

## **The Trademark Right Law**

The Pyidaungsu Hluttaw Law No.3, 2019

The 10<sup>th</sup> Waning Day of Pyatho, 1380 M.E

January 30, 2019

The Pyidaungsu Hluttaw (Union Parliament) hereby enacts this Law.

### **Chapter (1) Title, Effectiveness and Definitions**

1.
  - (a) This Law shall be called the “Trademark Right Law”.
  - (b) This Law shall come into force on the date that the President of the Union may, by notification, appoint for such purpose.
  
2. The following terms contained in this Law shall have the meanings given hereunder:
  - (a) “Union” means the Republic of the Union of Myanmar.
  - (b) “Central Committee” means the Central Committee of Intellectual Property Rights formed under this Law.
  - (c) “Ministry” means the Ministry of Commerce under the Union Government.
  - (d) “Relevant Ministry” means the Ministry of Information, the Ministry of Industry, the Ministry of Agriculture, Livestock and Irrigation, or the Ministry of Education under the Union Government.

- (e) “Agency” means the Agency of Intellectual Property Rights formed under this Law.
- (f) “Department” means the Department assigned by the Ministry to carry out tasks relating to Intellectual Property Rights.
- (g) “Registrar” means the Director General of the Department that undertakes tasks relating to the registration of Intellectual Property Rights.
- (h) “Examiner” means the officer, whose rank is assistant director or above, of the Department that carries out the examination process for the registration of Intellectual Property Rights.
- (i) “Intellectual Property Rights” means the rights granted by law for the protection of intellectual property. The term “Intellectual Property Rights” includes copyrights, patents, industrial design rights, trademark rights, and any other kind of intellectual property rights.
- (j) “Mark” means any visible sign that is capable of distinguishing the goods and services of a business from those of another, including personal names, letters, numerals, and figurative elements, combinations of colors, or any combination thereof. This term includes Trademarks, Service Marks, Collective Marks, and Certification Marks.
- (k) “Trademark” means any mark that is capable of distinguishing the goods dealt by a person in the course of trade from the goods so dealt by any other person.

- (l) “Service Mark” means any mark that is capable of distinguishing the services provided by a person in the course of provision of services from the services so provided by any other person.
- (m) “Collective Mark” means any mark owned by an organization (such as organizations or associations consisting of industrial entrepreneurs, manufacturers, or traders), socio-economic organizations, or cooperative societies. This term includes any mark that is capable of distinguishing the goods or services of members of such organization from any other goods or services.
- (n) “Certification Mark” means any mark certified by the Owner of a Mark to be used under its control in relation to the origin, quality, type, or other characteristics of goods and services.
- (o) “Geographical Indication” means a sign that identifies goods as originating in a country, or in a region or locality in that country, where a given quality, reputation, or other characteristic of the goods is essentially attributable to their geographical origin.
- (p) “Well-Known Mark” means any mark that is well known in the Union in accordance with the specified standards.
- (q) “Trade Name” means a name or denomination that is capable of distinguishing a trading business from any other trading business.
- (r) “Owner of a Mark” means any person or legal entity whose name is entered and recognized as the registered owner of a Mark in the Register of the Department.

- (s) “Right Holder” means the Owner of a Mark, the owner of a Well-Known Mark, the owner of a Geographical Indication, the owner of a Trade Name, the transferee of a registered Trademark right, or any individual person or legal entity that is authorized as a licensee to enjoy the rights of a registered Trademark.
- (t) “Member Country” means any country that is a member of intellectual property conventions, treaties, or agreements or the related international or regional organizations to or of which the Union is a party or a member.
- (u) “Intellectual Property Rights Court” means the court established by the Supreme Court of the Union under the law to adjudicate matters of Intellectual Property Rights or the court vested with the jurisdictional power or authority of such court.
- (v) “Right of Priority” means the priority right contained in Section 31.
- (w) “Exhibition Priority Right” means the Priority Right of Exhibition of Goods contained in Section 32.

### **Chapter (2) Objectives**

- 3. The objectives of this Law are as follows:
  - (a) to promote investment, trade, and commercial transactions by protecting marks;
  - (b) to protect the interests of Owners of Marks and Right Holders;

- (c) to create a fair competitive market system by preventing goods with counterfeit marks or counterfeit goods from entering the market and to create a safe environment for the public;
- (d) to enhance the quality of the domestic products of the Union by protecting Geographical Indications and to encourage the development of the socioeconomic life of local communities through entering the international market.

### **Chapter (3) Formation and Functions of the Central Committee**

#### 4. The Union Government

- (a) shall form the following Central Committee of Intellectual Property Rights to supervise functions concerning Intellectual Property Rights:
  - i. the Vice President Chairman
  - ii. Union Minister of the Ministry  
Deputy Chairman
  - iii. Deputy Ministers of relevant ministries Member
  - iv. Deputy Ministers or Directors-General of  
other suitable ministries Member
  - v. Experts in intellectual property Member  
(not exceeding four persons)
  - vi. Two representatives of non-governmental  
organizations Member
  - vii. Person appointed by the President Secretary

viii. Director General of the Department

Joint

Secretary

- (b) The Central Committee formed under Subsection (a) may be reformed as necessary.

5. The functions of the Central Committee are as follows:

- (a) Adopting policies, strategies, and action plans relating to Intellectual Property Rights in order to properly develop functions concerning Intellectual Property Rights in the Union;
- (b) Supervising the implementation of the policies, strategies, and action plans relating to Intellectual Property Rights;
- (c) Providing guidance in order to promote and encourage the development of the economy of the Union, foreign investment, and small- and medium-scale enterprises via the Intellectual Property Rights protection system;
- (d) Promoting training and education in human resources in order to develop Intellectual Property Rights activities;
- (e) Coordinating with relevant government departments, government organizations, other organizations, and private entrepreneurs in order to develop the Intellectual Property Rights system and to ensure that such system functions well;
- (f) Encouraging consultations with local and foreign organizations to obtain the necessary technical and other types of assistance;
- (g) Carrying out activities related to Intellectual Property Rights as assigned by the Union Government from time to time.

## Chapter (4) Formation and Responsibilities of the Agency

### 6. The Central Committee

(a) shall form the following Agency of Intellectual Property Rights with the approval of the Union Government:

i. Secretary of the Central Committee

Chairman

ii. Directors General from the Ministry and  
Member

relevant ministries related to the Agency

iii. Experts in Intellectual Property Rights  
Member (not exceeding eight persons)

iv. Representatives from non-governmental organizations  
Member

(not exceeding five persons)

v. Director General of the Department

Secretary

vi. Officers-in-charge of

Joint

divisions under the Department

Secretaries

(b) The Agency formed under Subsection (a) may be reformed as necessary.

7. The Chairman of the Agency shall be considered a person at the level of Deputy Minister.
  
8. The responsibilities of the Agency are as follows:
  - (a) Coordinating activities relating to Trademark rights;
  - (b) Implementing the policies, strategies, and action plans relating to Trademark rights as prescribed by the Central Committee and the training and education activities of human resources in order to properly develop the Trademark rights system;
  - (c) Providing information regarding observations to the Central Committee so that the Union can enter as a Member Country into conventions, treaties, and agreements relating to Trademark rights;
  - (d) Implementing conventions, treaties, and agreements relating to Trademark rights of which the Union is a Member Country;
  - (e) Cooperating with relevant local organizations, international organizations, regional organizations, and Member Countries in respect to Trademark rights;
  - (f) Forming necessary working groups and, with the approval of the Central Committee, assigning them responsibilities for taking legal action against infringements of Trademark rights;
  - (g) Forming necessary working groups and, with the approval of the Central Committee, assigning them responsibilities to carry out activities relating to Trademark rights;



- (h) Protecting high-quality products produced in each region within the Union so as to encourage the economic development of the communities of the relevant regions;
- (i) Passing resolutions upon appeal against the decisions of the Registrar;
- (j) Prescribing the fees to be charged in accordance with this law, through the Central Committee with the approval of Union Government;
- (k) Approving and specifying the seal to be used in the approval for the registration of Trademark rights;
- (l) Submitting progress reports and other required reports to the Central Committee;
- (m) Presenting an annual report on Trademark rights to the Central Committee;
- (n) Carrying out activities relating to Intellectual Property Rights as assigned by the Central Committee from time to time.

### **Chapter (5) Responsibilities of the Department**

9. The responsibilities of the Department are as follows:

- (a) Making announcements concerning the registration of Trademark rights;
- (b) Maintaining the register of Trademark rights;
- (c) Supervising the activities of divisions established for each field of Intellectual Property Rights, respectively;
- (d) Carrying out duties relating to Intellectual Property Rights as assigned by the Agency from time to time.

## **Chapter (6) Appointment and Duties of the Registrars and Examiners**

10. The Ministry may, upon the request of the Agency, appoint the Registrar and Examiner as necessary to carry out activities relating to Intellectual Property Rights in the Department.
  
11. The duties of the Registrar are as follows:
  - (a) Supervising the application and examination processes of Mark registration;
  - (b) Proceeding accordingly with the findings of the Examiner in fulfilling the duties of Mark registration;
  - (c) Making decisions regarding Mark registration;
  - (d) Carrying out the duties related to Intellectual Property Rights as assigned by the Central Committee and the Agency.
  
12. The duties of the Examiner are as follows:
  - (a) Examining applications for Mark registration and Geographical Indication registration;
  - (b) Submitting to the Registrar the findings of and remarks on examination and review of statements of opposition and counterstatements relating to the application for Mark registration;
  - (c) Examining relevant persons and requesting necessary documentation, with the approval of the Registrar, in fulfilling its duties of Mark registration;
  - (d) Presenting to the Registrar the applications for Mark registration with its remark whether the permission is granted or not for such registration;

- (e) Fulfilling duties relating to Intellectual Property Rights as assigned by the Agency, Department, and Registrar;

### **Chapter (7) Non-registrable Marks**

13. If any Mark falls into any of the following categories, such event shall be deemed an absolute ground for refusal of registration and such Mark shall not be registered:

- (a) Marks devoid of any distinctive characteristic;
- (b) Marks that consist exclusively of signs or indications that may serve, in trade, to designate the kind, related information, quality, quantity, intended purpose, value, geographical origin, or the time of production of goods or of rendering of services, or other characteristics of goods or services;

*Exception: The request for registration of a Mark shall not be refused if*

- i. it has in fact acquired a distinctive character as a result of the use of such Mark among users before the date of application for registration of such Mark.*
- ii. the applicant exclusively and continuously uses the Mark in good faith in the course of trade in the Union;*

- (c) Marks that are contrary to public order, morality, religion and belief, the prestige of the Union, culture, or customs of ethnic communities,
- (d) Marks that consist exclusively of signs or indications that have become generic or customary in the current language or in the bona fide and established practices of the trade,
- (e) Marks that would be deceptive to the public or in the course of trade, in respect of Subsection (b),

- (f) Marks that are wholly or partially identical to or in imitation of the flag, armorial bearings, other emblems, official signs, and hallmarks indicating the control and warranty of a country or the armorial bearings, flags, other emblems, name, or initials of an intergovernmental organization without the approval of the relevant authorities or if the use of such marks misleads the public;
- (g) Marks that contain signs specifically protected pursuant to the international treaties to which the Union is a party.

14. If any Mark falls into any of the following categories, such event shall be deemed a relative ground for refusal of registration and such Mark shall not be registered:

- (a) Marks that are identical or similar to a registered Mark of any other person, a Mark for which an earlier application for registration has been filed, or a Mark for which the Right of Priority has been sought, for goods or services that are similar or identical to those for which such Marks are protected, thus misleading consumers;
- (b) the use of Marks causing an adverse effect on the personal rights of any individual person or the name and reputation of any legal entity without the consent of such individual person or legal entity;
- (c) Marks that are signs that may infringe the Intellectual Property Rights of any other person;
- (d) Marks for which an application for registration is filed in bad faith;
- (e) Marks for which an application for registration is filed that is identical or similar to a Well-Known Mark and that is used for goods or services

similar or identical to those for which such Well-Known Mark is used, thus misleading consumers;

- (f) Marks for which an application for registration is filed that is identical or similar to a registered Well-Known Mark and that is used for goods or services different from those for which such registered Well-Known Mark is protected, but that would indicate a connection between the goods or services of the applicant and the owner of the Well-Known Mark and such use is likely to damage the interest of the owner of such registered Well-Known Mark.

### **Chapter (8) Application**

- 15. A person who wishes to apply for registration of a Mark to obtain rights in said Mark may submit an application to the Registrar as per the specified requirements.
  
- 16. An applicant for registration of a Mark
  - (a) may prepare an application for registration in Burmese or English;
  - (b) shall have the application translated from Burmese into English or vice versa upon the request of the Registrar;
  - (c) shall sign the translation with authentication, if such translation is required pursuant to Subsection (b).
  
- 17. An applicant for registration of a Mark
  - (a) shall indicate the following information in the application for registration:
    - i. request for registration;

- ii. name and address of the applying individual or legal entity;
- iii. name, NRC No., and address of the agent, if the applicant appoints an agent for this matter;
- iv. clear and detailed description of the Mark;
- v. goods and services for which the registration is meant to cover, pursuant to the international classification of goods and services for the purpose of registration of a Mark, and the name and types of goods and services.

(b) shall provide the following information, in addition to that of Subsection (a), if required:

- i. if the application is submitted by a legal entity, the registration no. of the entity, the type of entity, and the country of origin;
- ii. claim for priority right together with sound evidence showing the existence of said priority right, if the applicant makes a priority right claim;
- iii. claim for exhibition priority right together with sound evidence showing the existence of said exhibition priority right, if applicant makes an exhibition priority right claim;
- iv. documentation showing that the Mark has been registered, if the Mark for which the application is submitted has been registered with the Office of Registration of Deeds;
- v. other requirements as set forth by the Agency and Department from time to time.

18. The date when the Department receives an application for registration of a Mark that meets the requirements set forth in Section 17(a) shall be deemed the filing date of said application for registration in the Union after the applicant has paid the specified fee.
  
19. (a) Where more than one person submits applications for registration of identical or similar Marks on different days and there is a dispute over such applications, the Registrar shall permit registration of the Mark of the applicant that has submitted the earliest application for registration that satisfies the requirements.  
  
(b) In submitting applications pursuant to Subsection (a), where applicants claim a Right of Priority or exhibition priority right and there is a dispute over such applications, the applicant whose application satisfies the requirements for registration and contains the earliest priority date shall be permitted to register the Mark.
  
20. If more than one applicant submits applications for registration of identical or similar Marks on the same day or claims the same priority date
  - (a) the Registrar shall direct all applicants to present the name of person whom they wish to nominate as applicant for the Mark after consulting with one another within an appropriate period;
  - (b) the applicants shall notify the Registrar of the name of nominee that they have designated as applicant for the Mark after consultation with one another as per the direction of the Registrar;

- (c) where applicants do not reach agreement on such matter despite the direction of the Registrar under Subsection (a), such applicants shall comply with the decision made by the Registrar in the prescribed manner.

21. (a) An applicant for registration of a Mark

- i. may make a request, upon payment of the prescribed fees, to the Registrar to amend the application, if it wishes to correct an error in the written words or other amendable errors in the application, translation, or other supporting documents, before the Registrar permits or refuses the registration of the Mark or before the Agency makes a decision regarding an appeal against the decision of the Registrar;
- ii. may make a request to withdraw the application for registration of the Mark;
- iii. may make a request, upon the payment of the prescribed fees to the Registrar to divide any application involving various goods or services into multiple, separate new applications or to limit or reduce the list of goods and services submitted without extending such list.

(b) In submitting new applications so divided under Subsection (a)(iii), the filing date of the initial application shall be deemed the filing date of the applications so divided.



22. The Registrar may allow an amendment after examining the request made pursuant to Section 21, as per the prescribed conditions.

### **Chapter (9) Examination, Objection, and Registration**

23. With respect to an application for registration of a Mark, the Examiner
- (a) shall consider whether the application corresponds with the restrictions stated in Section 13 or includes all information stated in Section 17, and present the applications that satisfy the requirements to the Registrar together with its remarks.
  - (b) shall consider whether the application corresponds with the restrictions stated in Section 13 or includes all information stated in Section 17, and notify the applicants to amend applications that do not meet the requirements, with the approval of the Registrar. If an applicant fails to amend the application within thirty (30) days of the date of receiving such notification, such application shall be considered to be withdrawn.
  - (c) shall examine such application and present it to the Registrar together with its remarks for amendment if the Examiner receives an amended application pursuant to Subsection (b).
24. Where an applicant for registration of a Mark
- (a) fails to comply with the time limit and any rights relating to the application of such Mark are abrogated due to such failure, it may reapply for registration of such Mark to the Registrar if

- i. it makes a request within sixty (60) days of the date of abrogation due to the failure to comply with the time limit;
  - ii. it provides all necessary documents, information, or explanations regarding the failure to comply with the time limit;
  - iii. it includes the reasons for such failure to comply with the time limit in the request;
  - iv. it pays the prescribed fee.
- (b) If any request seeking rights is made under Subsection (a) during the period of appeal, the Registrar shall suspend such process.

25. The Registrar

- (a) may, after examination, accept a request for re-registration of an abandoned Mark pursuant to Section 24(a) where any right relating to the application of the relevant Mark is abrogated.
- (b) shall publish an application that meets the provisions of Section 13 and 17 for the opportunity to express opposition in the prescribed manner.

26. Any person who wishes to oppose an application for registration of a Mark may file a statement of opposition stating any grounds relating to the provisions of Section 13 and 14 to the Registrar within sixty (60) days of the date of publication.

27. Upon receiving a statement of opposition, the Registrar shall send a written notification to the applicant to give such applicant the opportunity to defend against the statement of opposition within the prescribed period.

28. Concerning an application for registration of a Mark, the Registrar
- (a) may approve such application for registration of a Mark if no statement of opposition is filed within sixty (60) days of the date of publication.
  - (b) may approve or refuse a statement of opposition after reviewing whether such statement of opposition complies with the provisions of Section 13 or 14.
  - (c) shall record the approval of or refusal of the application in the Register and notify the applicant of such approval or refusal, and shall publish such approval or refusal in the prescribed manner.
  - (d) shall issue a registration certificate of the Mark to the applicant, if the application for registration of Mark is approved.
29. An Owner of a Mark
- (a) may apply to the Registrar for a certified copy of the registration certificate of the Mark upon the payment of the prescribed fee, if the original registration certificate of the Mark is lost or defaced.
  - (b) may apply to the Registrar for correction of errors in written words or other amendable errors or the particulars of nationality and address, which are recorded in the Register, upon the payment of the prescribed fee.
30. The Registrar

- (a) shall issue a certified copy of the registration certificate of a Mark after reviewing an application submitted pursuant to Section 29(a).
- (b) may permit an applicant to make corrections after reviewing an application submitted pursuant to Section 29(b).

### **Chapter (10) Right of Priority**

- 31. If a person who has applied for registration of a Mark in any country that is a party to the Paris Convention or is a member of the World Trade Organization or its successor in title submits an application for registration of the same Mark used for the same goods or services as those registered in the Member Country to the Department within six (6) months of the date of submission of the first such application in the Member Country, it shall be entitled to a Right of Priority from the date of the first such application, as the date of application.
- 32. If a person submits an application to the Department for registration of a Mark used for the same goods or services as displayed at an international trade fair organized or recognized by the relevant government of any member country to the Paris Convention or a member of the World Trade Organization within six (6) months of the date of displaying such Mark at said international trade fair, it shall be entitled to an exhibition priority right from the date of first display as the date of application.
- 33. The exhibition priority right shall not exceed the period of time during which the Right of Priority is granted from the date of application under Section 31.

## **Chapter (11) Term of Registration and Renewal of Registration**

34. The term of registration for a registered Mark is 10 years from the filing date of the application for registration of such Mark. After the expiration of the 10-year term of registration, the registration may be renewed for an additional 10 years for each term.
  
35. If the Owner of a Mark wishes to renew the term of registration,
  - (a) it shall apply for renewal of said registration within six (6) months before the expiration date of said registration upon the payment of the specified fee.
  - (b) it shall apply for renewal of said registration within the grace period of six (6) months after the expiration date of said registration upon the payment of the specified registration fee and late fees.
  
36. The Registrar shall
  - (a) approve an application for renewal of registration that meets the requirements. The renewal of registration certificate shall come into force upon the expiration date of the preceding term of registration.
  - (b) renew a registration for a 10-year period and publish such renewal of registration in the prescribed manner, if an application for renewal of registration meets the requirements following review of such application.
  - (c) record a renewal of registration and payment of the prescribed fee in the Register.

- (d) revoke the registration of a registered Mark if the owner of the Mark fails to pay the prescribed fee for the renewal of registration within the grace period of six (6) months.
- (e) record the revocation of a registered Mark in the Register and publish such revocation in the prescribed manner.

### **Chapter (12) Rights Attached to the Registered Mark**

- 37. If the Owner of a Mark complies with the provisions of Chapter (11), it shall be entitled to the rights attached to a registered Mark provided in this Chapter during the term of registration.
  
- 38. Subject to the provisions of Section 39 and 40, the Owner of a Mark
  - (a) as exclusive right,
    - i. shall have, under this Law, the right to prevent any misleading act of any other person who uses, without the consent of the owner of the Mark, in the course of trade, a sign that is identical or similar to the Mark in relation to goods or services that are identical or similar to those for which such Mark is registered.
    - ii. shall have the right to file a civil suit or criminal case or both against a person that infringes upon the registered Mark.
    - iii. Shall have the right to prevent any use of a registered Well-Known Mark and any sign that is identical or similar to the Mark in relation to different goods or services in the course of trade without the consent of the owner of the Mark if

- (aa) it appears to indicate a relation between the owner of the Well-Known Mark and goods or services for which the Mark is used;
    - (bb) it may damage the interest of the owner of such Mark rights;
  - (b) may transfer or license the rights attached to the Mark registered under the provisions of Chapter (13) and (14) to any other person.
- 39. The Owner of a Mark shall not have right to prohibit any use of the following information by any other person in good faith for industrial or trading business:
  - (a) The personal name and address of the owner;
  - (b) Descriptions of the type, related information, quality, quantity, intended purpose, value, geographical origin, the time of production, or other characteristics of the goods or services;
  - (c) Statements showing the intended purpose of the goods or services (in particular, statements showing the intended purpose for accessories or spare parts).
- 40. The Owner of a Mark shall not have the right to prohibit any use of such Mark on goods distributed by itself or by any other person with its consent in the market.
- 41. Notwithstanding anything contained in Section 40, after distributing goods in the market, where there are any changes in the condition of such goods or such goods

are not in good condition, the Owner of a Mark may prohibit the continued sale of such goods under the existing law.

### **Chapter (13) Transfer of Rights Attached to the Mark**

42. (a) An applicant for registration of a Mark may apply to the Registrar for recording the transfer of its application to any other individual person or legal entity in accordance with the prescribed conditions.
  - (b) The Owner of a Mark may apply to the Registrar for recording the transfer of its ownership of the registered Mark to any other individual person or legal entity in accordance with the prescribed conditions.
43. If an applicant for registration of a Mark or a transferee pursuant to Section 42(a) or the Owner of a Mark or a transferee pursuant to Section 42(b) applies for recording the transfer of ownership, upon the payment of the prescribed fee, the Registrar shall record such transfer of ownership and publish the same in the prescribed manner.
44. No transfer of ownership shall be valid unless an application for recording such transfer of ownership is submitted to the Registrar.

### **Chapter (14) Licensing of a Registered Mark**

45. The Owner of a Mark may license any individual person or legal entity to use its registered Mark in accordance with the prescribed terms and conditions.



46. The Owner of a Mark or its licensee may apply to the Registrar for recording the licensing of such registered Mark along with the certified true copy of said license upon the payment of the prescribed fee.
47. The Registrar shall record an application submitted pursuant to Section 46 and publish such license in the prescribed manner.
48. If the Owner of a Mark or its licensee applies to the Registrar for revocation of a recorded license of a Mark per the prescribed conditions, the Registrar shall revoke the recording of such license and publish the revocation of such license in the prescribed manner.
49. No license shall be valid unless an application for recording such license is submitted to the Registrar.

#### **Chapter (15) Publication of Invalidity of and Revocation of Registrations of Marks**

50. (a) Upon the application of any interested person, if there is sound evidence showing that a Mark does not satisfy the definition of Section 2(j) or a Mark is not registrable due to one of absolute grounds stated in Section 13, the Registrar shall publish that such registration of said Mark is invalid.
- (b) Upon the application of any interested person, if there is sound evidence showing that a Mark is not registrable due to one of the relative grounds stated in Section 14, the Registrar shall publish that such registration of said Mark is invalid.

- (c) If the Registrar receives a final decision or judgment of the Court of Law in respect to an application for a declaration of invalidity of a registration of a Mark, the Registrar shall publish that the registration of said Mark is invalid.
  - (d)
    - i. A request for a declaration of invalidity of the registration of a Mark pursuant to Subsection (a) may be made any time.
    - ii. Unless a Mark is registered fraudulently, a request for a declaration of invalidity of the registration of a Mark pursuant to Subsection (b) may be made within five (5) years of the date of registration.
  - (e) Where the grounds for a declaration of invalidity of a registration exists in respect to only some of the goods or services for which the Mark is registered, the Mark shall be declared invalid as regards those goods or services only.
  - (f) The Registrar shall record the declaration of invalidity of a registered Mark, notify the owner of the Mark of such declaration of invalidity, and publish such declaration.
51. (a) Upon the application of a person interested in the use of a Mark, the Registrar shall revoke the registration of a Mark on any of the following grounds:
- i. that, within a period of three (3) years following the filing date of the application, the Mark has not been used in the course of trade in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

- ii. that such use has been suspended for a continuous period of three (3) years, and there are no proper reasons for non-use;
  - iii. that the registered Mark has become a sign or indication that serves to designate the type, related information, quality, quantity, intended purpose, value, geographical origin, or the time of production of goods, or has become generic or customary in the current language, or consists exclusively of signs or indications that have become established practices of the trade.
- (b) The use of a Mark described in Subsection (a) shall include the following uses:
  - i. use of the Mark in a form differing in elements that do not alter the distinctive character of the Mark from the form which was registered;
  - ii. use of the Mark in the Union includes applying the Mark to goods or to materials for the labelling or packaging of goods solely for export purposes.
- (c) If it is necessary to prove use of a Trademark, including the period, nature, or industry for which the Mark is used, the Owner of a Mark shall have burden of proving such use.
- (d) Where grounds for revocation of a registration exist in respect to only some of the goods or services for which the Mark is registered, the registration of the Mark shall be revoked as regards those goods or services only.
- (e) After the registration of the Mark has been revoked, such registration shall be deemed officially terminated.

- (f) The Registrar shall record the revocation of the registered Mark, notify the Owner of a Mark of such revocation, and publish such revocation.

52. No one shall use a Mark for which registration is refused by the Registrar subject to Section 13 (c) or is revoked by the Registrar.

### **Chapter (16) Geographical Indication**

53. If any legal entity that represents the following people in a locality where the relevant goods are manufactured wishes to register a Geographical Indication, it shall file an application for registration with the Registrar in accordance with the requirements:

- (a) Persons who exploit natural products or produce products made of natural resources;
- (b) Manufacturers of agricultural products;
- (c) Manufacturers of handicrafts and industrial products;
- (d) Respective officers from the relevant government department or government organization for and on behalf of the persons described in Subsections (a) to (c);

54. (a) An application for the registration of a Geographical Indication shall include

- i. The name of the applicant entity or the name, nationality, and address of the representative of the entity;
- ii. The Geographical Indication for which the application for registration is filed;

- iii. The place of origin of the Geographical Indication for which the application for registration is filed;
  - iv. The goods for which the Geographical Indication is used.
- (b) The following information shall be provided together with the application:
  - i. Specific attributes, quality, or reputation of the goods;
  - ii. Specific quality, reputation, or characteristics of the goods and the relationship between the place of origin and the manufacturing method of the goods;
  - iii. Other requirements.
- (c) The prescribed registration fee shall be paid upon filing the application.

55. A Geographical Indication is not registrable if

- (a) it does not comply with the definition of Geographical Indication stated in Section 2(o);
- (b) such Geographical Indication that is to be used on the proposed goods is generic or customary in the common language of the Union;
- (c) such Geographical Indication is contrary to public order, morality, or public policy.

56. Any interested person or relevant government department or department organization may apply to the Registrar for a declaration of invalidity or a revocation of registration of a Geographical Indication on the grounds

- (a) that such Geographical Indication does not comply with the definition of Geographical Indication stated in Section 2(o);
  - (b) that it cannot continue carrying out the activities required for registration set forth in Section 54(b) and other applicable requirements;
  - (c) that such Geographical Indication is an indication that is not protected, ceases to be protected, or ceases to be used in the place of origin;
  - (d) such Geographical Indication is contrary to public order, morality, or public policy.
- 57.
- (a) Only persons that carry out activities within certain regions in respect to the goods stated in the Register shall be entitled to use the registered Geographical Indication in the course of trade. However; such goods shall have the same quality, reputation, or other characteristics as those stated in the Register.
  - (b) The protection of a registered homonymous name shall be subject to a sufficient distinction in practice between a homonym registered subsequently and the name already on the Register, having regard to the need to treat the manufacturers concerned in an equitable manner and not to mislead the consumer.
  - (c) A person that has a right to a registered Geographical Indication shall have the right to prevent the following acts:
    - i. Use of Geographical Indications in any way for goods that do not truly originate in the geographical areas indicated by such Geographical Indications with the intention of misleading the public;

- ii. Use of registered Geographical Indications in any way that constitutes an act of unfair competition;
    - iii. Use of Geographical Indications in any way for goods that do not originate in the geographical areas indicated by such Geographical Indications where the true origin of the goods is indicated or where the Geographical Indication is used in translation or is accompanied by expressions such as “kind”, “group”, “style”, “imitation”.
  - (d) No rights stated in Subsections (a) and (c) shall be granted in respect to other Geographical Indications that mislead the public into believing that goods come from another territory, even if the name accurately indicates the actual place of origin of the goods.
58. (a) If an application complies with Section 53, 54, and 55, the Registrar shall publish the content and information stated in the application in the prescribed manner.
- (b) The provisions relating to an opposition against the registration of a Mark may, as may be necessary, apply to persons that wish to oppose the registration of a Geographical Indication.
- (c) If the Registrar receives no statement of opposition or refuses a statement of opposition, it shall register the Geographical Indication.
59. Registration of a Geographical Indication shall be effective under this Law as long as the distinctive characteristics, quality, or reputation for which protection is granted exist.

60. (a) Where an application for registration of a Mark is filed after filing an application for a Geographical Indication under this Law, the Registrar shall refuse the registration of the Mark used as being in violation of Section 57 or in relation to identical products.
- (b) If it is found that registered Marks correspond to Subsection (a), such Marks shall be declared invalid.
- (c) Even if a Mark that has been applied for or is registered in good faith before filing an application for the Geographical Indication is used in breach of Section 57, notwithstanding any provisions herein relating to the registration of Geographical Indications, the use of such Mark may continue in respect to such products, provided that such use does not contravene the provisions of Chapter (15). The Registrar may permit the use of a Geographical Indication in such cases in the same way as the use of the Mark that such Geographical Indication is related to.
61. (a) The relevant departments or organizations shall supervise the use of registered Geographical Indications. Some supervision tasks may be assigned to another entity.
- (b) Supervision tasks include:
- i. Ensuring that the relevant products are consistent with the description of products for which the Geographical Indication is registered;
  - ii. Overseeing the use of registered Geographical Indications in the market.



- (c) The costs for supervision tasks that ensure the relevant products are consistent with such descriptions shall be incurred by the relevant parties.
62. Regarding the infringement of rights of Geographical Indications, if there is non-compliance with provisions of this Law and the requirements thereof, action shall be taken according to the provisions concerning taking action in respect to infringement of rights in Marks.

### **Chapter (17) Trade Name**

63. (a) Trade names shall be protected without the necessity of filing for registration, irrespective of whether the trade name forms part of a Mark.
- (b) If a name or denomination is contrary to public order or morality due to the nature of such name or denomination or due to the use of such name or denomination, especially if the use of such trade name for a business may constitute misleading in the course of trade or the public, such name or denomination shall not be used as a trade name.
- (c) If a Mark that is identical or similar to a trade name is used as another trade name or Mark, without any necessary approval, and thus misleads the public, such trade name shall be protected.

### **Chapter (18) Application for International Registration**

64. After the Union has entered into an agreement concerning the international registration of a Mark, any domestic or foreign persons who wish to file an application for registration of a Mark may file such application with the Registrar

per the requirements, if they wish to adopt the system of international registration of Marks.

### **Chapter (19) Appeal**

65. (a) Any person who is dissatisfied with any decision made by the Registrar under this Law may file an appeal to the Agency within sixty (60) days of the date of such decision.
- (b) In the event of an appeal under Subsection (a), the Agency may uphold, revoke, or revise the decision of the Registrar or may direct the relevant parties to submit more evidence.
- (c) If more evidence is submitted pursuant to Subsection (b), the Agency may uphold, revoke, or revise the decision of the Registrar.
66. Any person who is dissatisfied with the decision made by the Agency may submit an application concerning such matter to the Intellectual Property Rights Court, on which the Supreme Court of the Union confers jurisdictional authority, within ninety (90) days of the date of receiving notification of such decision.

### **Chapter (20) Establishment of the Intellectual Property Rights Court**

67. The Supreme Court of the Union
- (a) may establish the Intellectual Property Rights Court in the relevant region and states and appoint judges to hear and adjudicate civil or criminal proceedings relating to Intellectual Property Rights;

- (b) may confer authority and jurisdiction to the judges appointed under Subsection (a) to hear and adjudicate cases relating to Intellectual Property Rights;
- (c) may confer authority and jurisdiction of the Intellectual Property Rights Court to a competent Court to hear and adjudicate matters relating to Intellectual Property Rights prior to the establishment of the Intellectual Property Rights Courts pursuant to Subsection (a);
- (d) shall determine the jurisdiction and authority of the Intellectual Property Rights Courts that shall have jurisdiction over appeals against and revisions to the judgments, orders, and decisions made by the Intellectual Property Rights Courts; and
- (e) shall confer jurisdiction and authority to a competent Intellectual Property Rights Court to hear and adjudicate cases filed under Section 66.

#### **Chapter (21) Protection of the Customs Department for Rights Related to a Mark**

68. If a Right Holder has valid grounds for suspecting that goods bearing a counterfeit Mark are imported, being imported, or going to be imported within the borders of the Union, it may submit an application to the Director General of the Customs Department for a suspension order, in accordance with the specified conditions, to suspend the release of such goods into free circulation of the channels of commerce.
69. (a) The Director General of the Customs Department

- i. shall, within 30 days of the date of receipt of an application, inform the applicant whether the application is accepted or rejected in accordance with Section 68.
    - ii. shall suspend the application process and send the applicant a notice requiring the applicant to provide more information within fifteen (15) days from the date of such notice, in the event that the applicant does not provide all necessary information for the application process.
    - iii. may require an applicant to provide a security to the Customs Department, as per the specified conditions, upon accepting the application.
    - iv. shall expressly describe the reasons an application is rejected.
  - (b) Unless the applicant requests a shorter period, the actions under Subsection (a) shall be effective for six (6) months.
70. (a) If there is sufficient evidence that imported goods are bearing a counterfeit Mark after receiving the application submitted under Section 69 or per the findings of the Customs Department, the Director General of the Customs Department shall suspend the release of such goods into free circulation of the channels of commerce. The applicant and the importer shall be informed of such suspension immediately.
- (b) Without prejudice to the protection of confidential information, the Director General of the Customs Department shall give the applicant and the importer sufficient opportunity to inspect the suspended goods in order

to substantiate the applicant's claim that such goods bear a counterfeit Mark.

71. (a) If, within a period not exceeding fifteen (15) days after the applicant has been served a notice of a suspension order, the applicant has not informed the Director General of the Customs Department that the applicant has initiated proceedings that would lead to a decision on the merits or that the Intellectual Property Rights Court has taken provisional measures prolonging the suspension of the release of the goods, the goods shall be released. In appropriate cases, this time limit of fifteen (15) days may be extended by another fifteen (15) days before the expiration of the specified time limit upon the decision of the Director General of the Customs Department.
- (b) The specified time limit for perishable goods is three (3) days.

72. If the importer is dissatisfied with a suspension order after receiving the notice of a suspension order, it may present such matter to the relevant competent Intellectual Property Rights Court. The Intellectual Property Rights Court shall amend, revoke, or confirm the time limit of the suspension within thirty (30) days of the date the request for reconsideration is made.

73. If the Intellectual Property Rights Court decides that the goods in question are goods bearing a counterfeit Mark, the importer shall pay the costs of detention, destruction, or disposal of such goods to the Custom Departments. Unless the

Director General of the Customs Department receives such costs from the importer, the applicant shall have the responsibility to pay the aforesaid costs and shall have the right to receive reimbursement for any costs so incurred from the importer.

74. If the Intellectual Property Rights Court decides that the goods in question do not bear a counterfeit Mark, the applicant shall pay compensation to the importer equivalent to an amount determined by the Intellectual Property Rights Court resulting from the wrongful suspension and temporary detention of the goods.
75. The provisions under this chapter shall not apply to goods bearing a counterfeit Mark of a non-commercial nature contained in travelers' personal luggage or imported goods as provided in the Rules made under this Law.
76. The Director General of the Customs Department may exchange information in respect to goods allegedly bearing a counterfeit Mark and cooperate with the World Customs Organization or the Directors General of the Customs Department of other countries.

#### **Chapter (22) Authority of the Intellectual Property Rights Court Regarding Infringement of Rights in Marks**

77. (a) A Right Holder may apply to the Intellectual Property Rights Court for a temporary injunction to prevent damage to said rights in accordance with the civil proceedings provided for under Sections 79 and 80.

- (b) A Right Holder may file a criminal case or civil suit with the Intellectual Property Rights Court.

78. The Intellectual Property Rights Court

- (a) shall deem the exercise of any rights contained in Section 38 by any person who is not the Owner of a Mark, without the consent of the owner of such Mark, as infringement of the rights in the Mark protected under this Law.
- (b) shall deem the use of a Mark identical or similar to an unregistered Well-Known Mark for identical or similar goods or services without the consent of the owner of said Mark as potentially misleading to the public.

79. (a) The Intellectual Property Rights Court may, upon receipt of an application alleging that Mark rights have been infringed pursuant to Section 77 (a), pass one or more orders taking the following provisional measures as civil remedies:

- i. Injunction to prevent the infringement of rights in a Mark and the entry of goods that involve the infringement of Mark rights, including imported goods for which customs clearance has been conducted, into the channels of commerce in the Union;
- ii. order to preserve relevant evidence related to the alleged infringement of Mark rights as it may think fit; or
- iii. order to revise, revoke, or uphold a suspension order issued by the relevant Customs Department.

- (b) The Intellectual Property Rights Court may direct the applicant to provide the following in order to take provisional measures:
  - i. to submit any reasonably available evidence in order to satisfy the Court to a sufficient degree of certainty that the applicant is the Right Holder and its right is being infringed or that such infringement is imminent;
  - ii. to pay adequate security in order to prevent the abuse of enforcement of provisional measures.
- (c) In taking provisional measures per an order made pursuant to Subsection (a), the Intellectual Property Rights Court may direct the applicant to submit further information in order to identify the goods alleged to have been infringed.
- (d) If a civil proceeding is not instituted within the reasonable time limit specified by the Intellectual Property Rights Court from the date of enforcement of provisional measures upon the application for such measure or, if a time limit is not set, within thirty (30) days from the date of the order to take provisional measures, the Intellectual Property Rights Court shall, upon the request of the defendant, revoke or discontinue the effectiveness of the provisional measures taken pursuant to Section 79(a) and 80(a), without prejudice to Section 80(b).
- (e) The Intellectual Property Rights Court may, upon the request of the defendant, order the applicant to pay reasonable and adequate compensation to the defendant for damages incurred due to provisional measures requested by the applicant if the Intellectual Property Rights Court revokes or discontinues the provisional measures due to any default



or act of the applicant, or finds that the rights in the Mark have not be infringed or there is no imminent infringement of such rights in the Mark.

80. (a) The Intellectual Property Rights Court may adopt provisional measures *inaudita altera parte* in any of the following situations where
- i. any delay is likely to cause irreparable harm to the Right Holder;
  - ii. there is a demonstrable risk that evidence will be destroyed.
- (b) In adopting provisional measures *inaudita altera parte*, the Intellectual Property Rights Court
- i. shall notify the defendant of the provisional measures immediately after such measures have been taken.
  - ii. shall complete the enforcement of such measures if the defendant fails to comply with such notice within the specified time limit or, if the time limit is not specified, within thirty (30) days from the date of notice.
- (c) A review and hearing shall take place within the reasonable period upon the request of the defendant(s) with a view to deciding whether such measures shall be modified, revoked, or confirmed.
81. (a) The Intellectual Property Rights Court may, without prejudice to the civil laws and Code of Civil Procedure, in litigation pursuant Section 77(b), pass one or more of the following orders regarding the infringement of the rights in a Mark:

- i. Injunction to prevent the infringement of rights in a Mark, including an injunction to prevent the entry of imported goods that involve the infringement of Mark rights into the channels of commerce of the Union immediately after customs clearance of such goods at the Customs Department;
  - ii.
    - (aa) Order that requires the infringer to pay the Right Holder damages adequate to compensate for the injury the Right Holder has suffered due to an infringement of the Right Holder's rights in a Mark, or that requires the infringer to pay the Right Holder pre-established damages or profits derived from such infringement, or both in appropriate cases;
    - (bb) Order that requires the infringer to pay the appropriate expenses of the Right Holder, including legal expenses and attorney's fees;
  - iii. Order to destroy or dispose of infringing goods outside the channels of commerce without payment of damages in order to avoid any harm caused to the Right Holder;
  - iv. Order to destroy or dispose of materials and implements the predominant use of which has been in the creation of infringing goods outside of the channels of commerce.
- (b) In considering the passing of an order pursuant to Subsection (a) (iii) and (iv), the Intellectual Property Rights Court shall consider the need for

proportionality between such order and the seriousness of the infringement, as well as the interest of other related parties.

82. In the event that any person is found to have wrongfully claimed that their rights in a Mark have been infringed, such person shall be liable to pay compensation to a defendant to whom damage has been caused through the wrongful detention of goods, and the Intellectual Property Rights Court may order such applicant to pay the legal expenses, including attorney's fees and other expenses, of the defendant.
83. (a) The Intellectual Property Rights Court may, without prejudice to the provisions under existing laws and the protection of confidential information in appropriate cases, order the opposing party to submit evidence when
- i. the Right Holder has presented sound evidence sufficient to support its claims;
  - ii. the Right Holder has specified evidence relevant to the substantiation of its claims that lies in the control of the opposing party.
- (b) In the case of voluntary infringement without a sound reason, the Intellectual Property Rights Court may make preliminary and final determinations, affirmative or negative, on the basis of the information presented to the Intellectual Property Rights Court, including the complaint or the allegations presented by the aggrieved party and the alleged infringer, provided that such parties to the proceedings have been

afforded an opportunity to be heard regarding the allegations or evidence,  
if

- i. Either such party refuses access to necessary information;
- ii. Either such party does not provide necessary information within a reasonable period;
- iii. Either such party significantly impedes a procedure relating to an enforcement action.

84. If the Intellectual Property Rights Court awards a pecuniary fine for any offense in a legal proceeding instituted under this Law, it may order the payment of all or part of such pecuniary fine as damages to the aggrieved party.
85. If civil and criminal proceedings have been instituted for the same cause of action, the Intellectual Property Rights Court shall set off the damages paid out of the pecuniary remedy awarded under Section 84 in the civil proceedings in which the Intellectual Property Rights Court passes a judgment, an order, or a decree to award damages against damage and injury.
86. The Intellectual Property Rights Court may act in accordance with the provisions of the Evidence Act, the Code of Civil Procedure, the Code of Criminal Procedure, and other applicable existing laws, unless provisions for enforcement of legal actions regarding the infringement of rights in a Mark are not expressly included in this Law.

### **Chapter (23) Offenses and Penalties**

87. (a) Any person who has been convicted of the following acts, without the Right Holder's consent, shall be punishable with imprisonment for a term not exceeding three (3) years or with fine not exceeding five (5) million kyats or both:
- i. Mark counterfeiting;
  - ii. Using a counterfeit Mark on goods or services;
  - iii. Possessing any material or implement mainly used in counterfeiting Marks or in utilizing counterfeited Marks on goods.
- (b) Any person who has been convicted of any of the following acts shall be punishable with imprisonment for a term not exceeding two (2) years or with fine not exceeding five (5) million kyats or both:
- i. Trade and distribution of goods bearing a counterfeit Mark or possessing such goods for the purpose of trade and distribution of such goods;
  - ii. Importing goods bearing a counterfeit Mark into the Union or exporting such goods from the Union.
88. If any person who has been convicted of any acts under Section 87 and is convicted of such acts again, he/she shall be punishable with imprisonment for a term of at least three (3) years and maximum ten (10) years and with fine not exceeding ten (10) million kyats.
89. If any person who has been convicted of using the flag or an emblem specifically protected in accordance with International Conventions to which the Union is a

party for the purpose of commercial use, he/she shall be punishable with imprisonment for a term not exceeding three (3) years or with the fine not exceeding five (5) million kyats or both.

90. If any person who has been convicted of removing, destroying, deforming, or modifying a registered Mark for the purpose of adversely affecting the owner of the Mark, he/she shall be punishable with imprisonment for a term not exceeding one (1) year or with fine not exceeding three (3) million kyats or both.

91. If any person has been convicted of any of the following acts, he/she shall be punishable with imprisonment for a term not exceeding one (1) year or with fine not exceeding two (2) million kyats or both:

- (a) Falsely issuing or causing to be issued a Mark registration certificate;
- (b) Making a false entry without good faith, or causing such to be made, in the Register of Trademark; or
- (c) Breaching the prohibitions set forth under Section 52.

92. Whoever aids or abets the commission of an offense under this Law shall be penalized with the punishment provided for such offense in this Law.

#### **Chapter (24) Miscellaneous**

93. (a) An Owner of a Mark registered at the Office of the Registration of Deeds in accordance with the Registration Act in place before this Law comes into force, or an owner of an unregistered Mark that is actually used in the

market of the Union, shall apply for registration in accordance with this Law if such owner wishes to secure a Mark registration right.

- (b) In respect to Marks that are actually used in the market of the Union, regardless whether or not they have been registered with the Office of Registration of Deeds, there shall exist a priority right to use such Marks for the goods and services that use such Mark, during the prescribed period.

94. Notwithstanding anything to the contrary contained in any other existing Law,

- (a) the registration of a Mark shall be conducted in accordance with this Law.

- (b) legal action shall be taken for any offenses relating to a Mark only in accordance with this Law.

95. If a decision made by the Registrar in the course of exercising its authority conferred under this Law may affect a person, the Registrar shall give such person an opportunity to be heard, per the specified conditions.

96. A duly certified and sealed copy of a Mark registration certificate and supporting documents issued by the Registrar may be submitted as evidence to the relevant Intellectual Property Rights Court.

97. The Intellectual Property Rights Court may pass an administrative order to seize goods bearing a counterfeit Mark, including tools, materials, and implements relating to such offense, as public property, or destroy or otherwise dispose of

such goods bearing a counterfeit Mark, including related tools, materials, and implements, as it sees fit.

98. For the enforcement of the provisions of this Law, the Ministry shall be responsible for the office functions of the Central Committee and the Agency and shall incur the expenses.
99. The Ministry shall determine, with the approval of the Union Government, the remuneration and allowances of members of the Central Committee, the Agency, and the Working Body who are non-civil service personnel.
100. Normally, the office term of the person who holds an office title at the Union level contained in this Law is the same as the term of the President of the Union.
101. The Ministry may establish divisions under the Department for each field regarding Intellectual Property Rights and assign the Department and its divisions the functions of the Agency.
102. The infringements of Mark rights under this Law shall not apply where a government department and a legal entity use any goods bearing such Mark in the case of national emergency of the Union and public affairs not for commercial purpose, but for the public interest.
103. Offenses contained in this Law are considered cognizable offenses.



104. The disputes arising among parties relating to Marks may be settled either in an amicable manner or by arbitration or legal proceedings.
105. The Central Committee and the Agency formed under this Law shall be deemed the Central Committee and Agency for all the Laws of Intellectual Property Rights.
106. In implementing the provisions of this Law,
- (a) the Supreme Court of the Union may issue Rules, Regulations, Bylaws, Notifications, Orders, Directives, and Procedures.
  - (b) the Ministry and the Respective Ministries:
    - i. may issue Rules, Regulations, and Bylaws with the approval of the Union Government; and
    - ii. may issue Notifications, Orders, Directives, and Procedures.
  - (c) the Ministry carrying out customs functions may, with the approval of the Union Government, issue Rules, Regulations, and Bylaws relating to customs.
  - (d) the Agency and the Department may issue Notifications, Orders, Directives, and Procedures with the approval of the Ministry.

I hereby sign under the Constitution of the Republic of the Union of Myanmar.

(Sd) Win Myint

The President

The Republic of the Union of Myanmar

