

## How to Prove a Generic or Descriptive Sign Is Eligible for Registration in Myanmar?

A mark lacking inherent distinctiveness or being descriptive of the goods or services can still achieve registration in Myanmar under Section 13 of Myanmar's New Trademark Law if it satisfies either of the following requirements: **(i)** *If the mark's distinctiveness is known among consumers due to its use before the date of application for mark registration, or* **(ii)** *If the applicant, in good faith, is exclusively using the mark continuously within the commercial area of Myanmar.* Despite these provisions, it remains unclear how the law determines a mark to be sufficiently "known" among consumers for eligibility, or the extent of "exclusive" and "continuous" use required within Myanmar's commercial landscape for a mark traditionally considered ineligible to qualify for trademark registration in Myanmar.

While this requires further detailed implementation through the issuance of decrees, circulars, or official guidelines to fully operationalize its provisions, KENFOX, with extensive experience and expertise in dealing with office actions concerning trademark applications, provides herein 9 suggested criteria which are commonly adopted by a trademark applicant to prove that his mark has acquired "distinctiveness" or "secondary meaning". These suggested criteria are re intended to assist applicants in the registration process of marks that are considered "generic" or "descriptive".

### 1. Duration of use:

As a trademark applicant, you are required to compile comprehensive records detailing the first use of the mark in commerce. This includes dates, locations, and the nature of the goods or services with which the mark has been used. Ensure that the use of the mark has been consistent over time. This means the mark has been used in the same manner and on the same goods or services without significant interruption. Consistency helps build a stronger association between the mark and the source in the minds of consumers. Create a detailed timeline that illustrates the mark's history of use. This should highlight key milestones, such as expansions in the use of the mark, significant marketing campaigns, or any rebranding efforts that involve the mark.

A longer period of consistent use of a mark serves as a key factor in establishing that consumers associate the mark with the source of the goods or services, thereby, establishing its distinctiveness or secondary meaning.

### 2. Extent of use:

This includes the geographic area where the mark has been used and the volume of sales under the mark. Widespread use across a significant geographic area or high sales volumes can indicate a strong association in the public's mind.

As a trademark applicant, you are required to collect and organize data showing all the geographic locations where the mark has been used. This should include not just the breadth of the distribution, but also the depth, such as the presence in major cities, regions, or countries. Maps or visual aids highlighting these areas can effectively communicate the extent of geographic use. Assemble comprehensive sales data associated with the mark, including total sales volume, sales figures over time, and sales distribution across different regions. This data should ideally show a consistent or growing demand for the goods or services under the mark, demonstrating its popularity and recognition among consumers. If applicable, demonstrate the mark's online presence, including website traffic statistics, social media engagement metrics, and any e-commerce sales data. A strong online presence can complement physical distribution and sales data, especially in showing reach to a wider audience. You should also consider providing evidence of marketing and advertising campaigns that have featured the mark, especially those targeting diverse geographic areas. Include details about the scope of these campaigns, such as the channels used (*e.g., online, print media, television*), the scale of the audience reached, and the budget allocated. This shows an effort to promote the mark and can help establish its recognition.

### 3. Advertising and publicity:

To demonstrate the advertising and publicity surrounding a mark, a trademark applicant should meticulously document and present the scope, frequency, and reach of their marketing efforts. This evidence can significantly impact the mark's recognizability and its perceived distinctiveness.

As a trademark applicant, you should gather comprehensive data on all advertising campaigns that have featured the mark. This includes information on the dates, duration, and frequency of these campaigns, as well

as the mediums used (e.g., television, radio, print, online, social media, outdoor billboards). Provide detailed information on the budget allocated to marketing and advertising campaigns involving the mark and collect and present any media coverage of the mark, including mentions in news articles, magazines, blogs, and other publications. Media coverage can significantly enhance a mark's visibility and recognition among the public. Finally, assemble a portfolio of promotional materials that have featured the mark, such as brochures, flyers, posters, email campaigns, and merchandise. These materials can visually demonstrate how the mark has been used in marketing efforts.

#### **4. Consumer Surveys:**

As a trademark applicant, you should use consumer surveys to directly show how a significant portion of the target market associates the mark with a particular source, reinforcing its distinctiveness

#### **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.

#### **6. Exclusivity of use:**

If the mark has been used exclusively by the entity claiming it, without any similar uses by competitors, this can help establish a direct association between the mark and the source in the minds of consumers.

#### **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.

#### **8. Consumer testimony:**

Statements or testimonials from consumers about their recognition and association of the mark with a specific source can be compelling evidence.

#### **Final thoughts**

While detailed implementing regulations are still needed to clarify the criteria for a mark to be considered sufficiently "known" among consumers for eligibility, as well as what constitutes "exclusive" and "continuous" use in this context, adhering to the nine criteria outlined above can significantly aid inherently non-distinctive or descriptive marks in enhancing their prospects for successful registration and protection in Myanmar.

For personalized assistance and to explore how KENFOX can help secure the registration and protection of your marks in Myanmar, contact us today.

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