



Enforcement of IPRs in Myanmar

JETRO, Tokyo, February 15,
2013

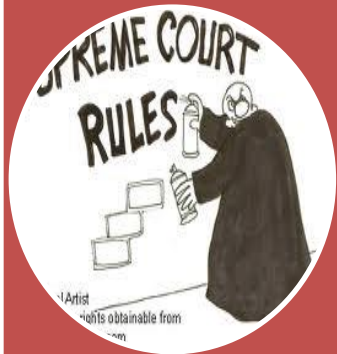
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Offices: Australia (liaison), China, Hong Kong, India (associated office),
Indonesia, Philippines, Saudi Arabia (associated office),
Thailand, UAE, United Kingdom, USA (liaison), Vietnam



Topics



Overview of legal and judicial systems

- Court system
- Arbitration system



Intellectual Property related agencies



Mechanisms and conditions to protect intellectual property rights

- Applicable laws
- Relevant cases law



Enforcement options



Recommendations



1. Legal and judicial system

Unique combination of common law and civil law systems: principles of common law and implants them into codified laws, statute laws, promulgated by legislature.

Sources of law include **Myanmar customary law**, statutes, directives of Ministries and Departmental notifications.

Doctrine of *stare decisis* is used in Courts.

The Arbitration Act applies to **domestic arbitration**. The Protocol and Conventions Act applies to the enforcement of foreign awards made in Geneva Convention countries having reciprocal arrangements with Myanmar, **there is no such reciprocal arrangement between Japan and Myanmar.**

Court system under the Judiciary law of 2000

Supreme Court

- The military appoints judges to the Supreme Court and the Supreme Court in turn appoints Judges to the lower courts.
- It sits in Yangon and Mandalay, it may issue its rules.
- IP lawsuit shall be instituted at the Supreme Court.

State or Divisional Court

- Appellate jurisdiction.
- Competency in IP matters.

District Court

- It may adjudicate on appeal or revision decision of the Township Court.
- Competency in IP matters.

Township Court

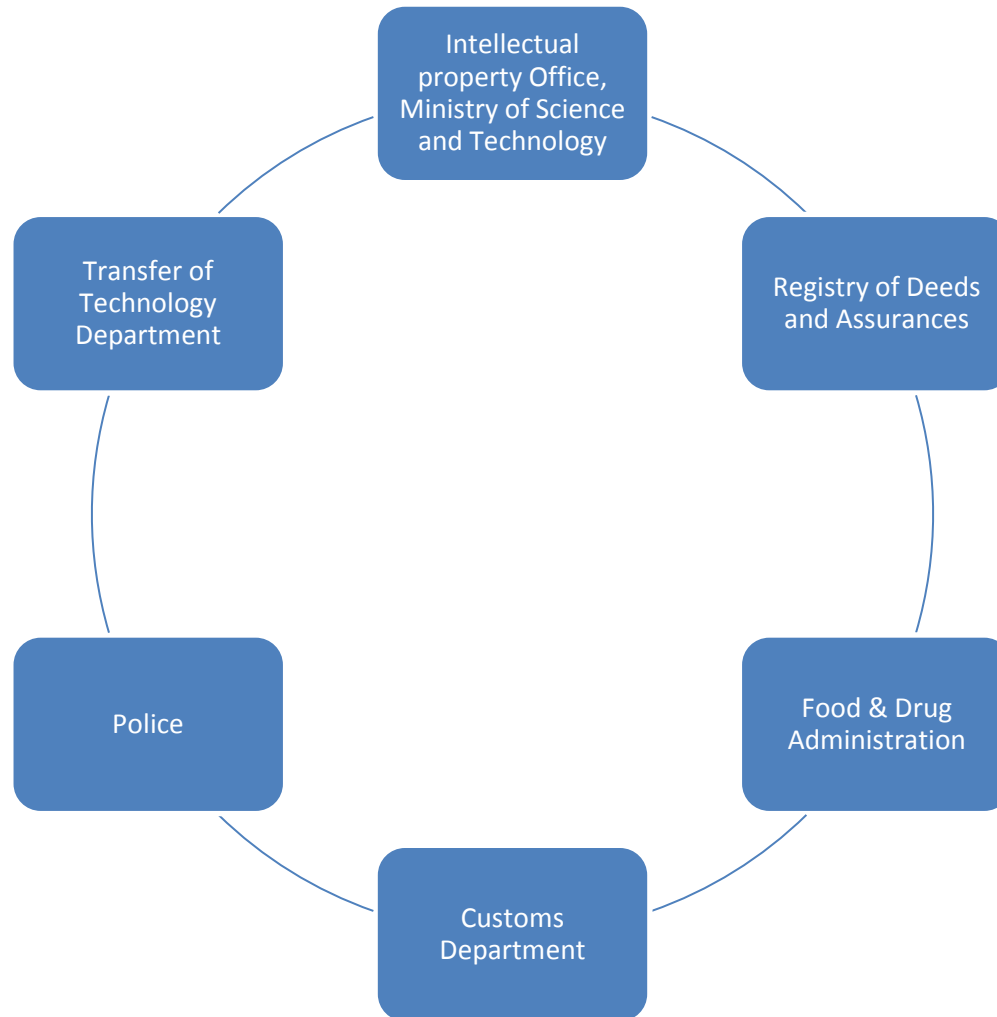
- Local court.
- Competency in IP matters.

Expected changes under TM draft Law

Specialized Intellectual Property Court: exclusive jurisdiction on disputes relating to intellectual and industrial property matters including but not limited to trade mark and patent.

Remedies: Injunctions; ex-parte injunction; order to preserve evidence (kind of “Anton Pillar Order”); ordering, setting a side, revising detention order issued by Customs Department; impose damages (civil action); remove or destroy counterfeit goods; issue warrants or orders against counterfeiters ; order the counterfeiter to reveal its supplying source(s); apply other remedies available under the Code of Civil Procedure and Code of Criminal Procedure.

2. Intellectual Property related agencies



Expected changes under TM draft Law

Ambitious IP institutionalisation process: until now the institutional trappings of IP implementation and enforcement in Myanmar has not received adequate attention. The promulgation of laws has not been accompanied by the creation of dedicated IP institutions such as a trade mark office. The Draft Law contains an ambitious institutionalisation process of IPRs registration and litigation through the establishment of a Myanmar Industrial Property Office, Registry, and an Intellectual property Court. Such level of IP specialization and modernization of the administrative and judicial systems is positive. However, its implementation is likely to constitute a real challenge to the Government.

3. Mechanisms and conditions to protect IPRs



Treaty memberships

- [Convention Establishing the World Intellectual Property Organization](#) (May 15, 2001)
- [Cartagena Protocol on Biosafety to the Convention on Biological Diversity](#) (May 13, 2008)
- [International Plant Protection Convention](#) (May 26, 2006)
- [International Treaty on Plant Genetic Resources for Food and Agriculture](#) (June 29, 2004)
- [United Nations Convention on the Law of the Sea](#) (June 20, 1996)
- [Convention on Biological Diversity](#) (February 23, 1995)
- [Agreement establishing the World Trade Organization \(WTO\)](#) (January 1, 1995)
- [World Trade Organization \(WTO\) - Agreement on Trade-Related Aspects of Intellectual Property Rights \(TRIPS Agreement\) \(1994\)](#) (January 1, 1995)
- [Convention concerning the Protection of the World Cultural and Natural Heritage](#) (July 29, 1994)
- [ASEAN Framework Agreement on Intellectual Property Cooperation](#)
- [Global System of Trade Preferences among Developing Countries](#)
- [ASEAN Trade in Goods Agreement](#) (May 17, 2010)
- [Agreement on the Common Effective Preferential Tariff Scheme for the ASEAN Free Trade Area](#) (January 28, 1992)
- [Agreement on Comprehensive Economic Partnership among Japan and Member States of the Association of Southeast Asian Nations](#) (December 1, 2008)

Patent and designs protection

No law in operation. Burma Patents and Designs Act and Emergency Provisions Act No. 5 of 1945 and No. 1 of 1946.

Pharmaceutical products : Drug Law of October 1992 and notifications of 1993 pertaining to drug manufacturing, importing, selling and distributing, labeling and advertisements.

Legislative framework for science and technological development and technology transfer.

During the lack of a specific Statute, patents and designs may be registered under the existing Registration Act.

Drafting new legislation for patents and designs to comply with TRIPS has been carried out by the Attorney General Office with the Ministry of Science and Technology.

Trade mark protection

There is no Trademark Act however, an established practice has well developed for the evidentiary assertion of the rights of trademark ownership. Trademark may be registered under Section 18 (f) of the Registration Act (Myanmar Deeds and Assurances Registration Act) as per the Direction 13 of the said Act.

A trademark may be registered with the Registry of Deeds and Assurances by means of declaration that is a solemn statement of facts made by the trademark owner. Despite the fact that registration is not a conclusive proof of the ownership, it becomes a prima facie evidence of ownership and may be of certain help in the criminal and civil proceedings.

The most effective way to establish the ownership of a trademark in Myanmar is by putting the goods bearing the mark on the local market, advertising, registering and renewing the registration and publication every three years.

Trade mark protection

Application recorded under current system

Application filed under the New Draft Law

Recorded mark under current system

Temporary certificate of registered mark (if filed within 3 years from new Law comes into force)

Registered mark (if it accords with the Law)

Not recorded mark under current system

New application (examined within 3 years from new Law comes into force)

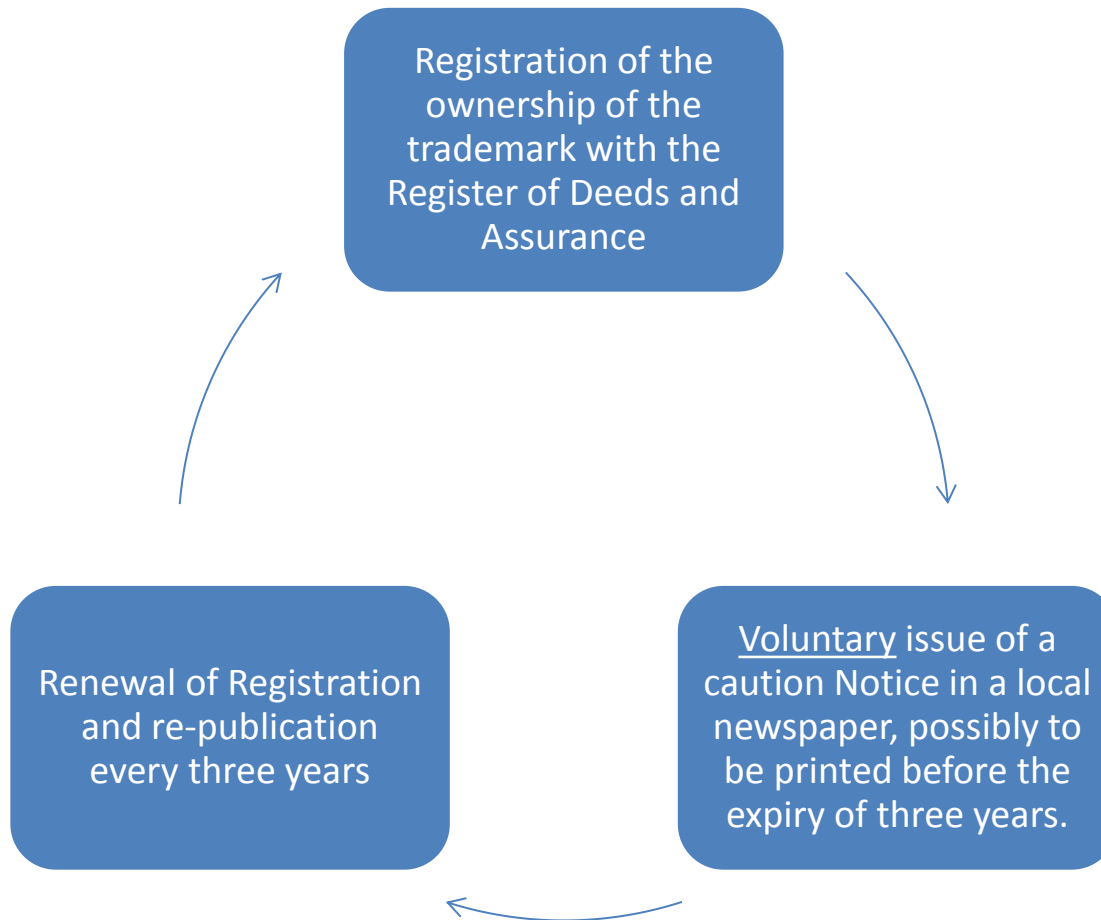
Rejected if it conflicts with prior recorded mark re-filed within 3 years from new Law

Expected changes under Trade Mark Draft Law

Uncertainty persists: although the Draft Law constitutes a very significant improvement from the current legislation and practice, we are of the view that uncertainty in the ownerships of trade mark rights persists (i.e. 3 years transition period, conflict resolution between *prior use* and *first to file*, rights granted to “temporary registered marks”, absence of provisions dealing with conflict resolution between trade marks and geographical indications etc.).

Trade mark filing in brief

*Average time to complete the registration process **4 weeks**, documents required DOT and POA.*



TRADE MARK CAUTION

NOTICE is hereby given that **Thai Union Frozen Products Public Company Limited.** a company organized under the laws of Thailand and having its principal office at 979/12 M. Floor, S.M. Tower, Phaholyothin Road, Samsennai, Phayathai, Bangkok 10400, Thailand is the owner and sole proprietor of following trademarks:-



(Reg: No. IV/3370/2012)



(Reg: No: IV/3371/2012)

The above two trademarks are in respect of:-
“Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products, edible oil and fats; all goods in this class, especially packaged tuna, packaged sardines, packaged mackerel, packaged squids, packaged shrimps, packaged clams, packaged crab meats, packaged frozen sea foods, packaged sea foods, fish snack, canned meatball” – Class: 29

Any fraudulent imitation or unauthorized use of the said trademarks or other infringements whatsoever will be dealt with according to law.

U Kyi Win Associates
for **Thai Union Frozen Products Public
Company Limited.**

P.O. Box No. 26, Yangon.

Phone: 372416 Dated: 23rd July, 2012

TRADE MARK CAUTION

NOTICE is hereby given that **Thai Union Manufacturing Company Limited.** a company organized under the laws of Thailand and having its principal office at 979/13-16 M. Floor, S.M. Tower, Phaholyothin Road, Samsennai, Phayathai, Bangkok 10400, Thailand is the owner and sole proprietor of following trademarks:-



(Reg: No. IV/3359/2012)



(Reg: No. IV/3360/2012)

The above two trademarks are in respect of:-

“Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products, edible oil and fats; all goods in this class, especially packaged tuna, packaged sardines, packaged mackerel, packaged squids, packaged shrimps, packaged clams, packaged crab meats, packaged frozen sea foods, packaged sea foods, fish snack, canned meatball” – Class: 29

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U Kyi Win Associates
for **Thai Union Manufacturing Company Limited.**

P.O. Box No. 26, Yangon.

Phone: 372416

Dated: 23rd July, 2012

Copyright protection

Myanmar is not a member to the Berne Convention. It protects original literary, artistic, musical and dramatic works by the 1914 Copyright Act.

In this Act, protected works, authorship and ownership of copyright, duration (term) of copyright, limitations, infringements of copyright, applications of copyright, civil and criminal remedies, definitions and penalties are included.

Myanmar being a member of WTO has an obligation to implement the provisions of the TRIPs Agreement. The drafting process of a new Copyright Law started on September 2004 headed by the Minister for the Prime Minister Office, with the cooperation of Office of the Attorney General and Ministry of Science and Technology. The draft new law is based upon the WIPO model law and in line with the TRIPs Agreement and Conventions and Treaties administered by WIPO and now it reached to the eight draft. This law will be come out within the time frame imposed by the TRIPs Agreement.

4. Enforcement options





Civil and criminal actions



Expected changes under Trade Mark Draft Law

Mixed enforcement signals: although civil and customs enforcement mechanisms supported by the establishment of an IP Court are encouraging, provisions pertaining to criminal enforcement of trade marks seem incomplete and weak (amount of fines are missing, no specific provision to deter repeating offenders etc).

How to determine Trade Mark infringement?

Registration itself only is not a conclusive proof of the ownership . In the absence of registration of respective marks it might be possible for parties to establish their rights by circumstantial proof i.e. by the principles of Common Law, (use of the mark) rather than by prima facie evidence.

Two marks at issue need not be identical, similarity though slightly different between them is sufficient to claim infringement

An owner of a mark has no right to prohibit other persons from the use of such mark for unrelated goods

Trade mark : civil & criminal actions

From series of case laws and prevailing practices, a person aggrieved by the infringement of his trademark can have two remedies : (1) she/he can institute **criminal proceedings** under Penal Code and/ or (2) she/he can bring a **civil action** for an injunction and damages. The obtainable relieves in these actions are injunctions (both temporary and perpetual injunction inclusive), damages and other ancillary remedies.

In **Penal Code**, Sections 478 to 489 in Chapter 18 provide definitions of trademark; property mark; using false marks and punishment for making, using and possessing such marks. In these proceedings, the defendant is liable to be fined and/ or imprisoned if found guilty.

The Merchandise Marks Act empowers the Court to confiscate all goods and things involved in the commission of offences.

Trade Mark criminal action

False mark or
counterfeiting
a mark

- using a false mark, selling goods marked with a counterfeiting mark under Articles 482-486 of the Penal Code.

**Exemptions
under Article
486:**

- The accused can be exempted from sanctions if she/he can prove that she/he acted innocently due to lack of knowledge of the difference between genuine and counterfeit
- He/she can identify the main source of counterfeit

Raid actions

Investigation : difficult because of lack of investigation firms

Normal enforcement route: amicable settlement, raid action by the Police

Requirements: prove TM rights in Myanmar (recorded mark + published mark) and actual use in Myanmar through proper distribution channels

Time to organize raids : few weeks if documents are ready

Fines : usually small and not much deterrent

Trade Mark criminal action



Punishments range from a fine to three years' imprisonment and seizure and destruction of infringing articles and goods.

How to determine trade mark infringement between conflicting marks? Cases law corner

Taj Mahal Stationery Mart Vs K.E. Mohamed Ebrahim V.S. Aliar & Co.

- *“ In Burma, there is no system of registration of trade marks, nor for a Statutory title to a trade mark. So the rights of the parties setting up rival claims for ownership of a trademark must be determined in accordance with the **principles of Common Law.**”*

Ko Maung Ngwe Vs Mr. B Lal

- *“ In Thomas Somerville Vs Paolo Schembri which was a case from Malta where there was no law or statute enabling the registration of trademarks it was held that by general principles of Commercial Law, **as soon as a trademark has been so employed in the market** as to indicate the purchasers that the goods to which it is attached are the manufacture of a particular firm, it becomes to that extent the property of the firm.”*



Administrative actions



Customs action

The **Sea Customs Act** prohibits export or import by land or sea of goods bearing a counterfeit mark. The remedies are confiscation of the goods and a fine. Custom officers are authorized to stop and search any person, vessel or vehicle on the grounds of reasonable suspicion.



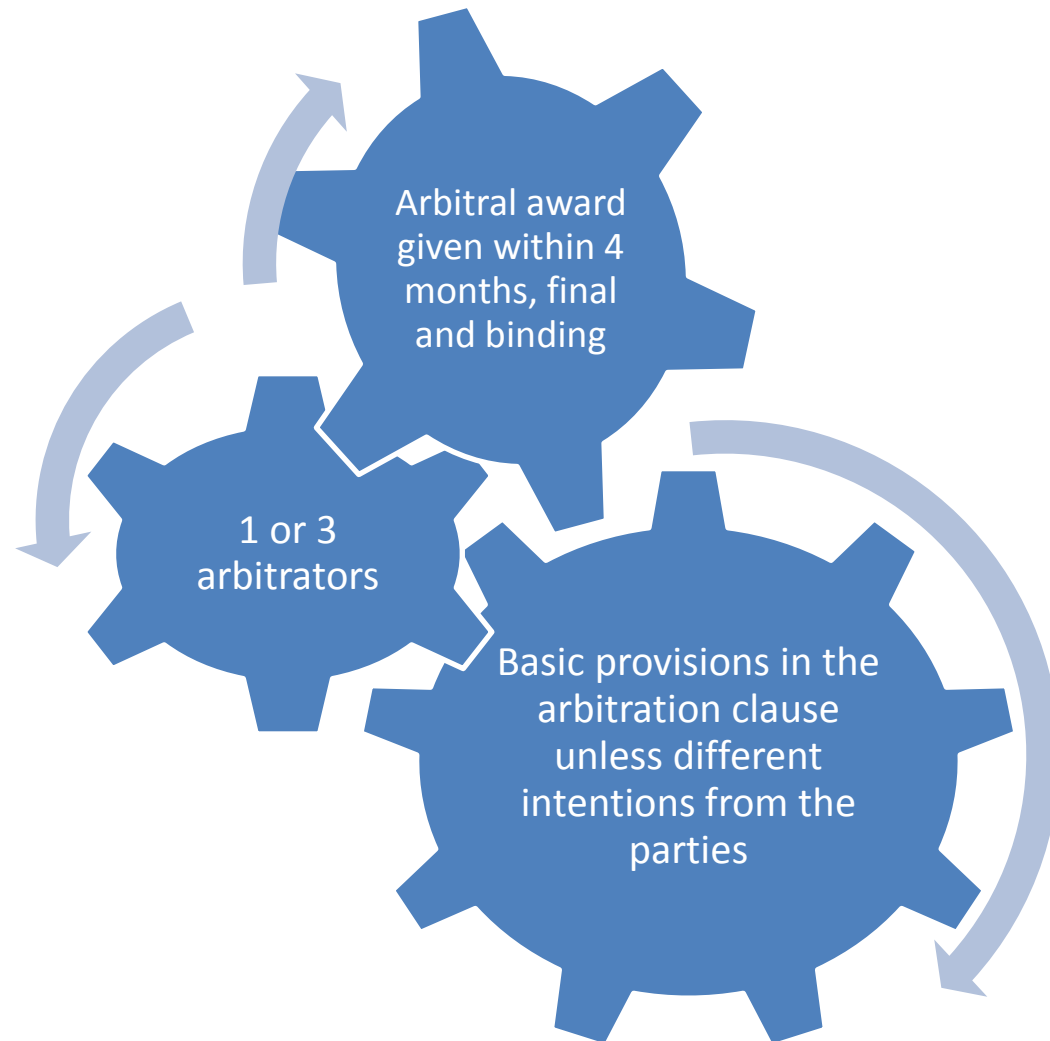
Substitute to litigation ?



Arbitration

Amicable settlement

Arbitration under the Arbitration Act 1944



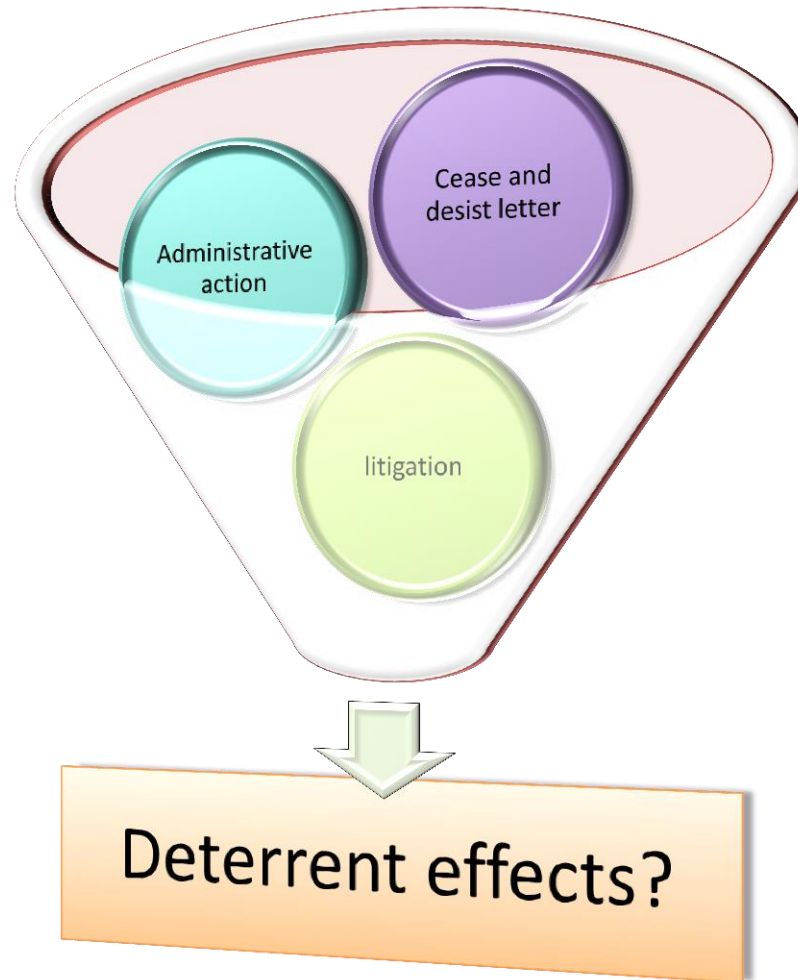
Arbitration under the Arbitration Act 1944

- Apart from disputes arisen from **trading**, there is **no explicit legal authority** as to whether one of the parties is domiciled in Myanmar and the other party abroad can agree on foreign arbitration institutions. Such authority may be implied from two cases in which the facts included foreign arbitration institutions. Also, after 1988, when market-oriented reforms were introduced in Myanmar, quite a number of contracts between Myanmar parties and foreign parties, including contracts in which the Myanmar party is a government entity, have included provisions for foreign arbitration institutions.
- The mere existence of a valid arbitration clause included in an agreement **does not** bar access to state courts. If a party to such agreement, however, commences a legal proceeding with respect to subject matter thereof, the other party has a right to get Such proceeding stayed so as to enable arbitration to proceed in accordance with the terms of the agreement.

Amicable settlement

IPRs infringement cases are handled by the Township/District/State or Regional Courts and the Supreme Court. Disputes are also amicably solved by **negotiations** or **conciliations** and with the intervention of a third party which may sometimes take place.

Enforcement generally takes the form of sending **cease and desist letters** followed by **amicable settlement**. In this respect, it is similar to the enforcement mechanisms in place in Cambodia with Cam Control and Economic Police.



5. Recommendations

Preventive steps vs. curative measures.

Registration + publication of cautionary notice even if that publication is not compulsory.

Re-apply for trade mark after the entry into force of the new law

Collect evidence of use of your marks in Myanmar

Recommendations

The Office of the Attorney-General has completed the bills on IP laws in compliance with the TRIPS Agreement. It is expected that the new Trade Mark Law will enter into force in **early 2013** (possibly March 2013). Under the new Trade Mark Law, there will be a **proper registration procedure** with formality and substantive examinations. All marks which have been recorded prior to March 2013, under the current law, will have to be **re-filed** under the new trade mark law in order to gain protection in Myanmar. However, if a mark is re-filed **within 3 years** from the date of entry into force of that new law, it should increase its chance to obtain protection.



Souvenirs from field visits...







