



ICLG

The International Comparative Legal Guide to:

Trade Marks 2015

4th Edition

A practical cross-border insight into trade mark work

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EDITORIAL

Welcome to the fourth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

One general chapter entitled “BRIC Economies: Another BRIC in the Wall of Global IP Standards?”.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 42 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord (UK) LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The International Comparative Legal Guide series is also available online at www.iclg.co.uk.

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Macau

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1 Relevant Authorities and Legislation

1.1 What is the relevant Macanese trade mark authority?

The Economic Services Bureau.

1.2 What is the relevant Macanese trade mark legislation?

The Industrial Property Legal Act, approved by Decree-Law no. 97/99/M, of 13 December.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Macau allows the registration of signs or a group of signs able to differentiate an enterprise's goods or services, provided that they can be represented graphically, namely:

- **product trademarks** identifying products or their packaging;
- **service trademarks** identifying services rendered or the service provider;
- **association trademarks** identifying a specific sign that belongs to an association of individuals or corporations;
- **certification trademarks** identifying a specific sign that belongs to a corporation that controls products or services or that enacts the regulations that such products or services must comply with;
- **three-dimensional trademarks** based on the three-dimensional appearance of the product or its container;
- **sound trademarks** – a type of non-physical trademark that uses a specific type of sound and is represented by means of distinctive tones or strings of tones;
- **motion trademarks** based on a specific motion;
- **combination colour trademarks** derived from a specific and distinctive application and combination of colors; and
- **trade dress**.

2.2 What cannot be registered as a trade mark?

Smell, taste and touch cannot be registered as they cannot be graphically represented.

2.3 What information is needed to register a trade mark?

- 1 **Applicant information** – name, nationality/place of incorporation and address.
- 2 **Trademark** – electronic (JPEG) representation (contact us for non-traditional).
- 3 **Class(es)** – a list of products/services and international classification in detail.
- 4 **Power of attorney** – notarised and one per application.
- 5 **Priority** – if claimed – priority filing date, number and country. A certified copy needs to be filed within the three months that follow the application.

2.4 What is the general procedure for trade mark registration?

After the submission of an application that fulfils all the requirements mentioned in question 2.3 above, a formal examination is carried out, and if the Registrar has no concerns then publication occurs within one month. After publication, third parties have two months to oppose. If no opposition is raised then the Registrar conducts a substantive examination and grants the trademark if he has no concerns. The grant is published and third parties have one month to file a judicial appeal of the grant. If no appeal is filed the trademark certificate is printed and handed over within 10 days.

2.5 How can a trade mark be adequately graphically represented?

A nominative mark is graphically represented by the word that composes the mark. A figurative mark is graphically represented by the image that composes the mark. A mix mark is graphically represented by the word(s) and image that compose the mark.

It is understood that to fulfil this requirement the mark must be clear, precise, complete in itself, easily accessible, lasting and objective, so that from the registration one can determine its exact nature. Sound marks are represented by “musical phrases” and the application must contain the digital sound file.

2.6 How are goods and services described?

By either following the Nice Classification or explaining in more detail the goods and services covered.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a Macanese trade mark?

Just Macau SAR.

2.8 Who can own a Macanese trade mark?

A legal person or an individual.

2.9 Can a trade mark acquire distinctive character through use?

Yes, it can.

2.10 How long on average does registration take?

Nine months.

2.11 What is the average cost of obtaining a Macanese trade mark?

The official fee is US\$130.

2.12 Is there more than one route to obtaining a registration in Macau?

No, there is not.

2.13 Is a Power of Attorney needed?

Yes, duly notarised. Legalisation is advised.

2.14 How is priority claimed?

By making reference to the priority in the application and by submitting the priority document within three months after the filing of the application.

2.15 Does Macau recognise Collective or Certification marks?

Yes, it does.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

Marks that are composed exclusively by generic, descriptive, usual or weak elements. Colours, except if combined in a peculiar and distinctive manner with each other or with graphics, words or other elements.

3.2 What are the ways to overcome an absolute grounds objection?

None, if the mark suffers from the said absolute grounds of objection.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal of registration can be appealed to the Court of First Instance.

3.4 What is the route of appeal?

An appeal may be filed with the Court of First Instance. The Court of First Instance will notify the Registrar, informing it of the appeal filed, and request that the case file is sent to the Court and allow 30 days for the Registrar to answer the appeal file, if it wishes to do so. The judgment of the Court of First Instance can be appealed to the Court of Second Instance.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

Whenever one of the general grounds of refusal occurs; the mark is a reproduction, in whole or in part, of a notorious mark if applied to identical or similar products and may be confused with the latter or those products may establish a relationship with the owner of the notorious mark; the mark, although covering products and services not related, represents a reproduction, imitation or translation of a previous mark that is prestigious in Macau and whenever the use of the later mark aims to take undue advantage of the distinctive character or prestige of the trademark or may harm it; whenever the signs may induce the public in error, namely in regards to its nature, qualities, utility or the geographical origin of the product and service that the mark covers; reproduction or imitation of an earlier registered trademark by a third party, for identical or similar products, that may cause error or confusion to consumers or that comprises the risk of association with the registered mark; medals, prizes, rewards, surnames, titles and honours; or reproduction of the trade name of a third party even if not incorporated in Macau.

4.2 Are there ways to overcome a relative grounds objection?

None, if the mark suffers from the said relative grounds of objection.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal may be made to the Court of First Instance.

4.4 What is the route of appeal?

An appeal may be filed with the Court of First Instance. The Court of First Instance will notify the Registrar, informing it of the appeal filed, request that the case file is sent to the Court and allow 30 days for the Registrar to answer the appeal file, if it wishes to do so. The judgment of the Court of First Instance can be appealed to the Court of Second Instance.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

On any of the absolute and relative grounds mentioned above.

5.2 Who can oppose the registration of a Macanese trade mark?

A third party that owns a prior mark or application or is using a notorious mark in Macau.

5.3 What is the procedure for opposition?

Filing an opposition with the Registrar within two months of publication of the trademark.

6 Registration

6.1 What happens when a trade mark is granted registration?

A publication of the grant is made and the one-month appeal period starts.

6.2 From which date following application do an applicant's trade mark rights commence?

From the date of grant. However, an applicant can oppose third party application trademarks filed after the application was filed or after the date of priority claimed.

6.3 What is the term of a trade mark?

Seven years after grant.

6.4 How is a trade mark renewed?

By submitting an application to renew together with a trademark certificate.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, they can.

7.2 Are there different types of assignment?

No, there are not.

7.3 Can an individual register the licensing of a trade mark?

Yes, they can.

7.4 Are there different types of licence?

No, there are not.

7.5 Can a trade mark licensee sue for infringement?

Yes, they can.

7.6 Are quality control clauses necessary in a licence?

No, they are not.

7.7 Can an individual register a security interest under a trade mark?

No, they cannot.

7.8 Are there different types of security interest?

No, there are not.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The object of the mark cannot be protected; public order and morals have been infringed; or infringement of the essential procedures and formalities for the grant of mark unless the mark has acquired distinctiveness through its use.

Other grounds are: if the legal provisions that determine the ownership of the industrial property right were infringed and when the rights of third parties, based on priority rights or others, have been infringed; the registration was granted without the submission of the required proof documents or authorisations; or if the mark infringes the Industrial Property Act provisions concerning relative grounds of opposition.

8.2 What is the procedure for revocation of a trade mark?

Filing of revocation procedure in the Court of First Instance.

8.3 Who can commence revocation proceedings?

Any third party, when the grounds foreseen in the first paragraph of question 8.1 above apply. For the remaining grounds, any third party that owns a previous trademark or files a trademark simultaneously with the revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

Any actions that show that the grounds are not present or that the revocation proceedings were filed by a third party without a right to do so or, in respect to some grounds, the revocation proceedings were filed after a period of five years from the grant of the trademark to be revoked.

8.5 What is the route of appeal from a decision of revocation?

An appeal to the Court of Second Instance.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

Same as above.

9.2 What is the procedure for invalidation of a trade mark?

Same as above.

9.3 Who can commence invalidation proceedings?

Same as above.

9.4 What grounds of defence can be raised to an invalidation action?

Same as above.

9.5 What is the route of appeal from a decision of invalidity?

Same as above.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

From a civil law point of view, by filing an injunction or an unfair competition lawsuit before the Court of First Instance. Criminal charges can also be filed in the Public Prosecution Office, which will file an accusation in the Court of First Instance if all elements of a crime are verified.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

On an unfair competition case the defendant has the right to file its defence. Following that, the Court will decide on the relevant facts that are deemed proven and those that need to be proven during trial. The parties can appeal from that decision to either add, eliminate or amend the list. If no appeal is filed, or after the court's decision on the appeals is made, the parties proceed to indicate the evidence and witnesses they want to file.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Yes. Whenever anyone has a grounded fear that a third party will cause serious damage to its right, they can file an unspecified preliminary

injunction requesting a Macau Court to issue a "preventive/conservation preliminary injunction" that is best-suited to ensure the effectiveness of the threatened right, namely by determining a specific conduct or absence of a conduct (cease-and-desist, for example). The plaintiff's interest in the grant of such preliminary injunction can arise either from an existing right (a registered IPR) or from a right to be granted by a lawsuit already filed or to be filed.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, by court order upon request of the opposing party.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence are presented in writing. Witnesses can be cross-examined on the matter that they have testified.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, they can.

10.7 After what period is a claim for trade mark infringement time-barred?

Five years for criminal charges. One year after knowledge of the facts on unfair competition lawsuit but not more than three years after the occurrence of the facts.

10.8 Are there criminal liabilities for trade mark infringement?

Infringement of any IPR is punishable by law. Obtaining illicit benefit for oneself or for a third party (by selling, circulating or concealing counterfeit products and being aware of that situation) within the context of an entrepreneurial activity without the consent of the holder of the IPR shall be punishable by a prison sentence or fine.

10.9 If so, who can pursue a criminal prosecution?

The owner of the IPR or the local authorities.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Injunctions.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

If the products or services are not identical or similar to the ones of the plaintiff.

11.2 What grounds of defence can be raised in addition to non-infringement?

Priority.

12 Relief

12.1 What remedies are available for trade mark infringement?

The owner of a registered IPR may oppose unauthorised use by third parties and also resort to an “*unfair competition lawsuit*” under the Commercial Code regulations (prior reputation and damage caused need to be proved). Injunctions can be filed also. Complaints can be filed with Customs and criminal charges can be filed with the Public Prosecution Office.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

All costs that were proven can be recovered if a full judgment is obtained.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Appeals can be filed from the judgment of the Court of First Instance to the Court of Second Instance. If the judgment of the Court of Second Instance is different to that of the Court of First Instance then an appeal of the judgment of the Court of Second Instance can be filed to the Court of Final Appeal.

13.2 In what circumstances can new evidence be added at the appeal stage?

It cannot.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

Filing a complaint with Customs with evidence of ownership of the infringed IPR and details of the infringing act. Customs usually takes immediate action.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in Macau?

Unregistered notorious or prestigious trademarks can be invoked as grounds of opposition, provided that with the opposition the

owner files an application to register the trademark in Macau. Unregistered marks being used in Macau for less than six months can claim priority and oppose similar or identical marks that have been applied for in the same period.

15.2 To what extent does a company name offer protection from use by a third party?

A company name can be invoked as relative grounds of opposition.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No, there are not.

16 Domain Names

16.1 Who can own a domain name?

A company incorporated in Macau or the owner of a trademark registered in Macau that will be used in the domain composition.

16.2 How is a domain name registered?

By filing an application with the appointed Macau domain name administrator with evidence of the right to register the domain.

16.3 What protection does a domain name afford *per se*?

It prevents third parties from registering a similar domain name.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

There are none.

17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.

Court of Second Appeal rulings number 461/2014, 419/2014 and 215/2014 – that refused an application by a gaming concessionaire that applied for a trademark that indicated the land in which the case was based.

17.3 Are there any significant developments expected in the next year?

No, there are not.

17.4 Are there any general practice or enforcement trends that have become apparent in Macau over the last year or so?

Macau Customs regularly assists and welcomes requests for assistance with enforcement of IP rights.



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Bruno Nunes has a Degree in Law from the Universidade Católica Portuguesa Law School and has been developing his practice mainly in the areas of commercial and corporate, intellectual property and gaming. He is a member of the APAA Design Committee and has provided assistance to European and Asian Chambers of Commerce in Hong Kong and Macau. He came to Macau in 2001 to work for the Government of Macau SAR in the Macau East Asian Games Organising Committee.



Our firm was established by professionals with FICPI, MARQUES, ECTA, AIPPI, APAA and INTA memberships and specialises in registering, licensing and protecting trademarks, designs and patents rights in Macau.

Our team comprises professionals and staff with vast knowledge and many years of experience representing international, regional and local corporations, delivering prompt and adequate solutions to all clients and being familiar with Eastern and Western cultures.

We pride ourselves in being familiar with our clients' concerns and practices so that no time is wasted and clients' needs are served.

Our services include:

- registration of IPR (trademark, invention patent, utility patent and industrial design and model applications);
- copyright protection;
- domain name registration;
- IPR development through sales, acquisitions, licensing;
- oppositions, appeals and prosecutions before the Macau Registrar or Courts; and
- IPR policies and opinions.

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