

Well-Known Trademarks in Myanmar

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From the time Myanmar opened its doors to the international community in 2011, there has been an influx of inward investment and a multitude of new ventures established in the country. As intellectual property (IP) is a vital asset for many of these companies, there has been an ever-increasing need for Myanmar to adopt a robust IP regime—particularly one that provides a solid foundation for well-known trademarks - in support of the large, multinational companies looking to invest in the country. Without a strong IP system, there potentially exists a serious impediment to the growth of businesses and investments that require IP protection.

Myanmar's trademark law was originally due to take effect in October 2013. Its arrival was then postponed to July 2014, but it has now been delayed once again. As it may be some time before the trademark law is implemented, this article addresses the protection of well-known trademarks in Myanmar under the current system and the proposed changes that may be introduced under the trademark law. The article also discusses Myanmar's patent, industrial design, and copyright laws.

The Protection of Well-Known Trademarks Under the current practice, identical or similar trademarks can be registered concurrently by more than one party in Myanmar because there is no trademark law, no official trademark search facility or database, no examination process for similar trademarks, and no opposition or cancellation processes against trademark applications prior to their registration. Currently, not only do regular trademarks lack protection, but well-known trademarks lack protection of owners' rights. Therefore, identical trademarks can be recorded and published in a cautionary notice to show they are protected in Myanmar.



Shop owners, as shown above, may use names and well-known trademarks as their shop and/or business names because the rights of trademark owners may be unknown to them. Additionally, under the current law, such shop owners may actually have the right to use well-known trademarks and names for their shops if they have recorded a declaration of ownership with the Registrar of Deeds and Assurances. Therefore, if these shop owners believe that they have the legal authority to use these trademarks with their businesses and shops, trademark owners are unable to prevent such infringement of their trademarks, unless they have already protected their trademark rights in line with the current practice.

A legitimate trademark owner, seeking legal recourse against an alleged infringer who has acted in bad faith, may:

- (i) send a cease-and-desist letter that orders a stop to the infringement; and/or
- (ii) request a cancellation action against the infringed registered trademark; and/or
- (iii) request a temporary injunction from the court and bringing the case to court.

In taking action against an infringer, a legitimate trademark owner must demonstrate actual use of the trademark to prove they are the legitimate trademark owner and have a better right over the mark in Myanmar. In order to demonstrate actual use, a trademark owner must sell and distribute products bearing the trademark on its own or via a distributor. This may, however, prove to be difficult, because the legitimate trademark owner may not be able to provide evidence claiming a better right over the alleged infringer for products which are not related to their business.

Furthermore, foreigners and foreign companies are not allowed to operate in trading and retailing businesses in Myanmar. For this reason, trademark owners, as well as IP owners, will face a limitation on their capacity to sell and distribute products, because they are required to find a local distributor and/or a business partner for trading, retailing, and/or importing their products in Myanmar. It may be difficult for IP owners to find a right local distributor and/or business partner, making it more difficult to use their trademarks and IP rights in Myanmar for certain products or in certain industries.

THE DRAFT TRADEMARK LAW

The new trademark law was expected to come into effect in 2014. At present, however, it has yet to be implemented. It is hoped that the new trademark law will take effect in 2015, so that mechanisms

from the alleged trademark owner, who had obtained the senior IP right from the current practice; and (vii) supporting evidence for legitimate trademark owners in proving their better right over a disputed mark. This applies not only to actual use

In terms of copyright, Myanmar's current copyright law does not afford protection to foreign copyrights—Myanmar's Copyright Act of 1911 is considerably outdated, having been last amended in 1914. Foreign works are not recognized by Myanmar's Copyright Act, and so foreign copyright owners cannot successfully claim their rights based on the current law. There is currently very little jurisprudence to go by, as copyright protection is given to works created by Myanmar nationals and/or works first published in Myanmar. Thus, only local owners can take legal action against infringers. Similarly, it is very difficult, without recognition of foreign works, to apply for injunctive relief with local courts or to persuade customs to seize infringing goods. However, if an infringing trademark is clearly visible on such copies or goods, it may be possible to proceed on the basis of trademark infringement instead of copyright infringement.



Published cautionary notice showing a mark registered in Myanmar.

of trademark protection and solutions to a number of problems that have arisen out of the current practice will be provided for. Such problems include:

- (iv) how to authenticate a trademark right that has arisen out of the current practice of recording the declaration in the trademark registration under the trademark law;
- (v) how the examination will be conducted to identify the rights of the trademark owners between two or more trademark owners who have recorded the same trademark with the Registry of Deeds and Assurances;
- (vi) solutions for the real trademark owner, who would retrieve their IP rights

of a disputed trademark in Myanmar, but also to use of the mark in other countries, which should be considered in both better right and unfair competition disputes.

PATENT, INDUSTRIAL DESIGN, AND COPYRIGHT LAWS

In addition to the trademark law, patent and industrial design laws are also expected to be introduced. This will have a significant impact on IP owners and particularly those in the manufacturing, industrial, pharmaceutical, automobile, and technology industries, as patents and designs are central to their businesses. The current practice does not presently provide sufficient protection for patents or industrial designs.

Adding to the difficulty of preventing copyright infringement, Myanmar is not a signatory to the Paris Convention for the Protection of Industrial Property, nor is it a signatory to the Berne Convention for the Protection of Literary and Artistic Work. Myanmar has, however, signed the Agreement on Trade-Related Aspects of Intellectual Property Rights under the World Trade Organization, and is therefore obligated to implement adequate intellectual property legislation.

Enacting up-to-date intellectual property laws in Myanmar is a foremost priority. The four IP laws will help stimulate investment and innovation in Myanmar as investors become increasingly more expectant of a country that has recognized its own tremendous potential and acknowledged the need to put in place a robust IP regime. Once Myanmar implements its IP laws and brings itself in line with international conventions, the country's appeal as a hub for investment will soar to levels much greater than they already are. ■

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