



Trademark Registration in Myanmar

Introduction

Myanmar is one of the original members the General Agreement on Tariffs and Trade, now known as the World Trade Organisation (WTO), and the World Intellectual Property Organization (WIPO). Under the Agreement Establishing the World Trade Organization, Myanmar, as a member state, is also a party to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). WIPO has a cooperation agreement with the WTO to extend legal and technical assistance to countries in the implementation of the TRIPS Agreement, which applies to all WTO members including Myanmar. As such, Myanmar has, in the past, sought WIPO's assistance in the drafting of effective Intellectual Property (IP) laws for the protection of IP rights, and as a result, Myanmar enacted the Trademark Law, Copyright Law, Patent Law and Industrial Design Law in 2019. However, as of 2023, only the Trademark Law has come into effect.

Old Trademark Protection in Myanmar

Previously, there was no specific or substantive law concerning trademark in Myanmar. Despite the absence of trademark laws, the Penal Code, the Registration Law, the Specific Relief Act, the Myanmar Merchandise Marks Act and the Sea Customs Act could have been used to settle trademark disputes via civil or criminal action. Among them, trademark registration under the Registration Law was a common method for seeking trademark protection. Under the aforementioned

law, a proprietor needed to register his trademark by way of a Declaration Deed, in conformity with the existing laws, to own the mark. The mark itself was registrable at the Registration of Deeds Office. This was needed to obtain the legal ownership of the mark. After registering a trademark, a Trademark Cautionary Notice would have been announced in daily newspapers to notify the public of the proprietorship of the mark. Trademark registration was not compulsory, nor was it conclusive proof of the proprietorship of the mark. Nevertheless, the registration gave evidential value for determining the ownership of the mark, constituting prima facie evidence in case of a criminal or civil proceeding.

Under the old system, unregistered marks were protected provided their owners could prove their actual use in commerce. Therefore, an unregistered mark could prevail over a registered mark if the owner of the unregistered mark proves that its use predates the use of the registered mark.

Myanmar's New Trademark Law

The Trademark Law, which came into effect on 1 April 2023 with Notification No. 82/2023, was enacted by the Pyidaungsu Hluttaw (Parliament) on 30 January 2019. It is the first official trademark law to exist in Myanmar. Under the new Trademark Law, a "Mark" means any visible mark, (which includes names, letters, numbers, illustrated parts, or combinations of colors, or one such mark combined with another), with a purpose to distinguish a particular good or service from other goods or services. This includes trademarks, service marks, collective marks and certification marks.¹ The new Trademark Law protects registered marks, well-known marks both registered and unregistered, registered geographical indications, and registered/unregistered trading names within Myanmar. In addition, the new system reflects the "first-to-file" method, which gives priority to the first party to register its trademark. Therefore, registered trademarks have a presumption of validity over unregistered trademarks. It can be said that the new Trademark Law establishes a comprehensive trademark registration and protection system that will greatly benefit trademark owners.

New Trademark Registration System

Under the Trademark Law, the Department of Intellectual Property (**DIP**), was formed to handle intellectual property matters, including trademark registration and protection. The DIP has the responsibility for registering trademarks and other marks recognised under the Trademark Law. Those with previously registered trademarks can re-register their trademarks for protection under the new Trademark Law since their former registered trademarks are not automatically re-registered. They may only receive priority right to use them if they re-register their trademarks.

An inspection officer will review applications according to the new criteria set by the Trademark Law, and a registration officer will issue registration certificates to the applicants. Marks that lack distinctiveness or those that may infringe the intellectual property rights of others will not be registrable under the new system.

Opening of Electronic Trademark Filing System in Myanmar

On 28 August 2020, the Ministry of Commerce (**MOC**) issued Order No. 63/2020 on registration, in line with the new trademark law, and set the start date of the electronic filing system for 1 October 2020. The Department of Intellectual Property (**DIP**), under the MOC, initiated a soft-opening process in the first phase. The new Trademark Law mainly proposed to change the registration system from “first-to-use” to “first-to-file”. According to the new electronic filing system, trademark owners who had previously registered with a Declaration of Ownership at the Registration of Deeds Office or who could prove the use of the trademark in the Myanmar market, despite it not being registered, will need re-register their trademarks under the new online filing system.

The trademark owners may apply to file the trademark registration on the new online filing system prescribed by the Department of Consumer Affairs on their own or via service firms or law firms. Nonetheless, the “new” trademark and its underlying goods or services will need to be the same as the “old” trademark, which had been previously registered. The underlying goods or services of the trademark will also need to be described in detail, using the international classification – Nice Classification, when filling the application. The registration fees and the methods of payment were announced independently on 1 April 2023, after the issuance of notification for the enforcement of the Trademark Law.

The following may be submitted as evidence for the sole ownership or proprietorship of trademarks in Myanmar:

- a trademark that was previously registered at the Registration of Deeds Office;
- a registration certificate issued by the Registration of Deeds Office (Certified Copy);
- evidence of a trademark cautionary notice announced in public newspapers;
- evidence of real use of the trademark in the Myanmar market;
- evidence of an advertisement of the trademark for sales promotion in the Myanmar market;

- a tax receipt or payment receipt; and
- evidence of the transfer of a trademark, owner's right or name change of trademark if the applicant is not the trademark owner who previously registered at the Registration of Deeds Office.²

Current Situation of Electronic Trademark Filing

On 1 April 2023, the MOC released Announcement No. 1/2023, which follows Order No. 63/2023, for the second phase registration, and on the 26th of the same month, the new trademark registration system, launched under the supervision of the DIP, began accepting registrations. During this phase, only existing trademark registrations may be applied for either by a mark's owner, in person or by his/her agent, at the DIP's head office (Nay Pyi Taw) or the branch office (Yangon), or through the online electronic trademark filing.³

The DIP plans to issue notifications and announcements with relation to the trademark registration, based on the situation of the electronic filing system and requirements of the applicants in order to facilitate the application process .

Conclusion

The establishment of a comprehensive trademark registration and protection system under the New Trademark Law, allows the trademark owners or brand owners to have their intellectual property rights when conducting businesses in Myanmar. However, the limited experience of local IP courts in handling trademark disputes could potentially pose obstacles to proprietors in fully exercising their IP rights.

[1] Section 2 (k) of the Trademark Law

[2] Order No. 63/2020 of the Ministry of Commerce

[3] https://api.ipd.gov.mm/content/_pdf_1680289817244.pdf

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