

## Intellectual Property Protection in Myanmar

### A. Introduction

Myanmar's framework for intellectual property protection may be described as patchy. Trademarks are fairly well covered by a combination of common law principles, criminal law and established practice. Other intellectual property is often less protected, or not protected at all.

This situation was to change when Myanmar passed four IP laws in 2019 to bring its outdated legal framework in sync with modern times. However, none of them has been implemented yet (they all "shall enter into force on the date determined by the president by notification", but there has been no such presidential notification so far), with the exception of certain aspects of the Trademark Law. These four laws are:

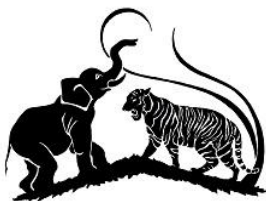
- [Trademark Law](#) (enacted on 30<sup>th</sup> January 2019)
- [Industrial Design Rights Law](#) (enacted on 30<sup>th</sup> January 2019)
- [Patent Law](#) (enacted on 11<sup>th</sup> March 2019)
- [Copyright Law](#) (enacted on 24<sup>th</sup> May 2019)

As a consequence of the enactment of these four laws, an [IP Department](#) was established under the Ministry of Commerce, but its only visible functions (currently) seem to be to (i) administer an online (re-) registration system for "existing" trademarks and (ii) organise training for trademark registration agents (whose role, however, would currently be limited to assisting with filing applications to (re-) register "existing" trademarks).

Intellectual property in Myanmar is therefore still protected (or, depending on one's standpoint and the type of the intellectual property, not protected) according to practice that developed in colonial times and has been updated only at the fringes. This practice is explained in Part C of this primer; it will be valid as long as there is no progress in implementing the four IP laws.

### B. Re-registration of "existing" trademarks

The original plan appears to have been to implement the Trademark Law first, to be followed by the other three laws. Implementation of the Trademark Law would have seen, among others, a shift from Myanmar's current paper-based registration system to a new online filing system. However, this shift is currently stuck at the very first step, the submission of applications for the (re-) registration of "existing" trademarks in the online system.



## LINCOLN LEGAL SERVICES (MYANMAR) LIMITED

An “existing” trademark is a trademark whose owner either (i) had a declaration of ownership registered with the Registration of Deeds Office or (ii) can prove the trademark’s actual use in Myanmar.

The original plan seems to have been to allow re-registration of “existing” trademarks for a 6 months period (“**soft opening period**”) starting from 1<sup>st</sup> October 2020 that was expected to end on 31<sup>st</sup> March 2021. However, events that occurred on 1<sup>st</sup> February 2021 resulted in the soft opening not having morphed yet into a “**grand opening**”.

The IP Department has not announced a grand opening date so far; we are therefore still in the soft opening period. Owners of “existing” trademarks that have not done so yet should file an application to (re-) register their trademarks in the online system.

Owners of “new” trademarks cannot file an online application for trademark registration directly during the soft opening period. Their best choice in our opinion is to (i) first register a paper-based declaration of ownership with the Registration of Deeds Office (which, after a hiatus, has become possible again) and (ii) then file an online application for re-registration.

The IP Department apparently intends to wait until after the grand opening before reviewing the applications for (re-) registration received during the soft opening period.

Government fees for re-registration are not known yet; they are expected to be announced shortly before the “grand opening”.

In order to submit an online application for (re-) registering an “existing” trademark, we will need the following:

<b>Owner registered a declaration of ownership</b>	<b>Owner has proof of use of the trademark in Myanmar</b>
<ul style="list-style-type: none"><li>▪ PDF copy of the registered declaration of ownership</li><li>▪ If different from the data shown in the declaration of ownership: Details of the trademark owner (company name; company registration number; jurisdiction of incorporation; address)</li><li>▪ If available: Evidence of use in Myanmar</li><li>▪ Trademark as a JPG file</li><li>▪ If the applicant is not the same as the trademark owner registered at the Registration of Deeds</li></ul>	<ul style="list-style-type: none"><li>▪ Evidence of use, showing a date (the IP Department seems to accept, among others, cautionary notices and newspaper advertisements)</li><li>▪ Details of the trademark owner (company name; company registration number; jurisdiction of incorporation; address)</li><li>▪ Trademark as JPG file</li><li>▪ Goods and/or services for which the trademark is used, according to the Nice</li></ul>



Owner registered a declaration of ownership	Owner has proof of use of the trademark in Myanmar
Office, proof of transfer of ownership or name change	Classification

## C. Myanmar's current IP protection practice, in use until implementation of the four IP laws

### 1. Trademarks

#### 1.1. Introduction

##### (a) Protection ultimately rooted in English common law

Early case law post independence held that the rights of parties setting up rival claims to the ownership of a trademark are, in the absence of a trademark registration system and any provisions for a statutory title to a trademark, determined in accordance with the principles developed in (English) common law.<sup>1</sup>

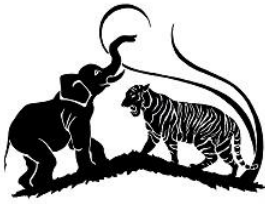
According to these principles, a trademark is established through actual use in commerce. Its owner may prevent others from using it (or a variation thereof) if such use might mislead customers into thinking that the goods sold under it originate from the trademark owner (whereas, in reality, they originate from the imitator).

One would expect these principles to now be part of Myanmar's own legal system, independent from their English origin, as trademark infringement cases seem to have quite frequently wound up in the courts and been decided on these principles. They might be characterised as a guide to "justice, equity and good conscience"; ideals which judges have to base their decision on if there is no statute (section 13(3) [Myanmar Laws Act](#)).

##### (b) Protection of service marks

Traditionally, trademarks are associated with goods, and indeed, the (only) statutory definition provides that a trademark is a "mark used for denoting that goods are the manufacture or merchandise of a particular person" (sec. 478 [Penal Code](#)).

<sup>1</sup> The Tajmahal Stationary Mart v. K.E. Mohamed Ebrahim V.S. Aliar & Co., H. C. 1949, [BLR High Court 1950](#), p. 43.



We would venture to say, however, that it should be possible to obtain injunctive relief and claim damages also if the infringed trademark (“service mark”) is not used for goods, but for services.

**(c) Protection of trademarks not used in the country**

In principle, trademark protection requires the trademark’s actual use in Myanmar (as potential customers would usually not be tricked into thinking that the goods sold under it are from someone else if this “someone” is from abroad and does not operate in Myanmar). There is, of course, an exception if the foreign trademark is so well known that customers in Myanmar may indeed be misled by local imitators, even if the real products are not on sale in the country.

Of note, it is perfectly possible to register a declaration of ownership of a trademark that is not (yet) used in Myanmar.

## 1.2. Declarations of ownership

**(a) Registration of a declaration of ownership**

Although there is no legal requirement to do so in order to establish trademark protection (this is done by the trademark’s actual use in commerce), it is possible, common and recommendable to register a declaration of ownership with the Registration of Deeds Office (“Office”) in Yangon. This registration is done according to section 17(l) [Registration of Deeds Law 2018](#) which allows to voluntarily apply for registration of any instrument whose registration is not compulsory.

The declaration contains a representation of the trademark, list of the goods and/or services for which it is used (according to the Nice classification), and a statement of the owner to the effect that he created the trademark for exclusive use and is willing to defend it against unauthorised use.

The Office is a sub-department of the Ministry of Agriculture, Livestock and Irrigation and registers all kinds of documents, such as long-term lease agreements and sale and purchase agreements for immovable property.

It is not a specialised intellectual property office. With regard to trademarks, it only registers the declaration of ownership (without reviewing its merits) and not the trademark itself (Rule 160 [Registration of Deeds Rules 2019](#)). Consequently, it does not perform any of the reviews that intellectual property offices usually do (in particular, whether a trademark is distinctive and not misleading).



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

### **(b) Effects of registration**

The registration of a declaration of ownership does not *per se* protect the trademark. Myanmar is (still) a first-to-use country (it will only become a first-to-file country once the Trademark Law, enacted in 2019 but not in force yet, is fully implemented), so the (perceived) owner of a trademark with prior registration might still lose a case against a (perceived) infringer if the (perceived) infringer can indeed prove prior use.

Nevertheless, it is common and advisable to register a declaration of ownership as this registration is circumstantial evidence as to the trademark’s ownership.<sup>2</sup> Furthermore, it implies that the trademark was used by the applicant on the day of the application for registration as, for a few years now, the Office has been requesting applicants to submit some evidence of actual use (such as a photo of the product sporting the trademark).

### **(c) Opposition**

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

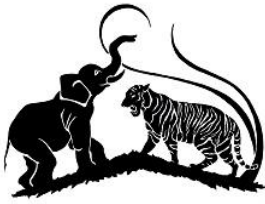
If, in such a case, the owner believing to have the stronger rights intends to have the overlapping registration deleted, he needs the consent of the perceived infringer as the Office does not have a cancellation system and only deletes a registration if the original applicant so requests. If the perceived infringer refuses to grant his consent, the owner has to sue him. If the lawsuit is successful, the court order replaces the application for deletion that the infringer did not want to file.

### **(d) Renewal**

The registration is valid indefinitely. Some intellectual property law firms advise to renew it every three years, but this is not compulsory.

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<sup>2</sup> C.M. Brothers v. A. Kunjalan and two others, H.C. 1950, [BLR High Court 1950](#), p. 269.



### (e) Procedure

Filings with the Registration of Deeds Office are entirely paper-based.

It takes the Office approx. three weeks to register a declaration of ownership. The registration certificate is, in fact, the declaration, to which the Office affixed its seal and a hand-written registration number.

The registration of a declaration of ownership requires the payment of stamp duty and a registration fee, but these are nominal amounts.

Documents in a foreign language have to be translated to Burmese; a notary has to certify that the translation is correct.

Of note, at least in the past, the Office accepted applications only from foreign companies and not from foreign individuals.

In order to prepare and register your declaration of ownership, we will need:

- (1) Copy of the trademark owner's
  - national registration certificate (if an individual);
  - certificate of incorporation and company extract (if a company incorporated in Myanmar); or
  - official registration certificate(s), showing at least the company's name, registration number, address and directors (if a company incorporated abroad);
- (2) JPG or other image file of the trademark;
- (3) List of goods and/or services for which the trademark is used, according to the Nice classification;
- (4) Proof of actual use (e.g., photo showing goods sporting the trademark) in or outside of Myanmar;
- (5) if the applicant is a company, resolution of its board of directors (draft provided by us); and
- (6) power of attorney (draft provided by us) - must be notarised and legalised if the trademark owner is a company incorporated outside of Myanmar.



## 1.3. Cautionary notices

Trademark owners often publish a cautionary notice in a newspaper after having registered a declaration of ownership.

As such, cautionary notices do not establish trademark protection, as a trademark owner is not required to specifically put people on alert that a trademark exists: A trademark, being in the nature of property, cannot be appropriated by anyone without the permission of its owner. If a person appropriates it, he will be committing an actionable wrong whether he does it honestly (i.e. without knowing that the trademark is “taken”) or fraudulently.<sup>3</sup>

Nevertheless, it is of course desirable for a trademark owner to make as many people as possible aware of the trademark as this might help prevent all sorts of honest mistakes. Furthermore, a cautionary notice might be circumstantial evidence of the trademark’s ownership and actual use, especially if published in an expensive newspaper with high circulation.

However, whether to publish a cautionary notice has to be given some thought currently as the only papers with a high, nationwide circulation are state-owned as many private papers either voluntarily went out of business or had their publishing licenses revoked. There are people in Myanmar who would currently be reluctant to place advertisements in a state-owned publication in order to avoid paying money to the state apparatus, or who might boycott products of companies that do.

## 1.4. Trademark searches

The Office does not have a searchable database.

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

## 1.5. Stopping infringements

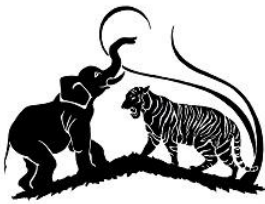
### (a) If an infringement is found: First steps

The process starts with

- spotting the infringement;

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<sup>3</sup> Johnny Walker and Sons Ltd. v. U Than Shwe, C.C. 1968, [BLR 1968](#), p. 79.



- securing evidence (e.g. photos; purchase of goods with a receipt together with a witness); and
- finding out the identity and contact details of the infringer (e.g. shop owner, factory owner, importer).

In a second step, the trademark owner would contact the infringer, possibly with the help of a law firm (which might send a cease and desist letter). Ideally, the infringer is sufficiently impressed to indicate his willingness to cease the infringement and negotiate. From the trademark owner's standpoint, the aims at this stage may vary and may include the infringer doing the following:

- Signing an undertaking to cease the infringement;
- publishing an apology;
- revealing the number of goods sold, the sales price and the number of goods still in stock;
- revealing the origin of the infringing goods;
- destroying the stock of the infringing goods;
- destroying the materials with which the infringing goods were produced; and/or
- paying damages.

### **(b) Involvement of the police**

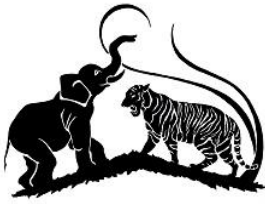
If there is no amicable solution, the trademark owner might consider reporting the infringer to the police (as sections 478-489 [Penal Code](#) sanction trademark-related crimes), but one would have to think about the current situation when determining whether to involve the police.

The aim would be to have (i) the infringer investigated, summoned for questioning and, possibly, arrested and (ii) the infringing goods seized.

The trademark owner would usually agree to 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.

Opening a case with the police requires the presence in Myanmar of a representative from within the trademark owner's organisation as this person will have to sign a statement at the police station that he is personally acquainted with the facts and has reported them truthfully.





## (c) Involvement of the civil courts

A trademark owner may furthermore try to obtain relief from the civil courts, in particular

- a temporary injunction to cease the infringement until the trademark owner's rights are fully proven and/or to maintain evidence;
- a perpetual injunction to permanently cease the infringement;
- an order to destroy the infringing goods and the means to produce them; and/or
- an award of damages.

## (d) Involvement of the customs authorities

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

## 1.6. Using trademark protection to protect other IP rights

As trademarks are the only IP rights that are well protected in Myanmar, owners of similar intellectual property try, or might consider trying, to “reclassify” them as trademarks to participate in this protection. This is in particular so for:

- Industrial designs;
- geographical indications;
- collective marks; and
- quality and similar seals (“certification marks”).

## 2. Intellectual property other than trademarks

### 2.1. Technology

The [Science and Technology Law 2018](#), which replaces an earlier law from the 1990s, defines “technology” as “process competency which is beneficial to production, and a combination of process, skill and know-how”.



Technology may only be transferred by contract registered with the [Department of Research and Innovation](#); an unregistered contract is presumably void (section 28).

Impliedly, we would say that this means that technology must not be stolen, and its rightful owner should therefore be able to sue an infringer for an injunction to cease the infringement (section 54 [Specific Relief Act](#)), damages, and related remedies.

The Science and Technology Law 2018 does not provide for criminal penalties for violations.

## 2.2. Business secrets

Sections 19 [Myanmar Competition Law 2015](#) prohibits business persons from stealing business secrets from, and using business secrets stolen from, a competitor.

The victim should therefore be able to sue an infringer for an injunction to cease the infringement, damages, and related remedies.

Section 41 furthermore provides for criminal penalties, but one would have to think about the current situation when determining whether to involve the police.

## 2.3. Copyright

As long as the Copyright Law from 2019 is not implemented, creators of literary and artistic works only enjoy limited protection.

The [Myanmar Copyright Act 1911](#) protects “every original literary, dramatic, and artistic work” during the life of the author and for 10 years after his death, provided that it was either first published in Myanmar, or, in case of an unpublished work, its author was at the time of its creation a citizen or resident of Myanmar.

Foreign works may therefore be freely copied.

The holder of a protected copyright may sue an infringer for an injunction to cease the infringement, damages, and related remedies.

Copyright infringements are also criminally sanctioned.

The maximum penalty is only a fine up to MMK 500 (approx. USD 0.25) for first-time offenders, but it may still make sense to file a criminal complaint as this enables the police, among others, to conduct searches and seize evidence. However, one would have to think about the current situation when determining whether to involve the police.



Apart from the Myanmar Copyright Act, the following provisions may (also) afford legal protection.

- Bootlegged videos (irrespective of whether the original is of Myanmar or foreign origin) may be seized by the police under section 32 [Television and Video Law 1996](#) (“distributing videos without censorship sticker”).
- Some software may be classified as “technology” and protected under the [Science and Development Law 2018](#).

### 2.4. Industrial designs and patents

#### (a) Currently, no protection

As long as the Industrial Design Rights Law and the Patent Law from 2019 are not implemented, designs and inventions are not protected in Myanmar and may in principle be imitated without any legal repercussions, unless the invention can somehow be classified as “technology” protected under the [Science and Technology Law 2018](#).

#### (b) Protection mechanisms from colonial times defunct

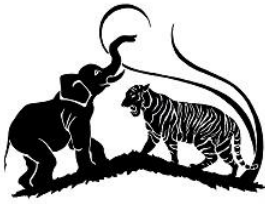
It was possible in colonial times to obtain protection for a novel “design” (the shape or configuration of or the pattern or ornament on an article) or an invention by filing an application for the registration of a design or an application for a patent with the Patent Office in Calcutta according to the [Indian Patents and Designs Act, 1911](#).

After Burma Province was separated from British India in 1937, a succession of laws, the latest being the Myanmar [Patents and Designs \(Emergency Provisions\) Act, 1946](#), meant to ensure continued application of the Indian Patents and Designs Act until Myanmar had its own patent office. And indeed, as late as 1964, a court considered a design “registered in Calcutta” to be in principle protected in Myanmar (in a suit that had started in 1955).<sup>4</sup>

However, Myanmar never established its own patent office. The [Myanmar Patents and Designs Act, 1945](#), which would have done this, was never brought into force and finally [repealed in 1993](#).

In the meantime, in India, the [Patents Act, 1970](#), and the [Designs Act, 2000](#), repealed the Indian Patents and Designs Act, 1911, so any patents or designs registered under the 1911 act, which might at least theoretically have enjoyed protection in Myanmar, would by now have expired.

<sup>4</sup> Maung Sein Brothers v. The Burma Plastic Moulders, C.C. 1964, [BLR 1964](#), p. 33.



**(c) Registration of Deeds Office does not register declarations of ownership**

The Registration of Deeds Office, which we understand used to register declarations of ownership of patents, designs and copyrights (in the same manner as it still registers declarations of ownership of trademarks: only documenting the claim to a right, not creating it), appears to have stopped doing so in 2019 (Rule 161 [Registration of Deeds Rules](#)).

**(d) Limited workarounds**

Unlike with trademarks, there are no common law principles that would protect an unregistered design or invention. Unless someone convinces the courts that it is against “justice, equity and good conscience” (section 13(3) [Myanmar Laws Act](#)) to allow imitators to rip off someone else’s designs or inventions, protection can currently therefore only be achieved by:

- designs: pretending that the design is a trademark; and
- inventions: keeping them secret.

## 2.5. Trade names

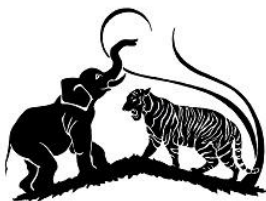
A trade name (the name of one’s company or business, such as “Mr. Miller’s Amazing Store”) may be protected as a trademark if it is linked to certain goods or services.

If, e.g., Mr. Miller produces juice from homegrown apples and writes “From Mr. Miller’s Amazing Store” on the labels that he slaps on the bottles, a competitor in the apple juice business might be prevented from calling his shop “Mr. Miller’s Amazing Store” as well.

Absent such link to specific goods or services, however, trade names are not protected, as “it is settled law that a person does not acquire a monopoly in the use of any trade name irrespective of any kind or class of goods.”<sup>5</sup>

*Information in this brochure is up-to-date as of 27<sup>th</sup> May 2022.*

<sup>5</sup> Johnny Walker and Sons Ltd. v. U Than Shwe, C.C. 1968, [BLR 1968](#), p. 84.



## ANNEX: COMPARISON OF THE CURRENT TRADEMARK PROTECTION SYSTEM WITH THE NEW SYSTEM ENVISAGED BY THE TRADEMARK LAW (IMPLEMENTATION INTERRUPTED)

Sr.	Topic	Current paper-based system	New envisaged online system
1	Registration	Voluntary	Compulsory
2	Protection period	Not limited	10 years, renewable
3	Protection starts	With actual use	On “submission date”
4	Checks prior to registration	(Often) only formal checks	Material checks, in particular: <ul style="list-style-type: none"> <li>▪ Mark distinctive?</li> <li>▪ No effect on public order?</li> <li>▪ Not misleading?</li> <li>▪ Not using national emblems or protected symbols?</li> </ul>
5	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)
6	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)
7	Required time for registration	Approx. 3 weeks	At least 60 days
8	Cautionary notice	Recommended (at least previously)	Not needed
9	Use of the trademark in Myanmar required?	Yes	No use required during the first 3 years, thereafter an interested person may apply for deletion
10	Transfer and	Valid without registration	Valid only with registration



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Sr.	Topic	Current paper-based system	New envisaged online system
	licensing		
11	Searchable database?	No	Yes, presumably
12	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

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