

Protection of Trademark Rights in Myanmar

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Abstract

A trademark is a word, symbol, brand names or phrase used to identify a particular manufacturer or seller's products and distinguish them from the products of another that is intangible when first created or invented. The owner of a trademark right owns the exclusive right to use the registered trademark for the designated goods and services listed in the application for trademark registration. Trademark law relating to the Registration Act, 1908, Penal Code, 1861, Specific Relief Act, 1877, Myanmar Merchandise Marks Act, 1889 and Sea Customs Act, 1878 in Myanmar protects the right of the mark owner to the exclusive use of that mark thereby protecting the owner's continued enjoyment of his trade reputation and the goodwill that flows from it, free from interference by others.

Key words: Intellectual Property, Trademarks, Specific Relief, Infringement, Passing - off Actions

Aims and Objectives

Trademarks are the most important category of the present day intellectual property law. With the aims of Protection of Trademark Right in Myanmar has laid down the following objectives: What is IP? How many types of IP are there? How to protect the Trademark Right and the students should study and understand the international agreements, conventions and Laws.

Introduction

Intellectual Property (IP) is the term that describes the ideas, inventions, technologies, artworks, music and literatures, which are intangible when first created.

Trademark" related to English word " Brand" which is reflected the marking placed on cattle by farmers with irons. Nevertheless, the people, nowadays understood, " Brand - name " as " Trademark.". "Trademarks" already existed since thousands of years ago, used by the Indian craftsmen. They engrave their signatures in their artistic creations or Ancient Chinese people also were using their marks on pottery - works or utilitarian products which they made export.

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A trademark gives protection to the owner of that mark by ensuring the exclusive right to use it to identify goods or services or to authorize the next person to use it by giving back money as rent for reputation of good with that trademark. Trademark protection is enforced by the courts, which in most systems have the authority to block trademark infringement. The registered trademark supports not only for commercial value but also dignity of the good which is given the name (trademark) like as artificial person.

The legal rules for trademarks are complicated and based on experience in selling products. Because trademarks are such a key part of doing business, federal and state law protect a business's right to identify its own merchandise and to keep other people from counterfeiting merchandise or using confusingly similar trademarks.

Definition

A trademark is a sign capable of distinguishing the goods (or) services produced (or) provided by one enterprise from those of other enterprises. In alternative way, a trademark is a distinctive sign, which identifies certain goods or services as those produced or provided by a specific person or enterprise. Any distinctive - *words, letters, numerals, drawings, pictures, shapes, colors, logotypes, labels or combination* used to distinguish goods or services may be considered a trademark. In some countries "advertising slogans" are also considered trademarks and may be registered as such at national trademark (or) patent office.

Using Trademarks

It will be applied for registration before you have used the trademark but some countries will not officially register it until you have shown proof of use (e.g. the United States). Also, in most cases, a trademark that has not been used for a given period of time (generally three to five years) following registration may be taken off the trademark register.

There is International Classification of Goods & Services for the purpose of the Registration of Marks under the Nice Agreement. There are 34 groups for goods and 11 groups (From 35 to 45) for services. In October 2003, 72 States were party to the Nice Agreement. They have adopted and apply the

Nice classification for the purposes of the registration of marks. You may therefore begin by familiarizing with the 45 different trademark classes.

The Value of Trademarks

A carefully and nurtured trademark is a (valuable business asset) for most companies. For some, it may be the most valuable asset they own. Estimates of the value of the world's most famous trademarks such as coca - cola (or) IBM exceed 50 billion dollars each. This is because consumers value trademarks, their reputation, their image and a set of desired qualities they associate with the mark, and are willing to pay more for a product bearing a trade mark that they recognize and which meet their expectations. Therefore, the very ownership of a trademark with a good image and reputation provides a company with a competitive edge.

Protection of Trademarks

Of course, it has commercial value it is needed to protect for the economic (or) financial way of thinking. While most businesses realize the importance of using trademarks to differentiate their products from those of their competitors, not all realize the importance of protecting them through registration. The registration, under the relevant trademark law, gives your company the exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar mark. If you do not make "Trademark" registration you might have to face the trouble that rival companies make some (or) a confusingly similar trademark for identical or similar products and your product may become wasteful. It may also damage the reputation and image of your company, particularly if the rival product has inferior quality.

Registration of Trademark in Myanmar

It is depend on registration level like as local, regional and international. Trademark will be protected due to where you have registered. Registration is *prima facie* evidence of the validity of the original registration. Registration gives the owner the exclusive right to the use of the trade mark. There is an infringement of this right when any person uses in the use of the trade mark. There is an infringement of this right when any person uses in the course of

trade an identical mark in relation to similar goods or services or a similar mark in relation to identical or similar goods or services. Registration covers only specified goods or services.

There is no separate patent office to register the trademarks in Myanmar. For the time being, registration office of Documentaries under ministry of Agriculture & Irrigation is working for such issues in accordance with (The Registration Act, 1908) and (Direction 13 of the Inspector - General of the Registration 1952). The new Intellectual Property Laws of Myanmar is under way coordination and cooperation among ministries concerned and Attorney General office. According to the instructions of the leading cases the right to own the trademark is started on the actual date which is used in commercial activity not on the trademark registration date.¹

Registration gives the registered owner the exclusive right to use the mark. He may sue any infringer for any unauthorized use of the registered trademark or for using a similar sign. If there is similarity the plaintiff must show that there will be a likelihood of confusion among the public. Both civil and criminal remedies are available for trademark infringement. The penalty will be due to the entire national laws.

Trademark Protection in Myanmar

Actually, there is no specific law related to trademark in Myanmar yet, civil procedure code but some laws and regulations of Penal Code, Registration. Act, Specific Relief Act, Merchandise Marine Act and Sea Custom Act are under applied related to trademark issues to give resolutions the criminal and civil disputes. For example, such as, civil procedure code, decree No. 39, regulation 1,2,3, Penal code Section 482 to 489 and Merchandise Marks Act Section 8 and Section 9 are relevant to trademark.

Since colonial period, Myanmar legal system follows the "Legal Principles of English Common Law" to solve the legal disputes related to trademark issue. Such a kind of leading cases has already made by the courts and "trademark protection" is made by said leading cases even though Myanmar has no specific Trademark Act yet. Therefore, Myanmar is praising

¹ U Kyaw and U Ba Aye 1962 BLR (cc) 187.

common law concept to issue resolution for trademark and copyright issues as there is no proper system of patent to trademark in legal practice in Myanmar.¹

In the leading case , the court defined that like as "Shwenantheingi Thwesay" (Shwenantheinge blood tonic powder) is index of the description of the goods. Thus it is not "trademark" rather than " distinctive mark" of the good.²

In the leading case, the court held, "Yangon Spectacles Shop" which is operating business in Taungoo. Such a name is "geographical name" but it does not index to manufacturing place and thus that is "trademark".³

In the leading Case the court held, even though that is same to other trademark it has right to use in different good. So, the original Johny walker is for whiskey and it can use for blood tonic.⁴

Trademark rights are protectable now in Myanmar under existing laws such as Penal Code and some civil laws which are as follows:

- (a) Registration Act, 1908,
- (b) Penal Code, 1861,
- (c) Specific Relief Act, 1877,
- (d) Myanmar Merchandise Marks Act, 1889 and
- (e) Sea Customs Act, 1878

There was no action could therefore be brought for infringement of a trademark, but the courts maintained passing - off suits. This concept was accepted and followed by the courts in Myanmar up to 1968 or *John Walker & Sons Ltd* case. So the rights of parties setting up rival claims to ownership of a trade mark must be determined in accordance with the principles of Common Law. A plaintiff may institute a criminal case under the Penal Code for using a false trademark, or counterfeiting a trademark, or making or possessing any instrument for counterfeiting a trademark, or selling goods marked with a counterfeit trademark. The defendant is liable to be fined and / or imprisoned if found guilty. In Myanmar both criminal and civil remedies for infringement of a trademark can be sought. Actually, the concept

¹ The Tajmahal Stationery V K.E Mohamed Ebrahim 1949 BLR (HC) 41.

² Daw Thet Pu V Saya Khin, 1952 BLR (HC) 245.

³ Ko Maung Ngwe V Mr.B Lall 1962 BLR (CC) 93.

⁴ Johny Walker & Sons Ltd V U Than Shwe 1968 BLR (cc)73.

that trademark can be protected on the basis of use is based not on a statute but on common law, which is to say that precedence is established through court decisions.

The possible enforcement of one's rights to a trademark by way of criminal action is under the Myanmar Penal Code 1860. Myanmar is one of only a few countries who recognize criminal offences for trademark infringement.

Section 478 to 489 of the Myanmar Penal Code provided relating to trademark, property mark and other marks. An owner of a trademark may take criminal action against an infringement of his trademark for the following offences:

- (a) Using a false trademark;
- (b) Counterfeiting a trademark;
- (c) Making of possessing any instrument for counterfeiting a trademark,
- (d) Selling goods marked with a counterfeit trademark.

In addition to these sections, the penalties prescribed in section 482 and 483 of the code for fraudulent and imitation of the mark.

Punishment under Section 482 and 483 of the Penal Code is one year to two year terms imprisonment or fine or with both to the person who defraud or counterfeit.

In the case of *U Kyaw (Applicant) v. U Ba Aye (Respondent)*¹, the criminal revision case for the Criminal Regular Trial No. 252 of 1959 of the 1st Additional Special Power Magistrate, Paung. The accused U Ba Aye (respondent) was sent up for trial for an alleged offence under section 483 of the Penal Code upon the complaint of the present applicant Ko Kyaw. It was alleged that the accused was manufacturing mechanical lighters and selling them under the trade mark depicting two animals, viz, elephant and lion with the name of the manufacturer Ko Kyaw printed in between the pictures of the two animals. The learned trial Magistrate, however, acquitted the accused on the ground that the complainant Ko Kyaw had not succeeded in establishing beyond reasonable doubt that he was the exclusive owner of the trade - mark used by him and that, in any event, it was not proved that the accused was manufacturing mechanical lighters and selling them under the particular trademark. The sheet anchor of the complainants case was that in the year 1957, he had registered the trade mark depicting the pictures of two animals, elephant and lion with the name Ko Kyaw printed between the two pictures and that the accused

¹ 1962, Myanmar Law Report, P. 187.

knowing fully well that lighters under this trademark had become popular, had tried to imitate them, Both Ko Kyaw and U Ba Aye had fairly large factories at Martaban. Ko Kyaw said that he had been selling mechanical lighters under the trademark elephant and lion since about three or four years before complaint although the registration of trade mark was undertaken only two years ago.

It is settled law that in Myanmar 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. U Ba Aye cited as witness a Myanmar gentleman and he stated that U Ba Aye used to purchase such lighters from him on a wholesale basis. As intention to defraud is an essential element in criminal prosecutions for infringement of trade marks. In this case, the Judge U San Maung did not consider that he should interfere. Therefore the application for revision is dismissed.

Under Section 480 of the Myanmar Penal Code defines using a false trademark and punishment for making use of any such false mark is provided in Section 488 of the Penal Code.

Whoever counterfeits any property mark used by a public servant, or mark used by a public servant to denote that any property has been manufactured by a particular person or at a particular time or place, or that the property is of a particular quality or has passed through a particular office, or that it is entitled to any exemption, or uses as genuine any such mark knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to three years, and also be liable to fine.¹

Whoever makes or has in his possession any die, plate or other instrument for the purpose of counterfeiting a trade mark, or property mark, or has in his possession a trade mark or property mark for the merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with both.²

In the case of selling the forged *Giordano* properties with *Giordano* Trademark, the complainant sued Sein Gay Har Store of Latha Township under Section 420 and 486 of the Penal Code . They argued that his company suffered loss and damage. The court decided that the accused Ko Mya Soe of Sein Gay Har Store

¹ Section 484, Penal Code.

² Section 485, Penal Code.

has been convicted under section 486 of Penal Code and Punished with fine of K.20000/- or in defamer with imprisonment of 4 months.¹

Since Myanmar has no Trademark Act, an action for infringement of a trademark was not practiced until 1968. But in the case of *John Walker & Sons ltd V. U Than Shwe*² in 1968, the Chief Court taking notice of Section 54 of the Specific Relief Act and held that a suit for infringement of a trademark is maintainable.

There are two ways of action; passing-off action and infringement action under Civil Laws. So depending on the nature of the case an action for passing off or an action for infringement of a trade mark could be taken. But the relief is the same. The reliefs that can be obtained are injunction; damages and other consequential relief.

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. Registration depends on distinctiveness acquired through use. Members of WTO may require, as a condition of registration, that signs be visually perceptible. The Penal Code of Myanmar defines as: "A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trademark".³ In the case of *Gaw Kan Lye v. Saw Kyone Saing*,⁴ the meaning of a "distinctive mark" was clarified. "Distinctive" means distinguishing a particular person's goods from somebody else's - not a quality attributed to the particular article, but distinctive in that respect that it is a manufacture of his, distinguished from somebody else's.

The leading case is. *U Chit Swe (Appellant) v. Ma Than and three Others (Respondents)*,⁵ This dispute was arising out of a trademark known as (“စောင်းကောက်”) means (harp) which is a very popular brand of slippers in the market at that time. It was held that trader acquires a right of property in a distinctive trademark merely by using it upon and in connection with his goods, irrespective of the length of such user and the extent of his trade.

¹ *U Han Kyi (The Creation Myanmar Co., Ltd) v. Ko Mya Soe (Sein Gay Har Store) (3-10-2001)*.

² 1968, Myanmar Law Reports CC p.73.

³ Section 478 of the Penal Code.

⁴ 1939, Yangon Law Reports, p.503.

⁵ 1958, Myanmar Law Reports, p.377.

It has been held in *J.Petley & Son v. S. Ah Kyun*¹ that the style of the "get up" of the boxes or packages in which goods are retailed does not constitute a "trademark" as defined in section 478 of the Penal Code.

Trademark is defined in the Special Appellate Civil Case No. 23, 2000. In this case, Section 478 of the Penal Code was referred for the definition of trademark and judges defined Trademark as "any sign or symbol applied or attached to goods offered for sale in the market so as to distinguish them from similar goods and to identify them with a particular owner. A trade mark includes a device, brand, heading etc and any combination thereof." This case was arisen out of the "Taung Gyi Mauk Mai," medicated Thanet Kha which is used as cosmetics and the different name "Shan Maung Mai" but similar trade mark, get up, size of plastic container and instruction cause the passing off action. It should be noted that although the names are different, similar trade mark, get up, size of plastic container and instruction cause likelihood of confusion.

A trademark can be protected on the basis of either use or registration. Both approaches have developed historically, but today trademark protection systems generally combine both elements. Trademark protection may vary from one country to another. Generally speaking, there are three ways in order to be protected a trademark right. The first way is that an acquisition of exclusive right of a trademark through use, e.g. U.S.A. Second way is that trademark protection is on the basis of either use or registration, e.g. Australia. The last system was adopted by France, Japan and some European countries in which trademark right will be acquired through registration. Myanmar as in many other countries, trademark right is granted through use as well as through registration.

Though there is no specific law for registration of trademark in Myanmar, an established practice has developed for the protection concern with the rights of trademark owners.

In the case of *The Tajmahal Stationery Market (Appellant) v. K. E. Mohamed Ebrahim V.S. Alair & Co*² (Respondent) , the Judge held that - In Myanmar there is no system of registration of trademarks so that the rights of parties setting up rival claims to ownership of a trademark must be determined in accordance with the principles of Common Law. Actually, the concept that trademark can be protected on

¹ 1903-04, 2 Lower Myanmar Rulings p.159.

² 1950, Myanmar Law Reports (High Court) p.41.

the basis of use is based not on a statute but on Common Law, which is to say that precedence are established through court decisions. There is a reported case¹ confirmed that acquisition of Trademark rights through use, In this case, appellate U Tin Latt has exclusive right on the trademark "Taung Gyi Mauk Mai" since 1994 when it has been used.

Conclusion

Trademarks play a very important role in marketing of individual enterprise. Trademark means 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.

By observing all the cases and laws relating to trademark in Myanmar, new trade mark law complied with TRIPs Agreement and other international rules is needed to support the effective trademark protection and to prevent the trademark disputes.

The protections of trademark rights are playing an important role for their life. Myanmar has no new law for intellectual Property in line with TRIPS Agreement although it is a member of TRIPS Agreement.

There is an idea which has already accepted is that laws of the developing countries should be kept modified in accordance with the dynamism of the global economic trends. So the Republic of the Union of the Myanmar needs to establish intellectual property Office and Agencies, and to give intellectual property knowledge for such Agencies. Myanmar has been drifting new Intellectual property laws. If the State carry out by the above mentioned ways, Myanmar will become and get an efficient and equitable Intellectual Property Laws, like developed countries.

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¹ *U Tin Latt (a) U Sai Latt & I v. U Kyaw Nyein*, 2001, Myanmar Law Reports, p.216.

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