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PROTECTING TRADE MARKS IN MYANMAR: STRATEGIES FOR FOREIGN TRADE MARK OWNERS

By Alec Christie

I. INTRODUCTION

Despite widely held views to the contrary, even among local practitioners, there is still no legislation in Myanmar giving a proprietary right to a mark upon registration and regulating the use and enforcement of trade marks in Myanmar. The acquisition of title to, and protection of, trade marks in Myanmar remains to be determined in accordance with Myanmar's general (or case) law. There is, however, a system of registering a Declaration of Ownership, for evidentiary purposes, which is often mistaken for a trade mark registration regime affording proprietary rights in the trade mark on registration.

The foreign trade mark owner wishing to protect its marks in Myanmar therefore needs to be aware of what legal protections are available and consider the various options or strategies, if the need arises, for enforcement of its trade marks in Myanmar. To this end, the current protections available in respect of trade marks under Myanmar's general law are briefly discussed in Part II of this article with the various strategies available for enforcement of trade marks. In particular, this article examines the existing trade mark regime and passing off actions available in Myanmar and actions and other strategies for enforcing trade marks under various other Myanmar laws.

II. THE EXISTING TRADE MARK REGIME

After reviewing all previous authorities, the Chief Court in Myanmar held:

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It is settled law that in [Myanmar] there is no method by
which a trade mark may be registered but property in or [a]
right in respect of a mark may be acquired by user.\(^2\)

This case was decided some time after the issuance of
Direction No. 13 of the Inspector General of Registration, which
allows Declarations of Ownership of trade marks to be registered
under the Registration Act, 1909 and remains the position in
Myanmar today.\(^3\)

\textbf{A. Acquiring the Right of Property in a Trade Mark}

A company may acquire a right of property in a distinctive
mark in Myanmar by using it on or in connection with the
company’s goods or services. Irrespective of the length of such use,
the company may acquire the right of property in the trade mark if
it can be shown that the public understands the mark to indicate
goods made by a particular manufacturer or sold by a particular
company/merchant.

One need not prove that the mark has always been used by
the company alone or, indeed, that it has been used as the name of
the company’s goods, so long as the public has used or recognised it
as such.\(^4\) Further, it need not be shown that the use has been such
that the public associates the goods sold under the mark with the
company’s name, as long as it can be shown that the public
understands the mark to mean goods made by a particular
manufacturer or sold by a particular company/merchant.

However, the inherent limitations of acquiring the right of
property in a mark under Myanmar’s general law are numerous
and include that such a property right in a mark, once acquired,
does not give one a complete monopoly on the use of that mark.
That is, an owner of a trade mark in respect of one type of good, for
example, has no right to prevent another from the use of such
mark in connection with goods of an altogether different character.\(^5\)

\textbf{B. Registering a Declaration of Ownership}

While, as noted above, there is no trade mark registration
legislation in Myanmar, a practice has developed by which the
person purporting to be the trade mark owner may make a
Declaration of Ownership (“Declaration”) with respect to that
trade mark and register that Declaration with the office of the

\(^{2}\) \textit{Id.} The Chief Court was the equivalent of the Supreme Court at that time.
\(^{3}\) Please see discussion, \textit{infra}, in Part II.B. Registering a Declaration of Ownership.
\(^{5}\) \textit{See, infra, note 14 and accompanying text.}
Sub-Registrar of Deeds and Assurances in Yangon under the Registration Act. Once the Declaration is registered, it is customary and advisable to publish a Cautionary Notice in the English language daily newspaper warning people not to infringe that trade mark. Such “registrations” are, in practice, valid for five years from the date of registration and may be “renewed” by re-registering a Declaration and re-publishing a Cautionary Notice.

A Declaration in the prescribed form must be completed by the person purporting to be the trade mark owner for each trade mark. A description of the goods on or in connection with which the trade mark is used and a copy of the mark must be included in the Declaration. Additionally, a Power of Attorney must be executed (by the same party who signs the Declaration) appointing local counsel to be the attorney of the trade mark owner for the purposes of registering the Declaration(s) at the Office of the Sub-Registrar of Deeds and Assurances in Yangon.

The Cautionary Notice (which may include details of more than one mark) should be published in the national English language newspaper, the New Light of Myanmar. Some Cautionary Notices are also published in the Myanmar language, although this is not strictly necessary.

However, as noted above, registration of the Declaration and publication of the Cautionary Notice only serve to establish *prima facie* the “use” of the trade mark in Myanmar for evidentiary purposes in any future dispute or passing-off action. They do not in and of themselves create any legal or proprietary right to the relevant trade mark:

The registration of a [Declaration of Ownership of a] trade mark by a person, though a relevant factor for the purpose of determining the date since which he had intended to claim the trade mark as his, will not by itself give him a right of property in that trade mark.

Thus, as with common law trade marks in other jurisdictions, a Myanmar trade mark needs to have established a reputation or “use” in Myanmar in order to be enforceable: registration of a Declaration of Ownership and publishing a Cautionary Notice do not give the purported owner of a trade mark the necessary “use” in Myanmar to vest rights in that trade mark in the declared owner.

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8. *U Kyaw, id.*
C. Trade Mark Searches

Trade mark searches/inspections of the official register of Declarations are not currently permitted. However, because the Cautionary Notices are published in the newspaper, private collections of Cautionary Notices can be searched as a guide to whether a Cautionary Notice for a mark has been published.

III. PASSING OFF

Even though property in a name or mark is not vested in the “registered owner” through registration under statute in Myanmar, the country’s general law does provide that no trader has any right to represent its goods as the goods of somebody else.9 An action to enforce this principle, namely an action based on passing off, lies where there is a real possibility of damages to some business or trading activity. It is not necessary to prove a fraudulent motive or representation, and the “injured party” is entitled to nominal damages if no actual damage is proved.

A. Protection of Trade Marks and Trade Names

A trader who uses a trade name, mark or get-up (hereafter collectively referred to as “the mark”) that has become distinctive of its goods, has the right to prevent passing off where the use of the same or similar mark will deceive or is likely to deceive a substantial number of members of the trade or public into thinking that the goods offered for sale or supplied by those others are the goods of or manufactured by the trader.10

B. Use of Mark Required

As noted above, a plaintiff, the trade mark or trade name owner, need not prove that the mark has always been used by the plaintiff alone or, indeed, that it has been used as the name of their goods, so long as the public has used it as such.11 Further, the plaintiff need not show that the public associates the goods sold under the mark with their name, as long as it can be shown that the public understands the mark to mean goods made by some particular manufacturer or sold by some particular merchant.

The extent of the use that it is necessary for the plaintiff to prove depends on the nature of the mark and other circumstances


11. As to trade mark rights in an individual's name (permissible in Myanmar), see P. Klier v. D.A. Ahaja, [1907/1908] B.L.T. 104.
of the case. In general, it is sufficient to prove use of the mark within a limited area or even use abroad (as long as the mark has a reputation in Myanmar), provided that the area and use are such that confusion is likely to arise between the goods of the plaintiff bearing the mark and the other’s goods.

In certain cases, the first use of a trade mark upon, or in connection with, a trader’s goods with the intention of indicating origin, assuming the mark is otherwise capable of being a mark, may be sufficient to establish “use.”

C. Confusion/Deception

Myanmar courts will only intervene where the plaintiff can show that another’s actions may endanger the goodwill of the plaintiff. Therefore, the type of trade in which the goods are sold, as well as the geographical area in which the goods are distributed, will be very important. Myanmar law requires that there be some common field of activity in which, however remotely, both the plaintiff and the other are engaged:

A person does not acquire a monopoly in the use of the mark or any trade name irrespective of the kind or class of goods in as much as there is no such thing as a monopoly of property in the nature of copyright or patent. An owner of a trade mark in respect of a particular commodity has no right to prohibit or prevent another person from the use of such mark in connection with goods of a totally different character.

It is not necessary, however, that the trades should actually overlap; protection will be afforded where the other is selling goods that are of so similar a nature to those of the plaintiff bearing the mark that a purchaser might infer a common origin. In addition, a Myanmar court will take account of likely extensions of the plaintiff’s trade in the future.

In deciding whether two marks are so alike that there is a real probability of confusion, a Myanmar court will consider the impression likely to be conveyed by the mark as a whole. Other factors considered by the court include the price and quality of the goods sold by the parties because a considerable difference in these factors will naturally diminish the probability of confusion. In considering whether there is any likelihood of deception of the public by a mark applied to goods, the persons to be considered are

ordinary and sensible members of the public, excluding both those who are particularly knowledgeable in the particular trade and those who are so ignorant that they ought not to be taken as representative.

It is not necessary for the plaintiff to show that confusion has actually occurred between the goods of the plaintiff and the other in order to obtain an injunction if the court is of the opinion that there is a strong probability of confusion occurring in the normal course of trade. Of course, the fact that such confusion has actually occurred is strong evidence of the probability of its recurrence in the future.

D. Defences to Passing Off Actions

A defendant in a passing off action may contest the owner’s title to the mark, as well as allege fraud, acquiescence or a licence, thereby disentitling the plaintiff to succeed. The defendant may plead that there was no real and tangible danger of confusion arising by the use of the mark or that the defendant has an independent or concurrent right to use the mark. Such concurrent rights may arise, for example, through use or inheritance whereby all of the children of the deceased trade mark owner have the right to use the mark.

A defendant’s showing of general bona fide use by others of the same mark on similar goods is likely to defeat the owner’s claim to a monopoly right in the mark for the specific goods:

A trade-mark or name which is primarily descriptive of an article . . . must be open to the trade and cannot be claimed for exclusive use by one trader.

Apart from general use, the defendant could also show use by the defendant or predecessors in business, perhaps merely local, but bona fide and of sufficient duration to negate the idea of deception. However, such individual and localised rights of use will not prevent the plaintiff from succeeding against third parties.

If the trade mark owner has allowed another person who is acting in good faith to build up a reputation under a mark to which the plaintiff has rights, the plaintiff may lose the right to bring proceedings for infringement or passing off against the other persons, and the trade mark owner may even be debarred from using the trade mark in the relevant region. However, even long

16. That is, that the mark is not distinctive of the plaintiff’s goods.
use of a mark by another, if fraudulent or surreptitious, does not affect the plaintiff’s right to a final injunction.20

E. Available Remedies

The remedies that may be granted in actions for passing off in Myanmar include both interim and permanent injunctions and an award of damages or an account of profits.21 Also, in appropriate cases, orders may be made for the delivery up of infringing articles or labels for the destruction or erasure of the offending mark. Where the mark can be erased, the order will usually be for erasure only.

IV. OTHER STRATEGIES FOR ENFORCING MYANAMAR TRADE MARKS

In addition to an action for passing off, there are a number of additional avenues for dealing with infringements in Myanmar. Each of these possible avenues (including criminal sanctions) should be considered to determine what combination of strategies would best be employed against the specific infringement.

A. Actions Under the Specific Relief Act

A possible additional cause of action worth considering in respect of trade mark infringements in Myanmar exists under Section 54 of the Specific Relief Act, 1877. This cause of action was reinvigorated as a possible alternative to passing-off by the comments of the Director General of the Office of the Attorney General.22

Section 54 of the Specific Relief Act provides that “when the defendant invades or threatens to invade the plaintiff’s right to, or enjoyment of, property, the Court may grant a perpetual injunction. . . .” The “Illustrations” to the operation of Section 54 include, among others, where:

A improperly uses the trade mark of B. B may obtain an injunction to restrain the user, provided that B’s use of the trade mark is honest.

Further, Section 54 of the Specific Relief Act specifically provides that “for the purpose of this section, a trade mark is property.” Thus, even without a system of registration of trade marks giving proprietary title on registration, judicial authority in Myanmar has held, and the Director General of the Office of the Attorney General has re-asserted, that an action for infringement of a trade mark, distinct from and additional to an action for passing off, is maintainable under Section 54 of the Specific Relief Act. Specifically, it has held that:

A trade mark, 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.\(^{23}\)

**B. Criminal Action Under the Penal Code**

Another indirect but nonetheless effective strategy for enforcement of one’s Myanmar trade marks and protection of trade names is through criminal action under the Myanmar Penal Code, 1860. For the purposes of the Penal Code and the Merchandise Marks Act, 1889, a trade mark is:

[A] mark used for denoting that goods are the manufacture or merchandise of a particular person.\(^{24}\)

The benefit of criminal action is that the Merchandise Marks Act’s forfeiture provisions, which also apply to offences under the Penal Code, give significant powers to the court to order the forfeiture of infringing goods, whether or not a conviction is actually secured.

**1. Offences Under the Penal Code**

Under the Penal Code it is an offence to, among other things:

(i) “use a false trade mark,” unless such act was done innocently, without intent to defraud;\(^{25}\)

(ii) counterfeit a trade mark;\(^{26}\)

(iii) make or possess any die, plate or other instrument for the purpose of counterfeiting a trade mark or possess a trade

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26. Section 483 of the Penal Code and *see Syon Sheeman & Co. v. R. Solomon*, 4 *Ran.* 16.
mark for denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not;\textsuperscript{27}

(iv) sell or possess for sale or any purpose of trade or manufacture any goods to which a counterfeit trade mark is affixed or impressed unless it is proven that: \textsuperscript{28}

(a) having taken all reasonable precautions against committing an offence, there was no reason to suspect the genuineness of the mark;

(b) all information known about the person from whom the goods were obtained was given to the prosecutor; and

(c) otherwise, the activities in question were done innocently.

A person is deemed to “use a false trade mark” if they mark any goods or packaging in a manner reasonably calculated to cause it to be believed that the goods are the manufacture or merchandise of a person of whose manufacture or merchandise they are not.\textsuperscript{29}

\section*{2. Penalties}

If convicted, the penalty for offences (i) and (iv) is imprisonment for up to a year, a fine or both; for offence (ii) it is imprisonment for up to two years, a fine or both; and for offence (iii) it is imprisonment for up to three years, a fine or both. Also of interest to trade mark owners are the forfeiture provisions of the Merchandise Marks Act (discussed in Part IV.C.), which are also applicable to the offences of use of a false mark and selling/possessing for sale goods with a counterfeit mark under the Penal Code.\textsuperscript{30}

\section*{C. Merchandise Marks Act}

The trade mark protection possibilities under the Penal Code described above tie in with the protections and remedies afforded under the Merchandise Marks Act, 1889.

\textsuperscript{27} Section 485 of the Penal Code.

\textsuperscript{28} Section 486 of the Penal Code and see \textit{King - Emperor v. Po Saing}, 4 L.B.R. 192.

\textsuperscript{29} \textit{Abdul Majid v. King - Emperor}, 9 L.B.R. 31 and, as to prosecution of companies for breaches of Section 482 and 486 of the Penal Code, see \textit{Seena M. Haniiff and Company v. Liptons Limited}, 7 L.B.R. 306.

\textsuperscript{30} Section 9(1) of the Merchandise Marks Act.
1. Effect of the Act

The Merchandise Marks Act does not exempt any person from any action, suit or other proceeding that might, but for the provisions of the Merchandise Marks Act, be brought against them, nor does it give any civil right of action to those who are damaged by any breach of its provisions. However, the Act’s forfeiture provisions, which also apply to offences under the Penal Code, give significant powers to the court to order the forfeiture of infringing goods, whether or not a conviction is secured.

2. Offences Under the Merchandise Marks Act

Every person who commits any of the following acts is guilty of an offence under the Merchandise Marks Act, unless it can be proven that they acted innocently and without the intent to defraud:

(i) “applies” any “false trade description” to goods; or
(ii) sells or exposes or has in possession for sale or for any purpose of trade or manufacture, any goods or things to which any false trade description is applied.

3. Penalties

The punishment for each of these offences on conviction is imprisonment for up to three months or a fine and, in the case of a second or subsequent conviction, imprisonment for up to one year or a fine or both.

4. What Is a “False Trade Description”?*

A trade description means any description, statement or other indication, direct or indirect as to:

- the number, quantity, measure, gauge or weight of any goods;
- the place or country in which any goods were made or produced;
- the mode of manufacturing or producing any goods;

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31. Section 18 of the Merchandise Marks Act.
33. Section 38 of the Merchandise Marks Act and see also, infra, in Part IV.C.6. Unintentional Contravention.
34. Sections 5 and 6 of the Merchandise Marks Act.
35. Section 7 of the Merchandise Marks Act and see Mahomed Jewa Motalla v. H.S. Wilson, 4 B.L.T. 83.
36. Sections 6 and 7 of the Merchandise Marks Act.
• the material of which any goods are composed; or
• any goods being the subject of any existing patent, privilege or copyright.\(^{37}\)

A “false trade description” is a trade description that is untrue in a material respect as regards the goods to which it is applied.\(^{38}\) The fact that the trade description includes a trade mark or part of a trade mark does not prevent it from being a false trade description for the purpose of the Merchandise Marks Act. A false trade description also includes the application to goods of any figures, words, marks or arrangement or combination of them, whether including a trade mark or not, as are calculated to lead a person to believe that the goods are the manufacture or merchandise of some person other than from the actual source.\(^{39}\) In this respect, the following test has been established:\(^{40}\)

The proper test is whether the “get-up” of the accused’s goods is likely to deceive a purchaser who is acquainted with the complainant’s “get-up”, but who trusts his memory. It is to be assumed that the purchaser will look fairly at the goods without the distinguishing features being concealed and the Court must also have regard to the class of purchasers by whom the goods would normally be bought.

5. Applying a False Trade Description

A person is deemed to apply a trade description (whether false or not) to goods who:

(i) applies it to the goods themselves;
(ii) applies it to any covering label or other thing in or with which the goods are sold or exposed;
(iii) possesses for the purpose of sale, trade or manufacture, goods to which the trade description has been applied; or
(iv) uses it in any manner reasonably calculated to lead to the belief that the goods in connection with which it is used are designated or described by the trade description.\(^{41}\)

A mere representation by conduct or words may amount to the application of a trade description.

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37. Section 2(2) of the Merchandise Marks Act: a “trade description” includes the use of any figure, word or mark that, according to trade usage, is taken to be an indication of any of the matters being referenced.

38. Section 2(3) of the Merchandise Marks Act.


40. A.M. Malumiar, id.

41. Section 5 of the Merchandise Marks Act.
6. Unintentional Contravention

The Merchandise Marks Act provides that persons charged with falsely applying to goods any trade mark or any mark resembling a trade mark or making any die, plate or other instrument for the purpose of counterfeiting a trade mark (under the Penal Code) or applying to goods any false trade description (under the Merchandise Marks Act) are entitled to be discharged if they can show that they:

(i) in the ordinary course of business, are employed to apply trade marks or trade descriptions or, as the case may be, to make dies, plates or other instruments to make or be used in making trade marks and, for the case that is the subject of the charge, they were so employed;

(ii) were not interested in the goods by way of profit or commission dependent on their sale;

(iii) took reasonable precautions against committing the offence charged;

(iv) at the time of the commission of the alleged offence, had no reason to suspect the genuineness of the trade mark or trade description; and

(v) gave the prosecutor all the information in their power with respect to the person on whose behalf the trade mark or trade description was applied.42

7. Accessories

Any person within Myanmar who aids or abets the commission of any act which, if committed in Myanmar, would be an offence under the Merchandise Marks Act or Chapter XVIII of the Penal Code,43 is deemed to be guilty of that offence and is subject to prosecution for and the penalties applicable to that offence.44

8. Implied Warranty of Genuineness

The Merchandise Marks Act implies into every sale of trade marked goods a warranty that the mark is a genuine trade mark, not counterfeit or falsely used, or, as the case may be, that the trade description is not a false trade description.45 This implied warranty can only be negated expressly in writing signed by or on behalf of the seller, delivered at the time of the sale or entry into

42. Section 8 of the Merchandise Marks Act.
43. That is, the offences listed, supra, in Part IV.B.1. Offences Under the Penal Code.
44. Section 22 of the Merchandise Marks Act.
45. Section 17 of the Merchandise Marks Act.
the contract and accepted by the buyer. However, it would appear that such circumstances would constitute applying a false trade description to goods.

9. Forfeiture of Infringing Goods

The court may order the forfeiture to the court of all goods and things by means of or in relation to which an offence has been committed or, where the accused is not convicted because the contravention was found to be unintentional, would have otherwise been committed. The offences to which forfeiture apply are:

(i) use of a false trade mark (Sections 480/482 and 487/488 of the Penal Code);
(ii) selling/possessing for sale goods with a counterfeit trade mark (Section 486 of the Penal Code);
(iii) applying a false trade description (Section 6 of the Merchandise Marks Act); and
(iv) selling/possessing for sale goods to which a false trade description is attached (Section 7 of the Merchandise Marks Act).

V. ASSIGNING/LICENSING TRADE MARKS

In countries adopting a system of registration of trade marks, giving the registered owner property in the trade mark, the assignment of marks with or without goodwill was accepted and specifically provided for in the relevant legislation. However, under Myanmar law, a trade mark cannot be assigned or transferred without also assigning or transferring the goodwill of the business for which the mark is used. Also, the assignment/transfer of the trade mark, along with the goodwill of the business, must be in writing in order to be enforceable. A purported assignment of a Myanmar trade mark without an assignment of goodwill and/or not in writing confers no title in the trade mark on the assignee. In addition, unless otherwise agreed, a transfer of the goodwill of a business in writing also carries with it an assignment of the trade mark and trade name of the business.

47. Section 9(1) of the Merchandise Marks Act.
48. For example, Section 22 of the Trade Marks Act 1938 (UK).
50. Id.
The licensing of trade marks is an untested area of the law in Myanmar. As trade marks remain governed by Myanmar’s general law, it is likely that any trade mark licence will be invalid, due to the possible confusion that such use may cause because the mark would then indicate a different manufacturer or trade origin of the goods to which it was applied. Alternatively, in certain circumstances, the licence may be deemed to act as an assignment of the mark.\textsuperscript{51} A trade mark may also be acquired by adoption, on the basis of use on an article for sale.\textsuperscript{52} However, to prove the acquisition of a trade mark in such a case, the plaintiff must prove that it has adopted the mark exclusively.\textsuperscript{53}

One of the main rationales in favour of a licence is to authorise the use of the mark by another and therefore not dilute the trade mark owner’s goodwill in the mark. Under Myanmar’s general law, however, a licence of a trade mark is not likely to be recognised. Even so, if a trade mark owner is “authorising” another to use its mark in Myanmar, that owner would be no worse off by entering into a “licence” or contract regarding the use of the mark insofar as the possible dilution of goodwill. Further, the licence/contract terms will give the owner added protection in case of trade mark infringement by the “authorised user” because in this event, such infringements or misuse will be actionable as breaches of contract.

\section*{VI. INTERNATIONAL TREATIES AND OBLIGATIONS/ FUTURE DEVELOPMENTS}

Myanmar is currently not a signatory to the Paris Convention for the Protection of Industrial Property or any other multilateral trade mark treaty. However, in accordance with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), to which it acceded as part of its entry into the Agreement Establishing The World Trade Organisation, Myanmar is required to implement and comply with Articles 1-12 and 19 of the Paris Convention and the terms of TRIPS by no later than January 1, 2006.

To date, Myanmar has not complied with its obligations under TRIPS in respect of trade marks. However, in order to comply with its obligations under TRIPS, the Government has recently announced that it is in the process of drafting a trade mark law (together with new laws for copyright, designs and patents) that will be enacted and in force by January 1, 2006.

\begin{thebibliography}{9}
\bibitem{52} P. Klier v. D.A. Ahuja, [1907/1908] B.L.T. 104.
\bibitem{53} Conrad Sixt v. William Massink, 10 B.L.R. 95.
\end{thebibliography}
While no draft of the legislation has been made publicly available, it is understood that the following will likely be the main tenets of the proposed new trade mark law (Trade Marks Law).54

A. What Is a Trade Mark Under the Trade Marks Law?

A trade mark is likely to be defined in the Trade Marks Law as a visible sign used to distinguish the goods of an economic enterprise or the “owner of an economic enterprise” from those of other owners. A mark may include labels, devices, certificates, names, signatures, words, letters, figures or a combination of one or more of these.

B. Registration of Trade Marks

Any “owner of an economic enterprise or an economic enterprise” is expected to be permitted to apply under the Trade Marks Law for registration of a trade mark that is to be used, or is being used, on or in connection with the sale of their goods.

A trade mark is likely not to be registrable under the Trade Marks Law if it:

(i) is similar to a trade mark already registered;
(ii) is similar to a de-registered trade mark or a trade mark renounced by its owner within the last three years;
(iii) is not distinctive;
(iv) is an imitation or copy of another trade mark;
(v) confuses the public as to the source, nature or production of the goods;
(vi) confuses or misleads the public;
(vii) reproduces or imitates the flag or emblem of Myanmar;
(viii) reproduces or imitates the name, flag or emblem of a foreign country or international organisation; or
(ix) affects moral values or public tranquillity.

It is anticipated that the term of registration will be a minimum of five years.

A registered trade mark will be cancelled upon the:

(i) expiry of the trade mark period;
(ii) surrender of the trade mark;

54. While the matters detailed above are anticipated to be included in the Trade Marks Law, there is no certainty as to the Law’s context because a discussion draft of the legislation has not been made public and significant changes may occur in the drafting before the legislation is finally enacted.
(iii) failure of the trade mark owner to comply with the prescribed duties regarding use;
(iv) licensing of the trade mark without registering a licensing agreement;
(v) registered owner of the mark ceasing to operate the enterprise or organisation using the trade mark; or
(vi) discovery that the registered owner of the mark had no right to register the trade mark.

C. Duties and Rights of a Trade Mark Owner

The owner of a trade mark registered under the Trade Marks Law is likely to be considered the sole owner of the trade mark in Myanmar and to enjoy the exclusive right to use the mark and to file civil or criminal proceedings against those infringing this right. It is expected that the owner of the registered trade mark or its licensee(s) will be able to use the mark on all goods for which it has been registered.

It is further expected that the owner of a registered trade mark will have the right to transfer (i.e., license) the use of the trade mark by way of a registered written agreement (i.e., registered user agreement). The respective rights and duties of the owner and licensee of the trade mark must be set out in the agreement and a provision on quality control must be included in the agreement. This agreement will probably be required to be registered at the Registration Office in order for it to be enforceable.

The Trade Marks Law will likely provide that no person may do any of the following that will mislead or confuse the public:
(a) use a replica of a registered trade mark;
(b) use a trade mark similar to a registered trade mark;
(c) use the registered trade mark of another owner; or
(d) interfere with the interest of a registered trade mark owner by using the owner’s trade mark or one that is similar.

D. Declarations of Ownership Registered Prior to the Trade Marks Law

It is not clear how the Trade Marks Law will deal with prior Declarations of Ownership. However, it is expected that, at the very least, all registered Declarations of Ownership will automatically lapse after a specified period from the date of enactment of the Trade Marks Law.
VII. CONCLUSION

Until such time as legislation is enacted in Myanmar providing statutory protection to the registered owner of a trade mark, trade mark owners should ensure that they establish their own reputation in the mark in Myanmar and not licence the trade mark to local distributors. This way any goodwill in the mark vests in them and not the local distributor.

Similarly, as regards infringements, a creative approach needs to be taken utilising all of the options under both Myanmar’s general law and the specific legislation in order to craft an enforcement strategy to deal with infringements.

However, once the new trade mark law is enacted, all trade mark owners will need to be ready to immediately file for registration of their trade marks (irrespective of whether or not there are current Declarations of Ownership in respect of the marks). Immediate registration under the new law will ensure that trade mark owners do not lose any existing rights in the marks in Myanmar. In respect of marks for which there is no existing Declaration of Ownership, early registration by the trade mark owners will lessen the risk that others will hijack their marks, requiring costly negotiations or litigation to secure the owner’s registration of the mark.

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