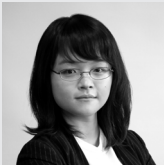




On 31 January 2019, the President of Myanmar signed and formally enacted the Industrial Design Rights Law (No.2/2019) and the Trademark Law (No.3/2019) (“Trademark Law”).

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10 FREQUENTLY ASKED QUESTIONS ABOUT THE MYANMAR TRADEMARK LAW 2019

On 31 January 2019, the President of Myanmar signed and formally enacted the Industrial Design Rights Law (No.2/2019) and the Trademark Law (No.3/2019) (“**Trademark Law**”). Similar to the Myanmar Companies Law 2017, the two aforementioned laws await further notification by the president to take effect. It could, therefore, be inferred that the authorities anticipate the laws to come into effect after the filing systems and regulations are implemented for the “first-to-file” feature under the aforesaid laws.

The enactment of the two aforementioned laws, along with the pending Bill of Copyright Law and Bill of Patent Law, signals a crucial step to build up a modern legal regime for intellectual property in Myanmar.

A list of 10 FAQs for the new Trademark Law is presented below. Please note, the list does not include some unanswered questions in the law, including practical aspects of filing procedures and transition of previous registrations, as it is assumed that the subsequent implementing rules of the Trademark Law will shed more light on these issues.

1. What kind of mark is registrable?

The definition of a “mark” under the Trademark Law confines it as “seeable by one’s own eyes” and “used, or

Highlights of this note

- ▶ What kind of mark is registrable?
- ▶ Does the trademark law adopt a “first-to-file” or “first-to-use” system? Can I claim priority rights?
- ▶ How long can a registered trademark be protected?
- ▶ What rights does a trademark owner have?
- ▶ If I identify a pending trademark application infringing upon my rights, what can I do?
- ▶ If I identify a registered trademark infringing upon my rights, what can I do?
- ▶ How can I stop someone with no legitimate grounds from infringing upon my trademark rights?
- ▶ Is there any special protection for well-known trademarks?
- ▶ Can geographic identification, collective trademark, and trade name be protected in Myanmar?
- ▶ Is there any way that I can lawfully use someone else’s trademark?

intended to be used to distinguish goods or services dealt with by a person from those dealt with by another.”

The implications of the element “seeable by one’s own eyes” indicates that it is unlikely that the registrar would accept registration of unconventional marks like sounds, smells, and tastes, which are registrable in comparative jurisdictions like the United States and Europe.

The Trademark Law also provides a list of unregistrable marks, such as lack of distinctiveness, contrary to the public policy, infringement on prior rights of other persons, etc.

2. Does the trademark law adopt a “first-to-file” or “first-to-use” system? Can I claim priority rights?

The Trademark Law does adopt a “first-to-file” system. Applications are to be made to the IP registration offices formed by the relevant department under the Ministry of Commerce. The application can be done in either Myanmar or English language; however, the officers may require translations, at their discretion.

The date of submission will be the date on which a complete submission is filed and the prescribed fees are paid. A few exceptions do apply, such as priority rights based on prior application under the Paris Convention and prior exhibition in international trade fairs.

3. How long can a registered trademark be protected?

Once registered, the term of protection will be 10 years from the date of submission, which is renewable every 10 years; this theoretically allows for perpetual proprietary ownership over the trademark.

4. What rights does a trademark owner have?

A registered trademark owner will enjoy the following rights:

1. The right to prevent others from using an identical or similar trademark on identical or similar goods/services for trading which may trigger confusion
2. In case of a well-known trademark, the right in (i) above will extend to goods/services that are not identical or similar but nonetheless suggest a false connection between the well-known trademark and such goods/services, or is contrary to the interests of the well-known trademark owner
3. The right to sue any person, either by a civil suit or a criminal suit, for infringement of its registered trademark
4. The right to assign or license others to use its registered trademark as well as other rights vested upon the trademark owner under the Trademark Law

5. If I identify a pending trademark application infringing upon my rights, what can I do?

Before a trademark application is finally approved and registered with the IP register, there will be an opportunity for public opposition over the trademark application.

6. If I identify a registered trademark infringing upon my rights, what can I do?

Even after a trademark is registered, it is not immune from an attack on its validity. The Trademark Law provides grounds for revocation or cancellation against a registered trademark.



7. How can I stop someone with no legitimate grounds from infringing upon my trademark rights?

While a right owner may initiate civil or criminal proceedings against infringers who use the right owner's trademark without legitimate grounds or authorization, the Trademark Law also provides an interim remedy, such as customs detention and interim injunction, to stop infringement activities before the legal proceeding is concluded.

8. Is there any special protection for well-known trademarks?

The Trademark Law provides the following protection to well-known trademarks to prevent others from registering or using such trademark:

1. For an unregistered well-known trademark, it may get protection in Myanmar against the use of an identical or similar mark on identical or similar goods/services.
2. For a registered well-known trademark, protection will be extended to goods/services that are not identical or similar, as it may in fact be contrary to the interests of such trademark if a false connection with the goods/services of the registered well-known trademark is suggested.

9. Can geographic identification, collective trademark, and trade name be protected in Myanmar?

The Trademark Law provides registration and protection to geographic identification and collective trademark. In addition, a registered or unregistered trade name may also get protection.

10. Is there any way that I can lawfully use someone else's trademark?

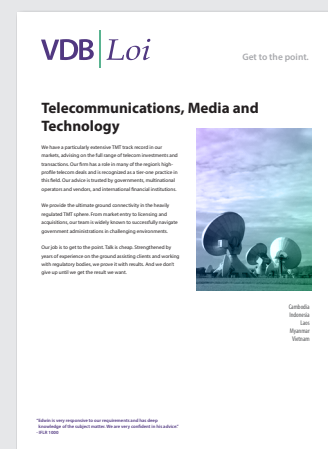
The Trademark Law provides limited "fair use" exceptions where one can lawfully use the trademark of someone else without that party's authorization. This includes:

1. Use of one person's own name or address
2. Use as an indication to describe the kind, quality, quantity, intended purpose, value, geographical origin, etc. of goods/services
3. Use where necessary to indicate the intended purpose or usage of product/services, in particular for accessories or spare parts

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