

KELVIN CHIA YANGON

LOCAL KNOW-HOW WITH INTERNATIONAL EXPERTISE

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Kelvin Chia Yangon Ltd. (KCY) has been in active operation in Myanmar since 1995, currently with offices in Yangon and Mandalay. KCY is the firm of choice for those seeking to navigate, where we have gained extensive experiences and expertise across all the fast-changing legal and regulatory landscape in Myanmar areas of commercial practice.

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MYANMAR TO ADOPT THE “FIRST-TO-FILE” SYSTEM, AND THOSE WHO HAD ALREADY REGISTERED UNDER MYANMAR’S EXISTING REGISTRATION REGIME FOR TRADEMARKS WILL STILL NEED TO RE-REGISTER UNDER THE NEW LAW.

On January 24, 2019, the Trademark Bill and the Industrial Design Bill were both passed by the Myanmar Parliament and have been forwarded to the President of Myanmar for approval.

Upon approval of the President of Myanmar, we can expect that, as regards the registration regime relating to trademarks, Myanmar will adopt the “First-to-File” system. Therefore, in order to obtain protection accorded by the law, trademark owners would be required to file applications in accordance with the requirements of the new law, and this would include trademark owners that have previously registered trademarks under the current trademark registration regime.

The drafts of both approved bills have not been released to the public as of this writing, and the date of enforcement has yet to be determined. However, as has been customary in Myanmar, we can expect a transitional period which trademark owners can use in order to prepare for the filing of appropriate applications under the new law.

Although the manner by which the provisions of the new law will be enforced in practice still remains to be seen because of the “First-to-File” system that the new law will put in place, trademark owners should obtain the earliest possible filing date to effectively block all other identical/similar marks that may be filed with respect to identical/similar goods and services.

In light of this, you may already want to prepare for the submission of the relevant application documents satisfactory to avail of “First-to-File” protections under the new law. These requirements are listed below:

(a) The applicant must provide the following details in the application:

- (1) request for registration
- (2) name and address of the person or lawful organization applying for registration
- (3) if the application is submitted by a representative on behalf of the applicant, the representative's name and address
- (4) complete and clear description of the mark
- (5) name and standard of goods and service, or, goods or services requested for registration in accordance with international mark classification

(b) In addition to the details above, the following must be attached if necessary:

- (1) the registration number, type and country origin of the organization, if the applicant is applying on behalf of a lawful organization,
- (2) documents supporting, describing and requesting the claim of right of priority, if the applicant request right of priority
- (3) documents supporting, describing and requesting the trade fair right of priority, if the applicant request trade fair right of priority
- (4) a certificate of registration, if the mark in the application is registered at the Office of the Registration of Deeds

We hope you find the foregoing useful. We will keep you apprised of developments as they occur.



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