

Table of Comparison of HK & UK Trade Mark Laws

Issue	HK Trade Marks Ordinance (Cap. 559)	UK Trade Marks Act 1994
Definition of “trade mark”	<p>(S.3(1))</p> <ul style="list-style-type: none"> ● any sign capable of distinguishing goods/services of one undertaking from others; capable of graphic representation. <p>(S.3(2))</p> <ul style="list-style-type: none"> ● may consist of words, indications, designs, letters, characters, numerals, figurative elements, colours, sounds, smells, shape of goods, packaging, or combination of above <p><u>Comment</u> Similar in scope with the UK trade mark law.</p>	<p>(S.1)</p> <ul style="list-style-type: none"> ● any sign capable of being represented graphically; capable of distinguishing goods/services of one undertaking from others. ● may consist of words (including personal names), designs, letters, numerals or shape of goods or their packaging.
“Well known mark”	<p>(S.4, Schedule 2)</p> <ul style="list-style-type: none"> ● 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. <p><u>Comment</u> Schedule 2 to the Hong Kong Trade Marks Ordinance contain a non-exhaustive list of factors for determining whether a trade mark is well-known in Hong Kong.</p>	<p>(S.56)</p> <ul style="list-style-type: none"> ● 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.

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Absolute grounds for refusal	<p>(S.11)</p> <ul style="list-style-type: none"> ● if sign does not satisfy requirements for a trade mark under S.3(1). ● signs which are devoid of distinctive character. ● signs which serve in trade or business to designate the kind, quality, quantity, intended purpose, value, geographical origin, etc of goods/services. ● signs customary in current language or honest, established practice of trade. ● shape resulted from nature of goods. ● shape necessary to obtain technical result. ● shape giving substantial value to goods. ● Contrary to principles of morality or likely to deceive the public. ● if use is prohibited by law in HK. ● if application made in bad faith. ● a mark consisting of the national flag, national emblem, regional flag or regional emblem. <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 UK.</p>	<p>(S.3)</p> <ul style="list-style-type: none"> ● if sign does not satisfy requirements for a trade mark under S.1(1). ● signs which are devoid of distinctive character. ● signs which serve in trade to designate kind, quality, quantity, intended purpose, value, geographical origin, etc of goods/services. ● signs customary in current language or honest, established practice of trade. ● shape resulted from nature of goods. ● shape necessary to obtain technical result. ● shape giving substantial value to goods. ● contrary to public policy or principles of morality or likely to deceive the public. ● if use is prohibited by law in UK. ● if application made in bad faith. <p>(S.4)</p> <ul style="list-style-type: none"> ● 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.

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Relative grounds for refusal	<p>(S.12) If subject mark is :</p> <ul style="list-style-type: none"> ● identical to earlier trade mark; identical goods/services. ● Identical to earlier trade mark; similar goods/services; likelihood of confusion. ● similar to earlier trade mark; identical or similar goods/services; likelihood of confusion. ● Identical/similar to earlier trade mark; dissimilar goods/services; if earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark and use of later mark would take unfair advantage of or be detrimental to distinctive character or repute of earlier trade mark. ● 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. ● may be registrable on consent of owner of earlier trade mark . <p><u>Comment</u> The “relative grounds for refusal” set out the conditions under which a trade mark registration will be refused, mainly because of conflicts with earlier registered marks. Similar restrictions are also found in the UK.</p>	<p>(S.5)</p> <ul style="list-style-type: none"> ● identical with earlier trade mark; identical goods/services. ● identical with earlier trade mark; similar goods/services; likelihood of confusion including likelihood of association. ● similar to earlier trade mark; identical/similar goods/services; likelihood of confusion including likelihood of association. ● 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 repute of earlier trade mark. ● 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. If applicant shows honest concurrent use, this objection can only be raised in opposition proceedings (S.7(2)). ● may be registrable on consent of owner of earlier trade mark.

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Infringement	<p>(S.18)</p> <ul style="list-style-type: none"> ● use of identical sign; identical goods/services in course of trade or business. ● use of identical sign; similar goods or services in course of trade or business; likely to cause confusion. ● use of similar sign; identical or similar goods in course of trade or business; likely to cause confusion. ● use of identical or similar sign; dissimilar goods or services; in the course of trade or business; registered mark is entitled to protection under the Paris Convention as a well-known trade mark; use of sign takes unfair advantage of or is detrimental to distinctive character or repute of trade mark. <p>(S.6)</p> <ul style="list-style-type: none"> ● “use” of a trade mark or sign includes any use whether by means of graphic representation or otherwise. <p>(S.7)</p> <ul style="list-style-type: none"> ● 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. <p><u>Comment</u> We follow the language of the UK law closely.</p>	<p>(S.10)</p> <ul style="list-style-type: none"> ● use of identical sign; identical goods/services in the course of trade. ● use of identical sign; similar goods/services in the course of trade; likely to cause confusion including likelihood of association. ● 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 distinctive character or repute of trade mark. <p>S.103(2)</p> <ul style="list-style-type: none"> ● “use” of a trade mark includes use otherwise than by means of a graphic representation.

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Exceptions to Infringement	<p>(S.21)</p> <ul style="list-style-type: none"> ● 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 (may take into account relevant factors including whether use takes unfair advantage of or is detrimental to distinctive character or repute of trade mark or whether use is such as to deceive the public). <p>(S.19(3))</p> <ul style="list-style-type: none"> ● use by a person of own name or address. ● use by a person of name, or name of place of business, of his predecessor in business. ● use of signs re characteristics of goods/services. ● use where necessary to indicate intended purpose of goods/services. <p>if accords with honest practices in industrial or commercial matters.</p> <ul style="list-style-type: none"> ● 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. <p><u>Comment</u> The concept of “fair” or “honest” use is common to both HK and UK trade mark laws.</p>	<p>(S.10(6))</p> <ul style="list-style-type: none"> ● 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. <p>(S.11(2))</p> <ul style="list-style-type: none"> ● use by a person of own name or address. ● use of indications re characteristics of goods/services. ● use where necessary to indicate the intended purpose of a product/service. <p>if accords with honest practices in industrial or commercial matters.</p> <ul style="list-style-type: none"> ● “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.

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Exhaustion of rights (Parallel imports)	<p>(S.20)</p> <ul style="list-style-type: none"> where goods have been put on market anywhere in the world under trade mark, by owner or with his consent (save where conditions of the goods have changed or are impaired). <p><u>Comment</u> 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>(S.12)</p> <ul style="list-style-type: none"> where goods have been put on market in the European Economic Area under that trade mark by the proprietor or with his consent (except where legitimate reasons exist for proprietor to oppose further dealings in the goods e.g. condition of goods have changed or are impaired).
Remedies/relief for infringement	<p>(S.22)</p> <ul style="list-style-type: none"> damages, injunctions, accounts or otherwise as for infringement of any other property right. <p>(S.25(4))</p> <ul style="list-style-type: none"> inserted as result of Article 46 of TRIPS Agreement. <p>(S.23)</p> <ul style="list-style-type: none"> order for delivery up of infringing goods, material or articles in one's possession, custody or control in the course of trade or business. <p>(S.25)</p> <ul style="list-style-type: none"> order for disposal where order for delivery up applicable. <p><u>Comment</u> The civil remedies available in HK and UK trade mark laws all seek to conform with the basic requirements stipulated under the Agreement on Trade-Related Aspects of Intellectual Property Rights under WTO.</p>	<p>(S.14(2))</p> <ul style="list-style-type: none"> damages, injunctions, accounts or otherwise as for infringement of any other property right. <p>(S.15)</p> <ul style="list-style-type: none"> order for erasure. <p>(S.16)</p> <ul style="list-style-type: none"> order for delivery up of infringing goods, material or articles in one's possession, custody or control in the course of a business. <p>(S.19)</p> <ul style="list-style-type: none"> order for disposal where order for delivery up applicable.

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Rights of licensees	<p>(S.35)</p> <ul style="list-style-type: none"> ● licensee can by notice in writing call on owner of trade mark to take infringement proceedings. ● 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. <p><u>Comment</u> The rights of the licensees are specifically defined in the HK and UK trade mark laws.</p>	<p>(S.30)</p> <ul style="list-style-type: none"> ● licensee can all on proprietor of trade mark to take infringement proceedings. ● 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.
Exclusive licensees	<p>(S.34)</p> <ul style="list-style-type: none"> ● 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. <p>(S.36)</p> <ul style="list-style-type: none"> ● 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. 	<p>(S.31)</p> <ul style="list-style-type: none"> ● 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. ● 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.

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Defensive trade mark	<p>(S.60)</p> <ul style="list-style-type: none"> ● if a registered trade mark has become exceptionally well-known in Hong Kong 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. ● even if owner of defensive trade mark does not use or intend to use trade mark re those goods/services ● defensive trade mark may later be registered by same owner as trade mark. <p><u>Comment</u></p> <p>The provisions serve as an additional means of protection for well-known or famous marks against dilution of their distinctive character.</p>	UK does not have defensive trade mark.

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Collective mark	<p>(S.61 & Schedule 3)</p> <ul style="list-style-type: none"> ● sign which distinguishes goods/services of members of an association, which is owner of the sign, from those of other undertakings. ● 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. ● collective mark not to be registered if misleading as to character or significance of mark. ● applicant must file regulations re use of collective mark. ● 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. ● a collective mark may be revoked, <i>inter alia</i>, on the ground that the regulations have not been observed. <p><u>Comment</u> The concept of a collective mark is recognized in both HK and UK trade mark laws.</p>	<p>(S.49 & Schedule 1)</p> <ul style="list-style-type: none"> ● collective mark is one that distinguishes goods/services of members of an association, which is proprietor of the mark, from those of other undertakings. ● 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. ● collective mark not to be registered if misleading as to character or significance of mark. ● applicant must file regulations re use of collective mark. ● 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. ● a collective mark may be revoked, <i>inter alia</i>, on the ground that the regulations have not been observed.

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Certification mark	<p>(S.62 & Schedule 4)</p> <ul style="list-style-type: none"> ● sign which indicates goods/services are certified by owner of sign re certain characteristics (i.e. origin, material, mode of manufacture, quality, accuracy etc.). ● 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. ● not to be registered if misleading as to character or significance of mark. ● an applicant must file regulations governing use of the mark. ● a certification mark may be revoked, <i>inter alia</i>, on the ground that the regulations have not been observed. <p><u>Comment</u> The concept of a “certification mark” is recognized in both HK and UK trade mark laws.</p>	<p>(S.50 & Schedule 2)</p> <ul style="list-style-type: none"> ● mark which indicates goods/services are certified by proprietor of mark re certain characteristics (i.e. origin, material, mode of manufacture, quality, accuracy etc.). ● 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. ● shall not be registered if public liable to be misled as to character or significance of mark. ● applicant must file regulations governing use of the mark. ● a certification mark may be revoked, <i>inter alia</i>, on the ground that the regulations have not been observed.

Note

While every effort has been made to ensure accuracy in excerpting and explaining the trade mark law in the UK, please note that the comparison above does not have the approval of the legal and judicial authorities in the UK. Please also note that in order to maintain accuracy in our comparison, we have not attempted to provide a Chinese translation of the UK trade mark law.