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AN ANALYSIS OF THE NEW TRADEMARK LAW 2019

1. Introduction

A new Trademark Law (Pyidaungsu Hluttaw Law No. 3/2019) and a new Industrial Design Law (Pyidaungsu Hluttaw Law No. 2/2019) were enacted on 30 January 2019. A new Patent Law (Pyidaungsu Hluttaw Law No. 7/2019) followed on 11 March. A Copyright Bill is still under consideration by parliament.

Among the enacted and proposed four pieces of legislation, the Trademark Law is considered to be the one with relevance to the largest number of investors and entrepreneurs. It is reported that to date, there are 60,000 registered declarations of ownership of (trade-) marks.¹ In contrast, only a negligible number of declarations of ownership of industrial designs or patents have been registered, and copyright protection is currently a rather elusive concept.

An English translation of the Trademark Law is available on our homepage: <https://tinyurl.com/y65cr9pt>

The three currently enacted intellectual property laws will enter into force only at some point in the future determined by the president in a notification. It is not expected that this is going to be soon as a new infrastructure (creation of an Intellectual Property Rights Central Committee and a modern registration system) still has to be set up.

There is therefore no need for the owners of marks that are already registered under the current system to take immediate action. Mark owners who haven't filed declarations of ownership under the current system yet should do so and not wait until the new Trademark Law enters into force.

The three laws establish common bodies and procedures with each law assigning to them the functions that are relevant to the respective law's specific scope. E.g., the "Registration Officer" in the Trademark Law registers marks whereas he or she registers industrial designs in the Industrial Design Law and patents in the Patent Law. We expect that the Copyright Law (if and once enacted) will share these common bodies and procedures.

The common bodies and procedures are:

¹ <https://www.mmtimes.com/news/trademark-law-and-industrial-design-law-enacted.html>



- Intellectual Property Rights Central Committee
- Intellectual Property Rights Agency
- Registration Officer
- Inspection Officer
- Intellectual Property Rights Courts
- Temporary seizure of goods by the customs department that allegedly infringe an intellectual property right.

2. Scope of protection

The Trademark Law will, once it enters into force, protect (registered) marks, (registered and unregistered) famous marks, (registered) geographical indications and (registered and unregistered) trading names.

(a) Protection of marks

A “**mark**” is defined as “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.” The expression encompasses trademarks, service marks, collective marks and certification marks.

The owner of a registered mark is exclusively entitled to prevent its unauthorised use in commerce for identical or similar goods or services. He or she is free to transfer or license the mark to any other person.

(b) Protection of famous² marks

A “**famous mark**” is defined as “a mark which is well-known and famous within the country according to a specified standard”. The Trademark Law does not specify such standards; this may later be done in a notification.

The owner of a registered famous mark is exclusively entitled to prevent its dilution due to its unauthorised use in commerce that creates the impression of a connection between the infringing goods or services and the owner of the famous mark, irrespective of whether the infringing goods or services are identical or similar to the goods or services for which the famous mark is registered.

² “Well-known” would also be a possible translation in line with the expression used in the Paris Convention and the TRIPS Agreement, but “famous” is closer to the original.



Irrespective of whether it is registered, the owner of a famous mark is exclusively entitled to prevent its unauthorised use in commerce for identical or similar goods or services.

(c) Protection of a geographical indication

A “**geographical indication**” is defined as “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”.

Under the current system, some declarations of mark ownership seem to have been registered at the Registration of Deeds Office for geographical indications. Protecting geographical indications as a mark should no longer be possible under the new system³ as it does not allow a mere indication of the place of origin to be registered as a mark. Rather, the new Trademark Law provides for a separate registration category for geographical indications.

Private organisations and government departments representing producers from a particular area that have registered a geographical indication are exclusively entitled to prevent its fraudulent use by producers from other areas, even if such producers as such do not lie about the place of origin and only state that their product belongs to the “kind”, “type” or “group” of the products made in the protected area.

(d) Protection of trading names

A “**trading name**” is defined as “a name or expression distinguishing a trading business from another”.

The owner of a trading name has the exclusive right to prevent the unauthorised use of another identical or similar trading name or mark if this use misleads the public, irrespective of whether the protected trading name is registered or part of a mark.

3. Registration system

The Trademark Law establishes a modern registration system for marks and geographical indications.

Currently, marks can be registered at the Registration of Deeds Office in Yangon. The Registration of Deeds Office is a sub-department of the Ministry of Agriculture, Livestock and

³ An exception may apply to existing marks, cf. section 60(c) Trademark Law.



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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 specialised intellectual property office.

With regard to marks, the Registration of Deeds Office currently registers “declarations of ownership”, i.e. a statement signed by the applicant (or its representative) that the applicant owns a certain mark. The registration officer usually does not verify whether the mark which the applicant wishes to have registered has already been registered for another person or whether it should not be registered due to lack of distinctiveness or other reasons that contradict the purposes of a mark. Furthermore, there is no cancellation procedure, i.e. an infringed right holder must obtain a court order to have the offending mark deleted.

The current registration system at the Registration of Deeds Office is entirely paper-based. The registers of the Office cannot be searched by the public. It is customary for mark owners to publish cautionary notices in newspapers, and some law firms (including ours) have created databases out of these cautionary notices. Searching these databases provides an indication whether a declaration of ownership has been registered for a mark, but such a search is not comprehensive.

Once the new system is established, the responsibility for registering marks (and geographical indications) will shift from the Ministry of Agriculture, Livestock and Irrigation to the Ministry of Commerce. The Ministry of Commerce shall authorise one of its departments (presumably, newly created) to manage intellectual property rights. Its director general shall act as “**Registration Officer**” and one of its assistant directors as “**Inspection Officer**”.

The Inspection Officer shall review whether (i) the application is complete and (ii) there are no absolute grounds for opposing registration. If the result of this review is satisfactory, the Registration Officer shall publish the mark or geographical indication in order to enable interested parties to file an opposition. If no opposition is filed within 60 days or the Registration Officer rejects the opposition, he or she shall register the mark or geographical indication and issue a registration certificate to the applicant.

Although the new Trademark Law makes no mentioning of it, it is expected that the new registration system will be electronic and create a searchable database.



4. Application for registration

(a) Application for the registration of a mark

An application for mark registration may be made either in the Myanmar or the English language. At the request of the Registration Officer, the applicant shall provide a signed translation from English to Myanmar or vice versa.

The application shall include:

- Registration request;
- name and address of the individual or legal entity filing the application;
- name, national registration card number⁴ and address of the representative if the application is filed by a representative;
- clear representation of the mark;
- names and class of the goods or services according to international classification, or names and types of the goods or services.

If required, the following information and documents shall also be provided:

- Registration number, type and jurisdiction of origin if the applicant is a legal entity;
- if the applicant requests a priority right or a priority right relating to an exhibition: submission of a priority right request together with proof and a description showing the existence of the priority right;
- if the mark had been registered previously at the Registration of Deeds Office: proof of such registration;
- other items specified from time to time by the Intellectual Property Rights Agency and the department authorised by the Ministry of Commerce.

Furthermore, payment of a registration fee (amount still unknown) will be required.

⁴ This means that the representative in a mark registration must be a Myanmar national.



(b) Application for the registration of a geographical indication

The application for registration of a geographical indication shall include the information:

- Name, nationality and address of the representative or legal entity;
- geographical indication for which the application for registration is filed;
- area to which the geographical indication applies;
- goods for which the geographical indication will be used;
- significant characteristics, quality or reputation of the goods;
- standards of the characteristics, quality or reputation of the goods; relation between the area of production and the production method; and
- other specified information.

Furthermore, payment of a registration fee (amount still unknown) will be required.

5. First-to-file system and registration period

Although it is currently possible (and recommendable) to file declarations of ownership of marks, unregistered marks are also protected provided that their owners are able to prove their actual use in commerce. The registration of a declaration of ownership is only an indication that the mark is in use; the owner of a competing mark may still prevail if he or she can prove that his or her use predates the use of the registered mark.

Under the new system, only registered marks are protected. As an exception, the owner of a famous mark may prevent its use for identical or similar goods irrespective of registration.

In case of competing marks, the mark for which the earliest application for registration was filed will prevail, provided that this application fulfilled the application criteria and there is no priority right (discussed below).

The registration period of a mark is ten years, starting from the date of the application for registration. An application for renewal has to be filed within six months prior to the expiry of the registration period. There is no limit on the number of renewals.



In contrast, the registration of a geographical indication apparently will not expire after a certain term. Rather, a “registered geographical indication shall be protected ... as long as it has its protected significant characteristics, quality or reputation”.

6. Absolute and relative grounds for opposing registration

(a) Opposing the registration of a mark

Upon receipt of an application for mark registration, the Inspection Officer must review whether there is an absolute ground for opposing registration. If a mark was registered in error, any interested party may request, at any time, invalidation of the registration if there is an absolute ground for opposition.

In contrast, the Inspection Officer may not review whether there is a relative ground for opposing registration. An interested party may request invalidation of the registration for a relative ground for opposition only within five years from the date of registration, unless the registration was achieved in bad faith.

It shall be an absolute ground for opposing registration if the mark -

- lacks distinctiveness;
- 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 misleads the public or commercial circles in this regard;
- affects public stability, integrity or beliefs, the reputation of the Union, public cultural heritage, or traditions of ethnicities;
- has become a common expression or customary in contemporary vocabulary or a commercial practice;
- 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
- uses mark symbols protected by an international treaty of which the Union is a member.



According to the new Trademark Law, “applying for registration in bad faith” (we suppose that this covers situations in which the applicant knows that someone else is the genuine owner of the mark) is a relative ground for opposing registration. Relative grounds furthermore exist if the mark -

- 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;
- 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;
- may violate the intellectual property rights of another person;
- misleads consumers because it is identical or similar to a famous mark and used for identical or similar goods or services; or
- 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.

(b) Opposing the registration of a geographical indication

The new Trademark Law does not use the expressions “absolute” and “relative” grounds for opposition with regard to geographical indications, but the concept is similar.

According to the law, no geographical indication shall be allowed to be registered if -

- it does not fall within the legal definition of geographical indication;
- the “goods for which the geographical indication would be used are common expressions or customary in the Union”⁵; or

⁵ This is a literal translation of section 55(b) Trademark Law. Correctly, it should probably read “the geographical indication has become a common or customary expression in the Union for the corresponding goods”.



- the geographical indication violates public stability or integrity or community standards.

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 -

- It does not fall within the legal definition of geographical indication;
- failure to meet in particular the characteristics, quality or reputation for which the goods from the protected area are known according to the application for registration;
- if a foreign geographical indication is not protected in its country of origin or no longer protected or no longer used in that country; or
- the geographical indication violates public stability or integrity or community standards.

7. Registration of marks lacking distinctiveness

The new law explicitly excludes marks that are purely descriptive or generic from registration. This may come as a surprise to many business owners as it appears that many declarations of ownership are currently registered for such marks.

(Invented) examples of purely descriptive or generic marks would be “Fantastic Construction”, “Myanmar Tours”, “Myanmar Accounting Services”, “Global Business Solutions” or “Mandalay Rum”.

Owners of such marks wishing to have them registered would have to prove that consumers distinguish it as a mark due to its use so far or that they exclusively and continuously used the mark in good faith in commerce in Myanmar.

Otherwise, the mark is in the public domain for anybody to use.

8. Failure to use a mark; mark that has become a generic term

The Registration Officer shall, upon application by any interested person, delete the mark registration in the following cases -



- Complete failure to use the goods or services related to the registered mark within three years from the date of application without good reason;
- continuous failure to use the registered mark for three years without good reason; or
- the mark (now) 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.

9. Priority right with regard to existing marks

According to section 93 Trademark Law -

“93. With regard to the Registration Act⁶ 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.”*

The new Trademark Law protects marks with a prior filing date over conflicting marks filed at a later date. In order to be protected in the future, marks currently registered with the Registration of Deeds Office have to be (re-) registered under the new system once it is in place.

Although the old filing date is not grandfathered in, there will be a “specified period” (its length not being determined yet) during which an application for (re-) registration may be filed. If the application for (re-) registration is filed within the specified period, this should result in the mark being considered to have a prior filing date in comparison with potentially conflicting marks. We expect details to be provided in a notification.

In any case, it should not be necessary to file an application for (re-) registration on the first day of the new system in order to secure priority. There are 60,000 marks registered under the

⁶ This should actually be the “Registration of Deeds Law” (Pyidaungsu Hluttaw Law No. 9/2018) which replaced the Registration Act (India Act 16, 1908, Vol. X) when it entered into force on 1 October 2018.



current system, and if all of their owners tried to re-register them at the same time, the new system would collapse.

The priority right is, however, tied to the actual use of the mark in Myanmar. If contested, the use has to be proven by the mark owner. Owners of existing marks may therefore wish to collect evidence (advertisements, price lists, stationary, photos of the goods on display, etc.) showing actual use.

The (few) organisations that currently have registered declarations of mark ownership for a geographical indication may wish to monitor developments as they may have to decide whether they should register a geographical indication or (re-) register the mark (which would presumably be possible according to section 60(c) Trademark Law).

10. Other priority rights

Although Myanmar is not a member of the Paris Convention, the new law provides for a priority right if an applicant had, within six months prior to the application in Myanmar, filed an application for mark registration in, or displayed the mark in an exhibition organised or recognised by the government of, a member state of the Paris Convention or the World Trade Organisation.

11. Transfer and license agreements require registration

The new law explicitly provides - differently from the current situation - that agreements by which a mark is transferred or licensed must be registered.

12. Protection by the customs department

Section 18(d) of the Sea Customs Act of 1878 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.

The new Trademark Law sets this system on a new and firm footing. It provides a procedure for a right holder to apply for a temporary suspension of the transport, the defences available to the importer, time frames, rules on the disposal of infringing goods and rules on expenses and damages.



13. Intellectual Property Courts

The Supreme Court 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. It may also vest these rights in other courts prior to the establishment of the Intellectual Property Courts.

The Intellectual Property Rights Court may issue any of the following provisional orders:

- Order prohibiting the import of goods that infringe a mark right⁷, irrespective of their customs clearance;
- order to maintain evidence with regard to a mark infringement in its original form; and
- order amending, revoking or confirming a temporary suspension ordered by the relevant customs department.

The court may issue unilateral provisional orders without hearing the defendant⁸ if the right holder otherwise suffered irreparable damage or evidence is at risk of being destroyed.

The court may pass any of the following (final) orders:

- Order prohibiting the import of goods that infringe a mark right, irrespective of their customs clearance;
- order the infringer to pay damages to the right holder; 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;
- order the infringer to pay the expenses of the right holder, including legal costs and lawyer fees;
- order to remove from commercial circulation, destroy or confiscate the goods that infringe a mark and the equipment used for their production;
- order a person who falsely claimed that his or her mark was infringed to pay damages to the defendant in addition to legal costs, lawyer fees and other costs.

⁷ The law only mentions “mark rights”, but we suppose that the owners of geographical indications (which are not included in the definition of “mark”) could also seize the Intellectual Property Rights Courts.

⁸ “Defendant” - literal translation.



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The court may order the defendant to furnish evidence in the right holder's favour if the right holder convincingly makes the case that the defendant is in possession of such evidence.

Finally, the court may order fines in criminal proceedings to be paid to the right holder as compensation.

14. Offences

The new law significantly expands criminal liability in connection with the illegal use of marks⁹ and the possession of goods for which a counterfeit mark is used.

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⁹ Again, the law makes reference only to "marks" and not also to "geographical indications".