

What Factors Should You Keep In Mind When Filing A Trademark Opposition In Myanmar?

In Myanmar's dynamic and evolving business landscape, trademarks play a pivotal role in differentiating brands and establishing consumer trust. The country's recent enactment of the Trademark Law provides a robust framework for intellectual property protection, empowering businesses and individuals to safeguard their brand identities. A key aspect of this process is the ability to file an objection or opposition to a trademark application, ensuring that only eligible and deserving marks are granted registration. In this comprehensive guide, we explore the procedures, important considerations, and legal aspects of filing an objection to a trademark application in Myanmar.

At KENFOX, we understand the paramount importance of protecting your intellectual property in Myanmar. Our team of experienced professionals is well-versed in the intricacies of the trademark opposition process, guiding you through each step to ensure a successful outcome.

1. Grounds for a trademark objection or opposition

Section 26 of Myanmar's Trademark Law bestows the right upon any person who believes that a trademark application does not meet the specified requirements in Sections 13 and 14 to raise an objection against the registration. The grounds for filing an objection are based on whether the application fulfills any of the conditions mentioned in Sections 13 and 14.

A trademark opposition in Myanmar may be filed based on either or both of grounds, i.e, absolute grounds and/or relative grounds.

1.1. Absolute grounds: Any third party may rely on 7 absolute grounds under Section 13 of the Myanmar New Trademark Law to raise an objection or file a trademark opposition.

(a) Lack of Distinctiveness: If the mark lacks distinctiveness and does not possess unique characteristics that can differentiate it from other marks.

(b) Descriptive Marks: Marks that contain only marks or indications of a good's or service's type, related information, quality, quantity, intended use, value, origin, time of manufacture, or other characteristics.

The above provisions (a) and (b) do not constitute grounds for refusal in the following circumstances: (i) Distinctiveness Through Prior Use: If the mark's distinctiveness is known among consumers due to its use before the date of the application for mark registration and (ii) Exclusive Use in Myanmar: If the applicant, in good faith, is exclusively using the mark continuously within the commercial area of Myanmar.

(c) Detrimental to Public Order, Reputation, Beliefs, or Traditions: Marks that may be detrimental to public order, reputation, beliefs, the Union's reputation, or traditions valued by ethnic minorities.

(d) Becoming Common Usage: Marks that have become common usage in contemporary expressions or have become a part of traditions and are being used practically in the commercial area.

(e) Misleading the Public: Marks that mislead the public or create confusion within the commercial area, particularly in relation to subsection (b) (descriptive marks).

(f) Unauthorized Use of Official Marks and Symbols: Marks that directly copy, imitate, or mislead without the approval of relevant authorities, all or part of a country's flag, ceremonial appearance, other marks and symbols, a legal mark indicating management or guarantee by a State, a mark of quality guarantee, or a multilateral international organization's ceremonial appearance, flags, or other marks, names, including said organization's acronyms, full name, or any part.

(g) Marks Protected under International Agreements: Use of marks and signs separately protected under international agreements in which the Republic of the Union of Myanmar is a Party.

1.2. Relative grounds: Any third party may rely on 6 absolute grounds under Section 13 of the Myanmar New Trademark Law to raise an objection or file a trademark opposition.

(a) Identical or Similar to Existing Marks: If the mark misleads consumers by being identical or similar to any other person's registered mark or mark for which registration or right of priority has been applied for

beforehand. This applies specifically to marks intended for identical or similar goods and services as those protected by the existing marks.

(b) Unauthorized Use of Marks: If the mark uses, without the consent of a relevant person or legally formed organization, a mark that may be harmful to the individual rights of any person or the name and reputation of a legally formed organization.

(c) Infringement of Intellectual Property Rights: If the mark is a mark that may infringe upon the intellectual property rights of any other person. This includes trademarks that resemble or imitate other protected trademarks owned by different individuals or entities.

(d) Lack of Good Faith: If the registration of a mark is applied for without good faith, meaning the applicant does not have a genuine intention to use the mark for its intended purpose and may be trying to exploit or block others from using the mark.

(e) Misleading Use of Well-Known Marks: If a mark registration application is made for a mark that misleads consumers by not only being identical or similar to a well-known mark but is also used in identical or similar goods or services. This is to prevent confusion or association with well-known marks that enjoy a high level of recognition among consumers.

(f) Connection to Well-Known Marks: If a mark registration application is made for a mark that is identical or similar to a registered well-known mark, but the goods or services for which the mark is being used are not identical or similar. However, there is an indication that there is a connection between the owner of the well-known mark and the goods or services that the mark in question is being used for. Such use may be harmful to the interests of the owner of the well-known mark.

2. Drafting an opposition: Opposition Form and Fee

To initiate an opposition, the objector must complete and submit an objection form to the Registrar. The objection form serves as a formal and structured means to outline the grounds on which the objection is based. By providing specific details about the trademark application under consideration and the reasons why it fails to meet the required criteria, the objector builds a strong case against the registration.

Additionally, a prescribed fee must accompany the objection form. This fee covers the administrative costs associated with processing the opposition. It ensures that the Registrar can effectively manage the influx of objections and encourages objectors to thoroughly consider the validity of their opposition.

3. Deadline for raising an objection (an opposition)

A vital aspect of the opposition process in Myanmar is the strict time limit. Objectors have precisely 60 days from the date of the public announcement (as mentioned in Section 25(b)) to submit the objection form and the prescribed fee. This relatively short window serves as a critical opportunity for interested parties to carefully review the trademark application, conduct necessary research, and compile a well-founded objection.

4. Processes of handling an objection (an opposition)

The Registrar's Role: Notifying the Applicant and the Examination of Objections

Upon receiving a valid objection within the specified time frame, the Registrar assumes a crucial role in the opposition process. First, the Registrar must notify the applicant of the opposition and request the submission of a counter-opinion. This provides the applicant with the chance to present their defense and address the concerns raised in the objection.

Following the notification process, the Registrar conducts a thorough examination of the objections. The primary objective is to determine whether the objections indeed meet the provisions of Sections 13 and 14 of the Trademark Law. During this evaluation, the Registrar considers the objector's arguments, the evidence presented, and the legal requirements for trademark registration.

The Registrar's Decision: Allowance or Refusal of Registration

Based on the examination of objections, the Registrar wields the authority to make a pivotal decision: to either allow or refuse the registration of the mark in question. If the objections are found to be valid and the trademark

application fails to meet the required criteria, the Registrar may refuse registration, safeguarding the interests of the objector and the integrity of the trademark registration process.

Conversely, if no valid objections are submitted within the 60-day window, the Registrar may allow the registration of the mark stated in the application. This signifies that the mark has overcome the opposition hurdle and is eligible to proceed towards registration.

The Aftermath: Record-Keeping and Public Announcement

Upon reaching a decision, the Registrar records the allowance or refusal of the mark registration. Furthermore, the applicant receives formal notification of the outcome of the opposition process. This ensures transparency and keeps stakeholders informed of the Registrar's decision.

Additionally, the Registrar must publicly announce the result of the decision, in a manner consistent with the stipulations, likely referring to the rules and regulations governing public notifications. This step ensures that the broader public is aware of the outcome and adds an additional layer of transparency to the trademark registration process.

Final thoughts

Filing a trademark opposition in Myanmar is a powerful tool for protecting intellectual property rights and upholding the integrity of the registration process. By thoroughly understanding the provisions of Sections 13 and 14 of the Trademark Law, objectors can build compelling cases against trademarks that may dilute their brand or infringe upon their rights. The opposition process, overseen by the Registrar, guarantees a fair and transparent evaluation of objections, leading to well-informed decisions that shape the landscape of trademark protection in Myanmar.

At KENFOX, we take pride in our expertise in navigating the complexities of the opposition process, providing our clients with comprehensive support and guiding them towards successful outcomes. As Myanmar's business landscape continues to evolve, safeguarding your brand identity through trademark opposition becomes an indispensable element of your intellectual property strategy.

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