




LINCOLN LEGAL SERVICES (MYANMAR) LIMITED



**INTELLECTUAL PROPERTY PROTECTION -
LAUNCH OF THE NEW SYSTEM**

10th December 2019



DEPARTMENT OF INTELLECTUAL PROPERTY
 MINISTRY OF COMMERCE

Workbench

DEMOAGENT16 | About | Logout |

WORKBENCH | SUBMISSION | MY PROFILE | NOTIFICATIONS

Language: EN

Filter

	WIPOFile Nbr	Date	Submission Type	Status	Summary
	WFT2019000042	2019-12-03 11:05:48	Old Mark Registration w/o Fees	Pending Payment	Lincolnlegal Myanmar Nice Classification Nbr:5

View 1 - 1 of 1

Perform Action on Selected Application:

Assign Portfolio:
 Select Portfolio

Powered by WIPO

THE NEW ONLINE REGISTRATION SYSTEM



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Steps so far

- **30th Jan 2019:** New Trademark Law; Industrial Design Law
- **11th March 2019:** New Patent Law
- **24th May 2019:** New Copyright Law
- **Unknown Date:** Transfer of an “Intellectual Property Department” from the Ministry of Education to the Ministry of Commerce
- **3rd Dec 2019:** IP Department holds first public seminar on the new online trademark filing system



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Next expected steps

- **18th Dec 2019:** IP Department to hold next public seminar, to publish rules and regulations
- **End of Dec 2019:** “Soft opening” of the new online filing system to start a 6 month transition period
- **During the 6 month transition period:**
 - Re-registration of old registered trademarks
 - Registration of old unregistered trademarks if they are in use in Myanmar
 - Application for registration of new trademarks, but no registration yet



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Next expected steps

- **End of June 2020:** “Grand opening” of the new online filing system. Thereafter:
 - 6 month grace period for (re-) registering existing trademarks with a penalty
 - Registration of new trademarks
 - Registration of transfer and of license agreements (s. 44, 49 Trademark Law)
 - Registration of geographical indications (s. 53 Trademark Law), collective marks and certification marks (s. 15 Trademark Law)



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Next expected steps

- **End of 2020:** Registration of industrial designs, and copyrights and related rights
- **End of 2021:** Registration of patents
- **At some point in the future:** Establishment of intellectual property courts



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

The new online registration system

- **Not for everybody:** Only IP agents (e.g., law firms, other specialised firms or individuals) may open an account
- Those wishing to file an application without an IP agent will have to do so in person at the Intellectual Property Offices in Yangon, Mandalay or Nay Pyi Taw



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

The new online registration system

- **Somewhat cumbersome:**

- Fill in online application
- Upload trademark image file, power of attorney (“appointment of representative”) and old trademark registration certificate and/or evidence of use
- Print out filled-in application form
- Sign application form
- Scan application form and upload
- Have fee calculated and pay fee
- Download application receipt with application number



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Important points are still unclear

- Expected to be clarified by 18th December 2019 (next public seminar and, possibly, publication of the rules and regulations)
- **“Submission date”** is important under the first-to-file rule. What is the submission date?
 - **Existing trademarks:** Old registration date, soft opening date, filing date of application for re-registration, or grand opening date?
 - **New trademark for which an application for registration is filed during 6 month transition period:** Filing date, or grand opening date?



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Important points are still unclear

- **“Registration date”** is important as an interested party may file an application for invalidation on relative grounds only within 5 years after the registration date. What is the registration date?
 - **Existing trademarks:** Old registration date, soft opening date, date of the re-registration, or grand opening date?
 - **New trademark for which an application for registration is filed during 6 month transition period:** Grand opening date, or actual registration date?



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Important points are still unclear

- **Power of attorney:** Does it have to be notarised and legalised if the applicant is from abroad?
- Will it be possible for foreign individuals to register a trademark? (Registration of Deeds Office currently only accepts applications from Myanmar individuals, Myanmar entities and foreign entities)
- When re-registering, can we change small things in comparison to the old registration (e.g., new company registration number, new address)?



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Important points are still unclear

- **“Mark translation”**: How would this be done in case of a “picture only” mark?



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

What to do right now

- If a no declaration of ownership has yet been filed under the current system: Hurry up filing in order to ensure the possibility to (re-) register under the new system during the transition period and secure the earliest possible priority right (our opinion)
- Locate current registration certificate
- Locate evidence for the use of the trademark in Myanmar (e.g. cautionary notice, advertisements, stationary, photos of the goods sporting the trademark)



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

TRADEMARK REGISTRATION: THE OLD AND THE NEW COMPARED



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

THE OLD AND THE NEW COMPARED

Topic	Old	New
Registration	Voluntary	Compulsory
Protection period	Not limited	10 years, renewable
Protection starts	With actual use	On “submission date”
Checks prior to registration	(Often) only formal checks	Material checks, in particular: <ul style="list-style-type: none">▪ Mark distinctive?▪ No effect on public order?▪ Not misleading?▪ Not using national emblems or protected symbols?



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

THE OLD AND THE NEW COMPARED

Topic	Old	New
Opposition procedure prior to registration	No	Registration officer must publish the trademark for 60 days prior to registration to enable opposition (usually from the owner of a similar trademark)
Invalidation procedure after registration	No; person with a “better right” must obtain court order to remove the registration	Interested person may apply for invalidation at any time (absolute grounds), w/in 5 years (relative grounds)



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

THE OLD AND THE NEW COMPARED

Topic	Old	New
Required time for registration	Approx. 3 weeks	At least 60 days
Cautionary notice	Recommended	Not needed
Use of the trademark in Myanmar required?	Yes	No use required during the first 3 years, thereafter an interested person may apply for deletion
Transfer and licensing	Valid without registration	Valid only with registration
Searchable database?	No	Yes, presumably



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

THE OLD AND THE NEW COMPARED

Topic	Old	New
Priority right if trademark is registered elsewhere?	No	Priority right if application in Myanmar is filed within 6 months after an (i) application was filed in a WTO or Paris Convention country or (ii) trademark was displayed at an international exhibition



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

PROTECTION AGAINST INFRINGEMENTS



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

How to go after an IP infringer

- As we will see on the next slides, there is a solid legal basis for going after the infringer of a trademark already in the current system, even without the new Trademark Law
- Such solid legal basis is currently often not there for other IP rights; it will only be introduced with the 4 new IP laws
- The real impact of the 4 IP laws will not be on trademarks (they are currently already pretty well protected), but on the many other IP rights for which there is currently no good protection



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

How to go after a trademark infringer

- Remedies against infringements:
 - Civil: Temporary or perpetual injunctions, damages
 - Criminal (sections 478-489 Penal Code 1861)
- **Step 1:** Process starts with (i) spotting the infringement, (ii) securing evidence (e.g. photos; purchase of goods with a receipt together with a witness); (iii) finding out the identity and contact details of the infringer (e.g. shop owner, factory owner, importer)



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

How to go after a trademark infringer

- **Step 2:** Contact the infringer, possibly with the help of a law firm (cease and desist letter) and negotiate
 - The **aims** may vary and include (i) the signing of an undertaking to cease the infringement, (ii) publication of an apology, (iii) revelation of the number of goods sold, the sales price and the number of goods still in stock, (iv) revelation of the origin of the infringing goods, (v) destruction of the stock of the infringing goods, (vi) destruction of the materials with which the infringing goods were produced, (vii) payment of damages



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

How to go after a trademark infringer

- **Step 3:** If there is no amicable solution, report the infringer to the police (sections 478-489 Penal Code for trademarks used for goods; **new sections 87, 90 Trademark Law for trademarks used for goods or services**)
 - The **aim** is to get (i) the infringer investigated, summoned for questioning and, possibly, arrested and (ii) the infringing goods seized. The rights holder would usually drop the case if the infringer cooperates and, e.g., signs an undertaking to cease the infringement, reveals the origin of the infringing goods, or publishes an apology.



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

How to go after a trademark infringer

- **Step 4:** If the police do not want to help, sue the infringer in court (avoid if you can as court proceedings are lengthy and unpredictable)
 - Section 53 Specific Relief Act (**new section 79 Trademark Law**): Temporary injunction to block the import of infringing goods and/or maintain evidence
 - Sections 54 Illustration (v), 55(g) Specific Relief Act (**new section 81(a)(1), (3), (4) Trademark Law**): Perpetual injunction (order) to stop the infringement, destroy or remove the goods (and the equipment)



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

How to go after a trademark infringer

→ Section 13(3) Myanmar Laws Act (“justice, equity and good conscience”); **new section 89(a)(2) Trademark Law: Damages**



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Prevent infringing goods from entering the country

- A rights holder may request the Customs Department to detain goods sporting an infringing trademark according to sections 18(d), 19A Sea Customs Act (**section 68 Trademark Law**)



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Going after non-trademark infringers (currently)

- **Criminal law?**
 - **S. 403 Penal Code: Criminal misappropriation - applies only to movable property which is “corporeal property” (s. 22)**
 - **S. 405 Penal Code: Criminal breach of trust - requires that the property was “entrusted” to the infringer**



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Going after non-trademark infringers (currently)

- **S. 415 Penal Code: Cheating** - requires that the rights holder was “deceived” (which he usually wasn’t; rather, the person deceived is the purchaser of the counterfeited goods)
- **S. 465 Penal Code: Forgery** - requires that the infringer made a “false document” (typically by forging a signature)
- **S. 7-9 Copyright Act: Various copyright infringements** - max. penalty Ks. 500 or, if there is a prior conviction, up to 1 month imprisonment



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Going after non-trademark infringers (currently)

- **Civil law?**
 - **S. 54 Specific Relief Act: Permanent injunction if there is an infringement of property - patents, trademarks and copyrights are “property” (s. 54 Explanation and s. 54 Illustrations (u), (v), (w)); other IP rights?**



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of fashion design

- **Current**

- No copyright protection of designs that are to be used as “models of patterns to be multiplied by any industrial process” (s. 22(1) Schedule I Myanmar Copyright Act); protection as “industrial design”?

- **Future**

- If an “original intellectual creation” → civil and criminal law **copyright protection** for up to 25 years after the creation as a “**work of applied art**”
- Registration available, but voluntary



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of fashion design

- Foreign works have to be published in Myanmar within 30 days after their first publication abroad to enjoy protection (s. 12(a)(2) Copyright Law)
- Alternatively, civil law (no criminal law) protection as a **registered industrial design** for in total up to 15 years



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of shapes and patterns of goods

- **Current**

- If new, non-functional and non-obvious, there may be civil law protection as property (s. 54 Specific Relief Act) in the shape of an **industrial design**
- No criminal law protection

- **Future**

- If “new, free from imitation, non-technological and non-operation related”: Civil law (no criminal law) protection as a registered **industrial design** for in total up to 15 years



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of books, films, music

- **Current**

- Civil law protection as property (s. 54 Illustration (v) Specific Relief Act) in the shape of a **copyright**
- Only available for works created by Myanmar citizens or residents or first published in Myanmar (s. 3 Myanmar Copyright Act, s. 1(1) Copyright Act 1911)
- No meaningful criminal law protection for books and music
- Bootlegged films may be seized by the police under section 32 (b) Television and Video Law 1996 (“distributing videos without censorship sticker”)



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of books, films, music

- Future
 - **Books and music:** civil and criminal law **copyright protection** for up to 50 years after the death of the author (s. 13(a), (d), 17(a)(1) Copyright Law)
 - **Performers** and **phonogram producers** have separate “related rights”
 - **Films:** civil and criminal law **copyright protection** for up to 50 years after publication (s. 13(e), 17(a)(3) Copyright Law)
 - Registration available, but voluntary
 - Protection of foreign works requires publication in Myanmar within 30 days of publication abroad



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of teaching and training materials

- **Current**

- Copyright protection if created by Myanmar citizens, residents or first published in Myanmar, but enforcement is weak
- If possible, ask course participants to sign non-disclosure / non-dissemination agreements; distribute materials only in paper form or as PDF with copy/print disabled

- **Future**

Better copyright protection with new law, but precautions as stated above still advisable if feasible



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of computer programs and databases

- Current
 - No meaningful civil or criminal law protection
 - Have non-disclosure / non-dissemination agreements with employees, freelance programmers and users
- Future
 - Civil and criminal law **copyright protection** for up to 50 years after the death of the author (s. 13(a), 15(c), 17(a)(1) Copyright Law)
 - Databases are only protected if there was a creative selection process



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Protection of computer programs and databases

- Registration available, but voluntary
- Protection of foreign works requires publication in Myanmar within 30 days of publication abroad



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

THANK YOU FOR YOUR ATTENTION!



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

Contact

Lincoln Legal Services (Myanmar) Ltd.

**La Pyi Wun Plaza, Room 409 (4th Floor),
37, Alan Pya Pagoda Road, Dagon Township,
Yangon, Myanmar**

**Phone: +95-9-262546284 (English)
 +95-9-790488268 (Myanmar)**
**E-mail: sebastian@lincolnmyanmar.com
 nyeinchanzaw@lincolnmyanmar.com**
Homepage: www.lincolnmyanmar.com



LINCOLN LEGAL SERVICES (MYANMAR) LIMITED