

Civil Special Leave to Appeal No 23/2000

Before U Than Oo, Deputy Chief Justice; U Myint Thein and U Chit Lwin, Judges of the Supreme Court

U Tin Latt (a) U Sai Latt and one other

v

U Kyaw Nyein

The meaning of trade mark ownership or right for a mark using such trade mark; requirements to constitute the colourable imitation of a trade mark; criteria to consider when granting temporary injunction for prohibition of the infringement of a trade mark.

The plaintiff was the manufacturer of a special *Thannakar* skin lotion bearing the trade mark '*Taunggyi Maukmae*'. The defendant produced a similar *Thanakar* skin lotion bearing the trade mark '*Shan Maungmae*'. The former trade mark was infringed by the similarity of the latter trade mark. The plaintiff brought an action for perpetual injunction against the defendant to Yangon Divisional Court, under the Specific Relief Act (1963). Although a temporary injunction was granted by the Divisional Court, the defendant was dissatisfied with the judgment of the Divisional Court and filed an appeal to the High Court (Supreme Court). The Appeal Court rejected the order of the Divisional Court to grant a temporary injunction. Therefore, the plaintiff (appellant) filed a special appeal under Section 6 of the Judiciary Law Act (1988), against the order of the High Court's decision to reject the temporary injunction, to the Supreme Court (sitting as full bench constituted by all members of the Supreme Court). The Supreme Court held as follows:

Held: Section 478 of the Myanmar Penal Code defines trade mark as 'a mark used for denoting that goods are the manufacture or merchandise of a particular person'.

A trade mark is a symbol applied or attached to goods offered for sale in the market so as to distinguish them from similar goods and to identify them with a particular owner. A mark includes a device, brand, heading ... or any combination thereof.

Held: In Myanmar, there is no law or statute established for the registration of trade marks. However, registration or declaration of ownership of a trade mark under the Registration Act can be acquired by using it (see *U Kyaw v U Ba Aye* [1962] B.L.R (C.C) p.187).

It could be said that the plaintiff has acquired exclusive rights to the trade mark '*Taunggyi Maukmae*', as they have been using the mark since 1994. Therefore, the defendant has no right to sell goods that imitate the aforementioned trade mark.

In order to obtain a temporary injunction restraining the use of a trade mark or label, the plaintiff must show that the case is of some urgency, that he has a clear colour of title and that the granting of the injunction will not cause irreparable damage to the defendant if it be later proven that the defendant has a right (see *Saya U Nyo Zeint v Saya Shein* [1948] B.L.R (C.C) p.134).

Held: Section 28 of the Myanmar Penal Code provides that 'it is not essential to counterfeiting that the imitation should be exact'.

In order to constitute a colourable imitation it is not necessary that the two marks concerned are similar in every particular, but it is sufficient in law to constitute a colourable imitation if there exists such 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 the goods are ordinarily or primarily intended (see *Gaw Shan Soot v E.C. Madha Brothers* [1952] B.L.R (H.C) p.136).

The two marks concerned need not be identical; similarities between the two can still amount to counterfeiting even if there are only slight differences. It constitutes as infringement of a trade mark if a person looking at the two marks side by side is confused, even though the differences are small (see *U Maung Maung (a) Ali Bhai v Daw Khin Than Myint* [1975] B.L.R (C.C) p.72).

In order to constitute a colourable imitation it is not necessary that the two marks concerned are similar in every particular. It constitutes as infringement of a trade mark if a person looking at the two marks side by side is confused, even if they are only slightly different.

Held: If a party makes out a prima facie case before granting a perpetual injunction, a temporary injunction should be granted during the proceedings. In considering whether a temporary injunction should be granted or not, it is not necessary to decide earlier on matters of ownership or imitation of the trade mark. Only whether the case has prima facie evidence or not needs to be taken into consideration.

In this case, in order to prove that in the view of the consumers the defendants are manufacturing and selling goods (*Thanakha*) using a similar trade mark that imitates the plaintiff's trade mark, the plaintiff submitted materials, such as medical instruction paper and a plastic box with the word '*Thanakha*' on the inside, relating to the similar trade mark, used for the plaintiff's own goods to compare them with the materials used by the defendant for manufacturing the defendant's goods. Therefore, the Court held that a temporary injunction should be granted as the action brought by the plaintiff had clear evidence for infringing the plaintiff's trade mark.