



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

CONVENIENCE TRANSLATION - ACCURACY NOT GUARANTEED

Trademark Law

(2019, Pyidaungsu Hluttaw Law No. 3)

10th Waning Day of Pyatho, 1380

(30th January 2019)

The Pyidaungsu Hluttaw has enacted this law.

Chapter (1)

Title, effective date and definitions

1. (a) This law shall be called the Trademark Law.
- (b) This law shall enter into force on the date determined by the president by notification.
2. The expressions in this law shall have the meanings given hereunder -
 - (a) “**Union**” means the Republic of the Union of Myanmar.
 - (b) “**Central Committee**” means the Intellectual Property Rights Central Committee established by this law.
 - (c) “**Ministry**” means the Ministry of Commerce of the Union government.
 - (d) “**Competent Ministry**” means the Ministry of Information, the Ministry of Industry or the Ministry of Agriculture, Livestock and Irrigation of the Union government.
 - (e) “**Agency**” means the Intellectual Property Rights Agency established in accordance with this law.
 - (f) “**Department**” means the department which is authorised by the Ministry to manage Intellectual Property Rights.
 - (g) “**Registration Officer**” means the director general of the department who performs registration functions for Intellectual Property Rights.
 - (h) “**Inspection Officer**” means an officer whose position is not lower than assistant director of the Department and to whom the inspection of the registration of Intellectual Property Rights is assigned.



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- (i) **“Intellectual Property Right”** means the right according to the law to protect one’s own invention and innovation made by one’s intelligence. It includes a copyright, patent, industrial design right, Trademark and other intellectual property rights.
- (j) **“Mark”** means any mark or a combination of marks that are visible, including identifications, characters, numbers, illustrations and colour combinations, which distinguish goods or services from other goods or services. This term includes a Trademark, Service Mark, Collective Mark and Certification Mark.
- (k) **“Trademark”** means the Mark of the goods of a trading business by which they can be distinguished from goods of other trading businesses.
- (l) **“Service Mark”** means the Mark of the services of a service business by which they can be distinguished from the services of other service businesses.
- (m) **“Collective Mark”** means a Mark that is owned by an organisation such as an organisation formed by industrial entrepreneurs, manufacturers and traders, an association, a socio-economic organisation or a cooperative society. This term includes a Mark for goods or services belonging to the members of such organisation to distinguish them from other goods or services.
- (n) **“Certification Mark”** means a Mark whose owner authorises its use under his/her control concerning origin, quality, type and other characteristics of goods or services.
- (o) **“Geographical Indication”** means an indication that identifies goods produced in a country, territory or region whose goods are said to have a significant quality, reputation or other significant characteristics.
- (p) **“Famous Mark”** means a mark which is well-known and famous within the country according to a specified standard.
- (q) **“Trading Name”** means a name or expression distinguishing a trading business from another.
- (r) **“Mark Owner”** means any person or legal entity which is recognised and registered in the register of the Department as Mark owner.
- (s) **“Right Holder”** means any person or legal entity who/that is the owner of a Mark, a Famous Mark, a Geographical Indication or a Trading Name, a transferee of an



intellectual property right concerning a registered Mark, or a person who is authorised to use an intellectual property right of a registered Mark.

- (t) **“Member State”** means any member of conventions, treaties or agreements or international or regional organisations with respect to Intellectual Property Rights of which the Union is a member.
- (u) **“Intellectual Property Rights Court”** means a court which is established by the Supreme Court according to the law to handle Intellectual Property Rights matters or a court in which the power of such court to handle intellectual property matters is vested.
- (v) **“Priority Right”** means the priority right prescribed in section 31.
- (w) **“Priority Right Relating To An Exhibition”** means the Priority Right Relating To An Exhibition prescribed in section 32.

Chapter (2) Objectives

3. The objectives of this law are as follows -

- (a) To develop and improve investment, trade and trading businesses by protecting Marks;
- (b) to protect the interests of Mark Owners and Right Holders;
- (c) to create a system of fair market competition and a safe environment for the public by preventing the counterfeiting of Marks and the entry of counterfeit goods into the market;
- (d) to develop the quality of local goods produced in the country by protecting Geographical Indications and to promote the social and economic development of the citizens in that region by expanding international markets for these goods.

Chapter (3) Formation of the Central Committee and its functions

4. The Union government -

- (a) Shall establish the Intellectual Property Rights Central Committee as follows to administer Intellectual Property Rights matters -
 - (1) Vice president Chairman



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| (2) | Union minister, Ministry | Vice-chairman |
| (3) | Deputy ministers from the Competent Ministries | Members |
| (4) | Deputy ministers or directors general from other appropriate ministries | Members |
| (5) | Not more than four Intellectual Property Rights experts | Members |
| (6) | Two representatives from non-governmental organisations | Members |
| (7) | Person assigned by the president | Secretary |
| (8) | Director general of the Department | Joint-secretary |
- (b) The Central Committee formed under sub-section (a) may be reorganised as required.
5. The functions of the Central Committee are as follows -
- To develop Intellectual Property Rights policies, strategies and programmes in order to promote Intellectual Property Rights businesses in the Union;
 - to facilitate the implementation of Intellectual Property Rights policies, strategies and programmes;
 - to guide the development of the national economy, foreign investments and SMEs by means of Intellectual Property Rights;
 - to encourage human resources development programmes in order to promote Intellectual Property Rights businesses;
 - to coordinate among competent government departments and organisations, other organisations and private business owners concerning the development and implementation of an Intellectual Property Rights system;
 - to promote the coordination between local and foreign organisations concerning the acquisition of technology and required assistance; and
 - to perform the tasks related to Intellectual Property Rights assigned by the Union government as required.



Chapter (6) Formation of the Agency and its functions

6. The Central Committee -

(a) The Intellectual Property Rights Agency shall be established with the consent of the Union government as follows:

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| (1) | Secretary of the Central Committee | Chairman |
| (2) | Directors general of the Ministry and the Competent Ministries who are relevant to the Agency | Members |
| (3) | Not more than eight Intellectual Property Rights experts | Members |
| (4) | Not more than five representatives from non-governmental organisations | Members |
| (5) | Director general of the Department | Secretary |
| (6) | Heads of the sub-departments of the Department | Joint-secretaries |

(b) The Agency formed according to sub-section (a) may be reorganised as required.

7. The chairman of the Agency shall be considered to be equivalent to a deputy minister.

[Translator's note: The reference to "Trademarks" instead of "Marks" in sections 8 and 9 is in the original.]

8. The functions of the Agency are as follows -

- (a) To coordinate businesses related to Trademarks;
- (b) to implement Trademark policies, strategies, programmes and human resources development programmes developed by the Central Committee in order to develop the Trademark system;
- (c) to observe and report to the Central Committee as to whether the Union should be a member in a Trademark rights convention, treaty or agreement;



- (d) to implement the provisions of the conventions, treaties and agreements related to Trademarks in which the Union is a member;
- (e) to cooperate with relevant local organisations, international organisations, regional organisations and member countries in connection with Trademarks;
- (f) to establish, with the consent of the Central Committee, working groups as required and assign their functions in order to take action against Trademark violations;
- (g) to establish, with the consent of the Central Committee, working groups as required and assign their functions in order to carry out matters related to Trademarks;
- (h) to protect good quality goods in areas of the Union in order to promote the economic status of citizens in these areas;
- (i) to decide appeals against the decisions of the Registration Officer;
- (j) to specify the fees to be collected under this law after obtaining the consent of the Union government through the Central Committee;
- (k) to adopt the seal to be used for registering Trademarks;
- (l) to submit activity reports and other required reports to the Central Committee;
- (m) to submit an annual report relating to Trademarks to the Central Committee; and
- (n) to perform Trademark-related functions assigned by the Central Committee from time to time.

Chapter (5)

Functions of the Department

9. The functions of the Department are as follows -
- (a) To announce registration matters relating to Trademarks;
 - (b) to maintain the registers related to Trademarks;
 - (c) to supervise the operation of the sub-departments formed according to the Trademark sectors; and



- (d) to perform Intellectual Property Rights-related functions assigned by the Agency from time to time.

Chapter (7)

Appointing the Registration Officer and Inspection Officer and assigning their functions

10. The Ministry may appoint, with the recommendation of the Agency, the Registration Officer and the Inspection Officer in order to perform Intellectual Property Rights matters at the Department.
11. The functions of the Registration Officer are as follows -
 - (a) To supervise the application and inspection process with regard to Mark registrations;
 - (b) to coordinate and act in accordance with the report of the Inspection Officer with regard to Mark registrations;
 - (c) to decide on Mark registration matters; and
 - (d) to perform Intellectual Property Rights functions and related matters assigned by the Central Committee and the Agency from time to time.
12. The functions of the Inspection Officer are as follows -
 - (a) To inspect applications for Mark registrations and Geographical Indication registrations;
 - (b) to report to the Registration Officer with his/her opinion and remark after examining the opposition and response concerning an application for Mark registration;
 - (c) to summon required persons and obtaining documentary evidence, with the approval of the Registration Officer, when performing the Mark registration functions;
 - (d) to report to the Registration Officer with his/her opinion and remark whether to allow registration after examining the application for Mark registration; and
 - (e) to perform Intellectual Property Rights-related functions assigned by the Agency, Department or Registration Officer as required.



Chapter (7)

Marks not eligible for registration

13. It shall be an absolute ground for opposing the registration of a Mark, and this Mark shall not be eligible for registration, if it falls within any of the following categories -
- (a) Lack of distinctiveness;
 - (b) it only describes the characteristics or indication that show the type, related subjects, quality, quantity, intended use, price, place of origin or manufacturing time of goods or services.
 - Exemption - The registration of a Mark shall not be opposed according to sub-sections (a) and (b) in the following cases -
 - (1) Consumers distinguish the Mark because of its use prior to the application date; or
 - (2) the Mark has been used in good faith by the applicant exclusively and continuously for trading in the Union.
 - (c) It affects public stability, integrity or beliefs, the reputation of the Union, public cultural heritage, or traditions of ethnicities;
 - (d) it has become a common expression or customary in contemporary vocabulary or a commercial practice;
 - (e) it misleads the public or commercial circles with regard to sub-section (b);
 - (f) it directly copies, imitates or resembles, in full or in part and without the consent of the relevant authority, national flags, emblems or symbols, the symbols or quality certification marks administered or guaranteed by a state, or the symbols, flags, names or acronyms of inter-governmental organisations; or
 - (g) it uses Mark symbols protected by an international treaty of which the Union is a member.
14. It shall be a relative ground for opposing the registration of a Mark, and this Mark shall not be eligible for registration, if it falls within any of the following categories -



- (a) It misleads consumers because it is identical with or similar to, in full or in part, a registered Mark, a Mark for which an application for registration was filed earlier or a Mark for which a priority right exists, and is used for goods or services that are identical or similar to the goods or services for which the earlier Mark is used;
- (b) it impairs the personal rights of an individual or the name and reputation of a legal entity without the authorisation of the individual or legal entity;
- (c) it may violate the intellectual property rights of another person;
- (d) applying for Mark registration in bad faith;
- (e) it misleads consumers because it is identical or similar to a Famous Mark and used for identical or similar goods or services; or
- (f) it is identical or similar to a registered Famous Mark and falsely indicates that there is a connection between the owner of the Famous Mark and the goods or services for which the Mark to be registered is used, even if these goods or services are not identical or similar to the goods or services for which the Famous Mark is used, and, furthermore, impairs the interest of the owner of the registered Famous Mark.

Chapter (8) **Application**

- 15. A person wishing to have an Intellectual Property Right under this law may apply for Mark registration with the Registration Officer as prescribed by this law.
- 16. The applicant applying for Mark registration -
 - (a) may apply either in the Myanmar or English language;
 - (b) shall provide a translation to English from Myanmar or to Myanmar from English if so requested by the Registration Officer;
 - (c) the applicant shall authenticate the translation made under sub-section (b) by signing it.
- 17. The applicant applying for Mark registration -
 - (a) Shall include the following in the application -
 - (1) Registration request;



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- (2) name and address of the applicant or legal entity;
 - (3) name, NRC no. and address of the representative if the application is filed by a representative;
 - (4) clear description of the Mark;
 - (5) names and class of the goods or services according to international classification, or names and types of the goods or services.
- (b) The applicant shall, if required, attach the following items in addition to the information to be provided under sub-section (a) -
- (1) Registration number, type and jurisdiction of origin if the applicant is a legal entity;
 - (2) if the applicant requests a Priority Right: submission of a Priority Right request together with proof and a description showing the existence of the Priority Right;
 - (3) if the applicant requests a Priority Right Relating To An Exhibition: submission of a Priority Right Relating To An Exhibition request, together with proof and a description showing the existence of the Priority Right Relating To An Exhibition;
 - (4) If the Mark had been registered previously at the Registration of Deeds Office: proof of such registration;
 - (5) other requirements specified by the Agency and the Department from time to time.
18. The date on which the Department receives the payment of the prescribed fee and the complete Mark registration application that meets the criteria under section 17, sub-section (a) shall be deemed as the submission date of the application for registration in the Union.
19. The Registration Officer -
- (a) If more than one person has applied for registration of an identical or similar Mark on different dates and there is a dispute over the application, the Registration Officer shall register the Mark for which the earliest application was filed, provided that this application fulfills the registration criteria.



- (b) With regard to the application in sub-section (a), if more than one person has requested a Priority Right or a Priority Right Relating To An Exhibition and there is a dispute over the request, the Registration Officer shall register the request of the person with the earliest Priority Right date, provided that this request fulfills the registration criteria.
20. If more than one person apply for registration of an identical or similar Mark on the same day or apply for the same Priority Right date -
- (a) The Registration Officer shall instruct all the applicants to discuss among themselves and report back within the specified time the name of the person to be regarded as the applicant for Mark registration.
- (b) The applicants shall report back to the Registration Officer the name of the person whom they have agreed to regard as the applicant for Mark registration as a result of the mutual discussion among them held in accordance with the instruction of the Registration Officer.
- (c) The applicants shall comply with the decision made by the Registration Officer if they cannot reach an agreement following the instruction given according to sub-section (a).
21. (a) A person who applies for Mark registration -
- (1) may, on payment of the prescribed fee, apply to the Registration Officer to amend the application or translation or any wrong written information or other correctable mistakes either before the Registration Officer approves or refuses to register the Mark or before the Agency decides on the appeal against the decision of the Registration Officer;
- (2) may apply to withdraw the application for Mark registration;
- (3) may, on payment of the prescribed fee, apply to the Registration Officer to divide any application that includes a number of goods or services to be one or more new applications, or to limit or reduce the goods or services mentioned in the application.
- (b) If the application is divided into new applications according to sub-section (a), paragraph (3), the original application date shall be deemed as the application submission date.



22. The Registration Officer may, with regard to the application made according to section 21, approve the amendment of the application after reviewing it as prescribed.

Chapter (9)

Inspection, opposition and registration

23. The Inspection Officer, with regard to the application for Mark registration -
- (a) Shall review the application to check if it violates the provisions of section 13 and fulfills the requirements under section 17 and submit the complete application to the Registration Officer together with his/her remarks;
 - (b) shall send, with the approval of the Registration Officer, a notice to the applicant to amend the application if it violates the provisions of section 13 or does not fulfill the requirements under section 17. If the applicant does not revise the application within 30 days starting from the date of the notice, the applicant shall be deemed to have abandoned the application;
 - (c) upon receipt of the revised application within the prescribed time as per sub-section (b), the Inspection Officer shall, after having reviewed it, submit it to the Registration Officer together with his/her remark.
24. A person who applies to register a Mark -
- (a) If he/she has failed to revise the application within the prescribed time and this failure has caused the loss of rights concerning the application for registration, may re-apply for the registration of the Mark in accordance with the following conditions:
 - (1) Submission of a request within 60 days from the date of abandonment due to the failure to revise the application within the prescribed time;
 - (2) attachment of all required explanations and information relating to the failure to revise the application within the prescribed time;
 - (3) describing in the request good reasons for the failure to revise the application within the prescribed time;
 - (4) payment of the prescribed fee.
 - (b) The Registration Officer shall suspend the request to re-establish the rights related to the application according to sub-section (a) during the period after an appeal is made.



25. The Registration Officer -
- (a) may approve the re-application made according to section 24 sub-section (a) if the abandonment of the application would have caused the loss of the right to apply for registration.
 - (b) He/she shall make an announcement to make the public aware and enable oppositions if an application meets the criteria of sections 13 and 17.
26. Any person wishing to oppose the application for registering a Mark may, on payment of the prescribed fee, submit an opposition letter to the Registration Officer, stating a cause prescribed in sections 13 or 14, within 60 days from the announcement date.
27. The Registration Officer shall, upon receipt of the opposition letter, send a notice to the applicant in order for him/her to defend him/herself within the prescribed period.
28. The Registration Officer, in relation to the application for the registration of a Mark -
- (a) May approve the application for the registration of the Mark if there is no opposition within 60 days from the date of announcement for public awareness;
 - (b) if an opposition letter is submitted, may approve or reject it after reviewing whether it meets the criteria under sections 13 and 14;
 - (c) shall record the approval or rejection of the registration in the register and notify the applicant. Furthermore, the approval or rejection of the registration shall be announced as prescribed for public awareness.
 - (d) If the registration is approved, a Mark registration certificate shall be issued to the applicant.
29. The Mark Owner -
- (a) may, on payment of the fee prescribed by the Department, apply to the Registration Officer to obtain a true copy of the Mark registration certificate if the original Mark registration certificate is lost or damaged; and
 - (b) may, on payment of the prescribed fee, apply to the Registration Officer to amend wrong information written in the register, other correctable mistakes or nationality or addresses.



30. The Registration Officer -
- (a) shall issue a true copy of the Mark registration certificate after reviewing the application made under section 29, sub-section (a);
 - (b) may approve the amendment after reviewing the application made under section 29 sub-section (b).

Chapter (10) **Priority Right**

31. A person who has applied for registration of a Mark in any Paris Convention member state or World Trade Organisation Member State shall, if he/she applies for the same Mark at the Department within six months from the date of the first application, be entitled to a Priority Right.
32. A person shall be entitled to a Priority Right Relating To An Exhibition if he/she applies, within six months from the date of the display, for registration of the Mark with the Department and the goods and services of the Mark have been displayed at an international exhibition organised or recognised by the government of any Paris Convention member state or World Trade Organisation Member State.
33. The Priority Right Relating To An Exhibition shall not exceed the period of priority which starts on the date of filing the application under section 31.

Chapter (11) **Registration term and renewal of the registration**

34. The term of the registered Mark is ten years from the date of application for Mark registration. The registration term may be extended every ten years after the ten years period.
35. The Mark Owner shall do the following if he/she wishes to extend the registration term -
- (a) shall, on payment of the prescribed fee, apply for the extension within six months prior to the expiry date of the registration term;
 - (b) may apply for the extension within six months offered under special privilege after the expiry of the registration term. The applicant must pay the prescribed registration fee and late filing penalty in this case.
36. The Registration Officer -



- (a) shall approve the application for extension if it meets the criteria. The extension of the registration term shall be effective on the expiry date of the previous registration term;
- (b) shall extend the term of the registration for ten years after reviewing the application for extension that meet the criteria and, furthermore, announce *[the extension]* as prescribed;
- (c) shall record the extension of the registration term and payment of the fees in the register;
- (d) shall terminate the registration of the Mark if the Mark Owner fails to pay the prescribed fee within six months offered under special privilege for the extension of the registration term;
- (e) shall record the termination of the Mark registration in the register and announce *[the termination]* as prescribed.

Chapter (12)

Rights of the registered Mark

- 37. The Mark Owner shall be entitled to the rights of the Mark registered under this law during the registration term if he/she complies with the provisions under chapter (11) of this law.
- 38. Without prejudice to the provisions in sections 39 and 40, the Mark Owner has the right -
 - (a) As an exclusive right:
 - (1) To prevent, and protect himself/herself against, the use by a person in commerce without the consent of the Mark Owner of the Mark for identical or similar goods or services;
 - (2) to sue any person who has infringed the rights of the registered Mark in civil or criminal proceedings or both;
 - (3) to prevent, and protect himself/herself against, the use in commerce of a registered Famous Mark or similar Mark without the consent of the Mark Owner for goods or services which are not identical or similar in the following circumstances -



- (aa) False indication that there is a connection between the goods or services that are infringing and the owner of the registered Famous Mark; and
 - (bb) the use impairs the interests of the Mark Owner.
- (b) The Mark Owner may transfer the rights of the registered Mark to any other person or authorise him/her to use them in accordance with the provisions under chapters (13) and (14).
39. The Mark Owner shall not prevent the use in good faith of the following in production or trading -
- (a) Name and address of the owner;
 - (b) indications that show the type, related subjects, quality, quantity, intended use, price, place of origin, manufacturing time or other characteristics;
 - (c) description of the intended use of the goods or services, in particular of goods that have to be used together or as spare parts.
40. The Mark Owner or the authorised person shall not prevent the use of the Mark for goods that were placed in the market by himself/herself.
41. Notwithstanding the provisions in section (40), the Mark Owner may, in accordance with the laws in force, restrict the sale of goods that he/she placed in the market if the conditions of the goods have changed or the goods are damaged.

Chapter (13) **Transferring Mark rights**

42. (a) A person applying for Mark registration may apply as prescribed to record the transfer of his/her application to a person or legal entity.
- (b) The Mark Owner may apply as prescribed to the Registration Officer to record the transfer of his/her registered Mark to a person or legal entity.
43. The Registration Officer shall, upon receipt of the application to record the transfer of the application according to section 42 sub-section (a) or the transfer of ownership according to section 42 sub-section (b) and payment of the prescribed fee by the owner or the transferee, record the transfer of ownership and announce it for public awareness as prescribed.



44. A transfer of ownership shall be void if no application is submitted to the Registration Officer concerning the transfer of the ownership of the registered Mark.

Chapter (14)

Authorising the use of a registered Mark

45. The Mark Owner may authorise a person or legal entity to use his/her registered Mark by specifying the terms and conditions.
46. A person who is authorised by the Mark Owner to use his/her Mark may apply to the Registration Officer to register the authorisation of the use of the Mark by submitting a true copy of the authorisation and paying the prescribed fee.
47. The Registration Officer shall record the application made in accordance with section 46 and make an announcement as prescribed.
48. If the Mark Owner or a person who is authorised by the Mark Owner to use the Mark applies to the Registration Officer to delete the authorisation, the Registration Officer shall delete it from the register and make an announcement for public awareness as prescribed.
49. The use of the Mark with authorisation shall be void if no application is submitted to the Registration Officer for recording.

Chapter (15)

Declaring a Mark registration invalid and deletion

50. (a) The Registration Officer shall, after reviewing required evidence upon the receipt of an application by an interested person, declare the registration of a Mark to be invalid if he/she has found that it does not meet the registration criteria under the provisions of section 2 sub-section (j) or section 13.
- (b) The Registration Officer shall, after reviewing the required evidence upon receipt of an application by an interested person, declare the registration of a Mark to be invalid if he/she has found that the trademark is not capable of being registered under the provisions of section 14.
- (c) If the Registration Officer receives the Intellectual Property Court's final and conclusive decision regarding an application to declare a registered Mark invalid, he/she shall declare the Mark registration to be invalid.



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- (d) (1) An application for invalidation made under sub-section (a) may be made at any time.
 - (2) Unless the registration was achieved in bad faith, the application for invalidation made under sub-section (b) may be made only within 5 years from the date of registration.
 - (e) If the reason for declaring a Mark invalid applies to only some of the goods or services of the registered Mark, only such related registration shall be declared invalid.
 - (f) The Registration Officer shall record the declaration of invalidity of the registration and such declaration shall be notified to the Mark Owner and to the public.
51. (a) The Registration Officer shall, upon application by any interested person, delete the Mark registration in the following cases -
- (1) Complete failure to use the goods or services related to the registered Mark within 3 years from the date of application without proven reason;
 - (2) continuous failure to use the registered Mark for 3 years without proven reason; or
 - (3) it only describes the characteristics or indication that show the type, related subjects, quality, quantity, intended use, price, place of origin or manufacturing time of goods or services, or it has become a common expression or customary in contemporary vocabulary or a commercial practice.
- (b) The following shall be included in the use of a Mark according to sub-section (a) -
- (1) Using characteristics of the registered Mark in a different form without changing the special characteristics;
 - (2) using the Mark in the country, including its fixation on goods or on the package of goods for export.
- (c) The burden of proof shall be on the Mark Owner if the usage of the Mark, including the period, nature and fields of use, is required to be proven according to this law.
- (d) If the reason for deleting the Mark only applies to some of the goods or services of the registered Mark, only such related registration shall be deleted.



- (e) If the registration of the Mark is deleted, the registration shall be deemed to officially cease.
 - (f) The Registration Officer shall record the deletion of the registered Mark and shall notify the Mark Owner and the public.
52. Nobody is allowed to use a Mark whose registration was rejected or deleted by the Registration Officer due to a violation of the provisions of section 13 sub-section (c).

Chapter (16) **Geographical Indication**

53. Any legal entity that represents the following persons from an area in which the relevant goods are produced that wishes to register its Geographical Indication may apply to the Registration Officer as prescribed.
- (a) Producers using natural goods or resources;
 - (b) producers of agricultural products;
 - (c) producers of handicraft or industrial goods;
 - (d) responsible persons from related government departments and organisations that represent persons under sub-section (a) to (c).
54. (a) The application for registration of a Geographical Indication shall include the following -
- (1) Name, nationality and address of the representative or legal entity;
 - (2) Geographical Indication for which the application for registration is filed;
 - (3) area to which the Geographical Indication applies;
 - (4) goods for which the Geographical Indication will be used.
- (b) The following has to be described together with the information above -
- (1) Significant characteristics, quality or reputation of the goods;
 - (2) standards of the characteristics, quality or reputation of the goods; relation between the area of production and the production method;
 - (3) other specified information.



- (c) Shall pay the registration fee when applying.
55. No Geographical Indication shall be allowed to be registered if -
- (a) It does not fall within the definition of Geographical Indication in section 2 sub-section (o);
 - (b) the goods for which the Geographical Indication would be used are common expressions or customary in the Union [*literal translation*]; or
 - (c) it violates public stability or integrity or community standards.
56. Any interested person, department or organisation may apply to the Registration Officer to declare invalid or delete the registration of a Geographical Indication in the following cases -
- (a) It does not fall within the definition of Geographical Indication in section 2 sub-section (o);
 - (b) failure to meet the criteria specified under section 54 sub-section (b);
 - (c) if a foreign Geographical Indication is not protected in its country of origin or no longer protected or no longer used in that country;
 - (d) it violates public stability or integrity or community standards.
57. (a) Concerning the goods recorded in the register, only persons in the specified area are allowed to use the registered Geographical Indication in commerce. However, these goods shall have the quality, reputation and other significant characteristics recorded in the registration.
- (b) Homonymous Geographical Indications shall be protected after it is established that the Geographical Indication first registered is used differently from the Geographical Indication registered later, taking into consideration the equal treatment of the relevant producers and the [*potential*] misleading of consumers.
- (c) The Right Holder of a registered Geographical Indication shall have the right to prevent and protect himself/herself against the following -
- (1) Fraudulent use of the Geographical Indication to mislead the public by stating that the goods are manufactured in the relevant area, although they are not manufactured there;



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- (2) use of the registered Geographical Indication that causes unfair competition; and
 - (3) use of the disputed Geographical Indication for goods that are not produced in the relevant area when indicating the *[true]* place of origin, translating and using the translation of the Geographical Indication or accompanying the Geographical Indication by expressions such as “kind”, “group”, “type” or other fraudulent expressions.
 - (d) Other Geographical Indications which correctly express the territory, region or area of origin, but mislead the public into believing that the goods are produced in another territory shall not have the rights according to sub-sections (a) and (c).
58. (a) The Registration Officer shall announce the information and data contained in the application as prescribed if the application has been made in conformity with sections 53, 54 and 55.
- (b) Anybody wishing to oppose the registration of a Geographical Indication may use the provisions for opposing a Mark as required.
- (c) The Registration Officer shall register the Geographical Indication if he/she has not received an opposition or rejected the opposition.
59. The registered Geographical Indication shall be protected by this law as long as it has its protected significant characteristics, quality or reputation.
60. (a) If an application for the registration of a Mark that is used for identical goods is filed after an application for the registration of a Geographical Indication has been filed in accordance with this law, the Registration Officer shall reject the registration of the Mark if it violates section 57.
- (b) If a registered Mark violates the provisions of sub-section (a), the Mark shall be declared invalid.
- (c) The use for goods of a Mark registered or for which an application for registration had been filed in good faith before the application for registration of a Geographical Indication was filed may continue irrespective of a violation of section 57, unless there is a violation of chapter 15. The Registration Officer shall allow the Geographical Indication to be used as the related Mark in such circumstances.



61. (a) The relevant departments and organisations shall monitor the protected Geographical Indications. Certain functions related to the monitoring may be transferred to other persons.
- (b) The following shall be monitored -
- (1) Whether the actual goods match the expression for the goods that is protected as Geographical Indication;
- (2) use of the names of the registered Geographical Indications in the market.
- (c) The expenses for monitoring whether the goods match the expression shall be borne by the interested parties.
62. Infringements of Geographical Indication rights outside of the provision of this law shall be taken action against according to the provisions concerning the infringement of Mark rights.

Chapter (17) **Trading Names**

63. (a) Trading Names shall be protected irrespective of them being part of a Mark or being registered.
- (b) If a name or an expression impairs public stability or integrity due to its nature or by its use, in particular if the nature of the business for which such name or expression is used misleads the commercial world or the public, such name or expression shall not be used as Trading Name.
- (c) A Trading Name shall be protected against any unauthorised use of another identical or similar Trading Name or Mark if this use misleads the public.

Chapter (18) **Application for international registration**

64. After the Union has become a member to an agreement for an international Mark registration system, any person from within or outside of the Union wishing to register a Mark under the international Mark registration system may apply to the Registration Officer as prescribed.



Chapter (19)

Appeal

65. (a) Any person not satisfied with the decision made by the Registration Officer under this law may appeal to the Agency within 60 days from the date of the announcement of the decision.
- (b) The Agency may, upon receipt of the appeal filed under sub-section (a), confirm, revoke or amend the decision of the Registration Officer or instruct him/her to obtain additional evidence.
- (c) The Agency may, upon the receipt of the additional evidence obtained under sub-section (b), confirm, revoke or amend the decision of the Registration Officer.
66. Any person not satisfied with the decision of the Agency may apply to the Intellectual Property Rights Court authorised by the Supreme Court of the Union in this regard within 90 days from the date of the receipt of the notice of the decision.

Chapter (20)

Establishment of Intellectual Property Rights Court [*singular in the original*]

67. The Supreme Court of the Union -
- (a) May establish Intellectual Property Rights Courts in appropriate areas and appoint judges in order to hear and decide in civil or criminal proceedings concerning Intellectual Property Rights matters;
- (b) may confer the power and jurisdiction to the judges appointed under sub-section (a) in order to hear and decide the cases relating to Intellectual Property Rights matters;
- (c) may confer the power and jurisdiction of an Intellectual Property Rights Court to the competent courts that have been conferred power to hear and decide Intellectual Property Rights matters before the establishment of the Intellectual Property Rights Courts under sub-section (a);
- (d) shall specify the jurisdiction and power of the courts that should have jurisdiction over appeals against and requests for amendments of the judgments, orders and decisions rendered by the Intellectual Property Rights Courts;
- (e) may confer the jurisdiction and power to the relevant Intellectual Property Rights Court to hear and decide an application filed in accordance with section 66.



Chapter (21)

Protection of Mark rights by the customs department

68. A Right Holder having sufficient grounds for suspecting that an import into the territory of Myanmar of goods allegedly sporting a counterfeit Mark has taken place, is taking place or is planned, may submit an application for a temporary suspension of the transport of such goods to the director general of the customs department as prescribed.
69. (a) The director general of the customs department -
- (1) Shall notify the applicant within 30 days after the receipt of the application filed according to section 68 whether the application has been approved or rejected.
 - (2) If the information provided is not sufficient, shall so notify the applicant requesting further information to be provided within 15 days after the receipt of the notice.
 - (3) May request a guarantee from the applicant if the application is approved.
 - (4) If the application is rejected, sufficient reason shall be provided.
- (b) The measures according to sub-section (a) [sic!] shall be in effect for six months if the Right Holder does not request a shorter period.
70. (a) The director general of the customs department shall, after the application according to section 69 [sic!] has been approved or after a relevant discovery by the customs department, suspend the transport of the imported goods if there is sound evidence that they sport a counterfeit Mark. The applicant and the importer shall be immediately notified of such suspension.
- (b) The director general of the customs department shall allow the applicant and the importer to examine, without disclosing confidential information, the goods whose transport is suspended in order to prove the allegation made by the applicant.
71. (a) If, after having been notified of the suspension, the applicant does not take action within 15 working days, or if the Intellectual Property Rights Court does not notify the director general of the customs department that further time is required, the suspension shall be lifted. The director general of the customs department has the discretion to extend, prior to its expiry, the initial 15 working days period by another 15 working days.



- (b) The specified period shall be 3 days for perishable goods.
72. The importer may apply to the competent Intellectual Property Rights Court after receiving a temporary suspension notice in order to have it reviewed. The Court shall amend, revoke or confirm the suspension period within 30 working days after having received the importer's application.
73. If the Intellectual Property Rights Court decides that the goods sport a counterfeit Mark, the importer shall pay, to the customs department, the expenses for the maintenance, destruction or removal of such goods. The applicant shall be liable to pay such expenses if the director general of the customs department is unable to obtain payment from the importer. The applicant shall have the right to recover such expenses from the importer.
74. If the Intellectual Property Rights Court decides that the goods do not sport a counterfeit Mark, the applicant shall pay, to the importer in the amount specified by the Court, damages that have occurred due to the wrongful suspension and detention of the goods.
75. The provisions in this chapter shall not apply to goods that sport a counterfeit Mark if they are carried during travel in small quantities without a commercial purpose by an importer for personal use or if the imported goods are specified in the rules.
76. The director general of the customs department may cooperate with the World Customs Organisation and the directors general of other customs organisations of other countries in connection with the exchange of information in respect of goods that allegedly sport a counterfeit Mark.

Chapter (22)

Powers of an Intellectual Property Rights Court regarding the infringement of Mark rights

77. (a) A Right Holder may apply to an Intellectual Property Rights Court for a provisional order [*literally, "temporary action order"*] in accordance with the provisions in sections 79 and 80 if he/she suffered [*translator's note: "suffered" is in the past tense in the original*] a damage.
- (b) A Right Holder may apply to an Intellectual Property Rights Court to take action according to civil or criminal proceedings.
78. An Intellectual Property Rights Court -



- (a) If a person who is not the Mark Owner exercises any rights under section 38 in the Union without authorisation from the Mark Owner, he/she is deemed to violate a Mark protected by this law.
 - (b) If a person uses an unregistered Famous Mark or symbol for identical or similar goods or services, this shall be deemed to be misleading the public.
79. (a) An Intellectual Property Rights Court may issue any of the following provisional orders upon an application for civil remedy according to section 77, sub-section (a) regarding infringements of Mark rights -
- (1) Order prohibiting the import into the country of goods that infringe a Mark right, irrespective of their customs clearance, in order to prevent the infringement of a Mark right;
 - (2) order to maintain evidence with regard to a Mark infringement in its original form;
 - (3) order amending, revoking or confirming a temporary suspension ordered by the relevant customs department.
- (b) The court may request the following from the applicant in order to pass a provisional order -
- (1) Sufficient evidence that the applicant has an interest in the matter and his/her rights are being infringed or potentially infringed; and
 - (2) submission of adequate security to prevent an abuse of the temporary action.
- (c) An Intellectual Property Rights Court may, when taking temporary action in accordance with sub-section (a), instruct the applicant to submit further information in order to identify the goods that are alleged to infringe.
- (d) The Intellectual Property Rights Court shall lift or make ineffective, without prejudice to section 80 sub-section (b), the provisional order made according to sub-section (a) of section 79 or sub-section (a) of section (80) upon a corresponding request from the defendant if no legal proceedings under civil procedure have been commenced within the period specified by the Court or, if no period has been specified, after 30 working days from the date of the provisional order.



- (e) An Intellectual Property Rights Court may order the applicant to pay reasonable and adequate compensation to the defendant for damages incurred due to the provisional order requested by the applicant if the provisional order is revoked or terminated by the Court due to an act or omission of the applicant or if the Court discovers that the registered Mark is not infringed or potentially infringed.
80. (a) An Intellectual Property Rights Court may pass a unilateral provisional order in the following circumstances -
- (1) If there is delay that may cause damages to the Right Holder that cannot be remedied; or
 - (2) if evidence is at risk of being destroyed.
- (b) If the Intellectual Property Rights Court passes a unilateral provisional order -
- (1) It shall notify the provisional order to the defendant promptly without delay.
 - (2) enforce the provisional order if the defendant does not react within the period specified by the Court or, if no period is specified, within 30 working days after the date of the notice.
- (c) shall hear and examine both parties again within a reasonable period of time upon a request made by the defendant in order to amend, revoke or confirm the provisional order.
81. (a) An Intellectual Property Rights Court may, without prejudice to civil law and the Code of Civil Procedure, pass any of the following orders regarding the infringement of Mark rights in accordance with the sub-section 77(b).
- (1) Order prohibiting the import into the country of goods that infringe a Mark right, irrespective of their customs clearance, in order to prevent the infringement of a Mark right;
 - (2) (aa) order the infringer to pay damages to the Right Holder due to a Mark infringement; or order the infringer to pay the amount claimed by the Right Holder, an amount equivalent to the profit achieved through the infringement, or both;
 - (bb) order the infringer to pay the expenses of the Right Holder, including legal costs and lawyer fees;



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- (3) order to remove from commercial circulation or destroy, without any compensation, the goods that infringe a Mark in order to prevent any damage to the Right Holder;
 - (4) order to remove from commercial circulation or destroy the equipment used for the production of goods that infringe a Mark.
 - (b) The Intellectual Property Rights Court shall attempt to balance the order passed according to sub-section (a), paragraphs (3) and (4) with the scope of the infringement, and consider the interest of other interested parties.
82. If a person is found to have falsely claimed that his/her Mark was infringed, the Intellectual Property Rights Court may order him/her to pay damages to the defendant who was wrongly accused by this claim in addition to legal costs, lawyer fees and other costs incurred by the defendant.
83. (a) An Intellectual Property Rights Court may, without prejudice to the provisions in other laws in force, while protecting confidential information, order the defendant to submit evidence if -
 - (1) the Right Holder has submitted sound evidence to sufficiently support his/her claim; and
 - (2) he/she shows convincingly that the defendant is in possession of sound evidence supporting the Right Holder's claim.
- (b) In case of an infringement without sufficient basis, the Intellectual Property Rights Court may, based on the pleadings and the evidence submitted by the aggrieved person and the infringer, pass an initial or final decision in the following circumstances -
 - (1) Access to required information was denied;
 - (2) the required information cannot be delivered within reasonable time;
 - (3) significant obstacle to a procedure relating to an enforcement action.
84. If there is a fine attached to an offence under this law, the court may order the infringer to pay the whole or part of the fine to the aggrieved person as compensation.
85. If both civil and criminal proceedings are commenced in the same matter, the Intellectual Property Rights Court may set off the fines imposed in the criminal proceeding according to



section 84 with the damages ordered to be paid by a judgment, decree or order in the civil proceeding.

86. The Intellectual Property Rights Court may apply the provisions of the Evidence Act, Code of Criminal Procedure, Code of Civil Procedure and other laws in force if procedures concerning the infringement of Mark rights are not explicitly set forth in this law.

Chapter (23) Offences and punishments

87. (a) Any person convicted for any of the following acts for commercial purposes without the authorisation of the Right Holder shall be punished with imprisonment for a term of not more than three years or with fine of not more than five million kyats or with both -
- (1) creating a counterfeit Mark;
 - (2) using a counterfeit Mark on goods or for services; or
 - (2) possession of any tools or equipment which are used for creating a counterfeit Mark or putting a counterfeit Mark on goods.
- (b) Any person convicted for any of the following acts for commercial purposes shall be punished with imprisonment for a term of not more than two years or with a fine of not more than five million kyats or both -
- (1) Sale, distribution or possession for distribution of goods for which a counterfeit Mark is used;
 - (2) export or import of goods for which a counterfeit Mark is used from or into the Union.
88. Any person with a previous conviction for any acts under section 87 being convicted again for similar acts shall be punished with imprisonment from three to ten years and a fine of not more than ten million kyats.
89. Any person convicted for using flags or emblems protected by an international agreement as a Mark for commercial purposes shall be punished with imprisonment of not more than three years or with a fine of not more than fifteen million kyats or with both.
90. Any person convicted for eliminating, destroying, changing the form of or adding something to a registered Mark with the aim of causing damage to the Mark Owner shall be punished with



imprisonment of not more than one year or with a fine of not more than three million kyats or with both.

91. Any person convicted for the following acts shall be punished with imprisonment of not more than one year or with a fine of not more than two million kyats or with both.
- (a) Fraudulently issuing or causing to be issued a Mark registration certificate;
 - (b) making or causing to be made a false entry in the register in bad faith; or
 - (c) violating the provisions under section 52.
92. Any person who aided or abetted in the commission of an offence according to this law shall be sentenced to the sentence that is specified for this offence.

Chapter (24) **Miscellaneous**

93. With regard to the Registration Act [*Translator's note: "Registration Act" instead of "Registration of Deeds Law" is in the original.*] in force before this law enters into effect -
- (a) A Mark Owner with a registration at the Registration of Deeds Office and a Mark Owner using a Mark in the Union without registration shall apply for registration under this law if he/she wishes to enjoy the rights of a registered Mark.
 - (b) Marks which are used in the market of the Union shall be entitled to a priority right for the related goods or services within the specified period irrespective of their registration at the Registration of Deeds Office.
94. Irrespective of any provisions of any other laws in force -
- (a) Mark registration shall be performed in accordance with this law.
 - (b) An offence relating to a Mark shall be taken action against only under this law.
95. The Registration Officer shall allow a person to appear [*in order to plead this person's cause*] if his/her decision taken in the exercise of his/her power conferred according to this law caused damage to this person.
96. A copy of a Mark registration certificate and other documents authenticated by the signature and the seal of the Registration Officer shall be eligible for submission as evidence to an Intellectual Property Rights Court.



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97. An Intellectual Property Rights Court may pass an appropriate administrative order to confiscate as people's property, destroy or otherwise dispose of goods for which a counterfeit Mark is used, including the related tools and equipment.
98. The Ministry shall act as the office of the Agency and cover the expenses of the Central Committee and the Agency in order to implement the provisions of this law.
99. The Ministry shall specify, with the consent of the Union government, the salary and allowances of the members in the Central Committee and the Agency who are not civil servants.
100. The regular term of office under this law of a Union level person shall be the same as the term of office of the president.
101. The Ministry may form departments and sub-departments and assign their functions based on Intellectual Property Rights sectors in order to perform the functions of the Agency.
102. Infringements of Mark rights under this law shall not affect the non-commercial use of goods with a Mark in an emergency of the Union or a catastrophe by government departments and legal entities in the interest of the public.
103. The offences under this law are cognizable offences.
104. Disputes arising among concerned parties relating to a Mark may be settled either amicably, by arbitration or in a law suit.
105. The Central Committee and the Agency established in accordance with this law shall be competent for all Intellectual Property Rights laws.
106. In implementing the provisions of this Law -
 - (a) The Supreme Court of the Union may issue rules, regulations, notifications, orders, directives and procedures.
 - (b) The Ministry and competent department -
 - (i) may issue rules and regulations with the consent of the Union government; and
 - (ii) may issue notifications, orders, directives and procedures.
 - (c) The ministry in charge of customs-related matters may issue rules and regulations relating to customs matters with the consent of the Union government.



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- (d) The Agency and the Department may issue notifications, orders, directives and procedures with the consent of the Ministry.

I signed this law according to the constitution of the Republic of the Union of Myanmar.

Win Myint
President
The Republic of the Union of Myanmar

About Lincoln Legal Services (Myanmar) Limited

Lincoln Legal Services (Myanmar) Limited provides the full range of legal and tax advisory and compliance work required by investors. We pride ourselves in offering result-oriented work, high dependability and a fast response time at very competitive prices. Please do not hesitate to contact us:

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