

Informed Counsel

Analysis of Recent Legal Developments in Thailand and Vietnam



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Myanmar has released the tenth draft of its new Trademark Law, which will replace the Registration Act and offer greater safeguards for brand owners to protect their marks.
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Myanmar Trademark Law: The Long Wait May Soon Be Over

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Myanmar is emerging from a long period of international isolation. With the recent relaxing of sanctions against the country, Myanmar is taking steps to rejoin the international community, and this includes legal reforms relating to intellectual property. After joining the World Trade Organization (WTO) in 1994 and becoming an ASEAN member in 1997, Myanmar has implemented provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights and the ASEAN Framework Agreement on Intellectual Property Cooperation.

Within this framework, Myanmar has shown a commitment to providing protection for intellectual property rights. At present, there are no specific IP laws in Myanmar, but that is about to change. The country's Ministry of Science and Technology, Ministry of Commerce, and Office of the Attorney General have collaborated with the World Intellectual Property Organization (WIPO) to begin drafting its IP laws. Myanmar's Trademark Law is now being drafted and reviewed, and it is due to take effect by the end of 2013, making it likely to be the first IP law established in the country. The Myanmar Intellectual Property Office (MIPO) will be set up as the responsible government body, and it will accept and register applications for trademark registration.

Draft Trademark Law

The tenth draft of the Trademark Law, which remains subject to change as it moves through the legislative process, is a significant piece of legislation that introduces key aspects of trademark protection for brand owners, which includes the following:

Scope. Protection is available for trademarks, service marks, collective marks, certification marks, and series of marks.

Definition. The definition of "mark" covers perceptible signs including sounds, smells, and touch, or any visible signs including pictures, names, domain names, signatures, letters, words, numerals, brands, labels, configurations, trade dress, packaging, colors, or combinations of colors.

Multiple classes. Multiple-class applications are allowed.

First to file. A first-to-file system will be implemented—the person who files the earliest application will enjoy the right to register the mark.

Priority. To claim the priority right of the date to file the first application for registration of a mark in any foreign member state conventions, treaties, or agreements, or of international organizations or regional organizations of which Myanmar is a member, an application for trademark registration must be filed within six months of the first filing date.

Registrability. The mark will not be registrable if it is:

- Lacking distinctiveness;
- Similar or identical to others' registered marks or well-known registered marks;
- Misleading the public or trade circles;
- Using the name of plant varieties protected in Myanmar;
- Infringing others' IP rights;
- Filed in bad faith; and
- In conflict with other restrictions as prescribed by the law.

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Opposition. Opposition can be lodged against trademark applications during the publication period. The deadline to file an opposition is 30 days from the date of the application if the opposer resides inside Myanmar and 60 days if the opposer resides outside Myanmar.

Appeal. Any aggrieved person wishing to make an appeal against the Registrar's decision is entitled to file an appeal with the Director General of MIPO, with further appeals being made to the responsible ministry or the Supreme Court.

Term. The term of registration for marks is ten years from the filing date of the application for registration, and the protection is renewable every ten years. A grace period of six months from the expiry date can be requested, but this carries with it late fees. Applications for renewal of a trademark registration must be filed within six months prior to the expiry date.

Exclusive rights. The owner of a registered mark shall have the exclusive right, first, to prohibit and prevent a third party from using identical or similar marks for the same or similar goods or services in the course of trade where confusion may arise in the public domain. In case of the use of an identical symbol or sign for the same goods or services, confusion shall be presumed. Second, a trademark owner has the right to file litigation, in criminal and/or civil actions, against an alleged infringer.

Good faith. The owner of a registered mark shall not be entitled to prohibit a third party from using the mark in good faith for industrial or commercial purposes in the following ways:

- The owner's name or address;
- Indications concerning kind, quality, quantity, intended purpose, value, geographical origin, time of production, or other characteristics of goods or services;
- Indications in respect of the intended purpose of accessories or spare parts; and
- The Ministry of Health may take measures to limit the use of marks for the purpose of facilitating the prescription of and the access to generic pharmaceutical products and medical devices, or for the purpose of discouraging the public consumption of goods that are deemed prejudicial to health, provided such measures do not unreasonably cause a detriment to the capability of the marks in question to distinguish goods of one undertaking from those of another undertaking.

Licensing. Trademark license agreements must be recorded with the MIPO. After the Registrar scrutinizes the application for the recordal of license agreement, the application will be recorded and published.

Cancellation. Grounds for full or partial cancellation of a trademark registration are:

- The registered mark falls under any ground of unregistrable mark as described in the law;
- The owner of the registered mark is not entitled to the registration; and
- The registration has been obtained by fraud, misrepresentation, or concealment of any prescribed point.

Non-use. Non-use cancellation is available. The Registrar may cancel the registration of a mark if the trademark owner fails to use the mark for three consecutive years, commencing from the date of registration, without any sufficient justification.

Transitional Provisions

Despite the previous absence of a law governing trademarks, many brand owners have already taken steps

to protect their trademark rights under Myanmar's existing system by relying on the current Registration Act and filing their marks with the Office of the Registration of Deeds. What will happen to these marks after the new law comes into effect? Any trademarks registered before the new Trademark Law comes into force—regardless of whether or not a new application is filed under the new Trademark Law—will continue to receive protection for three years from the effective date of the new law. If a new application to register the mark is not filed under the new Trademark Law within three years from its effective date, the protection of the mark under the Registration Act will end.

Shifting Protection from the Registration Act to the Trademark Law

To continue the protection of a mark registered under the Registration Act, the trademark owner must file an application to register the mark with the MIPO (if the MIPO has already been established) within three years after the effective date of the new Trademark Law. Preliminary examination on absolute grounds will be conducted by the Registrar. If the mark is not refused on absolute grounds, a Receipt of Acknowledgement (the "Receipt") will be issued. The Registrar will then further examine whether or not the Receipt has been correctly issued in accordance with the new Trademark Law. If it meets the required criteria, the Certificate of Registered Mark will be issued. If it does not, the Receipt will be cancelled.

Best Practices for Protection

Given the upcoming changes to the law, many brand owners are left wondering how best to safeguard their rights in this fast-changing market. As a best practice, trademark owners who have not already done so should immediately seek protection for their marks under the Registration Act by way of recordation of Declaration of Ownership. This should be done now, without waiting for the new Trademark Law to be enacted. By securing this prior registration, trademark owners will qualify for trademark rights under the new Trademark Law, as soon as it comes into effect. This will ensure strong protection for trademark rights, even as the new system is in the process of being established.

In order to file a Declaration of Ownership of a mark with the Office of the Registration of Deeds of Myanmar, the following documents are required:

1. Full name, address, and nationality of the applicant;
2. A Power of Attorney, which has been duly certified by a Notary Public and legalized by the Embassy of Myanmar;
3. A simply signed Declaration of Ownership;
4. A specimen of the mark; and
5. List of goods according to the International Classification (a multiple-class application is allowed).

There is no substantive examination for the recordation, and so the recordation system allows more than one owner to record the ownership of the same mark. This is another reason why genuine trademark owners must hurry to protect their marks and obtain their trademark rights in Myanmar. Following the recordation of the Declaration of Ownership, it is recommended that a Cautionary Notice of the registered mark be published in a local English newspaper or in a periodical, to remind the public of the mark's ownership and warn against possible passing off or infringement. Depending on the status of the transition to the new Trademark Law, brand owners can also consider renewing their registration and republishing their Cautionary Notice every three years.

By establishing their rights under the current system, trademark owners can strengthen their position in Myanmar and ensure a smooth, uninterrupted transition into the new system, once the Trademark Law comes into effect. 🏠