



Trade Marks and Other Legislation Amendment Act 2001

No. 99, 2001

An Act to amend the *Trade Marks Act 1995*, and for other purposes

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An Act to amend the *Trade Marks Act 1995*, and for other purposes

[Assented to 22 August 2001]

The Parliament of Australia enacts:

1 Short title

This Act may be cited as the *Trade Marks and Other Legislation Amendment Act 2001*.

2 Commencement

- (1) Subject to this section, this Act commences on the 28th day after the day on which it receives the Royal Assent.
- (2) Part 2 of Schedule 1 commences at the later of:
 - (a) the time when Parts 4 to 10 of the *Administrative Review Tribunal Act 2001* commence; and
 - (b) the time immediately after the commencement of section 180A of the *Trade Marks Act 1995*.
- (3) Schedule 2 commences, or is taken to have commenced, immediately after the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

3 Schedule(s)

Subject to section 2, each Act that is specified in a Schedule to this Act is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this Act has effect according to its terms.

Schedule 1—Amendment of the Trade Marks Act 1995

Part 1—General amendments

1 Section 6 (definition of Commission)

Omit “Trade Practices Commission”, substitute “Australian Competition and Consumer Commission”.

2 Section 6

Insert:

working day means a day that is not:

- (a) a Saturday; or
- (b) a Sunday; or
- (c) a public holiday in the Australian Capital Territory.

3 Paragraph 26(1)(b)

Repeal the paragraph, substitute:

- (b) the authorised user may (subject to subsection (2)) bring an action for infringement of the trade mark:
 - (i) at any time, with the consent of the registered owner; or
 - (ii) during the prescribed period, if the registered owner refuses to bring such an action on a particular occasion during the prescribed period; or
 - (iii) after the end of the prescribed period, if the registered owner has failed to bring such an action during the prescribed period;

4 Application of amendment—section 26 of the Trade Marks Act 1995

The amendment of section 26 of the *Trade Marks Act 1995* made by this Schedule applies in relation to a prescribed period that begins at or after the commencement of this item.

5 Transitional—paragraph 26(1)(b) of the Trade Marks Act 1995

- (1) This item applies to regulations if:
 - (a) the regulations were made for the purposes of paragraph 26(1)(b) of the *Trade Marks Act 1995*; and
 - (b) the regulations were in force immediately before the commencement of this item.
- (2) The regulations have effect, after the commencement of this item, as if they were made for the purposes of the corresponding provision of that Act as amended by this Schedule.

6 Subsection 45(1)

Omit “A person who has made an application (*initial application*) for the registration of a trade mark in respect of certain goods and/or services”, substitute “If an application (*initial application*) for the registration of a trade mark in respect of certain goods and/or services is pending, the applicant”.

7 At the end of subsection 45(1)

Add:

Note 1: For *applicant* see section 6.

Note 2: For *pending* see section 6.

8 At the end of section 45

Add:

- (3) To avoid doubt, subsection (2) does not prevent a divisional application from being made by a person who has become the applicant in relation to the initial application because of subsection 108(2) (which deals with assignment and transmission).

9 Section 46

Repeal the section.

10 At the end of subsection 52(2)

Add “or in accordance with subsection (5)”.

11 At the end of section 52

Add:

- (5) If:
- (a) a person is granted an extension of time in which to file a notice of opposition; and
 - (b) before the notice of opposition is filed, the right or interest on which the person could have relied to file the notice of opposition becomes vested in another person; and
 - (c) the other person notifies the Registrar in writing that the right or interest is vested in him or her;
- then:
- (d) the other person is taken to have been granted an extension of time in which to file the notice of opposition; and
 - (e) that extension ends when the extension mentioned in paragraph (a) ends.

12 Application of amendments—section 52 of the Trade Marks Act 1995

The amendments of section 52 of the *Trade Marks Act 1995* made by this Schedule apply in relation to a right or interest that becomes vested in another person at or after the commencement of this item.

13 Subsection 63(2)

Omit all the words after “amend the application”, substitute:

as necessary:

- (c) to remove any ground on which the application could be rejected; or
- (d) so as to ensure that the application is made in accordance with this Act.

14 Paragraph 68(1)(b)

Repeal the paragraph, substitute:

- (b) in a case where there has been an opposition:
 - (i) if the Registrar’s decision, or (in the case of an appeal against the Registrar’s decision) the decision on appeal, is that the trade mark should be registered; or
 - (ii) if the opposition has been withdrawn; or
 - (iii) if the opposition has been dismissed under section 222.

15 Transitional—subsection 68(1) of the Trade Marks Act 1995

- (1) This item applies if, before the commencement of this item, the Registrar purported to register a trade mark under subsection 68(1) of the *Trade Marks Act 1995* on the basis that there had been an opposition, but:
 - (a) the opposition had been withdrawn; or
 - (b) the opposition had been dismissed under section 222 of that Act.
- (2) The registration is as valid as it would have been if the amendment of subsection 68(1) of that Act made by this Schedule had been in force at the time of the registration.

16 Section 73

After “section 78 or”, insert “80F or under”.

17 Division 2 of Part 7 (heading)

Repeal the heading, substitute:

Division 2—Renewal of registration (general)

18 Before section 75

Insert:

74A Application of this Division

This Division applies to a registered trade mark if:

- (a) particulars of registration were entered in the Register under section 69 before the end of the period of 10 years after the filing date of the application for registration; or
- (b) both:
 - (i) paragraph (a) does not apply; and
 - (ii) registration has already been renewed under Division 3 for a period that includes the day on which particulars of registration were entered in the Register under section 69.

Note: For *filing date* see section 6.

19 Section 78

After “not renewed”, insert “under section 77”.

20 Paragraph 80(a)

After “renewed”, insert “under section 77 or 79”.

21 Paragraph 80(b)

Omit “within 12 months after the registration expired, an application for the registration of a trade mark is made”, substitute “an application for the registration of a trade mark is made, or has already been made,”.

22 At the end of section 80

Add “at any time when the registration of the unrenewed trade mark could have been renewed under section 79”.

23 Transitional—Division 2 of Part 7 of the Trade Marks Act 1995

- (1) This item applies if, before the commencement of this item:
 - (a) the Registrar purported to renew registration of a trade mark under section 77 or 79 of the *Trade Marks Act 1995*; and
 - (b) particulars of registration were entered in the Register under section 69 of that Act after the end of the period of 10 years after the filing date of the application for registration.
- (2) In the case of a purported renewal under section 77, the renewal is as valid as it would have been if, at the time of the request for renewal:
 - (a) the words “, within the prescribed period before the registration of a trade mark expires,” were omitted from subsection 75(1) of the *Trade Marks Act 1995*; and
 - (b) the words “of a trade mark” had been added at the end of that subsection.

- (3) In the case of a purported renewal under section 79, the renewal is as valid as it would have been if, at the time of the request for renewal, the words “, within 12 months after the registration of a trade mark has expired,” were omitted from that section.

24 At the end of Part 7

Add:

Division 3—Renewal of registration (registration delayed for 10 or more years after filing date)

80A Application of this Division

- (1) This Division applies to a registered trade mark if particulars of registration were entered in the Register under section 69 on a day (*Register entry day*) that occurs after the end of the period of 10 years after the filing date of the application for registration.

Note: For *filing date* see section 6.

- (2) For the purposes of this Division, each of the following is a *potential renewal period* in relation to the registered trade mark:
- (a) the period (*first potential renewal period*) of 10 years that commenced 10 years after the filing date of the application for registration;
 - (b) any successive period of 10 years, being a period that commences before the Register entry day.
- (3) For the purposes of this Division, the *prescribed period* is a period that:
- (a) is specified in the regulations; and
 - (b) commences on the Register entry day.

80B Expiry of registration

To avoid doubt, the registration of the trade mark is taken to have expired, in accordance with subsection 72(3), 10 years after the filing date of the application for registration.

Note: For *filing date* see section 6.

80C Notice about renewal

As soon as practicable after the Register entry day, the Registrar must, in accordance with the regulations, notify the registered owner of the trade mark that a request may be made for renewal of the registration.

Note: For *registered owner* see section 6.

80D Request for renewal

- (1) Any person may, within the prescribed period, ask the Registrar to renew, or successively renew, the registration of the trade mark for one or more potential renewal periods nominated in the request.

- (2) The nomination must cover at least the first potential renewal period.
- (3) If the nomination relates to more than one potential renewal period, the nomination must cover continuous periods.
- (4) The request must:
 - (a) be in an approved form; and
 - (b) be filed in accordance with the regulations.

80E Renewal within prescribed period

- (1) If a request for the renewal of the registration of the trade mark is made in accordance with section 80D, the Registrar must renew, or successively renew, the registration for the potential renewal period or periods to which the request relates.
- (2) The Registrar must give notice of the renewal or renewals to the registered owner of the trade mark in accordance with the regulations.

Note: For *registered owner* see section 6.

80F Failure to renew

If the registration of the trade mark is not renewed under section 80E, or is not renewed under section 80E for each of the potential renewal periods, then:

- (a) subject to sections 80G and 80H, the registration ceases to have effect:
 - (i) if the registration was not renewed under section 80E—when it expired in accordance with section 72(3); or
 - (ii) if the registration was renewed under section 80E for one or more potential renewal periods—at the end of the last of those periods; and
- (b) unless the registration is renewed under section 80G, the Registrar must remove the trade mark from the Register 10 months after the end of the prescribed period.

80G Renewal within 10 months after end of prescribed period

- (1) If:
 - (a) the registration of the trade mark is not renewed under section 80E; and
 - (b) within 10 months after the end of the prescribed period, a person asks the Registrar to renew, or successively renew, the registration of the trade mark for one or more potential renewal periods nominated in the request;
 the Registrar must renew, or successively renew, the registration for the potential renewal period or periods to which the request relates.
- (2) The nomination must cover at least the first potential renewal period.
- (3) If the nomination relates to more than one potential renewal period, the nomination must cover continuous periods.
- (4) The request must:

- (a) be in an approved form; and
- (b) be filed in accordance with the regulations.

80H Status of unrenewed trade mark

If:

- (a) the registration of the trade mark is not renewed under section 80E; and
 - (b) the registration of the trade mark (*unrenewed trade mark*) has not been renewed under section 80G; and
 - (c) an application for the registration of a trade mark is made, or has already been made, by a person other than the person who was registered as the owner of the unrenewed trade mark;
- the unrenewed trade mark is taken to be a registered trade mark for the purposes of the application at any time when the registration of the unrenewed trade mark could have been renewed under section 80G.

25 Paragraph 88(2)(d)

Repeal the paragraph.

26 After section 96

Insert:

96A Circumstances in which opposition may proceed in name of a person other than the person who filed the notice

If:

- (a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested in another person; and
- (b) the other person:
 - (i) notifies the Registrar or the court (as the case may be) in writing that the right or interest is vested in him or her; and
 - (ii) does not withdraw the opposition;

the opposition is to proceed as if the notice of opposition had been filed in that other person's name.

Note: For *file* see section 6.

27 After paragraph 122(1)(f)

Insert:

- (fa) both:
 - (i) the person uses a trade mark that is substantially identical with, or deceptively similar to, the first-mentioned trade mark; and

- (ii) the court is of the opinion that the person would obtain registration of the substantially identical or deceptively similar trade mark in his or her name if the person were to apply for it; or

28 Paragraph 127(b)

Repeal the paragraph, substitute:

- (b) either:
 - (i) the defendant has applied to the court under subsection 92(3) for an order directing the Registrar to remove the trade mark from the Register in respect of those goods or services; or
 - (ii) the defendant has applied to the Registrar under subsection 92(1) for the trade mark to be removed from the Register in respect of those goods or services, and the matter has been referred to a court under section 94; and

29 Section 128

Omit “(under section 79)”, substitute “under section 79”.

30 At the end of section 128

Add:

- (2) If the registration of a trade mark is renewed under section 80G within 10 months after the end of the prescribed period, an action may not be brought in respect of an act that:
 - (a) infringed the trade mark; and
 - (b) was done after the end of the prescribed period and before the registration was renewed.
- (3) In subsection (2):

prescribed period has the same meaning as in Division 3 of Part 7.

31 Subsection 132(3)

Repeal the subsection, substitute:

- (3) The authorised user may give the notice to the Customs CEO:
 - (a) at any time, with the consent of the registered owner; or
 - (b) during the prescribed period, if the registered owner refuses to comply with the request on a particular occasion during the prescribed period; or
 - (c) after the end of the prescribed period, if the registered owner has failed to give such a notice during the prescribed period.
 The authorised user must give also to the Customs CEO, together with the notice:
 - (d) any document prescribed for the purposes of subsection (1); and
 - (e) any other prescribed document.

32 Application of amendment—section 132 of the Trade Marks Act 1995

The amendment of section 132 of the *Trade Marks Act 1995* made by this Schedule applies in relation to a prescribed period that begins at or after the commencement of this item.

33 Transitional—subsection 132(3) of the Trade Marks Act 1995

- (1) This item applies to regulations if:
 - (a) the regulations were made for the purposes of subsection 132(3) of the *Trade Marks Act 1995*; and
 - (b) the regulations were in force immediately before the commencement of this item.
- (2) The regulations have effect, after the commencement of this item, as if they were made for the purposes of the corresponding provision of that Act as amended by this Schedule.

34 Subsection 137(5)

Omit “3 weeks”, substitute “20 working days”.

35 Subsection 137(5)

After “court”, insert “directed at the Customs CEO”.

36 Section 138 (note 3)

Omit “26(b)”, substitute “26(1)(b)”.

37 Section 138 (note 3)

Omit “refuses or neglects to do so”, substitute “gives consent to the bringing of such an action or refuses or fails to bring such an action”.

38 Section 158

Repeal the section.

39 Section 159

Omit “trial”, substitute “prosecution”.

40 Section 159

Omit “Division 2 of Part II of the *Proceeds of Crime Act 1987* applies as if a reference in that Division”, substitute “the forfeiture order provisions apply as if a reference in those provisions”.

41 At the end of section 159

Add:

- (2) In this section:

forfeiture order provisions means:

- (a) Division 1 of Part II of the *Proceeds of Crime Act 1987*, to the extent to which that Division relates to forfeiture orders; and
- (b) Division 2 of Part II of the *Proceeds of Crime Act 1987*.

42 Section 170

Omit “paragraph 88(2)(d),”.

43 After section 180

Insert:

180A Assignment of unregistered certification trade mark

- (1) If:
 - (a) an application has been made for the registration of a certification trade mark; and
 - (b) a copy of the application has been sent to the Commission, but the certification trade mark has not been registered;
 the certification trade mark may be assigned only with the consent of the Commission.
- (2) An application to the Commission for its consent to the assignment of a certification trade mark must be in accordance with the regulations.
- (3) In deciding whether or not to give its consent, the Commission must have regard to the matters provided for under the regulations.
- (4) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Commission refusing to give its consent.

44 Section 186

Omit “paragraph 88(2)(d),”.

45 Paragraph 222(a)

Omit “this Act”, substitute “section 52 or subsection 224(6)”.

46 After section 254

Insert:

254A Acts not constituting infringement of trade mark—pending application under the repealed Act

- (1) This section applies if:
 - (a) an application for the registration of a trade mark under the repealed Act was pending immediately before 1 January 1996; and
 - (b) immediately before 1 January 1996, a person was engaging in conduct that would not have constituted an infringement of the mark if the mark had been registered under the repealed Act before 1 January 1996; and
 - (c) the person has, on or after that day, continuously engaged in, and is engaging in, that conduct; and
 - (d) the mark becomes a registered trade mark under this Act; and
 - (e) that conduct is an infringement of the registered trade mark under this Act.
- (2) Despite section 120, the person does not infringe the registered trade mark by engaging in that conduct.

254B Part B defence—INFRINGEMENT OF EXISTING REGISTERED MARK

- (1) This section applies if:
 - (a) immediately before 1 January 1996, a person was engaging in conduct that constituted an infringement of a mark registered under the repealed Act; and
 - (b) the mark is an existing registered mark for the purposes of this Act; and
 - (c) the mark was registered in Part B of the old register before 1 January 1996; and
 - (d) the person has, on or after that day, continuously engaged in, and is engaging in, that conduct; and
 - (e) that conduct is an infringement of the existing registered mark under this Act.
- (2) In an action for infringement of the existing registered mark (not being an infringement occurring by reason of an act referred to in section 121), an injunction or other relief must not be granted if the person establishes to the satisfaction of the court that the use of the mark is not likely to:
 - (a) deceive or cause confusion; or
 - (b) be taken as indicating a connection in the course of trade between the goods and/or services in respect of which the trade mark is registered and a person having the right, either as registered owner or as authorised user, to use the trade mark.

Note: For *existing registered mark* see section 6.

254C Part B defence—INFRINGEMENT OF TRADE MARK (PENDING APPLICATION UNDER THE REPEALED ACT)

- (1) This section applies if:
 - (a) an application for the registration of a trade mark in Part B of the old register was pending immediately before 1 January 1996; and
 - (b) immediately before 1 January 1996, a person was engaging in conduct that would have constituted an infringement of the mark if the mark had been registered in Part B of the old register before 1 January 1996; and

- (c) the person has, on or after that day, continuously engaged in, and is engaging in, that conduct; and
 - (d) the mark becomes a registered trade mark under this Act; and
 - (e) that conduct is an infringement of the registered trade mark under this Act.
- (2) In an action for infringement of the registered trade mark (not being an infringement occurring by reason of an act referred to in section 121), an injunction or other relief must not be granted if the person establishes to the satisfaction of the court that the use of the mark is not likely to:
- (a) deceive or cause confusion; or
 - (b) be taken as indicating a connection in the course of trade between the goods and/or services in respect of which the trade mark is registered and a person having the right, either as registered owner or as authorised user, to use the trade mark.

Note: For *existing registered mark* see section 6.

Note: The heading to section 254 is altered by omitting “**trade**” and substituting “**existing registered**”.

Part 2—Amendment relating to the Administrative Review Tribunal

47 Subsection 180A(4)

Omit “Administrative Appeals Tribunal”, substitute “Administrative Review Tribunal”.

Schedule 2—Amendment of the Patents Amendment (Innovation Patents) Act 2000

1 Subitem 2(2) of Schedule 2

Omit “88 and 89”, substitute “89 and 90”.

2 Item 7 of Schedule 2

Omit “85, 86, 88 and 89” (wherever occurring), substitute “86, 87, 89 and 90”.

*[Minister’s second reading speech made in—
House of Representatives on 4 April 2001
Senate on 28 June 2001]*
