



## Corporate Governance

- 14 Dr. Bandid Addresses Corruption and Corporate Governance

---

- 16 Directors' Legal Duties and Good Corporate Governance

---

- 18 Good Corporate Governance Benefits Investors

---

- 31 AMCHAM Congratulates 2013 CSR Award Recipients

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# Trademarks in Myanmar: An Emerging IP Regime

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Among its many legal reforms now underway, Myanmar is beginning to develop new systems for the protection of intellectual property rights. Historically, there have not been any specific IP laws in Myanmar. Instead, IP owners have needed to rely on other systems of registration in order to protect their rights. But in a demonstration of its commitment to provide full protection for IP rights, the country is now drafting and reviewing its first Trademark Law.

## EXISTING LEGAL REGIME – REGISTRATION ACT

Despite the 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. This interim system of protection allows an IP owner to protect a trademark by filing an application to record a Declaration of Ownership. When the Declaration of Ownership has been recorded, the trademark will be protected for three years from the registration date.

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).



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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. 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.

## DRAFT TRADEMARK LAW

To replace this existing procedure, Myanmar's Trademark Law is now being drafted and reviewed, and it is due to take effect in the first quarter of 2014, 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.

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.

**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 with 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. 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.

### SHIFTING PROTECTION FROM THE REGISTRATION ACT TO THE TRADEMARK LAW

What will happen to trademarks registered under the Registration Act 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.

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. 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.

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.

### LOOKING AHEAD

Myanmar has begun to pave the way toward establishing a concrete system of protecting intellectual property rights. After the Trademark Law is implemented, foreign investors in Myanmar will have greater reassurance that their brands will receive trademark protection that meets international standards.

As a best practice, however, trademark owners should not wait to register their marks until after the new law has come into effect. Those who have not already done so should immediately seek protection for their marks under the Registration Act by way of a recordation of Declaration of Ownership. 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.

This summary is designed to provide general information only and is not offered as specific advice on any particular matter. ■

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