

Patent Registration and Protection in Myanmar

1. Eligibility for Patent Protection in Myanmar

In Myanmar, patent protection is officially recognized under the Patent Law 2019. A patent is a form of intellectual property right granted to protect an invention, which is defined as any product or creation related to a production process that can solve a particular problem in a technical field, including minor inventions. Minor inventions are considered as technical creations that encompass new forms of a product, new structures of the parts of a product, or parts of a product that enhance its utility or performance.

To qualify for patent protection in Myanmar, an invention must meet three essential requirements, which are as follows:

Novelty: An invention is deemed novel if it represents technology that does not exist before the date of the application for patent rights or the date of the requested right of priority, in the case of applying for priority rights. This means the invention must be new and not previously known or publicly disclosed anywhere in the world before the filing date of the patent application. The prior art includes technologies that have been printed and published, spoken of, used, disclosed to the public, or publicized in any manner.

Inventive Step: The invention must involve an inventive step. This means that the invention must not be obvious to an expert in the relevant technical field. In other words, the invention should not be easily understandable or deducible by someone with ordinary skill in the specific area to which the invention pertains.

Industrial Applicability: For an invention to be eligible for patent protection in Myanmar, it must be industrially applicable, meaning it can be produced or used in an industrial enterprise. The term "industrial enterprise" is broadly defined and includes socioeconomic activities that precede manufacturing and service work. This covers a wide range of areas, including but not limited to handicraft, agriculture, livestock breeding, fisheries, trade, and service enterprises.

To summarize, an invention seeking patent protection in Myanmar must be new, non-obvious to experts in the relevant field, and capable of industrial application. Meeting these requirements under Section 13 of the Patent Law 2019 is crucial for obtaining patent rights and ensuring protection for the invention in the country.

2. Ineligibility for Patent Protection in Myanmar

Under Section 13 of the Myanmar Patent Law, certain subject matters are ineligible for patent protection. These exclusions aim to maintain a balance between promoting innovation and preventing the grant of patents for certain types of inventions that are not considered suitable for patent rights. The following are the 08 (eight) subject matters that are not eligible for patent protection in Myanmar:

(i) *Discoveries, Scientific Theories, and Mathematical Calculations:* Inventions that are mere discoveries of existing knowledge, scientific theories, or mathematical calculations are not eligible for patent protection. This exclusion ensures that fundamental scientific principles and mathematical concepts remain part of the public domain and cannot be monopolized through patents.

(ii) *Systems, Rules, and Methods for Conducting Business, Pure Psychology, or Games:* Inventions related to business methods, rules, regulations, or systems, as well as pure psychology or game-related methods, are ineligible for patent protection. This prevents the patenting of abstract business processes and ensures that certain areas of human activity remain open for free competition and innovation.

(iii) *Pure Computer Programs:* Pure computer programs, without any specific technical application, are not eligible for patent protection in Myanmar. This is in line with the approach of many countries to avoid monopolizing software that may be better protected through copyright or other intellectual property rights.

(iv) *Biological Production Processes Mainly Used for Growing Plants or Rearing Animals:* Biological production processes primarily used for growing plants or rearing animals are not eligible for patent protection, except for non-biological and microbiological production processes. This exclusion is likely intended to ensure that traditional agricultural and breeding practices remain accessible to the public.

(v) *Plants and Organisms from Nature:* All plant and organism species, DNA (including complementary DNA sequences), cells, cell lines, cell cultures, and seeds, including whole or part of organisms and biological

materials found in nature, are not eligible for patent protection. The exception is made for man-made microbiological organisms.

(vi) Surgical Methods or Treatment Methods for Humans and Animals: Inventions related to surgical methods or treatment methods for humans and animals, including methods of diagnosis discovered through experiments on human and animal bodies, are ineligible for patent protection. This preserves medical practices and procedures for the benefit of public health.

(vii) Inventions Related to Known Objects or Chemical Products Prescribed as Necessary: Inventions related to objects already known to the public or chemical products that are deemed necessary, including objects existing in nature, new ways of usage, and new forms, are not eligible for patent protection. This prevents the patenting of obvious modifications to existing objects or substances.

(viii) Inventions Detrimental to Public Morale, Order, Human Beings, Animals, Plants, Health, or the Environment: Any invention that is considered detrimental to public morale, order, human beings, animals, plants, health, or the environment, as well as inventions prohibited by existing laws within the territory of Myanmar, are ineligible for patent protection.

Timeline for Special Inventions: According to the policy of the World Trade Organization Trade-Related Aspects of Intellectual Property Rights (TRIPS) Council, pharmaceutical products or production processes are ineligible for patent protection in Myanmar until 01 January 2033 unless specified otherwise by the Union Government.

3. Eligible Applicants for Patent Rights in Myanmar

The statutory provisions concerning eligible applicants for patent rights, as outlined in Section 15 of the Myanmar Patent Law 2019, determine who has the right to apply for and be granted patent protection for an invention. These provisions are essential for ensuring that the appropriate parties are recognized and rewarded for their contributions to the invention and innovation process.

Individual Inventors and Right Holders: As per Section 15 (a), the primary eligible applicant is the inventor, who has the right to apply for patent protection and have their name listed on the patent. Additionally, the rights can be exercised by the licensee (*someone who has obtained permission to use the invention*) or the transferee (*someone who has acquired the rights from the inventor*).

Under Section 15 (b), in cases where the same invention is independently invented by multiple inventors, the one who submits the patent application first or legally obtains the earliest date of priority (if there's a claim for priority) shall be entitled to patent rights. This ensures a fair system for determining priority when multiple inventors come up with the same invention.

4. Joint Inventors

As per Section 16, all joint inventors of an invention are eligible to jointly apply for the patent of the invention. This provision recognizes that inventions can often be the result of collaborative efforts, and all contributors should have the right to be recognized and protected.

5. Inventions Made Under Employment Contracts

In Myanmar, as in many other countries, the ownership of inventions created during the course of employment can lead to complex legal questions. When employees develop new innovations related to their employer's work or using the employer's resources, the determination of patent ownership becomes crucial for fostering innovation, protecting intellectual property rights, and maintaining a fair balance between employers and employees.

(a) Patent Ownership Rights in Employee Inventions under Employment Contracts:

Section 17 (a) provides for patent ownership rights in employee inventions under employment contracts.

As a general rule, as per Section 17 (a), when an employee creates an invention while working under the terms of an employment contract, the default ownership of the invention and the right to apply for a patent usually belong to the employer. This means that if the invention falls within the scope of the employee's work duties or was made using the employer's resources or facilities, the employer typically has the right to claim ownership of the invention and proceed with the patent application.

Exception: However, there is room for exceptions to this general rule. If the employment contract contains specific clauses or provisions that state otherwise, the employee may retain the right to apply for the patent despite creating the invention during their employment. This exception acknowledges that certain employment contracts may explicitly grant the employee ownership or co-ownership rights over their inventions, especially if they were developed outside the scope of their regular duties or using personal resources.

(b) Employee's Right to Apply for Patent if Employer Fails to Act Within Specified Time:

If the employer fails to apply for the patent within 06 (six) months after being informed in writing by the employee that the invention is completed, the employer forfeits the right to patent registration. In such a case, the employee gains the right to apply for the patent for that invention. In conformity with the aforesaid provision, the processes for establishing patent rights will be as follows:

Initial right belongs to the employer: When an employee creates an invention during the course of their employment, the default ownership and right to apply for the patent initially belong to the employer. This means that, by default, the employer has the first opportunity to pursue the patent for the invention.

Employee's notice: However, the provision introduces a condition that grants the employee an opportunity to assert their right to the patent. If the employee completes the invention and wants to claim ownership of the patent, they must formally inform the employer in writing about the completion of the invention. This notice serves as a trigger for the employee's right to apply for the patent.

Time limit for employer: Upon receiving the employee's written notice, the employer has a specific time frame, which is six months from the date of the notice, to decide whether they will apply for the patent. During this six-month period, the employer can assess the invention's value and determine if they want to pursue the patent themselves.

Employer's failure: If the employer fails to apply for the patent within the six-month period, they forfeit their right to patent registration. This means that they no longer have the exclusive right to apply for the patent.

Employee's right to apply: In the event of the employer's failure to apply for the patent within the specified time frame, the provision grants the employee the right to apply for the patent for that particular invention. The ownership and application rights shift from the employer to the employee.

Example: Let's say Sarah is a software developer employed by TechCo, a software development company. As part of her job responsibilities, Sarah works on various projects, and during the course of her employment, she invents a new and innovative software algorithm that can significantly enhance TechCo's product line.

On January 1, 2023, Sarah completes the invention and immediately notifies her employer, TechCo, in writing, providing detailed information about the invention and her completion of it. According to the provision, TechCo now has six months (until June 30, 2023) to decide whether they want to pursue the patent for Sarah's invention.

However, for various reasons, TechCo fails to initiate the patent application process within the six-month period. As a result, on July 1, 2023, the right to patent registration for Sarah's invention shifts to her. Sarah now has the opportunity to apply for the patent herself, and she becomes the rightful owner of the patent.

(c) Ownership of an Invention made by an Employee after the expiration of their employment contract:

Section 17 (c) of Myanmar Patent Law addresses the ownership of an invention made by an employee after the expiration of their employment contract. The provisions outline the conditions under which the employer or the employee can apply for a patent for such an invention. In conformity with the aforesaid provision, the processes for establishing patent rights will be as follows:

Default ownership of invention: If an employee makes an invention within one year after their employment contract has expired, and if the invention is related to the field of their former employer (*i.e., falls within the scope of their former employment*), the invention will be considered as if it was made under the terms of the expired employment contract.

Employer's right to apply for patent: In such a scenario, the employer retains the right to apply for a patent for the invention. This means that the employer has the first opportunity to pursue the patent and protect the invention.

Conditions for employee's eligibility to apply for patent: However, there are specific conditions under which the employee becomes eligible to apply for the patent, even though the invention was made during their employment and is related to the former employer's field:

(i) **Agreement for employee's right:** If there is an agreement or specific provision in the employment contract that states the employee has the right to apply for the patent for such inventions, then the employee can exercise that right.

(ii) **Inability to refute evidence:** If the employee provides evidence or documentation showing that the former employer had not applied for a patent for the invention, and the former employer is unable to refute that evidence, the employee gains the right to apply for the patent.

(iii) **Employer's failure to apply:** If the former employer fails to apply for the patent within a specified time (as mentioned in subsection (b) of the provision), then the employee can proceed to apply for the patent themselves.

Example: John was previously employed as a chemist at a pharmaceutical company called PharmaMed. His employment contract with PharmaMed ended on January 1, 2023. On December 31, 2023, just within one year after the expiration of his employment contract, John invents a new chemical compound with potential medical applications.

Since John's invention falls within the field of PharmaMed's business (pharmaceuticals and chemistry), the invention is considered to have been made under the terms of his expired employment contract. Consequently, PharmaMed has the initial right to apply for a patent for John's invention.

However, during his employment, John had negotiated a specific clause in his contract that stated if he invents anything within one year of his employment ending, he retains the right to apply for patents related to those inventions. John reminds PharmaMed of this clause and informs them in writing about his completed invention on January 1, 2024.

PharmaMed reviews the situation and decides not to apply for the patent for John's invention. Since there is an agreement in John's employment contract giving him the right to apply for the patent for such inventions, John is now eligible to proceed with the patent application himself. The ownership and application rights for the patent have shifted from PharmaMed to John, despite the invention being made during his previous employment and in PharmaMed's field of expertise.

(d) Employee's Right to Patent for Unassigned Inventions Related to Employer's Work

Section 17 (d) of Myanmar Patent Law addresses the employee's right to patent for unassigned inventions related to employer's work. In conformity with the aforesaid provision, the processes for establishing patent rights will be as follows:

Unassigned invention: Section 17 (d) addresses a specific scenario where an employee creates an invention that is related to the employer's work or falls within the scope of the employer's business activities. Crucially, the invention is not specifically assigned or commissioned by the employer. In other words, the employee came up with the invention on their own initiative, and it was not part of their regular job duties or responsibilities.

Use of employer's resources: The invention was created using the employer's equipment, data, or technology. This implies that the employee had access to the employer's resources, facilities, or information that played a role in the development of the invention.

Patent application eligibility: In this scenario, the provision stipulates that only the employee, who is the creator of the invention, is eligible to apply for the patent. This means that the default ownership of the invention and the right to pursue a patent lie with the employee, not the employer.

Employment contract exception: The provision allows for exceptions. If the employment contract contains specific clauses or provisions that state otherwise, for example, if the contract explicitly assigns ownership of such inventions to the employer, then the employer may have the right to apply for the patent.

Example: Sarah is a software engineer working at a software development company named TechCo. As part of her job, she is responsible for developing new software applications for the company's clients. However, in her free time, Sarah starts working on a personal side project and ends up creating a new algorithm that could significantly improve the company's existing product line.

Sarah used TechCo's computer equipment and data for some testing and experimentation while creating the algorithm. However, this invention was not assigned or requested by her employer; it was her individual initiative.

In this case, according to the provision, Sarah, as the inventor of the algorithm, is eligible to apply for the patent for her invention. Since the invention was not specifically assigned to her by TechCo and was created using the employer's equipment, data, and technology, the default ownership and patent application rights belong to Sarah.

However, if Sarah's employment contract with TechCo had a clause stating that any inventions made during her employment automatically become the property of TechCo, then the employer might have the right to apply for the patent for her invention. This would be an exception to the general rule established by the provision.

(e) If an employee makes an invention outside the scope of subsections (a), (c), and (d), only the employee is eligible to apply for the patent, unless stated otherwise in the employment contract.

A bottom line

The provisions as set out in Section 17 are significant as they ensure a fair and balanced approach to patent rights in the context of employment relationships and joint inventorship. By defining the rights of individual inventors, employees, and employers, the law fosters an environment conducive to technological advancements and respects the interests of all parties involved.

The clarity in patent ownership helps employers protect their investments in research and development, while employees are incentivized to disclose their inventions and benefit from potential rewards. The provision on employee's right to apply for patents if the employer fails to act within the specified time provides an efficient dispute resolution mechanism, streamlining the process and reducing legal uncertainties.

Furthermore, the recognition of employee inventions made outside the scope of employment contracts acknowledges the value of individual creativity and encourages collaborative innovation while ensuring employees have the opportunity to protect their intellectual property rights.

As Myanmar continues its journey towards technological progress and economic growth, the provisions governing inventions made under employment contracts will play a pivotal role in fostering innovation and promoting a conducive environment for technological advancements in the country. By upholding a fair and balanced approach to patent rights, Myanmar can continue to attract foreign investments, promote research and development, and establish itself as a hub for innovation in the region.

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