

Myanmar Trademark Law - Commencement of Implementation - Registration to be Required for All Trademarks -

Enactment of the First Trademark Law in Myanmar

From October 1, 2020, current trademark users can file a priority application to register their trademarks under the newly introduced Trademark Law.

After a lengthy period with no trademark law in Myanmar, the Trademark Law was passed by Parliament on January 30, 2019, and is due to officially come into force by 2021. Prior to the official enactment, the Myanmar Intellectual Property Office (“MIPO”) commenced a “soft opening” of its operations on October 1, 2020, which enables current trademark users to file priority applications for registration.

In Myanmar, trademarks have been protected to a certain extent under customary laws as well as the Registration Act that stipulates the registration system for documents. However, all trademarks must now be registered to be protected under the Trademark Law. It is to be noted that any existing rights for trademarks will be void if trademark users fail to apply for registration with the MIPO.

Overview of the trademark protection under the current system and protection under the Trademark Law

	Trademark Protection System BEFORE the enactment of the Trademark Law	Trademark Protection System AFTER the enactment of the Trademark Law
Overview of Procedures	(i) Registration at the Office of Registration of Deeds (“ORD”) and (ii) Placement of “trademark caution” in newspapers, are both required.	It is necessary to register with the MIPO, a department which will be established as a department of the Ministry of Commerce.
Registration System	There is no unified registration system. Information is available only through “trademark cautions” in newspapers.	There will be a unified registration system, which enables registration searches.
Legal Basis and Provisions	There is no explicit law on which trademark rights can be based upon. The procedures are taken based on the Registration Act, which prescribes the registrations of general documents, and relevant customary laws.	The Trademark Law and the relevant rules thereof explicitly protect trademark rights.
Remarks	The protection under the current system will be lost due to the enactment of the Trademark Law. It will be necessary to apply for registration under the Trademark Law to be protected (see the column on the right).	There are two types of registration: Priority Application and Normal Application (see the table on the next page).

Priority Application and Normal Application

The Trademark Law allows for a Priority Application for those who have already been using trademarks in Myanmar to secure their protection.

Although there is no limitation on the types of evidence of current use of trademarks, registration with the ORD and placement of “trademark caution” in newspapers can be strong evidence of such use.

Overview of Priority Application and Normal Application

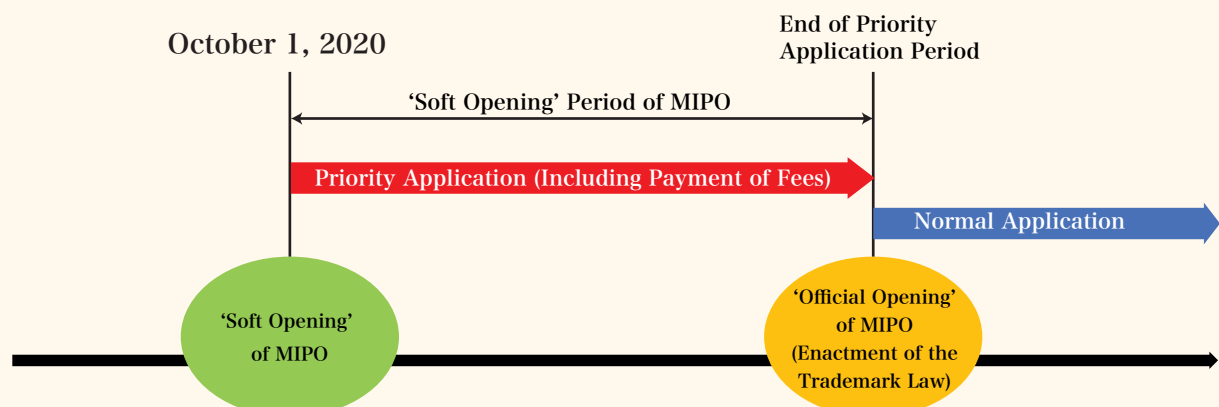
	Priority Application	Normal Application
When to Apply	Application is required to be filed within the period starting from the “soft opening” of the MIPO (i.e. October 1, 2020) until the “official opening” of the MIPO.	After the “official opening” of the MIPO.
Conditions for Application	An application must be submitted with the evidence of use (in general, registration with the ORD and a “trademark caution” in newspapers). *The evidence of use should be from before the date of enactment of the Trademark Law.	No need to submit evidence of use, unlike the case for the Priority Application.

Overview of Superiority of Priority Application and Normal Application

The Superiority of Multiple Applications filed for an Identical Trademark	
If both are priority applications	Priority will be determined based on the date of the evidence of use: The applicant who has evidence showing earlier use of the trademark will be entitled to register the trademark.
If both are normal applications	Priority will be determined based on the filing date: The applicant who has filed their application earlier will be entitled to register the trademark.
If one is a priority application and the other is a normal application	Priority will be given to the priority application. The date of use of the trademark (priority application) and the filing date of the trademark (normal application) will be compared, and the priority will always be given to the priority application since the evidence of the use of a trademark for the priority application must be prior to the date of enactment of the Trademark Law.

Schedule for Trademark Registrations

The MIPO commenced the “soft opening” on October 1, 2020, and current trademark users are now able to file a Priority Application. (Priority Application is a temporary measure during the “soft opening” until the “official opening” of the MIPO, i.e. the official enactment of the Trademark Law.) The evidence of use of a trademark for the Priority Application is limited to those prior to the enactment of the Trademark Law.



Recommendations

- **If a trademark user has completed the procedures for trademark protection under the current system (i.e. (i) registration with the ORD and (ii) placing a trademark caution in newspapers)**

In this case, it is necessary to file a Priority Application promptly. If the original user of the trademark fails to file a Priority Application or pay the application fees by the “official opening” of the MIPO, it will become impossible to claim a priority right based on the fact of having used the trademark.

- **If no action has been taken for trademark protection under the current system:**

Collecting as much evidence of previous use of the trademark and filing a Priority Application could be a possible solution. The evidence of trademark use, in this case, is not as convincing as the case where the procedures for trademark protection have been taken under the current system (i.e., (i) registration with the ORD, and (ii) placing a trademark caution). However, the fact of use of a trademark will be determined by conducting a comprehensive evaluation of the provided evidence, and it is, therefore, necessary to collect and submit convincing evidence to the extent possible. Examples of such evidence include invoices, receipts, brochures, and advertisements, containing the trademark along with relevant dates.

In addition, it is highly likely that the procedures for trademark protection under the current system (i.e. (i) registration with the ORD, and (ii) placing a trademark caution) can serve as evidence for a successful Priority Application, if such procedures were taken prior to the enactment of the Trademark Law. Therefore, taking these procedures under the current system can be an option for trademark owners if they have not yet initiated the procedures.

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