

President Htin Kyaw
Presidential Palace
Office No. 8
Nay Pyi Daw, Myanmar

19 March 2017

Re: Draft Trademark Law

Dear President Htin Kyaw,

The International Trademark Association (INTA) is pleased to submit these comments to the draft Trademark Law and subsequent implementing regulations in Myanmar. INTA strongly encourages the swift signing and passage of Myanmar's Trademark Law, which has passed both houses of parliament, and strongly encourages the commitment of resources to building the nation's first trademark registry. Trademarks are an essential element of trade, and will encourage investment, promote domestic innovation and protect consumers.

The International Trademark Association (INTA) is a global organization of 7,200 trademark owners and professionals from over 191 countries, including 10 members in Myanmar and 289 members in the ASEAN region. INTA is a not-for-profit membership association dedicated to supporting consumer confidence, economic growth and innovation. Founded in 1878, INTA is a leader in global trademark research, policy development, and education. For more information please visit our website at www.inta.org.

INTA commends Myanmar for the progress made towards enacting its first trademark laws. We have been strong supporters of these efforts for several years. In 2012, INTA conducted its first meetings with Myanmar government on the details of trademark protection and enforcement, and provided comments on draft legislation at that time. INTA and its members have undertaken public education campaigns and continued to work with Myanmar officials on a frequent basis.

INTA supports the progress over the years on Myanmar's development of trademark law and the forthcoming trademark registry, in line with INTA's Model Trademark Law Guidelines and Model Trademark Examination Guidelines.¹ We supports the trademark legislation and encourages its rapid passage and swift implementation.

INTA recommends the following areas be clarified in forthcoming implementing regulations, in order to create a robust, transparent and world-class trademark system.

¹ Please see the following webpage for a complete list of INTA model laws and regulations:
<http://www.inta.org/Advocacy/Pages/ModelLawsandGuidelines.aspx>

Transition Provisions

As Myanmar transitions from cautionary notice publications system of protection of trademarks to a formal registry of trademarks, INTA members call attention to the need for transitions that:

- Protect the rightful trademark owner;
- Are transparent, with legal clarity;
- Prevent inefficiencies (e.g. rush to the office, backlogs); and
- Prevent incentives for trademark squatters and bad-faith registrations.

INTA notes that Article 92 of the draft law allows for submission of previously filed rights under with the registry of deeds. However, details of what the effect of submission of these documents is unclear.

INTA suggests the following provisions be considered in implementing regulations or interpretation of Article 92's effect:

- The Office should give substantial deference to earlier cautionary notices to determine which party has superior rights between conflicting registrations; or
- Entities who have advertised their trademarks through cautionary notices are granted a provisional period within which to register and to claim priority; and
- Priority should only be granted to trademark applications which correspond in its entirety to the advertised trademarks in the cautionary notices.

A proposed transition process could be:

1. Filing sunrise applications
2. Substantive examination by the IP Office
3. Resolution of conflicts regarding confusingly similar trademarks that had been previously published (*inter partes* and/or decided by the IP Office)
4. Applications open to public, outside the transitional provisions

Also in the manner of domain name system, if conflicts arise during the transition period, the conflict could be resolved in efficient and low-cost dispute resolution mechanism.

Furthermore, the Office should be aware of the threat of trademarks squatting and bad-faith registration. INTA advises that practice agree with INTA's board resolution on bad-faith registrations, including taking into account the following factors when determining if a party is acting in bad-faith:²

- whether the mark was applied for/registered primarily to appropriate a trademark well known in other jurisdictions or to disrupt the business of a competitor;
- whether the mark was applied for/registered primarily to sell, license, or otherwise transfer the registration to the party opposing or seeking to cancel or to a competitor of that party;
- whether the mark was applied for/registered primarily to prevent the party opposing or seeking to cancel from acquiring trademark rights in the jurisdiction in which the application was filed;
- whether the applicant/registrant has a legitimate interest in the mark applied for;

² For further information on this board resolution and the background research on this important issue, please see: <http://www.inta.org/Advocacy/Pages/BadFaithasaGroundforOppositionProceedings.aspx>

- whether the applicant/registrant applied for/registered the mark with the intention of creating confusion as to the source, sponsorship, affiliation, or endorsement of the applicant's/registrant's goods or services;
- whether the applicant/registrant knowingly made false statements in connection with the trademark application/registration;
- whether the applicant/registrant has engaged in a pattern of applying for/registering marks in which it had no legitimate interest; and
- the degree of distinctiveness of the mark applied for.

Customs

Sections 66-74 cover customs and that customs will have authority to seize infringing goods. INTA recommends that customs also create a trademark recordal system where by rightsholders can register their trademarks with customs for effective enforcement of their rights at the border.

Additionally, INTA advises that the law be clarified to include transshipment of goods as "importation" for the purposes of finding an infringement.

Non-traditional Marks

INTA notes that the law does not include non-traditional marks, such as sound, color or shape marks. We strongly encourage future legislative drafts to consider these important trademarks, as evidence clearly show that consumers identify these signs and relate them to a product or service's origin.

INTA's Legislation and Regulation Committee, Trademark Office Practice Committee and Anticounterfeiting Committee and staff prepared these remarks. If you have any questions or concerns, please contact INTA's Asia-Pacific Chief Representative, Seth Hays at shays@inta.org.

Sincerely,

Etienne Sanz de Acedo
Chief Executive Officer
International Trademark Association

CC: State Councilor

Minister of Trade

Minister of Education