

**International  
Comparative  
Legal Guides**



Practical cross-border insights into patent law

**Patents  
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## Expert Analysis Chapters

- 1** **Jurisdiction and Competence of the Unified Patent Court**  
Katharine Stephens, Bird & Bird LLP
- 9** **Automobile Dealerships Are Not “Regular and Established Places of Business” of Auto Manufacturers for Purposes of U.S. Patent Venue**  
D. Stuart Bartow, Duane Morris LLP
- 12** **U.S. Policy Statement on Remedies for Standards-Essential Patents – Where Are We Now?**  
Kenneth R. Adamo & Eugene Goryunov, Law Office of KRAdamo & Haynes and Boone
- 16** **ASEAN Overview**  
Fabrice Mattei, Rouse

## Q&A Chapters

- 23** **Australia**  
Bird & Bird LLP: Jane Owen & Rebecca Currey
- 31** **Austria**  
GEISTWERT Rechtsanwälte: Rainer Schultes, Alexander Schnider & Constantin Kletzer
- 39** **Brazil**  
SiqueiraCastro Advogados: Eduardo Ribeiro Augusto & Fernanda Carmagnani
- 47** **China**  
Purplevine IP Group: Frank Jeng, Helen Zhang & Liam Tang
- 55** **France**  
Armengaud Guerlain: Catherine Mateu
- 64** **Germany**  
Glæss Lutz: Dr. Matthias Sonntag & Dr. Herwig Lux
- 72** **India**  
LexOrbis: Rajeev Kumar, Joginder Singh & Varun Sharma
- 82** **Ireland**  
A&L Goodbody: John Whelan, Alison Quinn & Sarah Douglas
- 91** **Israel**  
Gilat, Bareket & Co., Attorneys at Law / Reinhold Cohn Group: Adv. Eran Bareket & Adv. Jakob (Koby) Kasulin
- 100** **Italy**  
FTCC Studio Legale Associato: Filippo Canu
- 109** **Japan**  
Nagashima Ohno & Tsunematsu: Kenji Tosaki
- 117** **Korea**  
Lee International IP & Law: Yoon Suk Shin, Dong-Hwan Kim, Gon-Uk Huh & Kyu-Bok Lim
- 127** **Kosovo**  
SDP KOSOVË: Kujtesa Nezaj-Shehu & Nora Makolli
- 134** **Mexico**  
OLIVARES: Daniel Sánchez & Sergio L. Olivares
- 144** **Myanmar**  
Tilleke & Gibbins: Yuwadee Thean-ngarm, Khin Myo Myo Aye, Manaswee Wongsuryrat & Wongrat Ratanaprayul
- 151** **Norway**  
ACAPO AS: Stein Roar Gjoen & Helen Christie
- 157** **Sweden**  
Setterwalls: Martin Levinsohn & Per Lidman
- 165** **Taiwan**  
TIPL0 Attorneys-at-Law: J. K. Lin & H. G. Chen
- 175** **Ukraine**  
PETOŠEVIĆ Ukraine: Natalia Stetsenko, Olga Kudoyar, Taras Manolov & Oleh Karpenko
- 183** **United Arab Emirates**  
Rouse & Co. International: Philip Biggs, Paul Muscat & Bassel El Turk
- 192** **United Kingdom**  
Bird & Bird LLP: Katharine Stephens & Patrick Brown
- 204** **USA**  
Mintz: Michael T. Renaud & Matthew A. Karambelas
- 212** **Zambia**  
Dentons Eric Silwamba, Jalasi and Linyama Legal Practitioners: Joseph A. Jalasi, Jonathan Chileshe & Ntasi Silwamba

# Myanmar

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## 1 Patent Enforcement

### 1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

Myanmar's Patent Law (Pyidaungsu Hluttaw Law No. 7/2019) was enacted on March 11, 2019, but has yet to be brought into force. Intellectual property rights currently have limited protection under the common law system. While there are certain common law principles that allow for infringement proceedings to be brought, these are imprecise and primarily relate to trademarks. There are no precedent cases relating to patent infringement under the common law system.

The Patent Law will come into force on a date specified in a Notification issued by the President. As of the time of writing, no such Notification has been issued.

Among other things, the Patent Law empowers the Supreme Court to establish a Court of Intellectual Property Rights to hear civil and criminal cases concerning the infringement of intellectual property rights. The court can only be established and its rules and regulations issued once the Patent Law has been brought into force.

### 1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

According to Section 113 of the Patent Law, patent-related disputes may be settled in an amicable manner or by arbitration or litigation. Therefore, it will be for the parties to the dispute to decide the method for resolving the dispute after the Patent Law is in force. Rules and regulations governing the litigation process have not been issued.

Under the existing practice, most patent disputes are negotiated and settled confidentially between the parties. Arbitration can also be pursued if there is a specific agreement between the parties to settle disputes by arbitration, although it is unclear at present if any patent disputes are resolved this way.

According to the Law Amending the Code of Civil Procedure (Law No. 58/2021), a "Court-Led Mediation" will be available in civil cases from August 1, 2022. Further information on the procedural rules for this process have yet to be announced. Moreover, we will need to await the establishment of the Court of Intellectual Property Rights to determine if and how patent cases can be subject to mediation.

### 1.3 Who is permitted to represent parties to a patent dispute in court?

According to the Patent Law, a patent dispute is considered to be a civil case and not a criminal case. A Qualified Myanmar Attorney can represent parties before the court. Furthermore, an authorised representative of the patent owner or rights holder may represent parties to a patent dispute. However, additional announcements and guidelines for appointing representatives, including details as to the functions of representatives, will need to be issued once the Patent Law has been brought into force.

### 1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

Under Section 119(a) of the Patent Law, the Supreme Court can issue rules, regulations, notifications, orders, directives and procedural rules to the judiciary relating to the enforcement of provisions of the law. Such rules will need to be issued once the Patent Law has been brought into force and the Court of Intellectual Property Rights has been established.

### 1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

Section 103 of the Patent Law provides that the Court of Intellectual Property Rights can order a party to disclose evidence if the rights holder has submitted sufficient evidence to support their claim and that further evidence supporting their claim is in the possession of the other party. The court can protect the confidentiality of any disclosed information. Further procedural rules on such disclosures will need to be issued once the Patent Law has been brought into force.

### 1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

Procedural rules on pre-trial steps will need to be issued once the Patent Law has been brought into force and the Court of Intellectual Property Rights has been established. Under the Patent Law, a copy of the certified Patent Certificate and documents signed and sealed by the Registrar can be submitted as evidence before the Court.

**1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?**

Procedural rules on pre-trial steps will need to be issued once the Patent Law has been brought into force and the Court of Intellectual Property Rights has been established.

Generally, arguments and evidence can be presented at the trial by way of oral evidence and/or written evidence. Oral evidence includes testimony under oath by witnesses in court, while written evidence will have to be presented to the court for inspection. A party may change its pleaded arguments before and/or at trial.

**1.8 How long does the trial generally last and how long is it before a judgment is made available?**

As there is no precedent for patent cases, it is not possible to provide this information. As a general matter, the length of trial will depend on the amount of evidence and witnesses to be presented. In civil cases, it generally takes around 12–14 months from the date the complaint is filed for the judgment of the court of first instance to be issued.

**1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?**

The Patent Law does not make specific provision for streamlined proceedings. However, procedural rules will need to be issued once the Patent Law has been brought into force and the Court of Intellectual Property Rights has been established.

**1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?**

In Myanmar, judgments are not publicly accessible. The Supreme Court of the Union does publish some judgments from commercial cases on their official website, but there are no judgments relating to patents.

**1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?**

As the Court of Intellectual Property Rights has yet to be established and there is no precedent for patent infringement, it is not possible at this stage to say whether the court will be bound by precedent. This could be addressed in subsequent regulations.

**1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?**

The Patent Law empowers the Supreme Court of the Union to establish a Court of Intellectual Property Rights and to appoint judges to that court. The law does not make any further provision as to the qualifications or experience that such judges must possess. This may ultimately be determined once the Patent Law has been brought into force and the Court of Intellectual Property Rights has been established.

**1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?**

Under the Patent Law, a party will be entitled to proceed with both infringement and/or revocation actions. Nonetheless, there is no specific information relating to declaratory proceedings.

The Patent Law states that to bring a patent infringement claim a claimant must provide sufficient evidence that they are the holder of the patent right that is being infringed or at risk of being infringed.

By contrast, any person or legal entity can file a revocation claim with the Registrar and the patent will be revoked if one of the grounds for revocation is valid.

**1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?**

The Patent Law does not contain any specific provisions on this matter.

**1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?**

The Patent Law does not contain any specific provisions on secondary infringement. Rather, Section 52(b) provides generally that a patentee is allowed to file a civil action against persons who infringe their patent rights.

**1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?**

Yes. Under Section 52(a)(ii) of the Patent Law, a party can be liable for infringement of a process patent by importing a product produced overseas by an infringing process.

**1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?**

The Patent Law does not explain whether or not a patent claim extends to non-literal equivalents. In the context of infringement, there is currently no doctrine of equivalents and precedent alluding to the doctrine of equivalents.

**1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?**

The Patent Law allows the Registrar to revoke the patent if it receives the final order or judgment from the Court of Intellectual Property Rights regarding the application to revoke the patent. There is no mention of invalidity as a defence and this may be addressed in future regulations.

Issues of validity and infringement are handled by different authorities. The revocation process will go through the Registrar and can be appealed to the Agency and then to the Court of Intellectual Property Rights. Infringement proceedings will be brought to the Court directly.

**1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the "Formstein defence")?**

The Patent Law does not establish such a defence, although it is possible that this may be addressed in future regulations or guidance.

**1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?**

According to the Patent Law, the grounds for invalidation include:

- the subject matter of the patent is a non-patentable invention;
- the patentee is not entitled to the patent;
- the amendments to the patent application are beyond the scope of the description disclosed in the initial application;
- the patent has been obtained by means of fraud or the omission of prescribed important information;
- the claimed invention has been secretly used before the priority date; and
- the applicant for the patent fails to disclose the required information to the Registrar or cites false information.

**1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?**

The Patent Law does not provide for a stay of proceedings in relation to infringement or validity actions. Thus, it is still not clear whether infringement proceedings will be stayed if there is a pending validity case before the Patent Office (Intellectual Property Department).

**1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?**

The Patent Law does not specify any additional defences.

**1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device? (Please cross-refer to your answer to question 3.2 if compulsory licensing may be available in this scenario).**

According to the Patent Law, preliminary injunctions are available, and a rights holder can apply to the Court of Intellectual Property Rights for an order of provisional measure to protect against damages. Final injunctions are also available. The requirements for each type of injunction are as follows.

In *inter partes* matters, the claimant must submit reasonably sufficient evidence that the applicant is the rights holder and that the patent right is being infringed or at risk of being infringed. Moreover, they must provide sufficient security, which is to prevent the misuse of provisional measures.

As for *ex parte* matters, apart from the above-mentioned factors, the claimant also has to prove that any kind of delay would have an adverse effect that cannot be remedied or that there is a concern that the evidence is at risk of being destroyed.

Once the injunction order is issued, the Defendant can request a revocation of the order. The final injunction will be issued as a court decision. The final injunction must be within the scope of the claim of the plaintiff.

Section 65(a)(i) of the Patent Law states that, if it is of essential necessity for the public health sector, a compulsory licence must be issued to a person or legal entity. However, there is no specific provision for a public interest defence to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device.

**1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive/flagrancy damages available?**

Damages or an account of profits are only assessed together with the issue of infringement. Section 99(b) of the Patent Law stipulates that the Court of Intellectual Property Rights may issue an order that the infringer pay sufficient compensation to the rights holder. In appropriate cases, the court may also issue an order for the payment of damages specified in advance by reference to damage suffered by the rights holder or the benefits enjoyed by the infringer. Punitive damages are not available in Myanmar.

**1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?**

The Patent Law does not include specific provision for how orders of the court will be enforced. As a general matter, court judgments and orders are enforced in accordance with the court's procedural rules.

**1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?**

The Patent Law does not make specific provision for cross-border relief. Under the Patent Law, forms of relief include:

- an order to pay appropriated expenses, including the court fees and attorney fees of the rights holder;
- the destruction of infringing articles or the prevention of entering channels of commerce; and
- an order to destroy equipment used to create infringing goods or to prohibit their entry into channels of commerce without the payment of compensation.

**1.27 How common is settlement of infringement proceedings prior to trial?**

There is no precedent or common procedure for the settlement of patent disputes. It is currently difficult to bring formal legal proceedings in relation to patent infringement and cases will typically be settled privately. However, it is difficult to say at



this stage if this trend will continue once the Court of Intellectual Property Rights has been established.

**1.28 After what period is a claim for patent infringement time-barred?**

The Patent Law does not specify a prescription period for patent infringement claims.

**1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?**

As noted above, the Supreme Court of the Union will establish the Court of Intellectual Property Rights once the Patent Law has been brought into force. Section 95(d) of the Patent Law provides that the Supreme Court shall determine how appeals from the Court of Intellectual Property Rights should be handled. As such, while it is established that there must be a right of appeal, neither the court that will hear the appeal nor the specifics of the matters which can be appealed have been determined. These are matters that will need to be specified in subsequent regulations.

**1.30 What effect does an appeal have on the award of: (i) an injunction; (ii) an enquiry as to damages or an account of profits; or (iii) an order that a patent be revoked?**

Please refer to question 1.29 above. The effect of an appeal on an award of an injunction, enquiry or order will need to be specified in subsequent regulations.

**1.31 Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?**

Please refer to question 1.29 above. The specifics of the appeal process will need to be specified in subsequent regulations.

**1.32 How long does it usually take for an appeal to be heard?**

Please refer to question 1.29 above.

**1.33 How many levels of appeal are there? Is there a right to a second level of appeal? How often in practice is there a second level of appeal in patent cases?**

Please refer to question 1.29 above. While Section 95(d) of the Patent Law provides that provisions must be made for an appeal process, it does not specify the number of levels of appeal that must be established.

**1.34 What are the typical costs of proceedings to a first instance judgment on: (i) infringement; and (ii) validity? How much of such costs are recoverable from the losing party? What are the typical costs of an appeal and are they recoverable?**

As the Court of Intellectual Property Rights has yet to be established, information regarding typical costs is not available. Similarly, information regarding the typical costs of an appeal is not available.

Under Section 99(c) of the Patent Law, the Court of Intellectual Property Rights may order that an infringer pay reasonable expenses incurred by the rights holder, including court fees and attorney fees. However, it is not possible to say at this stage what level of costs would typically be recoverable.

**1.35 For jurisdictions within the European Union: What is the status in your jurisdiction on ratifying the Unified Patent Court Agreement and preparing for the unitary patent package? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?**

This is not applicable to our jurisdiction.

## 2 Patent Amendment

**2.1 Can a patent be amended *ex parte* after grant, and if so, how?**

The Patent Law contains basic provisions on the process for registering a patent with the Intellectual Property Department. However, it is possible that the process could be elaborated by further regulations and announcements once the Patent Law has been brought into force.

Section 28 of the Patent Law allows an applicant to amend a patent application before the patent is granted. Section 40(b) allows a patentee to apply to amend a patent after it has been granted, but only to amend clerical and other correctable errors, including the nationality and address that were recorded at the Registry.

**2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?**

There is currently no specific provision in the Patent Law on the *inter partes* amendment of patents during revocation/invalidity proceedings. We expect this to be addressed after the Patent Law is brought into force and subsequent rules and regulation are issued.

**2.3 Are there any constraints upon the amendments that may be made?**

Under the Patent Law, amendments that go beyond the scope claimed in the initial application are not permissible. Further rules, regulations, and guidelines have yet to be published by the officials.

## 3 Licensing

**3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?**

Section 61 of the Patent Law provides that a patentee or their licensee must apply to the Registrar to record the granting of a licence. Section 62 provides that the Registrar will record the granting of the licence if it does not abuse patent rights, does not oppose competition, does not directly or indirectly harm the interests of the State and is not likely to hinder or interfere with technical expertise and development.

In addition, under the Competition Law, parties cannot engage in conduct that restrains or controls production, market

acquisition, technology and development or technology and investment by any person.

### 3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

According to the provisions of the Patent Law, any person or legal entity can apply for a compulsory licence in any of the following situations: (i) essential necessity for the State's security, food supply, health sector or important sectors related to national interests; (ii) if the practices of the patentee or licensee are decided by a concerned authority to be anti-competitive, and the use of invention can remedy the anti-competitive practice; (iii) if the patentee misuses its exclusive rights or neglects the licensee's misuse of licensed exclusive rights; (iv) inability to obtain sufficient quantity or quality or a fair price in the country by manufacturing or exporting the invention; and (v) if the invention claimed in a second patent involves a significantly important technical advance for the economy in relation to the invention claimed in the first patent, and the second patent cannot be performed without violating the first patent.

## 4 Patent Term Extension

### 4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

According to the Patent Law, there is no provision to extend the term of a patent. The law states that the term of a patent is 20 years from the date of application and the annual fee must be paid periodically to maintain patent rights.

## 5 Patent Prosecution and Opposition

### 5.1 Are all types of subject matter patentable, and if not, what types are excluded?

According to Section 14 of the Patent Law, the following inventions are non-patentable and not protected:

- discoveries, scientific theories and mathematical calculation methods;
- a mere scheme or rule or method of doing business or performing mental acts or playing games;
- a mere computer program;
- biological production processes essential for the planting and breeding of plants and animals except non-biological and microbiological processes;
- except artificial microbiology, all animal varieties and plant varieties, which includes all animal and plant species including whole or part of life and organisms found in nature, DNA including complementary DNA sequences, cells, cell lines, cell cultures and seeds;
- surgical or therapeutic methods applied to the human and animal body, including the diagnostic techniques obtained from experiments on the human or animal body;
- naturally existing objects or known objects, including new usages and new forms, and chemical products prescribed from time to time and inventions related to those; and
- inventions that may be contrary to public order or morality, or which cause serious prejudice to humans, animals or plants or health or to the environment, and inventions prohibited for use within the territory of the State under any existing law.

Furthermore, the invention of pharmaceutical products or production processes shall not be protected until January 1, 2033, unless the Union Government specifies otherwise.

The Patent Law states that, unless specified otherwise by the Union Government, chemical substances used in agriculture, food products, and microbiological products cannot be protected by a patent until July 1, 2021, in accordance with the policy of the World Trade Organization's (the WTO) Council for Trade-Related Aspects of Intellectual Property Rights. While this date has passed, there has been no clear confirmation as to whether such products will be capable of protection by a patent once the Patent Law is brought into force.

### 5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

There is no specific requirement under the Patent Law to disclose prejudicial prior disclosures to the Patent Office (Intellectual Property Department). Nonetheless, according to the Patent Law, the whole or a part of a patent shall be revoked if it is revealed that the patent has been obtained by any means of fraud or the omission of prescribed important information, if the invention for which a patent is requested has been secretly used before the priority date, or if the applicant fails to disclose the required information or describes false information to the Registrar. The term "prescribed important information", the omission of which can lead to the revocation of the patent, is not defined in the Patent Law itself.

### 5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

Any third party can file an opposition to a patent within 90 days from the date of publication of the patent application. For petty patents, any third party can file an opposition within 60 days from the date of publication of the patent application.

### 5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

Any decision made by the Registrar under the Patent Law can be appealed to the Agency within 60 days from the date of the announcement of the decision. A decision of the Agency can be appealed to the Court of Intellectual Property, in accordance with authority conferred by the Supreme Court, within 90 days of the receipt of the decision.

### 5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

The Patent Law states that if the same patent is applied for on different days by more than one person for inventions created separately, the patent must be granted to the earlier application, provided it meets the required specifications. If each applicant claims priority or exhibition priority and there is a dispute, the applicant who claims the earliest priority date and complies with specifications will be granted the registration.

If the same patent is applied for on the same day by more than one person or the persons claim the same priority date, the Registrar will instruct the applicants to discuss between themselves and resubmit, within a specified timeline, the name of

the person they desire to prescribe as the patent applicant. If the parties agree to file as joint applicants, such an application must be submitted to the Registrar. If no agreement is reached, the Registrar will determine how the matter should be resolved.

#### 5.6 Is there a “grace period” in your jurisdiction, and if so, how long is it?

According to the Patent Law, there is a six-month grace period for the payment of the annual fee from the date the payment is due.

#### 5.7 What is the term of a patent?

The term of a patent is 20 years from the date of application, and the term of a petty patent is 10 years from the date of the application under the Patent Law.

#### 5.8 Is double patenting allowed?

No. According to the provisions of the Patent Law, an application for a patent shall apply to only one invention or to a group of inventions related to a single general inventive concept.

#### 5.9 For jurisdictions within the European Union: Once the Unified Patent Court Agreement enters into force, will a Unitary Patent, on grant, take effect in your jurisdiction?

This is not applicable to our jurisdiction.

## 6 Border Control Measures

#### 6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

According to the Patent Law, a patentee has exclusive rights to prevent third parties from importing its patented product or process without its consent. The Court of Intellectual Property Rights can issue provisional measures preventing the entry of patent-infringing goods into Myanmar channels of commerce, including imported goods that have been cleared and for which taxes have been paid. In the course of litigation, the court can also issue an order preventing patent-infringing products from entering into channels of commerce. However, subsequent rules and regulations will need to be issued once the Patent Law has been brought into force.

More generally, border control measures can be imposed by the Myanmar Customs Department (the MCD). The MCD is authorised to examine, investigate, and seize infringing products entering Myanmar by any mode of transport under the existing laws, such as the Sea Customs Act. However, there are no specific regulations or guidelines on the seizure of patent-infringing products.

## 7 Antitrust Law and Inequitable Conduct

#### 7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

There are no clear and specific provisions or regulation available at this stage.

#### 7.2 What limitations are put on patent licensing due to antitrust law?

As noted above, Section 62 of the Patent Law provides that the Registrar will not record the grant of a licence if, among other things, the licence constrains competition. In addition, under the Competition Law, parties cannot engage in conduct that restrains or controls production, market acquisition, technology and development or technology and investment by any person.

#### 7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts set FRAND terms (or would they do so in principle)? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

There is no provision in the Patent Law on these matters.

## 8 Current Developments

#### 8.1 What have been the significant developments in relation to patents in the last year?

There has been no further development since the Patent Law was enacted on March 11, 2019.

#### 8.2 Are there any significant developments expected in the next year?

We are currently waiting for the Patent Law to be brought into force. However, no firm date has been given for when the commencement date will be set. Once the Patent Law has been brought into force, it is expected that there will be further developments, including the issuance of rules, regulations and procedures by the relevant authorities and the establishment of the Court of Intellectual Property Rights by the Supreme Court.

#### 8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

In the absence of any substantive patent law and enforcement proceedings, it is not possible to provide an assessment of any trends.





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