

本文の複製、転載、改変、再配布を禁止します。

1. 4 Kelvin Chia Yangon 法律事務所への質問書及び回答書

※質問書は、Myanmar Trademark and Patent 法律事務所へのものと同じ

**1. Office Overview**

[1] Could you tell us the following staff information in your firm?

- Total number of the staff

61

- 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

6 attorneys dealing with intellectual property

1 patent agent

- Each number of technical staff related to invention patents, design patents, trademarks, copyrights.

1 patent agent

- Each number of your staff who handle mechanical engineering, telecommunication, chemistry, bio-technology.

1 patent agent – Chemical Engineering

- The number of Japanese staff or Japanese usable staff (if exists)

1

- The number of Former judges (if exists)

0

[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

Mainly IP applications and several IP litigations

- Each proportion of invention patents, design patents, and trademarks in total IP applications in your firm

Mostly Trademarks, some industrial designs

- Each proportion of invention patents, design patents, and trademarks in total IP litigations in your firm

Only trademarks

[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)

0

- Patents (from foreign companies)

0

- Trademarks (from domestic companies)

Less than 10

- Trademarks (from foreign companies)

Approx. 100

- Designs (from domestic companies)

- 0
- Designs (from foreign companies)
- 0
- [4] Could you inform us of the number of IP litigation in Myanmar since 2000?  
[Such information is not readily available.](#)
- [5] Could you inform us of the number of infringement litigations handled by your firm since 2000 with regard to following area?
- Patents
- 0
- Trademarks
- 2
- Designs
- 0
- Copyrights
- 0
- [6] Could you inform us of the strength of your firm as compared to other firm?  
[KCY is the largest foreign law firm in Myanmar.](#)

## **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?  
[We have heard from unofficial sources that the IP-related laws are intended to be passed soon after the elections.](#)
- [8] Is there any country's IP law used as a model for establishing IP related law in Myanmar?  
[Not that we are aware of. However we understand that INTA, WTO and WIPO actively assist with the drafting of the IP laws. WTO and WIPO in particular, assist Myanmar with drafting the laws in conformity with the Agreement on Trade-Related Aspects of Intellectual Property Rights \(TRIPS\).](#)
- [9] How will the current registered IPs under the Registration act be treated after the IP-related laws are enacted?  
[Based on the Trademark bill, current registrations will have to be re-registered.](#)
- [10] Will protection of intellectual property rights by the Registration Law still be maintained after the intellectual property-related laws are enacted?  
[No. Re-registration is necessary.](#)
- [11] In the latest version, will the patent law protect not only invention patents but also petty patents and design patents?  
[We are still translating the latest patent bill. Our replies are based on the translation of the previous version of the draft patent law.](#)

[Petty patents are also protected. There will be a separate law for protection of industrial design.](#)

### **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?

[We do not have accurate information relating to this question.](#)

[13] Are computer programs excluded as non-patentable subject in the latest patent bill?

[We are still in the process of finalizing our english translation of the latest draft patent bill, but based on the previous draft, computer programs are excluded and protected under copyright. There are indications of exception without further explanation.](#)

(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?

[Priority Date.](#)

[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?

[Yes to both.](#)

[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)?

[No](#)

(3) Translation

[17] 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?

[We are not able to comment as the accompanying rules and regulations to the patent bill have not yet been drafted.](#)

[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.).

[We have not made a decision on such matter yet.](#)

- [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?

[We are not able to comment as the accompanying rules and regulations to the patent bill have not yet been drafted.](#)

- (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.

[There is no deadline for requesting examination in the draft law.](#)

- [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?

[30 days for locals and 60 days for non-locals.](#)

[No mention of extension.](#)

- (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?

[Generally, registration would be a first step.](#)

- [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?

[We understand that JPO is providing assistance with the management aspect of an IPO office and will support Myanmar with starting its IP office services.](#)

#### **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?

[The following information and physical evidence would be useful:](#)

- [Name of the person or company committing the infringement](#)
- [Complete address of the person or company committing the infringement](#)

- [Photographs showing infringement](#)
- [In the event that a test purchase is made, the receipt of the purchase](#)
- [Actual counterfeit product](#)

[26] Is a notary required for evidences of the infringement, or strongly recommended?

[A notarized or certified true copy of a document which shows the name and/or complete address of the infringer is not required, but is helpful.](#)

[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

[In both cases, we prefer to work with investigators to obtain evidence.](#)

[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?

[A period of 2 years can be expected for decisions in civil cases to be rendered. Criminal cases can be decided earlier.](#)

[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?

[Generally, the rights to intellectual property arises from use, and we confirm that for designs and trademarks, notice to the public is made by way of a publication. In the case of patents, notice to the public is made also by publication, but the information to be published depends on the nature of the invention.](#)

[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].)

Without considering the surrounding facts and circumstances, we are unable to comment on whether an alleged infringing party would, in fact, have a cause of action against a rights owner by reason of simply receiving a “warning letter”.

Moreover, Myanmar does not currently have a specific law on patents. Thus, it is unlikely that issues relating to novelty or inventiveness will be taken up in any case before the court.

- [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).

We are unable to provide reliable comment on which companies or countries are active in IP infringement. We have, however, heard of recent reports where OOOO (the Japanese consumer electronics manufacturer) has successfully settled a counterfeiting case out of court.

- [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.

As an example, we are handling a civil trademark infringement case which is presently pending before a district court. The client is a manufacturer from the Netherlands which produces industrial adhesive products, and counterfeit versions of these adhesives have found their way in Yangon, Mandalay and Naypyitaw in Myanmar. The Respondent is the owner of the establishment where the items are being sold.

The case has yet to be resolved, but the evidence presented consists of photographs of the counterfeit goods and purchase receipts which prove that the purchase was made from the respondent's business premises.

- [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.

The following is a preliminary and non-comprehensive comparison of the available anti-counterfeiting measures:

| Action  | Cost         | Effectiveness | Period  |
|---|--------------|---------------|---|
| Issuance of Cease and Desist letter   | Low          | Moderate      | 1-2 months  |
| Enforcement action (involving law enforcement)  | High         | High          | 1-2 days (for the enforcement action itself, not including any preparations, negotiations and any court action) |
| Registration of trademarks with the Customs Department (which can result to an enforcement action)  | Low          | Moderate      | About 3 work weeks  |
| Enforcement action on the basis of consumer protection (evaluated on a case-to-case basis depending on the nature of the subject goods, and with the assistance of the relevant government agency, like the Ministry of Agriculture or the Ministry of Health, for example) | Case to case | Case to case  | Case to case  |
| Criminal Case   | Moderate     | High          | Case to case  |
| Civil Case  | High         | Moderate      | Case to case  |

Note however that what may be effective will depend largely on a number of factors, which include the nature of the product, the scope of the infringement and the cooperation of the Respondents.

[34] We'd like to know how amount any former judicial decision affects latter decision.

Case decisions heavily influence decisions in future cases.

[35] We'd like to know any trends of litigation cases and remarkable example(s) in which invention patents are involved?

We are not aware of any pending litigation cases involving patents, and the absence of a central regulatory agency makes it challenging to monitor and account for individual cases filed in the courts.

- [36] Could you inform us of expenses including seizure of evidences for intellectual property rights' enforcement?  
[Current Myanmar IP laws do not officially provide for a framework allowing the seizure of goods in relation to IP enforcement, although this may change with the passage of the new laws.](#)
- [37] Would you please teach us about the number of judges involved in intellectual properties in court?  
[There are no judges or courts specifically designated as IP courts or judges in Myanmar.](#)
- [38] Would you please teach us about effective measures against anti-counterfeiting goods?  
[Kindly refer to our response to Question 33.](#)
- [39] We'd like to know whether a resolution procedure through arbitration is used for infringement cases of a patent, design or trademark.  
[We are not aware of any infringement case wherein parties resorted to arbitration. We confirm however that arbitration is an available dispute resolution option under Myanmar law.](#)

#### **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?  
[We have some but not many cases.](#)
- [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?  
[Be advised that the Competition Law of Myanmar has been passed \(as of February 2015\), and we confirm that it contains protections from unfair competition, which includes the unauthorized collection, use or disclosure of "business secrets". Any act which can be classified as unfair competition may be subject to criminal or civil legal action. Thus, contractual stipulations referring to trade secrets or business secrets should therefore be generally consistent with the Competition Law.](#)
- [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?  
[We are not aware of any publicized instances.](#)  
Besides, what measures can we take against leakage of trade secrets through a former employee of the local company?  
[Action may be taken based on employment contract](#)



本文の複製、転載、改変、再配布を禁止します。

Furthermore, is there any case in the past such a local company or employee of the company filed for registration without any consent  
[We do not have accurate information.](#)

## **6. Others**

### (1) Attorney qualification

[43] 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?  
[No mention in draft patent law.](#)

### (2) Others

[44] What contents is your firm frequently asked of by companies with regard to IP-related issues?  
[IP registration, IP infringement](#)

[45] If your firm has any request to Japanese companies, we'll be glad to let us know.

End