



MYANMAR IP SEMINAR



IPR Circumstance and Anti-Counterfeit/ Pirate Measures in Myanmar

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Contents

CHAPTER I

- **PART 1**

IPR in Myanmar Premises

TRADEMARK

- (1) Laws in force
- (2) Practice in the daily life
- (3) Protection System
- (4) Disputes Settlement Mechanism
- (5) Key Institutions combating
Counterfeit Goods

- **PART 2**

PATENT

- **PART 3**

INDUSTRIAL DESIGN

- **PART 4**

COPYRIGHT

CHAPTER II

- (1) Myanmar Involvement in the Regional/
International Conventions & Commitments
- (2) IPR becomes our Constitutional Right

CHAPTER III

Expectation on the forthcoming new IP Laws

- (1) Laws to be enacted
- (2) Points that should be centralized
- (3) Measures to be prepared

Sources: Archive of Myanmar Trademark and Patent Law Firm
www.myanmarpatent.com

CHAPTER I

IPR in Myanmar Premises

- Since 1948, a number of enactments have been made by the successive governments of Burma (Myanmar).
- Almost all the substantive and procedural laws introduced by the **British** are still enforceable and in practice. Laws concerned with Intellectual Property are said to be among them.
- Burmese (Myanmar) people have been accustomed to the laws mostly introduced by the British for more than one and half centuries.

Trademark

(1) LAWS IN FORCE

<u>Type of IP</u>	<u>Substantive Law</u>	<u>Related Laws</u>
Trademark	Nil	Registration Act (1908) Penal Code (1860) Myanmar Merchandise Marks Act (1889) Sea Customs Act (1878) Specific Relief Act (1877) Money Laundering Combating Law 2014 Foreign Investment Law 2012 Myanmar Citizens Investment Law 2013 Consumer Protection Law 2014

The Registration Act 1908

- As one of our leading jurists observed in the suit of **John Walker and Sons Ltd Vs. U Than Shwe** that: “Admittedly no Trade Marks Act has been promulgated in Burma up to the present moment.”
- **Section 18(f)**: All other documents not required by Section 17 may be registered.
- **Direction 13**: Trademark may be registered under Section 18(f) of the Registration Act, in Registration Book 4, by means of a declaration for each trademark.

Penal Code 1860

- A person is said to COUNTERFEIT who causes one thing to resemble another thing, intending by means of that resemblance to practise **deception or knowing it to be likely that deception** will thereby be practised.

The fact whether imitation is exact or not is not essential to counterfeiting.

Section **28**

Penal Code

Chapter XVIII

- Section 463

Whoever makes any false document or part of a document, with intent to cause damage or injury to the public or to any person, or to support any claim or title, or to cause any person to part with property, or to enter into any express or implied contract, or with intent to commit fraud or that fraud may be committed, commit **forgery**.

- Section 468

Committing Forgery, with an intention to use the forged document for cheating – up to 7 years, with fine

Penal Code

Chapter (XVIII) Section 478-489

- Using a **false Trade mark** (S. 480)
- Using a **false Property mark** (S. 481)
- Using any false Trade mark or Property mark, **unless the accused proves that he acted without intend to defraud** (1 year or fine or both) (**S.482**)
- Counterfeiting any Trade mark or Property mark used by any other person (**2** years or fine or both) (S.483)
- Counterfeiting any Trade mark or Property mark used by a Public Servant (**3** years or fine or both) (S.484)
- Making or possession of any instrument for counterfeiting a Trade mark or Property mark (**3** years or fine or both)
S. 485)

Penal Code

- Sale, exposure, in possession for sale or any purpose of trade or manufacture, any goods or things with a counterfeit trade mark or property mark affixed to or impressed upon the same or to or upon any case, package or other receptacle in which such goods are contained (1 year or fine or both) (**S.486**)

'burden of proof of not being guilty' lies upon the accused.

- Making a false mark upon any receptacle containing goods, **unless the accused proves that he acted without intent to defraud** (3 years or fine or both) (S.487)
- Tampering with property mark with intent to cause injury (1 year or fine or both))(S.489)

Myanmar Merchandise Marks Act 1889

Forfeiture of goods (Section 9)

- When a person is **convicted** under section 482 of Penal Code (using a false trademark) or under section 486 (sale, exposure, in possession for sale or any purpose of trade or manufacture) or under section 487 (making a false mark) or section 488 (use of a false mark) or under section 6 or 7 of Merchandise Marks Act (applying a false trade description to goods) or (sale or exposure or in possession for sale or any purpose of trade or manufacture); or
- When he is **acquitted** on proofs specified in section 486 of Penal Code or section 7 or section 8 of this Act;
- the Court convicting or acquitting him may direct the forfeiture to the State of all goods and things involved in the case.

Myanmar Merchandise Marks Act

- In the case of goods brought into the Union of Burma by sea, evidence of the port of shipment shall, in a prosecution against this Act or section 18 of the Sea Customs Act, be prima facie evidence of the place or country in which the goods were made or produced.

Section 13

- No such prosecution as is mentioned in the last foregoing section shall be commenced after the expiration of 3 years next after the commission of the offence, or 1 year after the first discovery thereof by the prosecutor, whichever expiration first happens.

Section 15

Myanmar Merchandise Marks (*Amendment*) Law

Union Hluttaw Law No. 35/2013 (22 October 2013)

- Fines are increased

Section **2**. 50,000 MMK instead of 200 MMK (Sec 6 and 7 of 1889 Act)

Section **3**. 20,000 MMK instead of 50 MMK (Sec 9(3) of 1889 Act)

Section **4(a)**. 100,000 MMK instead of 1000 MMK (Sec 12(2) of 1889 Act)

- Wordings are substituted

Section **6**. 'Ministry of Finance' instead of 'President of the Union' (Sec 19 of 1889 Act)

Section **7**. 'Ministry of Commerce may, with the approval of the Union Government' instead of 'President of the Union' (Sec 20 of 1889 Act)

Sea Customs Act 1878

Section 18

- The goods not allowed to import to Myanmar either by land or by sea are listed in

(d) Goods having applied thereto a counterfeit trademark within the meaning of the Penal Code, or a false trade description within the meaning of the Merchandise Marks Act;

Section 19

- The President of the Union may, by notification from time to time, prohibit or restrict the bringing or taking by sea or by land goods of any specified description into or out of the Union of Burma or any specified part thereof, either generally or from or to any specified country, region, port or place beyond the limits of Myanmar.”

Sea Customs Act

Section 167(8)

- If any goods, the importation or exportation of which is for the time being prohibited or restricted by or under Chapter IV of this Act, be imported into or exported from Myanmar contrary to such prohibition or restriction, or
- If any attempt be made so to import or export any such goods, or
- If any such goods be found in any package produced to any officer of Customs as containing no such goods, or
- If any such goods or any dutiable goods be found either before or after landing or shipment to have been concealed in any manner on board of any vessel within the limits of any port in Myanmar, or

Sea Customs Act

- If any goods, the exportation of which is prohibited or restricted as aforesaid, be brought to any wharf in order to be put on board of any vessel for exportation contrary to such prohibition or restriction; are deemed to contravention to the provisions in section 18 & 19 and;
- They are penalized as such goods shall be liable to confiscation; and any person concerned in any such offence shall be liable to fine as a penalty not exceeding 3 times the values of the goods, or not exceeding four thousand MMK, whichever is more)

Sea Customs Act

- Section **167A**

Burden of Proof lies upon the accused if there arises whether such goods have not been imported or whether no attempt has been made to export such goods, contrary to prohibition or restriction under Section 19.

Specific Relief Act 1877

- Section **42**: Any person entitled to any legal character or to any right as to any property may institute a suit against any person denying or interested to deny his title to such character or right, and the Court may in its discretion make therein a declaration that he is so entitled, and the plaintiff need not in such suit ask for any further relief.
- Section **54**: When the defendant invades or threatens to invade the Plaintiff's right to or enjoyment of property, the Court may grant a perpetual injunction.

Explanation: "For the purpose of this section a trademark is property."

Illustration: "A improperly uses the trademark of B. B may obtain an injunction to restrain the user, provided that B's use of the trademark is honest."

Money Laundering Combating Law 2014

Union Hluttaw law no. 11 /2014 (14 March 2014)

- Section 5(c) Offences relating to IP infringement
- Section 43 Whoever sentenced for committing the money laundering shall be punishable up to 10 years imprisonment or fine or with both.
- If the committing person is a Company or Association/ Organization, up to a fine at MMK 500 millions and the beneficiary owner shall be punishable up to 7 years imprisonment.

Money Laundering Combating Law 2014

- Section 40 Customs Department may practise, as it thinks necessary, in accordance with the Sea Customs Act, to investigate the goods involved with the said offences and may seize the monies, negotiable instruments or precious metals and jewelries suspicious in the said offences.
- Section 52 The Court shall
 - (a) order to confiscate the exhibits and monies involved in the offences or administer them as per the stipulations.
 - (c) If the fine is not settled by the offender, that Company or Association/ Organization shall be billed as *the income tax arrears*.
- Section 60 Burden of Proof lies upon the accused.

(2) Practice in the daily life

Registration

- for all kinds of Deeds and Assurances in the Registry Office under Ministry of Agriculture and Irrigation
- Trademarks are registered under Section 18(f) and Registration Direction 13 in the absence of the specific prescribed law
- Actual use or Intend to use is acceptable
- Mere **Declaration of Ownership** made by the applicant himself (for foreign trademark application, **Special Power of Attorney** to a local Agent, which is legalised by a Myanmar Embassy is required)
- Formality examination only
- Within 6-8 weeks after filing the application, Registered Declaration form is issued
- Validity period is not mentioned in Registration Act

publication

- No official Trademark Gazettes nor Journals issued by the Registry Office
- Soon after registration, **Cautionary Notice** has been published in local newspapers or journals
- To remind any possible infringement and/ or passing off action

RENEWAL

- Once every 3 years, by means of re-registration or re-publication or both
- To ward off any possible infringement and/ or passing off action + to show the Trademark owner's constant interest

TRADEMARK CAUTION

BNP PARIBAS of 16, Boulevard des Italiens, 75009 Paris, France is the Owner and Sole Proprietor of the following trademark:

BNP Paribas

(Reg. No. IV/1926/2000)

(Reg. No. IV/130/2004)

(Reg. No. IV/11951/2012)

used in respect of – **Int'l Class 35:** "Business management assistance, business management and organization consultancy, business management, consultancy, professional business consultancy, efficiency experts, business information, business investigations, business research, business inquiries, business appraisals, commercial or industrial management assistance, accounting, tax preparation, advisory services for business management, marketing studies, compilation of information into computer data bases, management of data files, marketing research, economic forecasts, statistical information"

Int'l Class 36: "Banking, financial business, credit bureaux, financial analysis, capital investments, exchanging money, cheque verification, issuing of travellers' checks, safe deposit services, clearing-houses (change), financial consultancy, credit, lease purchase financing, deposit of valuables, issue of tokens of value, savings banks, financial evaluations (banks), fiscal assessments, financing services, financial information, mutual funds, capital investments, electronic funds transfer, financial management, lending against security, loans (financing), financial transactions; securities brokerage"

Int'l Class 38: "Telecommunications, communications by fiber optic networks, communications by computer terminals, communications by telephone, electronic mail, computer aided data transmission, telematic sending of information"

Fraudulent imitation or unauthorized use or any other infringement whatsoever of this trademark will be dealt with according to law.

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Tel: 376318 G.P.O Box: 666, Yangon, Myanmar.

21st November 2012.

TRADEMARK CAUTION

TRADEMARK CAUTION

TDK KABUSHIKI KAISHA (TDK CORPORATION) of No. 13-1, 1-chome, Nihonbashi, Chuo-ku, Tokyo, Japan is the Owner and Sole Proprietor of the following trademark:

TDK-EPC

(Reg. No. IV/8087/2009)

used in respect of—Class 9: "Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs automatic vending machines and mechanisms for coin-operated apparatus cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; housemark for a full line of electrical engineering and electronic devices for the telecommunications, automotive electronics and industrial and consumer electronics industries; electrical engineering and/or electronic devices for the telecommunications, automotive electronics and industrial and/or consumer electronics industries; electric/electronic parts; electric/electronic devices; electric/electronic components; electric/electronic materials; electric/electronic passive components; ceramic components; microwave ceramics; capacitors; ceramic capacitors; multilayer ceramic capacitors; assembled elements composed of capacitors; EMC (electromagnetic compatibility) components; ferrite beads; ceramic beads; chip beads; electrical/electronic filters; filters for electrical signals; filters to control signal frequencies; filters for radio interference suppression; EMC (electromagnetic compatibility) filters; 3-terminal filters; common mode filters; chokes; choke coils; common mode choke coils; differential mode choke coils; peaking coils; molded coils; varistors; clamp filters (ferrite core with case); ferrites; ferrite materials; ferrite cores; dielectric filters; ceramic filters; piezoelectric filters; ferrite beads filters; noise filters; inductors; coils; transformers; electrical/electronic transformers; pulse transformers; current transformers; noise suppressing sheets; magnetic sheets; electromagnetic absorbing and shielding materials; micro wave absorbers; electromagnetic absorbers; radio wave absorbers; high frequency magnetic substances; anechoic chambers; equipments/ devices for EMC (electro magnetic compatibility) test system, sold individually or in units; sensors; temperature measurement sensors; thermistors; NTC (negative temperature coefficient) thermistors; PTC (positive temperature coefficient) thermistors; temperature responsive reed switches; humidity sensors; surface potential sensors; gear tooth sensors; gear tooth sensors for angle sensing; gear tooth sensors for speed sensing; mechanical sensors; toner concentration/ residual volume sensors; powder level sensors; door open/shut sensors; switches for door latch; electromagnetic sensors; actuators; plungers; plungers (part of machines); mechanical drive components; neblizers; neblizer units; ultrasonic neblizer units; humidifier for mist generation system; pumps; piezoelectronic components; piezoelectric products; piezoelectronic ceramic filters; resonators; resonant circuits; ceramic resonators; sounding bodies; piezoelectric receivers; piezoelectric buzzers; electromagnetic buzzers; piezoelectronic actuators; magnetostrictive resonators; discriminators; ceramic discriminators; thermal print heads; thin film thermal heads; recording/reproducing heads; magnetic heads; thin film magnetic heads; memory controllers; non-volatile memory controllers; flash memory controllers; NAND flash memory controllers; flash memory; memory cards; flash memory cards; non-volatile memory; non-volatile memory cards; CF (compact flash) cards; CF (compact flash) card for industrial applications; SSD (solid state drive); SSD (solid state drive) for industrial applications; semiconductor devices; semiconductor memories; memory card adapters; displays; organic light emitting displays; light emitting diodes; organic light emitting diodes; RF (radio frequency) components; antennas; ceramic patch antennas; multilayer chip antennas; band pass filters; dielectric band pass filters; circulators; circulators for base stations; isolators; isolators for base stations; multiplexers; diplexers; multilayer diplexers; multilayer band pass filters; thin-film band pass filters; phase shifters; multilayer phase shifters; delay lines; strip lines; low pass filters; multilayer low pass filters; high pass filters; multilayer high pass filters; baluns; balun transformers; multilayer balun transformers; thin film

balun transformers; couplers; directional couplers; multilayer directional couplers; LAN (local area network) components; wireless LAN (local area network) modules; devices for wireless radio transmission; wireless telephony apparatus; electric/electronic resistors; double balance mixers; terminators; transducers; accelerometers; electrodes; magnets; ferrite magnets; plastic bonded magnets; rubber bonded magnets; magnets sheets; magnetic cores; magnetic materials; power supplies; AC (alternate current) input power supplies; DC (direct current) to DC (direct current) converters; DC (direct current) to AC (alternate current) inverters; switching power supplies; noise filters; UPS (uninterruptible power systems); solar cells; film solar cells; inverters; inverter ballasts; fluorescent lamp ballast for electric lights; converters; factory automation systems; water processing equipment; semiconductor manufacturing equipment; FOUPL Load Port (station for supporting a semiconductor wafer transporting container where the cover of the transporting container is separated or separable from the transporting container); flip chip mounting machine; flip chip dispensers; component inserting machines; bulk feeding machines; components sequencing machines; laser marking systems; chip component mounting machines; IC (integrated circuits); circuit boards; IC (integrated circuits) boards; batteries; blank magnetic tapes; blank magnetic discs; blank magnetic optical disks; blank optical disks; SAW (Surface Acoustic Wave) components; SAW (Surface Acoustic Wave) filters; SAW (Surface Acoustic Wave) resonators; duplexers; RF (radio frequency) modules; SAW (surface acoustic wave) modules; SAW (surface acoustic wave) fronted modules; diodes; arrestors; surge arrestors; surge voltage arrestors; ceramic switching components; ceramic heating components; switching spark gaps; conversion filters; power capacitors; tantalum chip capacitors; aluminum electrolytic capacitors; ultra capacitors; inductive ferrite components; film capacitors; polymer chip capacitors; accessories for ferrites; SMT (surface mount technology) inductive resistors; SMT (surface mount technology) power inductive resistors; repeating coils; filters for shielded rooms; EMC (electro magnetic compatibility) feedthrough components; metal oxide varistors; ceramic semiconductors; microwave band pass filters; microwave resonators; microwave ceramic components; dielectric ceramic filters; high-frequency modules; microwave modules; LTCC (low-temperature cofired ceramics) modules; surface wave components; volume wave components; dielectric materials; materials for electrodes; BAW (bulk acoustic wave) components; FBAR (film bulk acoustic wave) components; MEMS (micro electro mechanical Systems) components; MEMS (micro electro mechanical systems) sensors; RF (radio frequency) modules; electronic circuit modules; H-ML (high-frequency multilayer) devices; ESD (electro-static discharge) components; EMI (electro-magnetic interference) components; optical components; PLC (planar lightwave circuits); TOSA (transmitter optical subassembly); ROSA (receiver optical subassembly); optical sensors; visible radiant optical sensors; optical attenuators; optical couplers; optical splitters; optical filters; optical switches; optical isolators; optical circulators; optical modulators; optical connectors; optical multiplexers; optical demultiplexers; optical transceivers; photo diodes; optical sensor modules; visible radiant optical sensor modules; optical attenuator modules; optical coupler modules; optical splitter modules; optical filter modules; optical switch modules; optical isolator modules; optical circulator modules; faraday rotator modules; optical modulator modules; optical connector modules; optical multiplexer modules; optical demultiplexer modules; optical transceiver modules; photo diode modules; optical sensor assemblies; visible radiant optical sensor assemblies; optical attenuator assemblies; optical coupler assemblies; optical splitter assemblies; optical filter assemblies; optical switch assemblies; optical isolator assemblies; optical circulator assemblies; faraday rotator assemblies; optical modulator assemblies; optical connector assemblies; optical multiplexer assemblies; optical demultiplexer assemblies; optical transceiver assemblies; photo diode assemblies; transmitter optical sub assemblies; receiver optical sub assemblies; faraday rotators; piezoelectronic devices; multilayer varistors; multilayer NTC (negative temperature coefficient) thermistors; parts and fittings for all of the aforesaid goods and all goods in Class 9"

Fraudulent imitation or unauthorized use or any other infringement whatsoever of this trademark will be dealt with according to law.

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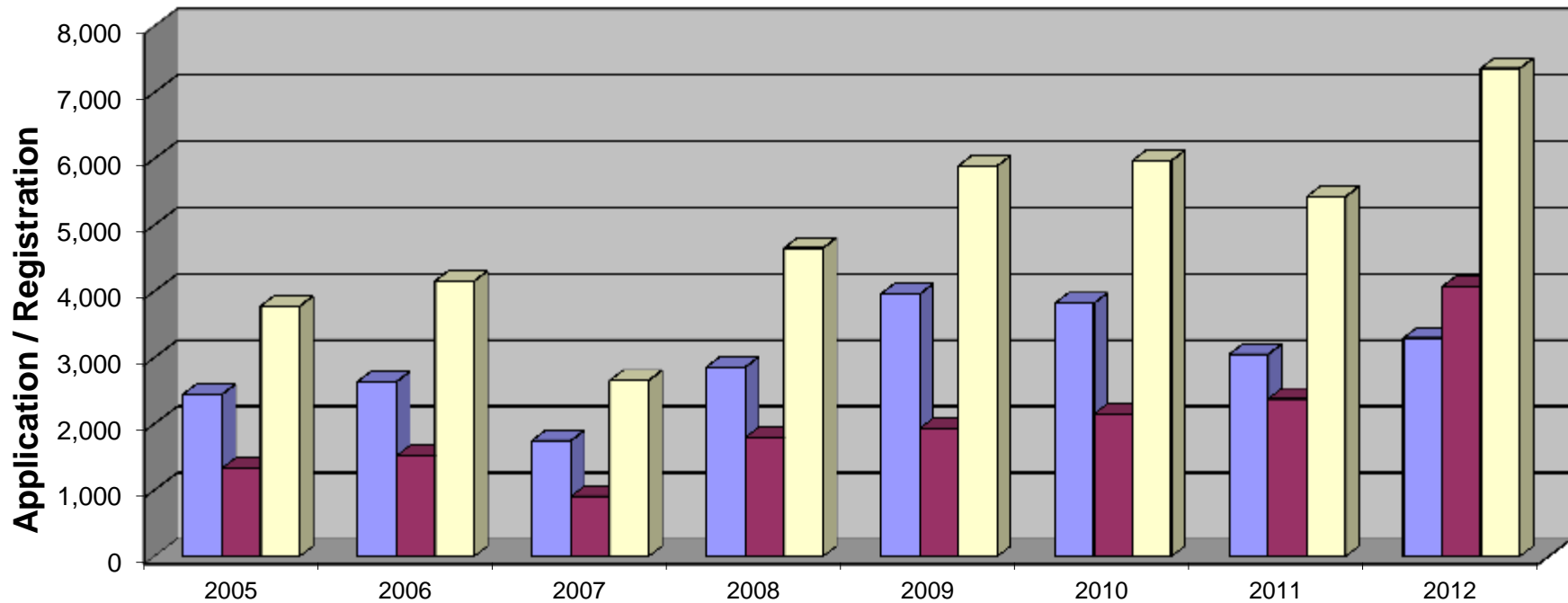
19th December 2012

2005 to 2012 Trademark Registration

Year	Application			Granted		
	Domestic	Foreign	Total	Domestic	Foreign	Total
2005	2,446	1,330	3,776	2,446	1,330	3,776
2006	2,637	1,518	4,155	2,637	1,518	4,155
2007	1,747	906	2,653	1,747	906	2,653
2008	2,857	1,796	4,653	2,857	1,796	4,653
2009	3,961	1,931	5,892	3,961	1,931	5,892
2010	3,821	2,149	5,970	3,821	2,149	5,970
2011	3,048	2,378	5,426	3,048	2,378	5,426
2012	3,294	4,068	7,362	3,294	4,068	7,362
Total	23,811	16,076	39,887	23,811	16,076	39,887

Source: based on Comparative Assessment Study of Patent and Trademark Offices in Southeast Asia (www.kiasia.org)

2005-2012 Trademark Registration



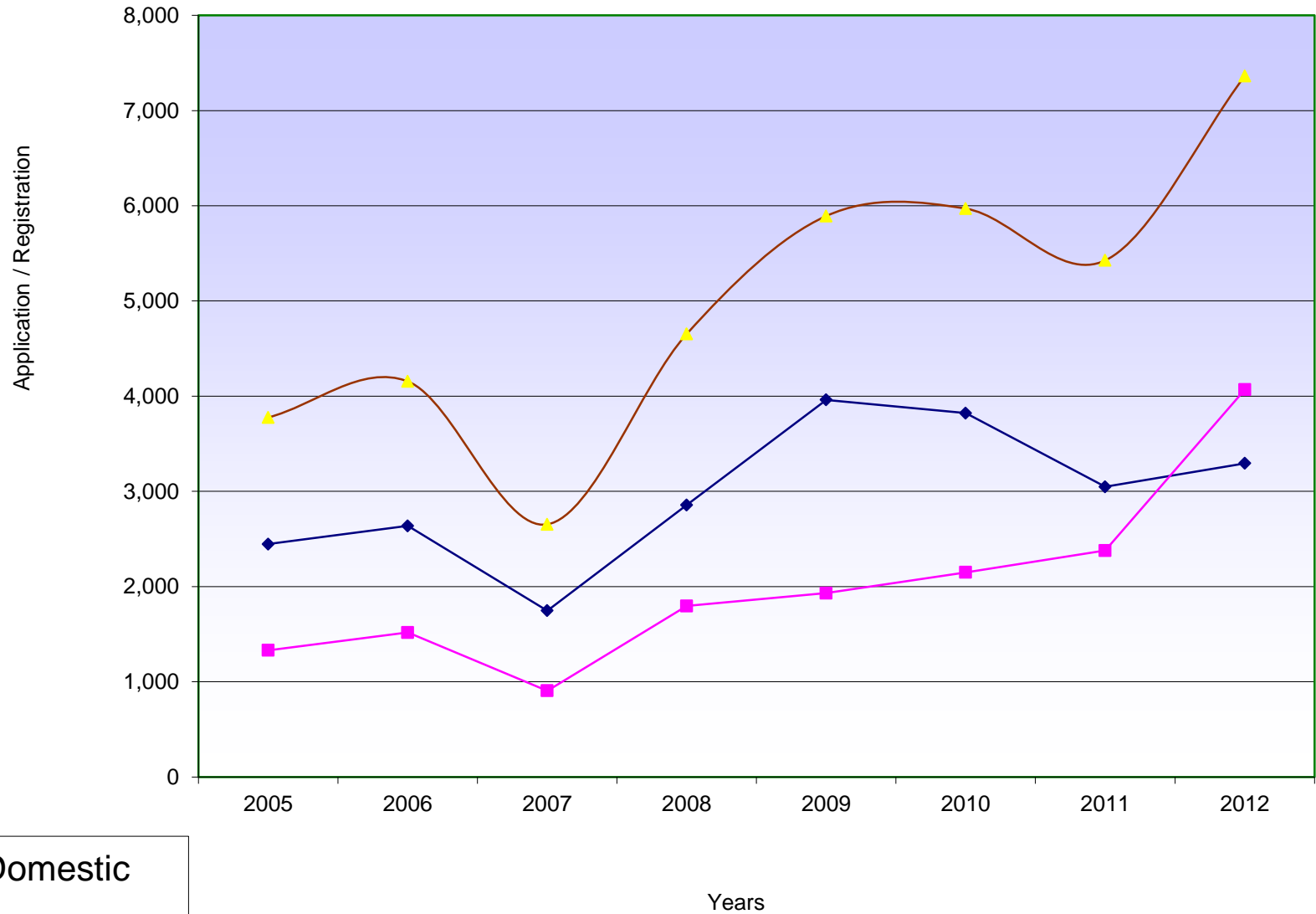
■ Domestic

■ Foreign

■ Total

Years

2005-2012 Trademark Registration Record

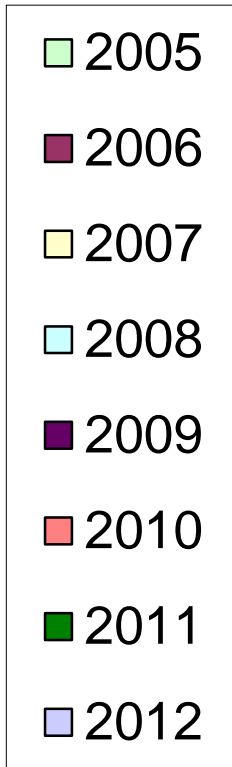
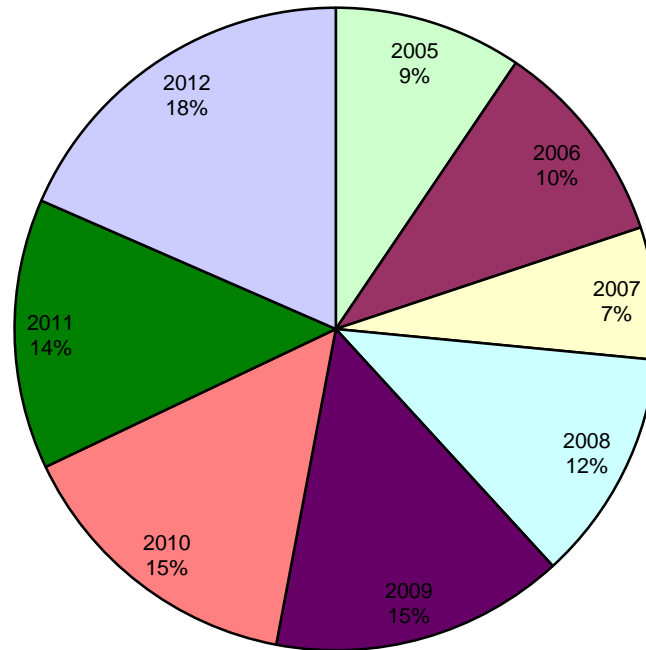


◆ Domestic

■ Foreign

▲ Total

2005-2012 Trademark Registration Record



(3) Protection system

- Trademark is protectable under the **Common Law** principle.
- “**First-to-Use**” is the basic system, in spite of this, Trademark may be registered by means of Declaration made by the trademark owner as per the Registration Act.
- The Court may accept such registration of Declaration presuming that the Registrant has first used the certain mark beginning from the date of registration.
- **3** essential factors: (1)**Registration**, (2) **Publication** (3) **Actual Use**’

(4) Disputes settlement mechanism

- In case of any disputes of Trademark ownership,
criminal case or civil suit can be maintained.
- Since Trademark ownership is in association with Civil Nature, based upon the Common Law, the Court consider on the point of an exclusive right of TM ownership with **the salient precedents.**
- Remedy
 - Punishment/ fine
 - Confiscation
 - Court's Order of Declaration of Ownership
 - Injunction (temporary/ perpetual/ interlocutory)
 - Damages/ Compensation
 - Accounts of Profit

Some leading cases in point

John Walker & Sons Ltd Vs. U Than Shwe
(1968 BLR pp.73-87)



Honourble Mr Justice U Thet Pe

- A trademark, being in the nature of property, cannot be appropriated by anyone without the permission of its owner. If a person appropriates it, he will be committing an actionable wrong **whether he does it honestly or fraudulently**;
- **A person does not acquire a monopoly in the use of any trade name irrespective of any kind or class of goods** inasmuch as there is no such thing as a monopoly of a property in the nature of copyright or patent.
- An owner of a trademark in respect of a particular commodity has no right to prohibit or prevent other person from the use of such mark in connection with **goods of a totally different character.**”

Gaw Shan Soot Vs. E.C.Madha Bros

1952 BLR (HC) p.136

- It is not necessary in order to constitute a colorable imitation that two marks should be similar in every particular, but it will be sufficient in law to constitute a colorable imitation if there exists such similarity between the two marks which could, in the circumstances of a particular case be considered to be calculated to deceive the class of persons for whom the goods are ordinarily or primarily intended.

see also

U Maung Maung Vs Daw Khin Than Myint

1975 BLR p. 72

U Tin Latt (a) U Sai Latt and one other Vs. U Kyaw Nyein

2001 BLR pp. 216-232

- A trade mark may be acquired by adoption and user upon a vendible article and when such user has been proved, the property of the person using the trade mark will be acquired by user.

U Chit Swe Vs Ma Than and three others

1958 BLR (HC) p. 377

- It is also clear that the first respondent Ma Than started her business many months after the appellant. By then the appellant had already acquired the right to use of the *Saungauk* trademark and the first respondent Ma Than was not entitled to invade that right.

U Kyaw Vs. U Ba Aye

(1962 BLR pp. 187-190)

33

- **Property in or right in respect of a mark may be acquired by user.**

P.A Pakir Mahomed Vs. King Emperor (A.I.R.1929 Ran 32)

- **Section 480 of Penal Code** the prosecution must prove that the accused marked goods, that he did so in a manner reasonably calculated to cause it to be believed that the goods so marked were the manufacture or merchandise of some other person and that such goods were not the manufacture or merchandise of such person.
- It is unnecessary for the prosecution to prove that an accused in such a case had acted with intent to defraud; but should the latter prove that he acted without intent to defraud he is entitled to be acquitted.
- In India there is no method by which a trademark may be registered, but property in or right in respect of a mark may be acquired by user. **A person not necessarily a manufacturer who uses a mark for the purpose of his trade may acquire rights to and in respect of that mark.**

Ko Maung Ngwe vs. Mr. B. Lall

1962 BLR (CC) p.93

- **Geographical names** which are so disconnected from the origin of goods that they are not indicative of the place of manufacture, are in fact distinctive name and may be allowed even on evidence of small use.

**Tajmahal Stationery vs. K.E. Mohamed Ebrahim 1949
BLR (HC) p.41**

- In Myanmar, there is no system of registration of trademarks, nor for a statutory title to a trademark. So the rights of the parties setting up rival claims to ownership of a trademark must be determined in accordance with the **principles of common law**.

* **Gaw kan Lye Vs. Saw Kyone Saing
1939 R.L.R (pg. 488) FB**

Counterfeiting in the present days

- After 2001, no precedent cases are sought.
- Trademark disputes are settled down in an amicable way.
- Trademark disputed cases are settled down in the lower Courts. (exemplary cases)

In spite of this,

- Trademark cautionary notices in which many global and domestic **well known marks** are claimed by the different parties as their owned marks by registering in their names are being advertised in the local newspapers and journals.³⁶

More TM disputes in the market but less TM cases to the Court

- Trademark owners' ignorance of knowledge on IPR
- Fear of time-consuming and cost to constitute litigation against the counterfeiters.
- Unwillingness to deal with complex litigation procedures and other factors
- No deterrent punishment is practised.³⁷

(5) Key institutions combating counterfeiting goods

- Ministry of Home Affairs
 1. Police Force
 2. General Administration Department
- Ministry of Finance
 1. Customs Department
- Union Supreme Court
 1. Courts at different levels

Patent

<u>Type of IP</u>	<u>Substantive Law</u>	<u>Related Laws</u>
Patent Law	Nil	Patents and Designs (Emergency Provisions) Act (1946) Registration Act (1908) Merchandise Marks Act(1889) Specific Relief Act (1877) Money Laundering Combating Law (2014) Science and Technology Development Law (1994) Private Industrial Enterprise Law 1990 Foreign Investment Law 2012 Myanmar Citizens Investment Law 2013

patent

- Burma Patents and Designs Act 1945
repealed in 1993 by SLORC
- Burma Patents and Designs
(Emergency Provisions) Act 1946
only 2 sections (not practicable)

Myanmar Merchandise Marks Act 1889

- Section **2(2)**

Trade description means any description, statement or other indication, direct or indirect – (e) as to any goods being the subject of an existing **patent**, privilege or copyright:

- Section **2(3) False trade description** means a trade description which is untrue in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement or otherwise, where that alteration makes the description untrue in a material respect,...

Myanmar Merchandise Marks Act

- **Section 6**

Person applying a false trade description shall, subject to the provisions of this Act and unless he proves that he acted without intend to defraud, be punished (**3** months or with fine)

In case of a second and subsequent conviction (**1** year or with fine or both)

- **Section 7**

Sale or exposure or in possession for sale or any purpose of trade or manufacture, to which a false trade description is applied (**3** months or with fine)

a second and subsequent conviction (**1** year or with fine or with both)

patent

- **Science and Technology Development Law 1994**
 1. Especially involves Transfer of Technology in the field of Science and Industry.
 2. Every contract for transfer of technology must be registered under this law.
 3. Failing of such registration will not have a right to institute a suit based upon transfer of technology.

Patent

- Patent may be applied for registration by means of Declaration under the Registration Act 1908.
- The Registrant may have no legal enforcement upon such registration rather than office recordation.
- In practice, Patent owners used to further publicize their Patent Caution after registration aiming at having the temporary protection before enactment of Patent Law.

Part 3

Industrial Design Law

<u>Type of IP</u>	<u>Substantive Law</u>	<u>Related Laws</u>
Industrial Design Law	Nil	Patents and Designs (Emergency Provisions) Act (1946) Myanmar Copyright Act (1914) Registration Act (1908) Specific Relief Act (1877) Money Laundering Combating Law 2014 Science and Technology Development Law (1994) Foreign Investment Law 2012 Myanmar Citizens Investment Law 2013

DESIGN

- **Myanmar Copyright Act 1911**

(The First Schedule of Myanmar Copyright Act 1914)

Section 1(1)

Copyright shall subsist for the term hereinafter mentioned in every original literary, dramatic, musical and **artistic work**.

Section 22

Designs, though capable of being registered under Patents and Designs Act 1907, not used or intended to be used as models of patterns to be multiplied by any industrial process are applicable.

Section 35(1)

Artistic Work includes works of painting, drawing, sculpture and **artistic craftsmanship**, and architectural works of art and engravings and photographs.

design

- Design may be applied for registration by means of Declaration under the Registration Act.
- After registration, Design cautionary notice is published in the newspapers or journals to ward off any possible infringement.
- At **3** years interval, Design is renewed by means of re-registration or re-publication or both of them.

DESIGN CAUTION

Midori Anzen Kabushiki Kaisha (also trading as MIDORI ANZEN CO., LTD.) of 4-3, Hiroo 5-chome, Shibuya-ku, Tokyo, Japan is the Owner and Sole Proprietor of the following design:

Toe core

FRONT VIEW



REAR VIEW



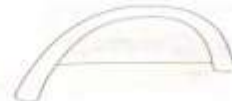
LEFT SIDE VIEW



RIGHT SIDE VIEW



PLAN VIEW



BOTTOM VIEW



PERSPECTIVE VIEW (1)



PERSPECTIVE VIEW (2)

(Reg. No. IV/11195/2011)

Fraudulent imitation or unauthorized use or any other infringement whatsoever of this design will be dealt with according to law.

Htain Lin Oo LL.B Advocate
MYANMAR TRADEMARK AND PATENT LAW FIRM
 E-mail: mtpip@mptmail.net.mm
 Tel: 376318 G.P.O Box: 666, Yangon, Myanmar.
 21st March 2012

In the case of Maung Sein Bros Vs. The Burma Plastic Moulders [1962 BLR 297 (Chief Court)]

“In a suit for declaration of ownership of a certain design which has been registered by the plaintiffs and for an injunction to restrain the defendant from using a similar design it opens to the defendants to raise as a defense to the plaintiff’s suit that the plaintiff’s design was neither new nor original.”

Maung Seing Bros Vs. The Burma Plastic Moulders [1964 BLR 32
(Chief Court)]

further held: *“Where the trial judge had held that the plaintiff’s comb which had a ‘toot kwet’ design on the base was new and original, and therefore should be protected. Among the Burmese people the ‘toot kwet’ (diamond cut or chiseled pattern) is a favourite design for bangles, combs and other articles of jewellery. The design on the plaintiff’s comb is nothing more than a variation of the said ‘toot kwet’ design.”*

Obiter: *“The fact that the defendant-appellant’s combs are almost identical in shape and design may be relevant in a passing off case; but it is not suit for declaration of ownership of design.”*

In a decided case,

SUPREME COURT

2009 Civil Special Appeal case nos. 37 , 38 and 39

Appeal upon the judgment and Decree delivered by Supreme Court (Mandalay) on November 28, 2008, in the case of 2008 CIVIL SECOND APPEAL cases nos.45, 46 and 47.

Daw Wadam Khon Nin Vs. Daw Khann Yin

Daw Nwe Oo

U Min Nyo (alias) U Hthinn Phu

Appellant

Respondents

- Daw Wadan Khon Nin has obtained registration at the Office of the Registry of Deed and Assurances, Myitkyina, of the new fashion **front fringe design** of female longyi of *Rawan* tradition. She subsequently deposited license fee at the Home Industry of the Ministry of Cooperative and distributed the said new designed longyis. The new design was approved and recommended by the Rawan Cultural Committee in Myitkyina. She managed sales promotion by inserting the advertisement in the Calendar published by the Literary and Cultural Committee, by her own expenses. While the plaintiff produced and distributed the new design, each of the respondents were separately producing and distributing the same design.

- Each of the respondents defended that -

The traditional dress is related with the entire ethnic national and cannot be given ownership to the individual. The traditional dress has existed since old time and it is not the Artistic work newly invented by the plaintiff. They were merely selling the *kachin* traditional dresses with the trademarks which they made earlier.

1. In the civil regular suit at the District Court, She won.
2. In the first appeal case at the State Court, She lose.
3. In the second appeal case at the Supreme Court (*Mandalay*), She lose.

Dismissing the each of the second appeal cases, the supreme Court ruled that the *Rawan* traditional female dress new design is not pertinent with the provisions of the Section 1(1) of 1914 Burma Copyright Act. That it is not the acceptable claim that the ownership right is vested with the plaintiff by just registration her new design at the Registry Office. That in the circumstances when the plaintiff has no ownership right related to the design of *Rawan* traditional longyi and the respondents did not imitate her trademark in their selling, the claimed compensation for damage is not entitled to the plaintiff.

SUPREME COURT
2009 Civil Special Appeal case nos. 37 , 38 and 39

The issues being aroused from these appeal cases are **whether the newly designed front fringe of *Rawan* traditional female longyi created and registered by the plaintiff is relevant with the existing Myanmar Copyright Act** and whether there is entitled of compensation for damage from the imitators.

SUPREME COURT

2009 Civil Special Appeal case nos. 37 , 38 and 39

The facts of the new design of *Rawan* traditional female longyi created, registered, produced and distributed by the plaintiff who made effort to recognize and to get them worn by the *Rawan* female and the facts of the each respondents imitated the said design to distribute are obvious in the original cases and the lower courts have reached the same conclusions in their decisions.

- The definition of the said “**Artistic craftsmanship work** “ cannot be seen in any promulgations and there is no Court precedents in this regards. Therefore it needs to check how it is defined in its origin country of England. This manner of checking is not to make copy but to get the example of how it is exercised in the country where the origin of this law exists.

SUPREME COURT

2009 Civil Special Appeal case nos. 37 , 38 and 39

- Clauson J., in *Burke and Margot Burke, Ltd. v. Spicers Dress Designs* (1936) 1-Ch.400 / Copinger and Skone James on Copyright, 9th Edn., London, 1958, P-66

In considering whether a lady's dress was capable of enjoying copyright protection as a work of artistic craftsmanship, cited definitions of "artistic" "artist" in the *Oxford English Dictionary* as showing that the proper question was whether a designer who designs and makes a frock was thereby cultivating "one of the fine arts" in which the object is mainly to gratify the aesthetic emotions by perfection of execution whether in creation or representation.

SUPREME COURT

2009 Civil Special Appeal case nos. 37 , 38 and 39

- Guild Ltd. Vs. Russel Williams (Textiles) Ltd. [2000] 1-W.L.R..2416 (U.K House of Lords)

An employee of the plaintiff has invented an original design of the clothe for stitching the dress. The said clothe comprise with vertical stripe lines within which there are flowers and leaves in place. They are decorated with the vague color. The said clothe were produced and brought success in the market. The respondent found them and made similar design to distribute. The plaintiff sued for this action and although the respondent defended that he took only the idea of design and did not take the get-up, figure and expression, the judgment delivered in favor of the plaintiff.

SUPREME COURT

2009 Civil Special Appeal case nos. 37 , 38 and 39

- It is evident that the *Rawan* female longyi front fringe new design of plaintiff would be included in **Artistic craftsmanship work** in England which is the country originated Myanmar Copyright Act.

- The action of the plaintiff who has invented a new design of **fringe** on the front of *Rawan* traditional female longyi in order to attract the female on *Rawan* base to increase delight in wearing them and got them registered and produced to distribute , was one of the Derivative works creations upon Ethnic marks or Traditional Cultural expression.
- “ The plaintiff is entitled to create such Derivative works creation which does not lower dignity or does not degrade anything, and the plaintiff should be entitled ownership right when the creation have been registered and it brings gratification of the people to wear it. ”

Copyright

Type of IP

Substantive Law

Related Laws

Copyright Law

**Myanmar
Copyright
Act (1914)**

Specific Relief Act (1877)

Sea Customs Act (1878)

Myanmar Merchandise Marks Act (1889)

Television and Video Law (1996)

Money Laundering Combating Law 2014

Motion Picture Law (1996)

Electronic Transaction Law 2004

Foreign Investment Law 2012

Myanmar Citizens Investment Law 2013

COPYRIGHT

- **Myanmar Copyright Act, 1914** is the one and only substantive IP Law in existence of Myanmar.
- The term or subsistence of the copyright is for a period of the life of the author plus **50** years.
- A copyright holder is entitled under the Copyright Act of 1911 to other remedies of injunction, damages, recovery of possession onto infringed copies, as well destroy of infringed copies by the court order.
- An action against infringer of copyright shall not be commenced after the expiration of **3** years next after the infringement.

- ▶ An action for infringement of the copyright is maintainable by means of a civil suit under section **54** of “**Specific Relief Act**” that authorises the court of law to grant an interlocutory and/or perpetual injunction against the infringer.
- ▶ Section **18(d)** of the “**Sea Customs Act**” prohibits export or import by land or sea of goods having applied a pirated materials, books, audio or video CDs, entailing punishment of confiscation of such goods and penalty up to three times the value of the goods or up to Kyats 1000 under its section 167.

- **Myanmar Merchandise Marks Act** has prescribed in its section 2(2)(e) that "trade description" means any description, statement or other indication, direct or indirect as to any goods being the subject of any existing patent, privilege or copyright.
- if any goods makes false trade description in respect of copyright or patent as regards the goods to which it is applied, it is actionable under the law.

copyright

- ▶ **Television and Video Law, 1996** becomes a reliable safeguard for copyright holders against piracy and unauthorised distributing, hiring and exhibiting of a licensed video tape for commercial purpose without permission of the authority or the license holder.
- ▶ On conviction, such violator shall be punished up to **3** years imprisonment or up to Kyat 100,000 fine, or both in addition to the confiscation of properties involved.
- ▶ Police Force destroys pirated or unlicensed video tapes and CDs in large scales during public exhibitions.

- ▶ Disputes as of copyright and the neighboring rights are mostly settled between the relevant parties in a peaceful way out of court.

- ▶ *ad hoc* Collective Management Committees [CMCs]

- In the sectors of photography, arts, traditional dancers, publishers, information technology, computer and software developers, settled the disputes either individually or through relevant associations.
- The existing laws are in the stage of difficulty to have reasonable answers on various issues arising out of modern surroundings with respect to literary, artistic, photography, music, IT and other kinds of copyright and related rights.







- ▶ A reported ruling of the Supreme Court in 1999, ascertained the protection of copyright of an author whose novel "*Hmine Wai Chit Te Khet Thistsar*".
- ▶ It was featured into video movie under slightly changed title without her knowledge and consent, thus amounting infringement of the rights of the copyright holder under section 1(2)(c) of the 1911 Copyright Act which contains as the First Schedule of Myanmar Copyright Act, 1914.

***U Hla Win & Other vs. Daw Kyi Kyi *alias* Daw Yin Wae Lwin, 1999 Myanmar Law Report (Civil) p. 208**

Author's Right recognized in Film and Video Sectors

- ▶ The Court held against the infringer (video producer) being liable compensation to the author and ordered to pay damages of Kyat 50000 to the plaintiff.
- ▶ Held also is that the owner of the copyright may assign the right, either wholly or partially, and either generally or subject to limitations.
- ▶ But, such assignment must be done in writing and signed by the owner himself or his duly authorized agent. Section 5 (2) of the 1911 Act prescribes that unless so written and signed, such assignment is not valid.

Chapter II

(1) involvement with the regional/ international conventions and commitments

- Myanmar was an original member of **General Agreement on Tariffs and Trade** (GATT), and also a founding member of **World Trade Organization** (WTO) in 1994 which was altered from GATT.
- Full-fledged member of **Association of South East Asian Nation** (ASEAN) 1997
- Member of **World Intellectual Property Organization** (WIPO) 2001
- **Agreement of Trade Related Aspects of Intellectual Property Rights** (TRIPS) and **ASEAN Framework Agreement on Intellectual Property Cooperation**, 1995

Myanmar is, however, non-signatory state to IP conventions or treaties such as those of Madrid Protocol, Nice Agreement, Paris Convention, Berne Convention, Trademark Law Treaty, Patent Law Treaty, and etc.,

The last due date by which Myanmar will have to provide Intellectual Property Protection in consonance with TRIPS Agreement is, as per WTO's decision on 11 June 2013, 1st July 2021 or when Myanmar ceases to be in the least developed category if that happens before 2021.

ASEAN Membership in International IP Treaties

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Country	Brunei	Cambodia	Indonesia	Laos	Malaysia	Myanmar	Philippines	Singapore	Thailand	Vietnam
Treaties										
WTO	✓	✓	✓		✓	✓	✓	✓	✓	✓
WIPO	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
Paris		✓	✓	✓	✓		✓	✓		✓
Berne			✓		✓		✓	✓	✓	✓
Rome			✓							
Hague							✓			
Madrid							✓	✓		✓
Nice								✓		
TLT			✓							
PCT			✓		✓		✓	✓		✓
WCT			✓				✓			
WPPT							✓			

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(2) IPR becomes Our Constitutional Right

- **Myanmar Constitutional Law 2008**

The Union shall permit citizens right of private property, right of inheritance, right of private initiative and patent in accord with the law.

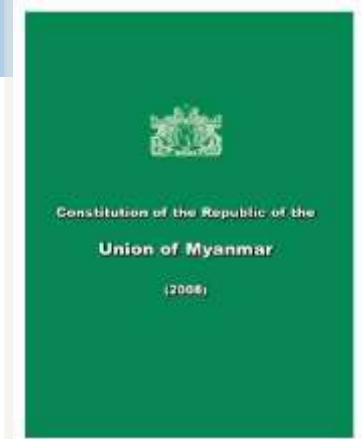
Fundamental Principles [Chapter 1, Section 37(C)]

Right to private invention and patent in the conducting of business is guaranteed if it is not contrary to the provisions of this constitution and the existing laws.

Fundamental Rights and Obligations of the Citizens [Chapter 8, Section 372]

Intellectual Property Rights such as Copyright, Patent, Trademark, and Industrial Design are clearly expressed in the Union Legislative Lists.

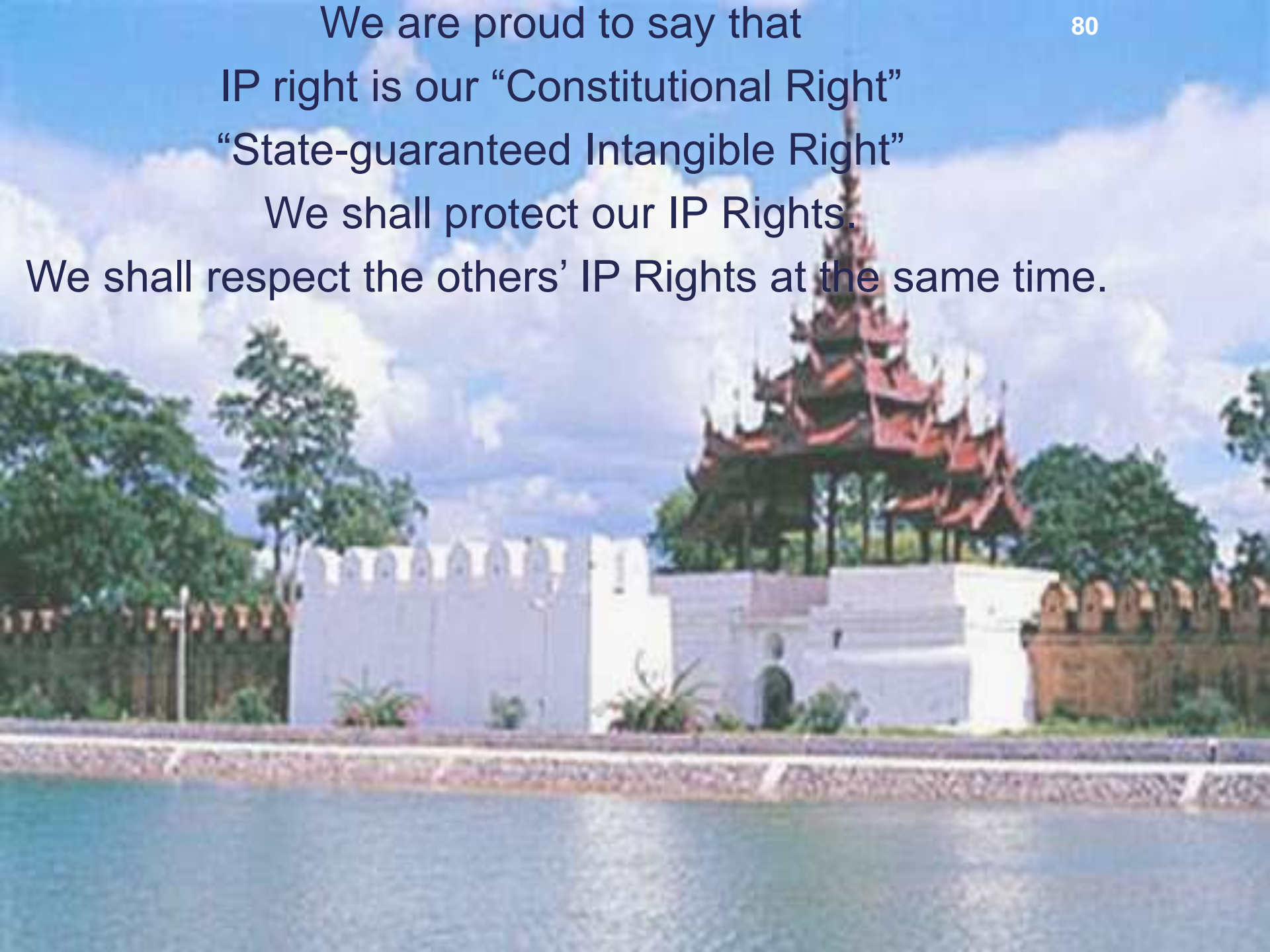
[Chapter 15 General Prescriptions, Schedule 1, Industrial Sector no.7(f)]



We are proud to say that
IP right is our “Constitutional Right”
“State-guaranteed Intangible Right”

We shall protect our IP Rights.

We shall respect the others’ IP Rights at the same time.



Expectation on the forthcoming new IP laws

- 1) **Laws to be enacted**

Trademark Law

Patent Law

Industrial Design Law

Copyright Law

- 10th drafts (Revised) have been fulfilled.
- To enact **the IP laws** in compliance with TRIPS and to establish **National IP Office** are the main tasks

In the forthcoming IP laws, we expect that It may include ...

- **Trademark Law**

Trademark Search

Protection of Well-known mark, GI, Series of Trademarks

Establishment of Myanmar IP Office, IP Court

Right of Priority and Temporary Protection

Validity Period *10* years

Legal Transfer of Registered Mark

License of Registered Mark

Invalidation and Cancellation of Registered Mark

Transitional Provisions

Customs' Salient Functions

Offences, Penalties and Remedies

Trademark law to be enacted

- 2) **Points that should be centralized**

Transitional Provisions

Within a transitional Period,

- Trademark Owner who registered under the existing law (Registration Act 1908) may have the full right under the new law subject to the provisions that the former registered TM is in line with the prescriptions of the new law
- Trademark Owner may have to re-register his mark under the new law

Trademark law to be enacted

- **3) Measures to be prepared**

(a) If there are intended TM to be registered in Myanmar, Register them now.

Whether 'intend to use' or 'actual use'

Be sure to be **distinctive** and **not deceptive**

Why???

(b) Stand to oppose filing of registration of new TM or re-registration of formerly registered TM if they are infringing or passing off your TM rights

(c) If you are uncertain, please do not forget to consult with competent local attorneys

We may expect **Patent law** to be enacted

- It may include **as the points to be centralized** that

Protection of Patent and Utility Model

Patentability and Non Patentability

Right of Priority and Temporary Protection

Term of Patent and Rights of Patent

Legal Transfer of Patent

License of Patent inclusive of Compulsory License

Remedies for Patent Infringement

Offences and Penalties

We may expect **Industrial design law** to be enacted

- It may include **as the points to be centralized** that

Registrable Industrial Design and Non Registrable Industrial Design

Right of Priority and Temporary Protection

Validity Period of Registration

Right of Registered Industrial Design

Transfer of Design Rights

License of Registered Industrial Design

Remedies for Design Infringement

Offences and Penalties

WE MAY EXPECT **COPYRIGHT LAW** TO BE ENACTED

- It may include **as the points to be centralized** that
 - Works protected and not protected
 - Term of Copyright
 - Economic Rights and Moral Rights
 - Limitations and Exceptions of Economic Rights
 - Transfer, Assignment and License
 - Protection of Related Rights
 - Registration of Copyright
 - Collective Management Organizations
 - Customs' Role
 - Remedies of Copyright Infringement
 - Offences and Penalties

Trademark protection checklist

- Infringement/ **Passing Off**

1. Reputation (in the particular market)
2. Colourable Imitation

Civil Remedies

Suit for Declaration (Specific Relief Act S.42)

Suit for Cancellation

Perpetual Injunction (Specific Relief Act S.54/ C.P.C order 39 r.1,2,3)

Damages/ Account of Profit/
Delivery-up

Seizure of infringed products/
articles/ documents

Limitation Act – 120 (6 years)

- Infringement/ **Counterfeit**

1. Unauthorised Use
2. Deception

Criminal Punishment

Penal Code S. 482-489/ 468/ 420

Merchandise Marks Act S.9

Sea Customs Act S.167(8)

Imprisonment/ Fine/ Both

Compensation out of Fine
(CR.P.C S.545)

Seizure of infringed products/ articles/
documents

Destruction / Confiscation

Myanmar Merchandise Marks Act S.
15 (3 / 1 year whichever is less)

“ To save IP is to raise the State’s dignity ”



Thanks with the warmest wishes.

U Thein Aung (*Advocate / IP Consultant*) *Senior Associate*

Myanmar Trademark and Patent Law Firm

Vice President cum Councilor of APAA

President of APAA Myanmar Recognized Group

Councilor cum Honorary Treasurer of ASEAN IPA

Legal Counsel of UMFCCI

Member of INTA, AIPPI, IPBA

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