

Bills Committee on Trade Marks Bill

Section 42 of the US Lanham Act

Introduction

As requested by the Bills Committee at its meeting on 26 February 2000, this note sets out our understanding of section 42 of the US Lanham Act.

Section 42 of the US Lanham Act

2. Section 42 of the Lanham Act (15 USC Sec 1124) provides that, with the exception of goods imported for personal use -

“No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer ... or which shall copy or simulate a trade mark registered in accordance with the provisions of this chapter or bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States ... shall be admitted to entry at any customhouse of the United States”.

3. Under the Lanham Act, the goods so detained would be released upon the importer showing that -

- (a) the trade mark was applied under the authority of the US trademark owner, a parent or subsidiary of the US owner, or a party otherwise subject to common ownership or control with the US owner, and that the merchandise as imported is not physically and materially different from articles authorized by the US owner for importation or sale in the US; or

- (b) the merchandise or its packaging bears a conspicuous and legible label designed to remain on the product until the first point of sale to a retail consumer in the US stating, that “This product is not a product authorized by the United States trade mark owner for importation and is physically and materially different from the authorized product.”

4. Owners of US trade marks who wish to obtain protection against imports on the basis of physical and material difference would need to submit certain information to US Customs, including a description of any physical and material difference between the specific articles authorised for importation or sale in the US and those not so authorised. In each instance, trade mark owners who assert that physical and material differences exist must state the basis for such a claim with particularity, and must support such assertions by competent evidence and provide summaries of physical and material differences for publication.

Trade and Industry Bureau
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