

## Brand protection in myanmar: Laying the groundwork for investment

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It seems that everyone wants to invest in Myanmar, but no one knows quite where to start. Many potential investors \_ from pioneering entrepreneurs to leading multinational corporations \_ are in a holding pattern, eager to share the country's immense potential, yet wary of moving in too soon and getting burned.

If you are thinking about investing in Myanmar, you should start by protecting your intellectual assets. Whether you plan to invest now or later, protecting your trademark in Myanmar will help to establish your rights to your brand in the local market.

If you wait until your business is ready to operate in Myanmar, then you are exposed and vulnerable to third parties stealing your trademark. The costs that you will incur to register your mark may be unnecessarily and significantly increased, because you will have to defend or enforce your rights against the infringer to take back your mark.

To get started, it is important to understand the legal framework in Myanmar is still in the process of being established. There are many areas where the laws are decades old, and others where regulations are completely non-existent. Intellectual property is one of these areas \_ currently there are no specific IP laws in Myanmar. But this is about to change. Myanmar's IP laws are in the process of being drafted, and its Trademark Law is due to be introduced by the end of 2013.

Despite the absence of any concrete law governing trademarks, many brand owners have already taken steps to protect their marks under Myanmar's existing system, before the new Trademark Law takes effect. Brand owners are relying on the current Registration Act and filing their marks with the Office of the Registration of Deeds. Under this regime, more than 30,000 marks received protection in Myanmar from 2005 to 2011. About 70% of those trademarks were recorded by local Myanmar citizens.

Best practices for protection: Many brand owners are in a state of flux, wondering how best to safeguard their IP rights. As a best practice, you should immediately seek protection for your marks under the current Registration Act by way of recordation of Declaration of Ownership. You should do this now, without waiting for the new Trademark Law to be enacted.

By securing this prior registration, you will qualify for trademark rights under the new Trademark Law, as soon as it comes into effect. This will ensure that your trademark rights are well protected, even as the new system is still in the process of being established.

In order to file a Declaration of Ownership of a mark with Myanmar's Office of the Registration of Deeds, you will need the following documents:

- full name, address, and nationality of the applicant;
- a power of attorney, which has been duly certified by a notary public and legalised by the Embassy of Myanmar;
- a simply signed Declaration of Ownership;
- a specimen of the mark; and
- a list of goods according to the international classification (a multiple-class application is allowed).

There is no substantive examination of the so-called recordation, meaning that the recordation system allows for more than one owner to record the ownership of a single mark. This is another reason why you should immediately obtain trademark protection in Myanmar.

Following the recordation of the Declaration of Ownership, you should publish a Cautionary Notice of the registered mark in a local English-language newspaper or periodical, to remind the public that you own the mark and warn against possible passing off or infringement. Depending on the status of the transition to the new Trademark Law, you can also consider renewing your registration and republishing your Cautionary Notice every three years.

What will happen to these marks after the new law comes into effect? Any trademarks registered prior to the new Trademark Law coming into force \_ regardless of whether or not a new application is filed under the new law \_ will continue to receive protection for a period of three years from the effective date of the new law. If you do not file a new application to register the mark under the new law within three years from its effective date, the protection of your 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, you must file an application to register the mark with the Myanmar Intellectual Property Office (MIPO) within three years after the effective date of the new Trademark Law.

Preliminary examination will be conducted by the Registrar. If the mark is not refused, a Receipt of Acknowledgement 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.

For now, the best course of action is to review your trademark portfolio and consult with your IP lawyers to develop an effective plan to protect your marks in Myanmar.