Intellectual Property Protection in Myanmar

A. Introduction

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

Myanmar passed four IP laws in 2019 to bring its outdated legal framework in sync with modern times:

- Trademark Law (enacted on 30th January 2019)
- Industrial Design Rights Law (enacted on 30th January 2019)
- Patent Law (enacted on 11th March 2019)
- Copyright Law (enacted on 24th May 2019)

Of these four laws, the State Administration Council ("SAC") ordered the Trademark Law to enter into force on 1 April 2023. The other three laws are still awaiting implementation.

B. Protection of marks

1. (Re-) registration of "existing" marks and registration of new marks

- Mark owners who (i) registered a paper-based declaration of ownership with the Registration of Deeds Office or (ii) can otherwise prove use of their mark in the country prior to 1 April 2023 and (iii) applied for (re-) registration under the newly created online filing system before 1 April 2023 have to appoint a representative with form TM-2 and pay the application fee (MMK 150,000 per class) until 31 May 2023 at the latest.
- Owners of old marks who have not yet applied for (re-) registration under the newly created online filing system may still be able to do so within 6 months from the grand opening date (rule 12 Mark Registration Rules), i.e., until 26 October 2023.
- Owners of new marks will be able to apply for their registration from the grand opening date on 26 April 2023.



2. From "first to use" to "first to file"

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

According to these principles, a mark 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 mark 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 mark infringement cases 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).

The **2019 Trademark Law**, which the SAC ordered to enter into force on 1 April 2023, changes this. For the first time, it introduces a proper mark registration system and makes the protection of mark rights at least in principle dependent on the mark's registration (section 15). It is therefore important for mark owners to apply for registration of their mark as early as possible, irrespective of whether they already successfully use their mark in commerce or still want to establish recognition of it.

As the registration system is still being rolled out, mark owners whose marks are being infringed may for a while still argue that they are the first users and therefore have the better rights to a mark, but this is expected to soon shift to a situation where business owners who failed to register their marks are likely to lose them to more aggressive competitors who applied for registration.

3. Application for mark registration

3.1. Types of marks

Marks come in different types, and they have to be indicated in the application:

The Tajmahal Stationary Mart v. K.E. Mohamed Ebrahim V.S. Aliar & Co., H. C. 1949, <u>BLR High Court 1950</u>, p. 43.



Word only: Figurative: Word and figurative: **LINCOLN LINCOLN** Three dimensional mark: Example 1: Example 2: (From ipd.gov.mm) Combination of colour mark: Colours are claimed as a distinctive feature of the mark: (From ipd.gov.mm) (From ipd.gov.mm)



Collective mark:



Certification mark:







practices)



(From madeinbritain.org)

(From citma.org.uk)

Geographical indication:

Not yet available; work-around: Registration of a collective mark or certification mark

3.2. Translating and transliterating non-Burmese/English elements of a mark

Elements of a mark in a language other than Burmese or English have to be translated and transliterated into either of the two languages.

Example (from the IPD's website):

Mark:	星
Translation:	Star
Transliteration (pronunciation):	Hoshi

3.3. Disclaiming exclusive use for non-distinctive elements of a mark

Marks are only marks if they distinguish goods and/or services from those of competitors. Mere descriptions of goods and/or services may therefore not be registered as marks. Applicants for mark registration must therefore make it clear that they claim exclusive use only for those elements of the mark that are distinctive.

The Intellectual Property Department provides the following examples:

(a) "Yangon English School": The combination of these three words in this order may be registered as a mark for educational services, but the applicant must disclaim exclusive use for "Yangon", "English" and "School" as the word "Yangon" belongs to the public and "English" and "School" only denote the kind of services offered.





The combination of the two words with the image may be registered as a mark, but the applicant must disclaim exclusive use for "Hotel", "Yangon" and the image of Kawkareik Palace, as the latter two belong to the public and the former only denotes the kind of services offered.

3.4. Priority rights

The Trademark Law provides for three types of priority rights:

- Priority right for marks whose owner either registered a declaration of ownership with the Registration of Deeds Office or can otherwise prove their use in Myanmar prior to 1 April 2023. In order to claim this priority right, the owner has to observe the following deadlines:
 - If the owner uploaded prior to 1 April 2023 a copy of the registered declaration of ownership and/or proof of actual use in the country before 1 April 2023, he will have to (i) submit form TM-2 (appointment of a representative) and (ii) pay the application fee (MMK 150,000 per class) until 31 May 2023.
 - If the owner has not uploaded a copy of the registered declaration of ownership and/or proof of actual use in the country before 1 April 2023, he may probably still do so, provided that he submits required documents and form TM-2 and pays the application fee until 26 October 2023.
- (b) Priority right of those who applied for mark registration in a Paris Convention or WTO member state and apply for mark registration in Myanmar within 6 months from that date.
- (c) Priority right of those who displayed goods and/or services bearing their mark at an international exhibition organized or recognised by a government of a member state of the Paris Convention or a WTO member state, provided that they apply for mark registration in Myanmar within 6 months from that date.

3.5. Goods and/or services for which the mark is used

Applicants have to specify in a specific format called the "Nice Classification" for which goods and/or services they use or intend to use the mark. The system comprises 34 classes for goods and 11 classes for services. Mark owners unfamiliar with the system usually rely on IP consultants to create a suitable list. National IP offices have created a database to assist with the research of commonly accepted terms.

In order to assist you with creating a list, we will need to know for which goods and/or services you wish to use your mark. Such a list might look like this:



This mark is used in respect of:

International Class 35: Business consultancy services; accounting services; tax services

International Class 39: Transport of goods **International Class 45:** Legal services



Official fees for mark registration are assessed per class - the more classes, the higher the fee.

It should be noted that once an application is filed, the applicant may limit the list of goods and/or services, but not expand it anymore.

3.6. Official fees

The official fees for government services in connection with mark registration are currently as follows:

Sr.	Type of service applied for	Unit	Fee (MMK)
(a)	Accepting and examining an application for trademark registration (TM-1)	Per class	150,000
(b)	Accepting and examining a request to allow a re-application for mark registration following a failure to comply with prescribed rules (TM-3)	Per request	100,000
(c)	Examining a request to correct clerical and other errors in a mark application, and making the correction (TM-4)	Per request	50,000
(d)	Examining a request to limit the list of goods and/or services in an application for mark registration, and limiting the list (TM-6)	Per request	50,000
(e)	Examining a request to divide an application for mark application, and dividing the application (TM-7)	Per request	100,000
(f)	Examining an application for opposition to a mark registration (TM-8)	Per mark	150,000
(g)	Registering a mark	Per class	150,000
(h)	Examining and approving a request to issue a certified copy of a mark registration certificate (TM-9)	Per request	50,000
(i)	Examining a request to amend information recorded in the mark register that may be amended, and making the amendment (TM-10)	Per request	50,000
(j)	Examining an application to extend the term of the registration of a mark, and recording the extension (TM-11)	Per class	300,000
(k)	Examining an application to record the transfer of mark rights, and	Per	100,000



Sr.	Type of service applied for	Unit	Fee (MMK)
	recording the transfer (TM-12)	transfer	
(1)	Examining an application to record a license to use a registered mark, and recording the license (TM-13)	Per license	100,000
(m)	Examining a request to declare a registered mark invalid (TM-15)	Per mark	150,000
(n)	Examining a request to cancel a registered mark (TM-16)	Per mark	100,000
(o)	Examining a request to change the name of the representative, and changing the name (TM-17)	Per request	20,000
(p)	Examining and approving a request to extend a specified time period (TM-18)	Per request	50,000
(q)	Examining an application for an appeal (TM-19)	Per class	500,000

3.7. Representative

Mark owners may either <u>make an appointment</u> and file applications in person in Yangon or Nay Pyi Taw, or have a representative file applications online. A trademark representative must be a Myanmar national, have an online account with the Department of Intellectual Property ("WIPO file user account") and passed a representative training course. Please do not hesitate to contact us if we (more precisely, one of our lawyers) should act as your trademark representative for online filing.

If the applicant does not reside in Myanmar, a copy of the power of attorney (form TM-2) has to be certified by a notary in his country of residence (rule 92 Mark Registration Rules); legalisation by the Myanmar embassy is apparently not required. It is possible to <u>combine several marks in one power of attorney</u>. We usually do not need powers of attorney as originals; however, the Registration Officer may on a case-by-case basis request the submission of an original within 30 days from such request.

3.8. Filing date, examination, publication, opposition and registration

(a) Filing date

If the application is complete and the application fee has been paid, the Registration Officer records its receipt date as the application's filing date; this is the date from which the protection of mark rights under the Trademark Law sets in.

(b) Examination

The Inspection Officer and/or the Registration Officer must then check whether:

- Information is missing;
- there are absolute grounds for rejection (mark not distinctive; only describes the goods or services; affects public policy; has become a common expression; is misleading; imitates state or other protected symbols; uses symbols protected by an international treaty);
- the applicant should disclaim elements of the mark that are not distinctive;
- the applicant provided sufficient evidence to show that a non-distinctive mark nevertheless acquired recognition in relevant circles due to prior use;
- the applicant provided sufficient evidence to show that he used a non-distinctive mark in good faith in Myanmar for 3 consecutive years; and
- the shape or colours of a three dimensional or combination of colour mark fulfil functional or technological functions and may therefore not be registered as a mark.

The applicant is given 30 days to rectify defects that the Inspection Officer and/or the Registration Officer may have found. Failure to respond within 30 days will result in the application being considered abandoned. If the applicant is unable to rectify the defects, the application is rejected.

(c) Publication

Marks that survived examination are published either on the website of the Intellectual Property Department or in the Department's publication book (rule 99 Mark Registration Rules).

(d) Opposition

Interested parties now have 60 days to file an opposition with form TM-8. Valid reasons for an opposition are:

- The mark does not meet the definition of a "mark" in section 2(j) Trademark Law (this will hardly ever happen);
- there is an absolute ground for rejection which was overlooked in the previous examination; and
- there is a relative ground for rejection (identity or similarity with an earlier mark; mark causes reputational damage; mark may violate the IP rights of someone else; mark registration was applied for in bad faith; mark exploits a famous mark).

The most common reason for an opposition is identity or similarity with an earlier mark. The opposer has to show that the two marks are identical or similar and are used for the same or similar goods and/or services, and that he registered his mark earlier, or applied for registration earlier, or has a priority right, or has the right to use the earlier mark due to a transfer or a license (rule 45(a) Mark Registration Rules).

To what extent an opposer (with a non-famous mark) may base his opposition on the mark's earlier use rather than earlier registration (rule 45(a)(3) Mark Registration Rules) will have to be seen.

The applicant is given the opportunity to file a defence against the opposition.

(e) Registration

If there is no opposition to the application for mark registration, or if the opposer withdraws the opposition, or if the opposition is rejected, the Registration Officer shall notify the applicant to pay the registration fee within 60 days from the notice. If the payment is not made within the specified time limit, the application shall be deemed abandoned. Otherwise, the Registration Officer shall record the registration and issue a mark registration certificate to the applicant.

4. Renewal of the mark registration

A mark registration has to be renewed every 10 years, starting from the filing date. Applications for renewal have to be filed with form TM-11 within 6 months prior to the expiry date or, as an exception and for a higher fee, within 6 months after the expiry date.



5. Compulsory registration of mark transfers and licenses

The new Trademark Law provides for a registration system for mark transfers and licenses (as well as for the termination of licenses). Unregistered transfers and licenses are void (sections 44, 49 Trademark Law).

6. Declaration of invalidity and cancellation of a mark registration

- (a) Any interested party may apply to the Registration Officer to declare a mark registration invalid with form TM-15 and evidence that a registered mark is inconsistent with the definition in section 2(j) Trademark Law or should not have been registered because there is an absolute ground for rejection under section 13 Trademark Law or a relative ground for rejection under section 14 Trademark Law (rule 82(a) Trademark Registration Rules).
- (b) Furthermore, any interested party may apply to the Registration Officer with form TM-16 to cancel a mark registration if the mark was not used at all during a period of 3 years from the date of application for mark registration, or its use was paused for a period of 3 consecutive years, or 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 it has become a common expression or customary in contemporary vocabulary or a commercial practice (rule 82(b) Trademark Registration Rules).

7. Trading names

It was always possible to protect a trading name (the name of one's company or business, such as "Mr. Miller's Amazing Store") as a tmark if it was linked to certain goods and/or services.

If, e.g., Mr. Miller produced juice from homegrown apples and wrote "From Mr. Miller's Amazing Store" on the labels that he slapped on the bottles, a competitor in the apple juice business might have been prevented from calling his shop "Mr. Miller's Amazing Store" as well.

Absent such link to specific goods and/or services, however, trading names have until now not been protected, as case law held that "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."²

Johnny Walker and Sons Ltd. v. U Than Shwe, C.C. 1968, BLR 1968, p. 84.

The new Trademark Law, while not providing for a registration system for trading names, seems to change that, stating that "trading names shall be protected irrespective of them being part of a mark or registered. ... 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." We will have to see how this new protection will pan out.

8. Enforcing mark rights

8.1. Stopping infringements out of court

If an infringement is found: First steps

The process starts with

- spotting the infringement;
- 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 mark 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 mark 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.



8.2. Stopping infringements with the help of the police

If there is no amicable solution, the mark owner might consider reporting the infringer to the police (as sections 87-92 Trademark Law and sections 478-489 <u>Penal Code</u> sanction mark-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 mark 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 mark 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.

8.3. Stopping infringements with the help of civil courts

On 24 March 2023, the Myanmar Supreme Court determined the following courts to be competent to adjudicate suits under the Trademark Law, and issued the <u>corresponding procedures</u>.

Sr. no.	Matter	Competent court	Source
1	The following powers of the Intellectual Property Rights Court: (a) Deciding on claims relating to the infringement of intellectual property rights under the Trademark Law;	Kyauktada District Court	Supreme Court Notification 238/2023 dated 24 March 2023
	(b) deciding on applications for a provisional order under section 77(a) Trademark Law.		
2	The following powers of the Intellectual Property Rights Court: (a) Deciding on applications according to section 66 Trademark Law to review a decision of the Intellectual Property Rights Agency;	High Court of Yangon Region	Supreme Court Notification 235/2023 dated 24 March 2023



Sr. no.	Matter	Competent court	Source
	(b) deciding on applications according		
	to section 72 Trademark Law to		
	review a suspension order issued by		
	the customs department's director general.		
3	Original jurisdiction in criminal matters	(a) Court of the Self-	Supreme Court
	of the Intellectual Property Rights Court	Administered	Notification 236/2023
	to try and adjudicate offences under the	Division;	dated 24 March 2023
	Trademark Law	(b) courts of self-	
		administered	
		zones;	
		(c) district courts	
4	Deciding on appeals and objections	High Court of Yangon	Supreme Court
	against judgments, orders and decisions	Region	Notification 239/2023
	of the Intellectual Property Rights Court		dated 24 March 2023
5	Deciding on appeals and objections	High courts of the	Supreme Court
	against judgments, orders and decisions	regions and states	Notification 237/2023
	in criminal matters under the		dated 24 March 2023
	Trademark Law passed by the Court of		
	the Self-Administered Division, or the		
	courts of self-administered zones or the		
	district courts within their jurisdictions		

Of particular note, infringement claims under the Trademark Law centrally heard by the Kyauktada District Court in Yangon. There may be an overlap for a while as the Supreme Court notifications only cover claims under the Trademark Law, and infringement claims may also be brought (and have been frequently brought for decades) under common law principles; in the latter case the competent court is the one in whose jurisdiction the defendant resides or carries on business or the infringement was committed.

8.4. Stopping infringements with the help of customs authorities

Section 18(d) <u>Sea Customs Act</u> contains an explicit prohibition to import goods sporting counterfeit marks. Such goods can be impounded by the customs authorities. The owner of a mark may, if he has

knowledge of a shipment, inform the customs authorities accordingly. It appears furthermore to be possible to register a mark with the customs authorities and train them to spot counterfeited goods.

In parallel, the new Trademark Law (sections 68-76) now provides for specific procedures for a mark owner to apply to the Director General of the Customs Department to =suspend the transport of infringing goods into the country.

C. Protection of intellectual property other than marks

1. Technology

The <u>Science and Technology Law 2018</u>, 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 <u>Department of Research and Innovation</u>; 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. 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.

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 <u>Television and Video Law 1996</u> ("distributing videos without censorship sticker").
- Some software may be classified as "technology" and protected under the <u>Science and</u> <u>Development Law 2018</u>.

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).³

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 <u>Patents Act, 1970</u>, and the <u>Designs Act, 2000</u>, 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.

(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 used to registers declarations of ownership of marks: 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 marks, 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) <u>Myanmar Laws Act</u>) 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 mark; and
- inventions: keeping them secret.

Information in this brochure is up-to-date as of 18 April 2023.

Maung Sein Brothers v. The Burma Plastic Moulders, C.C. 1964, BLR 1964, p. 33.



ANNEX: COMPARISON OF THE OLD PAPER-BASED MARK PROTECTION SYSTEM WITH THE NEW SYSTEM UNDER THE TRADEMARK LAW

Sr.	Topic	Old paper-based system	New online system
1	Registration	Voluntary	Compulsory
2	Protection period	Not limited	10 years, renewable
3	Protection starts	With actual use	On filing date
4	Checks prior to registration	(Often) only formal checks	 Material checks, in particular: Mark distinctive? No effect on public order? Not misleading? Not using national emblems or protected symbols?
5	Opposition procedure prior to registration	No	Registration officer must publish the mark 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 mark 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



Sr.	Topic	Old paper-based system	New online system
	licensing		
11	Searchable database?	No	Yes, presumably
12	Priority right mark 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) mark was displayed at an international exhibition

About Lincoln Legal Services (Myanmar) Limited

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