
TRADE MARKS.

N^o. 19 of 1912.

An Act to amend the *Trade Marks Act* 1905.

[Assented to 6th November, 1912.]

BE it enacted by the King's Most Excellent Majesty, the Senate, and the House of Representatives of the Commonwealth of Australia, as follows :—

Short title and
citation.

1.—(1.) This Act may be cited as the *Trade Marks Act* 1912.

(2.) The *Trade Marks Act* 1905, as amended by section four of the *Patents Trade Marks and Designs Act* 1910, is in this Act referred to as the Principal Act.

(3.) The Principal Act, as amended by this Act, may be cited as the *Trade Marks Act* 1905–1912.

Amendment of
s. 3.

2. Section three of the Principal Act is amended by omitting the words “ Part VII.—Workers' Trade Marks.”

Amendment of
s. 4.
Cf. 5 Edw. VII.
c. 15, s. 3.

3. Section four of the Principal Act is amended by adding thereto the following definitions:—

“ Mark ” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof ;

“Trade Mark” means a mark used or proposed to be used upon or in connexion with goods, for the purpose of indicating that they are the goods of the proprietor of the trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale ;

“Registrable Trade Mark” means a trade mark which is capable of registration under the provisions of this Act ;

“Prescribed” means, in relation to proceedings before the Court, prescribed by Rules of Court, and, in other cases, prescribed by this Act or the regulations under this Act.

4. After section nine of the Principal Act the following section is inserted in Part I. :—

“9A.—(1.) On and after a date to be fixed by proclamation, this Act shall apply to the Territory of Papua as if that Territory were a part of the Commonwealth. Extension of Act to Papua.

“(2.) For the purposes of this section—

(a) any reference in this Act to a State shall be deemed to include a reference to the Territory of Papua, and

(b) any reference in this Act to a State Trade Marks Act shall be deemed to include a reference to the Act or law of that Territory relating to the registration of trade marks.”

5. Section sixteen of the Principal Act is repealed, and the following section inserted in its stead :—

“16.—(1.) A registrable trade mark must contain or consist of at least one of the following essential particulars :— Registrable Trade Marks.

(a) The name of a company, individual, or firm represented in a special or particular manner ; Ct. 5 Edw VII. c. 15, s. 9.

(b) The signature of the applicant for registration or some predecessor in his business ;

(c) An invented word or invented words ;

(d) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname ;

(e) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (a), (b), (c) and (d) shall not, except by order of the Registrar, Law Officer, or Court, be deemed a distinctive mark.

“(2.) For the purposes of this section ‘distinctive’ means adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

“(3.) In determining whether a trade mark is so adapted, the Registrar, Law Officer, or Court may, in the case of a trade mark in actual use, take into consideration the extent to which such

user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.”

Repeal of s. 17.

6. Section seventeen of the Principal Act is repealed.

7. Section eighteen of the Principal Act is repealed and the following section inserted in its stead :—

Restriction on use of certain words in trade marks

“18. Subject to the regulations, the Registrar may refuse to register any trade mark which contains any of the following words or matters :—

- (a) The words ‘ Patent,’ ‘ Patented,’ ‘ By Royal Letters Patent,’ ‘ Registered,’ ‘ Registered Design,’ ‘ Copy-right,’ ‘ Entered at Stationers Hall,’ ‘ To Counterfeit this is Forgery,’ or words to the like effect; or
- (b) The word ‘ Royal,’ or any word of similar import, if the use of the word in the trade mark might lead people to think that the applicant had Royal or Government patronage, or authorization; or
- (c) Any representation of the King, the Queen, or any member of the Royal Family; or
- (d) Any representation of the Royal arms, or Royal crests, or arms or crests so nearly resembling them as to be likely to lead to mistake, or of the Royal Crowns, or of the British National Flags; or
- (e) Any representation of the arms, flag, or seal of the Commonwealth or of any State; or
- (f) Any representation of the arms of any foreign state or country; or
- (g) Any representation of the arms or emblems of any city or town in the Commonwealth, or of any Commonwealth or State public authority or public institution.”

Repeal of s. 19.

8. Section nineteen of the Principal Act is repealed.

Repeal of s. 20.

9. Section twenty of the Principal Act is repealed.

Amendment of s. 25.

10. Section twenty-five of the Principal Act is amended—

- (a) by omitting the words “ Except by order of the Court ” and inserting in their stead the words “ Subject to this Act ”; and
- (b) by omitting the words “ like goods, or class of goods,” and inserting in their stead the words “ same goods or description of goods ”.

11. Section twenty-seven of the Principal Act is repealed and the following section inserted in its stead :—

Rival claims to identical marks.
Cl. 5 Edw. VII.,
s. 15, s. 20.

“27. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Law Officer or the Court.”

12. Section twenty-eight of the Principal Act is amended by omitting the words "like goods or class of goods" and inserting in their stead the words "same goods or description of goods." Amendment of s. 28

13. Section thirty-one of the Principal Act is repealed and the following section inserted in its stead :—

"31. When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of— Series of Trade Marks. 5 Edw. VII., c. 15, s. 26.

(a) statements of the goods for which they are respectively used or proposed to be used ; or

(b) statements of number, price, quality, or names of places ; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark ; or

(d) colour ;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks."

14. Sub-section (2.) of section thirty-two of the Principal Act is amended— Amendment of s. 32.

(a) by adding at the end of paragraph (a) the word "and" ;

(b) by omitting paragraph (b) ; and

(c) by omitting the words " Provided that an applicant need not disclaim his own name or address or the foreign equivalents thereof or that of a predecessor in business."

15. Section thirty-three of the Principal Act is amended by omitting therefrom the words "like goods or class of goods" and inserting in their stead the words "same goods or description of goods." Amendment of s. 33.

16. Section forty-one of the Principal Act is amended by omitting the words "and in that event he shall not be liable for costs, but if he lodges a counter-statement and thereafter abandons his application he shall, unless the Registrar otherwise orders, pay to the opponent such costs as the Registrar allows." Amendment of s. 41.

17. Section forty-seven of the Principal Act is amended by inserting, after the words "the Registrar", the words "unless otherwise prescribed by the regulations." Amendment of s. 47.

18. Section forty-nine of the Principal Act is amended—

(a) by inserting in sub-section (1.) thereof, after the word "shall", the words "subject to any rights appearing from the register to be vested in any other person"; and Amendment of s. 49.

(b) by omitting sub-section (2.) thereof.

19. Sections fifty and fifty-one of the Principal Act are repealed and the following sections inserted in their stead :—

"50. Subject to the provisions of section fifty-one A of this Act, and to any limitations and conditions entered upon the register, the Rights of registered proprietor. 5 Edw. VII., c. 15, s. 39.

registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of the trade mark upon or in connexion with the goods in respect of which it is registered :

“ Provided that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods, no rights of exclusive user of such trade mark shall (except so far as their respective rights have been defined by the Registrar, the Law Officer, or the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

Registration
prima facie
evidence of
validity.
5 Ed^w. VII.,
c. 15, s. 40.

“ 51. In all legal proceedings relating to a registered trade mark (including applications under section seventy-one of this Act) the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark under this Act and of all subsequent assignments and transmissions of the trade mark.

Registration
conclusive after
seven years
1b s. 41.

“ 51A. In all legal proceedings relating to a registered trade mark (including applications under section seventy-one of this Act) the original registration of the trade mark under this Act shall, after the expiration of seven years from the date of the original registration be taken to be valid in all respects, unless the original registration was obtained by fraud, or unless the trade mark offends against the provisions of section one hundred and fourteen of this Act :

“ Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connexion with goods upon or in connexion with which such person has, by himself or his predecessors in business, continuously used the trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of sections eight, nine, or twenty-eight of this Act.”

20. After section fifty-three of the Principal Act the following sections are inserted in Division 4 of Part IV. :—

User of name
address or
description of
goods.
1b. s. 44.

“ 53A. No registration under this Act shall interfere with any *bonâ fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bonâ fide* description of the character or quality of his goods.

“ Passing-off ”
action.
1b. s. 45.

“ 53B. Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.”

Amendment of
s. 59.

21. Section fifty-nine of the Principal Act is amended—

(a) by omitting therefrom the word “ Court ” and inserting in its stead the word “ Registrar ” ;

(b) by omitting therefrom the word "it" and inserting in its stead the word "he"; and

(c) by adding to the section the following sub-section—

"(2.) An appeal shall lie to the Law Officer or, by leave of the Law Officer, to the Court from any decision of the Registrar under this section."

22. Section sixty-eight of the Principal Act is amended by inserting in sub-section (1.) thereof, after the words "by the registered proprietor of a trade mark," the words "or by some person entitled by law to act in his name,".

Amendment of s. 68.

23. Section seventy of the Principal Act is repealed and the following section inserted in its stead :—

"70.—(1.) The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting its identity, and the Registrar may refuse the leave or may grant it on such terms as he thinks fit, but any refusal or conditional permission shall be subject to appeal to the Law Officer.

Alteration of registered trade mark. 5 Edw. VII., c. 16, s. 34.

"(2.) If leave to add to or alter the trade mark is granted, the trade mark as altered shall be advertised in the prescribed manner."

24. Part VII. of the Principal Act relating to Workers' Trade Marks, including sections seventy-four to seventy-seven, is repealed.

Repeal of Part VII.

25. After section eighty-seven of the Principal Act, the following sections are inserted :—

"87A. Where any person is convicted of any offence against section eighty-six or section eighty-seven of this Act he shall be liable, in addition to the punishment provided by those sections, to forfeit to the King every chattel, article, instrument, or thing by means of or in relation to which, the offence was committed.

Forfeiture of articles, &c., on conviction. Cf. 50 & 51 Vict., c. 28, s. 2 (3) (iii).

"87B.—(1.) Where upon information of an offence against section eighty-six or section eighty-seven of this Act, a Justice of the Peace has issued either a summons requiring the defendant to appear to answer the charge or a warrant for the arrest of the defendant, and either the said Justice, on or after issuing the summons or warrant, or any other Justice of the Peace, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which the offence was committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such Justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant to enter the house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under the warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether they are or are not liable to forfeiture under this Act.

Search warrant 50 & 51 Vict., c. 28 s. 12.

“(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing the forfeiture of the goods or things, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, the goods or things will be forfeited, and at the time and place the court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order the goods or things or any of them to be forfeited.

“(3.) Any goods or things forfeited under this section may be destroyed or otherwise disposed of in such manner as the court of summary jurisdiction by which they are forfeited directs, and the court may, out of any proceeds which are realized by the disposition of the goods (all trade marks and trade descriptions being first obliterated), award to any innocent party any loss he has innocently sustained in dealing with the goods.”

Amendment of
s. 90.

26. Section ninety of the Principal Act is amended—

(a) by omitting the word “and” at the end of paragraph (a) of sub-section (1.);

(b) by adding the word “and” at the end of paragraph (b) of sub-section (1.);

(c) by adding to sub-section (1.) the following paragraph :—

“(c) All goods manufactured at any place outside Australia and having applied to them any name purporting to be the name of any manufacturer dealer or trader in Australia, unless the name is accompanied by a definite indication of the country in which the goods were made or produced.”

(d) by inserting in sub-section (2.) after the word “Comptroller-General” the words “of Customs,” and after the word “Minister” the words “for Trade and Customs”; and

(e) by inserting in sub-section (2.) after the words “improper marks will be effectually removed from the goods” the words “or that such additions will be made as will render unobjectionable any mark or name applied to the goods.”

27. After section ninety of the Principal Act, the following section is inserted :—

“90A.—(1.) Where any goods which are liable to forfeiture under the preceding section are imported into Australia, and the goods bear any name or trade mark being or purporting to be the name or trade mark of any manufacturer, dealer, or trader in Australia, and the Comptroller-General of Customs is, upon representations made to him, satisfied that the use of the name or trade mark is fraudulent, the proper officer of Customs may require the importer of the goods, or his agent, to produce any documents in his

Power to
require
information in
respect of
imported goods
bearing
fraudulent
marks
1 & 2 Geo. V.,
ch. 31, s. 1.

possession relating to the goods, and to furnish information as to the name and address of the person by whom the goods were consigned to Australia, and the name and address of the person to whom the goods were sent in Australia ; and, if the importer or his agent fails within fourteen days to comply with any such requirement, he shall be guilty of an offence.

“ Penalty : One hundred pounds.

“(2.) Any information obtained from the importer of the goods or his agent under this section, or from any other source, may be communicated by the Comptroller-General to any person whose name or trade mark is alleged to have been used or infringed.”

28. Section one hundred of the Principal Act is repealed and the following section inserted in its stead :—

“ 100. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court or a Judge thereof may certify the same, and if it or he so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court or a Judge thereof certifies that he ought not to have the same.”

Certificate of
validity.
5 Edw. VII.,
c. 15, s. 46.

29. Section one hundred and three of the Principal Act is amended—

Amendment
of s. 103.

- (a) by omitting therefrom the words “ of a trade mark ” and inserting in their stead the words “ or the registered proprietor of the trade mark in question,” and
- (b) by inserting therein, after the words “ giving the applicant,” the words “ or registered proprietor.”

30. Section one hundred and twelve of the Principal Act is repealed and the following section inserted in its stead :—

“ 112.—(1.) Any person who represents a trade mark as registered which is not so shall be liable for every offence on summary conviction to a fine not exceeding Five pounds.

Penalty on
falsely
representing a
trade mark as
registered.
5 Edw. VII.,
c. 15, s. 67.

“(2.) A person shall be deemed, for the purposes of this section, to represent that a trade mark is registered, if he uses in connexion with the trade mark the word ‘ registered,’ or any words expressing or implying that registration has been obtained for the trade mark.”

31. Section one hundred and thirteen of the Principal Act is amended—

Amendment of
section 113.

- (a) by inserting therein after the words “ Royal Arms ” the words “ or the Arms of the Commonwealth ” ; and
- (b) by omitting therefrom the words “ so nearly resembling them ” and inserting in their stead the words “ so nearly resembling the Royal Arms or the Arms of the Commonwealth.”