

## Trademark Registration in Myanmar under New Trademark Law: 10 Things to Know

Myanmar's new Trademark Law marks a promising chapter for intellectual property protection, offering businesses a valuable opportunity to secure their brand identities in this emerging market. To make the most of this exciting development, understanding the key provisions outlined in the law is essential. In this guide, we, at KENFOX, would like to equip businesses with the essential knowledge needed to successfully navigate the trademark registration process.

### 1. Ground to establish trademark rights in Myanmar

Per Section 15 of the Trademark Law of Myanmar, to fully enjoy the rights and protections associated with a trademark, applicants must follow the formal process of applying for trademark registration with the Registrar. By registering their trademark, applicants secure exclusive rights to use the mark in connection with the goods or services for which it is registered, and they gain the ability to take legal action against potential infringers. Therefore, merely using a trademark in commerce may not be sufficient to gain all the legal benefits and safeguards that come with official registration.

### 2. Required documents and information for trademark application in Myanmar

When applying for the registration of a trademark in Myanmar, the applicant must ensure that the application contains the necessary documents and information as specified by the new Trademark Law. Per Section 17 of the Trademark Law of Myanmar, here are the essential documents and details that must be included in the application:

#### (a) Mandatory Requirements:

- *Application for Registration:* The applicant must submit a formal application requesting the registration of the trademark.
- *Name and Address:* The application should include the name and address of the individual or legally formed organization applying for the trademark registration.
- *Agent or Representative Information:* If the applicant appoints an agent or representative to handle the trademark registration process on their behalf, the name, citizenship scrutiny card number, and address of the agent or representative must be provided.
- *Clear and Complete Description of the Mark:* A detailed and unambiguous description of the mark is crucial. The description should precisely depict the visual representation or design of the trademark.
- *Goods and/or Services Information:* The application should specify the name and type of goods and/or services for which the request for trademark registration is made. Additionally, the category of international mark classification to which the goods or services belong should be stated.

#### (b) Additional Requirements (If necessary):

- *For Legally Formed Organizations:* If the application is made on behalf of a legally formed organization, the registration number, type, and country of the organization should be attached to the application.
- *Right of Priority Request:* If the applicant seeks the right of priority based on a previous trademark application in another country, an application for the right of priority must be submitted. Sufficient evidence proving the applicant's right of priority and a description supporting the claim should also be included.
- *Right of Priority for Trade Exhibitions:* In case the applicant is claiming the right of priority based on the display of the mark at an international trade exhibition, an application for the right of priority for trade exhibitions must be submitted. Sufficient evidence supporting the right of priority for trade exhibitions and a description should be attached.
- *Documentary Evidence of Registered Marks:* If the mark is already registered at the documents registration office, documentary evidence proving such registration should be included in the application.

- *Other Requirements:* The applicant should be aware of any additional requirements stipulated by the Agency and the Department from time to time. It is essential to stay updated with any changes or new regulations that may affect the trademark application process.

### 3. Application requirements in Myanmar

Under Section 16 of the Myanmar Trademark Law, the applicant may write the registration application in Myanmar or English. If requested by the Registrar, the applicant must translate the application from one language to the other and provide a signed statement verifying the accuracy of the translation.

### 4. Filing date of trademark applications in Myanmar

Per Section 18 of the Trademark Law of Myanmar, the date of submission of a complete application, along with the prescribed fee, is deemed as the filing date of the trademark application in Myanmar.

### 5. Right of priority

Sections 31 to 33 address the right of priority, which grants applicants a six-month period to apply for registration in Myanmar following an initial application in a Member State of the Paris Convention or the World Trade Organization.

### 6. Examination of trademark applications in Myanmar

Section 23 of the Trademark Law of Myanmar outlines a comprehensive and structured process for the examination of trademark applications. The Examiner will examine the application to determine if it meets the provisions of Section 13 and includes the necessary information as per Section 17. If necessary revisions are required, the applicant will be notified, and failure to comply within 30 days may result in application withdrawal.

It is of note that no explicit timeline is provided for completing a substantive examination for a trademark application in Myanmar.

#### 6.1. Absolute grounds for refusal

Section 13 of the Trademark Law of Myanmar highlights the characteristics of a mark that constitute **absolute grounds for refusal**. Marks lacking distinctiveness or containing indications of goods or services' type, quality, origin, or other characteristics may be ineligible for registration. Additionally, marks that may be detrimental to public order, reputation, beliefs, or the Union's traditions or that copy or imitate certain protected symbols and marks are also subject to refusal.

*Exceptions:* However, the Trademark Law provides exceptions for certain circumstances. If the mark's distinctiveness is known among consumers due to prior use or if the applicant is exclusively using the mark within the commercial area of Myanmar in good faith, the grounds for refusal may not apply.

#### 6.2. Relative grounds for refusal

Section 14 of the Trademark Law of Myanmar addresses **relative grounds for refusal**, which may render a mark ineligible for registration. Such grounds include marks that mislead consumers by being identical or similar to already registered marks or marks for which registration has been applied beforehand for similar goods and services. Marks that infringe upon others' intellectual property rights or harm the individual rights of any person or legally formed organization may also face refusal.

#### 6.3. Handling of identical or similar trademark applications

Per Section 19 of the Trademark Law of Myanmar, if multiple applications for identical or similar marks are submitted on different dates, the Registrar will allow only the first applicant whose application meets the stipulations to register the mark. In cases of conflicting right of priority claims, the applicant with the earliest right of priority date, meeting the requirements, will be allowed to register the mark.

#### 6.4. Resolution of trademark applications with the same date

Per Section 20 of the Myanmar Trademark Law, when more than one applicant requests the registration of identical or similar marks on the same date or has the same right of priority date, the Registrar will direct the applicants to negotiate among themselves to determine the registrant. Based on the negotiations, the

applicants must submit the name of the applicant who receives the nomination for the registration of the mark to the Registrar. If, despite the Registrar's directive to negotiate, the applicants are unable to reach a consensus, the Registrar steps in and follows a prescribed decision-making method. This method likely involves a formalized process that considers various factors, including the evidence presented by each applicant, the distinctiveness and nature of the marks in question, and the legal requirements for trademark registration.

## 7. Amendments, corrections, or withdrawals to the trademark application in Myanmar

Section 21 of the Trademark Law of Myanmar provides valuable provisions that enable an applicant for the registration of a mark to make necessary amendments, corrections, or withdrawals to the application as required.

(a) Applicant's Rights for Amendments, Corrections, and Withdrawals:

*Application Amendments:* An applicant has the right to request amendments to the application, including the translation and documentary evidence, if there are any text errors or other errors that can be corrected. This provision ensures that applicants have the opportunity to correct mistakes or inaccuracies in their application before the Registrar or the Agency makes a final decision on the acceptance or refusal of the application.

*Application Withdrawal:* In cases where an applicant decides not to proceed with the registration of the mark, they can apply for the withdrawal of the application. This option provides flexibility to applicants who might have changed their minds or encountered circumstances that make proceeding with the registration impractical.

*Separation or Limitation of Goods and Services:* The applicant can request the Registrar to amend the application by either separating an application that includes multiple goods or services into more than one new application or limiting the submitted list of goods or services without adding new ones. This feature allows applicants to fine-tune their application and ensures that each application precisely reflects the intended scope of protection for different goods or services.

(b) Date of Submission for Separate Applications:

*Continuity of Original Application:* According to subsection (a)(3) of Section 21, when the applicant separates an application or limits the list of goods or services, the date of submission for the separate registration applications will be considered the same as the date of submission of the original application. This provision ensures that the applicant retains the benefit of the original application date for the separate applications.

## 8. Request registration of a mark even after missing the initial compliance deadline

Section 24 outlines the process for registering a mark and the conditions under which an applicant may request registration of a mark even after the failure to comply within the stipulated period, provided certain conditions are met.

*Request for Registration of Mark with Delayed Compliance:*

Section 24(a) of the Trademark Law of Myanmar allows an applicant to request the registration of a mark despite not complying within the specified time frame. This request can be made if the failure to comply within the stipulated period would otherwise result in the loss of rights connected to the relevant mark application. In other words, if an applicant misses a deadline or requirement, they have the opportunity to make a request to register the mark even after the initial deadline has passed.

*Conditions for Making the Request:*

To be eligible to make such a request, the applicant must fulfill several conditions:

(a) *Time Limit:* The applicant must submit the request within 60 days from the date of withdrawal due to the failure to comply within the stipulated period. This means that the applicant has a grace period of 60 days after the original deadline to submit the request.

(b) *Submission of Explanations and Information:* The applicant must attach all explanations, information, or requirements related to the failure to comply within the stipulated period. This is to ensure that the authorities have a clear understanding of why the initial deadline was not met.

(c) *Sufficient Reasons*: The applicant must describe sufficient reasons for the failure to comply within the stipulated period in the request. The reasons provided should justify the delay and demonstrate that the failure to comply was due to valid and acceptable reasons.

(d) *Prescribed Fee*: The applicant must pay the prescribed fee for making the request. This fee likely covers administrative costs and processing the request.

#### *Suspension of Request during Appeal:*

Section 24(b) of the Trademark Law of Myanmar specifies that if the applicant has already made a request to restore the rights related to the request under subsection (a) during the period of appeal, the Registrar must suspend the request under subsection (a). This means that if there is an ongoing appeal process related to the registration of the mark, the request to restore rights under subsection (a) will be put on hold until the appeal is resolved.

### **9. Allowing registration of a forfeited mark**

Section 25(a) of the Trademark Law of Myanmar empowers the Registrar to permit the registration of a mark after examination, but only if the applicant makes a request to register a forfeited mark under subsection (a) of Section 24. This section essentially states that if an applicant had previously forfeited their right to register a mark due to failure to comply within the stipulated period (as explained in Section 24), they still have a chance to request registration again. The Registrar has the authority to consider such a request and, if the conditions mentioned in Section 24(a) are met, the Registrar may allow the mark to be registered despite the initial forfeiture.

### **10. Filing a Notice of Opposition**

Section 26 of the Trademark Law of Myanmar deals with the process for filing objections (Notices of Opposition) to a trademark application. It grants the right to any person who believes that an application for the registration of a mark does not meet the requirements specified in Sections 13 and 14 to raise an objection against the registration.

*Opposition grounds*: The grounds on which a person can raise an objection are based on whether the application fulfills any of the requirements mentioned in Sections 13 (*i.e., absolute refusal grounds*) and 14 (*i.e., relative refusal grounds*).

*Opposition Form and Fee*: To raise an objection, a person needs to fill out and submit an objection form to the Registrar. The form likely includes details of the trademark application under consideration and the specific grounds on which the objection is based.

Additionally, a prescribed fee must be paid along with the objection form. This fee is likely set by the relevant authority and covers the administrative costs associated with processing the objection.

*Time Limit for Opposition*: A person has 60 days from the date of the public announcement (mentioned in Section 25(b)) to submit the objection form and the prescribed fee. This 60-day window serves as the opportunity for interested parties to thoroughly review the trademark application and raise any valid objections.

Per Section 27, the Registrar is responsible for notifying the applicant of the objection (opposition), requesting the applicant to submit a counter-opinion within a certain timeline.

Under Section 28, the Registrar are responsible for actions in response to the trademark application and any objections received as follows:

*Allowance of Mark Registration*: If no objections are submitted within 60 days from the date of the public announcement, the Registrar may allow the registration of the mark stated in the application. This means that if there are no valid objections raised, the mark may proceed towards registration.

*Examination of Objections*: If objections are submitted within the specified time frame, the Registrar must examine whether the objections meet the provisions of Sections 13 (*i.e., absolute ground refusal*) and 14 (*i.e., relative ground refusal*). This evaluation determines whether the objections are well-founded and have valid grounds.

*Decision on Registration:* Based on the examination of objections, the Registrar has the authority to either allow or refuse the registration of the mark. If the objections are found to be valid and the application does not meet the required criteria, the Registrar may refuse registration.

*Record-Keeping and Notification:* The Registrar must enter the allowance or refusal of the mark registration into the registration records. Furthermore, the applicant must be notified of the outcome of the decision.

*Public Announcement:* The outcome of the decision (allowance or refusal) must be announced to the public in a manner consistent with the stipulations, likely referring to the rules and regulations regarding public notifications.

*Issuance of Registration Certificate:* If the registration of the mark is permitted, the Registrar must issue the registration certificate of the mark to the applicant, confirming the successful registration.

### **A bottom line**

As Myanmar's economy continues to flourish, securing trademark rights becomes crucial for businesses seeking a competitive edge. By understanding and adhering to the key provisions in Myanmar's Trademark Law, applicants can confidently navigate the registration process and establish a strong foothold in this emerging market. At KENFOX, we are committed to assisting businesses in securing their intellectual property rights and guiding them through every step of the trademark registration journey. With our expertise and dedication, your brand's identity will be well-protected in Myanmar's dynamic and promising trademark landscape.

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