

From Geography to Goodwill:

The Battle over Trademark Distinctiveness in Myanmar

For the past two decades, B. Lall (the Plaintiff) had been operating under the distinguished trademark "RANGOON OPTICAL WORKS," selling spectacles in the vibrant cities of Prome and Paungde. The Plaintiff detected that Mr. Ko Maung Ngwe sold spectacles under the same mark. As such, the Plaintiff filed a lawsuit against Mr. Ko Maung Ngwe (the Defendant) for their use of the same trademark, "RANGOON OPTICAL WORKS," in relation to spectacles. The core issue at hand was whether the term "RANGOON," with its geographical reference, could be deemed distinctive and protectable as a trademark in Myanmar.

Case brief

The Plaintiff's initial pursuit of an injunction was met with refusal from the Trial Court, which cited the lack of distinctiveness and proprietary interest in the term "RANGOON" due to its geographic connotation. However, undeterred, the Plaintiff sought recourse in the First Appellate Court, where the tide turned in their favor. The Appellate Court recognized that "RANGOON OPTICAL WORKS" had acquired distinctiveness and goodwill in the market through continuous and longstanding usage of the mark. Consequently, the Plaintiff's claim for trademark protection gained substantial support.

Upon the Defendant's subsequent appeal at the Civil Appellate Court, the contention was made that "RANGOON" was simply a descriptive term and that employing geographic names as trademarks should be discouraged, aligning with the UK and Indian Trademark Statutes. Nevertheless, the Appellate Court rejected this appeal, underscoring a crucial distinction. The Court emphasized that a word should not be automatically classified as a geographical term merely because it corresponds to a place on Earth. Geographical names have the potential to transcend their origins and transform into distinctive trade designations when dissociated from their actual place of origin.

Given long and extensive use of the mark "RANGOON OPTICAL WORKS" on spectacles manufactured by the Plaintiff in the past 20 years, the mark has become synonymous with the Plaintiff's products, representing a symbol of their consistent quality and reliability in the eyes of the consumers. Therefore, the Defendant's subsequent use was clearly intended to deceive the public and misappropriate the goodwill and reputation of the Plaintiff.

Key takeaways

The transformation of "RANGOON OPTICAL WORKS"

The crux of the case hinged on the transformation of "RANGOON OPTICAL WORKS" from a mere geographical signifier to a distinct trade denomination. The Plaintiff's long-standing usage of the trademark on spectacles crafted in Prome strengthened their claim to its protection. On the other hand, the Defendant's subsequent use of the trademark appeared to be a deliberate attempt to deceive the public and misappropriate the goodwill and reputation of the Plaintiff.

Trademark distinctiveness in a global context

The legal battle between "RANGOON OPTICAL WORKS" and the Defendant raises significant questions about trademark distinctiveness in a globalized marketplace. Geographical names have long been a contentious issue in trademark law, with some jurisdictions being more lenient towards their protection while others discourage their use. The case sets a precedent by emphasizing that distinctiveness can be acquired through continuous and significant use, enabling a geographical name to become a protectable trademark.

Balancing geographic references and branding

The case also highlights the delicate balance that must be struck when considering trademark protection for geographical references. On one hand, protecting such marks can encourage local businesses and promote regional identities. On the other hand, preventing the use of common geographical terms can restrict fair competition and hinder market entry for new players.

The importance of goodwill and reputation

The legal battle underscores the value of goodwill and reputation in trademark disputes. The Plaintiff's ability to demonstrate their long-standing use of the mark and the goodwill associated with it played a crucial role in gaining support from the Appellate Court. This aspect reaffirms the significance of brand building and consumer trust in trademark protection.

Final thoughts

The intense legal battle between "RANGOON OPTICAL WORKS" and the Defendant sheds light on the complexities of trademark distinctiveness and protection when it comes to geographical references in Myanmar. The case serves as a valuable precedent for other jurisdictions grappling with similar trademark disputes. Ultimately, the transformation of a geographical name into a protectable trademark hinges on the establishment of goodwill and reputation, earned through continuous and significant use in the market. As global trade continues to evolve, the delicate balance between branding and geographic references will remain a challenge for trademark law.

At KENFOX, we understand the critical importance of protecting your brand and intellectual property rights in an ever-competitive global marketplace. Our comprehensive trademark services are designed to navigate the intricacies of trademark distinctiveness and protection, offering expert guidance and strategic solutions tailored to your unique needs. Whether you are a seasoned multinational corporation or a burgeoning startup, our team of experienced attorneys is dedicated to safeguarding your brand's integrity and securing its rightful place in the market.

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