

Myanmar: New Trademark and Industrial Design Laws

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Among additional features of the new Trademark and GI law are: (1) institution of formal and substantive examination, (2) recognition and registration of well-known marks and GIs, (3) a 10-year registration term (renewal available 6 months prior to expiration), (4) provision for oppositions to be filed 60 days of publication, (5) non-use cancellation for marks not used for three consecutive years, (6) possible license recordal requirement (details not yet clear) (7) acceptance of priority claims, though Myanmar has not yet acceded to the principal IP treaties, (8) criminal penalties for trademark

infringement and counterfeiting, including up to three years in prison and a fine of MMK 5 million (about \$3250 US) and (9) establishment of a Central Committee for Intellectual Property and an Intellectual Property Rights Agency, which, together, will have jurisdiction over the trademark registration system. The law also has given the judiciary the right to set up specialized IP courts, though it is uncertain whether this might occur.

Among the main features of the new Industrial Design Law are (1) institution of a first-to-file system, (2) a five-year term, renewable for up to 15 years, (3) availability of invalidation and cancellation actions, (4) a possible license recordal requirement (details not yet clear), (5) six-month Paris Convention priority (though adherence to Paris has not yet taken place), (6) additional enforcement (including criminal) provisions, (7) domestic and international novelty requirement for registration, and (8) employee rights to register under certain circumstances, though generally provision for employer ownership if the design was created within the scope of employment and at employer instruction.

While procedures and administrative bodies for these new laws are not yet in place, requirements for registration are set out. Accordingly, we recommend that rights owners audit their current, and consider any new, holdings so that (for example) evidence will be readily available when the laws become effective and procedures implemented. We will keep clients apprised of further developments, including timing of implementation, but recommend taking steps now to arrange for continued protection.

Primary Contacts

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