

Filing a Patent Application in Myanmar – 10 noteworthy considerations

Filing a patent application in Myanmar is a crucial step in securing protection for innovative inventions. The process requires meticulous attention to detail and adherence to the relevant provisions outlined in Sections 18 to 29 of the Myanmar Patent Law. This guide provides a comprehensive overview of the patent registration requirements, along with other important points to assist applicants in navigating the application process successfully.

1. Eligibility and application for patent rights

To obtain patent rights in Myanmar, eligible applicants must apply to the Registrar as prescribed under Section 18 of the Myanmar Patent Law. Eligible applicants are individuals or legally formed organizations who own the invention and meet the patent law's criteria.

2. Language requirement for patent applications

Section 19 of the Myanmar Patent Law outlines the language requirements for patent applications. Accordingly, the applicant is given the option to file their patent application in either Myanmar or English. However, if the Registrar requests a translation into the other language, the applicant must comply and provide an accurate translation along with a signed statement confirming its accuracy. This language requirement aims to facilitate effective communication and processing of patent applications in Myanmar.

3. Required documents for a patent application

Section 20 of the Myanmar Patent Law outlines the specific information and documents that the patent applicant needs to include in their application. In detail:

(a) The applicant for the patent shall state the following in his application:

- (1) Request to grant the patent: The applicant must explicitly state their request for the grant of a patent. This indicates the applicant's intention to obtain exclusive rights to their invention.
- (2) Name, nationality, and address of the individual or legally formed organization applying for the patent and the inventor: The application must include the full name, nationality, and address of the person or organization seeking the patent rights, as well as the name of the inventor(s) involved in the creation of the invention.
- (3) Name, Citizenship Scrutiny Card number, and address of the representative (if applicable): If the applicant has appointed a representative to handle the patent application process on their behalf, the representative's full name, Citizenship Scrutiny Card number, and address must be provided.
- (4) Complete description of the invention: The applicant should provide a comprehensive and detailed description of the invention, explaining its technical aspects and how it works.
- (5) Name and brief description of the invention: In addition to the complete description, a concise name and brief summary of the invention should be included.
- (6) Requests to grant one or more patents, which have been described in the prescribed manner: If the invention can be considered as multiple distinct patents, the applicant may request to grant more than one patent, provided each is described according to the prescribed manner.

(b) In addition to the provisions contained in subsection (a), the following must also be submitted together if necessary:

- (1) Address and name of the country of the applicant's important industry or business if any: If the applicant's important industry or business is based in a specific country, this information should be provided.
- (2) If the applicant is applying on behalf of a legally formed organization, the registration number, type, and name of the country of said organization: If the applicant is representing a legally formed organization, details such as the registration number, type of organization, and the country of registration should be included.
- (3) Any writings or drawings, which explain the invention, if any: If there are any supporting documents, writings, or drawings that further explain the invention, they should be submitted with the application.
- (4) If the applicant has requested the right of priority, the request to grant the right of priority and description together with sufficient evidence proving that the applicant has the right of priority: If the

- applicant is claiming the right of priority based on a previously filed application in another country, they must include a request for the right of priority and provide sufficient evidence to support this claim.
- (5) If the applicant has requested the right of priority for trade exhibitions, the request to grant the right of priority for trade exhibitions and description together with sufficient evidence proving that the applicant has the right of priority for trade exhibitions: If the applicant is claiming the right of priority based on participation in a trade exhibition, they must include a request for the right of priority and provide sufficient evidence to support this claim.
 - (6) If one of the joint applicants signs the application on behalf of all joint applicants, a written agreement by all the remaining joint applicants: If multiple parties are applying for the patent as joint applicants, a written agreement signed by all joint applicants must be provided when one applicant signs on behalf of all.
 - (7) Statement of legal use of traditional knowledge in combination or not in combination with genes or biological resources as well as genes and biological resources themselves and description of direct or indirect use in making the invention in question: If the invention involves the use of traditional knowledge, genes, or biological resources, a statement explaining the legal use and any relevant descriptions should be included.
 - (8) Request for early announcement if the applicant wishes so: If the applicant desires an early announcement of their patent application, they must make a specific request for it.
 - (9) Other requirements occasionally prescribed by the Agency and Department: The applicant should be aware that there might be additional requirements specified by the relevant Agency and Department, which should be followed and included in the application if applicable.

4. Filing date of the patent application in Myanmar

Section 21 of the Myanmar Patent Law clarifies that the official submission date of a patent application within Myanmar is the date when the Department receives the complete application, including the prescribed fees, and it fully complies with the requirements of Section 20(a). This submission date is crucial for various legal and procedural considerations throughout the patent application process.

5. Description of the Invention

As per Section 22, the description of the invention must meet the following requirements:

- (a) Clear Description for Ordinary Skill:** The description of the invention must be written in a way that an ordinary person skilled in the relevant field can operate the invention. The description should reflect the best method known to the inventor on the date of application or the date of priority.
- (b) Sufficiency and Completeness:** If the description provides sufficient information for an ordinary skilled person to use or make the invention, it will be considered clear and complete, avoiding excessive examination.
- (c) Disclosure of Resources and Traditional Knowledge:** If genetic or biological resources from the Union's territory or information related to traditional knowledge were used in the invention without prior permission, this must be transparently stated in the patent description.

6. Request for Grant of Patent

- (a) Specificity of Protection:** The request for the grant of patent must specify the exact points or aspects of the invention for which protection is being sought.
- (b) Clarity and Conciseness:** The request must be clear and concise, and it can include descriptions, writings, and drawings to explain the details of the invention.

7. Disputes and Priority

Section 24 of the Myanmar Patent Law provides a clear mechanism for resolving disputes when multiple applicants are seeking patent protection for the same invention.

- (a) Identical Inventions with Different Application Dates:** In situations where multiple applicants submit patent applications for identical inventions separately, the applicant with the earliest application meeting the registration requirements will be allowed to register the patent.

(b) Right of Priority or Right of Priority for Trade Exhibitions: If applicants have requested the right of priority (or right of priority for trade exhibitions) in their applications, the applicant with the earliest priority date, and who meets the registration requirements, will be allowed to register the patent in case of disputes.

8. Joint Applications

Section 25 of the Myanmar Patent Law addresses a scenario where multiple applicants submit patent applications on the same day or claim the same date of priority for identical inventions that were independently developed.

Step 1: Registrar's Identification

The Registrar identifies cases where multiple applicants have applied for a patent on the same day or claimed the same priority date for identical inventions invented separately.

Step 2: Discussion among Applicants

The Registrar instructs all applicants to engage in discussions among themselves to determine who will be designated as the applicant for the patent. Applicants are encouraged to collaborate, share information about their inventions, and negotiate the designation of the applicant.

Step 3: Resubmission of Designated Applicant

After discussions, applicants individually resubmit the name of the designated applicant to the Registrar within a prescribed period. This resubmission reflects the outcome of their discussions and indicates the chosen applicant for the patent.

Step 4: Registrar's Further Instructions

The Registrar reviews the resubmissions and provides additional instructions to the applicants. Applicants are directed to follow these instructions to proceed with the designation process.

Step 5: Designated Applicant or Joint Applicants

Based on the Registrar's instructions, applicants choose one of the following options:

- a) Submit the name of the designated applicant for the patent, as agreed upon during discussions.
- b) Indicate their wish to be designated as joint applicants, provided they have reached an agreement after discussions.

Step 6: Registrar's Decision in Case of Disagreement

If applicants are unable to reach an agreement even after following the instructions and discussions, the Registrar has the authority to make a decision. The Registrar's decision is based on the stipulations of the law and aims to resolve the issue of patent ownership.

Step 7: Binding Decision

The decision made by the Registrar becomes binding on all applicants involved in the dispute. Applicants are required to adhere to the Registrar's decision in terms of the designated applicant for the patent.

9. Examination Request and Timeframe

Section 26 of the Myanmar Patent Law outlines the requirements and consequences related to requesting a detailed examination of a patent application.

(a) Request for Detailed Examination:

Timing and Deadline: The applicant has up to 36 months from the date of application to submit a formal request for detailed examination. This deadline ensures that applicants actively pursue the examination process within a reasonable timeframe.

Prescribed Fee: Along with the request for examination, the applicant is required to pay the prescribed fee. This fee covers the costs associated with conducting the examination, including the review of technical and legal aspects of the patent application.

Announcement: Once the request for examination and the fee payment are received, the Registrar is obligated to announce this request in the manner prescribed by the relevant regulations. This announcement serves as a public record of the applicant's intent to proceed with the examination process.

(b) Forfeiture of Patent Application:

This subsection outlines the consequence of not submitting the request for detailed examination within the prescribed timeframe. If the applicant fails to make the examination request within the specified 36-month period, the patent application is deemed forfeited.

(i) Loss of Rights: The forfeiture provision emphasizes the importance of timely action by the applicant. Failure to request examination within the stipulated timeframe results in the loss of the applicant's rights to pursue the patent application further. This provision aims to prevent dormant or abandoned applications from clogging the patent system and encourages applicants to actively engage in the examination process.

(ii) Efficiency and Resource Allocation: By setting a forfeiture clause, the patent office can better manage its resources and prioritize applications that are actively being pursued. It ensures that applications that are not being actively pursued do not unnecessarily burden the examination process.

10. Single Invention

As per Section 27, a patent application must relate to one invention only which must be so linked as to form a single general inventive concept. Under the patent law, a patent application should be limited to one invention only, and that invention must be connected in a way that forms a unified and cohesive general inventive concept. In other words, the application must focus on a single inventive idea and all the elements described within the application should be linked together to form a coherent and integrated concept.

Single Invention: The patent application should center around a solitary and distinct invention. It cannot combine multiple unrelated inventions or ideas within the same application.

Unified Inventive Concept: The elements of the invention described in the application should be interconnected and collectively contribute to a general inventive concept. The various aspects of the invention should be related in a way that they form a cohesive and unified whole.

11. Patent amendments

Section 28 of the patent law outlines the provisions related to amending a patent application before it is granted. The section provides the patent applicant with certain rights and options to correct errors, make amendments, or withdraw the application, subject to specific conditions and timeframes.

a. Amendment Request Before Decision:

A patent applicant has the option to apply for amendments to the patent application, including the application, translation, or any documentary evidence, due to text errors or other errors. This can be done after paying the prescribed fee. The amendment request can be made either before the Registrar makes a decision on granting or refusing the patent or before the Agency makes a decision in the appeal case against the Registrar's decision. The key points are:

Amendment Scope: The amendment request is intended to correct errors in the application materials. This can encompass textual errors, inaccuracies, or other mistakes that need rectification.

Timing: Amendments can be requested at specific points in the application process, either before a decision is made by the Registrar or before an appeal decision by the Agency.

b. Amendment of Application Prior to Grant:

Applicants are granted the ability to amend the patent application before the patent is granted, as long as the amendments do not exceed the descriptions that were originally included in the application. This implies that applicants can fine-tune and modify their applications during the review process, as long as the changes stay within the scope of the original content.

c. Separation of Non-Conforming Applications:

Applicants are allowed to request the Registrar to separate an application that doesn't conform to Section 27 (requirements for a patent application) into more than one separate application. This can be done without adding additional descriptions beyond what was contained in the original application. Key points are:

Non-Conforming Applications: If an application is found to not meet the requirements of Section 27, it can be divided into separate applications, each focusing on a specific aspect, without expanding the content.

Separate Application Date: Each separate application created through this process will have the same submission date as the original application, or the priority date if applicable.

(d) Withdrawal of Patent Application:

Applicants are granted the right to request the Registrar to withdraw the patent application. This indicates that if an applicant decides not to pursue the patent application further, they can formally request its withdrawal.

Final thoughts

Meeting the specific filing requirements is vital to avoid the rejection of a patent application. Familiarity with the guidelines and provisions outlined in the Myanmar Patent Law is essential to ensure accurate preparation and adherence to the law, significantly increasing the likelihood of successful registration. A clear and comprehensive application that fulfills all filing requirements simplifies the examination process for patent examiners. They can easily comprehend the intricacies of the invention and evaluate its novelty, inventiveness, and industrial applicability.

Adhering to the filing requirements is crucial as it aligns the patent application with Myanmar's legal framework, ensuring the patent's validity and enforceability within the country. Understanding these requirements empowers inventors to correctly prepare their patent applications from the start, eliminating the need for corrections and resubmissions. This not only saves time but also reduces costs during the application process.

**By Nguyen Vu QUAN
Partner & IP Attorney**

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com