

## How to Overcome Trademark Refusal for Genericness or Descriptiveness in Myanmar?

Facing the hurdle of trademark refusal in Myanmar due to genericness or descriptiveness often poses significant obstacles for trademark applicants. However, the picture was not always so gloomy. Myanmar's New Trademark Law, particularly under Section 13, provides a pathway for such marks to change their fates, being accepted for registration if meeting certain. Specifically, a mark may qualify for registration if it is **(i) recognized for its distinctiveness among consumers prior to the application** or **(ii) exclusively and continuously used in good faith by the applicant within Myanmar's commercial domain.**

Yet, Myanmar's New Trademark Law does not clearly provide for how to effectively meet these criteria. So how can trademarks that are not inherently distinctive be protected in Myanmar? In response to this ambiguity, KENFOX introduces eight essential criteria aimed at assisting trademark applicants in demonstrating the necessary distinctiveness or secondary meaning for their marks. These strategies are designed to resolve the complexities of registering generic or descriptive trademarks in Myanmar's evolving trademark landscape.

### 1. Duration of use

Detailing the mark's first steps	<ul style="list-style-type: none"> <li>▪ <i>Record the first use date:</i> Note the initial date your mark was used in commerce.</li> <li>▪ <i>Identify locations:</i> Document where your mark has been used, pinpointing cities or regions.</li> <li>▪ <i>Nature of goods/services:</i> Clarify the goods or services associated with your mark from the start.</li> </ul>
The consistency principle	<ul style="list-style-type: none"> <li>▪ <i>Maintain uniform use:</i> Ensure your mark is used in the same way across all goods and services.</li> <li>▪ <i>Avoid interruptions:</i> Continuous use without significant breaks reinforces mark strength.</li> <li>▪ <i>Consumer perception:</i> Consistent use fosters a strong association of the mark with your offerings.</li> </ul>
Mapping your mark's history	<ul style="list-style-type: none"> <li>▪ Construct a timeline highlighting your mark's journey. Include key milestones such as market expansions, pivotal marketing campaigns, and rebranding initiatives. This visual representation showcases the evolution and enduring presence of your mark</li> </ul>
Distinctiveness & secondary meaning	<ul style="list-style-type: none"> <li>▪ A well-documented history of consistent and continuous use not only proves your mark's validity but also solidifies its distinctiveness. This is crucial for establishing a strong legal foundation for your trademark, ensuring it is synonymous with your goods or services in the minds of consumers.</li> </ul>

### 2. Extent of use

Mapping Success	<ul style="list-style-type: none"> <li>▪ <i>Document geographic locations:</i> Capture every city, region, or country where your mark is used.</li> <li>▪ <i>Use maps and visuals:</i> Highlight the breadth and depth of your trademark's presence to illustrate its extensive reach.</li> <li>▪ <i>Major cities focus:</i> Emphasize usage in key urban areas to showcase market penetration.</li> </ul>
Quantifying popularity	<ul style="list-style-type: none"> <li>▪ <i>Total sales volume:</i> Compile all sales data related to your mark.</li> <li>▪ <i>Growth over time:</i> Show sales trends to demonstrate increasing demand.</li> <li>▪ <i>Regional breakdown:</i> Provide sales figures by region to highlight where your mark shines.</li> </ul>
Digital footprint	<ul style="list-style-type: none"> <li>▪ <i>Website traffic:</i> Share statistics to show how often your mark attracts online interest."</li> <li>▪ <i>Social media engagement:</i> Use metrics like followers, likes, and shares to prove your mark's online popularity.</li> <li>▪ <i>E-commerce strength:</i> If applicable, include online sales data to underscore the mark's commercial success</li> </ul>

### 3. Advertising and publicity

Showcasing marketing milestones:	<ul style="list-style-type: none"> <li>▪ <i>Campaign details:</i> Record dates, duration, and frequency of all advertising campaigns featuring your mark.</li> <li>▪ <i>Media channels:</i> Catalog the variety of mediums utilized, from television and radio to online and social media.</li> <li>▪ <i>Budget insights:</i> Provide specifics on the marketing budget to highlight the investment behind promoting your mark.</li> </ul>
Media coverage	<ul style="list-style-type: none"> <li>▪ Compile instances of media coverage that spotlight your mark. From news articles to magazine features and blog mentions, each piece contributes to a stronger public recognition of your trademark.</li> </ul>
Promotional Materials	<ul style="list-style-type: none"> <li>▪ Assemble a collection of promotional materials that feature your mark, such as brochures, flyers, and merchandise. This portfolio not only highlights the creative use of your mark in marketing but also serves as tangible proof of its widespread recognition.</li> </ul>

#### 4. Consumer surveys

Consumer surveys offer powerful evidence of your trademark's distinctiveness by directly gauging public recognition

Crafting impactful questions:	<ul style="list-style-type: none"> <li>▪ <i>Objective clarity:</i> Ensure each question is designed to uncover how well consumers associate your mark with your goods or services.</li> <li>▪ <i>Demographic reach:</i> Target a broad section of your market to get a comprehensive view of your mark's recognition.</li> <li>▪ <i>Methodology:</i> Choose the right survey method (online, in-person, telephone) to best reach your target demographic.</li> </ul>
Decoding consumer perception	<ul style="list-style-type: none"> <li>▪ Analyzing survey results can reveal the depth of your trademark's market penetration and association. Look for high recognition rates as a clear indicator of your mark's distinctiveness.</li> <li>▪ <i>Document findings:</i> Compile survey results, highlighting key statistics that demonstrate market association with your mark.</li> <li>▪ <i>Legal leverage:</i> Use these findings as substantial evidence in your trademark application to argue for your mark's distinctiveness.</li> <li>▪ <i>Strategic adjustments:</i> Identify areas for marketing improvements based on consumer feedback to further strengthen your mark's recognition.</li> </ul>

#### 5. Third-party acknowledgments

Recognition by industry groups, awards, or endorsements can also be indicators that a mark is well-known and associated with a particular source.

Varied Forms of Recognition	<ul style="list-style-type: none"> <li>▪ <i>Industry awards:</i> Highlight any accolades your brand has received that underscore its excellence and market presence.</li> <li>▪ <i>Professional endorsements:</i> Document endorsements from reputable individuals or organizations within your industry.</li> <li>▪ <i>Media features:</i> Include features, interviews, and mentions of your mark in respected publications or media outlets.</li> </ul>
Creating a portfolio of recognition	<ul style="list-style-type: none"> <li>▪ Compile a comprehensive record of all third-party acknowledgments. This should include the awarding body, the date received, and the reasons for recognition. Provide context to demonstrate the significance of each acknowledgment in relation to your trademark.</li> </ul>
Utilizing acknowledgments	<ul style="list-style-type: none"> <li>▪ <i>Evidence of distinctiveness:</i> Use these acknowledgments to argue for your trademark's distinctiveness and market recognition.</li> <li>▪ <i>Marketing material:</i> Incorporate acknowledgments into your marketing strategy to build trust and reinforce brand identity.</li> <li>▪ <i>Strengthening brand perception:</i> External validations are powerful tools in shaping public perception and validating your mark's prominence.</li> </ul>

#### 6. Exclusivity of use

Understanding exclusivity	<ul style="list-style-type: none"> <li>▪ <i>Sole use</i>: Your mark is used only by your business, with no similar use by competitors.</li> <li>▪ <i>Clear association</i>: Exclusivity strengthens the link between your mark and your products or services in public perception.</li> <li>▪ <i>Legal strength</i>: A mark that is exclusively used enjoys stronger protection and is easier to defend in legal disputes.</li> </ul>
Proving exclusivity	<ul style="list-style-type: none"> <li>▪ Document instances of your trademark's use in the marketplace. Provide evidence such as marketing materials, product packaging, and online presence that shows your mark in use, clearly linked to your offerings.</li> </ul>

## 7. Quality of the product or service

A high level of quality and consistency in the products or services offered under the mark can reinforce its recognition and association with a single source.

Showcasing your commitment to quality	<ul style="list-style-type: none"> <li>▪ <i>Quality certifications</i>: Highlight any industry certifications or awards that attest to the quality of your products or services.</li> <li>▪ <i>Customer reviews</i>: Share positive feedback and testimonials that reflect the high quality associated with your trademark.</li> <li>▪ <i>Innovation and improvement</i>: Demonstrate continual efforts to enhance quality, showcasing innovation and responsiveness to customer feedback.</li> </ul>
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## 8. Consumer testimony

Why testimonials matter	<ul style="list-style-type: none"> <li>▪ <i>Direct evidence</i>: Testimonials provide firsthand evidence of consumer recognition and association with your mark.</li> <li>▪ <i>Authentic endorsement</i>: Genuine customer feedback acts as a powerful endorsement of your brand's value and reliability.</li> <li>▪ <i>Trust and credibility</i>: Positive statements from users build trust and credibility, enhancing your trademark's appeal.</li> </ul>
Collecting consumer Insights	<ul style="list-style-type: none"> <li>▪ Encourage your customers to share their experiences and perceptions related to your trademark. Use surveys, feedback forms, and social media platforms to facilitate and gather these valuable insights</li> </ul>

## Final thoughts

Proving that an ineligible mark deserves registration and protection under Myanmar's New Trademark Law can seem daunting and requires a comprehensive approach. However, by meticulously documenting the use, recognition, and value of your mark in the marketplace, you can build a persuasive case that highlights its distinctiveness and association with your goods or services, based on which, requesting Myanmar IP Office to accept registration and protection for your trademarks.

At KENFOX, we are proud of our ability to provide comprehensive solutions, from strategic consulting to hands-on implementation support, helping you not only understand statutory regulations, but also know how to exploit and take advantage of them to protect your intellectual property in the most effective way. Contact us today to explore new opportunities and ensure your brand's success in Myanmar.

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