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## AUTHOR



**Edith Ruan**  
Senior Legal Associate  
edith.ruan@vdb-loi.com

Qualified both in China and in New York, Edith lives in Yangon where she assists our clients in the telecommunications industry. She has extensive experience with the regulatory, financing, and transactional aspects of the TMT space.

## CONTACT



**Edwin Vanderbruggen**  
Senior Partner  
edwin@vdb-loi.com

Edwin is the senior partner of VDB Loi and a leading foreign legal advisor living in Myanmar since 2012. A frequent advisor to the Government on transactions and privatizations in energy, transportation and telecom, he is widely recognized for his "vast knowledge" (Legal 500) and his ability "to get difficult things through the bureaucracy" (Chambers, 2016).

## 10 FREQUENTLY ASKED QUESTIONS ABOUT THE MYANMAR INDUSTRIAL DESIGN RIGHTS LAW 2019

As we mentioned in our previous article on the Myanmar Trademark Law 2019 [[10 Frequently Asked Questions About the Myanmar Trademark Law 2019](#)], the Myanmar Industrial Design Rights Law 2019 (the "**Industrial Design Law**") was passed at the same time.

A list of 10 FAQs for the new Industrial Design Law is presented below. Please note, the list does not include some unanswered questions in the law, including practical aspects of filing procedures and transition of previous registrations, as it is assumed that the subsequent implementing rules will shed more light on these issues.

### 1. What kind of industrial design is registrable?

The scope of an industrial design under the Industrial Design Law includes "lines, sketches, color, shape, configuration, texture, features...external features of the whole or a part of the product". The product referred to must be a product resulting from an industrial or manual process, and includes any art, symbols, printed words, packages, or other decorations attached to the product.

The industrial design must be new, and not a combination of, or similar to, features that are already known to the public. Industrial designs that are a pure result of technical or visual effects, or that are against the public order or socially repugnant would not be protected by the law.

### Highlights of this note

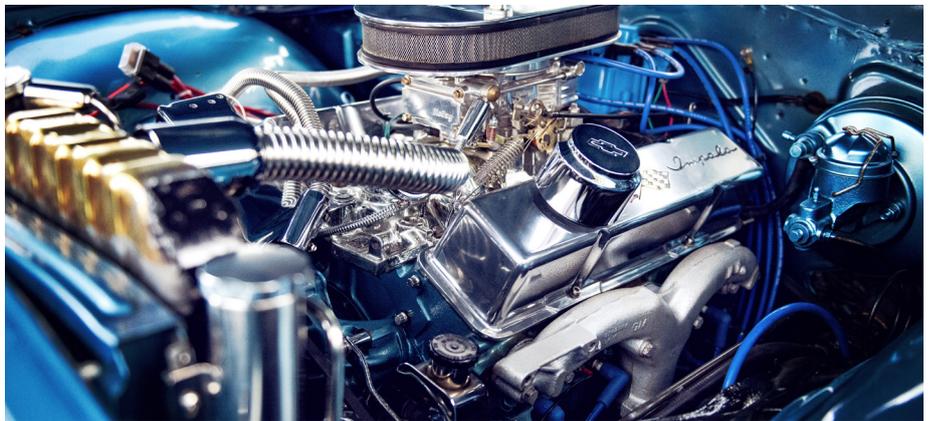
- ▶ 1. What kind of industrial design is registrable?
- ▶ 2. Can I sell the design first before I apply for registration?
- ▶ 3. Can I claim priority rights?
- ▶ 4. How long can a registered industrial design be protected?
- ▶ 5. Who owns the industrial design, the employee or the employer?
- ▶ 6. What rights does the owner have?
- ▶ 7. If I identify a pending industrial design application infringing upon my rights, what can I do?
- ▶ 8. If I identify a registered industrial design infringing upon my rights, what can I do?
- ▶ 9. How can I stop someone with no legitimate grounds from infringing upon my registered design rights?
- ▶ 10. Is there any way that I can lawfully use someone else's registered industrial design?

The implications of the element “external features” indicates that it is unlikely that protection will be granted to internal design features of a product that cannot be seen from the layout or from the package, if such product is usually exhibited in an opaque package. The rejection of protection for industrial designs created from “technical or visual effects” is somewhat vague, but implies that designs made using the latest technology, such as by artificial intelligence, with no direct human input or labor involved, may be challenged. Nevertheless, such a position will be pending further clarification from the authorities and the courts in their interpretations.

## 2. Can I sell the design first before I apply for registration?

You may risk losing your industrial design rights if you sell ahead of filing the application. Since “new” is a key element for industrial design rights, where the design has been disclosed to the public without an earlier application having been filed would in effect deny and invalidate any claims for industrial design rights. Therefore, if a person publicly advertises or distributes the product design before filing the application, the design will not be eligible for registration afterwards, even if it is the person’s own design. There are still some exceptions for priority rights to be retained (see Question 3), but don’t rely on luck – file it first. For the same reasons, a prior application or registration of an industrial design can also block the subsequent application of the same, whether from the same applicant or a third party.

This is quite different from a trademark, because the prior use of a trademark



does not necessarily extinguish a person’s rights over the same trademark subsequently, even though a registration application was not submitted at the time. However, in the world of industrial design rights, if a person publicly discloses the design without securing the design application first, the industrial design rights are extinguished for that person and everyone else, because it becomes “old” once it is known to the public. It also doesn’t matter where the publication or use occurs.

Therefore, before the commercial launch of your product in Myanmar and other countries, be sure you have secured proper filing in Myanmar, or the earlier disclosure in other countries may cause you to lose your industrial design rights in Myanmar.

## 3. Can I claim priority rights?

Yes. Priority rights can keep the design “new” for a certain grace period after public disclosure. An industrial design will not become “old” as long as the application to secure the rights in Myanmar is filed by a person (or their authorized assignee) within six months after the same person files an application over the same design in a

Paris Convention country or a World Intellectual Property Organization contracting country. In addition, it will not become “old” if the design rights application is filed within six months after the design has been displayed in a recognized international trade show held in a country with which Myanmar has agreed to keep this design “new” for the six-month grace period.

## 4. How long can a registered industrial design be protected?

Once registered, the term of protection will be five years from the date of application, renewable two times, for a period of five years each – for a total maximum period of 15 years.

## 5. Who owns the industrial design, the employee or the employer?

It depends. The ownership goes to the employer if the employer and the employee have mutually agreed to this, or the design is created under the instruction of the employer and created during the course of employment with resources provided by the employer. If the employer does not exercise its rights on time, the ownership may then go to the employee. The law also provides





a one-year grace period regarding designs created by a former employee. The employer will have a chance to claim rights over the design created by its former employer within one year of the employee's leaving subject to a number of factors, e.g. scope of the employer's business, employment terms, failure of the employer to register the design, etc.

#### 6. What rights does the owner have?

A registered owner of an industrial design will enjoy exclusive rights to:

1. Prevent others from manufacturing, selling, or importing any products that are copied from the registered industrial design;
2. Initiate civil action against any infringer; and
3. License or transfer the industrial design to others.

#### 7. If I identify a pending industrial design application infringing upon my rights, what can I do?

Before an industrial design application is finally approved and registered with the IP register, there will be a 60-day waiting period to allow for any public opposition over the application to be raised.

#### 8. If I identify a registered industrial design infringing upon my rights, what can I do?

The Industrial Design Law provides grounds for the invalidation of a registered industrial design. For example, if the design is not registrable because of an inherent defect such as discussed in

Question 1, or it is registrable but is not new, as discussed in Question 2.

#### 9. How can I stop someone with no legitimate grounds from infringing upon my registered design rights?

While a rights owner may initiate civil or criminal proceedings against infringers who use the rights owner's registered industrial design without legitimate grounds or authorization, the Industrial Design Law also provides an interim remedy, such as customs detention and interim injunction, to stop infringement activities before the legal proceeding is concluded.

#### 10. Is there any way that I can lawfully use someone else's registered industrial design?

The Industrial Design Law provides limited "fair use" exceptions to allow for the lawful use of someone else's registered industrial design without that party's authorization. These include:

1. Use for a private matter and not a commercial purpose;
2. Use for testing or research activities;
3. Use for reference materials for teaching/training; and
4. Use by the government for the public interest.

## DOWNLOADS



<http://bit.ly/2Ub780N>



<http://bit.ly/2uwR7DK>

## CONTACT

### YANGON

Level 10, Unit 01-05, Junction City Office Tower,  
Corner of Bogyoke Aung San Road and 27<sup>th</sup> Street,  
Pabedan Township  
T +951 9253752~756  
F: +951 9253758

### NAY PYI TAW

Nilar #2, Business Center, Park Royal Hotel Nay Pyi Taw,  
Jade Villa no. 13/14 Hotel Zone,  
Dekhina Thiri Township  
T: +95 678 106089  
F: +95 678 108 092