

**Summary of Key Concepts in FWKM Law and Practices in the Region**

QUESTION	AUSTRALIA	CHINA	HONG KONG	INDONESIA	JAPAN	MALAYSIA	NEW ZEALAND	PHILIPPINES	SINGAPORE	THAILAND	VIETNAM
1. Is the concept of trade mark dilution recognised?	<b>No</b>	<b>No</b>	<b>No</b>	<b>No*</b>	<b>No</b>	<b>No</b>	<b>No</b>	<b>Yes</b>	<b>Yes</b>	<b>No</b>	<b>No</b>
2. Are there other relevant laws that can apply to reach the same conclusion as dilution?	<b>Yes</b>	<b>No</b>	<b>No</b>	N/A	<b>Yes</b>	<b>No</b>	<b>Yes</b>	N/A	N/A	<b>No</b>	<b>Yes</b>
3. Are “Letters of Protest” recognised?	<b>No</b>	<b>No</b>	<b>No</b>	<b>No</b>	<b>Yes</b>	<b>No</b>	<b>No</b>	<b>No</b>	<b>No</b>	<b>No</b>	<b>No</b>
4. Can a trade mark application be refused/ opposed on “bad faith”?	<b>Yes*</b>	<b>Yes*</b>	<b>Yes</b>	<b>Yes</b>	<b>No</b>	<b>No</b>	<b>Yes</b>	<b>No</b>	<b>Yes*</b>	<b>Yes*</b>	<b>No</b>
5. Does the Trade Marks Office consider bad faith when examining trade mark applications?	<b>No</b>	<b>No</b>	<b>Yes</b>	N/A	<b>Yes</b>	<b>No</b>	<b>No*</b>	<b>Yes</b>	<b>No*</b>	<b>No*</b>	<b>No</b>

**\*See below for detailed commentary**

Questionnaire for INTA Projects – Objectives for 2016-2017

**1. Is the concept of trade mark dilution recognised?**

<b>Australia</b>	No, not strictly. The concept of trade mark dilution is not expressly recognized. We do have well-known trade mark protection and they are granted additional protection – on the basis that owners of well-known trade marks can oppose or seek to raise infringement issues against the same or similar marks (even for different goods or services). We also permit “defensive” registration of well-known trade marks where the trade mark can be registered and relied upon in relation to goods or services for which the trade mark has not in fact been used (broadening the protection for the well-known trade mark). We also have common law rights (passing off) and statutory causes of action (consumer law, misleading and deceptive conduct) which trade mark owners can use to protect their well-known trade marks. So despite not having an express dilution of trade marks protection mechanism or recognition of the concept, avenues do exist to assist well-known trade mark owners from having their trade marks tarnished or diluted in Australia.
<b>China</b>	No
<b>Hong Kong</b>	No
<b>Indonesia</b>	Although the Trademark Law does not specifically stipulate the definition of dilution, the concept of dilution is embodied in Article 6 (2) of the Trademark Law. There is a provision for the rejection of marks on the basis of well-known marks for dissimilar goods/services.
<b>Japan</b>	No, not expressly
<b>Malaysia</b>	Attempts to argue “bad faith” as an extension of passing off did not succeed in practice
<b>New Zealand</b>	No, not expressly. However, Section 89 of the <i>Trade Marks Act 2002</i> recognises that infringement may occur in relation to the unauthorized use of a mark that is identical/similar to a registered trade mark used in relation to goods/services that are <u>not</u> similar to those for which the mark is registered, if “ <i>the trade mark is well known in New Zealand and the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark</i> ”. The breadth of this section potentially gives scope for dilution to be argued in an appropriate case, under New Zealand law.
<b>Philippines</b>	Yes
<b>Singapore</b>	Yes
<b>Thailand</b>	No
<b>Vietnam</b>	No, Vietnam does not recognize trade mark dilution <i>per se</i> , but has its own similar concept “prejudice the distinctiveness” of a well-known mark. The purpose of such concept is to protect a well-known mark from subsequent marks that may be confusingly similar or identical, regardless of the goods and/or services associated with the allegedly diluting mark.

## 2. Are there often relevant laws that can apply to reach the same conclusion as dilution?

<b>Australia</b>	Yes, see Section 1 above.
<b>China</b>	No
<b>Hong Kong</b>	<p>The concept of “dilution” is not included in our trade mark legislation (Trade Marks Ordinance and Trade Marks Rules).</p> <p>In one recent case, the Court of Final Appeal in Hong Kong considered the concept of “dilution” in the sense of “gradual whittling away or dispersion of the identity and hold upon the public mind of the trade mark by its use upon non-competitive goods, which has led to unfair competition by other traders, albeit without the likelihood of consumers being confused or deceived”. In this case, the Court concluded that “there is no occasion in Hong Kong to introduce such a concept of “dilution” into the common law tort of passing-off.” See <i>TWG TEA CO PTE LTD AND ANOTHER v. TSIT WING (HONG KONG) CO LTD AND OTHERS (FACV15/2015)</i></p> <p>“Deception or confusion” on the part of the public therefore remains to be an essential element of the tort of “passing off”, as well as an essential element in determination of infringement of registered trade mark.</p>
<b>Indonesia</b>	No
<b>Japan</b>	<p>Yes. Section 2-1-2 of Unfair Competition Prevention Act provides that:</p> <p><i>The term “unfair competition” as used in this Act means any of the following:</i></p> <p><i>(ii) the act of using an indication of goods or business that is identical or similar to another person's famous indication of goods or business as one's own, or of assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing, or providing through a telecommunications line goods that use such an indication;</i></p>
<b>New Zealand</b>	Yes – refer to comments above in relation to Section 89 of the <i>Trade Marks Act 2002</i> . Furthermore, the <i>Fair Trading Act 1986</i> prohibits conduct that is misleading or deceptive or is likely to mislead or deceive and also deems unlawful any misrepresentations that suggest that goods or services have any sponsorship, approval, endorsement or affiliation.
<b>Philippines</b>	No
<b>Singapore</b>	No
<b>Vietnam</b>	<p>Yes, the IP Law (Article 74.2(i)) includes a provision for protection of a well-known trade mark against registration or use of identical or confusingly similar subsequent marks for identical or similar goods or services, or for goods or services that are not identical, similar or related to those bearing such well-known mark, provided that:</p> <ul style="list-style-type: none"> <li>(i) There is a likelihood of confusion about the origin of goods or services, or about the connection between the entity using the subsequent mark and the owner of the well-known trademark; or</li> <li>(ii) The use of such mark may prejudice the distinctiveness of the well-known mark or aims at taking advantage of the reputation of the well-known mark.</li> </ul>

### 3. Are “Letters of Protest” recognised?

<b>Australia</b>	No
<b>China</b>	No
<b>Hong Kong</b>	There is no express provision for “Letter of Protest” practice in our trade mark legislation.
<b>Indonesia</b>	Indonesia does not recognize the concept of Letter of Protest in IP Laws.
<b>Japan</b>	Yes
<b>New Zealand</b>	No
<b>Philippines</b>	No
<b>Malaysia</b>	No
<b>Thailand</b>	No
<b>Singapore</b>	No
<b>Vietnam</b>	No. The concept of “Letter of Protest” is not recognized in Vietnam’s IP Law.

#### 4. Can a trade mark application be refused/opposed on “bad faith”?

<b>Australia</b>	Yes, but only during opposition, not examination. There is an express ground of bad faith as an opposition ground.
<b>China</b>	Bad faith will only be considered during opposition or invalidation cases in China.
<b>Hong Kong</b>	Yes, section 11(5)(b) Trade Marks Ordinance provides that bad faith is one of the absolute grounds for refusal of registration and section 53(2) Trade Marks Ordinance stipulates that “ <i>in the case of bad faith in the registration of a trade mark, the Registrar himself may apply to the court for a declaration of the invalidity of the registration.</i> ”
<b>Indonesia</b>	An application for trade mark can be refused solely on bad faith in Indonesia. However, at the examination stage, in practice this is very rare and is usually associated in cases which involve well known trade marks that are easily recognized by the Trademarks Office.
<b>Japan</b>	No
<b>New Zealand</b>	Yes, both during examination and in opposition. However, whilst it is strictly possible for IPONZ to raise a bad faith ground during examination of a trade mark application, this is exceedingly rare ever to occur. The “bad faith” ground for rejection of a trade mark will most often occur during opposition in New Zealand.
<b>Philippines</b>	No
<b>Singapore</b>	Yes, a mark may be opposed on the ground of “bad faith”. Whilst it is theoretically possible for this to occur during examination, it is highly unlikely ever to occur.
<b>Vietnam</b>	No, bad faith by itself is not considered to be a direct ground for oppositions or cancellations but its similar concept “dishonesty” may serve as an indirect factor in some cases.
<b>Malaysia</b>	No
<b>Thailand</b>	Yes. A trade mark application may be opposed in Thailand on “bad faith” grounds, on the basis that the application is contrary to “public order, morality or public policy”.

## 5. Does the Trade Marks Office consider bad faith when examining trade mark applications?

<b>Australia</b>	No. Only at the Opposition stage or following.
<b>China</b>	No
<b>Hong Kong</b>	<p>Yes, the Registrar may consider bad faith when examining trade mark applications.</p> <p>The Hong Kong Intellectual Property Department (HKIPD) provides in the Trade Marks Registry Work Manual that although objections based on bad faith are more likely to be raised by a third party in opposition or invalidation proceedings than at the examination stage, it is appropriate for the Registry to raise an objection if the circumstances of the application give rise to a reasonable suspicion of the applicant's entitlement to the mark or the honesty of his intention.</p> <p>The HKIPD provides some examples regarding reasonable suspicion:</p> <ul style="list-style-type: none"> <li>• <i>“the mark is generally known to be the trade mark of a particular company, entity or individual, and the applicant has not submitted information to show a relationship between the applicant and the generally known owner of the trade mark;”</i></li> <li>• <i>the applicant has simultaneously filed a number of applications for registration of different trade marks, one or more of which is generally known to be the trade mark of a particular company, entity or individual, and there is no information in the applications showing the relationship between the applicant and the generally known owner of the trade mark; or</i></li> <li>• <i>the mark incorporates the name or image of a well-known person without his or her agreement, the registrar may raise an objection on the ground that the application is made in bad faith. The applicant may overcome the objection by providing material to show that he is entitled to apply for registration, such as a written endorsement of the owner of the trade mark in question.”</i></li> </ul>
<b>Indonesia</b>	No
<b>Japan</b>	<p>Yes. Section 4-1-19 of Trademark Act prohibits registration of a mark that is:</p> <ol style="list-style-type: none"> <li>a) identical or similar to other person's well-known mark; and</li> <li>b) used in bad faith.</li> </ol> <p>Here, “bad faith” refers to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes.</p>
<b>New Zealand</b>	Whilst IPONZ <i>can</i> consider bad faith when examining a trade mark application, this is very uncommon in practice. Nonetheless in an appropriate case it is at least possible for IPONZ to raise bad faith as a relevant opposition ground.

## 5. Does the Trade Marks Office consider bad faith when examining trade mark applications?

<b>Philippines</b>	Yes. It can be presumed that bad faith is present in identical marks. Hence, when the trade mark is undergoing merit examination and the Examiner finds that a mark is identical to a registered mark belonging to a different proprietor or a mark with an earlier filing date, the Examiner will issue an Office Action addressed to the applicant of the mark stating therewith that the registration of the mark may not be granted as it is identical to an existing registered mark. The applicant has two months within which to file a response to Examiner's action.
<b>Singapore</b>	Not as standard practice. Typically bad faith only features at the opposition stage as one of the possible grounds of opposition.
<b>Malaysia</b>	No
<b>Thailand</b>	In theory, it is possible for the Registrar to reject an application solely on the grounds that it was filed in bad faith before the opposition period. However, the Registrar rarely refuses registration of a trademark solely on such grounds, because the Registrar does not have such knowledge or information
<b>Vietnam</b>	No, bad faith is not considered when examining trademark applications. The concept is only used as an indirect ground in opposition or cancellation proceedings.