

# Bird & Bird ATMD & Further Update on New Trade Mark Laws in Myanmar

January 2019

*The new Myanmar trademark laws ("New Law") have been passed by the Upper and Lower House of Myanmar Parliament and is currently pending the President's approval. However, filing of new trademark applications are expected to be delayed even after the New Law is in force, pending the establishment of the Myanmar IP Office. There will likely be a transitional period for existing trademark owners to re-file their marks, although the exact nature of the rights during this period remains uncertain at this time.*

## Upcoming New Trademark Regime

Since our last update in July 2018 (click [here](#) to view the previous update), there have been several developments as outlined below:

- **15 February 2018** – Upper House of Myanmar Parliament passes Trademark and Geographical Indication Bill ("New Law"). Under the New Law, inter alia, a trademark filing and registration system and the Myanmar IP Office ("MIPO") will be established (see below for further details).
- **1 October 2018** – The new Myanmar Registration Act prescribes that (a) filed documents must be in the Myanmar language; and (b) if they are not in the Myanmar language, these must be submitted together with a translation of the filed documents with a certification from a Myanmar Notary Public. This new law will result in additional cost incurred to attend to the translation and certification requirements. There is no requirement to re-sign the existing Declaration of Ownership ("DOO") documents that are not in Myanmar language.

- **12 December 2018** – Lower House of Myanmar Parliament passes the New Law.

The New Law is currently pending approval and comments by the President. It is likely that the President will approve the New Law and its enactment may take place within first quarter of 2019. In the interim, the current laws and 'registration' system (including submission of documents to the Registry of Deeds) will continue to be accepted.

**Further delays expected.** It is likely that even after the New Law is in force, there will be further delays pending the establishment of the MIPO and the registration system to be in place before new trademark applications can be filed. It is not clear as yet what the costs involved will be.



## New Law

### Some of the features of the New Law include:

- First-to-file system with substantive examination of trademark applications based on absolute and relative grounds: *Filing → Publication for Opposition → Registration*
  - Priority claims, series marks applications and multi-class applications will be accepted.
  - Documents can be filed in either the English or Myanmar language.
  - Aside from trademarks, recognition of collective and certification marks, 3D marks (shapes and packaging), Geographical Indications.
  - Provisions will be in place to protect well-known marks.
- Opposition, cancellation and invalidation actions available.
  - Term of protection is 10 years, subject to further periods of 10 years upon payment of renewal fees. The MIPO will issue registration certificates.
  - Licence agreements will likely need to be recorded.
  - Administrative (customs) and criminal action.
  - Higher penalties for infringement cases.
  - Specialised IP Court to handle IP disputes.

### [For existing trademark owners seeking protection under the New Law](#)

Existing trademark owners will be required to re-file under the new system and the transitional period for re-filing will likely be around 3-6 months.

### The documents required for re-filing are:

- Completed application form provided by MIPO
- Original duly recorded DOO from Registry of Deeds
- Evidence of use may also be required such as photo of the product/shop in Myanmar market or customs clearance



## Recommendations (as at 24 January 2019 until the New Law is enacted or until there is further clarity)

**Trademark owners should consider and take active steps towards the following:**

### *Trademarks*

**Review their existing Myanmar trade mark portfolio;** evaluate budget and key marks for re-filing (there is no clarity to the official fees for re-filing at the moment).

**Continue to re-publish cautionary notices at 3-year intervals** as safeguard against non-use cancellation actions (available under the New Law)

**For re-filing purposes:**

- **Compile all original duly recorded Declaration of Ownership documents from Registry of Deeds and all original/copies of the published Cautionary Notices.**
- **Collate evidence of use of the marks in Myanmar (such as photographs, labels, invoices etc.).**
- **If there are changes in the names or addresses of the trademark owners, to record and republish as Cautionary Notices to ensure accuracy of the original Declaration of Ownership documents.**
- **For priority claims, compile certified or notarised trademark applications and translations (where applicable).**

**Where marks have not been put to use**, to start using the existing marks in Myanmar as soon as possible as (a) the current regime accords priority to marks that have been put to use in Myanmar; and (b) trademark owners may be required to show evidence of use under the New Law.

**To guard against third party infringers and squatters**, consider filing transliterations for key brands in the local language, as this is a commonly used tactic by third parties attempting to pass off established international or foreign brands.

### *Commercial agreements*

Earmark existing distribution/licencing agreements as these will likely need to be formally recorded with the Registry.

Recordal of trademark registrations with the Myanmar Customs Department (MCD) so that owners can inform MCD of importation of counterfeits, and MCD can detain suspected counterfeits.

### *To file new trademark applications now or wait for the new registration system?*

As there is no further clarity to the transitional provisions and the New Law, trademark owners should continue as per normal (i.e. to file and submit notarised and legalised Declaration of Ownership and Power of Attorney documents to the Registry of Deeds) to ensure that they are well positioned once the New Law takes effect.

*This article is produced by our Singapore office, Bird & Bird ATMD LLP, and does not constitute legal advice. It is intended to provide general information only. Please contact our lawyers if you have any specific queries.*

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