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## Practical Implications of Myanmar's New Trademark Law

On January 30, 2019, Myanmar's long-awaited Trademark Law was signed into law, effectively establishing the framework for a comprehensive trademark registration system open to both foreign and domestic trademark owners. This highly anticipated move by the government marks an essential step in its efforts to increase Myanmar's attractiveness as a destination for foreign investment.

Although the law has been officially approved and signed, the effective date has yet to be announced. Before that can happen, the government must first set up the necessary administrative bodies and prepare enabling legislation to support the new system. Once all of the pieces are in place, the application gates will open and the new system will come into effect. At that time, any trademark owners that have recorded their rights under the previous system will have to file new applications to ensure that their marks continue to be protected under the new law. Until further notice, new recordal applications, renewals of existing recordals and all other trademark declarations will still be accepted under the old system.

A brief overview of the salient features of the new Trademark Law, which is now the principal piece of legislation governing the protection of trademarks in Myanmar, is outlined below.

### Administrating Ministry

The core government ministry administrating the new Trademark Law is the Ministry of Commerce. Four other ministries—the Ministry of Information, the Ministry of Industry, the Ministry of Agriculture, Livestock and Irrigation, and the Ministry of Education—are named as having supervisory roles.

### Requirement to Re-file

Section 93(a) of the Trademark Law states that if trademark owners that have previously recorded their marks with the Office of Registration of Deeds (ORD) or have not recorded their marks but can provide evidence of actual use in Myanmar want to enjoy rights relating to their marks, they must apply for registration in accordance with the new law.

### Priority Rights for Existing Trademark Owners

Existing declarations of ownership should be submitted at the time of application, but the actual weight or value of such evidence remains unclear. If the mark was recorded with the ORD under the old system, the trademark owner should submit evidence of that recordation together with the trademark application under the new system for the registrar's examination.

### Actual Use of a Mark in the Market

If a trademark owner can prove actual use of its mark in the market, then the mark will be protected—irrespective of whether it is recorded at the ORD. The owner will enjoy priority rights for goods and services with such marks, within a specified period.

### Application Requirements

When filing a trademark application, the applicant must provide:

- ▶ a request for registration;
- ▶ the name and address of the applicant person or organization;
- ▶ a clear and complete description of the mark; and
- ▶ the name and types of goods or services for which registration is requested in accordance with international trademark classifications.

### Language of Application

Details of the trademark application can be submitted in either English or Burmese. However, the registrar can request a translation of either language.

### Multiple-class Applications

The availability of multiple-class applications is still unclear based on the wording of the law. This will likely be clarified in the forthcoming regulations.

### Term of Protection

Trademarks can be registered for 10 years and are perpetually renewable.

### Renewals

Trademark renewals must be filed within six months of the expiration date. Late renewals are possible, provided that they are filed within a six-month grace period after expiry.

### Paris Convention and World Trade Organization Priority

Priority claims are available six months from the filing or exhibition date.

### Madrid System

The Trademark Law sets out a provision that would make the Madrid System available, although Myanmar is not yet a signatory to the convention.

### IP Courts

The new law makes specific IP courts explicitly available, although implementation is subject to forthcoming regulations.

### Border Control Measures

Customs suspension orders are available and valid for six months.

### Examination Process

It appears that examination will be on formality requirements and absolute grounds of refusal only (eg, non-distinctiveness, direct descriptiveness, contrary to public morality and integrity or culture of the state, and genericism).

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## Opposition

Oppositions are allowed for the first 60 days from the date of publication. Oppositions can rely on relative grounds of refusal (eg, identical or similar to existing marks, unauthorised applications and bad faith).

## Appeals

Registry appeals can be filed within 60 days of the decision date. Further appeals can be filed with the court within 90 days of receipt of the registry's decision.

## Invalidation Actions

Invalidation actions can be lodged against registered marks. A limitation period of five years from the registration date applies, unless the claimant is relying on bad-faith claims.

## Non-use Cancellation Actions

If a registered trademark has not been used for three continuous years, it may become vulnerable to a cancellation action.

## Mediation Procedure

The availability of mediation procedures remains unclear. However, if one or more parties apply to register identical or similar marks on the same day, or for the same priority date, the registration officer will instruct all applicants to negotiate among themselves in order to determine the name of the applicant for the mark and to resubmit within a specified period.

## Geographical Identifications

Geographical identification rights can be applied for by:

- ▶ persons who produce goods from natural products or resources;
- ▶ producers of agricultural products;
- ▶ producers of handicraft or industrial products; and
- ▶ responsible persons from government departments and organizations representing the persons described in the previous three categories.

The term of protection will be extended provided that the special characteristics, qualities or reputation for which the mark has been allowed protection continue to exist.

## Licenses

Trademark licenses must be recorded.

## Trade Name

Trade name protection is available either as a part of a trademark or separately and will be protected with or without registration. There is no mandatory requirement for registration.

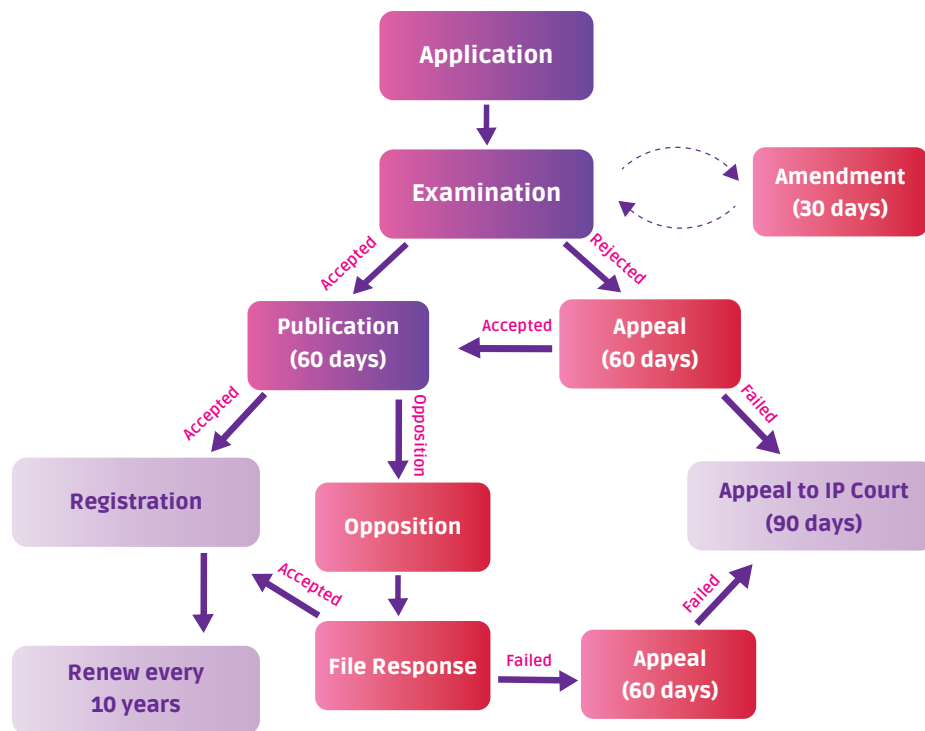
## Infringement

Civil and criminal actions are available to address infringement. Criminal penalties include up to 10 years' imprisonment (for repeat offenders) and a fine of up to MMK10 million (approximately USD6,500) (also for repeat offenders).

## Filing Procedure

The filing process will be more streamlined under the new Trademark Law than under the previous system and will be in line with international trademark registration standards, making it easier for both local and international IP owners to submit applications and obtain trademark protection. The general filing procedure is laid out in Figure 1.

Figure 1. General filing process



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### Next Steps for Trademark Owners

Although the procedure and administrative bodies for the new system are not yet in place, the new law lays out the documents and information required for registration. In advance of the law becoming effective, trademark owners can begin to compile and prepare:

- ▶ requests for registration;
- ▶ the name and address of the applicants for registration (or the representative's name and address, if submitted by a representative);
- ▶ clear and complete representations of the applied-for marks; and
- ▶ the names and types of goods and services requested for registration in accordance with international trademark classifications.

In addition to these required documents, the following information and documents should be provided, where applicable:

- ▶ the registration number, type, and country of origin of the entity, if the applicant is applying on behalf of a legal entity;
- ▶ documents supporting, describing, and requesting the claim of priority right, if the applicant requests such a right;
- ▶ documents supporting, describing, and requesting exhibition priority right, if the applicant requests such a right;
- ▶ a certificate of registration (declaration of ownership), if the applied-for mark is recorded at the ORD; and
- ▶ other requirements that may be set by a directorate that will be established to oversee trademark registration.

The documentary evidence to support new applications includes proof of existing records with the ORD. Although it is not yet clear what weight these will have during the trademark examination process, trademark

owners should audit their portfolios to ensure that their rights are recorded and up to date, in order to secure maximum leverage under the new system.

Similarly, the Trademark Law refers to providing evidence of use in order to support a trademark application. Therefore, trademark owners should begin to collate all evidence of existing use, including cautionary notices (which can still be published), advertisements, and office stationery.

For rights holders whose existing marks are subject to licensing arrangements in Myanmar, these agreements should also be audited and checked for up-to-date and accurate depictions of the relationship with franchisees and licensees, in order to avoid any ambiguities when evidencing use.

### Conclusion

Prior to the announcement of the new Trademark Law, revised IP legislation in Myanmar had been pending for a number of years. Although the announcement of the new legislation provides comfort and ease of mind to brand owners, there is still a long way to go before the law can come into effect. At present, the Ministry of Commerce is planning the required framework in order to support implementation of the law. Among other things, the framework includes the creation of an IP office at which filings and operational procedures will be centralized. Although the location of the office has yet to be determined, current plans suggest that it could be established between the start of the new fiscal year (October 2019) and the upcoming 2020 general election.

The Trademark Law is the first of a handful of new IP laws that will form the basis of Myanmar's reformed intellectual property system. An Industrial Design Law was also passed on January 30, 2019, followed by a new Patent Law signed into legislation on March 11, and a new Copyright Law on May 24, substantially expanding the rights of IP owners in the jurisdiction. These laws will help to build a robust IP landscape in Myanmar, which will prove to be instrumental in attracting higher numbers of foreign investors. 🍷

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## Indonesia Issues New Regulation on Patent Applications

On December 19, 2018, the Ministry of Law and Human Rights of the Republic of Indonesia (MOLHR) ratified Regulation No. 38 of 2018 on Patent Applications as an implementing regulation of Law No. 13 of 2016 Concerning Patents.

This regulation came into effect on December 28, 2018. It was presented to the public by the Directorate General of Intellectual Property (DGIP) on March 19, 2019, through a

local seminar organized by the Indonesian Intellectual Property Attorneys Association (AKHKI) and the DGIP.

This article summarizes the key changes, beneficial or otherwise, introduced by the new regulation.

### Simple patent applications based on the Patent Cooperation Treaty (PCT) application cannot be filed in Indonesia.

Before the enactment of the new regulation, applicants could file a simple patent application based on a PCT or a non-PCT application. However, under the new regulation, an application based on the PCT can only be filed as a patent application. Therefore the Patent Office is no longer accepting simple patent applications based on PCT applications and is only accepting simple patent applications based on non-PCT applications.

In addition, a patent application based on a PCT application cannot be converted into a simple patent application, according to the regulation. The conversion of a patent application into a simple patent and vice versa is only possible for applications based on non-PCT applications.

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