

## **BRAND PROTECTION AND ENFORCEMENT IN MYANMAR**

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### **Old System and Trademark Law 2019**

Before 2019, protection and enforcement of trademarks in Myanmar were possible under the “old system” based mainly on the Specific Relief Act 1877, the Law of Torts 1855, the Penal Code 1860, the Civil Procedure Code 1908, the Registration Act 1908 and the Deeds Registration Law 2018. The first-to-use principle is recognized under the old system.

On 30<sup>th</sup> January 2019, Myanmar passed its first ever Trademark Law 2019 (“**TML**”) to establish a new trademark registration system. However, as of August 2019, the TML has not yet come into force. But once it is in force, new trademark applications must be filed under the TML and the existing trademark registrations must be re-filed. For now the old system still applies.

### **Declaration of Trademark Ownership (“**DTO**”)**

A trademark can be registered with the Office for the Registration of Deeds (“**Registry Office**”) by filing a DTO signed by the applicant with the Registry Office within 120 days from the execution date of the DTO (Sections 17(d), 22 and 24 of the Deeds Registration Law 2018). One DTO can cover only one trademark but for several classes of goods or services. If the DTO is made in English, its notarized Myanmar translation must also be filed (Section 18-B of the Deeds Registration Law 2018). If the DTO is signed abroad, it must be notarized by a notary public. The Registry Office takes around two weeks to register a DTO. There are no examination or opposition proceedings. A trademark registration is valid without an expiry date.

To file the DTO of the applicant outside Myanmar, a local attorney must be appointed by a Power of Attorney (“**POA**”) notarized and legalized by the Embassy of Myanmar in the applicant’s country.

### **Cautionary Notice (“**CN**”)**

Once a trademark is registered under a DTO, it is a practice to publish a CN in a local newspaper to notify the public of trademark ownership and discourage infringement of the trademark. One CN can cover one trademark for a number of classes or a number of trademarks of the same owner for the same class of goods or services. The CN should contain a specimen of the trademark, its registration details, the name and address of its owner plus a short warning against infringement of the mark.

### **Civil and Criminal Actions against Trademark Infringers**

If a trademark is registered or used without authorization of its owner, the trademark owner can file a civil case for (i) an injunction order against its unauthorized use, (ii) a cancellation against its registration, and (iii) a compensation for any damages suffered by the owner from the infringing activities of the infringer (the Specific Relief Act, the Law of Torts and the Order 39 Rules (1) & (2) of the Code of Civil Procedures).

A criminal action can also be filed against an infringer who (i) uses a falsified or counterfeit trademark, (ii) makes or possesses any instrument for making the counterfeit trademark, or (iii) sells goods bearing the counterfeit trademark. The court can impose on the infringer a fine, an imprisonment term and an order for seizure and destruction of the infringing goods (Sections 482, 483, 485 and 486 of the Penal Code).

### **Cease and Desist Letter (“CDL”)**

Before filing a court case, it is a practice to send a CDL to the infringer and their authorized directors (if the infringer is a company) by registered post to their registered addresses, which can be obtained by a company search on the website of the Directorate of Investment and Company Administration (DICA). The said company search and a market search for evidence of the infringing activities are necessary for the CDL and the services of the court summons and other administrative actions.

The CDL should contain demands for the infringer to cease the infringing activities, withdraw the infringing trademark registration and sign an undertaking letter to undertake that the infringer will comply with the CDL demands.

### **Public Warning Notice (“PWN”)**

Before filing a court case, a PWN may also be published in a local newspaper to warn the public of the infringing products and to warn the infringer of potential legal actions if the infringer does not cease the infringing activities after the CDL. The PWN should be published in both the Myanmar and English languages in a well-known local newspaper with nationwide distribution.

### **Trademark Searches and Market Investigations**

If counterfeits are found in the market and if it is suspected that the counterfeiter has registered the infringing trademark in bad faith, trademark searches with a few trademark search companies should be made to find out whether that mark has been registered (there is no official trademark search system in Myanmar). The search results are not all accurate because trademark search companies collected only some copies of CNs published in local newspapers starting around 1989.

Market investigations in Yangon (Bogyoke Aung San Market and Theingyi Zay Market), Nay Pyidaw and Mandalay for details and evidence of infringing products and infringers are crucial. Samples of infringing products taken from markets and other evidence materials on manufacturing, importing or selling of infringing products are necessary for a trademark infringement case.

### **Consumer Survey**

A consumer survey can also be conducted with a target group of consumers in different cities in Myanmar to establish a claim that consumers are misled or confused in relation to the owners and the origins of counterfeits and genuine goods. The survey results can be used as evidence in court proceedings.