently asked of by companies with regard to IP-related issues?
- [45] If your firm has any request to Japanese companies, we'll be glad to let us know.

End