

Trademark Registration, Use and Enforcement in Myanmar

1. Trademark System Prior to Effective Date of TML2019

A trademark can be registered with the Office for Registration of Deeds by registering a Declaration of Trademark Ownership (“**DTO**”) under the Registration of Deeds Law 2018. One DTO can cover one trademark for one or several classes of goods or services. There is neither examination nor opposition procedures. The registration is granted after 2 weeks from the DTO filing date. Once the DTO is registered, publishing of a Cautionary Notice (“**CN**”) in local newspapers is then made by the trademark owner to notify the public of the trademark ownership and to discourage infringement of the trademark. The CN is re-published every period of 3 years.

A trademark registration is valid without an expiry date.

The right under the first to use principle is recognized in Myanmar for trademark protection and enforcement. The owner of a trademark can file a trademark infringement lawsuit in court as a criminal or civil case against the infringer based on the Specific Relief Act 1877, the Civil Procedure Code 1908 and the Penal Code 1860, the Myanmar Merchandise Marks Act 1889, the Sea Customs Act 1878 and the Registration of Deeds Law 2018.

2. Myanmar Trademark Law 2019

The Trademark Law 2019 (“**TML2019**”) was passed by the Parliament of the Republic of Union of Myanmar on 30th January 2019. It will become effective when the President announces its effective date. It consists of 24 chapters (106 sections) and adopts the “first to file” principle of trademark protection. The Ministry of Commerce (“**MOC**”) and the Department of Intellectual Property (“**DIP**”) are the main government offices in charge of trademark registration.

3. Central Committee of Intellectual Property (“CCIP”) and Intellectual Property Agency (“IPA”)

The CCIP was established on 6th March 2020 by the Cabinet of the Union Government of Myanmar to create policies, strategies and plans related to IP rights and to supervise the IPA (see below). The Chairman of the CCIP is the Vice President of Myanmar. The Minister of the MOC is its Vice Chairman. The Deputy Minister of MOC is its Secretary-General. The members of the CCIP consist of five deputy ministers from the Ministry of Planning, Finance and Industry; the Ministry of Information; the Ministry of Education; the Ministry of Investment and Foreign Economic Relations; and the Ministry of Agriculture, Livestock and Irrigation. It other members are 15 directors-general from related ministries, 4 expert members and 2 NGO members.

The IPA will be formed under the TML2019. The Secretary-General of the CCIP will be the Chairman of the IPA. Its ex officio members will be directors-general of the relevant ministries, 8 IP experts and 5 NGO representatives. The Director-General of the DIP will be its Secretary. The main functions of the IPA are implementing the trademark policies and strategies developed by the CCIP and reviewing appeals filed by applicants against orders and decisions of the Trademark Registrar and giving decisions.

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4. Marks Protected under the TML2019

The TML2019 protects marks, trademarks, service marks, collective marks, certification marks, trade names, well known marks and GIs (Geographical Indications).

Trade names are protected without registration, provided that they are not used in contrary to the public order or to mislead the public or the trade.

5. Re-filing of Registered Trademarks and Requirements

The trademarks already registered before the effective date of the TML2019 will not be automatically recognized and protected under the TML2019. They must be re-filed and examined and registered under the TML2019. The DIP will announce the Soft Opening Period (“SOP”) for owners of the registered trademarks to re-file them. The SOP will last for at least 6 months plus possibly 6 additional months.

The requirements for the refiling are a notarized Power of Attorney (“POA”) in the official form to be issued by the DIP for a Myanmar representative; a scanned copy of the registered DTO and the latest published CN; a specimen of the trademark in the ‘jpg’ format; a list of goods /services and their classes under the Nice Classification; and the name, home or office address, email address and the telephone number of the applicant.

6. Filing of Used Trademark and Filing Requirements

Trademarks already used in Myanmar without registration can also be filed during the SOP. The filing requirements include a notarized POA from the applicant to a Myanmar representative (if the applicant is not a Myanmar citizen); a scanned copy of business license of the applicant; a copy of advertisements of the used trademark; a specimen of the used trademark in the ‘jpg’ format; a list of goods/services and the classes under the Nice Classification; the name, home or office address, email address and telephone number of the applicant. The DIP may order submission of other documents during the application examination stage.

7. Filing New Trademarks and Filing Requirements

New trademarks not already registered in Myanmar before the effective date of the TML2019 can be filed with the DIP after the SOP. The filing requirements are the name, address, telephone number and email address of the applicant; a notarized POA from the applicant to a Myanmar representative if the applicant is not a Myanmar citizen; a specimen of the trademark in the ‘jpg’ format; a complete and clear description of the trademark; and a list of goods/services and their classes under the Nice Classification.

8. Examination of Trademark Application and Grounds of Refusal

At the examination stage, the DIP may refuse registration of the trademark on the absolute grounds of: lack of inherent distinctiveness; being directly descriptive of the goods and/or services for which it is applied; having become a generic mark customarily or commonly used in the trade or the industry of the goods and/or services for which it is applied; misleading or causing confusion to the public or the trade or the industry; adversely affecting the public order, morality, religion or culture of Myanmar; directly imitating a flag or a symbolic feature of a state or an international organization without their authorization; and being or including any of the emblems specifically protected under international agreements of which Myanmar is a member.

The DIP may also refuse registration of a filed trademark on the relative grounds if the trademark is identical with or confusingly similar to a senior pending trademark or a registered mark or a well-known mark or a mark with priority right; filed in bad-faith because the filed trademark is owned by another person; affecting the personal right or name or reputation of another person or another legal entity without their permission; and infringing an IP right of another person.

9. Publication, Opposition and Registration

After formality check and the absolute ground examination of a trademark application, the DIP will publish it for 60 days for opposition. If an opposition is filed, the DIP will send a notice to the applicant. The applicant can file a counterstatement within a period indicated in the notice of the DIP. If the DIP rules in favor of the applicant, the trademark will be allowed registration upon payment of the registration fee by the application.

10. Appeal

If the DIP refuses the application or rejects the opposition, the applicant or the opponent can file an appeal with the IPA within 60 days from the date of receiving the decision of the DIP.

If the appeal of the applicant or the opponent is rejected by the IPA, the applicant or the opponent can file further appeal with the Intellectual Property Court (“IPC”) within 90 days of receiving the IPA decision notice.

11. Registration Validity Term and Renewal

A trademark registration is valid for 10 years from the application filing date and it can be renewed every period of 10 years within 6 months prior to its expiration date. Renewal during a grace period of 6 months after the expiration date is possible. A trademark registration not renewed during the renewal period or the grace period cannot be any further renewed. It will be cancelled from the registration system by the DIP.

12. Assignment and License

The owner of a registered trademark or a pending trademark can assign the trademark to any other person (an individual or a legal entity).

The owner of a registered trademark can license it to any other person. Terms and conditions of the license must meet the minimum requirements under the TML2019. The assignment and license must be recorded with the Trademark Registrar of the DIP.

The trademark assignment agreement and the trademark license agreement must be made in writing, signed by the parties and recorded with the DIP.

13. Invalidation and Cancellation for Non-Use

A registered trademark can be invalidated for one or several of the absolute grounds or relative grounds of refusal or for not being a mark as defined under Section 2 (j) of TML2019.

A registered trademark which is not used in commerce in Myanmar for a good reason for 3 consecutive years is vulnerable to cancellation for non-use.

An invalidation action and a cancellation action for non-use can be filed by an interested party with the DIP or the IPC.

14. Actions against Infringement

The owner of a registered trademark can file civil and criminal actions against an infringer of the registered trademark with the IPC. The IPC may grant an interim injunction order and/or a permanent injunction order against the infringer and order the infringer to pay a compensation for damage suffered by the owner. The IPC may also order removal from the market or destruction of the infringing goods and other infringing articles.

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4th August 2020



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