

## Table of Comparison of Trade Mark Laws

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
Definition of 'trade mark'	<p>(Clause 3(1))</p> <ul style="list-style-type: none"> <li>• any sign capable of distinguishing goods/services of one undertaking from others; capable of graphic representation.</li> </ul> <p>(Clause 3(2))</p> <ul style="list-style-type: none"> <li>• may consist of words, indications, designs, letters, numerals, figurative elements, shape of goods, packaging, combination of colours or combination of above.</li> </ul> <p><u>Comment</u></p> <p>Similar in scope with the other trade mark laws under comparison.</p>	<p>(S.1)</p> <ul style="list-style-type: none"> <li>• any sign capable of being represented graphically; capable of distinguishing goods/ services of one undertaking from others.</li> <li>• may consist of words (including personal names), designs, letters, numerals or shape of goods or their packaging.</li> </ul>	<p>(S.17)</p> <ul style="list-style-type: none"> <li>• a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person, from goods or services so dealt with or provided by any other person.</li> </ul> <p>(S.6) 'Sign'</p> <ul style="list-style-type: none"> <li>• includes the following or any combination of the following: any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent. ("word" includes "an abbreviation of a word")</li> </ul>	<p>(15 USC § 1127)</p> <ul style="list-style-type: none"> <li>• includes any word, name, symbol, or device or any combination thereof, either used by a person or which that person has a bona fide intention to use in commerce, to identify and distinguish his goods/services and to indicate the source of the goods/services.</li> <li>• may include non-verbal as well as verbal symbols, packaging or the overall shape of a product, colour, or even a smell.</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
‘Well known mark’	<p>(Clause 4)</p> <ul style="list-style-type: none"> <li>means a mark entitled to protection under Paris Convention as a well-known trade mark which is well-known in HK; regardless of whether or not owner of mark carrying on business in HK or owns goodwill in a business in HK.</li> </ul> <p><u>Comment</u></p> <p>Hong Kong and UK trade mark laws do not contain criteria for defining a ‘well-known’ mark, as there is yet to be an international consensus of</p>	<p>(S.56)</p> <ul style="list-style-type: none"> <li>means a mark entitled to protection under Paris Convention as a well-known trade mark which is well-known in the UK; regardless of whether or not proprietor of mark carrying on business or has any goodwill in the UK.</li> </ul>	<p>(S.60)</p> <ul style="list-style-type: none"> <li>provides, as a ground of opposition, that a well known mark is one which has acquired a reputation in Australia; use of which by applicant would be likely to cause confusion or deception.</li> </ul> <p>(S.120(3))</p> <ul style="list-style-type: none"> <li>provides for infringement of a registered trade mark by use on goods/services unrelated to the registered goods/services if the registered trade mark is well known.</li> </ul>	<p>(15 USC §1125(2)(c) as amended)</p> <p>[referred to as ‘famous<sup>1</sup> marks’]</p> <ul style="list-style-type: none"> <li>owner of famous mark entitled to injunctive relief against another person’s use in commerce of a mark or trade name which causes dilution of the quality of the mark.</li> </ul> <p>(15 USC §1127)</p> <ul style="list-style-type: none"> <li>‘dilution’ defined as ‘the lessening of the capacity of a famous mark to identify and distinguish goods or services’; actionable even in absence of competition, or likelihood of confusion, mistake, or deception.</li> </ul>

<sup>1</sup> See S.43(c) Lanham Act [Non-exhaustive]

Factors for determining whether a mark is distinctive and famous:—

- (a) the degree of inherent or acquired distinctiveness of mark;
- (b) the duration and extent of use of the mark in connection with the goods/services with which the mark is used;
- (c) duration and extent of advertising and publicity of mark;
- (d) geographical extent of trading area in which mark is used;
- (e) channels of trade for goods/services with which mark is used;
- (f) degree of recognition of mark in trading areas and channels of trade used by mark’s owner and person against whom the injunction is sought;
- (g) nature and extent of use of same or similar marks by third parties; and
- (h) whether mark was registered.

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>a definition for "well-known marks".</p>		<p>(S.120(4))</p> <ul style="list-style-type: none"> <li>in deciding whether a TM is well-known in Australia, consider extent to which TM is known in relevant sector of public (whether as result of promotion or otherwise)</li> </ul>	
<p>Absolute grounds for refusal</p>	<p>(Clause 10)</p> <ul style="list-style-type: none"> <li>if sign does not satisfy requirements for a trade mark under S.3(1).</li> <li>signs which are devoid of distinctive character</li> <li>signs which serve in trade or business to designate the kind, quality, quantity, intended purpose, value, geographical origin, etc of goods/services.</li> <li>signs customary in current language or honest, established practice of trade.</li> <li>shape resulted from nature of goods.</li> </ul>	<p>(S.3)</p> <ul style="list-style-type: none"> <li>if sign does not satisfy requirements for a trade mark under S.1(1).</li> <li>devoid of distinctive character.</li> <li>signs which serve in trade to designate kind, quality, quantity, intended purpose, value, geographical origin, etc of goods/services:</li> <li>signs customary in current language or honest, established practice of trade.</li> <li>shape resulted from nature of goods.</li> <li>shape necessary to obtain technical result.</li> </ul>	<p>(S.39)</p> <ul style="list-style-type: none"> <li>if a trade mark contains or consists of a sign that under the regulations is not to be used as a trade mark.</li> </ul> <p>(S.40)</p> <ul style="list-style-type: none"> <li>if mark cannot be represented graphically.</li> </ul> <p>(S.41(2))</p> <ul style="list-style-type: none"> <li>if not capable of distinguishing the applicant's goods or services.</li> </ul> <p>(S.42)</p> <ul style="list-style-type: none"> <li>scandalous or contrary to law.</li> </ul>	<p>(15 USC § 1052)</p> <ul style="list-style-type: none"> <li>"No TM by which goods of applicant may be distinguished from goods of others shall be refused registration" ... unless it:—</li> <li>consists of immoral, deceptive, or scandalous matter; matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.</li> <li>consists of a geographical indication which, when used on wines or spirits, identifies a place other than the origin of the goods and</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<ul style="list-style-type: none"> <li>• shape necessary to obtain technical result.</li> <li>• shape giving substantial value to goods.</li> <li>• contrary to public policy or principles of morality or likely to deceive the public.</li> <li>• if use is prohibited by law in UK.</li> <li>• if application made in bad faith.</li> <li>• a mark consisting of the national flag, national emblem, regional flag or regional emblem.</li> </ul> <p><u>Comment</u> The “absolute grounds for refusal” set out the conditions under which a trade mark registration will be refused. Similar provisions are also provided in the other jurisdictions under comparison.</p>	<ul style="list-style-type: none"> <li>• shape giving substantial value to goods.</li> <li>• contrary to public policy or principles of morality or likely to deceive the public.</li> <li>• if use is prohibited by law in UK.</li> <li>• if application made in bad faith.</li> </ul> <p>(S.4)</p> <ul style="list-style-type: none"> <li>• if mark consists of the Royal arms, principal bearings of the Royal arms, representation of the Royal Crown or flags, representation of Her majesty or the national flag or flags of England, Wales, Scotland, N. Ireland or Isle of Man.</li> </ul>	<p>(S.43)</p> <ul style="list-style-type: none"> <li>• likely to deceive or cause confusion.</li> </ul>	<p>is first used on or in connection with wines or spirits by the applicant after WTO Agreement in force in USA.</p> <ul style="list-style-type: none"> <li>• consists of name, portrait, or signature identifying a particular living individual except by his written consent.</li> <li>• consists of flag, coat of arms or other insignia of the US or any state or municipality, or of any foreign nation, or any simulation thereof.</li> <li>• consists of mark which is merely descriptive or deceptively misdescriptive.</li> <li>• consists of mark which is primarily geographically descriptive or deceptively misdescriptive except as indications of regional origin. (may be registrable as certification or collective marks)</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
				<ul style="list-style-type: none"> <li>• which is primarily merely a surname.</li> <li>• subject to application for mark that has become distinctive of the applicants' goods/services in commerce.</li> </ul>
Relative grounds for refusal	<p>(Clause 11) If subject mark is:</p> <ul style="list-style-type: none"> <li>• identical to earlier trade mark; identical goods/services.</li> <li>• identical to earlier trade mark; similar goods/service; likelihood of confusion.</li> <li>• similar to earlier trade mark; identical or similar goods/services; likelihood of confusion.</li> <li>• identical/similar to earlier trade mark; dissimilar goods/services; if earlier trade mark has reputation in HK and use of later mark would take unfair advantage or be detrimental to distinctive</li> </ul>	<p>(S.5)</p> <ul style="list-style-type: none"> <li>• identical with earlier trade mark; identical goods/services.</li> <li>• identical with earlier trade mark; similar goods/services; likelihood of confusion including likelihood of association.</li> <li>• similar to earlier trade mark; identical/similar goods/services; likelihood of confusion including likelihood of association.</li> <li>• identical/similar to earlier trade mark; dissimilar goods/services; if earlier trade mark has reputation in UK and use of later mark would take unfair advantage or be detrimental to distinctive character or</li> </ul>	<p>(S.44)</p> <ul style="list-style-type: none"> <li>• if applicant's mark (for goods) substantially identical with, or deceptively similar to, an earlier registered mark or application re similar goods or closely related services.</li> <li>• if applicant's mark (for services) substantially identical with, or deceptively similar to, an earlier registered mark or application re similar services or closely related goods.</li> </ul> <p>[use of substantially identical or deceptively similar mark on dissimilar</p>	<p>(15 USC § 1052)</p> <ul style="list-style-type: none"> <li>• if mark so resembles a mark registered or a mark or trade name previously used in the US by another and which is not abandoned, as to be likely, when used on goods of the applicant, to cause confusion, or cause mistake, or to deceive.</li> <li>• Proviso: subject to concurrent lawful use in commerce and if Commissioner finds that confusion, mistake, or deception is not likely to result Commissioner shall then prescribe conditions and limitations as to mode or place of use for co-existence of registrations.</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>character or repute of earlier trade mark.</p> <ul style="list-style-type: none"> <li>• if use of subject mark liable to be prevented by any rule of law e.g. law of passing-off, copyright or registered designs. This ground must be raised in opposition proceedings.</li> <li>• may be registrable on consent of owner of earlier trade mark unless Registrar satisfied that use of mark likely to cause confusion among the public.</li> </ul> <p><u>Comment</u></p> <p>The “relative grounds for refusal” set out the conditions under which a</p>	<p>repute of earlier trade mark.</p> <ul style="list-style-type: none"> <li>• if use of later mark liable to be prevented by any rule of law e.g. law of passing-off, copyright, design right or registered designs. This must be raised in opposition proceedings (S.7 (2)).</li> <li>• may be registrable on consent of owner of earlier trade mark.</li> </ul>	<p>goods is an act of infringement in some circumstances, see section on ‘Infringement’, <i>infra</i>]</p>	<ul style="list-style-type: none"> <li>• Restatement of Torts 1938 sets forth four factors for determining likelihood of confusion.<sup>2</sup></li> </ul>

<sup>2</sup> (a) the degree of similarity in

- (i) appearance
- (ii) pronunciation
- (iii) verbal translation of the pictures or designs
- (iv) suggestion;

(b) the intent in adopting the designation;

(c) the relation in use and manner of marketing; and

(d) the degree of care likely to be exercised by purchasers.

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>trade mark registration will be refused, mainly because of conflicts with earlier registered marks. Similar restrictions are also found in other jurisdictions.</p>			
Infringement	<p>(Clause 17)</p> <ul style="list-style-type: none"> <li>• use of identical sign; identical goods/services in course of trade or business.</li> <li>• use of identical sign; similar goods or services in course of trade or business; likely to cause confusion.</li> <li>• use of similar sign; identical or similar goods in course of trade or business; likely to cause confusion.</li> <li>• use of identical or similar sign; dissimilar goods or services; in the course of trade or business;</li> </ul>	<p>(S.10)</p> <ul style="list-style-type: none"> <li>• use of identical sign; identical goods/services in the course of trade.</li> <li>• use of identical sign; similar goods/services in the course of trade; likely to cause confusion including likelihood of association.</li> <li>• use of similar sign, identical or similar goods in course of trade; likely to cause confusion including likelihood of association.</li> <li>• use of identical or similar sign; dissimilar goods or services in the course of trade; registered mark has reputation in UK; use of sign takes unfair advantage of or is detrimental to</li> </ul>	<p>(S.120)</p> <ul style="list-style-type: none"> <li>• substantially identical or deceptively similar sign; identical goods/services.</li> <li>• substantially identical or deceptively similar sign; goods/services of same description or closely related to those registered.</li> </ul> <p><u>(Proviso:</u></p> <p style="padding-left: 40px;">No infringement if defendant proves his use not likely to deceive or cause confusion.)</p> <p>(S.120(3))</p> <ul style="list-style-type: none"> <li>• use of sign substantially identical or deceptively</li> </ul>	<p>(15 USC § 1114)</p> <p>Without consent of registrant:</p> <ul style="list-style-type: none"> <li>• to use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark which is likely to cause confusion, mistake, or to deceive.</li> <li>• The Restatement of Torts 1938 sets forth four factors for determining likelihood of confusion: (See note 2 <i>supra</i>)</li> <li>• to reproduce, counterfeit, copy, or colourably imitate a registered mark, and apply such to packaging material etc intended to be used in commerce, which is likely to cause confusion,</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>registered mark has reputation in HK; use of sign takes unfair advantage of or is detrimental to distinctive character or repute of trade mark.</p> <p>(Clause 6)</p> <ul style="list-style-type: none"> <li>• ‘use’ of a trade mark or sign includes any use whether by means of graphic representation or otherwise.</li> </ul> <p>(Clause 7)</p> <ul style="list-style-type: none"> <li>• when deciding whether use of a trade mark/sign is ‘likely to cause confusion’, Registrar/court may consider all relevant factors including likelihood of association with an earlier trade mark.</li> </ul>	<p>distinctive character or repute of trade mark.</p> <p>S.103(2)</p> <ul style="list-style-type: none"> <li>• ‘use’ of a trade mark includes use otherwise than by means of a graphic representation.</li> </ul>	<p>similar to a registered trade mark that is a well known mark in Australia; on goods/services which are <u>not</u> of the same description and <u>not</u> closely related to registered goods; likely to indicate connection between the unrelated goods/services and the registered owner of trade mark; interests of registered owner are likely to be adversely affected.</p>	<p>mistake or to deceive (requires proof of knowledge that such imitation intended to be used to cause confusion etc., otherwise registrant not entitled to damages or profits<sup>3</sup>.)</p>

<sup>3</sup> The Federal Trademark Dilution Act 1995 (USA) extends protection beyond the likelihood of confusion standard by providing that likelihood of injury to business reputation or of dilution of distinctive quality of registered or unregistered mark or a trade name, shall be a ground for injunctive relief though there is no competition between parties or no confusion as to source of goods/services.

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p><u>Comment</u></p> <p>We follow the language of the UK law closely; but the Australian and US laws provide broadly similar definitions of infringing acts as well.</p>			
Exceptions to Infringement	<p>(Clause 17(7))</p> <ul style="list-style-type: none"> <li>• use of registered TM for identifying goods/services of owner of registered TM or licensee if accords with honest practices in industrial or commercial matters, does not take unfair advantage of or is detrimental to distinctive character or repute of trade mark.</li> </ul> <p>(Clause 18(3))</p> <ul style="list-style-type: none"> <li>• use by a person of own name or address.</li> <li>• use of signs re characteristics of goods/services; or where</li> </ul>	<p>(S.10(6))</p> <ul style="list-style-type: none"> <li>• use of registered TM for identifying goods/services of proprietor or licensee if accords with honest practices in industrial or commercial matters, does not take unfair advantage of or is detrimental to distinctive character or repute of trade mark</li> </ul> <p>(S.11(2))</p> <ul style="list-style-type: none"> <li>• use by a person of own name or address.</li> <li>• use of indications re characteristics of goods/services.</li> </ul>	<p>(S.122)</p> <ul style="list-style-type: none"> <li>• use in good faith by a person of own name or place of business, or name of predecessor in business or name of predecessor’s place of business.</li> <li>• use of a sign in good faith to indicate characteristics of goods/services.</li> <li>• in good faith to indicate intended purpose of goods/services.</li> </ul>	<p>(15 USC § 1115)</p> <ul style="list-style-type: none"> <li>• fair use of individual name of anyone in privity with defendant; use of term or device descriptive of and used fairly and in good faith only to describe goods/services of such party or their geographical origin.</li> <li>• Prior use (prior to date of registration or date of constructive use i.e. (filing))</li> <li>• consent of right holder</li> </ul> <p>(15 USC §1125(4))</p> <ul style="list-style-type: none"> <li>• fair use of a famous mark in comparative commercial advertising or promotion to</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>necessary to indicate intended purpose of product/service if accords with honest practices in industrial or commercial matters.</p> <ul style="list-style-type: none"> <li>earlier, continuous use of an unregistered trade mark or sign in the course of trade or business in HK which precedes date of first use and registration of registered trade mark.</li> </ul> <p><u>Comment</u></p> <p>The concept of “fair” or “honest” use is common to all of the four trade mark laws under comparison.</p>	<ul style="list-style-type: none"> <li>use where necessary to indicate the intended purpose of a product/service if accords with honest practices in industrial or commercial matters.</li> <li>‘earlier right’ i.e. use in the course of trade of an unregistered trade mark or sign continuously in a particular locality which precedes date of first use and registration of registered trade mark.</li> </ul>	<ul style="list-style-type: none"> <li>for purposes of comparative advertising.</li> <li>in exercise of a right to use trade mark given under this Act.</li> <li>if court thinks that person would obtain registration of trade mark in his name if he were to apply for it.</li> <li>use in a manner that does not infringe exclusive right of registered owner to use because of a condition or limitation on the registration trade mark under S.120.</li> <li>use of part of a trade mark that has been disclaimed.</li> </ul>	<p>identify competing goods/services of owner of famous marks.</p> <ul style="list-style-type: none"> <li>non-commercial use of mark.</li> <li>all forms of news reporting and news commentary.</li> </ul> <p>(Trademark Law Revision Act 1988)</p> <ul style="list-style-type: none"> <li>equitable defences including laches, estoppel and acquiescence.</li> </ul>
Exhaustion of rights (Parallel imports)	(Clause 19) <ul style="list-style-type: none"> <li>where goods have been put on market anywhere in the world under trade mark by owner or with his consent (save where</li> </ul>	(S.12) <ul style="list-style-type: none"> <li>where goods have been put on market in the European Economic Area under that trade mark by the proprietor or with his consent.</li> </ul>	(S.123) <ul style="list-style-type: none"> <li>no infringement if trade mark has been applied to goods/services by or with the consent of the registered owner of trade</li> </ul>	No specific stipulations.

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>conditions of the goods have changed or are impaired)</p> <p><u>Comment</u></p> <p>There is no international consensus on the treatment of parallel importation of intellectual property materials. Individual countries and economies may therefore accord different standards in line with their own needs.</p>	<p>(except where legitimate reasons exist for proprietor to oppose further dealings in the goods e.g. condition of goods have changed or are impaired.)</p>	<p>mark.</p>	
<p>Remedies/ relief for infringement</p>	<p>(Clause 20)</p> <ul style="list-style-type: none"> <li>• damages, injunctions, accounts or otherwise as for infringement of any other property right.</li> </ul> <p>(Clause 23(4))</p> <ul style="list-style-type: none"> <li>• inserted as result of Article 46 of TRIPS Agreement.</li> </ul>	<p>(S.14(2))</p> <ul style="list-style-type: none"> <li>• damages, injunctions, accounts or otherwise as for infringement of any other property right.</li> </ul> <p>(S.15)</p> <ul style="list-style-type: none"> <li>• order for erasure.</li> </ul> <p>(S.16)</p> <ul style="list-style-type: none"> <li>• order for delivery up of</li> </ul>	<p>(S.126)</p> <ul style="list-style-type: none"> <li>• injunction, which may be granted subject to any condition that the court thinks fit; at the option of the plaintiff, damages or an account of profits.</li> </ul>	<p>(15 USC § 1116-1118)</p> <ul style="list-style-type: none"> <li>• relief in civil action for violation: temporary restraining orders, preliminary and permanent injunctions, recall, damages, profits, costs and attorney's fees; seizure and impoundment; and destruction.</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>(Clause 21)</p> <ul style="list-style-type: none"> <li>order for delivery up of infringing goods, material or articles in one's possession, custody or control in the course of trade or business.</li> </ul> <p>(Clause 23)</p> <ul style="list-style-type: none"> <li>order for disposal where order for delivery up applicable.</li> </ul> <p><u>Comment</u> The civil remedies available in the trade mark laws under comparison all seek to conform with the basic requirements stipulated under the Agreement on Trade-Related Aspects of Intellectual Property Rights under the WTO.</p>	<p>infringing goods, material or articles in one's possession, custody or control in the course of a business.</p> <p>(S.19)</p> <ul style="list-style-type: none"> <li>order for disposal where order for delivery up applicable.</li> </ul>		<p>(15 USC 1125(2))</p> <ul style="list-style-type: none"> <li>in civil action under famous mark provision, only injunction is available unless defendant intended to trade on owner's reputation or to cause dilution of the famous mark.</li> </ul>
Rights of licensees	<p>(Clause 33)</p> <ul style="list-style-type: none"> <li>licensee can by notice in writing call on owner of trade mark to take</li> </ul>	<p>(S.30)</p> <ul style="list-style-type: none"> <li>licensee can call on proprietor of trade mark to take infringement</li> </ul>	<p>(S.26)</p> <ul style="list-style-type: none"> <li>subject to any agreement between the registered owner of the trade mark</li> </ul>	Not specifically stipulated.

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>infringement proceedings.</p> <ul style="list-style-type: none"> <li>where owner refuses, or fails to take action within <u>one</u> month, licensee may bring action in his own name as if he were owner.</li> </ul> <p><u>Comment</u></p> <p>The rights of the licensees are specifically defined in the HK, UK and Australian trade mark laws.</p>	<p>proceedings.</p> <ul style="list-style-type: none"> <li>if proprietor refuses, or fails to do so within <u>two</u> months, licensee may bring action in his own name as if he were proprietor.</li> </ul>	<p>and the authorised user:</p> <ul style="list-style-type: none"> <li>authorised user may use trade mark re goods/services covered by trade mark registration subject to any conditions/limitations on the registration.</li> <li>may bring action for infringement if owner refuses/neglects to do so within prescribed period.</li> <li>may cause to be displayed on goods covered by trade mark registration or on packaging, a notice prohibiting any act specified under S.121(2). (see infringing acts' above)</li> <li>may give notice to Comptroller objecting to importation of infringing goods.</li> <li>may give permission to any person to apply the trade mark to, or in relation to, the registered goods or services.</li> </ul>	

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
Exclusive licensees	<p>(Clause 32)</p> <ul style="list-style-type: none"> <li>where an exclusive licence provides rights to a licensee as if licence is an assignment, exclusive license may have same rights as in an assignment.</li> </ul> <p>(Clause 34)</p> <ul style="list-style-type: none"> <li>exclusive licensee entitled to bring infringement proceedings in his own name; his rights and remedies are concurrent with those of the owner of the registered trade mark.</li> </ul> <p><u>Comment</u></p> <p>The treatment is not uniform among the jurisdictions under comparison. This clause is added in the Bill for the avoidance of doubt.</p>	<p>(S.31)</p> <ul style="list-style-type: none"> <li>where an exclusive licence provides rights to a licensee as if licence is an assignment, exclusive licensee may have same rights as in an assignment.</li> <li>if same rights as an assignee, exclusive licensee entitled to bring infringement proceedings in his own name; his rights and remedies are concurrent with those of the proprietor of the registered trade mark.</li> </ul>	Not specifically stipulated.	Not specifically stipulated.

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
Defensive trade mark	<p>(Clause 58)</p> <ul style="list-style-type: none"> <li>• if a registered trade mark has become well-known through use and if as a result its use on other goods/services would detract from distinctive character, such trade mark may be registered as a defensive trade mark in respect of any or all of other goods/services.</li> <li>• even if owner of defensive trade mark does not use or intend to use trade mark re those goods/services.</li> <li>• defensive trade mark may later be registered by same owner as trade mark.</li> </ul> <p><u>Comment</u></p> <p>There is no standard treatment of “defensive marks” in the jurisdictions under comparison. The provisions in the Bill</p>	UK does not have defensive trade mark.	<p>(Part 17, Ss.184-189)</p> <ul style="list-style-type: none"> <li>• if due to extent of use of a registered trade mark re goods/services covered by registration, it is likely that use of the trade mark in relation to other goods/services will be taken to indicate there is a connection between those goods/services and the registered owner of the trade mark, a defensive trade mark may be registered in respect of any or all of those other goods/services.</li> <li>• may be registered as trade mark as well as defensive trade mark.</li> </ul>	Not specifically stipulated.

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>serve as an additional means of protection for well-known or famous marks against dilution of their distinctive character.</p>			
Collective mark	<p>(Clause 59 &amp; Schedule 1)</p> <ul style="list-style-type: none"> <li>• sign which distinguishes goods/ services of members of an association, which is owner of the sign, from those of other undertakings.</li> <li>• may consist of signs which designate geographical origin of goods/services subject to use by others of such sign in accordance with honest practices in industrial or commercial matters.</li> <li>• collective mark not to be registered if misleading as to character or significance of mark.</li> <li>• applicant must file regulations re use of</li> </ul>	<p>(S.49 &amp; Schedule 1)</p> <ul style="list-style-type: none"> <li>• collective mark is one that distinguishes goods/ services of members of an association, which is proprietor of the mark, from those of other undertakings.</li> <li>• may consist of signs which designate geographical origin of goods/services subject to use by others of such sign in accordance with honest practices in industrial or commercial matters.</li> <li>• collective mark not to be registered if misleading as to character or significance of mark.</li> <li>• applicant must file regulations re use of collective mark.</li> </ul>	<p>(Part 15, Ss.161-167)</p> <ul style="list-style-type: none"> <li>• sign used/intended to be used by members of an association to distinguish goods/services provided by them in the course of trade from persons who are not members of the association.</li> <li>• collective trade mark may not be assigned or transmitted.</li> <li>• in action by association for infringement, the association may take into account any damage or loss of profits sustained by members by the infringement.</li> </ul>	<p>(15 USC § 1127)</p> <ul style="list-style-type: none"> <li>• means a trade mark/service mark used by members of a cooperative, association or other collective group or organisation, or which such body has a bona fide intention to use in commerce.</li> <li>• includes marks indicating membership in a union, an association or other organisation.</li> </ul> <p>(15 USC § 1054)</p> <ul style="list-style-type: none"> <li>• registrable by persons, nations, states, municipalities, etc exercising legitimate control over use of marks sought to be registered even though no industrial or commercial establishment.</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>collective mark.</p> <ul style="list-style-type: none"> <li>• where the owner of a registered collective mark brings infringement proceedings, any loss suffered or likely to be suffered by authorised users shall be taken into account.</li> <li>• a collective mark may be revoked , <i>inter alia</i>, on the ground that the regulations have not been observed.</li> </ul> <p><u>Comment</u></p> <p>The concept of a "collective mark" is recognized in all jurisdictions under comparison.</p>	<ul style="list-style-type: none"> <li>• where the owner of a registered collective mark brings infringement proceedings, any loss suffered or likely to be suffered by authorised users shall be taken into account.</li> <li>• a collective mark may be revoked , <i>inter alia</i>, on the ground that the regulations have not been observed.</li> </ul>		
Certification mark	<p>(Clause 60 &amp; Schedule 2)</p> <ul style="list-style-type: none"> <li>• sign which indicates goods/services are certified by owner of sign re certain characteristics. (i.e. origin, material, mode of manufacture,</li> </ul>	<p>(S.50 &amp; Schedule 2)</p> <ul style="list-style-type: none"> <li>• mark which indicates goods/services are certified by proprietor of mark re certain characteristics. (i.e. origin, material, mode of manufacture, quantity,</li> </ul>	<p>(Part 16, S.168-183)</p> <ul style="list-style-type: none"> <li>• sign used/intended to be used to distinguish goods/services in the course of trade and certified by a person re certain characteristics, from goods/services not</li> </ul>	<p>(15 USC § 1127)</p> <ul style="list-style-type: none"> <li>• to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of goods/services provided by</li> </ul>

Issue	HK Trade Marks Bill 1999	UK Trade Marks Act 1994	Australian Trade Marks Act 1995	US Lanham Act 1946 (15 USC§1050 <i>et seq</i> ) (as amended)
	<p>quantity, accuracy etc.)</p> <ul style="list-style-type: none"> <li>• may consist of signs which designate geographical origin of goods/services subject to use by others of such sign in accordance with honest practices in industrial or commercial matters.</li> <li>• not to be registered if misleading as to character or significance of mark.</li> <li>• an applicant must file regulations governing use of the mark.</li> <li>• a certification mark may be revoked, <i>inter alia</i>, on the ground that the regulations have not been observed.</li> </ul> <p><u>Comment</u></p> <p>The concept of a "certification mark" is recognized in all jurisdictions under comparison.</p>	<p>accuracy etc.)</p> <ul style="list-style-type: none"> <li>• may consist of signs which designate geographical origin of goods/services subject to use by others of such sign in accordance with honest practices in industrial or commercial matters.</li> <li>• shall not be registered if public liable to be misled as to character or significance of mark.</li> <li>• applicant must file regulations governing use of the mark.</li> <li>• a certification mark may be revoked, <i>inter alia</i>, on the ground that the regulations have not been observed.</li> </ul>	<p>so certified.</p> <ul style="list-style-type: none"> <li>• rules governing use of certification trade mark must be filed.</li> <li>• application to be scrutinised by Registrar and the Trade Practices Commission ("Commission")</li> <li>• certification trade mark may only be assigned with consent of the Commission.</li> </ul>	<p>members of a union/organisation.</p> <ul style="list-style-type: none"> <li>• means any word, name, symbol, or device or any combination thereof used by a person other than its owner, or which its owner bona fide intends to permit a person other than the owner himself to use in commerce.</li> </ul> <p>(15 USC § 1054)</p> <ul style="list-style-type: none"> <li>• registrable by persons, nations, states, municipalities, etc exercising legitimate control over use of marks sought to be registered even though no industrial or commercial establishment.</li> </ul> <p>(15 USC § 1064)</p> <ul style="list-style-type: none"> <li>• liable to cancellation if control not exercised (see section on 'Revocation', <i>supra</i>)</li> </ul>

Note

While every effort has been made to ensure accuracy in excerpting and explaining the trade mark laws in other jurisdictions, and in some cases where confirmation has also been sought from the relevant competent authorities, please note that the comparison above does not have the approval of the legal and judicial authorities in these jurisdictions. Please also note that in order to maintain accuracy in our comparison, we have not attempted to provide a Chinese translation of these foreign trade mark laws.

[d1\18\tmlaws]