

Bird & Bird ATMD

IP Update



Myanmar New Trade Mark Laws – Soft Opening of Online Filing System to commence in December 2019 / January 2020

November 2019

Existing rights holders should collate and prepare the necessary documents and  information for re-filing of all their marks during the Soft Opening in December 2019 / January 2020. Where there are amendments to the existing marks to be made, these should also be effected under current practice before the Soft Opening.

Rights holders who do not have existing registrations but are interested in protecting their brands in Myanmar should take immediate steps to register their marks under the current practice to qualify for re-filing during the Soft Opening. Otherwise, all new applications can only be filed after the Grand Opening in Q2 2020.

Further to our update earlier this year in April 2019 (linked [here](#)), a tentative date has been set for the Soft Opening launch of the new online filing system. Slated to commence in or around the second half of December 2019 to January 2020 (exact date to be confirmed), existing mark holders who have recorded their marks under the current system will be required to re-file their marks under the new system. In the absence of undertaking this step to re-file their existing marks, mark holders will lose out on an early filing date and will only be able to file new applications under the new filing system after the Grand Opening, estimated to commence around Q2 2020.

Refiling during Soft Opening - Existing rights holders

The Soft Opening period will run for a period of 6 months. During this period, existing mark holders who have previously registered their marks with the Registry of Deeds may re-file their marks in the new online system to ensure that the existing rights continue to be protected.

Requirements for re-filing

A local Myanmar agent must be appointed to assist with the re-filing. Existing owners of registrations under the current system who wish to refile their marks under the Soft Opening period will need to prepare the following:

- 1 Clear specimen of the proposed mark (as recorded in the Declaration of Ownership);
- 2 Owner's name and address (as recorded in the Declaration of Ownership);
- 3 Classes and list of goods and services (as recorded in the Declaration of Ownership);
- 4 Claim of priority and supporting documents;
- 5 Colour claim (if any);

6 Scanned copy of the recorded Declaration of Ownership and/or Renewal with the Registry of Deeds; and

7 Evidence of use and the date of first use in Myanmar (if the mark has been put to use).

The re-filed marks will undergo substantive examination once the New Laws are effective. Pending the issuance of the Trademark Rules, it is still unclear at the moment how the Myanmar Department of Intellectual Property will decide in determining competing claims between 2 or more similar re-filed marks.

That said, under the New Laws, actual use of a mark in Myanmar will continue to assist existing right holders to gain priority over those who do not have such use in Myanmar. Whether the published Cautionary Notice will suffice as use or an *intention* to use the mark in Myanmar is not clear at the moment although the Trademark Rules (once issued) are expected to provide clarity on this point.

While the official fees have not been released yet, interested registrants are recommended to buffer around USD300 per mark to re-file once the Soft Opening commences. Please note that this estimate excludes official fees that will be payable to the Myanmar Department of Intellectual Property.

Grand Opening – New applications

New applicants who do not have existing registered rights under the current system can only file fresh applications after the Grand Opening, expected to commence Q2 2020. In addition, amendments to trademarks can also only be filed after the Grand Opening, such as recordal of name/address change, assignment of marks and so forth.

If you wish to register your new marks, please let us know and we will advise further.

Summary

Existing mark holders should:

- Start to compile the relevant documents/information required to prepare for re-filing during the Soft Opening;
- Commence use in Myanmar sooner than later to gain priority over other similar marks that have not been put to use, and collate such evidence of use; and
- Record amendments (such as name/address change, assignment of marks) under the current system before the Soft Opening bearing in mind that details of the re-filed mark must mirror that of the registered mark under the current system; otherwise, the mark can only be filed as a new application during the Grand Opening.

Rights holders who do not have registered rights under the current system and who are contemplating whether to expand or operate in Myanmar are strongly recommended to file their mark(s) under the current system as soon as possible in order to qualify for re-filing once the Soft Opening is launched.

As always, we will continue to monitor further developments and provide updates when these are available. Please feel free to contact us at our contact details below if you have any questions regarding filing or re-filing in Myanmar.

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