

## TRADE MARKS.

**No. 20 of 1955.**

An Act relating to Trade Marks.

[Assented to 15th June, 1955.]

**B**E it enacted by the Queen's Most Excellent Majesty, the Senate, and the House of Representatives of the Commonwealth of Australia, as follows :—

### PART I.—PRELIMINARY.

1. This Act may be cited as the *Trade Marks Act 1955*. Short title.
2. This Act shall come into operation on a date to be fixed by Proclamation. Commencement.
3. This Act is divided into Parts, as follows :— Parts.
  - Part I.—Preliminary (Sections 1-9).
  - Part II.—Administration (Sections 10-13).
  - Part III.—The Register of Trade Marks (Sections 14-23).
  - Part IV.—Registrable Trade Marks (Sections 24-39).
  - Part V.—Applications for Registration (Sections 40-48).
  - Part VI.—Opposition to Registration (Sections 49-52).
  - Part VII.—Registration and Effect of Registration (Sections 53-68).
  - Part VIII.—Renewal of Registration (Sections 69-72).
  - Part IX.—Registered Users (Sections 73-81).
  - Part X.—Assignment of Trade Marks (Section 82).
  - Part XI.—Certification Trade Marks (Sections 83-92).
  - Part XII.—Defensive Trade Marks (Sections 93-97).
  - Part XIII.—Protection of Trade Marks (Sections 98-107).
  - Part XIV.—International Arrangements (Sections 108-110).
  - Part XV.—The Appeal Tribunal (Sections 111-116).
  - Part XVI.—Miscellaneous (Sections 117-147).
4. The Acts specified in the first column of the Schedule to this Act are repealed to the extent respectively specified in the second column of that Schedule. Repeal.

Application of  
Act.

5.—(1.) This Act applies to and in relation to applications for the registration of trade marks made after the commencement of this Act and to and in relation to trade marks registered on those applications.

(2.) Subject to section ninety of this Act, this Act also applies to and in relation to trade marks registered under the repealed Acts and those trade marks shall, subject to the next succeeding sub-section, be deemed to be registered in Part A of the Register.

(3.) The Registrar may, on the application of the registered proprietor of a trade mark referred to in the last preceding sub-section, transfer the trade mark from Part A to Part B of the Register.

(4.) Subject to section ninety of this Act, the repealed Acts apply, notwithstanding their repeal, to and in relation to applications for the registration of trade marks made before the commencement of this Act and to and in relation to the registration of trade marks on those applications, but this Act applies to and in relation to trade marks so registered and those trade marks shall, subject to the next succeeding sub-section, be deemed to be registered in Part A of the Register.

(5.) Before the acceptance of an application for the registration of a trade mark made before the commencement of this Act, the Registrar may, upon the request of the applicant, treat the application as an application for registration in Part B of the Register and deal with the application accordingly.

(6.) The repealed Acts apply, notwithstanding their repeal, to and in relation to applications for the registration of a person as the registered user of a trade mark made before the commencement of this Act and to and in relation to the registration of persons as registered users on those applications, but this Act applies to and in relation to persons so registered.

Definitions.

6.—(1.) In this Act, unless the contrary intention appears—

“assignment” means assignment by act of the parties concerned;

“Australia” includes the Territories of the Commonwealth to which this Act extends;

“Convention country” means a country in respect of which there is in force for the time being a Proclamation declaring that country to be a Convention country for the purposes of this Act;

“legal practitioner” means a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory of the Commonwealth;

- “limitations” means limitations of the right to the exclusive use of a trade mark given by the registration of the trade mark, including limitations of that right as to—
- (a) mode of use ;
  - (b) use within a territorial area within Australia ; or
  - (c) use in relation to goods to be exported to a market outside Australia ;
- “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral, or any combination thereof ;
- “permitted use”, in relation to a registered trade mark, means the use of the 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 ;
    - (ii) in respect of which the trade mark remains registered ; and
    - (iii) for which he is registered as a registered user ; and
  - (b) which complies with any conditions or restrictions to which his registration is subject ;
- “person” includes a body politic and a body of persons, whether corporate or unincorporate ;
- “registered proprietor”, in relation to a trade mark, means the person for the time being entered in the Register as proprietor of the trade mark ;
- “registered trade mark” means a trade mark which is registered under this Act ;
- “registered user” means a person who is registered as such under section seventy-four of this Act ;
- “the Deputy Registrar” means the Deputy Registrar of Trade Marks holding office under this Act ;
- “the expiration of the last registration”, in relation to a registered trade mark, means the date of the expiration of the original registration of the trade mark or of the last renewal of registration, as the case may be ;
- “the *Official Journal*” means the Official Journal referred to in section one hundred and seventy-five of the *Patents Act* 1952–1955 ;

“the Register” means the Register of Trade Marks under this Act ;

“the Registrar” means the Registrar of Trade Marks holding office under this Act ;

“the repealed Acts” means the Acts repealed by this Act ;

“this Act” includes the regulations ;

“trade mark” means --

(a) except in relation to Part XI., 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 a person who has the right, either as proprietor or as registered user, to use the mark, whether with or without an indication of the identity of that person ; and

(b) in relation to Part XI., a mark registrable, or registered, in Part C of the Register ;

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being assignment ;

“word” includes an abbreviation of a word.

(2.) In this Act—

(a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark ; and

(b) references to the use of a mark in relation to goods shall be construed as references to the use of the mark upon, or in physical or other relation to, goods.

(3.) For the purposes of this Act, a trade mark shall be deemed to be deceptively similar to another trade mark if it so nearly resembles that other trade mark as to be likely to deceive or cause confusion.

Crown to  
be bound.

7. This Act binds the Crown in right of the Commonwealth and of the several States.

Extension to  
Territories.

8. This Act extends to Norfolk Island, the Territory of Papua and the Territory of New Guinea, as if each of those Territories were part of the Commonwealth, and no application for the registration of a trade mark is receivable under a law (other than this Act) in force in any of those Territories.

No new  
application to  
be made under  
State Acts.

9. An application for the registration of a trade mark under a State Act relating to the registration of trade marks is not receivable.

## PART II.—ADMINISTRATION.

10.—(1.) There shall be a Registrar of Trade Marks, who shall, under the Attorney-General, have the chief control of the Trade Marks Office. Registrar and other officers.

(2.) Until the Governor-General otherwise determines, the Commissioner of Patents shall be the Registrar of Trade Marks.

(3.) There shall be a Deputy Registrar of Trade Marks, who shall, subject to the control of the Registrar of Trade Marks, have all the powers and functions of the Registrar of Trade Marks under this Act, other than the powers of the Registrar under the next succeeding section.

(4.) Where, under this Act, the exercise of a power or function by the Registrar, or the operation of a provision of this Act, is dependent upon the opinion, belief or state of mind of the Registrar in relation to a matter, that power or function may be exercised by the Deputy Registrar, or that provision may operate, as the case may be, upon the opinion, belief or state of mind of the Deputy Registrar in relation to that matter.

(5.) There shall be one or more Assistant Registrars of Trade Marks.

(6.) There shall be so many Examiners of Trade Marks as are necessary.

(7.) Persons holding office as Examiners of Trade Marks at the commencement of this Act shall continue to hold that office.

11.—(1.) The Registrar of Trade Marks may, in relation to a particular matter or class of matters, by writing under his hand, delegate all or any of his powers or functions under this Act (except this power of delegation) to an Assistant Registrar of Trade Marks, so that the delegated powers and functions may be exercised by the delegate with respect to the matter or class of matters specified in the instrument of delegation. Delegation by Registrar.

(2.) A delegation under this section is revocable at will and does not prevent the exercise of a power or function by the Registrar of Trade Marks or by the Deputy Registrar of Trade Marks.

12.—(1.) For the purposes of this Act, there shall be an office which shall be known as the Trade Marks Office. Trade Marks Office and sub-offices.

(2.) There shall be a sub-office of the Trade Marks Office in each State.

(3.) A document required or permitted by this Act to be lodged at the Trade Marks Office may be lodged at a sub-office of the Trade Marks Office and a reference in this Act to lodgment at the Trade Marks Office includes a reference to lodgment at a sub-office of the Trade Marks Office.

13. There shall be a seal of the Trade Marks Office and impressions of the seal shall be judicially noticed. Seal of Trade Marks Office.

## PART III.—THE REGISTER OF TRADE MARKS.

Register of  
Trade Marks.

14.—(1.) There shall be kept at the Trade Marks Office a Register of Trade Marks, in which shall be entered—

- (a) particulars of registered trade marks ; and
- (b) such other matters as are prescribed.

(2.) The Register shall be divided into four parts, which shall be known as Part A, Part B, Part C and Part D, respectively.

(3.) Subject to the next succeeding sub-section, the Register of Trade Marks existing at the commencement of this Act shall be incorporated with and form part of Part A of the Register under this Act.

(4.) The Registrar shall transfer from Part A of the Register to Part C of the Register marks registered as standardization trade marks under the repealed Acts.

Trusts not  
to be  
noticed.

15. Notice of a trust, expressed, implied or constructive, shall not be entered in the Register or be received by the Registrar.

Inspection of  
Register.

16. The Register shall be open to the inspection of the public at all convenient times.

Register and  
certified  
copies to be  
evidence.

17.—(1.) The Register is evidence of all matters required or authorized by this Act to be entered in the Register.

(2.) The Registrar may, subject to this Act, supply copies of or extracts from the Register, or of or from a document or publication in the Trade Marks Office, certified by writing under his hand and the seal of the Trade Marks Office and a copy or extract so certified and sealed is admissible in evidence in all courts and proceedings without further proof or production of the original.

(3.) The Registrar may, subject to this Act, certify, by writing under his hand and the seal of the Trade Marks Office—

- (a) that an entry, matter or thing required by or under this Act or the repealed Acts to be made or done, or not to be made or done, has, or has not, as the case may be, been made or done ; or
- (b) that a book, document or publication in the Trade Marks Office was made available for public inspection in the Trade Marks Office on the date specified in the certificate,

and such a certificate is evidence of the statements contained in the certificate.

False entries  
in Register.

18. A person shall not wilfully—

- (a) make or cause to be made a false entry in the Register ; or
- (b) produce or tender in evidence a document falsely purporting to be a copy of or extract from an entry in the Register or of or from a document in the Trade Marks Office.

Penalty : Imprisonment for three years.

19.—(1.) The Registrar may, on application by the registered proprietor of a trade mark, amend or alter the Register by— Correction of Register.

- (a) correcting an error in the entry of a trade mark in the Register ;
- (b) entering a change in the name, address or description of the registered proprietor ;
- (c) cancelling the entry of a trade mark in the Register ;
- (d) amending the specification of the goods in respect of which the trade mark is registered but so that the amendment does not in any way extend the rights given by the registration of the trade mark ; or
- (e) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark,

and may make any consequential amendment or alteration in the certificate of registration, and for that purpose may require the certificate of registration to be produced to him.

(2.) The Registrar may, on request made by a registered user of a trade mark, correct an error, or enter a change, in the name, address or description of the registered user.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under sub-section (1.) of this section.

20.—(1.) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and of proof of title to his satisfaction, register that person as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect and cause particulars of the assignment or transmission to be entered in the Register. Registration of assignment.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(3.) Except in the case of an appeal under this section or of an application under section twenty-two of this Act, a document or instrument in respect of which no entry has been made in the Register in accordance with the provisions of sub-section (1.) of this section is not, unless the court otherwise directs, admissible in evidence in a court in proof of a title to a registered trade mark.

21.—(1.) The registered proprietor of a trade mark may apply to the Registrar for leave to alter the trade mark in a manner not substantially affecting its identity and the Registrar may refuse the leave or grant it on such terms and subject to such conditions and limitations as he thinks fit. Alteration of registered trade mark.

(2.) The Registrar may cause an application under this section to be advertised in the *Official Journal* where it appears to him that it is desirable to do so.

(3.) A person may, within the prescribed time, give notice to the Registrar of opposition to the application and shall serve a copy of the notice on the applicant.

(4.) The Registrar shall, after hearing the parties, if desirous of being heard, decide the matter.

(5.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(6.) Where leave is granted, notice of leave having been granted shall be advertised in the *Official Journal* and the advertisement shall include the trade mark as altered unless the trade mark has already been advertised in the form to which it has been altered in an advertisement under sub-section (2.) of this section.

**Rectification  
of Register.**

**22.—(1.)** Subject to this Act, the High Court may, on the application of a person aggrieved or of the Registrar, order the rectification of the Register—

- (a) by the making of an entry wrongly omitted to be made in the Register ;
- (b) by the expunging or amendment of an entry wrongly made in or remaining in the Register ;
- (c) by the insertion in the Register of a condition or limitation affecting the registration of a trade mark which ought to be inserted ; or
- (d) by the correction of an error or defect in the Register.

(2.) On application to the High Court by a person aggrieved or by the Registrar, the High Court may make such order as it thinks fit for expunging or varying the registration of a trade mark, on the ground of a contravention of, or failure to observe, a condition or limitation entered in the Register in relation to the trade mark.

(3.) The power to order the rectification of the Register conferred by this section includes power to order the removal of a registration in Part A of the Register to Part B of the Register.

(4.) The Registrar shall not make application to the High Court under this section unless he considers the application desirable in the public interest.

(5.) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(6.) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

**23.**—(1.) Subject to this section and to section ninety-three of this Act, the High Court or the Registrar may, on application by a person aggrieved, order a trade mark to be removed from the Register in respect of any of the goods in respect of which it is registered, on the ground—

Provisions as to non-use of trade mark.

- (a) that the trade mark was registered without an intention in good faith on the part of the applicant for registration that it should be used in relation to those goods by him or, if it was registered under sub-section (1.) of section forty-five of this Act, by the body corporate or registered user concerned, and that there has, in fact, been no use in good faith of the trade mark in relation to those goods by the registered proprietor or a registered user of the trade mark for the time being earlier than one month before the application ; or
- (b) that, up to one month before the date of the application, a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods by the registered proprietor or a registered user of the trade mark for the time being.

(2.) Except where an applicant has been permitted under section thirty-four of this Act to register a substantially identical or deceptively similar trade mark in respect of the goods to which the application relates, or the High Court or the Registrar is of opinion that the applicant can properly be permitted to register such a trade mark, the High Court or the Registrar may refuse an application made under the last preceding sub-section in relation to any goods if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor or a registered user of the trade mark for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(3.) Where, in relation to goods in respect of which a trade mark is registered—

- (a) the matters referred to in paragraph (b) of sub-section (1.) of this section are shown as far as regards failure to use the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in Australia (otherwise than for export from Australia), or in relation to goods to be exported to a particular market outside Australia ; and
- (b) a person has been permitted under section thirty-four of this Act to register a substantially identical or deceptively similar trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Australia), or in relation to goods to be

exported to that market, or the High Court or the Registrar is of opinion that that person might properly be permitted to register such a trade mark,

the High Court or the Registrar may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions or limitations as the High Court or the Registrar thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Australia), or in relation to goods to be exported to that market.

(4.) An applicant is not entitled to rely, for the purposes of paragraph (b) of sub-section (1.), or for the purposes of sub-section (3.), of this section, on failure to use a trade mark if the failure is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

(5.) Where proceedings concerning a trade mark are pending in a court, an application under this section shall not be made except to the High Court.

(6.) If the Registrar considers that an application made to him under this section ought to be decided by the High Court, he may refer the application to the High Court and the High Court may hear and determine the application as though it had been made to the High Court in the first instance.

(7.) An appeal lies to the Appeal Tribunal from an order or direction of the Registrar under this section.

(8.) An application to the High Court under this section shall be made as prescribed by Rules of Court and an application to the Registrar shall be made as prescribed by the regulations.

(9.) An office copy of an order of the High Court under this section shall be served on the Registrar who shall take such steps as are necessary to give effect to the order.

#### PART IV.—REGISTRABLE TRADE MARKS.

Registrable  
trade marks—  
Part A.

**24.**—(1.) A trade mark is registrable in Part A of the Register if it contains or consists of—

- (a) the name of a person represented in a special or particular manner ;
- (b) the signature of the applicant for registration or of some predecessor in his business ;
- (c) an invented word ;
- (d) a word not having direct reference to the character or quality of the goods in respect of which registration is sought and not being, according to its ordinary meaning, a geographical name or a surname ; or
- (e) any other distinctive mark.

(2.) A name, signature or word (not being a name, signature or word described in paragraph (a), (b), (c) or (d) of the last preceding sub-section) is not registrable in Part A of the Register unless it is, by evidence, shown to be distinctive.

(3.) A trade mark may be registered in Part A of the Register in respect of any goods notwithstanding the registration of the trade mark or of a part or parts of the trade mark in Part B of the Register, in the name of the same person, in respect of the same or different goods.

25.—(1.) A trade mark is registrable in Part B of the Register if it is distinctive, or is not distinctive but is capable of becoming distinctive, of goods in respect of which registration of the trade mark is sought and with which the applicant for registration is or may be connected in the course of trade. Registrable  
trade marks—  
Part B.

(2.) A trade mark may be registered in Part B of the Register in respect of any goods notwithstanding the registration of the trade mark or of a part or parts of the trade mark in Part A of the Register, in the name of the same person, in respect of the same or different goods.

26.—(1.) For the purposes of this Act, a trade mark is not distinctive of the goods of a person unless it is adapted to distinguish goods with which that person is or may be connected in the course of trade from goods in respect of which no such connexion subsists, either generally or, where the trade mark is sought to be registered, or is registered, subject to conditions or limitations, in relation to use subject to those conditions or limitations. Distinctiveness.

(2.) In determining whether a trade mark is distinctive, regard may be had to the extent to which—

- (a) the trade mark is inherently adapted so to distinguish ; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark does so distinguish.

(3.) Where—

- (a) an application for registration of a trade mark has been made by a person ;
- (b) before the date of the application, the trade mark was used by a person other than the applicant under the control of, and with the consent and authority of, the applicant ;
- (c) an application has been made by the applicant and that other person for the registration of that other person as a registered user of the trade mark ; and
- (d) the Registrar is satisfied that that other person is entitled to be registered as a registered user of the trade mark immediately after the registration of the trade mark,

the Registrar may, for the purpose of determining whether the trade mark is distinctive of the goods of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by

the applicant and may make an order that the trade mark is so distinctive.

(4.) An appeal lies to the Appeal Tribunal from an order of the Registrar under the last preceding sub-section.

(5.) Where an order is made under sub-section (3.) of this section that the trade mark is distinctive of the goods of the applicant, the registration of the trade mark shall cease to have effect if, at the expiration of the prescribed period or such further period, not exceeding six months, as the Registrar allows, that other person has not become registered as the registered user of the trade mark.

Trade marks  
in colour.

**27.**—(1.) A trade mark may be limited in whole or in part to one or more colours and, in that case, the fact that the trade mark is so limited shall be taken into consideration for the purpose of determining whether the trade mark is distinctive.

(2.) In so far as a trade mark is registered without limitation as to colour it shall be deemed to be registered for all colours.

Scandalous  
and improper  
marks.

**28.** A mark—

- (a) the use of which would be likely to deceive or cause confusion ;
- (b) the use of which would be contrary to law ;
- (c) which comprises or contains scandalous matter ; or
- (d) which would otherwise be not entitled to protection in a court of justice,

shall not be registered as a trade mark.

Registration  
may be  
refused of  
certain words,  
&c., in trade  
marks.

**29.**—(1.) The Registrar may refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as to be likely to be taken for that mark :—

- (a) the word or words “ Patent ”, “ Patented ”, “ By Royal Letters Patent ”, “ Registered ”, “ Registered Design ”, “ Copyright ”, “ To counterfeit this is a forgery ”, or a word or words to the like effect ;
- (b) a representation of the Sovereign or of a member of the Royal Family ;
- (c) a representation of—
  - (i) the Royal Arms, crests, armorial bearings, insignia or devices ;
  - (ii) any of the Royal crowns ; or
  - (iii) the national flag of a part of the Queen’s dominions ;
- (d) the word “ Royal ” or any other word, or any letters or device, likely to lead persons to think that the applicant has or has had Royal or Government patronage or authority ;
- (e) a representation of the Arms, or of any flag or seal, of the Commonwealth or of a State or Territory of the Commonwealth ;

- (f) a representation of the Arms or emblem of a city or town in Australia or of a public authority or public institution in Australia ;
- (g) a representation of a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements ; or
- (h) a mark which is specified in the regulations as being, for the purposes of this section, a prohibited mark.

(2.) The regulations may provide that a mark in relation to which the last preceding sub-section applies (not being a registered trade mark or a mark in use in good faith as a trade mark) shall not be used as a trade mark or as part of a trade mark, either at all or after a date specified in the regulations.

**30.—**(1.) Where a person makes an application for registration of a trade mark which consists of or includes the name or a representation of a living person or of a person believed by the Registrar to be living, the Registrar may require the applicant to furnish him with the consent of that person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

Names, &c.,  
of living  
persons.

(2.) Where a person makes an application for registration of a trade mark which consists of or includes the name or a representation of a person recently dead, or of a person believed by the Registrar to be recently dead, the Registrar may require the applicant to furnish him with the consent of the legal representative of the deceased person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under either of the last two preceding sub-sections.

**31.—**(1.) A trade mark shall be registered in respect of any or all of the goods comprised in a prescribed class of goods.

Trade marks to  
be registered  
for particular  
goods.

(2.) If a question arises as to the class in which goods are comprised, that question shall be decided by the Registrar and the decision of the Registrar is not subject to appeal and shall not be called in question in an appeal or other proceedings under this Act.

**32.—**(1.) If a trade mark—

Disclaimer.

(a) contains parts—

- (i) which are not the subject of separate applications by the proprietor for registration as trade marks ; or
- (ii) which are not separately registered by the proprietor as trade marks ; or

(b) contains matter which is common to the trade or is otherwise not distinctive,

the Registrar, the Appeal Tribunal or the High Court, in deciding whether the trade mark shall be registered or shall remain upon the Register, may, in his or its discretion, require as a condition

that the proprietor shall disclaim any right to the exclusive use of any of those parts, or of that matter, to the exclusive use of which the Registrar, the Appeal Tribunal or the High Court holds the proprietor not to be entitled or that the proprietor shall make such other disclaimer as the Registrar, the Appeal Tribunal or the High Court considers to be proper for the purpose of defining the rights of the proprietor under the registration.

(2.) No such disclaimer affects the rights of the proprietor of the trade mark which do not arise out of the registration of the trade mark.

Identical  
marks.

**33.—**(1.) Subject to this Act, a trade mark is not capable of registration by a person in respect of goods if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same goods or of goods of the same description, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

(2.) The Registrar may defer acceptance of the application for registration of the first-mentioned trade mark until the second-mentioned trade mark has been registered.

Concurrent  
use.

**34.—**(1.) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, the Registrar may permit the registration of trade marks which are substantially identical or deceptively similar, or, but for the honest concurrent use or other special circumstances would be deceptively similar, for the same or different goods, by more than one proprietor subject to such conditions and limitations (if any) as the Registrar imposes.

(2.) Where a person has, by himself or his predecessors in business, continuously used a trade mark before the use, or before the date of registration, whichever is the earlier, of another registered trade mark by the registered proprietor of that other trade mark, by his predecessors in business or by a registered user of that other trade mark, the Registrar shall not refuse to register the first-mentioned trade mark by reason of the registration of that other trade mark.

Jointly  
owned trade  
marks.

**35.—**(1.) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others to use the trade mark except—

(a) on behalf of both or all of them ; or

(b) in relation to goods with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act has effect in relation to any rights of those persons to the use of the trade mark as if those rights were rights of a single person.

(2.) Subject to the last preceding sub-section, nothing in this Act authorizes the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors of the trade mark.

**36.**—(1.) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods— Association of trade marks.

- (a) is substantially identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or goods of the same description ; or
- (b) so nearly resembles such a trade mark as to be likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may, at any time, require that the trade marks shall be entered in the Register as associated trade marks.

(2.) On application made by the registered proprietor of two or more associated trade marks, the Registrar may, if he is satisfied that there would be no likelihood of deception or confusion being caused, dissolve the association with respect to one or more of those trade marks and amend the Register accordingly.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under either of the last two preceding sub-sections.

**37.** Associated trade marks are assignable or transmissible only as a whole and not separately, but, subject to this Act, they shall for all other purposes be deemed to have been registered as separate trade marks. Assignment of associated trade marks.

**38.**—(1.) Where, under this Act, use of a trade mark is required to be proved for any purpose, the Registrar, the Appeal Tribunal or the High Court may, if and so far as he or it thinks right, accept use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting the identity of the trade mark, as an equivalent for the use required to be proved. Use of trade marks whether associated or otherwise.

(2.) The use of the whole of a registered trade mark shall, for the purposes of this Act, be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor.

**39.**—(1.) Where a person who claims to be the proprietor of several trade marks for the same goods or for goods of the same description within a single class seeks to register those trade marks and the trade marks, although they resemble each other in material particulars, differ in respect of— Series of trade marks.

- (a) statements or representations as to the goods in respect of which the trade marks are used or proposed to be used ;
- (b) statements or representations as to number, price, quality or names of places ;

(c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or

(d) colour,

or in respect of any two or more of those matters, the trade marks may be registered as a series in one registration.

(2.) 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.

#### PART V.—APPLICATIONS FOR REGISTRATION.

Application for registration.

**40.**—(1.) A person who claims to be the proprietor of a trade mark may make application to the Registrar for the registration of that trade mark in Part A or Part B of the Register.

(2.) The application—

(a) shall specify the goods in respect of which registration is sought; and

(b) shall be lodged by being left at, or delivered by post to, the Trade Marks Office.

(3.) An application shall not be made in respect of goods comprised in more than one class.

Applications to be examined.

**41.** An Examiner shall, in respect of each application, ascertain and report whether—

(a) the application is as prescribed; and

(b) the trade mark is capable of registration under this Act.

Action on Examiner's report.

**42.**—(1.) If the Examiner reports adversely to an application under the last preceding section, the applicant may amend the application so as to remove the grounds of objection and the amended application shall be again reported on in like manner as the original application.

(2.) If the applicant does not amend the application to the satisfaction of the Registrar, the Registrar may direct that the application be amended to his satisfaction within such time as the Registrar allows.

(3.) An amendment shall not be made or directed under either of the last two preceding sub-sections if the amendment would substantially affect the identity of the trade mark before amendment.

(4.) An appeal lies to the Appeal Tribunal from a direction of the Registrar under sub-section (2.) of this section.

Division of application.

**43.**—(1.) Where a part of a trade mark which is the subject of an application for registration is separately registrable as a trade mark, the applicant may, before the application has been accepted or refused, make a further application for the registration of that part in respect of goods in relation to which the first-mentioned application was made.

(2.) A further application so made shall, if the Registrar so directs, be deemed to have been lodged on the date on which the first-mentioned application was lodged.

(3.) Where an application has been made for registration of a trade mark in respect of certain goods and, before the application has been accepted or refused, the applicant has made a further application for the registration of that trade mark in respect of goods included in the description of goods in respect of which the first-mentioned application was made, the Registrar may direct that the further application shall be deemed to have been lodged on the date on which the first-mentioned application was lodged.

(4.) An appeal lies to the Appeal Tribunal from a direction of the Registrar under either of the last two preceding sub-sections.

44.—(1.) If the Registrar is satisfied that there is no lawful ground of objection to an application, or that the grounds of objection to an application have been removed, the Registrar shall accept the application without conditions or limitations or subject to such conditions or limitations as he thinks fit; if he is not so satisfied, he may refuse to accept the application.

Acceptance of application.

(2.) In the case of an application for registration of a trade mark in Part A of the Register, the Registrar may, with the consent of the applicant, instead of refusing to accept the application, treat the application as an application for registration in Part B of the Register and deal with the application accordingly.

(3.) Where, after the acceptance of an application for registration of a trade mark but before the registration of the trade mark, the Registrar is satisfied—

- (a) that the application has been accepted in error; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations,

the Registrar may withdraw the acceptance and proceed as if the application had not been accepted.

45.—(1.) An application for the registration of a trade mark may be accepted, and the trade mark may be registered, notwithstanding that the applicant does not use or propose to use the trade mark—

Application of may be accepted where trade mark is to be used by assignee or registered user.

- (a) if the Registrar 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 by the body corporate of the trade mark in relation to the goods in respect of which registration is sought; or
- (b) if an application has been made for the registration of a person as a registered user of the trade mark and the Registrar 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 registration of the trade mark.

(2.) Where a trade mark is registered under the last preceding sub-section in the name of an applicant who relies on an intention to assign to a body corporate, then, unless within such period as is prescribed or within such further period, not exceeding six months, as the Registrar allows, the body corporate has been registered as the proprietor of the trade mark in respect of the goods in respect of which the trade mark is registered, the registration shall cease to have effect at the expiration of that period and the Registrar shall amend the Register accordingly.

Appeals.

46.—(1.) An appeal lies to the Appeal Tribunal from a refusal by the Registrar to accept an application or from the acceptance by the Registrar of an application subject to conditions or limitations.

(2.) The Registrar is entitled to appear and be heard upon the hearing of the appeal and shall appear if so directed by the Appeal Tribunal.

Advertisement of acceptance.

47. Where an application has been accepted, the Registrar shall give notice in writing of the acceptance to the applicant and shall advertise the acceptance in the *Official Journal*.

Limit of time for proceeding with application.

48.—(1.) Subject to this section, where an application has not been accepted within twelve months after the date on which the first report of the Examiner was sent to the applicant, the Registrar shall give notice of the non-acceptance to the applicant and if, at the expiration of one month from the date of the notice or at the expiration of such further time as the Registrar allows, the application has not been accepted, the application shall lapse.

(2.) Where an appeal under any of the provisions of this Act has been instituted in respect of an application, the Registrar shall not give notice of the non-acceptance of the application until the expiration of three months after the determination of the appeal or until the expiration of such further time as the Appeal Tribunal allows.

(3.) Where—

(a) the time within which an appeal mentioned in the last preceding sub-section may be instituted has not expired; or

(b) the applicant has died,

the Registrar shall not give notice of the non-acceptance of the application until such time as he determines.

(4.) Where acceptance of an application has been deferred under sub-section (2.) of section thirty-three of this Act, the Registrar shall not give notice of the non-acceptance of the application until the expiration of three months after the registration of the second-mentioned trade mark referred to in that sub-section.

## PART VI.—OPPOSITION TO REGISTRATION.

49.—(1.) A person may, within three months after the date of the advertisement of the acceptance of an application, or within such further period, not exceeding three months, as the Registrar, on application made to him within the first-mentioned period, allows, by notice in writing specifying the grounds of opposition and lodged at the Trade Marks Office, oppose the registration of the trade mark. Notice of opposition.

(2.) The opponent shall serve a copy of the notice on the applicant.

50.—(1.) The Registrar shall, after giving to the applicant and the opponent an opportunity of being heard, decide— Hearing of opposition.

(a) to refuse to register the trade mark ;

(b) to register the trade mark subject to such conditions or limitations as he thinks fit ; or

(c) to register the trade mark without conditions or limitations.

(2.) In determining the opposition the Registrar may take into account a ground of objection whether relied upon by the opponent or not.

51. The applicant or an opponent may appeal to the Appeal Tribunal from a decision of the Registrar under the last preceding section. Appeal to the Appeal Tribunal.

52. If a person giving notice of opposition neither resides nor carries on business in Australia, the Registrar may order him to give security for costs within a specified time and, if the order is not complied with, the opposition shall lapse. Security for costs.

## PART VII.—REGISTRATION AND EFFECT OF REGISTRATION.

53.—(1.) If there is no opposition to the registration of a trade mark, or, in the case of opposition, if the Registrar's decision, or the decision on appeal from that decision, is that the trade mark should be registered, the Registrar shall register the trade mark, in the name of the proprietor, in the appropriate part of the Register. Registration of trade mark.

(2.) Subject to this Act, a trade mark shall be registered as of the date of the lodging of the application for registration and that date shall be deemed for the purposes of this Act to be the date of registration.

54.—(1.) Subject to this section, a trade mark shall not be registered after twelve months from the date of the advertisement of the acceptance of the application. Time for registration.

(2.) Where the Registrar has allowed an extension of time within which notice of opposition to the registration of a trade mark may be given and notice of opposition has not been given, an extension of

time for the same period, or the aggregate of the periods, if more than one, after the period of twelve months referred to in the last preceding sub-section shall be allowed for the registration of the trade mark.

- (3.) Where the registration of a trade mark is delayed by—  
 (a) opposition to the registration of the trade mark ; or  
 (b) an appeal to the Appeal Tribunal,

that trade mark may be registered within such time as—

- (c) in a case to which paragraph (a) of this sub-section applies—  
 the Registrar directs ; or  
 (d) in a case to which paragraph (b) of this sub-section applies—  
 the Appeal Tribunal directs.

(4.) Where the applicant dies before the expiration of the time which would otherwise be allowed for registering a trade mark, the trade mark may be registered at any time within twelve months after his death or within such further period as the Registrar directs.

(5.) Where a trade mark cannot be registered within the time allowed by or under this section, that time may, on application made to the Registrar within the prescribed time, but subject to the regulations, be extended for such further time as is prescribed.

(6.) Where a trade mark has not been registered within the time which is applicable to it under this section the application shall lapse.

Duration of  
 registration.

55.—(1.) Subject to the next succeeding sub-section, the registration of a trade mark as of a date after the commencement of this Act shall be for a period of seven years.

(2.) The registration of a trade mark as of a date before the commencement of this Act shall be for a period of fourteen years.

(3.) The registration of a trade mark may be renewed from time to time in accordance with Part VIII. of this Act.

Words used  
 as name or  
 description  
 of an article  
 or substance.

56.—(1.) Subject to this section, the registration of a trade mark does not become invalid by reason only of the use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance.

(2.) The succeeding sub-sections of this section have effect where—

- (a) there is a well-known and established use of a word as the name or description of an article or substance by a person or persons carrying on a trade in that article or substance, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or, in the case of a certification trade mark, in relation to goods certified by the proprietor ;  
 or

(b) the article or substance was formerly manufactured under a patent, a period of two years or more after the patent has ceased has elapsed, and the word is the only practicable name or description of the article or substance.

(3.) If the trade mark consists solely of that word, the registration of the trade mark, so far as regards registration in respect of the article or substance or of any goods of the same description, shall be deemed for the purposes of section twenty-two of this Act to be an entry wrongly remaining in the Register.

(4.) If the trade mark contains that word and other matter, the High Court, in deciding whether the trade mark shall remain in the Register, so far as regards registration in respect of the article or substance or of any goods of the same description, may, in the case of a decision in favour of the trade mark remaining in the Register, require as a condition that the proprietor shall disclaim any right to the exclusive use of that word in relation to that article or substance or to any goods of the same description, but no such disclaimer affects any rights of the proprietor of the trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

(5.) For the purposes of any other legal proceedings relating to the trade mark—

(a) if the trade mark consists solely of that word, all rights of the registered proprietor to the exclusive use of the trade mark ; or

(b) if the trade mark contains that word and other matter, all rights of the registered proprietor to the exclusive use of that word,

in relation to the article or substance or to any goods of the same description, shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of sub-section (2.) of this section first became well-known and established, or at the expiration of the period of two years mentioned in paragraph (b) of that sub-section.

57.—(1.) Subject to this Act, the registered proprietor of a trade mark has, subject to any rights appearing from the Register to be vested in some other person, power to assign the trade mark and to give good discharges for any consideration for the assignment.

Powers of  
registered  
proprietor.

(2.) Equities in respect of a trade mark may be enforced in like manner as in respect of other personal property.

58.—(1.) Subject to this Act, the registration of a trade mark in Part A or Part B of the Register, if valid, gives to the registered proprietor of the trade mark the right to the exclusive use of the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

Rights given by  
registration.

(2.) The rights acquired by the registration of a trade mark are subject to any conditions or limitations to which the registration is subject.

(3.) Where two or more persons are proprietors of registered trade marks which are substantially identical or deceptively similar, whether for the same or different goods, rights of exclusive use of either of those trade marks are not (except so far as their respective rights have been defined by the Registrar, the Appeal Tribunal or a court) acquired by any one of those persons as against any other of those persons by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users) as he would have if he were the sole registered proprietor.

Registration  
evidence of  
validity.

59. In legal proceedings relating to a registered trade mark (including applications under section twenty-two of this Act), the original registration of the trade mark and the registration of any assignment or transmission of the trade mark shall be deemed to be valid unless the contrary is shown.

Limitation on  
removal of  
trade mark  
after three  
years.

60. In legal proceedings relating to a trade mark registered in Part A of the Register (including applications under section twenty-two of this Act) instituted after the expiration of three years from the date of registration, the trade mark shall not be removed from the Register or be held invalid on the ground that it was not a registrable trade mark under section twenty-four of this Act, unless it is proved that it was not, at the commencement of the proceedings, distinctive of the goods of the registered proprietor.

Registration  
conclusive  
after seven  
years.

61.—(1.) In legal proceedings relating to a trade mark registered in Part A of the Register (including applications under section twenty-two 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 it is shown—

- (a) that the original registration was obtained by fraud;
- (b) that the trade mark offends against the provisions of section twenty-eight of this Act; or
- (c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods of the registered proprietor.

(2.) Paragraph (c) of the last preceding sub-section does not apply to a trade mark registered before the commencement of this Act until after the expiration of three years from the commencement of this Act.

Infringement  
of trade marks.

62.—(1.) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user of the trade mark using by way of permitted use, uses a mark which is

substantially identical with, or deceptively similar to, the trade mark, in the course of trade, in relation to goods in respect of which the trade mark is registered.

(2.) In an action for infringement of a trade mark registered in Part B of the Register (not being an infringement occurring by reason of an act referred to in the next succeeding section), an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connexion in the course of trade between the goods in respect of which the trade mark is registered and a person having the right, either as registered proprietor or as registered user, to use the trade mark.

63.—(1.) Where, by notice upon goods or upon the container of goods, the registered proprietor or a registered user of a trade mark registered in Part A or Part B of the Register makes a statement prohibiting the doing of an act to which this section applies, a person who, being the owner for the time being of the goods, does that act, or authorizes it to be done in relation to the goods in the course of trade or with a view to a dealing with the goods in the course of trade, infringes the trade mark unless—

Infringement  
of trade mark  
by breach of  
certain  
restrictions.

- (a) at the time when that person agreed to buy the goods he acted in good faith without notice that the statement appeared on the goods; or
- (b) he became the owner of the goods by virtue of a title derived from another person who had so agreed to buy the goods.

(2.) The acts to which this section applies are—

- (a) the application of the trade mark upon goods after they have suffered alteration to their state, condition, get-up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration, partial removal or partial obliteration of the trade mark;
- (c) in the case in which the trade mark is upon the goods and there is also other matter upon the goods, being matter indicating a connexion in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partially, of the trade mark unless that other matter is wholly removed or obliterated;
- (d) in a case in which the trade mark is upon the goods, the application of some other trade mark to the goods; and
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of other matter, in writing or otherwise, that is likely to injure the reputation of the trade mark.

(3.) In this section, references, in relation to goods, to the registered proprietor, to a registered user and to the registration of a trade mark shall be construed, respectively, as references to the registered proprietor of the trade mark, to a registered user of the trade mark and to the registration of the trade mark, in respect of those goods, and the expression "upon" includes, in relation to goods, a reference to physical relation to the goods.

Acts not  
constituting  
infringement.

64.—(1.) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of a trade mark:—

- (a) the use in good faith by a person of his own name or the name of his place of business or the name, or the name of the place of business, of any of his predecessors in business;
- (b) the use in good faith by a person of a description of the character or quality of his goods;
- (c) the use by a person of a trade mark in relation to goods in relation to which that person has, by himself or his predecessors in business, continuously used the trade mark from a date before—
  - (i) the use of the registered trade mark by the registered proprietor, by his predecessors in business or by a registered user of the trade mark; or
  - (ii) the registration of the trade mark, whichever is the earlier;
- (d) the use of the trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the facts, a connexion in the course of trade between any person and the goods; and
- (e) the use of a trade mark, being one of two or more registered trade marks which are substantially identical, in exercise of the right to the use of that trade mark given by registration as provided by this Act.

(2.) Where a trade mark is registered subject to conditions or limitations, the trade mark is not infringed by the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in a place, in relation to goods to be exported to a market, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend.

Relief in  
infringement  
actions.

65. The relief which a court may grant in an action or proceeding for infringement of a registered trade mark includes an injunction (subject to such terms, if any, as the court thinks fit) and, except in the case of a trade mark registered in Part C of the Register, at the option of the plaintiff, either damages or an account of profits.

66. In an action or proceeding relating to a trade mark, evidence is admissible of the usages of the trade concerned and of any relevant trade mark, trade name or get-up legitimately used by other persons.

*Evidence of trade usage*

67. Jurisdiction is, by this section, conferred on the High Court to hear and determine an action or proceeding for the infringement of a trade mark, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action or proceeding.

*High Court to have jurisdiction in infringement actions.*

68. In an action for passing off arising out of the use by the defendant of a registered trade mark of which he is the registered proprietor or a registered user, being a trade mark substantially identical with, or deceptively similar to, the trade mark of the plaintiff, damages shall not be awarded against the defendant if he satisfies the court—

*Passing off actions.*

- (a) that at the time he commenced to use the trade mark he was unaware and had no reasonable means of ascertaining that the trade mark of the plaintiff was in use; and
- (b) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark in relation to goods in relation to which it was used by the plaintiff.

#### PART VIII.—RENEWAL OF REGISTRATION.

69. The Registrar shall, on application made by the registered proprietor of a trade mark within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the expiration of the last registration of the trade mark.

*Renewal of registration.*

70.—(1.) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice to the registered proprietor or his agent in Australia of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of the registration may be obtained.

*Procedure on expiry of period of registration.*

(2.) If, at the expiration of the time prescribed in that behalf, those conditions have not been complied with, the Registrar may remove the trade mark from the Register.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

71.—(1.) Where a trade mark has been removed from the Register for non-payment of the prescribed fee, the Registrar may, within twelve months from the date of expiration of the registration of the trade mark, if satisfied that it is just so to do, restore the trade mark to the Register, and renew the registration of the trade mark, either

*Restoration of trade mark removed for non-payment of renewal fee.*

generally or subject to such conditions or limitations as he sees fit to impose, for a period of fourteen years from the expiration of the last registration.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(3.) Section one hundred and thirty of this Act does not apply in relation to sub-section (1.) of this section.

Status of  
un-renewed  
trade mark.

72. Where a trade mark has been removed from the Register for non-payment of the fee for renewal, the trade mark shall, for the purpose of an application for registration by another person lodged not later than twelve months next after the expiration of the last registration, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that—

- (a) there has been no use in good faith of the trade mark during the two years immediately preceding the expiration of the last registration ; or
- (b) no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

#### PART IX.—REGISTERED USERS.

Application  
of Part.

73. This Part applies only in relation to trade marks registered in Part A or Part B of the Register.

Registered  
users.

74.—(1.) Subject to this section, a person other than the registered proprietor of a trade mark may be registered as a registered user of that trade mark for all or any of the goods in respect of which the trade mark is registered.

(2.) Where it is proposed that a person shall be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall apply in writing to the Registrar and shall furnish him with a statutory declaration made by the registered 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 registered proprietor and the proposed registered user, including particulars showing the degree of control by the registered proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user will be the sole registered user or that there will be any other restriction as to persons for whose registration as registered users application may be made ;
- (b) stating the goods for 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.

(3.) Where the requirements of the last preceding sub-section have been complied with and the Registrar, after considering the documents, information and evidence furnished to him under that sub-section, 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 conditions or restrictions which the Registrar thinks appropriate, would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user for the goods as to which he is so satisfied, subject to those conditions or restrictions.

(4.) 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 the trade mark.

(5.) The Registrar may determine that the registration of a person as a registered user of a trade mark shall be for such period as, having regard to the information referred to in paragraph (d) of sub-section (2.) of this section, the Registrar thinks fit.

(6.) The Registrar may determine that the period of the registration of a person as a registered user of a trade mark shall commence on the date on which the application by that person for registration as a registered user was made.

(7.) The Registrar shall, if so required by an applicant under sub-section (2.) of this section, ensure 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 High Court.

**75.** Without affecting the operation of section twenty-two of this Act, the registration of a person as a registered user—

Variation, &c.,  
of registration.

(a) may be varied by the Registrar, on the application in writing of the registered proprietor, with respect to the goods for which, or with respect to any conditions or restrictions subject to which, the registration has effect ;

(b) may be extended by the Registrar, on the application in writing of the registered proprietor, for such period as the Registrar thinks fit ;

(c) may be cancelled by the Registrar on the application of the registered proprietor or of the registered user or of any other registered user of the trade mark : or

(d) may be cancelled by the Registrar on the application of a 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 registered 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.

Cancellation  
of registration.

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

Effect of  
permitted user.

77.—(1.) The permitted use of a registered trade mark shall be deemed to be use by the registered proprietor of the trade mark and shall be deemed not to be use by a person other than the registered proprietor, for the purposes of section twenty-three of this Act and for any other purpose for which use by the registered proprietor of the trade mark is material under this Act.

(2.) Where—

- (a) a person is registered as a registered user of a trade mark ;
- (b) there has been previous use (whether before or after the commencement of this Act) of the trade mark by that person ;  
and
- (c) that use is in relation to 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,

the last preceding sub-section has effect as if that previous use had been permitted use.

(3.) Neither the registration of a person as a registered user of a trade mark, nor the use by that person of the trade mark as a registered user, prejudices any of the rights arising at common law of the person who is the registered proprietor of the trade mark.

(4.) For the purpose of determining the rights arising at common law of the person who is the registered proprietor of a trade mark, the use of the trade mark by a registered user shall be deemed to

be use by that person and shall be deemed not to be use by a person other than that person.

78.—(1.) Subject to any agreement subsisting between the registered user of a trade mark and the registered proprietor of the trade mark, the registered user is entitled to call upon the registered proprietor to take proceedings for infringement of the trade mark, and, if the registered 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 registered proprietor and shall make the registered proprietor a defendant.

Infringement  
proceedings.

(2.) A registered proprietor so added as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings.

79. This Part does not confer on the registered user of a trade mark an assignable or transmissible right to the use of that trade mark.

Rights of  
registered user  
not assignable.

80. The Registrar shall not exercise a discretionary power under this Part adversely to a person without, if so required, giving to each person who will be affected by the exercise of the power an opportunity of being heard.

Hearing by  
Registrar.

81. An appeal lies to the Appeal Tribunal from a decision of the Registrar under this Part.

Appeals.

#### PART X.—ASSIGNMENT OF TRADE MARKS.

82.—(1.) Subject to this section, a registered trade mark may be assigned and transmitted with or without the goodwill of the business concerned in the goods in respect of which the trade mark is registered or of some of those goods.

Assignment  
and  
transmission of  
trade marks.

(2.) Subject to the next three succeeding sub-sections, an assignment of a registered trade mark without goodwill, whether before or after the commencement of this Act, is invalid if—

- (a) the trade mark was not at any time in use in good faith in Australia by the assignor or his predecessor in title; or
- (b) a substantially identical or deceptively similar trade mark continues to be used by the assignor, after 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.) Paragraph (a) of the last preceding sub-section does not apply where—

- (a) the trade mark was registered with the intention that it should be assigned to a body corporate to be formed and the trade mark has been so assigned ; or
- (b) the trade mark was registered with the intention that a person should be permitted to use it as a registered user and a registered user has been registered in respect of the trade mark within six months after the registration of the trade mark and has used the trade mark within that period.

(4.) An assignment of a trade mark is not invalid if, at the date of the institution of the proceedings in which the validity of the assignment is called in question, the trade mark has 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, or, if the registration is limited to a territory, to the exclusion of all other persons within that territory.

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

(6.) 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, is not an infringement of the trade mark by reason only of the trade mark having been assigned by the registered proprietor to some other person after the purchase or acquisition of those goods.

(7.) All rights subsisting in a trade mark (being a registered trade mark), whether under this Act or otherwise, shall be deemed to be assigned upon the registration of the assignment of the trade mark.

#### PART XI.—CERTIFICATION TRADE MARKS.

Certification  
trade marks.

83.—(1.) Where a mark is adapted in relation to goods to distinguish in the course of trade goods certified by a person, or by another person authorized by the first-mentioned person, in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods not so certified, the mark may, upon the application of the first-mentioned person, be registered in Part C of the Register, in the name of the applicant as proprietor, as a certification trade mark in respect of those goods.

(2.) A mark is not so registrable upon the application of a person who carries on a trade in goods of the kind certified.

(3.) In determining whether a mark is adapted so to distinguish in relation to goods, regard may be had to the extent to which—

- (a) the mark is inherently adapted so to distinguish ; and
- (b) by reason of the use of the mark or of any other circumstances, the mark has become adapted so to distinguish.

84.—(1.) Subject to this Act, the registration of a certification trade mark in Part C of the Register, if valid, gives to the registered proprietor the right to the exclusive use of the mark in relation to the goods in respect of which the mark is registered and to obtain relief in respect of infringement of the mark in the manner provided by this Act. Rights given by registration.

(2.) The right to the exclusive use of a certification trade mark given by registration is subject to any conditions or limitations entered in the Register and is not infringed by the use of the mark in relation to goods to be sold or otherwise traded in in a place, in relation to goods to be exported to a market, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend.

(3.) The right to the exclusive use of a certification trade mark given by registration is not infringed by the use of the mark by a person in relation to goods certified by the registered proprietor of the certification trade mark if—

- (a) as to those goods or a bulk of which they form part, the registered proprietor, or another person in accordance with his authority under the rules governing the use of the mark, has applied the mark and has not subsequently removed or obliterated it; or
- (b) the registered proprietor has expressly or impliedly consented to the use of the mark.

(4.) The last preceding sub-section does not have effect in the case of use consisting of the application of a certification trade mark to goods, notwithstanding that they are such goods as are mentioned in that sub-section, if the application of the mark is contrary to the rules governing the use of the mark.

85.—(1.) An application for the registration of a mark as a certification trade mark under this Part shall be accompanied by draft rules for governing the use of the mark. Rules governing the use of certification trade marks.

(2.) The rules shall include provisions as to the cases in which the goods are to be certified and use of the certification trade mark authorized and may contain any other provisions which the Registrar requires or permits to be inserted in the rules (including provisions referring to a right of appeal to the Registrar against a refusal to certify goods or to authorize the use of the mark in accordance with the rules).

86.—(1.) Before accepting an application under this Part, the Registrar shall consider— Matters to be considered before acceptance.

- (a) whether the applicant or person authorized by him is competent to certify the goods in respect of which the mark is to be registered;

(b) whether the draft rules are satisfactory ; and

(c) whether the registration applied for would be to the public advantage.

(2.) Before accepting the application, the Registrar may require the applicant to make such amendments or modifications of the draft rules as he thinks proper.

(3.) An appeal lies to an Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

Alteration of  
rules.

**87.**—(1.) The rules governing the use of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(2.) An application under the last preceding sub-section shall be advertised as prescribed and is subject to opposition as prescribed.

Rectification  
of Register.

**88.**—(1.) The power to order the rectification of the Register conferred by section twenty-two of this Act extends, in relation to a certification trade mark, to rectification on the ground—

(a) that the registered proprietor or person authorized by him is no longer competent, in relation to any of the goods in respect of which the mark is registered, to certify those goods ;

(b) that it is no longer to the public advantage that the mark should be registered as a certification trade mark ;

(c) that the registered proprietor has failed to observe a provision of the rules governing the use of the mark which he is required to observe ; or

(d) that it is necessary, for the public advantage, that if the mark remains registered as a certification trade mark, the rules governing the use of the mark should be varied.

(2.) The High Court may, on the application of a person aggrieved or of the Registrar, make such order as it thinks fit for varying the rules governing the use of a certification trade mark.

(3.) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(4.) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

Certification  
trade marks  
not assignable.

**89.** A certification trade mark may be assigned or transmitted with the consent of the Registrar.

**90.**—(1.) The repealed Acts apply, notwithstanding their repeal, to and in relation to applications for the registration of standardization trade marks made before the commencement of this Act. Transitional provisions.

(2.) A mark registered on such an application shall be registered as a certification trade mark in Part C of the Register and this Act applies to and in relation to a certification trade mark so registered.

(3.) The Registrar may require an applicant under an application referred to in sub-section (1.) of this section to lodge at the Trade Marks Office such rules as the Registrar permits or requires governing the use of the mark.

(4.) Marks which, immediately before the commencement of this Act, were registered under the repealed Acts as standardization trade marks shall be deemed to be registered as certification trade marks in Part C of the Register.

(5.) The registered proprietor of such a mark may lodge, or may be required by the Registrar as a condition of the continuance of the registration to lodge, at the Trade Marks Office such rules as the Registrar permits or requires governing the use of the mark.

(6.) Where no rules have been lodged at the Trade Marks Office in respect of a certification trade mark registered under this section, this Part has effect in relation to that mark as if references in this Part to rules had been omitted.

**91.** Rules governing the use of certification trade marks shall be open to inspection in like manner as the Register. Rules to be open for inspection.

**92.** The provisions of this Act (other than sections twenty-three, twenty-four, twenty-five, twenty-six, thirty-six, thirty-seven and thirty-eight, sub-section (1.) of section forty, sections forty-five, fifty-eight, sixty and sixty-one, sub-section (2.) of section sixty-two, section sixty-three and Parts IX., X. and XII.) apply in relation to the registration of a mark as a certification trade mark under this Part and to a mark registered as a certification trade mark. Application of Act to certification trade mark.

#### PART XII.—DEFENSIVE TRADE MARKS.

**93.**—(1.) Where a trade mark registered in Part A of the Register has been used to such an extent in relation to all or any of the goods in respect of which it is registered that the use of the trade mark in relation to other goods would be likely to be taken as indicating a connexion between those other goods and the registered proprietor, the trade mark may, upon the application of the registered proprietor of the trade mark, be registered as a defensive trade mark in Part D of the Register, in the name of the applicant as proprietor, in respect of all or any of those other goods notwithstanding that he does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section twenty-three of this Act. Defensive registration of well-known trade marks.

(2.) A trade mark registered as a defensive trade mark in respect of goods is not liable to be removed from the Register under section twenty-three of this Act in respect of those goods.

(3.) A trade mark may be registered as a defensive trade mark in respect of goods notwithstanding that the trade mark is already registered in the name of the applicant in respect of those goods otherwise than as a defensive trade mark or may be registered in respect of goods otherwise than as a defensive trade mark notwithstanding that the trade mark is already registered in the name of the applicant in respect of those goods as a defensive trade mark.

(4.) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same person shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

Rectification  
of Register.

94.—(1.) The High Court may, on the application of a person aggrieved or of the Registrar, cancel the registration of a defensive trade mark in respect of all or any of the goods in respect of which it is registered, on the ground that the requirements of sub-section (1.) of the last preceding section are no longer satisfied.

(2.) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(3.) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

(4.) The powers conferred on the High Court by this section are in addition to the powers conferred by section twenty-two of this Act.

Cancellation  
by Registrar.

95. The Registrar may cancel the registration of a defensive trade mark where there is no longer a registration in the name of the registered proprietor of the defensive trade mark otherwise than as a defensive trade mark.

Rights given  
by registration.

96. Subject to this Act, the registration of a defensive trade mark in Part D of the Register, if valid, gives to the registered proprietor of the mark the right to obtain relief in respect of infringement of the mark in the manner provided by this Act.

Application  
of Act.

97. Subject to this Part, the provisions of this Act apply in relation to the registration of a trade mark as a defensive trade mark and to a trade mark registered as a defensive trade mark but it is not necessary for the registered proprietor of a defensive trade mark to prove use of the trade mark for the purpose of obtaining renewal of the registration.

## PART XIII.—PROTECTION OF TRADE MARKS.

98.—(1.) A person shall not—

Forgery, &c.,  
of trade marks.

- (a) forge a registered trade mark ;
- (b) falsely apply a registered trade mark to goods ;
- (c) make a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark ; or
- (d) dispose of or have in his possession a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark.

Penalty : Imprisonment for three years.

(2.) It is a defence in proceedings for an offence against the last preceding sub-section if the defendant proves that he acted without intent to defraud.

99.—(1.) A person shall not sell or expose for sale, or have in his possession for sale or for the purpose of trade or manufacture, goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied.

Selling, &c.,  
goods with  
false marks.

Penalty : One hundred pounds.

(2.) It is a defence in proceedings for an offence against the last preceding sub-section if the defendant proves that he acted without intent to defraud.

100. A person shall not knowingly import into Australia goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied.

Importing  
goods with  
false marks.

Penalty : One hundred pounds.

101. A person convicted of an offence against any of the last three preceding sections is liable, in addition to the punishment provided by those sections, to forfeit to the Commonwealth all goods by means of which, or in relation to which, the offence was committed.

Forfeiture of  
articles, &c.,  
on conviction.

102.—(1.) A person shall not aid, abet, counsel or procure, or be in any way, directly or indirectly, knowingly concerned in or party to the commission of an act outside Australia which, if it were committed in Australia, would be an offence against this Act.

Aiding and  
abetting  
offences.

Penalty : One hundred pounds.

(2.) The last preceding sub-section does not affect the operation of section five of the *Crimes Act 1914-1955*.

103.—(1.) Goods manufactured outside Australia and having applied to them a trade mark, being, or being substantially identical with, a registered trade mark the registered proprietor or a registered user of which is a manufacturer, dealer or trader in Australia, are,

Prohibition of  
importation of  
goods bearing  
Australian  
trade marks.

if the registered proprietor or registered user notifies the Comptroller-General of Customs in writing that he objects to the importation of the goods, prohibited to be imported and, if imported, may be seized as forfeited to the Commonwealth.

(2.) Subject to the regulations, the Comptroller-General of Customs, or on appeal from him the Minister of State for Trade and Customs, may, if in his opinion the contravention has not occurred either knowingly or negligently, permit goods which are liable to be or have been seized as forfeited under this section to be delivered to the owner or importer upon security being given to the satisfaction of the Comptroller-General—

- (a) that the improper marks will be effectually removed from the goods ;
- (b) that such additions will be made as will render unobjectionable any mark applied to the goods ; or
- (c) that the goods will be forthwith exported.

(3.) The provisions of the *Customs Act* 1901–1954 apply to the seizure and forfeiture of goods under this section as if the goods were prohibited imports under that Act.

(4.) Before taking action under this section or permitting an officer to take action under this section, the Comptroller-General of Customs may require the person requesting the action to give security in accordance with the regulations.

Power to require information in respect of imported goods bearing fraudulent marks.

**104.**—(1.) Where goods which are liable to forfeiture under the last preceding section are imported into Australia and the Comptroller-General of Customs is, upon representations made to him, satisfied that the use of the trade mark is fraudulent, an officer of Customs may require the importer of the goods, or his agent, to produce any documents in his 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.

(2.) The importer or his agent shall, within fourteen days, comply with the requirement.

Penalty : One hundred pounds.

(3.) 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 the registered proprietor or registered user of the trade mark which is alleged to have been used or infringed.

Modification in relation to Territories.

**105.** The regulations may provide for the modification or adaptation of the provisions of the last two preceding sections in relation to a Territory of the Commonwealth to which the *Customs Act* 1901–1954 does not apply.

**106.**—(1.) A person shall be deemed to forge a registered trade mark— What deemed forgery of trade mark.

(a) if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of this Act, he makes the trade mark or a mark substantially identical with it; or

(b) if he falsifies a registered trade mark, whether by alteration, addition, effacement or otherwise.

(2.) In a prosecution for forging a trade mark, the burden of proving the assent of the registered proprietor or registered user lies on the defendant.

**107.**—(1.) A trade mark shall be deemed to be applied to goods if it is woven in, impressed on, worked into, or annexed or affixed to, the goods. When trade mark deemed applied.

(2.) A trade mark shall be deemed to be applied to goods if—

(a) it is applied to the goods themselves;

(b) it is applied to a covering, label, reel or thing in or with which the goods are sold or exposed or had in possession for a purpose of trade or manufacture;

(c) it is used in a manner likely to lead to the belief that it refers to or describes or designates the goods; or

(d) it is used in a sign, advertisement, invoice, wine list, catalogue, business letter, business paper, price list or other commercial document and goods are delivered to a person in pursuance of a request or order made by reference to the trade mark as so used.

(3.) For the purposes of this section, “covering” includes a stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper, and “label” includes a band or ticket.

(4.) A registered trade mark shall be deemed to be falsely applied to goods if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of this Act, the trade mark or a mark substantially identical with it is applied to the goods.

(5.) In a prosecution for falsely applying a registered trade mark to goods, the burden of proving the assent of the registered proprietor or a registered user lies on the defendant.

#### PART XIV.—INTERNATIONAL ARRANGEMENTS.

**108.**—(1.) The Governor-General may, with a view to the fulfilment of a treaty, convention, arrangement or engagement between the Commonwealth and another country, by Proclamation, declare that a country specified in the Proclamation is a Convention country for the purposes of this Act. Convention countries.

(2.) The Governor-General may, by Proclamation, declare a part of the Queen's dominions which has made satisfactory provision for the protection, in that part, of trade marks to be a Convention country for the purposes of this Act.

(3.) Where the Governor-General, by Proclamation, declares that an application for the registration of a trade mark—

(a) is, in accordance with the terms of a treaty subsisting between two or more Convention countries, equivalent to an application made in one of those Convention countries, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country; or

(b) is, in accordance with the law of a Convention country, equivalent to an application made in that Convention country, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country.

Applications  
under  
International  
Conventions.

**109.**—(1.) Where a person has made an application for the registration of a trade mark in a Convention country and that person, or his legal representative or assignee, makes an application for the registration of the trade mark within six months after the date on which the application was made in the Convention country, the trade mark shall, if registered, be registered as of the date on which the application was made in the Convention country and that date shall, subject to sub-section (3.) of this section, be deemed for the purposes of this Act to be the date of registration.

(2.) Where applications have been made for the registration of a trade mark in two or more Convention countries, the period of six months referred to in the last preceding sub-section shall be reckoned from the date on which the earlier or earliest of those applications was made.

(3.) For the purposes of determining the period of registration of the trade mark, the date of registration of the trade mark shall be deemed to be the date on which the application for registration under this Act was made.

Manner of  
application  
under this  
Part.

**110.** An application for the registration of a trade mark under this Part shall be made and dealt with in the same manner as an application otherwise than under this Part.

#### PART XV.—THE APPEAL TRIBUNAL.

Appeal  
Tribunal.

**111.**—(1.) The High Court is the Appeal Tribunal for the purposes of this Act.

(2.) The High Court has jurisdiction to hear and determine appeals which lie to the Appeal Tribunal under this Act.

Jurisdiction to  
be exercised by  
single Justices.

**112.** The jurisdiction of the High Court as the Appeal Tribunal shall be exercised by a single Justice.

Intervention by  
Registrar.

**113.** The Appeal Tribunal may grant to the Registrar leave to intervene in an appeal to the Appeal Tribunal.

- 114.** Upon the hearing of an appeal, the Appeal Tribunal may— Powers of Appeal Tribunal.
- (a) admit further evidence, either orally or upon affidavit or otherwise ;
  - (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence orally or upon affidavit or otherwise at the hearing before the Registrar ;
  - (c) order an issue of fact to be tried in such manner as it directs ;
  - (d) affirm, reverse or modify the decision, determination or direction appealed from ;
  - (e) give such judgment, or make such order, as in all the circumstances it thinks fit, or refuse to make an order ; and
  - (f) order a party to pay costs to another party.

**115.**—(1.) The Appeal Tribunal may state a case or reserve a question for the consideration of a Full Court of the High Court, or may direct a case or question to be argued before a Full Court of the High Court. Special case.

(2.) A Full Court of the High Court has jurisdiction to hear and determine the case or question.

**116.** A Full Court of the High Court has jurisdiction to hear and determine appeals from a judgment or order of the Appeal Tribunal with respect to which a Full Court of the High Court grants leave to appeal. Appeals.

#### PART XVI.—MISCELLANEOUS.

**117.**—(1.) The application in Australia of a trade mark to goods to be exported from Australia and any other act done in Australia in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Australia, would constitute use of a trade mark in Australia, shall, for the purposes of this Act, be deemed to constitute use of the trade mark in relation to those goods. Use of trade mark for export trade.

(2.) The last preceding sub-section shall be deemed to have had effect in relation to an act done before the date of the commencement of this Act as it has effect in relation to an act done after that date, but does not affect a determination of a court which has been made before that date or the determination of an appeal from a determination so made.

**118.** The use of a registered trade mark in relation to goods between which and the person using the trade mark a form of connexion in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of that person a different form of connexion in the course of trade subsisted or subsists. Trade mark not to be deemed to be deceptive or confusing in certain cases.

F.4270/55.—15

Powers of Registrar.

119. The Registrar may, for the purposes of this Act—

- (a) summon witnesses ;
- (b) receive evidence on oath, whether orally or otherwise ;
- (c) require the production of documents or articles ; and
- (d) award costs against a party to proceedings before him.

Disobedience to summons an offence.

120.—(1.) A person who has been summoned to appear as a witness before the Registrar shall not, without lawful excuse, and after tender of reasonable expenses, fail to appear in obedience to the summons.

(2.) A person who has been required by the Registrar to produce a document or article shall not, without lawful excuse, and after tender of reasonable expenses, fail to produce the document or article.

Penalty : Fifty pounds.

Refusal to give evidence an offence.

121. A person who appears before the Registrar as a witness shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents or articles, or to answer questions, which he is lawfully required to produce or answer.

Penalty : Fifty pounds.

Recovery of costs.

122. Costs awarded by the Registrar may, in default of payment, be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were awarded to the person in whose favour they were awarded.

Certificate of validity.

123. In an action or proceeding in which the validity of the registration of a trade mark is unsuccessfully disputed, the court may certify that the validity of the registration of the trade mark came in question and, if the court so certifies, then, in a subsequent action or proceeding in which the validity of the registration of the trade mark is disputed, the registered proprietor of the trade mark, on obtaining a final order or judgment in his favour, is entitled, unless the court trying the action or proceeding otherwise directs, to have his full costs, charges and expenses as between solicitor and client.

Groundless threats of legal proceedings.

124.—(1.) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding for infringement of a trade mark which is registered, or alleged by the first-mentioned person to be registered, or some other like proceeding, a person aggrieved may, whether the person making the threats is or is not the registered proprietor or the registered user of the trade mark, bring an action against the first-mentioned person and may obtain a declaration to the effect that the threats are unjustifiable, and an injunction against the continuance of the threats, and may recover such damages (if any) as he has sustained, unless the first-mentioned person satisfies the court that the trade mark is registered

and that the acts in respect of which the proceedings were threatened constitute, or, if done, would constitute, an infringement of the trade mark.

(2.) The last preceding sub-section does not apply if the registered proprietor of the trade mark, or a registered user acting in pursuance of sub-section (1.) of section seventy-eight of this Act, with due diligence commences and prosecutes an action against the person threatened for infringement of the trade mark.

(3.) Nothing in this section renders a legal practitioner or a patent attorney liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4.) Jurisdiction is, by this section, conferred on the High Court to hear and determine an action under this section, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action.

125. The defendant in an action or proceeding under the last preceding section may apply, by way of counter-claim, for relief to which he would be entitled in a separate action in respect of an infringement by the plaintiff of the trade mark to which the threats relate and in that case the provisions of this Act with respect to an action for infringement of a trade mark are, *mutatis mutandis*, applicable in relation to that action.

Counter-claim  
by defendant  
for  
infringement.

126. In an indictment, information, pleading or proceeding in relation to a registered trade mark, it is not necessary to set out a copy or facsimile of the trade mark or a description of it, but the trade mark may be referred to as a registered trade mark and identified by its registered number.

Description  
of trade marks  
in pleadings.

127.—(1.) The Registrar may, on such terms as to costs or otherwise as he thinks just—

Power of  
amendment.

- (a) whether for the purpose of correcting a clerical error or an obvious mistake or otherwise, permit the amendment of an application for the registration of a trade mark, a notice of opposition or other document lodged at the Trade Marks Office; or
- (b) for the purpose of correcting a clerical error or an obvious mistake, amend the Register or a certificate of registration of a trade mark.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(3.) An amendment of an application shall not be permitted under this section if the amendment would substantially affect the identity of the trade mark as specified in the application before amendment.

Exercise of  
discretionary  
power by  
Registrar.

**128.** Where a discretionary power is, by this Act, given to the Registrar, he shall not exercise that power adversely to a person applying for the exercise of that power without (if so required by that person within such time as is specified by the Registrar) giving to that person an opportunity of being heard.

Fees.

**129.**—(1.) There shall be paid to the Registrar such fees as are prescribed.

(2.) Where—

- (a) a fee is payable in respect of the doing of an act by the Registrar, the Registrar shall not do that act until the fee has been paid ;
- (b) a fee is payable in respect of the doing of an act by a person other than the Registrar, the act shall be deemed not to have been done until the fee has been paid ; or
- (c) a fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.

Extension of  
time.

**130.** Where, by this Act, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.

Power to extend  
times by reason  
of errors in  
Trade Marks  
Office, &c.

**131.**—(1.) Where, by reason of—

- (a) circumstances beyond the control of the person concerned ; or
- (b) an error or action on the part of an officer or person employed in the Trade Marks Office,

an act or step in relation to an application for the registration of a trade mark or in proceedings under this Act (not being proceedings in a court) required to be done or taken within a certain time has not been so done or taken, the Registrar may extend the time for doing the act or taking the step and permit the act to be done or the step to be taken.

(2.) The time required for doing an act or taking a step may be extended under this section although that time has expired.

Address for  
service.

**132.**—(1.) An address for service stated in an application or notice of opposition shall, for the purposes of the application or notice of opposition, be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them by post to the address for service of the applicant or opponent, as the case may be.

(2.) An address for service may be changed by notice in writing to the Registrar.

(3.) The registered proprietor of a trade mark shall from time to time notify the Registrar in writing of any change in his address, and request him to enter the change in the Register, and the Registrar shall alter the Register accordingly.

(4.) The address of the registered proprietor of a trade mark, as appearing for the time being in the Register, shall for all purposes under this Act be deemed to be the address of the registered proprietor.

**133.** If a person is, by reason of infancy, lunacy or other disability, incapable of making a declaration or doing anything required or permitted by this Act, the guardian or committee of the incapable person, or if there is no such guardian or committee, a person appointed by a court, or a Justice or Judge of a court, of the Commonwealth or of a State or Territory of the Commonwealth possessing jurisdiction in respect of the property of incapable persons, upon the petition of a person on behalf of the incapable person, or of some other person interested in the making of the declaration or the doing of the thing, may make the declaration (or a declaration as nearly corresponding to the declaration as the circumstances permit) and may do that thing, in the name and on behalf of the incapable person and all acts so done are, for the purposes of this Act, as effectually done as if they had been done by the incapable person and that person had not been incapable at the time of the making of the declaration or the doing of the thing.

Declaration  
by Infant,  
lunatic, &c.

**134.** If a person who is party to a proceeding under this Act (not being a proceeding in a court) dies pending the proceeding, the Registrar may, on request, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding his successor in interest in his place, or, if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without the substitution of his successor in interest.

Death of  
party to a  
proceeding.

**135.—(1.)** Subject to section one hundred and thirty-eight of this Act, a person shall not, for gain—

Unauthorized  
persons not to  
act in trade  
mark matters.

- (a) apply for or obtain the registration of a trade mark ;
- (b) prepare, or cause to be lodged at the Trade Marks Office, or at a sub-office of the Trade Marks Office, a document necessary for obtaining or opposing the registration of a trade mark ;
- (c) give advice as to the validity of the registration of a trade mark or as to the infringement of a trade mark,

unless he is—

- (d) a legal practitioner ;
- (e) a registered patent attorney ;
- (f) the applicant or the opponent concerned ;
- (g) a person in the sole and permanent employment of the applicant or the opponent concerned ;
- (h) a person who, within one year after the commencement of this Act, has satisfied the Registrar that, for a continuous period of two years immediately before the first day of January, One thousand nine hundred and fifty-five, he was practising as a trade marks agent in Australia ; or

(i) a person who—

(i) within one year after the commencement of this Act, has satisfied the Registrar that, for a continuous period of two years immediately before the first day of January, One thousand nine hundred and fifty-five, he was employed by a registered patent attorney in Australia and his duties related solely or principally to the lodging, prosecuting and opposing of applications for the registration of trade marks ; and

(ii) unless the Registrar otherwise directs, has, within one year after the commencement of this Act or within such further time as the Registrar allows, passed the prescribed examination.

Penalty : One hundred pounds.

(2.) For the purpose of paragraph (h) of the last preceding subsection, a person shall not be deemed to have practised as a trade marks agent unless the only or the principal business carried on by him was the business of lodging, prosecuting and opposing, for gain, applications for the registration of trade marks in Australia on behalf of applicants or opponents.

Privileges of  
patent  
attorneys.

**136.—(1.)** A patent attorney—

(a) is entitled to prepare documents, transact business and conduct proceedings for the purposes of this Act ; and

(b) has such other rights and privileges as are prescribed.

(2.) Nothing in this section authorizes a patent attorney to prepare a document which is to be issued from or filed in a court or to transact business or to conduct proceedings in a court.

Unregistered  
persons not to  
describe  
themselves as  
trade marks  
agents.

**137.—(1.)** Subject to the next succeeding section—

(a) a person shall not describe himself or hold himself out, or permit himself to be described or held out, as a trade marks attorney, trade marks agent or agent for obtaining the registration of trade marks, unless he is a legal practitioner, registered as a patent attorney or a person referred to in paragraph (h) or (i) of sub-section (1.) of section one hundred and thirty-five of this Act ; or

(b) the members of a partnership shall not describe themselves or hold themselves out, or permit themselves to be described or held out, as trade marks attorneys, trade marks agents or agents for obtaining the registration of trade marks, unless each member of the partnership is so registered, is a legal practitioner or is a person referred to in paragraph (h) or (i) of sub-section (1.) of section one hundred and thirty-five of this Act.

Penalty : One hundred pounds.

(2.) A company shall not describe itself or hold itself out, or permit itself to be described or held out, as a trade marks attorney, trade marks agent or agent for obtaining the registration of trade marks.

Penalty : One hundred pounds.

(3.) A director, manager, secretary or other officer of a company which is guilty of an offence against the last preceding sub-section who is knowingly a party to the offence is guilty of an offence punishable, upon conviction, by a fine not exceeding One hundred pounds.

**138.** It is not an offence against section one hundred and thirty-five or section one hundred and thirty-seven of this Act if the legal representative of a deceased patent attorney carries on the business or practice of that deceased patent attorney for a period not exceeding three years from the death of the patent attorney, or, in the case of a patent attorney who died before the date of commencement of the *Patents Act* 1952, for a period of three years from that date, or, in either case, for such further period (if any) as the High Court allows, and is himself a patent attorney or a person entitled to practise as a patent attorney, or employs a patent attorney, or a person entitled to practise as a patent attorney, to manage that business or practice on his behalf.

Carrying on  
business of  
deceased  
patent  
attorney

**139.—(1.)** The regulations may make provision for the amendment of the Register, whether by making, expunging or varying entries in the Register, for the purpose of adapting the designation in the Register of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification of goods which is prescribed.

Adaptation of  
classification.

(2.) An amendment for the purpose referred to in the last preceding sub-section shall not be made if it would have the effect of adding goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of goods.

(3.) The last preceding sub-section does not have effect in relation to goods as to which the Registrar is satisfied—

- (a) that compliance with that sub-section in relation to those goods would involve undue complexity ; and
- (b) that the addition or antedating, as the case may be, would not affect a substantial quantity of goods and would not substantially prejudice the rights of any person.

(4.) A proposal for the amendment of the Register for the purpose referred to in sub-section (1.) of this section—

- (a) shall be notified to the registered proprietor of the trade mark affected ;
- (b) shall be advertised in the *Official Journal* ; and

(c) may be opposed before the Registrar by a person aggrieved on the ground that the proposed amendment contravenes the provisions of sub-section (1.) of this section.

(5.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under this section.

Making and signing of applications.

**140.** Where, by this Act, an application or notice is required or permitted to be made or signed by a person, that application or notice may be made or signed, on behalf of that person, by a patent attorney, legal practitioner or person entitled to practise as a trade marks agent.

Examiners' reports to be communicated.

**141.** A copy of each report of an Examiner under this Act shall be sent to the applicant or registered proprietor of the trade mark concerned, as the case requires.

Security for costs.

**142.** If a person who appeals to the Appeal Tribunal neither resides nor carries on business in Australia, the Appeal Tribunal may require that person to give security for the costs of the appeal, and in default of security being given to the satisfaction of the Appeal Tribunal, the appeal may be dismissed.

Costs of attendance of patent attorney.

**143.** Where, at the hearing of an action or proceeding under this Act, a patent attorney attends in court for the purpose of assisting a party in the conduct of the hearing and an order is made for payment of the costs of that party, those costs may include an allowance in respect of that attendance.

Service of orders on appeal.

**144.—(1.)** Where by this Act provision is made for the service on the Registrar of a judgment or order of a court, and an order is made by the Queen in Council, or by a court, on appeal from such a judgment or order, a person in whose favour the order on appeal is made is not entitled to enforce the order until he has served on the Registrar an office copy of the order.

(2.) Upon the service on him of such an order, the Registrar shall make such entries (if any) in the Register, or take such other action (if any), as the case requires.

Improperly describing an office as the Trade Marks Office.

**145.—(1.)** A person shall not use, in connexion with his business, words which would reasonably lead to the belief that his office is, or is officially connected with, the Trade Marks Office.

Penalty : Twenty pounds.

(2.) Without limiting the effect or application of the last preceding sub-section, a person who—

(a) places, or suffers or permits to be placed, on the building in which his office is situated ;

(b) uses in advertising his office or business ; or

(c) places on a document, as a description of his office or business, the words " Trade Marks Office ", the words " Office for registering trade marks ", or words of similar import, whether alone or in conjunction with other words, shall be deemed to use, in connexion with

his business, words which would reasonably lead to the belief that his office is the Trade Marks Office.

**146.**—(1.) A person shall not make a representation—

- (a) with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark ;
- (b) with respect to a part of a registered trade mark, not being a part separately registered as a trade mark, to the effect that it is so registered ;
- (c) to the effect that a registered trade mark is registered in respect of goods in respect of which it is not registered ; or
- (d) to the effect that the registration of a trade mark gives a right to the exclusive use of the trade mark in circumstances in which, having regard to conditions or limitations entered on the Register, the registration does not give that right.

Falsely  
representing  
a trade mark  
as registered  
an offence.

Penalty : Fifty pounds.

(2.) For the purposes of this section, the use in Australia, in relation to a trade mark, of the word “ registered ”, or of some other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration under this Act, except—

- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated, and indicating that the reference is to registration as a trade mark under the law of a country outside Australia, being a country under the law of which the registration referred to is in force ;
- (b) where that word (being a word other than the word “ registered ”) is of itself such as to indicate that the reference is to such registration as is referred to in the last preceding paragraph ; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Australia and in relation to goods to be exported to that country.

**147.** The Governor-General may make regulations, not inconsistent with this Act, prescribing all matters which by this Act are required or permitted to be prescribed, or which are necessary or convenient to be prescribed for carrying out or giving effect to this Act, or for the conduct of any business relating to the Trade Marks Office, and in particular—

Regulations.

- (a) for providing for the destruction of documents relating to trade marks the registration of which has ceased not less than twenty-five years before the time of destruction ; and
- (b) for prescribing penalties not exceeding a fine of Fifty pounds or imprisonment for six months for offences against the regulations.

## THE SCHEDULE.

Section 4.

FIRST COLUMN. Acts Repealed.	SECOND COLUMN. Extent of Repeal.
<i>Trade Marks Act 1905</i> .. .. .	The whole
<i>Patents Trade Marks and Designs Act 1910</i> .. .. .	Section 4
<i>Trade Marks Act 1912</i> .. .. .	The whole
<i>Trade Marks Act 1919</i> .. .. .	The whole
<i>Trade Marks Act 1922</i> .. .. .	The whole
<i>Trade Marks Act 1936</i> .. .. .	The whole
<i>Trade Marks Act 1948</i> .. .. .	The whole