

TRADE MARKS.

No. 76 of 1948.

An Act to amend the *Trade Marks Act* 1905-1936.

[Assented to 17th December, 1948.]

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* 1948.

(2.) The *Trade Marks Act* 1905-1936* 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* 1905-1948.

Commencement.

2. This Act shall come into operation on a date to be fixed by Proclamation.

Definitions.

3. Section four of the Principal Act is amended—

(a) by inserting before the definition of "The Court" the following definition :—

“ ‘ Australia ’ includes the Territories of the Commonwealth to which this Act applies or extends ” ;

* Act No. 20, 1905, as amended by No. 19, 1910; No. 19, 1912; No. 7, 1919; No. 25, 1922; No. 45, 1934; and No. 76, 1936.

(b) by omitting the definition of "Trade Mark" and inserting in its stead the following definition :—

" 'Trade Mark' means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connexion in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark whether with or without any indication of the identity of that person, and includes a mark permitted under section twenty-two of this Act to be registered as a trade mark ; " ; and

(c) by adding at the end thereof the following definition :—

" 'Registered User' means a person who is for the time being registered as such under section thirty-one A of this Act."

4. Section eleven of the Principal Act is amended by omitting ^{Registrar.} from sub-section (3.) the words " a Deputy Registrar " and inserting in their stead the words " one or more Deputy Registrars ".

5. After section thirty-one of the Principal Act the following section is inserted in Division 1 of Part IV. :—

" 31A.—(1.) Subject to this section, a person other than the ^{Registered} proprietor of a registered trade mark may be registered as a registered ^{user.} user of that trade mark in respect of all or any of the goods in respect of which it is registered and either with or without conditions or restrictions.

" (2.) The use of a registered trade mark—

- (a) by a registered user of the trade mark in relation to goods—
- (i) with which he is connected in the course of trade ;
and
 - (ii) in respect of which the trade mark remains registered for the time being and in respect of which he is registered as a registered user for the time being ;
and

(b) which complies with any conditions or restrictions to which his registration is subject,
is in this Act referred to as ' the permitted use ' of the trade mark.

" (3.) The permitted use of a registered trade mark shall be deemed to be use by the proprietor of the trade mark and shall be deemed not to be use by a person other than the proprietor for purposes of section seventy-two of this Act and for any other purpose for which use by the proprietor of the trade mark is material under this Act.

" (4.) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor of a trade mark to take proceedings to prevent infringement of the trade mark and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may

institute proceedings for infringement in his own name as if he were the proprietor and shall make the proprietor a defendant. A proprietor so made a defendant shall not be liable for costs unless he enters an appearance and takes part in the proceedings.

“ (5.) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user shall apply in writing to the Registrar in the prescribed manner and shall furnish him with a statutory declaration made by the proprietor, or by some person authorized to act on his behalf and approved by the Registrar—

- (a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there should be any other restriction as to persons for whose registration as registered users application may be made ;
- (b) stating the goods in respect of which registration is proposed ;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use or to any other matter ; and
- (d) stating whether the permitted use is to be for a period or without limit of period and, if for a period, the duration of the period,

and with such further documents, information or evidence as is required under the regulations or by the Registrar.

“ (6.) When the requirements of the last preceding sub-section have been complied with the Registrar may, if, after considering the documents, information and evidence furnished to him under that sub-section, he is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user, subject to any conditions or restrictions which the Registrar thinks appropriate, would not be contrary to the public interest, register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied.

“ (7.) The Registrar shall not register a person as a registered user of a trade mark if it appears to him that the registration would tend to facilitate trafficking in that trade mark.

“ (8.) The Registrar shall, if so required by an applicant under sub-section (5.) of this section, take steps for securing that any document, information or evidence furnished for the purpose of that application (other than matter entered in the register) is not disclosed to any other person except by order of the Court.

“(9.) Without prejudice to the provisions of section seventy-one of this Act, the registration of a person as a registered user—

- (a) may be varied by the Registrar in respect of the goods in respect of which, or in respect of any conditions or restrictions subject to which, the registration has effect, upon the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates ;
- (b) may be cancelled by the Registrar upon the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark ; or
- (c) may be cancelled by the Registrar upon the application in writing in the prescribed manner of any person on the ground—
 - (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion ;
 - (ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration or that the circumstances have materially changed since the date of the registration ; or
 - (iii) that the registration ought not to have been effected, having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

“(10.) Provision shall be made by the regulations—

- (a) for the notification of the registration of a person as a registered user to any other registered user of the trade mark ; and
- (b) for the notification of an application under the last preceding sub-section to the registered proprietor and to each registered user (not being the applicant) of the trade mark.

“(11.) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

“(12.) The Registrar shall not exercise any discretionary power under this section adversely to a person without, if so required within the prescribed time, giving each person who will be affected by the exercise of the power an opportunity of being heard personally or by his agent.

“(13.) Any decision of the Registrar under the preceding sub-sections of this section shall be subject to an appeal to the Court.

“(14.) Where—

- (a) a person is registered as a registered user of a trade mark on an application made within one year after the commencement of this section ;
- (b) there has been previous use (whether before or after the commencement of this section) of the trade mark by that person ; and
- (c) that use is in relation to the goods in respect of which that person is registered and, where he is registered subject to conditions or restrictions—
 - (i) that use complied substantially with those conditions or restrictions ; or
 - (ii) did not so comply but was not such as to be contrary to the public interest,

sub-section (3.) of this section shall have effect as if that previous use had been permitted use.

“(15.) Nothing in this section shall confer on the registered user of a trade mark any assignable or transmissible right to the use of that trade mark.”.

Lodging of
application.

6. Section thirty-three of the Principal Act is amended by adding at the end thereof the following sub-sections :—

“(4.) An application for the registration of a trade mark in respect of any goods may be accepted, and the trade mark may be registered, notwithstanding that it appears that the applicant does not use or propose to use the trade mark—

- (a) if the Registrar, the Law Officer or the Court, as the case may be, is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the trade mark to the body corporate with a view to the use of the trade mark in relation to those goods by the body corporate ; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Registrar, Law Officer or the Court, as the case may be, is satisfied that the proprietor intends the trade mark to be used by that person in relation to those goods and is also satisfied that that person will be registered as a registered user of the trade mark immediately after its registration.

“(5.) The Registrar, the Law Officer or the Court may, as a condition of the exercise of the power conferred by the last preceding sub-section in favour of an applicant who relies on an intention to

assign to a body corporate, require the applicant to give security, within a time specified by the Registrar, the Law Officer or the Court, for the costs of any proceedings before him or it relating to any opposition or appeal, and in default of security being so given the application shall lapse.

“(6.) Where a trade mark is registered in respect of any goods under the power conferred by sub-section (4.) of this section in the name of an applicant who relies on an intention to assign the trade mark to a body corporate, then, unless within such period as is prescribed or within such further period not exceeding six months as the Registrar on an application being made to him in the prescribed manner allows, the body corporate has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect of those goods at the expiration of that period and the Registrar shall amend the register accordingly.”.

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

“58.—(1.) Subject to this section, a trade mark when registered may be assigned and transmitted only in connexion with the goodwill of the business concerned in the particular goods or class of goods in respect of which it has been registered or of some of those goods and shall be determinable with that goodwill.

Assignment and
transmission of
trade marks.

“(2.) An assignment of a registered trade mark without that goodwill, whether before or after the commencement of this section, shall not be invalid unless it is made to appear—

- (a) that the trade mark was not at any time in actual and *bona fide* use in Australia by the assignor or his predecessor in title, unless the trade mark is one—
 - (i) which has been registered with the intention that it should be assigned to a body corporate to be formed or that some person should be permitted to use it as a registered user ; and
 - (ii) which has in fact been so assigned or the use of which by a permitted user has in fact been so registered within six months after the registration of the trade mark ;
- (b) that the assignee has, after the date of the assignment, used the trade mark in association with statements or otherwise in a manner likely to lead to the belief, contrary to the fact, that the goods in respect of which the trade mark is used by the assignee are manufactured or dealt in by the assignor ; or

(c) that the trade mark or a trade mark substantially identical with it continues to be used by the assignor, after the date of the assignment, in relation to other goods, where there exists a connexion in the course of trade between those goods and the assignor and where those goods are of the same description as those in respect of which the trade mark has been assigned, or of such a description that the public is likely to be deceived by the use of the trade mark by the assignor and assignee upon their respective goods.

“(3.) An assignment of the trade mark shall not be held to be invalid if the assignee makes it appear that at the date of the institution of the proceedings in which the validity of the assignment is questioned the trade mark had come to denote to the public a connexion in the course of trade between the goods and the assignee to the exclusion of all other persons within the territory in respect of which he is registered as proprietor of the mark.

“(4.) An assignment of a trade mark shall not be held to be invalid except in proceedings instituted within three years after the date of the registration of the assignment.

“(5.) If goods bearing a registered trade mark are purchased or acquired by a person, the sale of or other dealing in those goods by that person, or by a person claiming under or through him, shall not be an infringement of the trade mark by reason only of the trade mark being assigned by the registered proprietor to some other person after the purchase or acquisition of those goods.

“(6.) All rights subsisting in a registered trade mark, whether under this Act or otherwise, shall be deemed to be assigned on the registration of the assignment of the trade mark.”

Rights of
registered
proprietor.

8. Section fifty of the Principal Act is amended by inserting in the proviso thereto, after the word “rights” (last occurring), the words “as against other persons (not being registered users)”.

Correction of
register.

9. Section sixty-eight of the Principal Act is amended by inserting after sub-section (1.) the following sub-section:—

“(1A.) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.”

Removal of
trade mark
from register
if no *bona fide*
user.

10. Section seventy-two of the Principal Act is amended—

(a) by inserting after sub-section (1.) the following sub-section:—

“(1A.) The Court may, on the application of any person aggrieved, order the removal of a trade mark from the register in respect of any of the goods in respect of

which it is registered if the trade mark was one in relation to which sub-section (4.) of section thirty-three of this Act applied and it is shown—

(a) that the mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by the body corporate or registered user concerned; and

(b) that, up to the date one month prior to date of application to the Court, there was in fact no *bona fide* use of the trade mark in relation to those goods by the body corporate or by the person who was for the time being registered user of the trade mark.”; and

(b) by inserting in sub-section (2.), after the word “proprietor”, the words “or registered user”.

11. Section one hundred A of the Principal Act is amended by inserting after the word “proprietor” the words “or a registered user”.

B remedy in
case of
groundless
threats of legal
proceedings.