



CONVENIENCE TRANSLATION - ACCURACY NOT GUARANTEED

Republic of the Union of Myanmar
Supreme Court of the Union
Procedures for Adjudicating Suits Under the Trademark Law
Notification No. 240/2023
4th Waxing Day of Tagu, 1384
(24 March 2023)

The Supreme Court of the Union hereby issues the following procedures in exercise of the powers conferred by section 106(a) Trademark Law.

Chapter 1
Name and definitions

1. These procedures shall be called the Procedures for Adjudicating Suits Under the Trademark Law.
2. These procedures shall be followed when adjudicating suits under the Trademark Law.
3. The following expressions in these procedures shall have the meanings given hereunder:
 - (a) **“Law”** means the Trademark Law.
 - (b) **“Mark rights”** includes rights related to a mark, trading name, famous mark and geographical indication;
 - (c) **“Lawsuit regarding mark matters”** means not only civil proceedings by which relief against a mark rights infringement is sought according to section 77(b) of the Law, but also miscellaneous civil proceedings by which a provisional order under section 79 of the Law and a unilateral provisional order under section 80 of the Law is applied for.
 - (d) **“Intellectual property rights court having jurisdiction over appeals and revisions under the Trademark Law”** means courts to which the Supreme Court of the Union has given jurisdiction over appeals and revisions for this matter.
 - (e) **“Application to the intellectual property rights court against the Agency’s decision”** means an application according to section 66 of the Law to the intellectual property rights court which has jurisdiction to amend or cancel the Agency’s decision.
 - (f) **“Application to the intellectual property rights court against a suspension order of the Director General of the Customs Department”** means an application according to



section 72 of the Law to the intellectual property rights court which has jurisdiction to review a suspension order imposed by the Director General of the Customs Department.

Chapter 2 Jurisdiction

Jurisdiction for offences

4. Intellectual property rights courts and judges which were authorised by the Supreme Court of the Union by notification have jurisdiction for charged offences.

Jurisdiction for lawsuits

5. Intellectual property rights courts and judges which were authorised by the Supreme Court of the Union by notification have jurisdiction for lawsuits regarding mark matters, applications for provisional orders, applications to the intellectual property rights court against the Agency's decision, and applications to the intellectual property rights court against a suspension order of the Director General of the Customs Department.

Chapter 3 Criminal proceedings under the Trademark Law

6. The intellectual property rights court shall comply with the provisions of the Code of Criminal Procedure when examining and adjudicating offences charged under the Trademark Law.
7. The intellectual property rights court shall open and maintain a separate criminal case registration book for offences charged under the intellectual property laws, including the Trademark Law. This registration book shall be named "Criminal Case Registration Book Related to the Intellectual Property Laws". The case numbering shall follow the format "Criminal Case No. - .../2023 (Intellectual Property Rights)".

Chapter 4 Lawsuits under the Trademark Law

8. A lawsuit may be filed according to section 2(d) [sic] Trademark Law either by the right holder himself or by a person who is authorised to act on his behalf under any law in force.
9. Lawsuits filed for mark infringement under the Trademark Law shall be filed within the legally prescribed period.
10. In relation to applications to declare a mark registration invalid and delete it, the provisions of chapters 15 and 19 shall be carried out.



11. The complaint shall be written in accordance with the Code of Civil Procedure. In addition, the reason for the mark rights infringement, the amount of money claimed, and the calculation thereof shall be fully presented.
12. The intellectual property rights court shall open and maintain a separate civil case registration book for lawsuits alleging intellectual property rights infringements under the intellectual property rights laws, including the Trademark Law. This registration book shall be named "Civil Case Registration Book Related to Intellectual Property Laws". The case numbering shall follow the format "Civil Case No. - .../2023 (Intellectual Property Rights)".

Service of the writ of summons

13. Upon receipt of the complaint, the intellectual property rights court shall instruct the plaintiff to immediately serve the writ of summons on the defendant. The plaintiff shall serve the writ of summons on the defendant at his own costs, and shall also send a copy of the complaint to the defendant along with the writ of summons.
14. The plaintiff shall submit an affidavit to the intellectual property rights court stating that he served the writ of summons on the defendant on or before the date set by the intellectual property rights court. If he fails to do so, the intellectual property rights court may dismiss the complaint or set a new suitable date. If the plaintiff fails again to do so on the newly set date, the intellectual property rights court may close the case.

The defendant is abroad

15. When a defendant who is abroad is being sued, the intellectual property rights court shall proceed in accordance with the Code of Civil Procedure and the relevant instructions issued by the Supreme Court.

Evidence to be presented by the plaintiff when suing for damages

16. If the plaintiff sues for damages, he has to present evidence showing the following:
 - (a) That he is a right holder under the Trademark Law;
 - (b) that the defendant used the mark and that such use harmed the interests of the right holder;
 - (c) that the right holder's mark is identical or similar;
 - (d) that the public or consumers are being misled;



- (e) other evidence required to verify the occurrence of damages and the amount of the damages.
- 17. When claiming a famous mark, evidence has to be provided that the mark is famous, irrespective of whether it is registered or unregistered, and that the claimant owns it.
- 18. If a lawsuit is filed in an intellectual property rights court regarding an infringement of mark rights and the defendant argues that the intellectual property right obtained by the plaintiff is invalid and the case between the same parties is pending at an intellectual property rights court vested with jurisdiction under section 66, the original court that is hearing the infringement case may suspend proceedings until the other court has finished its examination.
- 19. A person who wants to show that a mark has been registered shall submit the original or a certified copy of the mark registration certificate.

Taking action against goods that infringe mark rights

- 20. In lawsuits filed for mark infringement, appropriate orders may be made to prevent infringing goods from entering commercial channels under section 81(a)(1) of the Law, remove them from commercial circulation or destroy them under section 81(a)(3) of the Law, and remove from commercial circulation or destroy the equipment used for manufacturing these goods. **(Intellectual property right form-1)**

Chapter 5

Application for provisional orders

- 21. The intellectual property rights court shall open miscellaneous civil proceedings for a right holder to apply for the imposition of a provisional order under section 79 of the Law and a unilateral provisional order under section 80 of the Law.
- 22. Applications for provisional orders under the intellectual property laws against the infringement of rights (including applications for unilateral provisional orders) shall be entered into the registration book for miscellaneous intellectual property cases of the intellectual property rights court. The case numbering shall follow the format "Miscellaneous Civil Case No. - .../2023 (Intellectual Property Rights)".
- 23. The applicant:
 - (a) Shall, when applying for provisional orders under section 79 of the Law, present evidence that he is a right holder and that the respondent infringes or is likely to infringe



his rights, and in addition, any other evidence that the intellectual property rights court instructs him to present.

- (b) Shall, when applying for a unilateral provisional order under section 80 of the Law, state that a delay will cause irreparable harm to the right holder, or that there is an actual risk of evidence being destroyed.
 - (c) Shall present these elements together with an affidavit or affidavits. The affidavit shall state that the facts presented in the application are true. The applicant shall submit required documents to the intellectual property rights court at the time determined by the intellectual property rights court.
24. The intellectual property rights court shall instruct the applicant to immediately serve the writ of summons on the respondent except in cases where a unilateral provisional order under section 80 of the Law may be made (**Intellectual property right form-2**). The applicant shall serve the writ of summons on the respondent at his own costs, and together with it, he shall send copies of the application and of the affidavits in support of the application to the respondent.
25. The applicant shall submit an affidavit to the intellectual property rights court stating that he served the writ of summons on the respondent on or before the date set by the intellectual property rights court. If he fails to do so, the intellectual property rights court may reject the application or set a new suitable date. If the respondent fails again to do so on the newly set date, the intellectual property rights court shall reject the application.
26. The respondent shall file a rebuttal of the application within 15 days from the receipt of the writ of summons or until the date determined by the intellectual property rights court. Together with it, the respondent shall submit an affidavit that he believes all elements in the rebuttal to be true to his knowledge. He may enclose documents and evidence that he wants to submit. If the respondent fails to file a rebuttal until the date set by the intellectual property rights court, he may be treated as if no defence was made in his absence.
27. (a) With regard to an application for a provisional order or a unilateral provisional order, the intellectual property rights court may instruct the applicant to deposit sufficient security in cash or a guarantee on such terms as it may deem fit. (**Intellectual property rights form-3**)
- (b) If the applicant does not comply with the instructions of the intellectual property rights court to deposit cash security or a guarantee within the determined time period, the intellectual property rights court shall reject the application.



28. The intellectual property rights court:
- (a) Shall make issue such order as it may deem fit under section 79(a) of the Law with regard to an application.
 - (b) Shall notify the provisional order to the respondent. (**Intellectual property rights form-4**)
 - (c) Shall act in accordance with section 94(c), Rule 2 Order 39 Code of Civil Procedure if the provisional order is not complied with.
29. (a) If the intellectual property rights court made a unilateral provisional order, it shall notify the respondent without delay.
- (b) The unilateral provisional order shall be enforced according to section 80(b)(2) of the Law if the respondent does not comply with the order within the time period determined by the intellectual property rights court or within 30 days from the date of issuance of the notice if there is no such determination.
 - (c) If the respondent applies for the unilateral provisional order to be amended or cancelled, the intellectual property rights court shall hear the parties within a reasonable time period and issue an order amending, cancelling or confirming the unilateral provisional order according to section 80(c) of the Law.
 - (d) If the respondent does not comply with the order amending or confirming the unilateral provisional order, the intellectual property rights court shall act in accordance with section 94(c), Rule 2 Order 39 Code of Civil Procedure.
30. If the applicant does not file a lawsuit for damages within the time period determined by the intellectual property rights court or within 30 days if there is no such determination, the intellectual property rights court shall, without prejudice to section 80(b) of the Law, at the request of the respondent lift or terminate the effect of provisional orders imposed under section 79(a) or section 80(a) of the Law.
31. If the provisional order is lifted or terminated, or if it is found that there is no infringement of mark rights or that no infringement is likely, the intellectual property rights court may, at the request of the respondent and after hearing both parties, order the applicant to pay appropriate compensation to the respondent for the damages caused by the applicant's acts.
32. The intellectual property rights court may order the compensation to be paid from the security deposit submitted by the applicant to the court.



Effect of the provisional order

33. A provisional order is effective only until a judgement is passed in the lawsuit filed for infringement of an intellectual property right under the Trademark Law, unless the relevant intellectual property rights court issued an order at the request of the respondent lifting it or terminating its effect.

Chapter 6

Application to the intellectual property rights court against a decision of the Agency

34. A person who is not satisfied with a decision of the Agency may apply to the relevant intellectual property rights court according to section 66 of the Law within 90 days from the date of having received the notice of the decision.
35. The person who may apply to the intellectual property rights court against a decision of the Agency shall have been a party to the appeal filed with the Agency [*against a decision of the Registration Officer*].
36. The intellectual property rights court's judgement on an application against a decision of the Agency is binding on the Agency, and the Agency and the beneficiaries of its decision shall be included as respondents.
37. Regarding the person who will act as representative in the application to the intellectual property rights court against the Agency's decision, the Code of Civil Procedure and other relevant laws in force shall be complied with.
38. The intellectual property rights court shall enter the applications for amendment and cancellation of the Agency's decision in the "Registration Book for Intellectual Property Rights Applications". (**Intellectual property rights form-5**)
39. (a) Certified copies of the decision or order of the Agency that the intellectual property rights court should review and decide about and of the case file shall be enclosed with the application, as well as an affidavit or affidavits supporting the application. The affidavit shall state that the facts presented in the application are true. The applicant shall submit required documents to the intellectual property rights court at the time determined by the intellectual property rights court.
- (b) Upon receipt of the application, the intellectual property rights court shall verify whether the elements in sub-section (a) are fulfilled, and if they are, shall open miscellaneous civil proceedings. The case numbering shall follow the format "Miscellaneous Civil Case No. - .../2023".



- (c) Then, the intellectual property rights court shall instruct the applicant to serve the writ of summons on the respondent. (**Intellectual property rights form-6**) The applicant shall serve the writ of summons on the respondent at his own costs, and together with it, he shall send to the respondent copies of the application and of the affidavits in support of the application, a copy of the Agency's decision [*or?*] order, and a copy of the case file or case record.
- (d) The applicant shall submit an affidavit to the intellectual property rights court stating that he served the writ of summons on the respondent on or before the date set by the intellectual property rights court. If he fails to do so, the intellectual property rights court may reject the application or set a new suitable date. If the respondent fails again to do so on the newly set date, the intellectual property rights court shall reject the application.
- (e) The respondent(s) shall submit two sets of replies to the intellectual property rights court before the hearing date. (**Intellectual property rights form-7**) Together with it, the respondent shall submit an affidavit that the respondent believes all elements in the reply to be true to the respondent's knowledge. The respondent may enclose documents and evidence that the respondent wants to submit. If the respondent fails to submit a reply until the date set by the intellectual property rights court, the respondent may be treated as if no defence was made in the respondent's absence. A reply may be amended or substituted for another reply with the permission of the intellectual property rights court.
40. Apart from the evidence presented at the Agency, no oral or written evidence shall be admitted. However:
- (a) The intellectual property rights court may, for making an order or for any other valid reason, if necessary allow the presentation of evidence and documents and allow the cross-examination of witnesses.
- (b) The intellectual property rights court shall give the reasons in writing when allowing additional evidence to be presented.

Impact and binding effect of the intellectual property rights court's judgment on the Agency's decision

41. If the intellectual property rights court approves the Agency's decision, it shall reject the applicant's application. If the intellectual property rights court grants the applicant's application, it may issue an order cancelling the Agency's decision or any other order it deems appropriate.



42. If the intellectual property rights court issues an order cancelling the Agency's decision, a copy of the intellectual property rights court's order shall be sent to the Agency.

Chapter 7

Application to the intellectual property rights court against a suspension order of the Director General of the Customs Department

43. The intellectual property rights court shall open miscellaneous civil proceedings for applications according to section 72 of the Law to review a suspension order of the Director General of the Customs Department.
44. The intellectual property rights court's judgement on an application against a suspension order of the Director General of the Customs Department is binding on the Customs Department, and the Director General of the Customs Department and the beneficiaries of the suspension order shall be included as respondents.
45. The suspension order of the Director General of the Customs Department shall be enclosed with the application. In addition, other documents required to support the applications of the applicant (importer) may also be submitted.
46. (a) The application shall be entered into the registration book for intellectual property rights applications of the intellectual property rights court. (**Intellectual property rights form-5**) The case numbering shall follow the format "Miscellaneous Civil Case No. - .../2023".
- (b) Then, the intellectual property rights court shall instruct the applicant to immediately serve the writ of summons on the respondents, unless it deems that the application should be heard *ex parte*. (**Intellectual property rights form-6(a)**) The applicant shall serve the writ of summons on the respondent at his own costs, and together with it, he shall send to the respondent copies of the application and of the affidavits in support of the application, a copy of the suspension order of the Director General of the Customs Department, and a copy of the case file or case record.
- (c) The applicant shall submit an affidavit to the intellectual property rights court stating that he served the writ of summons on the respondent on or before the date set by the intellectual property rights court. If he fails to do so, the intellectual property rights court may reject the application or set a new suitable date. If the respondent fails again to do so on the newly set date, the intellectual property rights court shall reject the application.



- (d) The respondent(s) shall submit two sets of replies to the intellectual property rights court before the hearing date. (**Intellectual property rights form-7(a)**) Together with it, the respondent shall submit an affidavit that the respondent believes all elements in the reply to be true to the respondent's knowledge. The respondent may enclose documents and evidence that the respondent wants to submit. If the respondent fails to submit a reply until the date set by the intellectual property rights court, the respondent may be treated as if no defence was made in the respondent's absence. A reply may be amended or substituted for another reply with the permission of the intellectual property rights court.
47. If so instructed by the intellectual property rights court, the Customs Department is responsible for sending required documentary evidence to the intellectual property rights court.
48. According to section 72 of the Law, the intellectual property rights court shall amend, cancel or confirm the suspension order within 30 days from the date on which a review of the suspension order of the Director General was requested.
49. If the intellectual property rights court issues an order cancelling the suspension order of the Director General of the Customs Department, a copy of the intellectual property rights court's order shall be sent to the Customs Department.

Chapter 8 Evidence management

50. The intellectual property rights court may, if necessary, order evidence related to the case to be sent to the court, if a civil or criminal case related to a mark infringement was filed. If the evidence is difficult to send to the court, be it because it is large in quantity or bulky, the Myanmar Police Force, the Customs Department, or a party or parties deemed fit may be instructed to keep it in a suitable place so that it is not damaged or lost.
51. If in a civil or criminal case a party or parties are ordered during the proceedings to maintain evidence, the party may be instructed to submit a guarantee in relation to the evidence. (**Intellectual property rights form-8**)
52. Goods evidencing an offence, including tools and equipment, may according to section 97 of the Law be ordered to be confiscated as public property, destroyed or returned to the owner, or subject to any other order deemed appropriate according to a law in force.



Chapter 9

Enforcement of decrees and orders issued by the intellectual property rights court

53. The court enforcing decrees and orders issued by the intellectual property rights court under the Trademark Law shall comply with the Code of Civil Procedure.
54. In enforcing the decrees and orders issued by the intellectual property rights court, the relevant departments and organisations concerned are obliged to cooperate as instructed by the court.

Chapter 10

Miscellaneous

55. In taking action against an infringement of mark rights, section 86 of the Law may be applied for matters not explicitly set forth in these procedures.
56. These procedures shall be applied from 1 April 2023 (1384, 12th Waxing Day of Tagu) when the Trademark Law will come into force according to Notification No. 82/2023 dated 10 March 2023 of the State Administration Council.

(Tun Tun Oo)

Chief Justice of the Union

Intellectual property rights forms *[omitted]*



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