

# Bird & Bird ATMD

## IP Update



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

*December 2019*

Further to our earlier note on the upcoming Soft Opening in November 2019 (linked [here](#)), we are writing to provide further updates below obtained from various Myanmar sources<sup>1</sup>.

### 1. Current Registration System

The Ministry will announce a final date for registration of marks under the current system at the Registry of Deeds. Marks registered before this deadline will be deemed as existing registrations that may be accepted for re-filing (see further below). Marks registered after this deadline will not be accepted for re-filing during the Soft Opening period.

As a scanned and stamped Declaration of Ownership is required for submission during re-filing, it appears that a pending mark under the current registration system will not qualify for re-filing. Only registered marks with stamped Declaration of Ownerships will be accepted.

Pending the final date announced by the Ministry, **it is imperative that applicants who have not registered their marks under the current system do so as soon as possible**, unless there has been actual use of the mark in Myanmar (see further below).

### 2. Soft Opening Date

The Soft Opening will likely commence on a date between 19 December 2019 to the first week of January 2020, at the latest. The Soft Opening will run for 6 months from the starting date.

### 3. Marks to filed or re-filed during Soft Opening

All registered Declaration of Ownerships under the current system will no longer be valid once the New Law comes into effect. Previously registered Declaration of Ownerships will need to be re-filed under the new system for existing trademark owners to enjoy continued protection over their marks.

The following 2 categories of marks will be accepted for re-filing during Soft Opening:

- (a) Trademarks registered at the Registry of Deeds under the current system; and
- (b) Trademarks that have not been registered at the Registry of Deeds **but have been put to actual use in Myanmar**.

In other words, if you have not registered your mark but have continuously used it in Myanmar, you will be eligible to file during Soft Opening.

Mark owners whose marks do not fall within either category above can only file their applications when Grand Opening commences.

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<sup>1</sup> Please note that the information provided reflects our understanding based on our research and discussions with Myanmar counsel and related sources. Whilst we have tried to provide accurate information, we trust that you understand that the actual position may change depending on the information made available, from time to time.

## 4. Filing date of Soft Opening applications

Accepted marks filed during the Soft Opening, whether filed on the first or last day of the Soft Opening period, will be accorded the same filing date, i.e. the date of the Grand Opening. The filing date of existing registrations under the current system will no longer apply or be considered.

On this basis, it appears that applicants do not need to rush to file or re-file their marks on the first day of Soft Opening since the actual date of re-filing (during the Soft Opening) appears to be inconsequential to the accepted application's assigned filing date.

## 5. Filing basis

It appears that there may be 2 filing basis for applicants to select at the point of filing, namely "Intent to Use" and "Actual Use". If the latter is selected, the applicant will need to submit evidence of actual use in order to claim a priority right as to use. However, it is not clear whether this option is available in the course of re-filing at Soft Opening or new filings during the Grand Opening.

## 6. Scope of re-filed marks

The re-filed marks should mirror the existing registrations. Nonetheless, it is possible to restrict (but not expand) the scope of the goods and services claimed under the re-filed mark. An expanded claim will be deemed a new trademark application, which will not be accepted during Soft Opening and can only be filed during Grand Opening.

It is not clear at the moment whether series marks will be accepted. However, if series marks are not accepted under the new system, it will still be possible for applicants to rely on the existing Declaration of Ownership and select the preferred representation for re-filing.

## 7. Power of Attorney

A Power of Attorney (PoA) will be required for filing during Soft Opening. Under the current system, a notarised and legalised PoA is required. It appears that this previously notarised and legalised PoA will be acceptable for re-filing, provided that the PoA was not granted for a limited purpose and if the notarisation is still valid.

Otherwise, a fresh PoA will need to be executed as part of the filing requirements. Although unconfirmed, the PoA requirements may only need to be notarised. However to buffer sufficient time to attend to pre-filing matters, we recommend assuming that legalisation up to the Myanmar embassy of the applicant's home country will still be required.

## 8. Examination of applications

Based on our current understanding, Soft Opening is intended to be an administrative period where the Registry will accept and collate the necessary paperwork accompanying the filings and re-filings.

Actual examination of all Soft Opening filings will take place during Grand Opening. The Registry will examine applications for formality requirements and absolute grounds before publishing for opposition purposes.

If opposed or in the event of a similar mark conflict, the Registry will conduct substantive examination of the applied mark against any prior rights. Prior rights may in turn be assessed and priority accorded based on the party that has earlier use of their mark(s).

## 9. What amounts to "use" of the mark in Myanmar

Guidelines relating to "use" will be set out in the Trademark Rules, which to-date, have not been issued. We believe that these should not stray too far from traditional forms of evidence of use such as invoices, sales vouchers, agreements, import licences, shipping and clearance documents, receipts, catalogues, brochures and pamphlets, photographs showing the use of the mark on goods/labels/shopfronts, FDA certificates, promotional activities such as advertisements, marketing peripherals and so forth.

It would also be helpful if the evidence of use bears the date of first use or a date to support such use.

Whether an 'international' website (e.g. gTLDs such as ".com") that can be accessed by Myanmar users will amount to "use" in this regard is not clear at the moment. However, the emphasis appears to be **actual use in Myanmar**. We believe that there should be further clarity when the Trademark Rules are issued.

There is some indication that Cautionary Notices may be accepted as evidence of use or at least, evidence of intent to use. However, it remains to be seen how much weight the Registry will give to Cautionary Notice-type evidence in the event of a conflict between 2 or more similar marks. If supporting evidence of actual use is submitted, we believe this would trump the Cautionary Notice-type evidence. However in the absence of any evidence of use by either party, a Cautionary Notice may possibly lend some support towards a priority right. We therefore suggest providing these for the Soft Opening.<sup>2</sup>

## 10. Fees

We have been made to understand that official fees will only be released sometime in the 5th month of Soft Opening (or sometime in May 2020) as the pricing structure is currently pending the President's approval.

Local Myanmar attorneys have therefore indicated their preference to wait for the release of the official fees before announcing their own professional fees.

The Myanmar Trademark Office will issue filing dates (i.e. first day of Grand Opening) and filing numbers on the first day of the Grand Opening to accepted applications *that have also duly paid the stipulated fees*.

It would therefore appear that Soft Opening applicants will have around 1 months' time between the announcement of official fees till Grand Opening to ensure that fees are paid so as not to jeopardise their Soft Opening applications.

While there continues to be no visibility on the official or Myanmar attorneys' professional fees until the 5th month of Soft Opening, we are given to understand that the official fees will likely be charged on a per mark, per class basis. Professional fees will likely follow the same structure (as opposed to the one official fee pricing structure at the moment regardless of the number of classes) and for budgeting purposes, you may wish to budget around USD300 to USD500<sup>3</sup> per mark per class in professional fees, excluding the Trademark Office's official fees.

As always, we will provide further updates as and when these are available. Please feel free to contact us at our contact details below if you have any questions.

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<sup>2</sup> Where you have published Cautionary Notices more than once over a period of time, we suggest you submit copies of all these Cautionary Notice, if available.

<sup>3</sup> The fee structure can only be confirmed once we the official fees are released.