

# Baker McKenzie. Myanmar Adopts New Trade Mark Legislation

## What to Expect with the Incoming Trademark Law

### Here is what you need to know:

Currently, Myanmar is one of the few countries that does not have IP laws, or a trade mark registration system. The government recently announced that a new IP regime will be coming into force expeditiously (anticipated in 2019).

As a result, **all trade marks will have to be re-registered.**

**We recommend reviewing your trade mark portfolios to ensure all important aspects of your branding are protected.**

### For owners of trade mark registrations:

**It is critical that brand owners immediately prepare to re-file their trade marks as soon as the new IP regime comes into force.**

- There will **not** be an automatic migration of existing trade mark registrations.
- Declarations of Ownerships for existing registrations may be considered during assessment of re-registration applications.
- A statutory “transitional period” will be allowed, pending official confirmation from the government.

### For applicants considering new filings:

**If you are considering new applications, you are encouraged to wait until the new IP regime comes into force, and file promptly and broadly to prevent “troll activity” by third parties.**

## Other Changes Of Note:

**First-to-file system and Statutory Rights:** The new trade mark regime will be a first-to-file system. Statutory rights of 10 years from the filing date will be conferred to registered marks.

**Substantive Examination:** The law is expected to introduce trade mark prosecution in Myanmar, and applications will be subject to a formal and substantive examination process not previously available in the country. As such, prosecution actions, such as registrar objections or citations, should also be expected. The rules and regulations covering trademark prosecution actions have yet to be issued.

**Well-known marks and Geographical Indications:** Well-known marks will be recognised, but it is unclear if a separate well-known marks registry will be kept. Geographical indications will also be recognised, and can be registered separately.

**Priority rights:** Convention priority will be recognised, subject to Myanmar's accession to the relevant treaty or international agreement.

**Opposition and cancellation:** Oppositions and cancellation actions will be available. Oppositions can be filed within 60 days from the publication of the mark. Non-use for 3 years may be vulnerable to cancellation. Rules for the administration of these proceedings have yet to be issued.

**IP courts and enhanced enforcement actions:** The new IP laws, including the anticipated trademark law, will create dedicated IP courts to manage IP-related criminal and civil actions. In addition, criminal or civil enforcement actions will be updated, and administrative border control (customs) options will be enhanced, allowing rights holders more options for enforcement.

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# **SIGNUP NOW**

## **for our Transition Shortlist**

### **ENSURE YOU ARE READY FOR THE CHANGE**

#### **Contact us to discuss a specific strategy for your trade mark portfolio**

We maintain a list of clients preparing to transition to the new trade mark registration system. For clients in this shortlist, we offer:

- Incremental and detailed updates on developments about the trade mark laws and regulations, apart from our general legal updates.
- Early copies of drafts of supporting documents, such as forms and templates, that may be required for trade mark registration.
- Other practical recommendations and assistance in preparing for trade mark re-registration.