

## **AN ANALYTICAL STUDY OF MYANMAR TRADEMARK LAW 2019**

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### **Abstract**

Trademark right, as one of the intellectual property rights, is directly related to the area of trade and investment. Trademark Law is essential for the development of international trade as well as national economy of the nation. Trademark protection is also important for all the traders, manufacturers, investors, entrepreneurs and consumers. Before 2019, there was no examination, opposition and cancellation procedures of trademark registration and Myanmar can recognize the trademark rights by declaration the ownership of trademark. Local and foreign investors want to acquire legally ownership and protection their trademark in Myanmar. In 2019, Myanmar enacted Trademark Law and it will be entered into force in coming soon. In order to implement Trademark Law, Trademark Rules and administrative authority are needed to establish. But, some of the provisions of Trademark Law are needed to change in line with International rules for effectively enforce in practice. The aim of this research is to examine the provisions of Trademark Law 2019, to describe the some significant points of this law and to discuss some suggestions which are in line with the provisions of international conventions and agreements in order to the development of existing Trademark Law and upcoming Trademark Rules.

**Keywords:** Distinctiveness, Right of Priority, Confusion, First-to-File, Registration.

### **Introduction**

In 2019, Trademark Law was passed for the development of Myanmar's IP system. Nearly all members of TRIPs Agreement have already established Intellectual Property Law as well as Trademark Law. The promulgation of Trademark Law makes a step forward for Myanmar's trademark protection system. The Trademark Law enables significant changes to the current process of trademark registration and protection in Myanmar in line with international agreement and standards. The Trademark Law introduces many new provisions which are for the interests of trademark owners as well as for the consumers. After the promulgation of Trademark Law, the enactment of Trademark Rules and the establishment of IP Court are needed in order to implement the law.

The paper also examines existing provisions of Trademark Law 2019 and compares with the provisions of international convention relating to protection of trademark. This paper provides some suggested terms and provisions that are needed to replace and change in Trademark Law. This paper also proposes some procedure or process for upcoming Trademark Rules.

### **Materials and Methods**

A descriptive, comparative and an analytic method are applied in this research. The materials used for the purpose of the research are Trademark Law 2019 and International Conventions relating to trademark protection, books, and articles (including articles on the Internet).

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## **Importance of Trademark in International Trade**

In the twentieth century, trademarks become a important factor in the modern world of international trade and market oriented economy that allow manufacturers and traders to offer consumers a variety of goods under differ in quality, price and other characteristics. In the current information technology era, the marketing of goods and services are moving quickly and trademark infringement issues are widespread. The economic development of the country is directly relationship between enhanced intellectual property protection and an increase of foreign direct investment. Therefore, trademark protection is becoming on particularly important matter and it may be promoted by promulgating effective IP law including Trademark Law.

A trademark is one of the categories of Intellectual Property Rights (IPRs). It is represented by the symbol <sup>TM</sup> or ® and used on the products. It is a distinctive sign, symbol or indicator which is used by an individual, business organization or other legal entity to identify uniquely the source of its products or services to consumers, and to distinguish its products or services from those of other entities. It could typically be a name, word, phrase, logo, symbol, design, image, or a combination of these elements. Trademarks are used to facilitate and enhance the marketing of a commodity and is a sign that indicates to consumers the source and reputation of the affixer of the mark and provides an important advertising and sales tool.<sup>1</sup>

## **Myanmar and International Provisions relating to Trademark Protection**

Myanmar is a member of World Trade Organization (WTO) and World Intellectual Property Organization (WIPO). Myanmar has an obligation to comply with Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). The TRIPs Agreement establishes the detailed substantive minimum standards on the protection of trademark. According to TRIPs' Provisions, Myanmar has indirectly applied and obliged other related international agreements.

Article 2 of the TRIPs Agreement obliges Members to comply with Article 1 through 12 and Article 19 of the Paris Convention. Article 2 also incorporates all substantive provisions of the Paris Convention, and these binding on contracting parties who are not members of the Paris Convention if they are members of the World Trade Organization (WTO). Although Myanmar is not a party to the Paris Convention, So, Myanmar will in effect be obliged to observe the Paris Convention.

Several other global and regional agreements signed between the Paris Convention and TRIPs remain. All of these conventions are interrelated such that an entire international system of trademark protection exists today. Agreements that pre-date TRIPs, based on the Paris Convention for the Protection of Industrial Property 1883, coexist with the requirements of TRIPs. A few of these older trademark agreements include: Madrid Agreement on the International Registration of Trademarks 1891; Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration 1957; Vienna Agreement for international classification of the figurative elements of marks 1973; Madrid Protocol on the International Registration of Trademarks 1989; and Trademark Law Treaty 1994. Each of these conventions offers a different link to TRIPs.<sup>2</sup> The Trademark Law Treaty 1994 and Singapore Treaty on the

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<sup>1</sup> <https://www.lawteacher.net/free-law-essays/business-law/trademark-infringement-vis-vis-the-tata.php>.

<sup>2</sup> Summaries of Conventions, Treaties and Agreements Administered by WIPO, 2013, wipo\_pub\_442.pdf, p 10.

Law of Trademarks 2006 harmonize national and regional registration procedures, the Madrid Agreement and the Protocol relating to the Madrid Agreement facilitate multiple registrations in a number of jurisdictions.

The TRIPs Agreement contains a comprehensive definition of trademarks and a description of the rights conferred by registered trademarks, as well as provisions on limitations and on the term of protection. The TRIPs Agreement also adds some significant substantive provisions regarding service marks and the protection of well-known marks. These provisions codify and concretize to some extent jurisprudence and general practice that had already been developed under the Paris Convention and relevant national laws. Therefore, Myanmar enacted Trademark Law 2019 in line with TRIPs Agreement. Then, Myanmar is also a member of the ASEAN, Myanmar is bound by the ASEAN Framework Agreement on Intellectual Property Cooperation 1995 to advance the legal framework to support the ASEAN Economic Community.

### **Significant Points of Trademark Law 2019**

Trademark Law was enacted on 30<sup>th</sup> January 2019 by (Pyidaungsu Hluttaw Law No. 3/2019). It will be come into force on the date which is prescribed in the notification issued by the President.<sup>1</sup> Trademark Law 2019 is comprised of 24 Chapters and 106 Sections. The enactment of the Trademark Law is an important step for Myanmar Intellectual Property Regime. It can facilitate to protect trademark right effectively in Myanmar. As a result, it can attract for local and foreign investment. Trademark Law establishes a framework for a comprehensive trademark registration and protection system for trademark owners.

#### **Examination System for Registration**

Before the enactment of Trademark Law 2019, there is no examination system for registration whether the applied trademark is registrable not. Trademark Law 2019 introduces formality and substantive examination of application, publication for oppositions and granting certificate. Opposition on absolute ground or related ground may be filed by anyone by paying an opposition fee within 60 days of publication. For example, if applications to register trademark that are deemed to lack of distinctiveness, or directly descriptive of goods or services, that mark will be refused for registration.

#### **Rights of Registered Trademark Owner**

Trademark Law clearly enacted the rights of registered trademark owner. Under section 37 to 41 of Trademark Law, a trademark owner can enjoy an exclusive rights such as the right of transferred and licensed<sup>2</sup>, the right to prevent<sup>3</sup>, the right to take the criminal action, civil action and both against the infringer<sup>4</sup>.

#### **Term of a Registered Trademark**

Before the enactment of Trademark Law, there is no recognized term for trademark duration. According to section 34 of this Law, the term of a registered mark shall be 10 years from

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<sup>1</sup> Section 1(b) of the Trademark Law 2019.

<sup>2</sup> Section 38(b) of the Trademark Law 2019.

<sup>3</sup> Section 38(a) (1) of the Trademark Law 2019.

<sup>4</sup> Section 38(a) (2) of the Trademark Law 2019.

the submission date for application of trademark registration. After this period, the applicant may renew the term of registration for 10 years at a time.

### **Transfer of Trademark's Right**

Section 42 to 44 states that “transfer of the trademark’s right”. According to those sections, the owner of a registered mark may apply to the Registrar to transfer ownership of the mark to any other person or legally formed organization. This process can decline the issues relating to trademark disputes.

Section 45 to 49 clearly rules that “licensing of registered mark”. An owner of a registered mark may grant a license for use of the mark to any person or legally formed organization after setting the terms and conditions.<sup>1</sup> An owner of a registered mark or the licensee may submit certified copies of the grant of license and pay the prescribed fee to the Registrar to request the entry of the grant of license into the registration records.<sup>2</sup> Unlike the prior to the enactment of Trademark Law, there is a systematic method of trademark licensing and registering of that manner under the control of Registrar.

### **Establishment of IP Court and Appointment of Judges**

According to section 67 of the Trademark Law, the Supreme Court will establish the IP Court and appoint the judges in order to adjudicate the criminal and civil suits of IP matters.

### **Scope of Protection**

The Trademark Law covers the protection of trademarks, service mark, well-known marks, collective mark, certification mark, geographical indications and trade names. The interpretation of the terms of law is fundamental to the process and practice of law. It is the process of defining that the intended meaning of a written document. Some interpretation of term of the Trademark Law is ambiguous. In this Law, statutory interpretation of the terms is important in enforcing the law in efficient and effective way. So, the court can face difficulty in order to seek to ascertain the meaning of the legislature.

### **Intellectual Property Rights**

Section 2(i) of the Trademark Law 2019 states that “Intellectual property rights means the right granted by law to protect creations made by one’s own intellect. This expression includes copyright, patent rights, industrial design rights, trademark rights, and other types of intellectual property rights”. In this definition, there are two parts and the second part of the definition should be added. According to Article 2 (viii) of the Convention Establishing the World Intellectual Property Organization, “Intellectual property” shall include the rights relating to: literary, artistic and scientific works, performances of performing artists, phonograms, and broadcasts, inventions in all fields of human endeavor, scientific discoveries, industrial designs, trademarks, service marks, and commercial names and designations, protection against unfair competition, and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

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<sup>1</sup> Section 45 of the Trademark Law 2019.

<sup>2</sup> Section 45 of the Trademark Law 2019.

So, the second part of this definition should replace the words “this expression includes all categories of intellectual property rights under WIPO”.

### **Mark and Trademark**

The TRIPs Agreement defines “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks.”<sup>1</sup>

Unlike TRIPs provisions and Trademark Law of other countries, Section 2 (j) Myanmar Trademark Law defines the term “mark”: “Mark means any visible sign, which includes personal names, letters, numbers, figurative elements, or combinations of colors or one a combination of such signs, capable of distinguishing a particular goods or services from other goods or services. This term includes trademark, service mark, collective mark and certification mark”.

By observing this definition, the first part of this definition indicates the term marks is distinguishable for a particular goods or services from other goods or services. The second part expressed the term “mark” includes “trademark, service mark, collective mark and certification mark”. Therefore, the first part and the second part of the definition do not harmonize and it is difficult to apply in practice.

Beside the definition of “mark”, there is a definition of “trademark” in this law. That is “Trademark means a mark that distinguishes the goods of one enterprise from those of other enterprises in the course of trade.”<sup>2</sup> As a result, the interpretation of mark and trademark can confuse in practice. Even though the title of Law is “Trademark Law”, almost all of the provisions, except Section 8 and 9, used the term “mark” instead of the place of using “trademark”.

Article 2 (viii) of the Convention Establishing the World Intellectual Property Organization 1967, the term “trademark” is used in the definition of “intellectual property” Section 2, Article 15 to 21 of the TRIPs Agreement provides the “Trademark” including “protectable subject matter of trademark, rights conferred, term of protection, requirement of use and licensing and assignment”. In this provisions, the term “trademark” was only used. In addition to, there are other international agreements relating to trademark such as Madrid Agreement on the International Registration of Trademarks 1891, Trademark Law Treaty 1994 and Singapore Treaty on the Law of Trademarks 2006. By analyzing international trends, some provision of this law should be used the term “trademark” which is more suitable than “mark”.

Therefore, the term “mark” should be changed “trademark” in line with the relevant provisions. For example, some of the provisions related to “right of priority” are only related to trademark or services not related to collective mark, certification mark and trade name.

### **Service Mark**

Section 2 (l) of Trademark Law 2019 states “service mark means a mark that distinguishes the services of one enterprise from those of other enterprises in the course of trade”. Even though the term service mark is defined in this law, there is needed the authoritative instruction that the

<sup>1</sup> Article 15 (1) of TRIPs Agreement 1994.

<sup>2</sup> Section 2(k) of the Trademark Law 2019.

provision of trademark applies for the protection of service mark. The TRIPs Agreement requires service marks to be protected in the same way as marks distinguishing goods.<sup>1</sup> So, service mark protection has sometimes been introduced by a very short amendment to the existing trademark law, *mutatis mutandis*, of the provisions on the protection of trademarks.

### **Collective Mark and Certification Mark**

In relating to the right of collective mark, the term “collective mark” was defined in Section 2(m) of the Trademark Law that “Collective mark means a mark owned by a collective organization, such as organization, association or socio-economic organization collective with Industrialists, manufacturers or traders or cooperative. This expression includes marks which distinguish the goods or services of the members of said organizations from those of others”. Except that definition, there was no provisions that how to registered and how to protect the collective mark. And then, section 2 (n) of Trademark Law 2019 defines “Certification mark means a mark which certifies the use, under the supervision of the owner of said mark, in connection with the origin, quality, type and other distinguishing characteristics of the goods or services of a mark”. Some provision relating to registration and enforcement for the infringement of those marks should be added in line with Paris Convention and TRIPs Agreement.

### **Geographical Indications**

The protection of geographical indication was expressly provided in Article 22 to 24 of TRIPs Agreement. In Trademark Law 2019, section 2 (o) and section 53 to 62 of Trademark Law 2019 clearly express the protection of geographical indication. But there is no provision relating to the form of infringement and the action upon infringement. So, the nature of geographical indication is different from other marks and it should be added in detail in the upcoming Rules.

### **Well-Known Marks**

Section 2 (p) of Trademark Law 2019 defines well-known mark that is “well-known mark means a mark that is well-known, in accordance with the stipulated standard, in the Republic of the Union of Myanmar”. Well-known mark is a trademark or service mark that has relatively high renown and repute among the substantial segment of the relevant public. Well-known mark has special character which is different from ordinary trademark or service mark. Therefore, the detail procedure should be supplement in Trademark Law as well as upcoming Trademark Rules.

The basic instruments governing protection of well-known marks are Paris Convention for the Protection of Industrial Property, TRIPs Agreement and WIPO Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks. Therefore, the provisions relation to well-known marks in Trademark Law 2019 should be fulfilled in line with those international provisions. There should be laid down a list of factors that can assess of whether a mark is well known in Myanmar. The criteria which evaluate an ordinary mark to be a well-known mark is important for competent authorities and judicial courts in practice the law.

The protection of well-known mark is very complicated issues. If a mark has recognized as a well-known mark, it may be protected from infringements without registration, and even without use. Some issue relating to unfair competition of the well-known mark may be the confusion,

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<sup>1</sup> Articles 15.1, 16.2 and 16.3 of TRIPs Agreement 1994.

dilution and bad faith registration of the well-known mark. So, Trademark Law 2019 should add the detail procedure for the examination of the confusion and dilution of the well-known marks.

Although there is no guideline in international convention, the national practice of determining factor is existed. For example, US second circuit courts use the Polaroid test which contains a number of factors as a guideline for determination of whether there is likelihood of confusion or not. The court can apply when examining:

- (1) the strength of the plaintiffs marks;
- (2) the degree of similarity between the marks;
- (3) the proximity of the products or services;
- (4) the likelihood of the senior user “bridging the gap” into the junior user’s product service line;
- (5) evidence of actual confusion between the parties’ marks;
- (6) whether the defendant adopted its mark in good faith;
- (7) the quality of the defendant’s goods or services; and
- (8) the sophistication of the parties’ customers.<sup>1</sup>

This is the another State practice that Federal Trademark Dilution Act ("FTDA") provides a list of eight non-exclusive factors that a court may consider in determining whether a particular mark is distinctive and famous, thus warranting protection against dilution. The factors are:

- (1) the degree of inherent or acquired distinctiveness of the mark.
- (2) the duration and extent of the use of the mark in connection with the goods or services with which the mark is used.
- (3) the duration and extent of advertising and publicity of the mark
- (4) the geographical extent of the trading area in which the mark is used
- (5) the channels of trade for the goods or services with which the mark used
- (6) the degree of recognition for the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;
- (7) the nature and extent of use of the same or similar marks by third parties; and
- (8) whether the mark is federally registered.<sup>2</sup>

### **Conditions for Registration as a Trademark**

Section 94(b) of this law clearly describes, “regardless of the provisions in any other existing law, registration of a mark must be carried out according to this law”. In order to obtain trademark and service mark protection in Myanmar, registration of a mark is the principal way under Trademark Law. This system is in line with the international provisions. According to Article 6(1) of the Paris Convention and Article 15.2 of the TRIPs Agreement, the conditions for

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<sup>1</sup> INTA, The Trademark Reporter, Annual Review, Vol 97, March-April, 2007, No 2 ,p.126.

<sup>2</sup> 15 U.S.C section 1225 (c) (1).

the filing and registering of a trademark are in principle determined by the domestic legislation of each Member country.

Trademark Law 2019 describes trademark rights are territorial. This means the ownership of a registered trademark is valid within territory of Myanmar. The trademark owner, who has already registered his trademark in another country, the trademark must be needed to register if his trademark wants to protect in Myanmar.

In order to apply registration of mark, “a clear and complete description of the mark” is one of the factors.<sup>1</sup> With regards to an application for the registration of a mark, the examiner must been made according to stipulations, together with his remarks to the Registrar after examining whether the application meets any of the provisions set out in section 13 and whether it contains the points set out in section 17 of this law.<sup>2</sup>

### **Examination Process**

The Intellectual Property Office will examine the absolute ground<sup>3</sup> and related ground<sup>4</sup>. This law recognizes acquired distinctiveness through use in line with the provisions of TRIPs Agreement. Before the enactment of Trademark Law, Myanmar applies acquisition of trademark rights through use. The trademark right through use will also recognized and registered under section 93 of Trademark Law 2019. If the mark is not distinctiveness and it is a generic mark, it can be refused as absolute ground by the IP office.

Section 13 (b) (1) of Trademark Law states that if the mark’s distinctiveness is known among consumers due to its use before the date of application for mark registration; recognize to register and protect the trademark which has “acquired distinctiveness through use” among the customer. Section 13 (b) (2) of Trademark Law provides “If the applicant, in good faith, is exclusively using the mark continuously within the trading area of Myanmar”. This provision means Trademark Law 2019 is still recognizing use system.

For registration, the mark must be a distinctive mark and it must be capable of distinguishing the goods or services with which it is used. Such marks must be invented or fanciful and not be descriptive of the goods or services they identify. The mark must have some inherent quality making it unique. Because their purpose is to help consumers identify products and services.

### **Multiple-Class Applications**

Section 17 (a) (5) of the Trademark Law states that “name and type of goods and/or services for which a request for registration is made and the category of international mark classification to which it belongs”. According to this provisions, the availability of multiple-class applications is allowed.

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<sup>1</sup> Section 17 (a) (4) of Trademark Law 2019.

<sup>2</sup> Section 23 (a) of Trademark Law 2019.

<sup>3</sup> Section 13 of the Trademark Law 2019.

<sup>4</sup> Section 14 of the Trademark Law 2019.



### **Right of Priority and Right of Priority for Trade Exhibitions**

Section 2 (v) of the Trademark Law defines “Right of Priority” which means “the right of priority described in Section 31 of this Law”. Section 17 (b) (2) of the this Law, “In addition to the requirements in subsection (a), the following must be attached to the application if necessary: if the applicant requests the right of priority, an application for the right of priority together with sufficient evidence proving that he has the right of priority, and description.”

Section 31 states that “If a person who has initially applied for registration of mark in a Member State of the Paris Convention or the World Trade Organization or the transferee of said person applies for the registration for identical goods or services and identical mark in the Republic of the Union of Myanmar within six months from the date of the initial application, the aforementioned date of application must be considered as the date of application and the right of priority must be granted from such date”. In this section, “Right of Priority” means “Right of Priority for International Registration”. Therefore, the term should be amended more clearly as “Right of Priority for International Registration” in section 2(v). Because, there will be conflict in section 93 (b) of the law.

Section 93 (b) of Trademark Law, Stated that “before this law enters into force, whether a mark has been registered or not registered in accordance with the Registration Act, a mark that is actually used in the markets of the Union (Myanmar) shall enjoy the right of used priority for the goods or services for which said mark is used for the duration of the stipulated period”. This section relates to the recognition of trademark right through use and the owner of mark can have an opportunity to apply for registration. This section is ambiguous that whether the law allows use priority or right or priority of international registration. According to this section, the term “Union” should be also interpreted.

And then, section 2 (w) of Trademark Law states that “Right of priority for trade exhibitions” which means the right of priority related to trade exhibitions described in section 32 of this Law. Section 32 of this Law states that “If the applicant requests the registration of a mark, displayed at an international trade exhibition authorized or recognized by a Member State of the Paris Convention or the World Trade Organization, to the Department within six months from the first day of displaying the goods or services, then the first day of display shall be considered as the date of application and the right of priority for trade exhibitions for the aforementioned mark shall be granted from such date’.

According to Section 17 (b) (3) of the Trademark Law, “In addition to the requirements in subsection (a), the following must be attached to the application if necessary: if the applicant requests the right of priority for trade exhibitions, an application for the right of priority for trade exhibitions together with sufficient evidence proving that he has the right of priority for trade exhibitions, and description.”

The provision of this section is in line with the international convention. If the local or foreign trademark owners who displayed their mark in authorized international trade exhibition before the registration, they have an opportunity to enjoy right of priority.

## **Transitional Period**

Trademark Law introduces registration system to be in line with other countries. A trademark application can be filed at Intellectual Property Office and the task of examination and opposition will be handled by that office.

All marks currently registered under the Registration Act 1908 or the Deeds Registration Law 2018 must be re-filed and examined when the Trademark Law enters into force in order to get trademark mark ownership in Myanmar. Currently, trademarks can be registered at the Registration of Deeds Office under Ministry of Agriculture, Livestock and Irrigation. This office accepted the registration of all sorts of documents, in particular long-term lease contracts and sale and purchase contracts for immovable property. It is not a specific office for Trademark Registration. This office currently registers the trademark and issues “declarations of ownership”.

The registration officer usually does not examine and verify

1. whether the applied mark has already been registered or not
2. whether the applied mark has distinctiveness or not.
3. there is no cancellation procedure whether the unauthorized use occurred other the owner.

There will likely be a transitional period for existing trademark owners to re-file their marks. Section 93(a) of the Trademark Law states that if trademark owners that have previously recorded their marks with the Office of Registration of Deeds (ORD) or have not recorded their marks but can provide evidence of actual use in Myanmar want to enjoy rights relating to their marks, they must apply for registration in accordance with the new law.

Existing and previously registered Declarations of Ownership and published Cautionary Notices can be submitted as part of the application. Section 17 (b) (4) of the Trademark Law states, “in addition to the requirements in subsection (a), the documentary evidence proving such registration must be attached to the application if the mark is registered at the documents registration office”. This section allows the transaction of old registration to new registration.

If the mark was recorded with the ORD under the old system, the trademark owner should submit evidence of that recordation together with the trademark application under the new system for the registrar’s examination.

If a trademark owner can prove actual use of its mark in the market, then the mark will be protected – irrespective of whether it is recorded at the ORD. The owner will enjoy priority rights for goods and services with such marks, within a specified period.

## **Enforcement of Trademark Rights**

Under Trademark Law 2019, civil, criminal and administrative action can claim when the infringement was occurred. Section 77 to 86 of the law provide the authority of IP court relating to infringement of trademark right. The right holder may apply to the IP court for criminal action or civil action<sup>1</sup>. The provisions of this law are in line with TRIPs Agreement. Part III, sections 2 to 5 of TRIP Agreement provide a more detailed list of procedures and criminal, civil, and

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<sup>1</sup> Section 77 (b) of Trademark Law 2019.

administrative corrective measures. In cases of infringement, rights holders may seek enforcement from judicial, administrative, and customs authorities, through measures such as injunctions and penal sanctions, or through the confiscation or destruction of counterfeit goods. If infringement is threatening, the owner may demand provisional measures such as suspension of the goods from circulation.

### **Civil Action**

The right holder may, according to the provisions in sections 79 and 80, apply for a miscellaneous suit to IP court for provisional measures orders through civil action for damage.<sup>1</sup> Under the Trademark Law 2019, the civil remedies are to order the removal of goods in the market, to prevent the entry of products and to maintain the original condition of evidence relating to alleged infringement upon mark rights.

### **Administrative Action**

The owner can claim the refusal for application, invalidation the registration and cancellation the registered mark by administration actions A trademark registration can be cancelled for non-use and it can be invalidated for non-registrability. Section 50 of the Trademark Law, the Registrar have an authority to announce about the invalidation of a registered mark when any stakeholder request with sufficient that constitutes the grounds for refusal under the provisions of this Law. Upon the request of any stakeholder regarding the use of the mark, the Registrar must cancel the registration of a mark if it is found to meet conditions which are clearly described in Section 51 and its sub-sections of Trademark Law 2019.

### **Criminal Action**

The provisions relating to offences and penalties of criminal actions are stated section 87 to 92 of Trademark Law 2019. And then, section 94(b) of this law clearly describes, “regardless of the provisions in any other existing law, any offense regarding a mark must be punished according to this law only”. As a result, the Penal Code and other existing laws which have been using before the enactment of Trademark Law 2019 will not use when the Trademark Law enter into force. Depend upon different infringement, punishment range from fine and imprisonment.

## **Findings**

By analyzing the Trademark Law, this law is mostly relating to the protection of trademark, service mark and well-known mark .In order to successfully impalement Trademark Law 2019 in practice, some provisions should be amended and some of the terms should be replaced or substituted. By observing this Law, there is no clear procedure of recognition and protection of well-known mark, collective mark, certification mark and trade names. There should be added the amendment provisions for the registration protection of collective mark and certification mark because the nature of marks are different. The Trademark search system is important and that searching procedure should be needed to add in the Rules. Because of trademark rights can also be protected by unfair competition, the term “act of unfair competition” should be interpreted and the forms of act of unfair competition should be added in line with Article 10*bis* of Paris Convention.

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<sup>1</sup> Section 77 (b) of Trademark Law 2019.

## **Conclusion**

Myanmar have new system that the registered trademark will be recorded and published to the public. So, the applicant can search the list of registered mark and they can create the new distinctive mark. By enacting Trademark Law in Myanmar, it can be enable to improve the ASEAN region's trademark registration and protection system.

Modern marketing methods require a trademark law in conformity with the needs of trade. For a developing country, investment in every sector of the economy, both domestic and foreign, is a key factor to promoting its economic development, which forms the basis for all other developments. Myanmar has invited participation in terms of technical know-how as well as investment from sources inside the country and abroad for the proper evolution of the market-oriented economic system and development of the economy for the country and for the people.

Trademarks can be protected for goods and services used in connection with the trade through normal application and registration of a trademark in Myanmar. Since the protection of trademarks is fairly in its infancy stage in Myanmar and is gradually going through further development. Myanmar must set up a programme to improve the legislative system for enforcing intellectual property rights in line with TRIPs Agreement. Further, it is important that legislative improvement will enable both judiciary and administrative enforcement bodies in Myanmar to award damages and expenses to right holders, and to provide for adequate border measures.

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