

## Effective Legal Routes to Tackle Trademark Infringement in Myanmar

Myanmar's commitment to safeguarding intellectual property rights (IPR) and fostering innovation-driven growth is evident in its comprehensive Trademark Law, which provides a robust framework for right holders to protect their trademarks against infringement. Sections 77-86 of the law outline the options, responsibilities, and measures available to right holders seeking to take action against trademark violations in the country. In this article, we delve into the key provisions of these sections, shedding light on the procedural aspects and civil remedies available to protect trademark rights in Myanmar.

### Options for right holders to enforce trademark rights

In Myanmar, right holders facing trademark infringement have 02 (two) primary avenues to pursue:

- *Civil Action for Damages:* Right holders can opt for a miscellaneous suit filed with the intellectual property rights court. This allows them to seek provisional measures orders through civil action for damages, as outlined in Sections 79 and 80 of the Trademark Law.
- *Criminal or Civil Action:* Right holders also have the choice to initiate legal proceedings in the form of either criminal action or civil action against the party responsible for the trademark infringement.

### Responsibilities of the IPR Court

In Myanmar's legal framework, the IPR court holds significant responsibilities in ensuring the integrity of trademark rights and preventing infringements. According to Section 78 of the Trademark Law:

- *Violation of Protected Marks:* The court must consider a mark protected under the law as violated if any person, other than the right holder, exercises any right under section 38 in Myanmar without the owner's consent.
- *Use of Unregistered Well-Known Marks:* The court must also recognize the use of an identical or similar unregistered well-known mark for identical or similar goods or services, without consent, as misleading the public.

### Provisional measures for civil remedies

The IPR court in Myanmar is entitled, under Section 79, to issue provisional measures orders for civil remedies when an application is submitted. These measures include:

- *Preventing Entry of Infringing Products:* The court can issue orders to prevent the entry of infringing products into Myanmar's commercial area, maintaining the original condition of evidence related to alleged infringements, and amending, canceling, or confirming suspension orders issued by the Customs Department.
- *Requesting Information and Security:* To ensure a fair and transparent process, the court may request the applicant (the right holder) to provide sufficient proof of their ownership, evidence supporting the infringement claim, or likelihood of infringement, and ample security measures to prevent any potential misuse of the provisional measure process.
- *Distinguishing Infringing Goods:* To facilitate the implementation of interim orders, the court may direct the applicant to furnish relevant information that helps distinguish the alleged infringing goods from legitimate products.
- *Withdrawal or Termination of Provisional Measures:* If the respondent (the alleged infringer) requests, the court is obligated to withdraw or terminate the effectiveness of provisional measure orders if civil litigation has not commenced within a reasonable period. This provision allows the applicant to pursue damages accordingly.
- *Damages for Withdrawal of Provisional Measures:* In certain situations, the respondent (the alleged infringer) may request the court to order the applicant to pay damages due to the withdrawal of the provisional measure order, actions of the applicant leading to the cessation of effectiveness, or cases where no infringement is found or likely to occur.

## Provisional measures in absentia

An IPR court in Myanmar, under Section 80, is competent to make provisional measure orders in absentia under either of the following conditions: **(i)** any delay which can cause irreparable damage to the right holder; or **(ii)** actual threat that the evidence will be destroyed and lost.

When implementing an interim order in absentia, the court is required **(i)** to notify the respondent about the provisional measure order immediately after the actions in said order are carried out and **(ii)** to completely carry out the actions in said order if the respondent fails to comply within the period prescribed by the court or, in the absence of such prescription, 30 days from the date of issuance of the notice.

Upon the respondent's request, both parties must be granted a reasonable opportunity to be heard for the purpose of modifying, revoking, or approving provisional measures.

## Orders in cases of infringement

An IPR court in Myanmar can, under Section 81, issue various orders in cases of trademark infringement, while also emphasizing the need for proportionality and consideration of other stakeholders' interests. In detail, an IPR Court has the authority to issue one or more of the following orders, keeping in mind that these orders do not supersede any civil-related laws or the Code of Civil Procedure in suits under subsection (b) of section 77.

- *Prevention Order*: The court may issue an appropriate order to prevent the infringement of mark rights. This includes the prevention of imported goods that violate mark rights, and for which duties have been paid to the Customs Department, from entering the commercial area of Myanmar.
- *Compensation Order (Payment of Damages)*: The court may order the infringer to pay a sufficient sum to the right holder as compensation for the damages suffered due to the infringement of mark rights. In appropriate cases, the court can also award damages based on the amount set beforehand by the right holder or the profits gained by the infringer, or a combination of both.
- *Compensation of Expenses*: The court can order the infringer to pay an appropriate amount for the right holder's expenses, including court fees and attorney fees.
- *Removal of Infringing Goods*: The court may order the destruction or removal of mark rights infringing goods from the trade routes market. This action is taken without requiring payment of damages to avoid further harm to the right holder.
- *Removal of Infringing Equipment*: The court may order the destruction or removal of the equipment primarily used to produce the mark rights infringing goods from the commercial area.

## Compensation for false claims

Under Section 82, if a right holder falsely claims infringement without good faith, the court may order the right holder to compensate the respondent for damages, including court fees, attorney fees, and other expenses incurred.

## Orders requiring the other party to submit evidence

Section 83 of the Intellectual Property Rights Court provides guidance on the issuance of orders regarding the submission of evidence and decision-making in infringement cases, while also outlining the circumstances under which such actions may be taken:

### **(a)** Order to Submit Evidence:

The court is empowered to issue an order requiring the other party (defendant) to submit evidence while safeguarding confidential information. This order can be made under the following conditions:

*Sufficiency of Evidence*: When the right holder (plaintiff) has already presented sufficient evidence to substantiate their claims, the court can compel the defendant to provide additional evidence to support their defense.

*Possession of Evidence:* If it is evident that the defendant possesses relevant evidence related to the claims made by the right holder, the court can order the defendant to produce such evidence for examination.

#### **(b) Decision-Making in Insufficient Grounds Cases:**

In cases where there is insufficient evidence to support claims of infringement, an IPR court in Myanmar has the authority to take certain actions after conducting a hearing between the involved parties and considering their respective evidence and accusations. These actions include:

*Confirmation or Refusal:* The court may independently confirm or refuse the claims of infringement based on the information provided by both the right holder and the infringer during the hearing.

*Preliminary Decision:* The court can make a preliminary decision on the case when either party fails to obtain necessary information, leading to inadequate evidence.

*Final Decision:* In situations where one party fails to deliver the required information within a reasonable period or significantly hinders the procedural aspects of the case, the court may proceed to make a final decision based on the available evidence and the conduct of the parties.

#### **Fines for offenses prosecuted under the law**

The court may order the payment of all or part of fines as damages to the grieved party in cases where offenses are prosecuted under the Trademark Law.

#### **Set-off of damages paid in civil suits**

Damages paid to the grieved party in a civil suit judgment, order, or decree may be set off from the fines imposed in criminal actions.

#### **Use of existing laws for action against trademark infringement**

When taking action against trademark infringement, the intellectual property rights court may use existing laws, such as the Evidence Act, Criminal Procedure Code, Civil Procedure Code, and other related laws, in the absence of specific provisions in the Trademark Law.

#### **Final thoughts**

Myanmar's Trademark Law, through Sections 77-86, provides a robust legal framework to protect the rights of trademark owners. By empowering right holders to pursue civil and criminal actions against infringements, and granting the IPR court the authority to issue provisional measures and appropriate orders, Myanmar demonstrates its commitment to safeguarding IPR. These provisions not only encourage compliance with trademark laws but also contribute to a fair and conducive environment for legitimate trade in the country's thriving business landscape.

As a firm that offers trademark services, KENFOX stands ready to assist our clients in navigating the complexities of Myanmar's Trademark Law. With a profound understanding of the legal intricacies, we equip our clients with the knowledge and expertise necessary to protect and defend their trademark rights in this dynamic and evolving marketplace.

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