

Enforcing Trademark Rights in Myanmar - Essential Considerations

In the competitive landscape of business, trademarks are the lifeblood of a company's identity and reputation. They are symbols of trust, quality, and recognition in the market. The more well-known a mark is, the more vulnerable to infringement it is. However, as a trademark infringement case in Myanmar reveals, the more renowned a mark becomes, the more susceptible it becomes to infringement. This case sheds light on the intricate challenges involved in protecting a well-known mark within the vibrant market of Myanmar.

Facts

K. E. Mohamed Ebrahim & Anr, the Appellants-Plaintiffs, operated as importers and wholesalers, offering a diverse range of goods, including exercise books. They had a distinctive and widely recognized trademark featuring a "Standing Chinthay (Lion)" device. This trademark had garnered significant goodwill and recognition in the Myanmar market.

However, their success and reputation faced a challenge when The Taj Mahal Stationery Mart - the Respondents - entered the market and began selling similar products, including exercise books and pocket notebooks. The issue arose because The Taj Mahal Stationery Mart used a similar trademark but with a subtle variation, replacing the "Standing Chinthay" device with a "Sitting Chinthay" device. Additionally, they also used a "Sitting Chinthay & Two Dragons" device on some of their products.

Actions by the Appellants-Plaintiffs: This situation gave rise to the claim of fraudulent and colorable imitation by K. E. Mohamed Ebrahim & Anr against The Taj Mahal Stationery Mart. The Appellants argued that the Respondents deliberately adopted a confusingly similar trademark to exploit the goodwill and recognition associated with their own brand. This alleged imitation was deemed to be fraudulent and colorable, as it created confusion among consumers, leading them to associate the products of The Taj Mahal Stationery Mart with those of K. E. Mohamed Ebrahim & Anr.

In response to this potential infringement, K. E. Mohamed Ebrahim & Anr took legal action and filed a suit for passing off against The Taj Mahal Stationery Mart. They alleged that the Respondents intentionally adopted a confusingly similar trademark to exploit the goodwill and recognition associated with their own brand. The claim of fraudulent and colorable imitation was based on the belief that this action led consumers to associate the products of The Taj Mahal Stationery Mart with those of K. E. Mohamed Ebrahim & Anr, creating confusion in the market.

The matter was brought before the Trial Court, where the Appellants sought an injunction against the Respondents for both their marks and all stationary articles.

Actions by the Respondents: The Respondents, in their defense, argued that the Lion device was commonly used across Burma, implying that no exclusive rights could be claimed over it. Moreover, they contended that there was no likelihood of confusion or deception among consumers.

Cour rulings

The Trial Court ruled in favor of the Appellants, granting an injunction against the Respondents for both their marks and all stationary articles. However, **the Appellate Civil Court** adopted a different perspective during the appeal. While recognizing the Appellants' exclusive rights over the Chinthay trademark in relation to exercise books, it clarified that this did not grant them a monopoly over all forms of stationery. Furthermore, the presence of additional features in the Respondents' devices, notably the Two Dragons Device, set them apart from the Appellants' mark. As a result, the injunction was narrowed to only apply to exercise books related to the Sitting Chinthay Device.

Displeased with the scope of the injunction, K. E. Mohamed Ebrahim & Anr filed an appeal before the Supreme Court. **The Supreme Court** reviewed the case and concurred with the Appellate Court's finding that the Respondent's trademark contained additional prominent features that set it apart from the Appellants' mark. This distinction was crucial in determining that the Respondents' mark could not be easily mistaken for the Appellants' mark, thus reducing the likelihood of consumer confusion. Such a consideration is in line with trademark law principles, which emphasize the importance of analyzing the overall impression and distinctiveness of each mark.

However, the Supreme Court also recognized that the Appellants had provided sufficient evidence to establish their exclusive rights to the Chinthay trademark in relation to both exercise books and diaries. This

acknowledgment suggests that the Appellants had a valid claim to the Chinthay mark for a broader range of stationery products, beyond just exercise books. By doing so, the Supreme Court reinforced the importance of considering the scope of protection afforded to well-established trademarks in different product categories.

Consequently, the Supreme Court affirmed the decision of the Appellate Court, but with a variation. The variation allowed the Appellants to claim relief not only for the impugned Chinthay mark concerning exercise books but also for diaries. This modification signifies that the Appellants' rights to the Chinthay mark extend to both exercise books and diaries, giving them a broader scope of protection.

A bottom line

The trademark battle in Myanmar presented above serves as an invaluable case study, shedding light on the crucial need for a comprehensive analysis of various factors, including the distinctiveness of the trademarks, the similarity of the marks in question, and the potential for consumer confusion in Myanmar. It also emphasizes the importance of trademark owners diligently protecting their intellectual property rights to safeguard their goodwill and market position. Additionally, it showcases how the courts' interpretations can influence the scope of legal remedies, with decisions varying based on the specifics of each case.

As you embark on your journey to safeguard your brand in Myanmar, KENFOX is here to be your trusted partner, providing expert guidance, meticulous attention to detail, and unwavering commitment to protecting your intellectual property. With KENFOX by your side, rest assured that your trademarks are in capable hands, allowing you to focus on what you do best – building your business and leaving a lasting impression in the minds of your consumers. Partner with KENFOX today and let us help you secure your trademarks, fortify your brand's reputation, and ensure a prosperous future in the dynamic market of Myanmar.

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