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Myanmar's New Trademark Law: What Foreign Business Owners Need to Know

The Myanmar Trademark Law 2019 was finally enacted on January 30, 2019. This is an important step in the government's efforts to attract foreign investment into Myanmar, as the new Trademark Law establishes a framework for a comprehensive trademark registration and protection system to both foreign and domestic trademark owners. In this article, we will address some of the common questions raised by foreign business owners in Myanmar.

1. What are trademarks?

Under the new Myanmar Trademark Law 2019, trademarks are defined as any visually perceptible sign that distinguishes the goods or services of one undertaking from those of other undertakings. This includes an individual's personal name, letters, numerals, graphical representations, and combinations of colors. Nevertheless, it is important to note that not all trademarks are registrable. For example, an application to register trademarks that are deemed to lack distinctiveness, or are directly descriptive of goods or services, will be refused. An application may also be rejected if the trademark is applied for in bad faith, or is identical or confusingly similar to a third party's trademark.

2. I have already registered my trademarks in my home country. Why do I need to file new applications in Myanmar?

Trademark rights are territorial in nature. This means that the ownership of a registered trademark in another country will not be sufficient for you to establish grounds for trademark infringement, if your trademark is used by an unauthorized third party in Myanmar. If you are using (or if you are planning to use) your trademark in Myanmar, it is highly recommended for trademark protection to be sought here. You may also wish to consult your trademark agent on the possibility of claiming the priority date of your foreign trademark applications in Myanmar.

3. I have already recorded my trademarks in Myanmar using statutory declarations in the past, and I have also published trademark notices in the Myanmar newspapers for many years. How does this new law affect me?

In accordance with the Myanmar Trademark Law 2019, trademark owners who have previously recorded their trademarks with the Office of Registration of Deeds are required to apply for registration under the new law in order to enjoy statutory trademark rights. Proof of existing

registrations under the old framework can be submitted at the time of application. In other words, upon the entry into force of the new law, existing trademark declarations and trademark notices will no longer be sufficient to demonstrate ownership of trademarks in Myanmar.

4. I am using the trademark under a license. Can I file an application for the trademark, too?

This will depend on the contractual arrangement between you and your trademark licensor. Nonetheless, the new Myanmar Trademark Law 2019 requires all trademark licenses to be recorded with the Trademark Office. If you are a trademark owner, it is important to note that all licenses granted should be recorded, as unrecorded trademark licenses will be deemed void under the law.

5. How do I file a trademark application under the new system?

Although the Myanmar Trademark Law 2019 has been officially approved and signed, the effective date has yet to be announced. The government is currently working on the establishment of administrative bodies and the drafting of implementing regulations to support the new system, aiming for completion by the end of the year. Meanwhile, the Myanmar Trademark Law 2019 requires the following for a trademark application:

- ▶ The application request in the form designated by the Trademark Office;
- ▶ The name and address of the applicant for registration (or the representative's name and address if submitted by a representative);
- ▶ A clear and complete representation of the trademark to be applied for; and
- ▶ A description of goods and/or services requested for registration in accordance with the stipulated international trademark classification. (This is expected to be the Nice International Classification, but is not yet finalized.)

In addition, the following 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 right;
- ▶ Documents supporting, describing, and requesting exhibition priority right, if the applicant requests such right;
- ▶ A certificate of registration (Declaration of Ownership), if the trademark has been recorded at the Myanmar Office of Registration of Deeds; and
- ▶ Other requirements that may be set from time to time by the Trademark Office.

6. I have a limited budget. Can I file applications by myself?

While this is not prohibited under the Myanmar Trademark Law 2019, it is expected that foreign applicants will have to appoint a local representative to file applications. This is a common practice in many jurisdictions, and will be further clarified through implementing regulations to be issued in due course. Assuming such rules are adopted, it will be necessary to seek professional assistance in submitting an application—which actually increases the likelihood of application approval anyway. An experienced trademark practitioner will be able to assist in building and maintaining your portfolio. This may include conducting pre-filing clearance checks, ensuring that the scope of goods and services applied for is appropriate so as to reduce the likelihood for an invalidation action based on

non-use, avoiding or arguing against the imposition of trademark disclaimers, the monitoring of third-party trademarks, the maintenance of deadlines, and more. A customized and well-designed trademark prosecution strategy will reduce or anticipate the possibility of costly objections, rejections, and third party oppositions—and is a more cost-effective option for trademark owners in the long run.

7. Since the law is not yet effective, what should I do in the meantime?

Pending the effective date of the new Myanmar Trademark Law 2019, you should begin collating all evidence of existing use of your trademark, including past trademark notices, advertisements, invoices, catalogues, office stationery, and other clear evidence of use of your trademark in Myanmar. It is important to ensure that all such materials are dated. For trademark owners whose existing marks are subject to licensing arrangements in Myanmar, these too should be audited and checked for up-to-date and accurate depictions of the relationship with licensees, to avoid any ambiguities when evidencing use.

Meanwhile, it is recommended that you continue maintaining your trademark registrations under the current recordal system, especially if the trademark in question has not been used in the course of trade in Myanmar. Similarly, trademark owners can continue to publish trademark notices in local newspapers.

The intellectual property rights protection framework in Myanmar is undergoing an overhaul, due to the recent enactment of the Myanmar Trademark Law 2019, alongside three other pieces of legislation—the Patents Law, the Industrial Designs Law, and the Copyright Law. Coming at a time when Myanmar’s government is in the process of opening the country to foreign investment and greater involvement from overseas businesses, this raft of legislation is an indicator of the government’s intention to create a fair, modernized system that will be welcoming to intellectual property owners. Investors and entrepreneurs should take note of these developments, which collectively are a positive sign of where the business environment in Myanmar may be headed.

For more information on protecting intellectual property in Myanmar, please contact Tilleke & Gibbins’ Yangon office at myanmar@tilleke.com.

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