



Intellectual Property Protection in Myanmar

1. Registration of trademarks, industrial designs and patents

1.1. Available registration system

Myanmar presently does not have an intellectual property office and a modern registration system. Certain intellectual property rights - trademarks, industrial designs and patents - can be registered at the Registration of Deeds Office (“Office”) in Yangon.

The Office is a sub-department of the Ministry of Agriculture, Livestock and Irrigation and registers all sorts of documents, in particular long-term lease agreements and sale and purchase agreements for immovable property. It is not a specialized intellectual property office.

With regard to trademarks, industrial designs and patents, the Office registers “declarations of ownership”, i.e. a statement signed by the applicant (or its representative) that the applicant owns a certain trademark, industrial design or patent.

The Office sometimes refuses an application if it is contrary to public policy. We were, e.g., recently told that “Old Rangoon” could not be registered as a trademark as the expression referred to an existing, well-known location in Myanmar. It is not always clear in advance what the present public policy is.

The Office usually does not reject an application on the grounds that someone else had obtained registration of a similar declaration of ownership earlier. Sometimes, such rejections are made (if, e.g., the same registration officer dealt with the earlier application and remembers its contents), but there is as such no internal research system and it is perfectly possible that the same or similar intellectual property rights are registered for two different owners.

If, in such a case, the owner believing to have the stronger rights intends to have the overlapping registration deleted, it needs the consent of the perceived infringer as the Office does not have a cancellation system and only deletes a registration if the original applicant so requests. If the owner cannot obtain this consent, it has to sue the perceived infringer. If the lawsuit is successful, the otherwise required application for deletion by the infringer is replaced by a court order.

The registration of a declaration of ownership requires the payment of stamp duty and a registration fee, but these are nominal amounts. It takes the Office about one month to register a declaration of ownership. The registration certificate is, in fact, the declaration, to which the Office affixed its seal and a hand-written registration number.



The entire system is paper-based; there is no online registration.

1.2. Cautionary notice

Registration is customarily followed by the publication of a cautionary notice in a newspaper. The costs depend on the size of the advertisement and the newspaper. Publications in the Myanmar Times or the state-owned press will cost at least several hundred USD. In other papers, costs are around USD 100. State-owned papers have a higher circulation than private ones. From a legal perspective, it is of course best to choose the newspaper which a potential infringer is most likely to read, but if the very substantial price difference is really worth opting for higher circulation is subject to debate.

The internet in Myanmar means: Facebook, and companies with a large following may additionally decide to publish the cautionary notice on Facebook and other social media.

1.3. Renewal

The registration is valid indefinitely. Some intellectual property law firms advise, however, to repeat the registration and/or the publication of the cautionary notice every three years. We do not think that it is necessary to renew the registration, but it might be a good idea to repeat the publication of the cautionary notice, at least in case of trademarks and industrial designs that are not being used in Myanmar and of which the public would otherwise have no knowledge.

1.4. Effects of registration and publication

Registration does not *per se* protect an intellectual property right. Myanmar is (still) a first-to-use country, so the (perceived) owner of a trademark with prior registration might still lose a case against a (perceived) infringer if the (perceived) infringer can demonstrate prior use.

It is, however, nevertheless very recommendable to register and publish intellectual property rights as (a) the police and the courts take a very unfavourable view on those trying to seek protection without having registered and published their rights, and (b) Myanmar will, according to bills presently pending in parliament, become a “first-to-register” country and the registration date under the present system will probably be grandfathered into the new system if a new application for registration is filed.

1.5. Is it possible to do a trademark research?

The Office does not have a searchable database.



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Like other specialised service providers, we have a collection of past cautionary notices which we can search. We can, however, not guarantee that this search reveals all registered trademarks as our list (most certainly) is incomplete.

1.6. Required documents for registration

The following documents and information are required to register a declaration of ownership:

Trademark	Industrial design	Patent
<p><i><u>If the applicant is an individual:</u></i></p> <ul style="list-style-type: none"> ▪ If Myanmar national: Copies of the national registration card and household list ▪ If foreigner: Notarised and legalised copy of the passport ▪ Power of attorney for local counsel (notarised and legalised if the applicant is a foreigner) <p><i><u>If the applicant is a local or foreign-invested company registered in Myanmar:</u></i></p> <ul style="list-style-type: none"> ▪ Original of the company registration certificate and, in case of a foreign-invested company, original of form 1 ▪ Originals of forms 6 and 26 ▪ Original memorandum and articles of association ▪ Resolution of the board of directors (draft provided by us) ▪ Power of attorney for local counsel (draft provided by us) <p><i><u>If the applicant is a company registered outside of Myanmar:</u></i></p> <ul style="list-style-type: none"> ▪ Copies of the company registration certificate and list of directors (notarised and legalised) and English translation thereof ▪ Copy of the articles of association (notarised and legalised) and English translation thereof ▪ Resolution of the board of directors (notarised and legalised); draft provided by us ▪ Power of attorney for local counsel (notarised and legalised); draft provided by us 		
<ul style="list-style-type: none"> ▪ Picture file(s) of the trademark(s) ▪ Description according to the Nice Classification 	<ul style="list-style-type: none"> ▪ Photos or drawings of the design(s) from different angles ▪ Description according to the Locarno Classification 	<ul style="list-style-type: none"> ▪ Patent specifications including drawings

We will prepare the declaration of ownership and send it to the applicant for approval. We will then proceed to sign the declaration of ownership before the registration officer. After having



obtained the registration certificate (i.e., after approx. one month after filing the application for registration), we will publish a cautionary notice in a newspaper of the applicant's choice.

2. Infringements

2.1. If an infringement is found: First steps

The owner of a protected intellectual property right would, in a first step, contact the infringer and request cessation of the infringement. The owner may involve a law firm to find the contact details of the infringer. If there is no reaction, or no positive reaction, on the part of the infringer, the owner would request a law firm to send a cease and desist letter to the infringer and, depending on the case, negotiate.

2.2. Involvement of the police

The unauthorised use of a trademark is a criminal offence according to sections 478 et seqq. Penal Code. The owner of the trademark can file a criminal complaint with a view to have (i) the infringer investigated and, possibly, arrested and (ii) the infringing goods seized. Furthermore, the police will question the infringer as to the origins of the infringing goods, thus providing the trademark owner with information required to close the route of import. As such, a trademark owner would often not be interested in a criminal trial against the infringer and agree with the police dropping the case if the infringer (i) signs a confession, (ii) promises to stop the infringement, (iii) agrees to the destruction of the seized goods, (iv) names the origin of the seized goods, (v) possibly, agrees to publish an apology in a widely-circulated newspaper and (vi) possibly, agrees to pay compensation.

In order to file a criminal complaint against an infringer, we would need from the owner of the trademark (if it is a foreign company registered abroad):

- Notarised and legalised copies of the company's registration certificate, list of directors and articles of association and an English translation thereof;
- notarised and legalised resolution of the board of directors and power of attorney (drafts provided by us);
- proof of ownership of the trademark: Ideally, the registration certificate of a declaration of ownership filed in Myanmar and a cautionary notice published in a Myanmar newspaper;
- evidence of the infringement (e.g., infringing good purchased from the infringer together with a witness; payment receipt issued by the infringer);



- sometimes, copy of the cease and desist letter sent to the infringer.

It may be possible to interpret the infringement of an industrial design or patent as a “misappropriation of property” (Section 403 Penal Code) and solicit the help of the police in such cases as well.

2.2. Involvement of the civil courts

Possibly in parallel to the criminal case, an owner may try to obtain relief from the civil courts, namely (i) a temporary injunction in order to temporarily preserve the status quo (although the court may not operate fast enough for meaningful help), (ii) a perpetual injunction to stop the infringement, (iii) an order to destroy the infringing goods and the means to produce them, and (iv) an award of damages.

The competent court depends on the amount of damages sought (Township Court: up to Ks. 10,000,000; District Court: Ks. 10,000,001 - 1,000,000,000; High Court: from Ks. 1,000,000,001). The court fees are capped at Ks. 500,000.

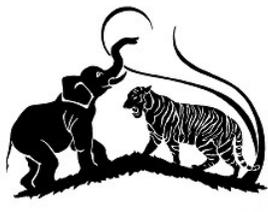
Section 54 Illustrations (u) and (w) Specific Relief Act explicitly allow perpetual injunctions against infringements of patents and trademarks, but we understand that it is also possible to obtain a perpetual injunction against the infringement of an industrial design. Furthermore, Section 55 Illustration (g) specifically allow a court to order the destruction of goods sporting an imitated trademark, but a court should also be able to order destruction in other cases by virtue of the general wording of Section 55.

The award of damages results from uncodified tort law.

In order to file a civil suit, we need the same documents and information as in the case of a criminal complaint.

2.3. Involvement of the customs authorities

Section 18 (d) Sea Customs Act contains an explicit prohibition to import goods sporting counterfeit trademarks. Such goods can be impounded by the customs authorities. The owner of a trademark may, if he has knowledge of a shipment, inform the customs authorities accordingly. It is furthermore possible to register a trademark with the customs authorities and train them to spot counterfeited goods.



3. Protection of other intellectual property rights

3.1. Copyright

The Copyright Act of 1911 is interpreted as protecting only works which were either first published in Myanmar or, in case of unpublished works, of which the author was, at the time of their creation, a Myanmar citizen or resident. Works of foreign origin are therefore not protected in Myanmar.

Bootlegged videos may, however, be seized by the police under section 32 (b) Television and Video Law 1996 (“distributing videos without censorship sticker”).

The Computer Science and Development Law of 1996 makes it a crime to import software of which the Myanmar Computer Science Development Council prohibits import. The Council may well have issued a notification prohibiting the import of pirated software, but we would not be aware of it.

3.2. Business secrets

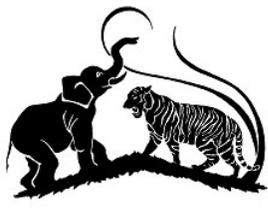
Sections 19, 41 of the Myanmar Competition Law of 2015 make it a crime to steal or otherwise misappropriate business secrets of competitors.

4. Trademark, Industrial Design and Patent Bills

On 24th July 2017, the Myanmar parliament published bills that will, if enacted, create a modern trademark, industrial design and patent protection system, shifting from a “first to use” to a “first to file” approach. With regard to registrations under the current system, applications for renewed registration have to be filed; the old registration date will probably be grandfathered in. One should be aware, however, that all this is only a mid-term scenario as the bills have not been enacted yet and, in any case, it will take time to build up the required institutions.

A “copyright bill” has not been published yet.

Information in this brochure is up-to-date as of 8th August 2017.



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