

商標権に関するモデル事例研究（ミャンマー回答）

争点

本事例研究においては、ミャンマーの現行法及び商標に関連する新しい法案に従い解決すべきいくつかの諸問題が存在する。それらは下記のとおりである。

- (1) 商標権侵害に関する刑事的及び民事的救済措置の有無
- (2) 商標権侵害行為に対する民事的及び刑事的訴訟手続を開始するための事前通知を交付する義務の有無
- (3) 輸入総代理店は民事訴訟における原告としての資格があるのかどうか
- (4) 商標 1～9 の付いた商品を生産、輸入、販売及び輸出する行為について
- (5) 商標の類似性の判断に関する一般的な基準の有無
- (6) 全世界的に有名な商標が商標に関する判決に与える影響
- (7) 登録された商標である“Dolfin”の代わりに、“Dolfin”という商標を使用した場合の影響
- (8) 商標申請時点での侵害商標との非類似性に関する認定の影響
- (9) 未登録商標権による訴訟提訴権

※ 以下、特に付記のない条文については別紙条文集（英文のみ）を参照のこと。

1. 救済措置（争点(1)への回答）

ミャンマーでは、商標侵害に対する刑事訴訟手続及び民事訴訟手続の双方は、ミャンマーの**現行法**に基づき提訴することが可能である。**刑事訴訟手続**は、**現行ミャンマー刑法第 478, 480, 482, 483, 485, 486, 487 から 488 条**に基づき提起することが可能であり、**民事訴訟手続**は、**現行特定救済法第 54 条及び民事訴訟法第 9 条**に基づき提起することが可能である。これら 2つの司法手続は**別個に処理される**。

同様に、**ミャンマー新商標法案第 35 条(a)**により、商標権侵害に対し、刑事訴訟及び民事訴訟の双方を開始することが可能となる。これら 2つの司法手続は**別個に処理される**。

商標権侵害に関する刑事訴訟及び民事訴訟の事例は、ほとんど存在しない。訴訟事例の情報は現在も収集中であり、今後提出する予定である。

2. 民事訴訟又は刑事告訴を開始するための要件（争点(2)への回答）

ミャンマーには、商標登録に関する法令が存在しない。商標権侵害に対する刑事訴訟及び民事訴訟手続は、**現行の民事訴訟法又は刑事訴訟法**に従って行われる。これらの法典によると、**商標権侵害に関する訴訟又は告発に先立ち事前の通知又は警告を交付する義務は存在しない。**

ミャンマーには商標法が存在しないので、1962年までは登記を受け付ける機関が存在しなかった。しかしながら、この権利に関する紛争が徐々に増加したため、政府は、1962年登記法第18条(f)に従い商標権の登記所に関連した業務遂行のために、総括監察官及びその証書保証書登記所（農業省管轄）に任務を割り当てた。従って、総括監察官及びその証書保証書登記所は、**商標を登録するための1962年指令書13号を發布した。**

この指令書に基づき、商標権者と称される者が、商標権の宣言書を作成し、この宣言書を証書登記事務所に登記できる実務が発展した。この宣言書が登記されると、たいていの場合、この商標を侵害しないように人々に呼びかける警告文が英語版日刊新聞に掲載される。商標権侵害が起こった場合、登記された宣言書及び警告文が、ミャンマー国内での商標の「使用」を一応証明する証拠（反証のない限り立証したことになる証拠）としての機能を果たす。

ミャンマー新商標法案第34条¹に基づき、保護を得るためには商標を登録することが義務付けられたが、商標権侵害に対する民事訴訟又は刑事告訴を開始する目的で事前の公示又は警告を交付する必要はない。

3. 輸入総代理店が訴訟を起こす資格はあるのか（争点(3)への回答）

現行法律によれば、民事訴訟における原告としての資格を輸入総代理店に与える規定は存在しない。しかしながら、“**Gasper & Co v. Leong Chye & Co**”²の事件では、商標権侵害を理由とした差止め命令及び／又は損害賠償を求める民事訴訟において、原告としての資格が輸入総代理店に与えられた。

ミャンマー新商標法案の下で、この事件において原告としての資格が輸入総代理店に与えられたか否かは明確でない。

4. 商標権侵害（争点(4)への回答）

現行刑法の**第478, 480, 482, 483, 485, 486, 487から488条**によれば、偽造商標の付された**商品を製造、保有及び販売する** Bonitoの各行為は、商標権侵害に当たる。更に、

1 “商標の所有権者がX章を遵守している場合は、この所有権者は、登録の有効期間中、本章に規定される登録商標に関連した権利を享受するものとする。”

2 Indian Law Report (1934) Vol 12, page 534

関税法及び水産物関税法によれば、**これら商品の輸出及び輸入**も、商標権侵害に当たる。**現行民事訴訟法第9条及び現行特定救済法第54条に基づき**、TunaもBonitoの行為に対し、差止命令、損害賠償、補償を請求する民事訴訟を起こす権利を有する。

ミャンマー新商標法案第86条によれば、偽造商標の付された商品を製造、販売、輸入及び輸出するBonitoの各行為は、商標権侵害による刑事上の犯罪に当たる。

偽造商標の付された商品を製造及び販売するBonitoの各行為が、この新法案に基づき民事上の商標権侵害に当たるか否かは明確ではない。

しかしながら、Bonitoの製造、販売及び輸入行為は、同法案の第11章に基づき、民事上の商標権侵害に当たると推定される可能性があり、Bonitoの輸出行為は、同法案の第49条(b)に基づき、商標権侵害に当たる。

同法案の第35条に基づき、Tunaが、民事訴訟及び刑事訴訟の双方の法的手段を取る権利を有することは明確である。民事訴訟法第9条及び特定救済法第54条の規定に沿って解釈した場合は、Tunaは、Bonitoに対し、差止命令、損害賠償及び補償を求める民事訴訟を起こす権利を有することとなる。

5.商標の類似性に関する一般的な基準（争点(5)への回答）

ミャンマーの現行法律には、商標の類似性を判断する一般的な基準を規定している明文規定は民事訴訟法に存在しない。

しかしながら、ミャンマー刑法第28条では、偽造に関して定義されている。ミャンマーの判例法に基づけば、商標の類似性を判断する一般的な基準は存在し、2つの商標の間に類似性が認められるならば、模倣品であると断言するに十分であり、当該具体的な状況においては、商品が通常又は第一次的に販売される人々に対する詐欺を目論むものであると判断され得るものである。

ミャンマーにおいては、**商標の類似性に関する一般的な基準についての裁判所の判決**は下記のとおりである。

○ 問題となる2つの商標は、同一である必要はなく、わずかな違いがある類似性は、商標権侵害を主張するに十分である³。

○ 英語に翻訳された商標“Nanyang” “Elephant” “Elephant Star”の意味は、ミャンマー語での“Elephant”商標と類似又は同一である“Nanyang Sin Kyal”と同じ意味を有する⁴。

○ **“Taung Gyi Mauk Mai”**とは、自然化粧品のための器具を含めた商標である。外見、プラスチック容器、及び指示書が類似したものを使用した**“Shan Mauk Mai”**

3 U MaungMaung (a) Alibi Vs. DawKhin Than Myint 1975 BLR 72

4 Nanyang Industry Ltd Vs Gold Asia Rubber Manufacturing, Special Civil Appeal Case No. 48, (Special Bench -Three Judges Sitting), Supreme Court (Yangon), 2005

という異なる商標の商品が市場に出回った場合は、一時的差止命令を認める合理的な根拠となる⁵。

○ ある特定の商品に関する商標権者は、全く異なる性質の商品に関して第三者が当該商標を使用することを禁止又は防止する権利を有していない⁶。

○ 模倣品に該当すると判断するためには、2つの商標が隅から隅まで類似していることは必要ではないが、法律の観点からすると、消費者を“だます行為”につながる可能性がある程度に2つの商標に類似性が存在している場合は、模倣品に該当すると判断するためには十分である⁷。

ミャンマー新商標法案に商標の類似性を判断するための一般的な基準は存在しない。しかしながら、上記の判例法による商標の類似性を判断するための一般的な基準を使用することにより、ミャンマーの裁判所は、この基準に従い、商標権侵害に関する事件を判断するであろう。

登録商標と被疑侵害商標 1 から 9 までの間に同一性又は類似性があるか否かを判断するために、裁判所は、これら商標の外見、発音、観念（意味合い）及び侵害者の意図を精査する。ミャンマー国内での議論によれば、**結論**は下記のとおりである。**マーク（1）及び（2）の事例は商標権侵害に当たり、残り7つのマークは Tuna の商標権を侵害しているとはいえないと判断される。**

番号	外見	発音	観念（意味合い）	意図	結論
1	○	○	?	○	○
2	○	○	?	○	○
3	×	○	?	×	×
4	×	×	×	×	×
5	×	×	×	×	×
6	×	×	×	×	×
7	×	○	×/○ 消費者が言葉の意味を知っていれば	×/○	×/○
8	×	×/○ (発音できるならば)	○	×	×
9	○ (Dolfin 以外の単語が小さく表記されていれば)	×	×	×/○	×/○

5 U Tin Lett (a) U Sai Lett and one Vs. U KyawNyein, Year 2000, Special Civil Appeal Case No. 23 (Special Bench), Yangon, 2001 BLR -128

6 John Walkers Vs. U Than Shwe 1968 BLR 73

7 Gaw Shan Soot Vs E.C Madah (1952, BLR, 136 (H.C))

6. 全世界的によく知られた商標（争点(6)への回答）

ミャンマー国内でよく知られた商標（周知商標）を保護するための規定や判例法は存在しない。全世界的によく知られた商標は、商標の類似性の判断に影響を与えない。

しかしながら、ミャンマーの現行法律及び判例法によれば、**この事例において全世界的に有名な商標の商標権者がミャンマー国内でかかる商標を使用すれば、商標の類似性の判断に影響を与える可能性がある。**

商標権侵害者に対する訴訟を起こすに際し、**正当な商標権者は**、自身は正当に商標を所有しており、ミャンマー国内では、商標に対するより良い権利を保有していることを証明するために、**当該商標の実際の使用例を立証しなければならない。**

実際の使用例を立証するために、商標権者は、商標の付された商品を、自身で又は販売店を介して販売及び流通させなければならない。しかしながら、その証明は困難である可能性がある。なぜなら、正当な商標権者は、彼らの事業には関連のない製品に関し、商標権侵害容疑者に対しより良い権利を主張するための証拠を提出できない可能性があるためである。

ミャンマー新商標法案第 35 条(a) (3)及び第 76 条(b)には、ミャンマー国内において周知商標を保護する規定がある。

新商標法案は、ミャンマーの周知商標を認識している。この法案では、周知商標とは、所定基準に従いミャンマー連邦共和国内でよく知られている商標であると定義されている。

同法案第 101 条によれば、商標を付する特定の商品又は役務に関するミャンマー連邦の公衆の関連分野において周知の商標と認定されるための基準は、連邦の所管省庁が決定できる。しかしながら、この認定は、ミャンマー国内で登録されていない周知商標であることが条件である。

7. 使用されていない商標の取り消し（争点 7 (1)及び 7 (2)への回答）

争点 7 (1)に関して、登録商標の特徴を変更することなしに異なるデザインの商標を使用することが、登録商標を使用しないことに該当する又は使用しないことに相当すると定めている現行法又は判決の明文規定は存在しない。

新商標法案第 49 条(b) (1)によれば、登録商標と異なるデザインの商標を使用することは、登録商標の使用に当たる又は使用に相当する。

争点 7 (2)に関して、商標の不使用は、商標の類似性又は侵害性の判断に影響を与える可能性がある。

ミャンマーの判例法によると、ミャンマー国内での商標の使用が保護の対象となる前提条件であり、不使用を理由として商標権が失効する可能性がある。

商標権者は、その商標を使用しない場合又は商標を放棄する場合、権利を失う可能性があるが、商標の不使用の正確な期間又は商標の放棄を限定する規定又は判決は存在していなかった⁸。

使用されていない商標の取消しに関する明確な現在の慣習は存在しない。不使用による取消しも、新商標法案において規定される予定である。商標権者が、正当な理由なしに、申請日から連続3年間、当該商標を使用しなかった場合、登記機関は商標の登録を取り消すことができる。

8. 出願の際の主張の影響（争点(8)への回答）

登録商標に関して、出願手続において Tuna が“Dolphin”商標とは類似していないと認めたことを、裁判手続において証拠として使用できることについての現行法律及び判例法の明文規定は存在しない。従って、ミャンマー証拠法においては禁反言の規定が存在するものの、“Dolphin”商標との非類似性を認めたということが、商標権侵害事件における類似性の判断に影響を与えるか否かについては明確でない。

新商標法案第 95 条によれば、Tuna が商標登録を出願した時点でその商標に“Dolphin”（上記(2)で説明したとおり）との類似性はなかったとする Tuna の主張は、証明可能である。

従って、Tuna が商標登録を出願した時点でその商標に“Dolphin”との類似性はなかったとする Tuna の主張は、この事件における各商標間の類似性の判断に影響を与える可能性がある。

9. 未登録商標の所有権者の権利（争点(9)への回答）

争点(2)への回答で説明したとおり、ミャンマーの現行法及び判例法の下では、商標権侵害に対する民事訴訟又は刑事告訴を提訴するために関連商標を登録する義務はない。

従って、Tuna がミャンマー国内でその商標を使用する場合は、その時点で、Bonito に対し、関税法、水産物関税法及びミャンマー商品商標法に基づく訴訟を含めた訴訟を提起できる資格がある。

今回は、Tuna には新商標法案第35条⁹に基づき関連商標を登録する義務が生じるが、当該商標が周知商標でなく、ミャンマー国内で登録されていないならば、Tuna は、訴訟を提起できる資格を有さないことになる。

8 Aung Gun Chun (a) Mg Chun and two v. B.Y.C Soap Factory, 1966, B.L.R., (C.C) 1038

1. 付属書(6)参照

しかしながら、Tunaの商標が周知商標であり、既にミャンマー国内で登録された商標であるならば、Tunaは、**新商標法案第35条(a) (3)**に基づき、異なる商品又は役務のために登録された、周知商標と同一又は類似した商標の使用を防止できる権利を有する。更に、**ミャンマー公正競争法第17条及び第18条**に基づき、Tunaは、訴訟を提起することもできる。

更に、Tunaの商標が周知商標であるが、ミャンマー国内で登録されていない場合は、Tunaは、**新商標法案第76条(b)**に基づき、同一又は類似の商品又は役務に関する周知商標と同一又は類似の商標の使用を防止できる権利を有する。

Myanmar's Response to the Questions of the Model Case Study as to the Trade Mark Right

Issues

For this case study, there are some issues to be solved under the existing laws of Myanmar and under the new Bill relating to Trademark. They are:

- (1) the criminal and civil remedies for trademark infringement,
- (2) the requirement for the issuance of prior notice in order to commence civil and criminal procedures against an act of trademark infringement,
- (3) entitlement of a sole import agent to stand as a plaintiff in civil litigation,
- (4) acts of producing, importing, selling and importing goods with Marks 1 through 9,
- (5) general criteria for judging the similarity of trademarks,
- (6) the effect of the global profile of trademark on the judgment of the trademark,
- (7) the effect of the use of trademark “*Dolfin*” instead of the registered trademark “**Dolfin**”
- (8) the effect of the admission regarding the dissimilarity with infringing mark on trademark application,
- (9) right of unregistered trademark right for legal action.

1. Remedies (Answer for Issue No (1))

In Myanmar, both Criminal proceeding and Civil Proceeding can be taken against the trademark infringement **under the existing Laws** of Myanmar. Under the provisions of **Section 478, 480, 482, 483, 485, 486, 487 to 488 of the existing Myanmar Penal Code¹, Criminal proceeding** can be taken, and **under s. 54 of the existing Specific Relief Act² and s. 9 of the Civil Procedure Code³**, the **civil proceeding** can be taken. In doing so, these two proceedings are **to be taken separately**.

In the same way, **under the Section 35 (a) of new Myanmar Trademark Bill⁴**, both Criminal and Civil Proceeding can be taken against the trademark infringement. In taking so, these two proceedings are **to be taken separately**.

There are only few criminal cases and civil cases for trademark infringement. The Number of cases is still being collected and will be submitted later.

2. Requirements for commencing Civil litigation or Criminal prosecution

(Answer for Issue No (2))

There is no trade mark registration legislation in Myanmar. Criminal proceeding and Civil Proceeding against the trademark infringement are conducted under **the existing Civil or Criminal Procedure Code**. According to these Codes, **there is no requirement to issue prior public notice or warning in order to commence the litigation or prosecution for infringing trademark**.

As there is no trademark law in Myanmar, there was no registration facility until 1962. But, as the disputes as to such right had increased steadily, the government assigned Inspector General and his Registration Office of Deeds and Assurances under Ministry of Agriculture to do as a registration office for trademarks in accordance with the s. 18 (f) of the Registration Act in 1962. Therefore, the Inspector General and his Registration Office of Deeds and Assurances **had issued Direction No. 13/ 1962 to make the registration of the trademark**.

Under this Direction, a practice has developed by which the person purporting to be the trade mark owner can make a Declaration of Ownership and register the declaration with the office of the Registrar of Deeds. Once the declaration is registered, mostly, a Cautionary Notice is published in a daily English language newspaper to be warning people not to infringe the trade mark. In the case of infringement, the registered declaration and the cautionary notice serve to establish prima facie evidence for 'use' of the trade mark in Myanmar.

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1. See the Annex (1)
 2. See the Annex (2)
 3. See the Annex (3)
 4. "s. 35 The right owner shall, without affecting the provisions in sections 36 and 37:
 - (a) Enjoy the following as an exclusive right:
 - i. +++++
 - ii. the right to pursue criminal action, civil action or both against those who infringe on the rights relating to a registered mark,"
 - iii. ++++"

Under the Section **34 of new Myanmar Trademark Bill**⁵, a trademark is required to be registered to get protection, but no need to issue prior public notice or warning for the purpose of commencing civil litigation or criminal prosecution for trademark infringement.

3. Entitlement to litigate a suit by a sole import agent (Answer for Issue No (3))

Under existing laws, there is no provision that empowers a sole import agent to stand as a plaintiff in civil litigation. However, in the case of “**Gaspar & Co v. Leong Chye & Co**”⁶, a sole import agent was entitled to stand as a plaintiff in civil litigation to demand injunction and/or damages on the grounds of infringement of the trademark.

Under the new Myanmar Trademark Bill, it is not clear that a sole import agent was entitled to stand as a plaintiff in such cases.

4. Infringements (Answer for Issue No (4))

Under section **478, 480, 482, 483, 485, 486, 487 to 488** of the existing Penal Code⁷, each of Bonito’s acts of **producing, possessing and selling goods** with counterfeiting marks constitute the infringement of the trademark. And also under the Custom Act and Sea Custom Act, **importing and exporting such goods** constitute the infringement of the trademark. **Under S. 9 of the existing Civil Procedure Code**⁸ and **S. 54 of the existing Specific Relief Act**⁹, Tuna also has the right to take civil litigations for injunctions, damages and compensations against Bonito’s acts.

Under **section 86 of the new Myanmar Trademark Bill**¹⁰, each of Bonito’s acts of producing, selling, importing and exporting goods with counterfeiting marks constitute the criminal infringement.

It is not clear that each of Bonito’s acts of producing and selling goods with counterfeiting marks constitutes civil infringements under this new Bill.

However, Bonito’s acts of producing, selling and importing may be inferred to constitute civil infringement under Chapter 11 of the Bill, and Bonito’s acts of exporting constitute infringement under s. 49 (b) of the Bill.

Under s.35 of the Bill, it is clear that Tuna has the right to take both Civil and Criminal Action. If we read it along with the provision of S. 9 of the Civil Procedure Code and S. 54 of the Specific Relief Act, Tuna will have the right to take civil litigations for injunctions, damages and compensation against Bonito’s acts.

5. “If the owner of a mark complies with Chapter X, he shall enjoy the rights, related to a registered mark, stipulated in this chapter for the term of the registration.”

6. Indian Law Report (1934) Vol 12, page 534

7. See the Annex (1)

8. See the Annex (3)

9. See the Annex (2)

10. See Annex (4)

5. General criteria for the similarity of trademark (Answer for Issue No (5))

Under the existing laws of Myanmar, there is no expressed provision in Civil Procedure Code which sets the general criteria for judging the similarity of trademarks.

However, there is the definition of counterfeiting in s. 28 of Myanmar Penal Code. Under the case-laws of Myanmar, there have general criteria for judging the similarity of trademarks, and it is sufficient to constitute a colorable imitation if there is similarity between the two marks, which could, in the circumstances of a particular case, be considered to be calculated to deceive the class of persons for whom goods are ordinarily or primarily intended.

In Myanmar, **general criteria for the similarity of the trademark by the court rulings** are as follows:

- Two marks at issue need not be identical, similarity through slightly different between them is sufficient to claim infringement¹¹
- the translation of the meaning of trademark “Nanyang” “Elephant” “Elephant Star” in English version having the same meaning as “Nanyang Sin Kyal” () as a similar or identical of the Elephant" trademark in Myanmar language¹²
- “**Taung Gyi Mauk Mai**” is a trademark that includes a device for natural cosmetics. A different mark “**Shan Maunk Mai**” using similar get-up, size of plastic container and instruction was launched on the market is reasonable ground for granting temporary injunction¹³
- An owner of a trademark in respect of a particular commodity has no right to prohibit or prevent other person from the use of such mark in connection with goods of totally different character.”¹⁴
- It is not necessary in order to constitute a colorable imitation that two marks should be similar in every particular, but it will be sufficient in law to constitute a colorable imitation if there exists such similarity between the two marks which could lead to consumers“deception.”¹⁵

There are **no general criteria for judging the similarity of trademarks under the new Myanmar Trademark Bill**, However, **Myanmar Courts will follow and decide** the trademark infringement cases by **using general criteria for judging the similarity of trademarks, which are set by the above-mentioned case-laws.**

11. U MaungMaung (a) Alibi Vs. DawKhin Than Myint 1975 BLR 72

12. Nanyang Industry Ltd Vs Gold Asia Rubber Manufacturing, Special Civil Appeal Case No. 48, (Special Bench –Three Judges Sitting), Supreme Court (Yangon), 2005

13. U Tin Lett (a) U Sai Lett and one Vs. U KyawNyein, Year 2000, Special Civil Appeal Case No. 23 (Special Bench), Yangon, 2001 BLR -128

14. John Walkers Vs. U Than Shwe 1968 BLR 73

15. Gaw Shan Soot Vs E.C Madah (1952, BLR, 136 (H.C)

To decide whether there is identical or similarity between the registered mark and the infringed one from 1 to 9, the court looks at the appearance, pronunciation, concept (meaning) of these marks and the intention of the infringer. According to the discussions in Myanmar, the **conclusions** can be drawn as follows. it is found out that **there are infringements in the case of Mark (1) and (2), and the remaining (7) marks cannot be deemed to infringe Tuna's rights.**

Mark No.	appearance	pronunciation	concept (meaning)	Intention	Conclusion
1	O	O	?	O	O
2	O	O	?	O	O
3	×	O	?	×	×
4	×	×	×	×	×
5	×	×	×	×	×
6	×	×	×	×	×
7	×	O	×/O if consumer know definition	×/O	×/O
8	×	×/O (if can pronounce)	O	×	×
9	O (if other words are small)/+	×	×	×/O	×/O

6. Global profile of the trade mark (Answer for Issue No (6))

There is **neither provision nor case-law to protect the Well-known marks** in Myanmar. The global profile does not affect the judgment on the similarity of the trademark.

But, under the existing laws and case-laws of Myanmar, **if the owner of global profile of the trademark in this case uses it in Myanmar**, it can affect the judgment on the similarity of the trademark.

In taking action against an infringer, **a legitimate trademark owner must demonstrate actual use of the trademark to prove** that he is the legitimate trademark owner and has a better right over the mark in Myanmar.

In order to demonstrate actual use, a trademark owner must sell and distribute products bearing the trademark on its own or via a distributor. This may, however, prove to be difficult, because the legitimate trademark owner may not be able to provide evidence claiming a better right over the alleged infringer for products which are not related to their business.

Under **section 35 (a) (3) and 76 (b) of the new Myanmar Trademark Bill¹⁶**, there are protections for the Well-known marks in Myanmar.

16. See Annex (5)

The Draft Trademark Law recognizes the well-known mark in Myanmar. It defines that a well-known mark is a mark being well-known in the Republic of the Union of Myanmar in accordance with the stipulated standard.

According to s. 101 of this Bill, this standard may be determined by the responsible Union Ministry to be well-known mark by the relevant sector of the public in the Union of Myanmar in respect of the type of goods or services to which the mark applies. But this recognition is subject to the right of well-known mark which is not registered in Myanmar.

7. Cancellation of Non-use Trademark (Answers for Issue No. 7 (1) and 7 (2))

Regarding the Issue No. 7 (1), there is no expressed provision in the existing laws or rulings which prescribe that using a mark in a different design without modifying the special characteristics of the registered mark is or amounts to non-use of the registered one.

Under s. 49 (b) (1) of the new Bill¹⁷, using a mark in a different design with registered one is or amounts to using a registered mark.

Regarding the Issue No. 7 (2), non-use of the trademark can affect on the judgment on the similarity or infringement of it.

Under the case-laws of Myanmar, usage of a mark in Myanmar is precondition for the protection, and invalidation of the trade-mark right may be possible on the grounds of non-use.

A trademark owner could lose his right if he did not use or abandon his trademark, but there was no provision or rulings limiting the exact duration of non-use or abandonment of the trademark¹⁸.

There is no clear current practice for cancellation of non-use trademark. Non-use cancellation will also be available under the new Bill. **The Registrar may cancel the registration of a mark if the trademark owner fails to use the mark for three consecutive years, commencing from the date of application, without sufficient justification¹⁹.**

8. The effect of statement during the trademark registration process (Answers for Issue No. 8)

There is **no expressed provision in the existing laws and case-laws that Tuna's argument for the registration of its mark, which has admitted the dissimilarity with the mark of "Dolphin" in the application, can be used as evidence in the court proceedings.** Therefore, it is not clear that Tuna's argument which has admitted the dissimilarity with the mark of "Dolphin" affect the judgment on the similarity in the trademark infringement case although there are estoppel provisions in Myanmar Evidence Act.

17. See Annex (6)

18. Aung Gun Chun (a) Mg Chun and two v. B.Y.C Soap Factory, 1966, B.L.R., (C.C) 1038,

19. See Annex (7)

Under S. 95 of the new Trademark Bill²⁰, Tuna's argument at the time of applying for the registration of its trademark that it was not similar to "Dolphin" (as explained in 2) above) can be proved.

So, the argument of Tuna at the time of applying for the registration of its trademark that it was not similar to "Dolphin" may affect the judgment of similarity between the marks in this case.

9. Right of the owner of unregistered mark (Answers for Issue No. 9)

As we explained in the answers for Issue No (2), there is no requirement to register the relevant trademark in order to take civil litigation or criminal prosecution for trademark infringements under the existing laws and case-laws of Myanmar.

Therefore, Tuna is entitled to take any legal actions including actions under the Custom Act, Sea Custom Act and Myanmar Merchandising Marks Act **against Bonito if and when Tuna uses its mark in Myanmar.**

Now it is required to register the relevant trademark under S.35 of the new Trademark Bill²¹, and Tuna, **if its mark is not well-known and not registered in Myanmar**, is not entitled to take any legal actions.

However, **if Tuna's mark is a well-known and registered mark in Myanmar**, Tuna has the right to prevent the use of a mark identical or similar to a well-known, registered mark for different goods or services **under S. 35 (a) (3) of the new Trademark Bill²²**. And also, **Tuna is able to take an action under S. 17 and 18 of the Competition Law of Myanmar²³**.

And **if Tuna's mark is a well-known but not registered mark in Myanmar**, Tuna has the right to prevent the use of a mark identical or similar to its well-known mark for identical or similar goods or services **under S. 76 (b) of the new Trademark Bill²⁴**.

20. See Annex (8)

21. See Annex (6)

22. See Annex (6)

23. See Annex (9)

24. See Annex (6)

1. Annex (1) : Section 478, 480, 482, 483, 485, 486, 487 to 488 of the existing Myanmar Penal Code

(a) Section 478

“A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trademark.”

(b) Section 480

“Whoever **marks** any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, **in a manner reasonably calculated to cause it to be believed** that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.”

(c) Section 482

“Whoever **uses** any false mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.”

(d) Section 483

“Whoever **counterfeits** any trademark or property mark used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with fine, or with both”

(e) Section 485

“Whoever **makes or has in his possession** any die, plate or other instrument for the purpose of counterfeiting a trade mark, or property mark, or **has in his possession a trade mark** or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.”

(f) Section 486

“Whoever **sells, or exposes, or has in possession for sale** or any purpose of **trade or manufacture**, any goods or things with a counterfeit trade mark or property mark affixed to or impressed upon the same or to or upon any case, package or other receptacle in which such goods are contained, shall, unless he proves –

(a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and

(b) that, on demand made by or on behalf of the prosecutor, he **gave all the information in his power** with respect to the person from whom he obtained such goods or things, or

(c) that otherwise he **had acted innocently**,

be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.

(g) Section 487

Whoever **makes any false mark** upon any case, package or other receptacle containing goods, **in a manner reasonably calculated to cause** any public servant or any other person to believe that such receptacle contains goods which it does not contain, or that it does not contain goods which it does contain, or that the goods contained in such receptacle are of a nature or quality different from the real nature or quality thereof, shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both

(h) Section 488

Whoever **makes use of any such false mark** in any manner prohibited by the last foregoing section shall unless he proves that he acted without intent to defraud, be punished as if he had committed an offence against that section.

2. Annex (2) : S. 54 of the existing Specific Relief Act

“Subject to the other provisions contained in, or referred to by, this Chapter, **a perpetual injunction may be granted to prevent the breach** of an obligation existing in favor of the applicant, whether expressly or by implication. When such obligation arises from contract the Court shall be guided by the rules and provisions contained in Chapter (ii) of this Act. **When the defendant invades or threatens to invade the plaintiff's right to, or enjoyment of property,** the Court may grant a perpetual injunction in the following cases (namely):-

- (a) where the defendant is trustee of the property for the plaintiff;
- (b) where there exists no standard for ascertaining the actual damage caused, or likely to be caused, by the invasion;
- (c) where the invasion is such that pecuniary compensation would not afford adequate relief;
- (d) where it is probable that pecuniary compensation cannot be got for the invasion;
- (e) where the injunction is necessary to prevent a multiplicity of judicial proceedings.

• Explanation - **For the purpose of this section a trademark is property”.**

Illustrations

(w) **A improperly uses the trademark of B. B may obtain an injunction to restrain the user, provided that B's use of the trademark is honest.**

3. Annex (3) : S. 9 of the Civil Procedure Code

The Courts shall (subject to the provisions herein contained) have jurisdiction to try ***all suits of a civil nature excepting suits of which their cognizance is either expressly or impliedly barred.***

Explanation- **A suit in which the right to property or to an office is contested** is a suit of a civil nature, notwithstanding that such right may depend entirely on the decision of questions as to religious rites or ceremonies.

4. Annex (4) : Section 86 of the new Myanmar Trademark Bill

Whoever deliberately **commits** the following offences or **abets the offender** for commercial purposes, without the consent of the trademark owner, shall be punished with a prison sentence of **no more than three (3) years**, a fine not exceeding five million **(5,000,000) kyats**, or both:

- (a) counterfeiting a trademark;
- (b) **using** a counterfeit trademark for goods or services;
- (c) **retaining** any substance or equipment materially used to make a counterfeit trademark or to apply use a counterfeit trademark in goods;
- (d) **selling and distributing** goods using the counterfeit trademark; or
- (e) **importing or exporting** goods using the counterfeit trademark into or from Myanmar.

5. Annex (5) : section 35 (a) (3) and 76 (b) of the new Myanmar Trademark Bill

(a) Section 35 (a) (3) of the new Myanmar Trademark Bill

The right owner shall, without affecting the provisions in sections 36 and 37:

- (a) Enjoy the following as an exclusive right:
 - i. +++++
 - ii. the right to pursue either criminal action, civil action or both against those who breach infringe on the rights relating to a registered mark,”
 - iii. in any of the following events, the right to prevent the use of a mark identical or similar to a well-known, registered mark for different goods or services, without the consent of owner of the mark, in the course of trade:
 - 1. if it indicates that there is a connection between the owner of a well-known, registered mark and the goods or services which use the mark;

2. if it is harmful to the interests of owner of said mark.

(b) Section 76 (b) of the new Myanmar Trademark Bill

The court:

(a) shall presume that a mark protected under this Law is violated if any person who is not the right owner of the mark exercises any right under section 35 in Myanmar without the consent of the owner.

(b) shall presume that the use, without consent, of an identical or similar well-known mark which is not registered for identical or similar goods or services shall be deemed as misleading the public.

6. Annex (6) : S. 49 (b) (1) of the new Myanmar Trademark Bill

S.49 (a) +++++

(b) **The use of marks** according to subsection (a) includes the following:

(i) **use in a different design without modifying the special characteristics of the registered mark;**

7. Annex (7) : S. 49 (a) (1) of the new Myanmar Trademark Bill

(a) Upon an application by a related person, the Registrar must cancel the registration if a registered mark is found to meet any of the following conditions:

(i) Goods or services related to the registered mark are not used within three (3) years from the date of registration in the Department and there is no sufficient reason for the failure to use the said mark;

8. Annex (8) : S. 95 of the new Trademark Bill

95. **A copy of the registration certificate of a mark and other documents**, which are signed, sealed and certified by the registrar, **are allowed to be submitted to the relevant courts as evidence.**

9. Annex (9) : S. 17 and 18 of the Competition Law of Myanmar

(a) S.17 of the Competition Law of Myanmar

The acts done for the purposes of unfair competition under this Law include as follows

- (a) **Misleading of consumers,**
- (b) Disclosing business secrets,
- (c) Coercing of businessmen to each other,
- (d) Defaming of the reputation of another business,
- (e) Disturbing the operation of another business;
- (f) Advertising and sale promotion for the purpose of unfair competition,
- (g) Discriminating among businessmen,
- (h) Selling goods at price lesser than production cost or post, insurance and freight (CIF) in the market,
- (i) Abusing influence of his business, inducing or instigating of a party under contract with other businesses to breach the contract,
- (j) Exercising unfair competitive act in competition stipulated by the commission for the interests of consumers when necessary.

(b) S.18 of the Competition Law of Myanmar

No businessman shall carry out any of the **following acts which mislead the consumers;**

- (a) Carrying out with intention to compete with the use of deceptive information which mislead **the legally registered name of goods, business slogan, logo, packaging, geographical indication and other elements,**
- (b) Carrying out business such as production of goods and services by using the information contained in sub-section (a).