

The Trademark Law
(The Pyidaungsu Hluttaw Law No. 3, 2019)
The 10th Waning Day of Pyatho, 1380 M.E.
(30th, January 2019)

The Pyidaungsu Hluttaw hereby enacts this Law.

Chapter I

Title, Enforcement and Definitions

1. (a) This Law shall be called **the Trademark Law**.
- (b) This Law shall come into force on the date prescribed, by notification, by the President.
2. The following expressions in this Law shall have the meanings given below:
 - (a) **State** means the Republic of the Union of Myanmar;
 - (b) **Central Committee** means the Central Committee on Intellectual Property formed under this Law;
 - (c) **Ministry** means the Ministry of Commerce of the Union Government;
 - (d) **Relevant Ministry** means the Ministry of Information, Ministry of Industry, Ministry of Agriculture, Livestock and Irrigation or Ministry of Education of the Union Government;
 - (e) **Agency** means the Intellectual Property Agency formed under this Law;
 - (f) **Department** means the Department assigned by the Ministry to carry out intellectual property matters;
 - (g) **Registrar** means the Director General of the Department who carries out the functions relating to the registration of intellectual property;
 - (h) **Examiner** means an officer from the department who is at the level of assistant director or higher level thereof conducting examination of the registration process of intellectual property;
 - (i) **Intellectual property rights** means the rights vested by law to protect the own intellectual creations. This expression includes

copyright, patent, industrial design, trademark, and other forms of intellectual property rights;

- (j) **Mark** means any visually perceptible sign in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs capable of distinguishing the goods or services of one undertaking from those of other undertakings. This expression includes the trade mark, service mark, collective mark and certification mark;
- (k) **Trademark** means any mark capable of distinguishing the goods of one undertaking from those of other undertakings in trade;
- (l) **Service mark** means any mark capable of distinguishing services of one undertaking from those of other undertakings in trade;
- (m) **Collective mark** means any mark owned by a collective such as an association or a federation of industries, producers or traders or socio-economic organizations or cooperatives. This expression includes a mark capable of distinguishing the goods or services of the members of the collective from the goods or services of other undertakings;
- (n) **Certification mark** means any mark used in connection with goods or services certified by the owner of a mark as to their origin, quality, standard or other characteristics and which are used under the control of the owner of a mark;
- (o) **Geographical indication** means any indication which identifies goods as originating in the territory of a country or a region or a locality in that territory, where a given quality, reputation or other characteristics of the goods is essentially attributable to its geographical origin;

- (p) **Well-known mark** means any mark that is well-known in the State according to the prescribed criteria;
- (q) **Trade name** means the name or designation identifying and distinguishing an enterprise;
- (r) **Owner of a mark** means the person or legal entity recorded as the owner of a registered mark in a register of the Department;
- (s) **Right holder** means any natural person or legal entity, who has the right for a registered mark, that is to be regarded as the owner of a mark or a well-known mark or a geographical indication or a trade name or a transferee or a licensee of the registered mark;
- (t) **Member State** means any member State of the conventions, treaties or agreements or of international organizations or regional organizations relating to intellectual property, of which the State is a member;
- (u) **Intellectual Property Court** means the court established by the Supreme Court of the Union under the law to adjudicate intellectual property matters or the court conferred jurisdiction and authority of such court;
- (v) **Right of priority** means the right of priority in section 31 of this Law;
- (w) **Right of exhibition priority** means the right of exhibition priority in section 32 of this Law.

Chapter II

Objectives

- 3. The objectives of this Law are as follows:
 - (a) to develop investment, trade and commerce by protecting the marks;
 - (b) to protect the interests of the owner of a mark and the right holder;

- (c) to create a fair competitive market system and a safety environment for the public by prohibiting the import of counterfeit marks and goods to the market place;
- (d) to improve the qualities of the products of Myanmar by the protection of geographical indications, and to develop the economy of the public in locality by exporting to the international market.

Chapter III

Formation of the Central Committee and its Functions and Duties

4. The Union Government:

(a) shall, to deal with intellectual property matters, form the Central Committee on Intellectual Property as follows:

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| (i) Vice President | Chairperson |
| (ii) Union Minister of the Ministry | Vice-Chairperson |
| (iii) Deputy Ministers from the relevant Ministries | Members |
| (iv) Deputy Ministers or Directors General from other appropriate Ministries | Members |
| (v) No more than four intellectual property experts | Members |
| (vi) Two representatives from non-governmental organizations | Members |
| (vii) The person assigned by the President | Secretary |
| (viii) Director General of the Department | Associate Secretary |

(b) may re-form the Central Committee under subsection (a), as may be necessary.

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

- (a) adopting the intellectual property policies, strategies and action plans to develop the intellectual property matters in the State;
- (b) supervising the implementation of the intellectual property policies, strategies and action plans;
- (c) guiding, through the intellectual property system, to encourage the development of national economy, foreign investment, and small and medium enterprises of the State;

- (d) encouraging training and nurturing the necessary human resources for the development of the intellectual property matters;
- (e) coordinating with the relevant government departments, government organizations, other organizations and private entrepreneurs to practise and develop the intellectual property system effectively;
- (f) encouraging and promoting the coordination with local and foreign organizations for technical and other necessary assistance;
- (g) carrying out functions and duties relating to intellectual property assigned by the Union Government from time to time.

Chapter IV

Formation of the Agency and its Functions and Duties

6. The Central Committee:

- (a) shall form the Intellectual Property Agency with the approval of the Union Government as follows:

(i) Secretary of the Central Committee	Chairperson
(ii) Directors General who are concerned with the Agency from the Ministry and the relevant Ministry	Members
(iii) No more than eight intellectual property experts	Members
(iv) No more than five representatives from non-governmental organizations	Members
(v) Director General of the Department	Secretary
(vi) Division Heads of the Department	Associate Secretaries

- (b) may re-form the Agency under subsection (a), as may be necessary.

7. The Chairperson of the Agency shall be considered to be a person who is at the level of the Deputy Minister.

8. The functions and duties of the Agency are as follows:

- (a) coordinating the functions relating to the trademark;
- (b) implementing trademark policies, strategies and action plans adopted by the Central Committee, and training and nurturing human resources for the development of the trademark system;

- (c) observing the conventions, treaties and agreements relating to the trademark and giving suggestion that the State should accede to them to be a member, to the Central Committee;
- (d) implementing the functions of the trademark in line with the provisions of the conventions, treaties and agreements relating to the trademark of which the State is a member;
- (e) cooperating with the relevant local, international and regional organizations relating to the trademark and member States;
- (f) forming necessary working groups and prescribing their functions and duties with the approval of the Central Committee to take action on infringement of trademark;
- (g) forming necessary working groups to implement functions relating to the trademark, and prescribing their functions and duties with the approval of the Central Committee;
- (h) protecting the qualified products which are produced by each region of the State for the development of the economy of the public in locality;
- (i) making a decision on an appeal against the decision of the Registrar;
- (j) prescribing the fees to be collected in accordance with this Law with the approval of the Union Government through the Central Committee;
- (k) approving the seal to be used in granting registration of the trademark;
- (l) submitting the task reports and other necessary reports to the Central Committee;
- (m) submitting the annual trademark report to the Central Committee;
- (n) carrying out the functions and duties relating to intellectual property assigned by the Central Committee from time to time.

Chapter V

Functions and Duties of the Department

9. The functions and duties of the Department are as follows:
 - (a) publishing the matters on registration of trademarks;
 - (b) maintaining the register of trademarks;
 - (c) supervising the performance of the Divisions formed in the respective field of intellectual property;
 - (d) carrying out the functions and duties relating to intellectual property assigned by the Agency from time to time.

Chapter VI

Appointing the Registrar and Examiners and Prescribing their Functions and Duties

10. The Ministry may appoint the Registrar and necessary Examiners in the Department according to the submission of the Agency to carry out the functions relating to intellectual property.
11. The duties of the Registrar are as follows:
 - (a) supervising the functions relating to the application for and examination of the registration of marks;
 - (b) coordinating upon the submission of the Examiner's report in carrying out the registration of marks;
 - (c) making a decision on the registration of marks;
 - (d) carrying out the functions and duties relating to intellectual property assigned by the Central Committee and the Agency.
12. The duties of the Examiner are as follows:
 - (a) examining the application for the registration of marks and geographical indications;
 - (b) submitting the findings with remarks to the Registrar after examining the opposition and objection in respect of the application for the registration of marks;

- (c) summoning and examining the necessary persons, and calling for the documents with the approval of the Registrar in carrying out the registration of marks;
- (d) submitting the remarks to the Registrar whether the registration should be granted or not after examining the application of marks;
- (e) carrying out the functions and duties relating to intellectual property assigned by the Agency, Department and Registrar.

Chapter VII

Non-registrable Marks

13. A mark that falls under any of the following absolute grounds for refusal shall not be registrable:

- (a) lack of distinctive character;
- (b) consisting exclusively of signs or indications which may serve to designate the kind, subject matter, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or rendering of services, or other characteristics of the goods or services;

Exception: A mark shall not be refused registration in accordance with subsections (a) and (b) if it falls under any of the following:

- (i) having the acquired distinctive character as a result of use among consumers before the date of application for registration;
 - (ii) using the mark continuously and exclusively in good faith in the course of trade in the State by the applicant;
- (c) affecting the public order, morality, faith and conscience, integrity of the State, or venerated culture, and cherished customs of ethnic groups of the State;
- (d) becoming the generic or customary in the current language or in the bona fide and established practices of the trade;

- (e) misleading the public or trade circle in respect of subsection(b);
- (f) consisting of the total or partial reproduction or imitation of a flag, armorial bearings, or other emblems adopted by a State or an international intergovernmental organization; an official sign or hallmark indicating control and warranty adopted by a State; abbreviations and names of an international intergovernmental organization, unless authorized by the competent authorities of the State or of the relevant international intergovernmental organization;
- (g) using the emblems protected under international treaties to which the State is a contracting party.

14. Any mark that falls under any of the following relative grounds for refusal shall not be registrable:

- (a) being identical with or similar to a registered mark or earlier applied mark or priority claimed mark in the name of a different person, the goods or services in respect of which registration has been requested are identical with or similar to the goods or services for which the earlier mark has been registered or applied for and the use of the sign would cause a likelihood of confusion with that mark by the users;
- (b) using the mark affecting personality rights of a person or the reputation of the legal entity without the permission of the relevant person or legal entity;
- (c) being the mark that infringes the copyright or industrial property right of a third party;
- (d) filing the mark in bad faith;
- (e) being identical with or similar to a well-known mark, the goods or services in respect of which registration of the sign is applied for are identical with or similar to the goods or services for which the

well-known mark is used and the use of the sign would cause a likelihood of confusion with that mark;

- (f) being identical with or similar to a registered well-known mark, the goods or services in respect of which registration of the sign is applied for are dissimilar to the goods or services for which the well-known mark is registered, the use of the sign would indicate a connection between the goods or services for which it is used and the owner of the registered well-known mark, and the interests of the owner of the registered well-known mark are likely to be damaged by such use.

Chapter VIII

Application

15. In order to have the right of a registered mark under this Law, any person entitled to the registration of a mark may file an application to the Registrar in the prescribed manner.

16. The applicant for the registration of a mark:

- (a) may make the application for registration either in Myanmar or English;
- (b) shall translate the application from Myanmar into English or English into Myanmar if requested by the Registrar;
- (c) shall certify the translation under subsection (b).

17. The applicant for the registration of a mark shall:

- (a) mention the following facts in the application:
 - (i) a request for registration;
 - (ii) the name and address of the applicant or legal entity;
 - (iii) name, citizenship scrutiny card number and address of the representative where the application is filed by the representative;
 - (iv) a sufficiently clear representation of the mark;

- (v) the names and classes of the goods and/or services for which the registration is sought, grouped according to the classes of the international classification (Nice Classification);
- (b) attach the following facts, if necessary, in addition to subsection (a):
- (i) where the application is filed for a legal entity, registration number, type and name of the country of that legal entity;
 - (ii) where the applicant wants to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with indications and evidence in support of the declaration of priority;
 - (iii) where the applicant wants to take advantage of any priority resulting from the display of goods and/or services in an exhibition, a declaration to that effect, together with indications and evidence in support of that declaration of exhibition priority;
 - (iv) evidence of a registered mark if the mark which is requested for the registration has been registered at the Office of the Registration of Deeds;
 - (v) any other elements prescribed by the Agency and Department from time to time.

18. The date on which the application of a mark, in accordance with subsection (a) of section 17, received by the Department shall be presumed to be the filing date of the application for registration in the State, subject to the payment of fees.

19. The Registrar shall:

- (a) where more than one party applies to register identical or similar marks on different dates and any dispute arises, grant registration to the earliest applicant submitting the application consistent with the requirements for registration;
- (b) where each and every applicant claims the right of priority or the right of exhibition priority under subsection (a) and any dispute arises, grant registration to the applicant submitting the application

for the registration of the mark that has earliest filing date and conforms with the requirements for registration.

20. Where more than one applicant has filed the application for registration of identical or similar marks on the same date or have requested for the same priority date:

- (a) the Registrar shall direct all applicants to submit the name of a person whom they want to prescribe as a mark applicant after consultation among themselves, within a prescribed period;
- (b) the applicants shall, in accordance with the direction of the Registrar, resubmit the name of a person whom they have agreed to specify as a mark applicant after consultation among themselves, such point to the Registrar;
- (c) although the Registrar directs all applicants under subsection (a), if no agreement is reached among them, the applicants shall follow the Registrar's decision in the prescribed manner.

21. (a) The applicant for the registration of a mark:

- (i) may file with the Registrar to correct any error of translation or transcription, clerical error or other mistakes in any application or document after subscribing the prescribed fees before the Registrar makes the decision on grant of or refusal to an application or before the Agency makes the decision on the appeal against the decision of the Registrar;
- (ii) may request to withdraw the application with respect to registration of a mark;
- (iii) may, subscribing the prescribed fees, apply to amend, divide any application listing several goods or services to the Registrar into more than one application and limit or reduce the list of specified goods or services but may not extend that list;

- (b) shall presume the filing date of a new divisional application for registration under clause (iii) of subsection (a) to be the date of initial application.

22. The Registrar may amend the application under section 21 in accordance with the stipulations after examining.

Chapter IX

Examination, Opposition and Registration

23. With regard to the application for registration of a mark, the Examiner shall:

- (a) submit the applications which conform to the provisions of sections 13 and 17 to the Registrar together with remarks after examining whether the application complies with the requirements;
- (b) notify the applicant to amend the application which does not conform to the provisions of sections 13 and 17 with the permission of the Registrar after examining whether the application complies with the requirements. If the applicant fails to amend the application within 30 days from the date of receipt of the notice, the application shall be considered as withdrawn;
- (c) submit the application to the Registrar together with remarks after examining if the amendment in accordance with the provisions of subsection (b) has been received.

24.(a) Where an applicant for the registration of a mark has failed to comply with a time limit for an action in a procedure and that failure has the consequence of causing a loss of rights with respect to an application for the registration of a mark, he may reapply for the registration of a mark to the Registrar if it meets the following requirements:

- (i) submitting a request within 60 days from the date of withdrawal of the application in respect of the cause of failure to comply with the time limit;

- (ii) providing the requirements, information or explanation in respect of the cause of failure to comply with the time limit;
- (iii) describing the sufficient reasons in the request for the failure to comply with the time limit;
- (iv) fees which had been paid.

(b) The Registrar shall suspend the reinstatement of rights under subsection (a) within the period of appeal.

25. The Registrar:

- (a) may allow the request, after examining the application if it is likely to cause the loss of rights in respect of the application for the registration of a forfeited mark and reapplying the application under subsection (a) of section 24;
- (b) shall publish the application in order to oppose for any person in the prescribed manner and that application complies with sections 13 and 17.

26. A person who wants to oppose the application for registration of marks may, within 60 days from the date of publication, file an opposition to the Registrar by subscribing the prescribed fees, and stating any grounds mentioned in sections 13 and 14.

27. If the Registrar receives the opposition, he shall send a notice to the applicant to defend the objection within the prescribed period.

28. With respect to the application for registration of a mark, the Registrar:

- (a) may grant the application for registration of a mark if the opposition is not filed within 60 days from the date of publication;
- (b) may grant or refuse the opposition after examining in accordance with the provisions of section 13 or 14, if the opposition is filed;

- (c) shall record such grant or refusal in the register, and notify the applicant. In addition, he shall publish such grant or refusal in the prescribed manner;
- (d) shall issue the certificate of a registered mark to the applicant if the registration is granted.

29. The owner of a mark:

- (a) may apply to the Registrar to issue the certified copy of the certificate of a registered mark after subscribing the prescribed fees if the original certificate is damaged or lost;
- (b) may apply to the Registrar to correct clerical error or other mistakes that may be permitted to correct, or to change nationality and address recorded in the register after subscribing the prescribed fees.

30. The Registrar:

- (a) shall issue the certified copy of the certificate of a registered mark after examining the application under subsection (a) of section 29;
- (b) may amend the application after examining under subsection (b) of section 29.

Chapter X **Right of Priority**

31. Where a person who has filed an application for the registration of a mark in any member State to the Paris Convention or the World Trade Organization, or his transferee applies to the Department for the registration of the same mark, in respect of goods or services which are identical with or contained within those for which the foreign application has been filed within 6 months from the first filing date, the first date of the application shall be enjoyed as giving rise to the right of priority.

32. Where the applicant has disclosed the mark at an official or officially recognized international exhibition held in any member State to the Paris

Convention or the agreement establishing the World Trade Organization, he may claim a right of priority from the date of the first disclosure of such mark in the exhibition, if he files the application in the Department within a period of 6 months from that date.

33. An exhibition priority shall not extend the filing date of priority under section 31.

Chapter XI

Term of Registration and Renewal of Registration

34. The term of registration of a mark shall be 10 years from the filing date of the registration of a mark. After the expiry of 10-year term of registration, each term of renewal shall be 10 years at a time.

35. The owner of a mark shall carry out the following if he wants to renew the registration of a mark:

- (a) he shall apply to renew within 6 months before the expiry of the term of registration of a mark by subscribing the prescribed fee;
- (b) he may apply to renew within the grace period of 6 months after the expiry of the term of registration of a mark. He shall pay the prescribed registration fees and late fees when applying as such.

36. The Registrar shall:

- (a) grant the request for renewal which conforms with the requirements. The renewal shall come into force from the date of expiry of the previous registration;
- (b) renew the term of registration for 10 years, and publish it in the prescribed manners after examining the application for renewal of registration;
- (c) record the renewal of registration and subscribed fee in the register;
- (d) remove the registered mark from the register if the owner of a mark does not subscribe the renewal fee within the grace period of 6 months;

- (e) record the removal of a mark in the register, and publish it in the prescribed manners.

Chapter XII

Rights of Registered Marks

37. If the owner of a mark complies with the provisions in Chapter XI, he enjoys the right of a registered mark in this Chapter within the period of registration of a mark.

38. Without prejudice to the provisions in sections 39 and 40, the owner of a mark is entitled:

(a) as an exclusive right:

(i) to prevent a third party if, without the owner's consent, he uses in the course of trade a sign which is identical with or similar to the mark in relation to goods or services which are identical with or similar to those for which the mark is registered where there exists a likelihood of confusion on the part of the public;

(ii) to sue the infringer of the rights of a registered mark in criminal or civil action or both;

(iii) to prevent any unauthorized third party if, without the owner's consent, he uses in the course of trade a sign which is identical with or similar to the registered well-known mark for goods or services which are dissimilar to those for which the registered well-known mark is used that fall under any of the following:

(aa) where such use would indicate a connection between the owner of a registered well-known mark and the goods or services which are used;

(bb) where the interests of the owner of a registered well-known mark are likely to be damaged by such use;

(b) to transfer or license the rights of a registered mark to any other person in accordance with the provisions in Chapters XIII and XIV.

39. The owner of a mark shall not be entitled to prohibit a third party from using in good faith for industrial or commercial purposes on the following matters:

- (a) his own name or address;
- (b) indications concerning kind, subject matter, quality, quantity, intended purpose, value, geographical origin, time of production or other characteristics of goods or services;
- (c) a mark to indicate the intended purpose of goods in particular as accessories or spare parts or services.

40. The owner of a mark shall not be entitled to prohibit a third party from using his mark in relation to goods which have been put on the market by the owner himself or by a third party with his consent.

41. Notwithstanding anything in section 40, the owner of a mark may, where the condition of the goods has been changed or impaired after they have been put on the market, prohibit the continuous use in the course of trade in conformity with the existing law.

Chapter XIII

Transfer of the Rights of a Mark

42. (a) The applicant for registration of a mark may apply to the Registrar to record the transfer of his application of a mark to any person or legal entity in the prescribed manners.
- (b) The owner of a mark may apply to the Registrar to record the transfer of ownership of a registered mark to any person or legal entity in the prescribed manners.

43. The Registrar shall record and publish any change in ownership of the registration of a mark where the applicant or the transferee under subsection (a) of section 42 or the owner of a mark or the transferred mark owner under subsection (b) of section 42 requests to record in the prescribed manner by subscribing the prescribed fees.

44. A change in the ownership of a registered mark shall have no effect unless it is applied to record to the Registrar.

Chapter XIV

Licence of the Registered Mark

45. The owner of a mark may license any person or legal entity to use the registered mark by determining the terms and conditions.

46. The owner of a mark or his licensee may apply to the Registrar to record the licence together with the certified copy of licensing documents by subscribing the prescribed fees.

47. The Registrar shall record the licence under section 46, and publish it in the prescribed manner.

48. The Registrar shall cancel the record of licence, and publish it in the prescribed manners if the owner of a mark or his licensee applies for cancellation of the record of licence in the prescribed manner.

49. A licence shall have no effect unless it is applied to record to the Registrar.

Chapter XV**Invalidation and Cancellation of the Registration of a Mark**

50. (a) According to the application of any interested person, the Registrar shall declare that the registration of a mark is invalid if it is proved that the mark does not comply with the definition provided in subsection (j) of section 2 or that the mark shall not be registrable for the absolute grounds for refusal in section 13.
- (b) According to the application of any interested person, the Registrar shall declare that the registration of a mark is invalid if it is proved that the registered sign shall not be registrable for any relative grounds for refusal in section 14.
- (c) Regarding the application for a declaration of invalidation of the registration of a mark, the Registrar shall declare that the registration of a mark is invalid on the final decision or judgment made by the court.
- (d) (i) An application for a declaration of invalidation pursuant to sub-section (a) may be made at any time.
- (ii) An application for a declaration of invalidation pursuant to subsection (b) may be made within five years period from the date of the registration, unless the registration was applied for in bad faith.
- (e) Where grounds of invalidation are related to only some of the goods or services for which the mark is registered, the registration of such goods or services shall be declared as invalidation.
- (f) The Registrar shall record the declaration of invalidation of a registered mark, and notify it to the owner of a mark and publish it.
51. (a) According to the application for the use of a mark of any interested

person, the Registrar shall cancel the registration of a mark on any of the following grounds that:

- (i) a registered mark has not been put to genuine use in the State in relation to the goods or services for which it is registered within a period of three years from the date of registration, and there are no proper reasons for failure to use;
 - (ii) the use of a registered mark has been suspended for an uninterrupted period of three years, and there are no proper reasons for failure to use; or
 - (iii) in consequence of acts or inactivity of the registered holder, a registered mark came to consist exclusively of indications which may serve, in trade, to designate the kind, subject matter, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods, or of indications that have become generic or customary in the current language or in the bona fide and established practices of trade.
- (b) For the purposes of subsection (a), the use of a mark includes the following:
- (i) use in a form differing in elements which do not alter the distinctive character of a mark in which it was registered;
 - (ii) use in the State includes affixing the mark to goods or to the packaging of goods solely for export purposes.
- (c) Where it is required to prove the use to which a mark has been put, including the duration, nature or scope of the use under this Law, the burden of such proof shall lie against the registered owner.
- (d) Where grounds for cancellation are related to only some of the goods or services for which the mark is registered, the registration shall be cancelled in relation to those goods or services only.
- (e) Where the registration of a mark is cancelled, the registration shall be deemed to have ceased.

- (f) The Registrar shall record the declaration of cancellation of a registered mark, inform it to the owner of a mark, and publish it.

52. No person shall use the mark refused or cancelled the registration by the Registrar since the mark is involved with subsection (c) of section 13.

Chapter XVI

Geographical Indication

53. Any legal entity representing the following persons of the locality in which the relevant goods is produced, desirous of registration of a geographical indication shall apply to the Registrar for registration in conformity with the stipulations:

- (a) persons who produce goods by exploiting natural products or natural resources;
- (b) producers of agricultural products;
- (c) manufacturers of products of handicraft or industry;
- (d) competent authorities from government departments and organizations on behalf of the persons indicated under subsections (a) to (c).

54. (a) An application for the registration of a geographical indication shall specify the following points in accordance with the stipulations:

- (i) name, nationality and address of the entity or representative;
 - (ii) the geographical indication for which registration is sought;
 - (iii) the geographical area to which the geographical indication applies;
 - (iv) the goods to which the geographical indication applies.
- (b) The application should be accompanied by the following:
- (i) a specification describing in sufficient details the specific characteristics or quality or reputation of the goods;
 - (ii) the link between a specific quality, the reputation or the characteristics of goods, geographical origin and method of production;
 - (iii) other prescribed particulars.
- (c) The application shall be subject to the payment of the prescribed fees.

55. The geographical indication that involves any of the following points shall not be entitled for registration:

- (a) not corresponding to the definition of geographical indication in subsection (o) of section 2;
- (b) being a generic term or customary in common language in the State of the goods that are to use such geographical indication;
- (c) being a geographical indication, which is contrary to the public order or morality or public policy.

56. Any interested person or relevant department or organization may apply to the Registrar for invalidation or cancellation of the registration of a geographical indication on the following grounds:

- (a) not corresponding to the definition of a geographical indication in subsection (o) of section 2;
- (b) no longer comply with the requirements laid down in the specification according to subsection (b) of section 54;
- (c) foreign geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country;
- (d) being a geographical indication, which is contrary to the public order or morality or public policy.

57. (a) Only producers carrying on their activities in the geographical area specified in the register shall have the right to use a registered geographical indication, in the course of trade, with respect to the products specified in the register. Provided that such products possess the quality, reputation or other characteristics specified in the register.

- (b) In the case of homonymous geographical indications, protection shall be accorded to each indication, provided that the practical conditions under which the homonymous indications will be differentiated from each other, taking into account the need to

ensure equitable treatment of the producers concerned and that consumers are not misled.

- (c) The right holder of the registered geographical indication shall have the rights to prevent the following matters:
 - (i) the use of any means in the presentation of the goods to be originated in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical indication of the goods;
 - (ii) any use of a registered geographical indication which constitutes an act of unfair competition;
 - (iii) any use of a geographical indication identifying goods not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the same.
- (d) The rights under subsections (a) and (c) do not apply to another geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

58. (a) Whether the application complies with sections 53, 54 and 55, the Registrar shall publish the content of the application and specification in the prescribed manners.

(b) A person who intends to oppose the registration of geographical indications may apply, *mutatis mutandis*, the provisions relating to the opposition of marks.

(c) Where no opposition of the registration is received or the opposition is rejected by the Registrar, the geographical indication shall be registered.

59. The term of the protection of a geographical indication shall be valid from the filing date of the application under this Law as long as the product specifications compliance with such as quality, characteristic and reputation are longer ensured.

60. (a) After applying the registration of a geographical indication under this Law, the registration of a mark the use of which would contravene section 57 and which relates to the product of the same type shall be refused by the Registrar if the application for registration of a mark is submitted.
- (b) The registered marks shall be invalidated when the marks fall under subsection (a).
- (c) A mark the use of which contravenes section 57 which has been applied for or registered in good faith before the date on which the application for protection of a geographical indication is submitted to the Registrar, may continue to be used for that product notwithstanding the registration of a geographical indication, provided that no grounds exist under Chapter XV. In such cases, the Registrar shall permit the use of a protected geographical indication as the use of the relevant marks.
61. (a) Protected geographical indications shall be subjected to official controls by competent authorities. Competent authorities may delegate the part of control activities to a third party.
- (b) Official controls shall cover:
- (i) compliance of products registered as geographical indications with the corresponding product specifications;
- (ii) use of registered geographical indications names on the market.
- (c) The cost of official controls related to the compliance with product specifications may be partially borne by the interested parties subjected to these controls.
62. The enforcement provisions in case of the infringement of mark in this Law shall apply, *mutatis mutandis*, to the implementation of the rights to the geographical indication.

Chapter XVII

Trade Name

63. (a) A trade name shall be protected without the obligation of registration, whether or not it forms the part of a mark.

- (b) A name or designation may not be used as a trade name if by its nature or use to which it may be put, it is contrary to the public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name or a designation.
- (c) A trade name shall be protected against any unauthorized use of the identical or similar sign whether used as a trade name or a mark if that use is likely to mislead the public.

Chapter XVIII

Application for International Registration

64. The applicants for the registration of a mark from Myanmar or foreign countries may file with the Registrar in the prescribed manners if they want to exercise the International Trade Mark Registration System called Madrid System after the State has become a member of the International Trademark Registration System.

Chapter XIX

Appeal

65. (a) Any person who is dissatisfied with any decision made by the Registrar under this Law may appeal to the Agency within 60 days from the date of publication of such decision.
- (b) The Agency may confirm, cancel or revise the decision of the Registrar, or direct that further evidence shall be produced in the appeal under subsection (a).
- (c) The Agency may confirm, cancel or revise the decision of the Registrar if further evidence is submitted under subsection (b).
66. Any person who is dissatisfied with the decision made by the Agency may file a case in the Intellectual Property Court which is vested the

jurisdiction by the Supreme Court of the Union for this purpose within 90 days from the date of receiving the notice of such decision.

Chapter XX

Establishment of the Intellectual Property Courts

67. The Supreme Court of the Union:

- (a) may establish the Intellectual Property Courts in any appropriate places, and appoint judges to adjudicate on the criminal or civil cases with respect to the intellectual property matters;
- (b) may confer the jurisdiction and authority to the judges appointed under subsection (a) to adjudicate on the intellectual property matters;
- (c) may confer the jurisdiction and authority of the Intellectual Property Courts to the appropriate courts to adjudicate on the intellectual property matters before the establishment of the Intellectual Property Courts under subsection (a);
- (d) shall confer the jurisdiction and authority to the Intellectual Property Courts that have jurisdiction over appeal and revision cases against any judgment, order and decision made by the Intellectual Property Courts;
- (e) shall confer the jurisdiction and authority to the appropriate Intellectual Property Courts to adjudicate on the cases under section 66.

Chapter XXI

Protection on Rights of the Registered Mark by the Customs Department

68. The right holder who has absolute grounds for suspecting that the importation of alleged counterfeit mark goods into the territory of the State has taken place, is taking place or will take place may submit an application in accordance with the stipulations, to the Director General of the Customs Department to issue the suspension order of the release of such goods into free circulation.

69. (a) The Director General of the Customs Department:

- (i) shall, within 30 days from the date of receipt of an application under section 68, notify the applicant whether the application has been granted or rejected;

- (ii) if not satisfied because of the lack of information necessary for adjudication of the application, with a notice to the applicant shall defer its decision in order to enable the applicant to submit additional information within 15 days from the date of notification;
 - (iii) may determine that the applicant shall provide a security to the Customs Department in accordance with the stipulations in granting the application;
 - (iv) shall clearly state the reason if the application is rejected.
- (b) Unless the applicant requested a shorter period, the activities under subsection (a) shall be effective for a period of 6 months.
70. (a) Following the acceptance of the application according to section 69 and according to the finding of the Customs Department, and if they have valid grounds for suspecting that imported goods are counterfeit mark goods, the Director General of the Customs Department shall suspend the release of such goods, and immediately inform the right holder and importer of such suspension.
- (b) Without prejudice to the protection of confidential information, the Director General of the Customs Department shall permit the right holder and the importer sufficient opportunity to inspect the goods subject to suspension in order to substantiate the rights holder's claim that the goods are counterfeit mark goods, and for no other purpose.
71. (a) The goods shall be released if within a period not exceeding 15 days after the applicant has been served the notice of suspension, the Director General of the Customs Department has not been informed that proceeding leading to a decision on the merits of the case have been initiated by the right holder or that the Intellectual Property Court has taken provisional measures prolonging the suspension of the release of goods. In appropriate cases, this time limit may be extended by another 15 days by the written decision of the Director General of the Customs Department before the expiry of 15 days.
- (b) If it is the perishable goods, the period is 3 days.

72. After receiving the notice, the importer may apply to the Intellectual Property Court if dissatisfied with pending the determination of the merits, for a review of the suspension and for the opportunity to be heard. The Intellectual Property Court shall, within a period 30 days from the request for a review, modify, revoke or confirm the terms of the suspension.

73. Where the Intellectual Property Court determined that the goods are counterfeit mark goods, the importer is liable to pay the costs of storage, destruction or disposal of infringing goods to the Customs Department. If the Director General of the Customs Department is unable to recover the said costs from the importer, the right holder shall be liable to pay said costs but shall be entitled to recover any costs so paid from the importer.

74. Where it has been determined that the goods are not counterfeit mark goods, the importer shall be entitled to the payment of damages by the applicant in an amount determined by the Intellectual Property Court because of the wrongful suspension and detention of the goods concerned.

75. The provisions in this Chapter shall not be applicable to counterfeit mark goods of non-commercial nature, and intended for the importer's own personal use contained in personal luggage, or sent in goods prescribed in the Regulations.

76. The Director General of the Customs Department may exchange information, and cooperate with the World Customs Organization and the Director General of the Customs Department of other countries in respect of alleged counterfeit mark goods.

Chapter XXII

Authority of Intellectual Property Courts on Infringements of Trademark

77. (a) The right holder may file a civil miscellaneous case for his grievance in the Intellectual Property Court to order provisional measures under sections 79 and 80.

- (b) The right holder may file a criminal or civil case in the Intellectual Property Court.

78. The Intellectual Property Court shall presume that:

- (a) a mark protected under this Law is infringed where any other third party exercises any right contained in section 38 in the State without the consent of the owner of a mark;
- (b) the use of a sign which is identical with or similar to an unregistered well-known mark in relation to goods or services which are identical with or similar to those, without the consent, is likelihood of confusion to the public.

79. (a) The Intellectual Property Court may order the following one or more provisional measures for civil remedies upon the application under subsection (a) of section 77 in respect of the infringements of mark:

- (i) an order as it thinks fit to prevent the infringement of mark and to prevent the entry into the channels of commerce of the State of mark infringing goods including imported goods after paying leviable duties to the Customs Department and customs clearance;
- (ii) an order as it thinks fit to preserve relevant evidence in regard to the alleged mark infringing goods;
- (iii) an order to modify, revoke or confirm the order of suspension issued by the relevant Customs Department.

(b) The Intellectual Property Court may direct the applicant to provide the following to take provisional measures:

- (i) valid evidence that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent;

- (ii) sufficient assurance to prevent abuse of provisional measures.
 - (c) The Intellectual Property Court may further direct the applicant to supply additional information necessary for identification of the alleged infringing goods when ordering the provisional measures under subsection (a).
 - (d) The Intellectual Property Court shall revoke or cease to have effect the provisional measures ordered under subsection (a) of section 79 and subsection(a) of section 80 upon request of the respondent without prejudice to subsection (b) of section 80, if civil proceeding is not initiated within the reasonable period determined by the Intellectual Property Court or in the absence of such determination, within 30 days from the date of ordering the provisional measures, to decide on merits of the case for the injury commencing from the date of execution of the requested provisional measures.
 - (e) Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or probability of infringement of a mark right, the Intellectual Property Court may order the applicant, upon request of the respondent, to provide the respondent appropriate compensation for any injury caused by these measures.
80. (a) The Intellectual Property Court may make an ex parte order of the provisional measures in any of the following conditions:
- (i) where any delay is likely to cause irreparable harm to the right holder;
 - (ii) where there is a demonstrable risk of evidence being destroyed.
- (b) Where making an ex parte order of provisional measures, the Intellectual Property Court shall:
- (i) notify the respondent of the provisional measures, without delay, after the execution of the measures;

(ii) execute the provisional measures within the period determined by the Intellectual Property Court, or in the absence of such determination, within 30 days from the date of notification, if the respondent does not follow the notification.

(c) The Intellectual Property Court shall review the provisional measures, upon request of the respondent by hearing both sides within the reasonable period in order to make decision on whether these measures to be modified, revoked or confirmed.

81. (a) The Intellectual Property Court may, in case of the infringement of mark, pass any one or more of the following orders without prejudice to the Civil Law and the Code of Civil Procedure in the proceedings under subsection (b) of section 77:

(i) an injunction against the infringement of mark, including the prevention of the entry into the channels of the commerce of the State of imported mark infringing goods after paying leviable duties to the Customs Department and customs clearance;

(ii) (aa) an order to pay the right holder sufficient damages for the injury that the right holder has suffered due to the infringement of mark by the infringer or an order to pay the right holder pre-established damages or the profits obtained by the infringer or both, in appropriate cases;

(bb) an order to pay the right holder appropriate expenses including legal costs and attorney's fees;

(iii) an order that the mark infringing goods be disposed of outside the channels of commerce or destroyed without paying any compensation to the right holder in order to avoid any harm caused to the right holder;

(iv) an order that the materials and implements predominantly used in the creation of the mark-infringing goods be disposed of outside the channels of commerce or destroyed.

(b) When considering to pass any order under clauses (iii) and (iv) of subsection (a), the Intellectual Property Court shall take into account proportionality between the seriousness of the infringement of mark and such order as well as the interests of the third party.

82. The Intellectual Property Court may order the applicant to pay the respondent compensation and legal costs including attorney's fees and other expenses of the respondent who has been wrongfully restrained by the complaint where the complaint about infringement of mark is appeared incorrect and dishonest.

83. (a) The Intellectual Property Court may order the adverse party to produce evidence, by ensuring the protection of confidential information in appropriate cases, without prejudice to the provisions of existing laws, for the following conditions:

(i) when the right holder has produced valid evidence to support his claims sufficiently;

(ii) when the right holder has specified that the valid evidence relevant to his claims are in the hands of the adverse party.

(b) The Intellectual Property Court may, in voluntary infringement without valid reason, make preliminary and final determinations such as affirmation or rejection based on the information including allegation and declination, subject to providing the parties an opportunity to be heard on allegation or evidence in the following situations:

(i) refusing to provide necessary information;

(ii) not providing necessary information within a reasonable period;

(iii) significantly impeding the procedure relating to an enforcement action.

84. If the Intellectual Property Court has imposed a fine for any offence prosecuted under this Law, it may order to pay the aggrieved person the whole or part of such fine as damages.

85. If both criminal and civil cases are filed on the basis of the same matter, the Intellectual Property Court shall set-off the money given as damages from the fine imposed under section 84 when passing the judgment, order and decree to pay damages for injury in the civil case.

86. The Intellectual Property Court may apply the provisions in the Evidence Act, the Code of Criminal Procedure and the Code of Civil Procedure and other relevant existing laws if it is not provided expressly in this Law in respect of the enforcement actions for infringement of mark.

Chapter XXIII

Offences and Penalties

87. (a) Whoever commits any of the following acts on the commercial purposes without the consent of the right holder shall, on conviction, be punished with imprisonment for a term not exceeding three years or with a fine not exceeding five million kyats, or with both:

(i) counterfeiting a mark;

(ii) applying a counterfeit mark to goods or using it in connection with services;

(iii) possessing any materials or implements, the predominant use of which is likely to be to counterfeit a mark or applying a counterfeit mark to goods.

(b) Whoever commits any of the following acts on the commercial purposes shall, on conviction, be punished with imprisonment for a term not exceeding two years or with a fine not exceeding five million kyats, or with both:

(i) dealing or possessing in counterfeit mark goods;

- (ii) importing into or exporting from the State, counterfeit mark goods.

88. Whoever commits any act of section 87, after a prior conviction for the same offence, shall be punished with imprisonment for a term from a minimum of three years to a maximum of ten years, and shall also be liable to a fine not exceeding ten million kyats.

89. Whoever uses a sign of flag or emblem which is particularly protected under international treaties to which the State is a contracting party as a mark for the commercial purposes shall, on conviction, be punished with imprisonment for a term not exceeding three years or with a fine not exceeding five million kyats or with both.

90. Whoever removes, destroys, deforms or adds the registered mark with intention to adversely affect the owner shall, on conviction, be punished with imprisonment for a term not exceeding one year or with a fine not exceeding three million kyats or with both.

91. Whoever commits any of the following acts shall, on conviction, be punished with imprisonment for a term not exceeding one year or with a fine not exceeding two million kyats or with both:

- (a) irregular issue or causing to issue the certificate of a registered mark;
- (b) irregular entering or causing to enter dishonestly in the register;
- (c) violation of the prohibition of section 52.

92. Whoever conspires or abets in commission of any offence in this Law shall be liable to the punishment provided for such offence.

Chapter XXIV

Miscellaneous

93. Before this Law comes into force, under the Registration Act:

- (a) the owner of a mark registered at the Office of the Registration of Deeds or the owners of the actual use of a mark in the channel of

commerce of the State although they are not registered, shall apply to register under this Law if they want to enjoy the rights of a registered mark;

- (b) the rights of priority use shall be enjoyed for a mark registered or unregistered at the Office of the Registration of Deeds which is the mark of the actual use in the channels of commerce of the State during a prescribed period in respect of goods or services.

94. Notwithstanding anything in any other existing laws:

- (a) registration of a mark shall be carried out in accordance with this Law;
- (b) action shall be taken only under this Law for any offence relating to a mark.

95. Where any party is adversely affected, the Registrar shall give him an opportunity to be heard in accordance with the stipulations in the exercise of any power vested in him by this Law.

96. The copy of the certificate of a registered mark, and documents certified and sealed by the Registrar may be presented as evidence in the relevant Intellectual Property Court.

97. The Intellectual Property Court may pass an order that the counterfeit mark goods as well as any materials and implements related to commission of the offence be forfeited or destroyed or may pass an appropriate administrative order to act in any other ways.

98. The Ministry shall be responsible for office works of the Central Committee and the Agency and bear their expenses to implement the provisions of this Law.

99. The Ministry shall fix honorarium and allowance for the members of the Central Committee, the Agency and Working Groups who are non-civil service personnel with the approval of the Union Government.

100. The term of the person at the union level under this Law is normally the same as that of the President.

101. The Ministry may form and assign the Department and its divisions in the respective field of Intellectual Property to carry out the functions and duties of the Agency.

102. The infringement of mark in this Law shall not apply to the use of any goods bearing the mark by any government department and legal entity, provided that such use is not made on the commercial purposes and is limited to specific cases of the national emergency or public disaster.

103. The offences under this Law shall be determined as cognizable offences.

104. The disputes on the trademark right between the two parties may be settled by means of mutual consultation, amicably or arbitration, or judicial proceedings.

105. The Central Committee and the Agency established under this Law shall be considered to encompass all intellectual property laws.

106. In implementing the provisions of this Law:

- (a) the Supreme Court of the Union may issue rules, regulations, bye-laws, notifications, orders, directives and procedures relating to judiciary;
- (b) the Ministry and the relevant Ministries may:
 - (i) issue rules, regulations and bye-laws with the approval of the Union Government;
 - (ii) issue notifications, orders, directives and procedures;
- (c) the Ministry undertaking the functions of customs may issue rules, regulations and bye-laws relating to customs with the approval of the Union Government;
- (d) the Agency and Department may issue notifications, orders, directives, and procedures with the approval of the Ministry.

I hereby sign in accordance with the Constitution of the Republic of the Union of Myanmar.

Sd./ Win Myint
President
Republic of the Union of Myanmar