

Myanmar is about to implement a modern Trademark Registration System

Myanmar's new Trademark Law, which was enacted on 30 January 2019, establishes the framework for a comprehensive trademark registration and protection system. This is an important step taken by the government in its efforts to attract foreign investments and is relevant to both foreign and domestic trademark owners.

Trademark owners should review their portfolio in light of these significant legal changes.

What is the current situation?

Currently, trademark protection in Myanmar can be obtained by filing a Declaration of Ownership (DOO) at the Registry of Deeds and publishing the trademark via a Cautionary Notice in a Myanmar newspaper. Although not mandatory, it is recommended to renew a Myanmar trademark every three years (whereas trademark protection in most other countries is granted for ten years). Renewal can be done by way of re-registration once every three years, by way of re-publication only, or by way of both re-registration and re-publication.

It is generally advisable to renew via re-registration and re-publication in order to fully safeguard the trademark rights of a trademark owner in Myanmar and to ensure that the registers are up to date.

What will change?

It has been announced that Myanmar will implement its trademark registration system in two phases, commencing in January 2020.

In the first phase, which is expected to last six months, all trademarks registered under the current system may be re-filed under the new system, allowing such trademarks to claim seniority rights (meaning that in the event of a dispute, they prevail against trademarks which have been filed at a later point in time).

Applicants who have not registered their trademarks and filed a DOO under the current system may still be able to do so now.

Aside from trademarks that are currently registered, trademarks which have been put to actual use in Myanmar (without any registration) will also be accepted for re-filing.

So far, there are no clear guidelines on what constitutes the "use" of a trademark in Myanmar. Generally, it refers to the use of the trademark in the course of commercial activities such as placing the sign on invoices, sales vouchers, agreements, import licenses, catalogues, brochures, advertisement materials, marketing and promotional activities etc.

In the second phase (likely from July 2020 onwards), new trademarks may be filed under the new system.

What will be the Filing Date and Scope of Protection?

It seems that all trademarks filed within the first phase (the so-called "soft opening period") will be accorded the same filing date, being the date falling on the last day of the soft opening period (the so-called "grand opening date"). It should therefore not matter whether a trademark is re-filed on the first or last day of the soft opening period. However, an early re-filing is recommended to avoid any unpleasant surprises arising from unexpected delays.

The scope of protection for the re-filed marks is the same as the scope of protection under the existing registration. It is, however, possible to restrict or limit the scope of the goods and services to which the re-filed mark applies.

Once the soft opening period ends, the Registry will examine all re-filing applications and verify whether all formality requirements are met and that no absolute grounds of refusal exist before the trademark is published for opposition purposes.

Which documents are required?

For trademark registrations, the following documents will be required:

- (i) An original (legalized) Power of Attorney
- (ii) A description of the goods and services for which the trademark shall enjoy protection
- (iii) A clear representation of the trademark
- (iv) A certified copy of the priority document, if priority is claimed
- (v) Fees (details are still unclear)

What should trademark owners be aware of?

A trademark that is currently protected by way of a DOO can only be refiled under the new system in the way it is currently registered. If it shall be registered, e.g., in a different name (for example if the trademark is currently registered under a subsidiary or related company's name but shall actually be registered in the holding company's name), a record of the assignment or transfer of the ownership needs to be lodged. It is important to do so prior to filing the new application because the earlier registration and the later trademark application must be under the same owner in order to claim seniority rights.

After the six-months soft-opening period for refiling under the new system has expired, a trademark owner will no longer be allowed to convert its DOO into a registered trademark under the new regime. Such DOO will only remain effective for a certain time and is deemed unusable thereafter.

Myanmar is on its way to establish a modern intellectual property regime. Although some details are yet to be agreed upon (e.g. the fees), an important milestone has been achieved in order to bring Myanmar's trademark law and registration system in line with international standards.

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