

**TRADE MARKS ACT 1955 [Note: This Act is "repealed" by Act No. 156 of  
1994 (#DATE 06:07:1994)]**

- Updated as at 6 July 1994

\*1\* The Trade Marks Act 1955 as shown in this reprint comprises Act No. 1955 amended as indicated in the Tables below.

Table of Acts

Act Number and year	Date of Assent	Date of commencement	Applic saving transi provis
Trade Marks Act 1955 20, 1955	15 June 1955	1 Aug 1958 (see Gazette 1958, p. 2115)	
Trade Marks Act 1958 42, 1958	23 Sept 1958	23 Sept 1958	-
Statute Law Revision (Decimal Currency) Act 1966			

93, 1966	29 Oct 1966	1 Dec 1966	-
Statute Law Revision Act 1973			
216, 1973	19 Dec 1973	31 Dec 1973	Ss. 9 10
Administrative Changes (Consequential Provisions) Act 1976			
91, 1976	20 Sept 1976	S. 3: (a)	S. 4
Trade Marks Amendment Act 1976			
163, 1976	9 Dec 1976	Ss. 3, 4, 7 and 10: 1 Feb 1977 (see Gazette 1977, No. S3, p. 3) Remainder: Royal Assent	Ss. 9 10 (2)
Trade Marks Amendment Act 1978			
130, 1978	31 Oct 1978	1 Feb 1979 (see Gazette 1979, No. S14)	-
Jurisdiction of Courts (Miscellaneous Amendments) Act 1979			
19, 1979	28 Mar 1979	Parts II-XVII (ss. 3-123): 15 May 1979 (see Gazette 1979, No. S86) Remainder: Royal Assent	S. 124
Trade Marks Amendment Act 1981			
43, 1981	13 May 1981	22 June 1981 (see Gazette 1981, No. G24, p. 2)	Ss. 5 and 10
Statute Law Revision Act 1981			
61, 1981	12 June 1981	Part XXII (ss. 103, 104): 1 Feb 1977 (b)	-
Statute Law (Miscellaneous Amendments) Act (No. 2) 1982			
80, 1982	22 Sept 1982	Part LXXVII (s. 280): Royal Assent (c)	S. 280 and (3

Statute Law (Miscellaneous Provisions) Act (No. 1) 1984			
72, 1984	25 June 1984	S. 3: 23 July 1984 (d)	-
Statute Law (Miscellaneous Provisions) Act (No. 1) 1985			
65, 1985	5 June 1985	S. 3: 3 July 1985 (e)	-
Statute Law (Miscellaneous Provisions) Act (No. 2) 1985			
193, 1985	16 Dec 1985	S. 3: Royal Assent (f)	Ss. 14
Jurisdiction of Courts (Miscellaneous Amendments) Act 1987			
23, 1987	26 May 1987	S. 3: (g)	S. 5
Industry, Technology and Commerce Legislation Amendment Act 1989			
91, 1989	27 June 1989	S. 15: 14 Dec 1988	S. 27
		Part 4 (ss. 20-25):	
		30 Nov 1989 (see	
		Gazette 1989, No. S371)	
		Part 5 (ss. 26, 27):	
		1 Aug 1989 (see Gazette	
		1989, No. S262)	
		Remainder: Royal Assent	
Industry, Technology and Commerce Legislation Amendment Act (No. 2)			
10, 1990	17 Jan 1990	Ss. 40 and 43-49:	S. 42
		14 Feb 1990 (h)	S. 2 (
		Ss. 41 and 42: 30 Apr	(am. b
		1991 (h)	1992,
		as amended by	
		Patents Act 1990	
		83, 1990	
	30 Oct 1990	30 Apr 1991	-
Patents Act 1990			
83, 1990	30 Oct 1990	30 Apr 1991	-
Industry, Technology and Commerce Legislation Amendment Act 1992			
168, 1992	11 Dec 1992	Part V (ss. 14, 15):	-
		30 July 1975	

Remainder: Royal Assent

Industry, Technology and Regional Development Legislation Amendment  
1994

58, 1994            9 Apr 1994            29 June 1994 (see            S. 4 (  
Gazette 1994 No. S211)

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(a) The Trade Marks Act 1955 was amended by section 3 only of the Administrative Changes (Consequential Provisions) Act 1976, subsection of which provides as follows:

"(7) The amendments of each other Act specified in the Schedule made Act shall be deemed to have come into operation on 22 December 1975."

(b) The Trade Marks Act 1955 was amended by Part XXII (sections 103 a only of the Statute Law Revision Act 1981, subsection 2 (9) of which pr as follows:

"(9) Part XXII shall be deemed to have come into operation on 1 Febru 1977."

(c) The Trade Marks Act 1955 was amended by Part LXXVII (section 280) of the Statute Law (Miscellaneous Amendments) Act (No. 2) 1982, subsect (1) of which provides as follows:

"(1) Sections 1, 2, 166 and 195 and Parts III, VI, VII, XVI, XXXVI, X LI, LIII, LIV, LXI and LXXVII shall come into operation on the day on w this Act receives the Royal Assent."

(d) The Trade Marks Act 1955 was amended by section 3 only of the Sta Law (Miscellaneous Provisions) Act (No. 1) 1984, subsection 2 (1) of wh provides as follows:

"(1) Subject to this section, this Act shall come into operation on t twenty-eighth day after the day on which it receives the Royal Assent."

(e) The Trade Marks Act 1955 was amended by section 3 only of the Sta Law (Miscellaneous Provisions) Act (No. 1) 1985, subsection 2 (1) of wh

provides as follows:

"(1) Subject to this section, this Act shall come into operation on t  
twenty-eighth day after the day on which it receives the Royal Assent."

(f) The Trade Marks Act 1955 was amended by section 3 only of the Sta  
Law (Miscellaneous Provisions) Act (No. 2) 1985, subsection 2 (1) of wh  
provides as follows:

"(1) Subject to this section, this Act shall come into operation on t  
on which it receives the Royal Assent."

(g) The Trade Marks Act 1955 was amended by section 3 only of the  
Jurisdiction of Courts (Miscellaneous Amendments) Act 1987, subsection  
of which provides as follows:

"(2) The amendments made by this Act to an Act specified in the Sched  
shall come into operation on such day as is fixed by Proclamation in re  
to those amendments."

The date fixed in pursuance of subsection 2 (2) was 1 September 1987  
Gazette 1987, No. S217).

(h) The Trade Marks Act 1955 was amended by sections 40-49 only of th  
Industry, Technology and Commerce Legislation Amendment Act (No. 2) 198  
subsections 2 (3) and (7) of which provide as follows:

"(3) Subsection 15 (1), sections 18, 41 and 42, and Part 6, commence  
same day as the Patents Act 1990.

"(7) The remaining provisions of this Act commence 28 days after this  
receives the Royal Assent."

Table of Amendments

ad=added or inserted am=amended rep=repealed rs=repealed and substi

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Provision affected

How affected

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S. 3

rep. No. 216, 1973

Ss. 4, 5	am. No. 163, 1976
S. 6	am. No. 216, 1973; No. 163, 1976; No. 1978; No. 193, 1985; No. 23, 1987; No and 83, 1990
S. 6A	ad. No. 163, 1976 am. No. 43, 1981
S. 8	rs. No. 163, 1976
S. 10	am. No. 42, 1958; Nos. 91 and 163, 19 No. 91, 1989; No. 10, 1990; No. 58, 1
S. 11	rs. No. 91, 1989; No. 58, 1994
S. 14	am. No. 163, 1976
S. 14A	ad. No. 10, 1990
Ss. 16, 17	am. No. 10, 1990
S. 18	am. No. 163, 1976; No. 65, 1985
Ss. 19, 20	am. No. 163, 1976; No. 130, 1978; No. 1987
S. 21	am. No. 163, 1976; No. 23, 1987
S. 22	am. No. 163, 1976
S. 23	am. No. 163, 1976; No. 130, 1978; No. 1987
Ss. 24, 25	am. No. 130, 1978
S. 26	am. No. 163, 1976; No. 130, 1978; No. 1987
S. 27	am. No. 163, 1976
S. 29	am. No. 216, 1973
S. 30	am. No. 163, 1976; No. 23, 1987
S. 31	am. No. 130, 1978
S. 32	am. No. 163, 1976
S. 33	am. No. 130, 1978
Ss. 34, 35	am. No. 163, 1976; No. 130, 1978

S. 36	am. No. 163, 1976; No. 130, 1978; No. 1984; No. 23, 1987
S. 38	am. No. 163, 1976
Ss. 39, 40	am. No. 163, 1976; No. 130, 1978
S. 40A	ad. No. 10, 1990
S. 42	am. No. 163, 1976; No. 23, 1987
S. 43	am. No. 163, 1976; No. 130, 1978; No. 1987
S. 45	am. No. 163, 1976; No. 130, 1978
S. 46	am. No. 163, 1976; No. 23, 1987
S. 48	am. No. 163, 1976; No. 19, 1979
S. 49	am. No. 163, 1976
S. 51	am. No. 163, 1976; No. 23, 1987
S. 54	am. No. 163, 1976; No. 19, 1979; No. 1987
S. 55	am. No. 163, 1976
S. 56	am. No. 163, 1976; No. 130, 1978
S. 58	am. No. 163, 1976; No. 130, 1978
S. 59	am. No. 163, 1976
Ss. 60, 61	am. No. 163, 1976; No. 130, 1978
S. 62	am. No. 130, 1978
S. 64	am. No. 163, 1976; No. 130, 1978
S. 67	am. No. 163, 1976 rs. No. 43, 1981
S. 68	am. No. 130, 1978
Ss. 69-72	am. No. 163, 1976
Ss. 74, 75	am. No. 163, 1976; No. 130, 1978
S. 76	am. No. 130, 1978
S. 77	am. No. 163, 1976; No. 130, 1978
S. 78	am. No. 163, 1976

S. 81	am. No. 163, 1976; No. 23, 1987
S. 82	am. No. 163, 1976; No. 130, 1978
Ss. 83-85	am. No. 130, 1978
S. 86	am. No. 163, 1976; No. 130, 1978; No. 1981; No. 23, 1987
S. 88	am. No. 163, 1976; No. 130, 1978
S. 90	am. No. 163, 1976
S. 92	am. No. 163, 1976
Ss. 93, 94	am. No. 163, 1976; No. 130, 1978
S. 98	am. No. 163, 1976; No. 130, 1978; No. 1985; No. 168, 1992
Ss. 99, 100	am. No. 93, 1966; No. 163, 1976; No. 1985 rs. No. 168, 1992
S. 101	am. No. 163, 1976 rep. No. 168, 1992

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THE SCHEDULE

Repeal of Acts

**TRADE MARKS ACT 1955 - LONG TITLE**

**SECT**

An Act relating to Trade Marks

## **TRADE MARKS ACT 1955 - PART I**

### **PART I - PRELIMINARY**

## **TRADE MARKS ACT 1955 - SECT 1**

### **Short title**

## **SECT**

1. This Act may be cited as the Trade Marks Act 1955.\*1\*  
SEE NOTES TO FIRST ARTICLE OF THIS CHAPTER .

## **TRADE MARKS ACT 1955 - SECT 2**

### **Commencement**

## **SECT**

2. This Act shall come into operation on a date to be fixed by  
Proclamation.\*1\*  
SEE NOTES TO FIRST ARTICLE OF THIS CHAPTER .

## **TRADE MARKS ACT 1955 - SECT 4**

## **Repeal**

## **SECT**

4. The Acts specified in the first column of the Schedule are repealed to the extent respectively specified in the second column of that Schedule

### **TRADE MARKS ACT 1955 - SECT 5** **Application of Act**

## **SECT**

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 in relation to trade marks registered on those applications.

(2) Subject to section 90, this Act also applies to and in relation to trade marks registered under the repealed Acts and those trade marks shall, to the next succeeding subsection, be deemed to be registered in Part A Register.

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



(4) Subject to section 90, 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 in relation to trade marks so registered and those trade marks shall, subject to the next succeeding subsection, 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 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.

## **TRADE MARKS ACT 1955 - SECT 6**

### **Interpretation**

## **SECT**

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

"assignment" means assignment by act of the parties concerned;

"Australia" includes Norfolk Island;

"Convention country" means a country in respect of which there is in for the time being a regulation under section 108 declaring that country a Convention country for the purposes of this Act;

"Deputy Registrar" means a Deputy Registrar of Trade Marks;

"Federal Court" means the Federal Court of Australia;

"legal practitioner" means a barrister or solicitor of the High Court the Supreme Court of a State or Territory;

"limitations" means limitations of the right to the exclusive use of mark given by the registration of the trade mark, including limitations 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 Austr

"mark" includes a device, brand, heading, label, ticket, name, signat word, letter or numeral, or any combination thereof;

"Official Journal" has the same meaning as in the Patents Act 1990;

"permitted use", in relation to a registered trade mark, means the us the trade mark:

(a) by a registered user of the trade mark in relation to goods or services:

(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 corpo

unincorporate;

"prescribed court" means the Federal Court, the Supreme Court of a State or Territory, the Supreme Court of the Australian Capital Territory, the Supreme Court of the Northern Territory of Australia or the Supreme Court of Norfolk Island;

"registered proprietor", in relation to a trade mark, means the person who, at 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 74;

"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 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 or services for the purpose of indicating, or so as to indicate, a connexion in the course of trade between the goods or services 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 the Register;

"transmission" means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transmission 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 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 the trade mark as to be likely to deceive or cause confusion.

## **TRADE MARKS ACT 1955 - SECT 6A**

### **References to prescribed courts**

## **SECT**

6A. A reference in this Act to a prescribed court shall be read:

(a) in relation to the institution of an appeal or other proceeding, reference to a prescribed court having jurisdiction with respect to matters arising under this Act in respect of which the appeal or other proceeding instituted; and

(b) in relation to the exercise of jurisdiction, as a reference to a prescribed court exercising jurisdiction in accordance with section 112

**TRADE MARKS ACT 1955 - SECT 7**  
**Crown to be bound**

**SECT**

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

**TRADE MARKS ACT 1955 - SECT 8**  
**Application of Act to Norfolk Island**

**SECT**

8. (1) This Act extends to Norfolk Island.

(2) An application for registration of a trade mark is not receivable a law (other than this Act) in force in Norfolk Island.

**TRADE MARKS ACT 1955 - SECT 9**  
**No new application to be made under State Acts**

**SECT**

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

## **TRADE MARKS ACT 1955 - PART II**

### **PART II - ADMINISTRATION**

## **TRADE MARKS ACT 1955 - SECT 10**

### **Registrar and other officers**

## **SECT**

10. (1) There is to be a Registrar of Trade Marks.

(1A) The Registrar has such powers and functions as are conferred on her under this Act or any other Act.

(3) There is to be at least one Deputy Registrar of Trade Marks.

(3A) Subject to any direction by the Registrar, a Deputy Registrar has the powers and functions of the Registrar under this Act or any other Act except the Registrar's powers of delegation under section 11.

(3B) A power or function of the Registrar under this Act or any other when exercised or performed by a Deputy Registrar, shall, for the purpose of this Act or any other Act, be taken to have been exercised or performed by the Registrar.

(3C) The exercise of a power, or the performance of a function, of the Registrar under this Act or any other Act by a Deputy Registrar does not prevent the exercise of the power, or the performance of the function, by the Registrar.

(4) Where, under this Act or any other Act, the exercise of a power or function by the Registrar, or the operation of a provision of this Act or any other Act, depends on the opinion, belief or state of mind of the Registrar in relation to a matter:

(a) that power or function may be exercised by a Deputy Registrar on the opinion, belief or state of mind of the Deputy Registrar in relation to that matter; and

(b) that provision may operate on the opinion, belief or state of mind of the Deputy Registrar in relation to that matter.

(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.

## **TRADE MARKS ACT 1955 - SECT 11**

### **Delegation by Registrar**

## **SECT**

11. (1) The Registrar may, by writing, delegate all or any of the Registrar's powers under this Act or any other Act to:

(a) a prescribed person, or a prescribed class of persons, holding or performing the duties of an Australian Public Service office in the Trade Marks Office; or

(b) a prescribed employee, or a prescribed class of employees, employed in the Trade Marks Office.

(2) In this section:

"employee" has the same meaning as in the Public Service Act 1922.

## **TRADE MARKS ACT 1955 - SECT 12** **Trade Marks Office and sub-offices**

## **SECT**

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

(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 Marks Office may be lodged at a sub-office of the Trade Marks Office an 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.

## **TRADE MARKS ACT 1955 - SECT 13**

### **Seal of Trade Marks Office**

## **SECT**

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

## **TRADE MARKS ACT 1955 - PART III**

### **PART III - THE REGISTER OF TRADE MARKS**

## **TRADE MARKS ACT 1955 - SECT 14**

### **Register of Trade Marks**

## **SECT**

14. (1) There shall be kept at the Trade Marks Office a Register of T 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 4 parts, which shall be known A, Part B, Part C and Part D, respectively.

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

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

## **TRADE MARKS ACT 1955 - SECT 14A**

### **Register may be kept wholly or partly by computer**

## **SECT**

14A. (1) The Register may be kept wholly or partly by use of a comput

(2) If the Register is kept wholly or partly by use of a computer:

(a) references in this Act to an entry in the Register include refere  
a record of particulars kept by use of the computer and comprising the  
Register or part of the Register; and

(b) references in this Act to particulars being registered, or entered in the Register, include references to the keeping of a record of those particulars as part of the Register by use of the computer; and

(c) references in this Act to the amendment, alteration or rectification of the Register include references to the amendment, alteration or rectification of the record of particulars kept by use of the computer and comprising the Register or part of the Register.

## **TRADE MARKS ACT 1955 - SECT 15**

### **Trusts not to be noticed**

## **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 16**

### **Inspection of Register**

## **SECT**

16. (1) The Register shall be open to the inspection of the public at convenient times.

(2) If a record of particulars is kept by use of a computer, subsection 17(1) is to be taken to be complied with, to the extent that the Register contains those particulars, by giving members of the public access to a computer terminal which they can use to inspect the particulars, either on a screen or in the form of a computer printout.

## **TRADE MARKS ACT 1955 - SECT 17**

### **Register and certified copies to be evidence**

#### **SECT**

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

(1A) If the Register is wholly or partly kept by use of a computer, a document signed by the Registrar and reproducing in writing all or any particulars comprising the Register, or that part of it, is admissible in legal proceedings as prima facie evidence of those particulars so reproduced.

(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 hand and the seal of the Trade Marks Office:

(a) that an entry, matter or thing required by or under this Act or t repealed Acts to be made or done, or not to be made or done, has, or ha as the case may be, been made or done; or

(b) that a book, document or publication in the Trade Marks Office wa 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.

## **TRADE MARKS ACT 1955 - SECT 18**

### **False entries in Register**

## **SECT**

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 of or extract from an entry in the Register or of or from a document in Trade Marks Office.

Penalty:

(a) in the case of a natural person - \$5,000 or imprisonment for 2 ye both; or

(b) in the case of a body corporate - \$25,000.

## **TRADE MARKS ACT 1955 - SECT 19**

### **Correction of Register**

## **SECT**

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

- (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 or services 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 Federal Court from a decision of the Registrar.

under subsection (1) of this section.

## **TRADE MARKS ACT 1955 - SECT 20**

### **Registration of assignment**

## **SECT**

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

(2) An appeal lies to the Federal Court from a decision of the Regist under the last preceding subsection.

(3) Except in the case of an appeal under this section or of an appli under section 22, a document or instrument in respect of which no entry been made in the Register in accordance with the provisions of subsecti is not, unless the court otherwise directs, admissible in evidence in a in proof of a title to a registered trade mark.

## **TRADE MARKS ACT 1955 - SECT 21**

## Alteration of registered trade mark

### SECT

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 as he thinks fit subject to such conditions and limitations as he thinks fit.

(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 Federal Court from a decision of the Registrar under the last preceding subsection.

(6) Where leave is granted, notice of leave having been granted shall be advertised in the Official Journal and the advertisement shall include



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 subsection

## **TRADE MARKS ACT 1955 - SECT 22**

### **Rectification of Register**

## **SECT**

22. (1) Subject to this Act, a prescribed 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 a prescribed court by a person aggrieved or by the Registrar, the prescribed court may make such order as it thinks fit for the expunging or varying the registration of a trade mark, on the ground of 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

Register to Part B of the Register.

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

(5) Notice of an application to a prescribed court under this section (other than an application by the Registrar) shall be given to the Registrar, and shall appear and be heard and shall appear if so directed by the prescribed 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.

## **TRADE MARKS ACT 1955 - SECT 23**

### **Provisions as to non-use of trade mark**

## **SECT**

23. (1) Subject to this section and to section 93, a prescribed court or the Registrar may, on application by a person aggrieved, order a trade mark removed from the Register in respect of any of the goods or services in respect of which it is registered, on the ground:

(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 re

to those goods or services by him or, if it was registered under subsection (1) of section 45, by the body corporate or registered user concerned, that there has, in fact, been no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or a registered user of the trade mark for the time being earlier than 1 month before the application; or

(b) that, up to 1 month before the date of the application, a continuous period of not less than 3 years had elapsed during which the trade mark registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods or services 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 34 to register a substantially identical or deceptively similar trade mark in respect of the goods or services to which the application relates, or the prescribed court or the Registrar is of opinion that the applicant can properly be permitted to register such a trade mark, a prescribed court or Registrar may refuse an application made under the last preceding subsection in relation to any goods or services 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 or services in respect of which the trade mark is registered, being:

(a) where the application relates to goods - goods of the same description as those goods or services that are closely related to those goods; or

(b) where the application relates to services - services of the same description as those services or goods that are closely related to those services.

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

(a) the matters referred to in paragraph (b) of subsection (1) are so far as regards failure to use the trade mark in relation to goods to be or otherwise traded in, in a particular place in Australia (otherwise than 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 34 to register a trade mark identical or deceptively similar to the trade mark in respect of which the registration extends 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 prescribed court or the Registrar is of opinion that that person might properly be permitted to register such a trade mark;

a prescribed court or the Registrar may, on application by that person, order that the registration of the first-mentioned trade mark shall be subject to such conditions or limitations as the prescribed court or the Registrar may think 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.

(3A) Where, in relation to services in respect of which a trade mark is registered:

(a) the matters referred to in paragraph (b) of subsection (1) are so far as regards failure to use the trade mark in relation to services provided in a particular place in Australia; and

(b) a person has been permitted under section 34 to register a trade mark

identical or deceptively similar trade mark in respect of those service a registration extending to use in relation to services provided in the place, or the prescribed court or the Registrar is of the opinion that person may properly be permitted to register such a trade mark; a prescribed court or the Registrar may, on application by that person, that the registration of the first-mentioned trade mark shall be subject such conditions or limitations as the prescribed court or the Registrar proper for securing that that registration shall cease to extend to use trade mark in relation to services provided in that place.

(4) An applicant is not entitled to rely, for the purposes of paragraph of subsection (1), or for the purposes of subsection (3) or (3A), 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 or services to which the application relates.

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

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

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

(8) An application to a prescribed court under this section and an application to the Registrar shall be made as prescribed by the regulat

(9) An office copy of an order of a prescribed court under this secti shall be served on the Registrar who shall take such steps as are neces give effect to the order.

## **TRADE MARKS ACT 1955 - PART IV**

### **PART IV - REGISTRABLE TRADE MARKS**

## **TRADE MARKS ACT 1955 - SECT 24**

### **Registrable trade marks - Part A**

## **SECT**

24. (1) A trade mark is registrable in Part A of the Register if it c or consists of:

- (a) the name of a person represented in a special or particular manne
- (b) the signature of the applicant for registration or of some predec in his business;
- (c) an invented word;

(d) a word not having direct reference to the character or quality of goods or services in respect of which registration is sought and not be 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 de in paragraph (a), (b), (c) or (d) of the last preceding subsection) is registrable in Part A of the Register unless it is, by evidence, shown distinctive.

(3) A trade mark may be registered in Part A of the Register in respe any goods or services notwithstanding the registration of the trade mar a part or parts of the trade mark in Part B of the Register, in the nam the same person, in respect of the same goods or services or other good services.

## **TRADE MARKS ACT 1955 - SECT 25**

### **Registrable trade marks - Part B**

## **SECT**

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

(2) A trade mark may be registered in Part B of the Register in respect of any goods or services notwithstanding the registration of the trade mark or 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 goods or services or other goods or services.

## **TRADE MARKS ACT 1955 - SECT 26**

### **Distinctiveness**

## **SECT**

26. (1) For the purposes of this Act, a trade mark is not distinctive of goods or services of a person unless it is adapted to distinguish goods or services with which that person is or may be connected in the course of trade from goods or services in respect of which no such connexion subsists, 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.

(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 person;

(b) before the date of the application, the trade mark was used by a 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 pers the registration of that other person as a registered user of the trade and

(d) the Registrar is satisfied that that other person is entitled to 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 mar distinctive of the goods or services of the applicant, treat use of the 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 Federal Court from an order of the Registra the last preceding subsection.

(5) Where an order is made under subsection (3) that the trade mark i distinctive of the goods or services of the applicant, the registration trade mark shall cease to have effect if, at the expiration of the pres period or such further period, not exceeding 6 months, as the Registrar allows, that other person has not become registered as the registered u the trade mark.

## Trade marks in colour

### SECT

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

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

## TRADE MARKS ACT 1955 - SECT 28 Scandalous and improper marks

### SECT

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.

## TRADE MARKS ACT 1955 - SECT 29

### Registration may be refused of certain words etc. in trade marks

## SECT

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 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 forgery", or a word or words to the like effect;

(b) a representation of the Sovereign or of a member of the Royal Fam

(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, lik lead persons to think that the applicant has or has had Royal or Govern patronage or authority;

(e) a representation of the Arms, or of any flag or seal, of the Commonwealth or of a State or Territory;

(f) a representation of the Arms or emblem of a city or town in Austr of a public authority or public institution in Australia;

(g) a representation of a mark notified by the International Union fo 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 pu

of this section, a prohibited mark.

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

## **TRADE MARKS ACT 1955 - SECT 30**

### **Names etc. of living persons**

## **SECT**

30. (1) Where a person makes an application for registration of a trade mark which consists of or includes the name or representation of a living person 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.

(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 deceased, the Registrar may require the applicant to furnish him with the consent of a legal representative of the deceased person to the name or representation appearing on the trade mark before he proceeds with the registration of

trade mark.

(3) An appeal lies to the Federal Court from a decision of the Registrar under either of the last 2 preceding subsections.

## **TRADE MARKS ACT 1955 - SECT 31**

### **Trade marks to be registered for particular goods or services**

## **SECT**

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

(2) If a question arises as to the class in which goods or services 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.

## **TRADE MARKS ACT 1955 - SECT 32**

### **Disclaimers**

## **SECT**

32. (1) If a trade mark:

(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 or a prescribed court, in deciding whether the trade mark be registered or shall remain upon the Register, may, in his or its discretion, require as a condition that the proprietor shall disclaim a right to the exclusive use of any of those parts, or of that matter, to exclusive use of which the Registrar or the prescribed court holds the proprietor not to be entitled or that the proprietor shall make such disclaimer as the Registrar or the prescribed court considers to be pro the purpose of defining the rights of the proprietor under the registra

(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.

## **TRADE MARKS ACT 1955 - SECT 33**

### **Identical marks**

## **SECT**

33. (1) Subject to this Act, a trade mark is not capable of registrat

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, of goods of the same description as those goods or of services that are closely related to those goods, 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) Subject to this Act, a trade mark is not capable of registration 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 services, of services of the same description as those services, or of services that are closely related to those services, 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.

(3) Where, in accordance with this section, a trade mark is not capable of registration by reason of the existence of another trade mark, 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.

## **TRADE MARKS ACT 1955 - SECT 34**

### **Concurrent use**

## **SECT**

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 circumstances would be deceptively similar, for the same goods or services or other goods or services, by more than 1 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, 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.



## **TRADE MARKS ACT 1955 - SECT 35**

### **Jointly owned trade marks**

#### **SECT**

35. (1) Where the relations between 2 or more persons interested in a mark are such that no 1 of them is entitled as between himself and the or others to use the trade mark except:

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

(b) in relation to goods or services with which both or all of them a connected in the course of trade;

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

(2) Subject to the last preceding subsection, nothing in this Act aut the registration of 2 or more persons who use a trade mark independentl propose so to use it, as joint proprietors of the trade mark.

## **TRADE MARKS ACT 1955 - SECT 36**

### **Association of trade marks**

#### **SECT**

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

(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 proprietor in respect of the same goods, of goods of the same description those goods or of services that are closely related to those goods; or

(b) so nearly resembles such a trade mark as to be likely to deceive 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.

(1A) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any services:

(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 proprietor in respect of the same services, of services of the same description as those services, or of goods that are closely related to services; or

(b) so nearly resembles such a trade mark as to be likely to deceive 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 2 or more associated trade marks, the Registrar may, if he is satisfied that there would be a likelihood of deception or confusion being caused, dissolve the association with respect to 1 or more of those trade marks and amend the Register accordingly.

(3) An appeal lies to the Federal Court from a decision of the Registrar under this section.

## **TRADE MARKS ACT 1955 - SECT 37**

### **Assignment of associated trade marks**

#### **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 38**

### **Use of trade marks whether associated or otherwise**

#### **SECT**

38. (1) Where, under this Act, use of a trade mark is required to be made for any purpose, the Registrar or a prescribed court may, if and so far as it thinks right, accept use of an associated registered trade mark or 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 made.

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

## **TRADE MARKS ACT 1955 - SECT 39**

### **Series of trade marks**

## **SECT**

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

(a) statements or representations as to the goods or services in respect of which the trade marks are used or proposed to be used;

(b) statements or representations as to number, price, quality or name or 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 2 or more of those matters, the trade marks may be registered as a series in 1 registration.

(2) All the trade marks in a series of trade marks so registered shall

deemed to be, and shall be registered as, associated trade marks.

## **TRADE MARKS ACT 1955 - PART V PART V - APPLICATIONS FOR REGISTRATION**

### **TRADE MARKS ACT 1955 - SECT 40 Application for registration**

#### **SECT**

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

(2) The application:

(a) shall specify the goods or services in respect of which registrat sought; and

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

(3) An application shall not be made in respect of goods or services comprised in more than 1 class.

## **TRADE MARKS ACT 1955 - SECT 40A**

### **Withdrawal of application**

#### **SECT**

40A. (1) An application is to be treated as having been withdrawn if, only if, the applicant lodges at the Trade Marks Office a written notice of withdrawal signed by the applicant.

(2) A written notice of withdrawal may be lodged by leaving it at, or delivering it by post to, the Trade Marks Office.

## **TRADE MARKS ACT 1955 - SECT 41**

### **Applications to be examined**

#### **SECT**

41. An Examiner shall, in respect of each application, ascertain and whether:

- (a) the application is as prescribed; and
- (b) the trade mark is capable of registration under this Act.

## **TRADE MARKS ACT 1955 - SECT 42**

### **Action on Examiner's report**

## **SECT**

42. (1) If the Examiner reports adversely to an application under the preceding section, the applicant may amend the application so as to remove grounds of objection and the amended application shall be again reported 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 the satisfaction within such time as the Registrar allows.

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

(4) An appeal lies to the Federal Court from a direction of the Registrar under subsection (2).

## **TRADE MARKS ACT 1955 - SECT 43** **Division of application**

## **SECT**

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, before the application has been accepted or refused, make a further application for the registration of that part in respect of goods or services 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 or services and, before the application has been accepted or refused, the applicant has made a further application for registration of that trade mark in respect of goods or services which include the description of goods or services 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 Federal Court from a direction of the Registrar under either of the last 2 preceding subsections.



## **TRADE MARKS ACT 1955 - SECT 44**

### **Acceptance of application**

## **SECT**

44. (1) If the Registrar is satisfied that there is no lawful ground 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.

(2) In the case of an application for registration of a trade mark in the Register, the Registrar may, with the consent of the applicant, if 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 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.

## **TRADE MARKS ACT 1955 - SECT 45**

### **Application may be accepted where trade mark is to be used by assignee registered user**

## **SECT**

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:

(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 that body corporate with a view to the use by the body corporate of the trade mark in relation to the goods or services 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 that person intends to use the trade mark in relation to those goods or services 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 subsection 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 6 months, as the Registrar allows, the bo

corporate has been registered as the proprietor of the trade mark in re of the goods or services in respect of which the trade mark is register registration shall cease to have effect at the expiration of that perio the Registrar shall amend the Register accordingly.

## **TRADE MARKS ACT 1955 - SECT 46**

### **Appeals**

## **SECT**

46. (1) An appeal lies to the Federal Court from a refusal by the Reg 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 appeal and shall appear if so directed by the Federal Court.

## **TRADE MARKS ACT 1955 - SECT 47**

### **Advertisement of acceptance**

## **SECT**

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

acceptance in the Official Journal.

## **TRADE MARKS ACT 1955 - SECT 48**

### **Limit of time for proceeding with application**

#### **SECT**

48. (1) Subject to this section, where an application has not been accepted within 12 months after the date on which the first report of the Examiner is sent to the applicant, the Registrar shall give notice of the non-acceptance to the applicant and if, at the expiration of 1 month from the date of 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, in respect of an application, an appeal under any provision of this Act has been instituted or an application has been made to the Administrative Appeals Tribunal for a review of a decision, the Registrar shall not give notice of the non-acceptance of the first-mentioned application until the expiration of 3 months after the determination or other disposition of the appeal or review or until the expiration of such further time as the Registrar allows to which the appeal, or any further appeal, is brought, or the Administrative Appeals Tribunal, or the court to which any appeal arising out of the determination of the Administrative Appeals Tribunal, is brought, as the case may be, allows.

(3) Where:

(a) the time within which an appeal, or an application to the Administrative Appeals Tribunal, mentioned in subsection (2) may be instituted or made not expired; or

(b) the applicant has died;

the Registrar shall not give notice of the non-acceptance of the application for the registration of a trade mark until such time as he determines.

(4) Where acceptance of an application has been deferred under subsection (2) of section 33, the Registrar shall not give notice of the non-acceptance of the application until the expiration of 3 months after the registration of the second-mentioned trade mark referred to in that subsection.

## **TRADE MARKS ACT 1955 - PART VI**

### **PART VI - OPPOSITION TO REGISTRATION**

## **TRADE MARKS ACT 1955 - SECT 49**

### **Notice of opposition**

## **SECT**

49. (1) A person may, within 3 months after the date of the advertisement of the acceptance of an application, or within such further period, not exceeding 3 months, as the Registrar, on application made to him within the first-mentioned period, allows, by notice in writing specifying the grounds

opposition and lodged at the Trade Marks Office, oppose the registration of the trade mark.

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

## **TRADE MARKS ACT 1955 - SECT 50**

### **Hearing of opposition**

## **SECT**

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

- (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 the ground of objection whether relied upon by the opponent or not.

**TRADE MARKS ACT 1955 - SECT 51**  
**Appeal to a prescribed court**

**SECT**

51. The applicant or an opponent may appeal to the Federal Court from decision of the Registrar under the last preceding section.

**TRADE MARKS ACT 1955 - SECT 52**  
**Security for costs**

**SECT**

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

**TRADE MARKS ACT 1955 - PART VII**  
**PART VII - REGISTRATION AND EFFECT OF REGISTRATION**

**TRADE MARKS ACT 1955 - SECT 53**  
**Registration of trade mark**

## **SECT**

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

(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 for the purposes of this Act to be the date of registration.

### **TRADE MARKS ACT 1955 - SECT 54** **Time for registration**

## **SECT**

54. (1) Subject to this section, a trade mark shall not be registered 12 months from the date of the advertisement of the acceptance of the application.

(2) Where the Registrar has allowed an extension of time within which of opposition to the registration of a trade mark may be given and noti



opposition has not been given, an extension of time for the same period the aggregate of the periods, if more than 1, after the period of 12 months referred to in the last preceding subsection 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;

(b) proceedings in a court; or

(c) an application to the Administrative Appeals Tribunal;

that trade mark may be registered within such time as:

(d) in a case to which paragraph (a) applies - the Registrar directs;

(e) in a case to which paragraph (b) applies - the court or, if the proceedings are discontinued, the Registrar directs; or

(f) in a case to which paragraph (c) applies - the Tribunal or a court which an appeal arising out of the decision of the Tribunal is brought, directs, or, if the proceedings before the Tribunal are, or any such appeal is, discontinued, as the Registrar directs.

(4) Where the applicant dies before the expiration of the time which otherwise be allowed for registering a trade mark, the trade mark may be registered at any time within 12 months after his death or within such period as the Registrar directs.

(5) Where a trade mark cannot be registered within the time allowed by 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 applicable to it under this section the application shall lapse.

## **TRADE MARKS ACT 1955 - SECT 55**

### **Duration of registration**

## **SECT**

55. (1) Subject to the next succeeding subsection, the registration of a trade mark as of a date after the commencement of this Act shall be for a period of 7 years.

(2) The registration of a trade mark as of a date before the commencement of this Act shall be for a period of 14 years.

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

## **TRADE MARKS ACT 1955 - SECT 56**

### **Words used as name or description of an article or substance**

## **SECT**

56. (1) Subject to this section, the registration of a trade mark does 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 the name or description of an article, substance or service.

(2) The succeeding subsections have effect where:

(a) there is a well-known and established use of a word as the name or description of an article, substance or service by a person or persons carrying on a trade in that article, substance or service, not being in relation to goods or services 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 or services certified by the proprietor; or

(b) the article or substance was formerly manufactured under a patent or service formerly provided was a patented process, as the case requires, for a period of 2 years or more after the patent has ceased to have effect, and the word is the only practicable name or description of the article, substance or service.

(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, or of the services or any services of the same description, as the case requires, shall be deemed for the purposes of section 22 to be an entry wrongly remaining in the Register.

(4) If the trade mark contains that word and other matter, a prescribed

court, in deciding whether the trade mark shall remain in the Register, as regards registration in respect of the article or substance or of an of the same description, or of the services or of any services of the s 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 s disclaim any right to the exclusive use of that word in relation to tha article or substance or to any goods of the same description, or to the services or to any service of the same description, as the case may be, such disclaimer affects any rights of the proprietor of the trade mark such as arise out of the registration of the trade mark in respect of w the disclaimer is made.

(5) For the purposes of any other legal proceedings relating to the t 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 registered proprietor to the exclusive use of that word;

in relation to the article or substance or to any goods of the same description, or to the service or to any services of the same descripti the case requires, shall be deemed to have ceased on the date at which mentioned in paragraph (a) of subsection (2) first became well-known an established, or at the expiration of the period of 2 years mentioned in paragraph (b) of that subsection.

## **TRADE MARKS ACT 1955 - SECT 57**

### **Powers of registered proprietor**

## **SECT**

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

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

## **TRADE MARKS ACT 1955 - SECT 58** **Rights given by registration**

## **SECT**

58. (1) Subject to this Act, the registration of a trade mark in 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 goods or services 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.

(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 2 or more persons are proprietors of registered trade marks are substantially identical or deceptively similar, whether for the same or services or other goods or services, rights of exclusive use of either those trade marks are not (except so far as their respective rights have been defined by the Registrar or a prescribed court) acquired by any 1 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 persons (not being registered users) as he would have if he were the sole registered proprietor.

## **TRADE MARKS ACT 1955 - SECT 59**

### **Registration evidence of validity**

## **SECT**

59. In legal proceedings relating to a registered trade mark (including applications under section 22), 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.

## **TRADE MARKS ACT 1955 - SECT 60**

### **Limitation on removal of trade mark after 3 years**

## **SECT**

60. In legal proceedings relating to a trade mark registered in Part the Register (including applications under section 22) instituted after expiration of 3 years from the date of registration, the trade mark shall be removed from the Register or be held invalid on the ground that it was not a registrable trade mark under section 24, unless it is proved that it was, at the commencement of the proceedings, distinctive of the goods or services of the registered proprietor.

## **TRADE MARKS ACT 1955 - SECT 61**

### **Registration conclusive after 7 years**

## **SECT**

61. (1) In legal proceedings relating to a trade mark registered in Part of the Register (including applications under section 22), the original registration of the trade mark under this Act shall, after the expiration of 7 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 28;
- (c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods or services of the registered proprietor.

(2) Paragraph (c) of the last preceding subsection does not apply to a trade mark registered before the commencement of this Act until after the expiration of 3 years from the commencement of this Act.

## **TRADE MARKS ACT 1955 - SECT 62**

### **Infringement of trade marks**

#### **SECT**

62. (1) A registered trade mark is infringed by a person who, not being a registered proprietor of the trade mark or a registered user of the trade mark, uses 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 relation to goods or services in respect of which the trade mark is registered.

(2) In an action for infringement of a trade mark registered in Part 2 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 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 likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods or services 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.

## **TRADE MARKS ACT 1955 - SECT 63**

### **Infringement of trade mark by breach of certain restrictions**



## SECT

63. (1) Where, by notice upon goods or upon the container of goods, a 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:

- (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 some alteration to their state, condition, get-up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration consists in the 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 some 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 the 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 trade mark.

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 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" in relation to goods, a reference to physical relation to the goods.

## **TRADE MARKS ACT 1955 - SECT 64**

### **Acts not constituting infringement**

## **SECT**

64. (1) Notwithstanding anything contained in this Act, the following 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 place of business or the name, or the name of the place of business, 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 or services;

(c) the use by a person of a trade mark in relation to goods or services 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 of the trade mark by his predecessors in business or by a registered user of the trade mark

(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 or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement or for the time being be so used, if the use of the trade mark is reasonable necessary in order to indicate that the goods or services are so adapted 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 or services; 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 a 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, in relation to services to be provided in a place, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend.

## **TRADE MARKS ACT 1955 - SECT 65**

### **Relief in infringement actions**

## **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 66**

### **Evidence of trade usage**

#### **SECT**

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.

## **TRADE MARKS ACT 1955 - SECT 67**

### **Action or proceeding may be instituted in prescribed court**

#### **SECT**

67. An action or proceeding for infringement of a trade mark may be instituted in a prescribed court, but nothing in this section prevents action or proceeding being instituted in a court that is not a prescribed court.

## **TRADE MARKS ACT 1955 - SECT 68**

### **Passing off actions**

## **SECT**

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 be awarded against the defendant if he satisfies the court:

(a) that at the time he commenced to use the trade mark he was unaware 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 or services in relation to which it was used by the plaintiff.

## **TRADE MARKS ACT 1955 - PART VIII**

### **PART VIII - RENEWAL OF REGISTRATION**

## **TRADE MARKS ACT 1955 - SECT 69**

### **Renewal of registration**

#### **SECT**

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 14 years from the expiration of the last registration of the trade mark.

## **TRADE MARKS ACT 1955 - SECT 70**

### **Procedure on expiry of period of registration**

#### **SECT**

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 otherwise upon which a renewal of the registration may be obtained.

(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.

**TRADE MARKS ACT 1955 - SECT 71**  
**Restoration of trade mark removed for non-payment of renewal fee**

**SECT**

71. (1) Where a trade mark has been removed from the Register for non-payment of the prescribed fee, the Registrar may, within 12 months 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 re-register the registration of the trade mark, either generally or subject to such conditions or limitations as he sees fit to impose, for a period of 14 months from the expiration of the last registration.

(3) Section 130 does not apply in relation to subsection (1).

**TRADE MARKS ACT 1955 - SECT 72**  
**Status of un-renewed trade mark**

**SECT**

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 12 months next to the expiration of the last registration, be deemed to be a trade mark which

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 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 or of any previous use of the trade mark which has been removed.

## **TRADE MARKS ACT 1955 - PART IX PART IX - REGISTERED USERS**

### **TRADE MARKS ACT 1955 - SECT 73 Application of Part**

#### **SECT**

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

### **TRADE MARKS ACT 1955 - SECT 74 Registered users**

#### **SECT**



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 the trade mark for all or any of the goods or services 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 in terms of their relationship that the proposed registered user will be the registered user or that there will be any other restriction as to persons whose registration as registered users application may be made;

(b) stating the goods or services for which registration is proposed;

(c) stating any conditions or restrictions proposed with respect to the characteristics of the goods or services, 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 a period, and, if for a period, the duration of the period; and with such further documents, information or evidence as is required by the regulations or by the Registrar.

(3) Where the requirements of the last preceding subsection have been

complied with and the Registrar, after considering the documents, information and evidence furnished to him under that subsection, is satisfied that, in the circumstances, the use of the trade mark in relation to the proposed goods or services or any of them by the proposed registered user, subject to any conditions or restrictions which the Registrar thinks appropriate, would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user for the goods or services 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 subsection (2), 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 subsection (2), 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 a prescribed court.

## **TRADE MARKS ACT 1955 - SECT 75**

### **Variation etc. of registration**

## **SECT**

75. Without affecting the operation of section 22, the registration of a person as a registered user:

(a) may be varied by the Registrar, on the application in writing of the registered proprietor, with respect to the goods or services for which, 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 following ground:

(i) that the registered user has used the trade mark otherwise than in the 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 has 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.

## **TRADE MARKS ACT 1955 - SECT 76**

### **Cancellation of registration**

## **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 77**

### **Effect of permitted user**

## **SECT**

77. (1) The permitted use of a registered trade mark shall be deemed use by the registered proprietor of the trade mark and shall be deemed be use by a person other than the registered proprietor, for the purpos section 23 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 commence

this Act) of the trade mark by that person; and

(c) that use is in relation to goods or services in respect of which person is registered and, where he is registered subject to conditions 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 subsection has effect as if that previous use had be 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 registered proprietor of the trade mark.

(4) For the purpose of determining the rights arising at common law of a 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.

## **TRADE MARKS ACT 1955 - SECT 78**

### **Infringement proceedings**

## **SECT**

78. (1) Subject to any agreement subsisting between the registered user 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 or neglects to do so within 2 months after being so called upon, the registered user may institute proceedings for infringement in his own name if he were the registered proprietor and shall make the registered proprietor a defendant.

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

## **TRADE MARKS ACT 1955 - SECT 79**

### **Rights of registered user not assignable**

## **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 80**

### **Hearing by Registrar**

## **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 81 Appeals**

### **SECT**

81. An appeal lies to the Federal Court from a decision of the Registrar under this Part.

## **TRADE MARKS ACT 1955 - PART X PART X - ASSIGNMENT OF TRADE MARKS**

## **TRADE MARKS ACT 1955 - SECT 82 Assignment and transmission of trade marks**

### **SECT**

82. (1) Subject to this section, a registered trade mark may be assigned transmitted with or without the goodwill of the business concerned in t

goods or services in respect of which the trade mark is registered or of those goods or services.

(2) Subject to the next 3 succeeding subsections, 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 or services, where there exists a connexion in the course of trade between those goods or services and the assignor and where those goods or services 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 or services.

(3) Paragraph (a) of the last preceding subsection 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 so registered in respect of the trade mark within 6 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



called in question, the trade mark has come to denote to the public a connexion in the course of trade between the goods or services and the assignee to the exclusion of all other persons, or, if the registration limited to a territory, to the exclusion of all other persons within th territory.

(5) An assignment of a trade mark shall not be held to be invalid exc proceedings instituted within 3 years after the registration of the assignment.

(6) If goods bearing a registered trade mark are purchased or acquire person, the sale of or other dealing in those goods by that person, or person claiming under or through him, is not an infringement of the tra by reason only of the trade mark having been assigned by the registered proprietor to some other person after the purchase or acquisition of th goods.

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

## **TRADE MARKS ACT 1955 - PART XI PART XI - CERTIFICATION TRADE MARKS**

### **TRADE MARKS ACT 1955 - SECT 83**

## Certification trade marks

### SECT

83. (1) Where a mark is adapted in relation to goods or services to distinguish in the course of trade goods or services, as the case may be, certified by a person, or by another person authorized by the first-mentioned person, in respect of quality, accuracy, or other characteristic, including the case of goods, origin, material or mode of manufacture, from goods or services, as the case may be, 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 mark in respect of those goods or services.

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

(3) In determining whether a mark is adapted so to distinguish in relation to goods or services, 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.

## **TRADE MARKS ACT 1955 - SECT 84**

### **Rights given by registration**

## SECT

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

(2) The right to the exclusive use of a certification trade mark give 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 goo be sold or otherwise traded in in a place, in relation to goods to be e to a market, in relation to services to be provided in a place, or in a 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 give registration is not infringed by the use of the mark by a person in rel to goods or services certified by the registered proprietor of the certification trade mark if:

(a) in the case of goods, as to those goods or a bulk of which they f part, the registered proprietor, or another person in accordance with h authority under the rules governing the use of the mark, has applied th and has not subsequently removed or obliterated it; or

(b) the registered proprietor has expressly or impliedly consented to use of the mark.

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

## **TRADE MARKS ACT 1955 - SECT 85**

### **Rules governing the use of certification trade marks**

## **SECT**

85. (1) An application for the registration of a mark as a certificat trade mark under this Part shall be accompanied by draft rules for gove the use of the mark.

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

## **TRADE MARKS ACT 1955 - SECT 86**

### **Matters to be considered before acceptance**

## **SECT**

86. (1) Before accepting an application under this Part, the Registrar consider:

(a) whether the applicant or person authorized by him is competent to certify the goods or services 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 the Federal Court from a decision of the Registrar under the last preceding subsection.

## **TRADE MARKS ACT 1955 - SECT 87** **Alteration of rules**

## **SECT**

87. (1) The rules governing the use of a certification trade mark may

the application of the registered proprietor, be altered by the Registr

(2) An application under the last preceding subsection shall be adver as prescribed and is subject to opposition as prescribed.

## **TRADE MARKS ACT 1955 - SECT 88**

### **Rectification of Register**

## **SECT**

88. (1) The power to order the rectification of the Register conferre section 22 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 competent, in relation to any of the goods or services in respect of wh mark is registered, to certify those goods or services;

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

(c) that the registered proprietor has failed to observe a provision 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 registered as a certification trade mark, the rules governing the use o mark should be varied.

(2) A prescribed court may, on the application of a person aggrieved 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 a prescribed court under this section than an application by the Registrar) shall be given to the Registrar, appear and be heard and shall appear if so directed by the prescribed c

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

## **TRADE MARKS ACT 1955 - SECT 89**

### **Certification trade marks not assignable**

## **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 90**

### **Transitional provisions**

## **SECT**

90. (1) The repealed Acts apply, notwithstanding their repeal, to and

relation to applications for the registration of standardization trade made before the commencement of this Act.

(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 in relation to a certification trade mark so registered.

(3) The Registrar may require an applicant under an application refer in subsection (1) 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, wer registered under the repealed Acts as standardization trade marks shall 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 req by the Registrar as a condition of the continuance of the registration 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 resp a certification trade mark registered under this section, this Part has in relation to that mark as if references in this Part to rules had bee omitted.



## **TRADE MARKS ACT 1955 - SECT 91**

### **Rules to be open for inspection**

#### **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 92**

### **Application of Act to certification trade mark**

#### **SECT**

92. The provisions of this Act (other than sections 23, 24, 25, 26, 3 and 38, subsection (1) of section 40, sections 45, 58, 60 and 61, subsection (2) of section 62, section 63 and Parts IX, X and XII) apply in relation to the registration of a mark as a certification trade mark under this Part to a mark registered as a certification trade mark.

## **TRADE MARKS ACT 1955 - PART XII**

### **PART XII - DEFENSIVE TRADE MARKS**

## **TRADE MARKS ACT 1955 - SECT 93**

## Defensive registration of well-known trade marks

### SECT

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 or services in respect of which it is registered that the use of the trade mark in relation to other goods or services would be likely to be taken as indicating a connexion between those other goods or services and the registered proprietor of the trade mark, 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 other goods or services notwithstanding that he does not use or propose to use the trade mark in relation to those other goods or services and notwithstanding anything in section 23.

(2) A trade mark registered as a defensive trade mark in respect of goods or services is not liable to be removed from the Register under section 23 in respect of those goods or services.

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

(4) A trade mark registered as a defensive trade mark and that trade otherwise registered in the name of the same person shall, notwithstanding that the respective registrations are not registrations in respect of the goods or services, be deemed to be, and shall be registered as, associated trade marks.

## **TRADE MARKS ACT 1955 - SECT 94**

### **Rectification of Register**

## **SECT**

94. (1) A prescribed court may, on the application of a person aggrieved by the Registrar, cancel the registration of a defensive trade mark in respect of all or any of the goods or services in respect of which it is registered on the ground that the requirements of subsection (1) of the last preceding section are no longer satisfied.

(2) Notice of an application to a prescribed court under this section (other than an application by the Registrar) shall be given to the Registrar, and the Registrar shall appear and be heard and shall appear if so directed by the prescribed 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 a prescribed court by this section are in addition to the powers conferred by section 22.

## **TRADE MARKS ACT 1955 - SECT 95**

### **Cancellation by Registrar**

## **SECT**

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.

## **TRADE MARKS ACT 1955 - SECT 96**

### **Rights given by registration**

## **SECT**

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

## **TRADE MARKS ACT 1955 - SECT 97**

## **Application of Act**

### **SECT**

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.

## **TRADE MARKS ACT 1955 - PART XIII PART XIII - PROTECTION OF TRADE MARKS**

### **TRADE MARKS ACT 1955 - SECT 98 Forgery etc. of trade marks**

### **SECT**

98. (1) A person shall not:

- (a) forge a registered trade mark;
- (b) falsely apply a registered trade mark to goods or services;
- (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 ins for the purpose of forging, or of being used for forging, a registered mark.

Penalty: Imprisonment for 2 years.

## **TRADE MARKS ACT 1955 - SECT 99**

### **Selling etc. goods with false marks**

## **SECT**

99. (1) A person must not:

(a) sell; or

(b) expose for sale; or

(c) have in his or her possession for sale or for the purpose of trad manufacture;

goods, if the person knows that the goods are goods to which a forgery registered trade mark is applied, or to which a registered trade mark i falsely applied.

(2) A contravention by a person of subsection (1) is an offence punis on conviction by a fine not exceeding \$500 for each item of goods to wh offence relates or imprisonment for a period not exceeding 2 years, or

(3) If a fine is imposed on a person because of subsection (2) in rel to an offence committed by the person and there are 2 or more items of to which the offence relates, the fine imposed in respect of that offen

not exceed \$50,000.

(4) For the purposes of establishing a contravention of subsection (1) having regard to:

(a) a person's abilities, experience, qualifications and other attributes and

(b) all the circumstances surrounding the alleged contravention of that subsection;

the person ought reasonably to have known that the goods are goods of a kind referred to in that subsection, the person is taken to have known that the goods are goods of that kind.

## **TRADE MARKS ACT 1955 - SECT 100**

### **Importing goods with false marks**

## **SECT**

100. (1) A person must not import into Australia goods for the purpose of trade or manufacture if the person knows that the goods are goods to which

(a) a forged registered trade mark is applied; or

(b) a registered trade mark is falsely applied.

(2) A contravention by a person of subsection (1) is an offence punishable on conviction by a fine not exceeding \$500 for each item of goods to which the offence relates or imprisonment for a period not exceeding 2 years, or

(3) If a fine is imposed on a person because of subsection (2) in relation to an offence committed by the person and there are 2 or more items of which the offence relates, the fine imposed in respect of that offence shall not exceed \$50,000.

(4) For the purposes of establishing a contravention of subsection (1) having regard to:

(a) a person's abilities, experience, qualifications and other attributes and

(b) all the circumstances surrounding the alleged contravention of that subsection;

the person ought reasonably to have known that the goods are goods of a kind referred to in that subsection, the person is taken to have known that the goods are goods of that kind.

## **TRADE MARKS ACT 1955 - SECT 102**

### **Aiding and abetting offences**

## **SECT**

102. (1) A person who aids, abets, counsels or procures, or is in any way directly or indirectly, knowingly concerned in, or party to, the doing of an act outside Australia which, if it were done in Australia, would be an offence against this Act, shall be deemed to have committed that offence and is punishable accordingly.



(2) Subsection (1) does not affect the operation of section 5 of the Act 1914.

## **TRADE MARKS ACT 1955 - SECT 103**

### **Importation of goods infringing Australian trade marks**

## **SECT**

103.\*2\* (1) In this section:

"objector", in relation to goods imported into Australia, means:

(a) if the registered proprietor of the relevant trade mark had, before importation of the goods, given a notice of the kind referred to in paragraph (3) (b) in relation to that trade mark and had not, before the importation of the goods, given notice in writing to the Comptroller-General of Customs revoking that notice - the registered proprietor; or

(b) in a case to which paragraph (a) does not apply - a registered user of the relevant trade mark, who had, before the importation of the goods, given notice of the kind referred to in paragraph (3) (b) in relation to that trade mark and had not, before the importation of the goods, given notice in writing to the Comptroller-General revoking that notice;

"owner", in relation to goods imported into Australia, means the person whose name appears on the entry made in relation to the goods under section 101 of the Customs Act 1901 as being the owner of the goods.

(2) References in this section to the owner of goods shall, where a n

under subsection (7) has been given to a person who acted as agent of the owner in relation to the importation of the goods, be read as including references to the person to whom that notice was given.

(3) Where:

(a) goods manufactured outside Australia are imported into Australia are, in accordance with the Customs Act 1901, subject to the control of Customs;

(b) a notice in writing objecting to the importation of goods infringing trade mark registered in respect of goods (in this section referred to "relevant trade mark") has been given to the Comptroller-General of Customs after the commencement of the Trade Marks Amendment Act 1981 and before importation of the goods referred to in paragraph (a), being a notice that not been revoked, by:

(i) the registered proprietor of the relevant trade mark; or

(ii) if a registered user of the relevant trade mark satisfies the Comptroller-General that he is, by virtue of subsection (5), entitled to give such a notice - that registered user;

(c) the goods referred to in paragraph (a) have applied to them a mark in the opinion of the Comptroller-General, is substantially identical with or deceptively similar to, the relevant trade mark; and

(d) the goods referred to in paragraph (a) are goods in respect of which the relevant trade mark is registered;

the Comptroller-General shall, unless he is satisfied that there are no reasonable grounds for believing that the importation of the goods constitutes an infringement of the relevant trade mark, seize the goods.

(4) The Comptroller-General of Customs may refuse to take any action

subsection (3) in relation to goods unless he has been given by the objector or by one or more of the objectors, security to the satisfaction of the Comptroller-General for reimbursing the Commonwealth in respect of expenses that may be incurred by the Commonwealth by virtue of action taken by the Comptroller-General under this section in relation to the goods.

(5) Subject to any agreement between a registered user of a trade mark and the registered proprietor of that trade mark, that registered user is entitled to call upon the registered proprietor to give a notice of the kind referred to in paragraph (3) (b) in relation to that trade mark and, if the registered proprietor refuses or neglects to do so within 2 months of being so called upon, the registered user is entitled to give such a notice.

(6) Goods seized under subsection (3) shall be taken to such place of security as the Comptroller-General of Customs directs.

(7) Where goods have been seized under subsection (3), the Comptroller-General of Customs shall, as soon as practicable after the goods were seized:

(a) give to the owner of the goods or a person who acted as agent of the owner in relation to the importation of the goods, either personally or by post, a notice in writing identifying the goods and stating that the goods so identified have been seized under subsection (3); and

(b) give to the objector or to each objector, either personally or by post, a notice in writing:

(i) identifying the goods and stating that the goods so identified have been seized under subsection (3); and

(ii) stating that the goods will be released to the owner unless an

action or proceeding for infringement of the relevant trade mark in respect of the goods is instituted by an objector before the expiration of the period of one month after the giving of the notice and the objector gives notice in writing to the Comptroller-General before the expiration of that period stating that that action or proceeding has been instituted.

(8) Where:

(a) goods have been seized under subsection (3);

(b) the Comptroller-General of Customs is satisfied that, having regard to the information that has come to his knowledge after the goods were so seized, there are no reasonable grounds for believing that the importation of the goods constituted an infringement of the relevant trade mark; and

(c) no action or proceeding for infringement of the relevant trade mark has been instituted in respect of the goods by an objector;

the Comptroller-General may release the goods to the owner.

(9) The owner of goods seized under subsection (3) may, by notice in writing given to the Comptroller-General of Customs at any time before an action or proceeding for infringement of the relevant trade mark is instituted in respect of the goods by an objector, consent to the goods being forfeited to the Commonwealth and, where the owner gives such a notice, the goods are forfeited to the Commonwealth and may be disposed of in such manner as is prescribed or as the Comptroller-General directs.

(10) Where:

(a) goods have been seized under subsection (3);

(b) the objector or each objector gives notice in writing to the Comptroller-General of Customs stating that that objector consents to the

release of the goods; and

(c) no action or proceeding for infringement of the relevant trade mark has been instituted by an objector in respect of the goods; the Comptroller-General shall release the goods to the owner.

(11) Subject to the regulations, where goods have been seized under subsection (3), the Comptroller-General of Customs may, at any time before an action or proceeding for infringement of the relevant trade mark is instituted by an objector in respect of the goods, if in his opinion any possible infringement of the relevant trade mark did not occur either knowingly or negligently, release the goods to the owner 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 a mark applied to the goods; or

(c) that the goods will be forthwith exported.

(12) The Comptroller-General of Customs shall release goods seized under subsection (3) (not being goods forfeited to the Commonwealth under subsection (9)) to the owner on the expiration of the period of one month after the giving of a notice under subsection (7) to the objector or the objector's death unless an objector has, before the expiration of that period:

(a) instituted an action or proceeding for infringement of the relevant trade mark in respect of the goods; and

(b) given notice in writing to the Comptroller-General stating that the action or proceeding has been instituted.

(13) Where:

(a) goods have been seized under subsection (3); and

(b) an objector is a registered user of the relevant trade mark;

nothing in section 78 prevents the institution of an action or proceeding for infringement of the relevant trade mark in respect of the goods by that registered user, being an action or proceeding instituted before the expiration of the period referred to in subsection (12).

(14) Where:

(a) an action or proceeding for infringement of a trade mark has been instituted in respect of goods seized under subsection (3); and

(b) at any time after the expiration of 3 weeks after the date on which an action or proceeding was instituted there is not in force an order of a court in which the action or proceeding was instituted restraining the use of the goods;

the Comptroller-General of Customs shall release the goods to the owner

(15) Where:

(a) an action or proceeding for infringement of a trade mark has been instituted in respect of goods seized under subsection (3); and

(b) a person applies to the court in which the action or proceeding was instituted to be joined as a defendant to the action or proceeding; the court may permit that person to be joined as a defendant to the action or proceeding.

(16) Where, in an action or proceeding for infringement of a trade mark in respect of goods seized under subsection (3), a court makes an order in relation to the release of the goods, the Comptroller-General of Customs shall comply with the terms of that order.

(17) Where:

(a) in an action or proceeding for infringement of a trade mark instituted by an objector in respect of goods seized under subsection (3), a court determines that the importation of the goods did not constitute an infringement of the relevant trade mark; and

(b) the defendant satisfies the court that he has suffered loss or damage by reason of the goods being detained;

the court may order the objector to pay to the defendant such amount as the court determines as compensation for that loss or damage, other than an amount of that loss or damage that is attributable to any period before the date on which that action or proceeding was instituted.

(18) Where the Comptroller-General of Customs has seized goods under subsection (3), the Comptroller-General shall not release or dispose of goods under this section, and shall not take any action in relation to goods in pursuance of an order of a court made in an action or proceeding for infringement of a trade mark instituted in respect of the goods, if the Comptroller-General is required or permitted, under any other law of the Commonwealth, to retain control of the goods.

(19) Without limiting the relief that a court may grant apart from this section, where an objector has instituted an action or proceeding for infringement of a trade mark in respect of goods seized under subsection (3), the court in which the action or proceeding was instituted:

(a) may, at any time, if it thinks just, make an order, subject to such terms (if any) as the court thinks fit, requiring the goods to be released to the owner; or

(b) may order that the goods be forfeited to the Commonwealth.

(20) Where a court orders that goods be forfeited to the Commonwealth goods shall be disposed of in such manner as is prescribed or as the Comptroller-General of Customs directs.

(21) A court in which an action or proceeding is instituted in respect of goods seized under subsection (3) shall permit the Comptroller-General of Customs to appear and be heard.

(22) Where security given under subsection (4) for reimbursing the Commonwealth in respect of expenses that may be incurred by the Commonwealth by virtue of action taken by the Comptroller-General of Customs under this section in relation to goods seized under subsection (3) is insufficient to meet those expenses, the amount of the excess is a debt due by the objector, or, if there is more than one objector, jointly and severally by the objectors, to the Commonwealth and may be recovered by action taken in respect of competent jurisdiction.

(23) Sections 130 and 131 do not apply in relation to this section.

(24) An action or proceeding does not lie against the Commonwealth in respect of any loss or damage suffered by a person by reason of:

- (a) goods being seized or not being seized under this section; or
- (b) the release of goods seized under this section.



(25) The Comptroller-General of Customs may, either generally or as otherwise provided by the instrument of delegation, by writing signed by him or by a delegate to a person who is an officer for the purposes of the Customs Act 1901 any of his powers under this section, other than this power of delegation.

(26) A power so delegated, when exercised by the delegate, shall, for purposes of this section, be deemed to have been exercised by the Comptroller-General of Customs.

(27) A delegation under subsection (25) does not prevent the exercise of the power by the Comptroller-General of Customs.

\*2\* S. 103 - Section 103 of the Trade Marks Act 1955 was repealed and substituted by the Trade Marks Amendment Act 1981, subsection 5 (6) of which provides as follows:

"(6) Section 103 of the Principal Act continues to apply in relation to goods imported into Australia before the commencement of this Act, not to goods in relation to which section 103 of the Principal Act as amended by this Act applies by virtue of subsection (2)."

Section 103 of the Principal Act, which was continued in force by subsection 5 (6) of the Trade Marks Amendment Act 1981 provided as follows:

"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, trader or person providing a service in Australia if the registered proprietor or registered user notifies the Comptroller-General of Customs in writing that he objects to the import of the goods, prohibited to be imported and, if imported, may be seized

forfeited to the Commonwealth.

"(2)(a) Subject to the regulations, the Comptroller-General of Customs on appeal from him the Minister of State for Business and Consumer Affairs 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 a 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 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.

"(5)(a) Where an application has been made to the Administrative Appeals Tribunal, whether before or after the commencement of this subsection, for review of a decision of the Comptroller-General of Customs made under subsection (2), a person is not entitled to appeal to the Minister for Business and Consumer Affairs against that decision."

(a) Section 103, as continued in force, was amended by section 280 and Schedule 12 of the Statute Law (Miscellaneous Amendments) Act (No. 2) 1981. The provisions of Schedule 12 applicable to section 103 provide as follows:

"Subsection 103 (2) as continued in force by subsection 5 (6) of the Statute Law (Miscellaneous Amendments) Act 1981

Omit 'of State for Business and Consumer Affairs', substitute 'for In

and Commerce'.

Subsection 103 (5) as continued in force by subsection 5 (6) of the Trade Marks Amendment Act 1981

Omit 'Business and Consumer Affairs' substitute 'Industry and Commerce'

## **TRADE MARKS ACT 1955 - SECT 104**

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

## **SECT**

104. (1) Where goods which are liable to be seized under section 103 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 14 days, comply with the requirement.

Penalty:

(a) in the case of a natural person - \$1,000 or imprisonment for 6 months or both; or

(b) in the case of a body corporate - \$5,000.

(3) Information obtained from the importer of the goods or his agent this section, or from any other source, may be communicated by the Comptroller-General to the registered proprietor or registered user of trade mark which is alleged to have been used or infringed.

## **TRADE MARKS ACT 1955 - SECT 105**

### **Modification in relation to Territories**

#### **SECT**

105. The regulations may provide for the modification or adaptation o provisions of the last 2 preceding sections in relation to Norfolk Isla

## **TRADE MARKS ACT 1955 - SECT 106**

### **What taken to be forgery of trade mark**

#### **SECT**

106. (1) A person is taken to forge a registered trade mark:  
(a) if the person knows that the trade mark is a registered trade mar  
(b) the person:  
(i) without the agreement of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of thi makes the trade mark, the trade mark with additions or alterations not

substantially affecting its identity or a mark substantially identical  
it; or

(ii) falsifies the registered trade mark, whether by alteration,  
addition, effacement or otherwise.

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

(3) For the purposes of establishing a contravention of subsection (1  
having regard to:

(a) a person's abilities, experience, qualifications and other attrib  
and

(b) all of the circumstances surrounding the alleged contravention of  
subsection;

the person ought reasonably to have known that the trade mark is a regi  
trade mark, the person is taken to have known that the trade mark is a  
registered trade mark.

## **TRADE MARKS ACT 1955 - SECT 107**

### **When trade mark deemed applied**

## **SECT**

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

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

(a) it is applied to the goods themselves; or

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

(2A) A trade mark shall be deemed to be applied to goods or services

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

(b) it is used in:

(i) a sign or advertisement, including a televised advertisement; or

(ii) an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document;

and goods are delivered, or services provided, as the case may be, to a person in pursuance of a request or order made by reference to the trade mark used.

(3) For the purposes of this section, "covering" includes a stopper, 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 or services 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 the proprietor of the trade mark or a mark substantially identical with it is applied to goods or services.

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

**TRADE MARKS ACT 1955 - SECT 107A**  
**Forfeiture orders under the Proceeds of Crime Act 1987**

**SECT**

107A. If a person other than the Director of Public Prosecutions has instituted proceedings for trial of another person in respect of an indictable offence against this Part, Division 2 of Part 2 of the Proceeds of Crime Act 1987 applies as if a reference in that Division to the Director of Public Prosecutions includes a reference to the first-mentioned person.

**TRADE MARKS ACT 1955 - PART XIV**  
**PART XIV - INTERNATIONAL ARRANGEMENTS**

**TRADE MARKS ACT 1955 - SECT 108**  
**Convention countries**

**SECT**

108. (1) The Governor-General may make regulations declaring that a country specified in the regulations is a Convention country for the purposes of this Act.

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

(3) Where the Governor-General makes regulations declaring that an application made in a foreign country 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 the 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.

## **TRADE MARKS ACT 1955 - SECT 109**

### **Applications under International Conventions**

## **SECT**



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 6 months after the date on which the application was made in the Convention country, the trade mark shall, if registered, be deemed for the purposes of the Act to be the date of registration.

(2) Where applications have been made for the registration of a trade mark in 2 or more Convention countries, the period of 6 months referred to in the last preceding subsection shall be reckoned from the date on which the first 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.

## **TRADE MARKS ACT 1955 - SECT 110**

### **Manner of application under this Part**

## **SECT**

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 other than under this Part.

**TRADE MARKS ACT 1955 - PART XV**  
**PART XV - JURISDICTION AND POWERS OF COURTS**

**TRADE MARKS ACT 1955 - SECT 111**  
**Interpretation**

**SECT**

111. In this Part, "decision", in relation to the Registrar, includes

- (a) an order of the Registrar;
- (b) a refusal by the Registrar, under section 44, to accept an applic  
and
- (c) an acceptance, subject to conditions or limitations, by the Regis  
under section 44, of an application.

**TRADE MARKS ACT 1955 - SECT 112**  
**Jurisdiction of prescribed courts**

**SECT**

112. (1) The Federal Court has jurisdiction with respect to matters a  
under this Act.

(1A) The jurisdiction of the Federal Court to hear and determine appeals from decisions, directions or orders of the Registrar is exclusive of the jurisdiction of any other court, other than the jurisdiction of the High Court under section 75 of the Constitution.

(1B) Subject to subsection (2), each prescribed court (other than the Federal Court) has jurisdiction with respect to matters arising under this Act in respect of which actions or proceedings may, under a provision of this Act, be instituted in a prescribed court.

(1C) A prosecution for an offence against this Act shall not be instituted in the Federal Court.

(2) The jurisdiction conferred by subsection (1B) on the Supreme Court of the Territory:

(a) to the extent that it relates to an action or proceeding for the infringement of a trade mark, an action under section 124 or a matter arising under this Act that may be heard and determined together with such an action or proceeding - is conferred to the extent that the Constitution permits

(b) in any other case - is conferred only in relation to an action or proceeding instituted by a natural person who is resident in the Territory or a corporation that has its principal place of business in the Territory at the time of the institution of the action or proceeding.

(3) The jurisdiction of a prescribed court under this section shall be exercised by a single Judge.

(4) The regulations may make provision for and in relation to the practice and procedure of prescribed courts in an action or proceeding under this Act, including provision prescribing the time within which any action or proceeding may be instituted or any other act or thing may be done, and providing for the extension of any such time.

## **TRADE MARKS ACT 1955 - SECT 113**

### **Transfer of proceedings**

## **SECT**

113. (1) A prescribed court in which an action or proceeding has been instituted under this Act may, if the court thinks fit, upon application of any party made at any stage in the action or proceeding, by order, transfer the action or proceeding to another prescribed court having jurisdiction to hear and determine the action or proceeding.

(2) Where an action or proceeding is transferred from a court in pursuance of this section:

(a) all documents filed of record in that court shall be transmitted to the Registrar or other proper officer of that court to the Registrar or other proper officer of the court to which the action or proceeding is transferred, and

(b) the court to which the action or proceeding is transferred shall hear and determine the action or proceeding as if the action or proceeding had been originally instituted in that court.

and as if the same proceedings had been taken in that court as had been in the court from which the action or proceeding was transferred.

## **TRADE MARKS ACT 1955 - SECT 114**

### **Appeals from prescribed courts**

## **SECT**

114. (1) An appeal lies to the Federal Court from a judgment or order

- (a) another prescribed court exercising jurisdiction under this Act;
- (b) any other court in an action or proceeding referred to in section 124.

(2) Except with the leave of the Federal Court, an appeal does not lie to the Full Court of the Federal Court from a judgment or order of a single judge of the Federal Court in the exercise of its jurisdiction to hear and determine appeals from decisions, directions or orders of the Registrar.

(3) An appeal lies to the High Court, with special leave of the High Court, from a judgment or order referred to in subsection (1).

(4) Except as provided in the foregoing provisions of this section, no appeal lies from a judgment or order referred to in subsection (1).

## **TRADE MARKS ACT 1955 - SECT 115**

## **Intervention by Registrar**

### **SECT**

115. The Federal Court may grant to the Registrar leave to intervene appeal to the court from a decision, direction or order of the Registra

### **TRADE MARKS ACT 1955 - SECT 115A** **Powers of prescribed courts**

### **SECT**

115A. Upon the hearing of an appeal from a decision or direction of t Registrar, the Federal Court may:

- (a) admit further evidence, either orally or upon affidavit or otherw
- (b) permit the examination and cross-examination of witnesses, includ witnesses who gave evidence orally or upon affidavit or otherwise at th 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 or direction appealed from
- (e) give such judgment, or make such order, as in all circumstances i thinks fit, or refuse to make an order; and
- (f) order a party to pay costs to another party.

### **TRADE MARKS ACT 1955 - PART XVA** **PART XVA - APPLICATION FOR REVIEW OF CERTAIN DECISIONS BY**

## **ADMINISTRATIVE APPEALS TRIBUNAL**

### **TRADE MARKS ACT 1955 - SECT 116** **Application for review**

#### **SECT**

116. An application may be made to the Administrative Appeals Tribuna review of any of the following decisions made on or after the commencem this Part:

- (a) a decision of the Registrar under subsection (2) of section 70, subsection (1) of section 71 or subsection (1) of section 127; or
- (b) a decision of the Registrar under subsection (1) of section 131 n extend the time for doing an act or taking a step.

### **TRADE MARKS ACT 1955 - PART XVI** **PART XVI - MISCELLANEOUS**

**TRADE MARKS ACT 1955 - SECT 117**  
**Use of trade mark for export trade**

**SECT**

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 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 the use of a trade mark in relation to those goods.

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

**TRADE MARKS ACT 1955 - SECT 118**  
**Trade mark not to be deemed to be deceptive or confusing in certain cases**

**SECT**

118. The use of a registered trade mark in relation to goods or services



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 or services 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 MARKS ACT 1955 - SECT 118A**  
**Subsections 99 (1) and 100 (1) may be dealt with summarily in certain circumstances**

**SECT**

118A. (1) Despite an offence against subsection 99 (1) or 100 (1) being an indictable offence, a court of summary jurisdiction may hear and determine proceedings in respect of such an offence if the court is satisfied that it is proper to do so and the defendant and the prosecutor consent.

(2) If, in accordance with subsection (1), a court of summary jurisdiction convicts a person of an offence against subsection 99 (1) or 100 (1), the penalty that the court may impose is a fine not exceeding \$500 for each item of goods to which the offence relates or imprisonment for a period not exceeding 12 months, or both.

(3) If a fine is imposed on a person because of subsection (2) in relation to an offence committed by the person and there are 2 or more items of goods to which the offence relates, the fine imposed in respect of that offence

not exceed \$10,000.

## **TRADE MARKS ACT 1955 - SECT 119**

### **Powers of Registrar**

## **SECT**

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.

## **TRADE MARKS ACT 1955 - SECT 120**

### **Disobedience to summons an offence**

## **SECT**

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

Penalty: \$1,000 or imprisonment for 6 months, or both.

(2) A person who has been required by the Registrar to produce a docu

article shall not, without lawful excuse, and after tender of reasonable expenses, fail to produce the document or article.

Penalty for contravention of this subsection:

(a) in the case of a natural person - \$1,000 or imprisonment for 6 months or both; or

(b) in the case of a body corporate - \$5,000.

## **TRADE MARKS ACT 1955 - SECT 121**

### **Refusal to give evidence an offence**

## **SECT**

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 produce documents or articles, or to answer questions, which he is lawfully required to produce or answer.

Penalty: \$1,000 or imprisonment for 6 months, or both.

## **TRADE MARKS ACT 1955 - SECT 122**

### **Recovery of costs**

## **SECT**

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

the costs were awarded to the person in whose favour they were awarded.

## **TRADE MARKS ACT 1955 - SECT 123**

### **Certificate of validity**

#### **SECT**

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.

## **TRADE MARKS ACT 1955 - SECT 124**

### **Groundless threats of legal proceedings**

#### **SECT**

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, when

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 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

(2) The last preceding subsection does not apply if the registered proprietor of the trade mark, or a registered user acting in pursuance of subsection (1) of section 78, 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) An action under this section may be instituted in a prescribed court but nothing in this section prevents such an action being instituted in a court that is not a prescribed court.

## **TRADE MARKS ACT 1955 - SECT 125**

### **Counter-claim by defendant for infringement**

#### **SECT**

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 *mutatis mutandis*, applicable in relation to that action.

## **TRADE MARKS ACT 1955 - SECT 126**

### **Description of trade marks in pleadings**

#### **SECT**

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.

## **TRADE MARKS ACT 1955 - SECT 127**

### **Power of amendment**

## **SECT**

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

(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 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.

(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 specified in the application before amendment.

## **TRADE MARKS ACT 1955 - SECT 128** **Exercise of discretionary power by Registrar**

## **SECT**

128. Where a discretionary power is, by this Act, given to the Registrar 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 specified by the Registrar) giving to that person an opportunity of being

heard.

## **TRADE MARKS ACT 1955 - SECT 129**

### **Fees**

## **SECT**

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

(2) Where a fee is payable in respect of the doing of an act by the Registrar, the Registrar must not do the act until the fee has been pai

(3) Subject to subsection (4), where a fee is payable in respect of t doing of an act by a person other than the Registrar, or a fee is payab respect of the lodging of a document, the act is to be regarded as done the document is to be regarded as lodged, even if the fee is not paid.

(4) Where the Registrar notifies the person concerned, or his or her in accordance with the regulations, of failure to pay the fee, the act to be regarded as done, or the document is not to be regarded as lodged before the day on which the fee is paid.

## **TRADE MARKS ACT 1955 - SECT 130**

### **Extension of time**



## **SECT**

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

### **TRADE MARKS ACT 1955 - SECT 131** **Power to extend times by reason of errors in Trade Marks Office etc.**

## **SECT**

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 i Trade Marks Office;

an act or step in relation to an application for the registration of a 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 taken, the Registrar may extend the time for doing the act or taking th 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 extend under this section although that time has expired.

### **TRADE MARKS ACT 1955 - SECT 132** **Address for service**

## **SECT**

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 shall 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.

### **TRADE MARKS ACT 1955 - SECT 133** **Declaration by disabled person**

## **SECT**

133. If a person is, by reason of infancy or physical or mental 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 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 making of the declaration or the doing of the thing.

### **TRADE MARKS ACT 1955 - SECT 134** **Death of party to a proceeding**

## **SECT**

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, p  
the proceeding to continue without the substitution of his successor in  
interest.

## **TRADE MARKS ACT 1955 - SECT 135**

### **Unauthorised persons not to act in trade mark matters**

## **SECT**

135. (1) Subject to section 138, a person shall not, for gain:

(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 obtainin  
opposing the registration of a trade mark; or

(c) give advice as to the validity of the registration of a trade mar  
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  
opponent concerned;

(h) a person who, within 1 year after the commencement of this Act, h  
satisfied the Registrar that, for a continuous period of 2 years immedi  
before 1 January 1955, he was practising as a trade marks agent in Aust  
or

(i) a person who:

(i) within 1 year after the commencement of this Act, has satisfied

the Registrar that, for a continuous period of 2 years immediately before January 1955, he was employed by a registered patent attorney in Australia 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 1 year after the commencement of this Act or within such further time as the Registrar allows, passed the prescribed examination.

Penalty: \$1,000.

(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 only or the principal business carried on by him was the business of prosecuting and opposing, for gain, applications for the registration of trade marks in Australia on behalf of applicants or opponents.

## **TRADE MARKS ACT 1955 - SECT 136**

### **Privileges of patent attorneys**

## **SECT**

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.

## **TRADE MARKS ACT 1955 - SECT 137**

### **Unregistered persons not to describe themselves as trade marks agents**

## **SECT**

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 subsection (1) of section 135; 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 subsection (1) of section 135.

Penalty: \$1,000.

(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: \$5,000.

(3) A director, manager, secretary or other officer of a company which is guilty of an offence against the last preceding subsection who is knowingly a party to the offence is guilty of an offence punishable, upon conviction, by a fine not exceeding \$1,000.

## **TRADE MARKS ACT 1955 - SECT 139**

### **Adaptation of classification**

## **SECT**

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, classes of goods, services or classes of services in respect of which trade marks are registered to any amended or substituted classification of goods or services which is prescribed.

(2) An amendment for the purpose referred to in the last preceding subsection shall not be made if it would have the effect of adding goods or classes of goods, services or classes of services to those in respect of which a trade mark is registered (whether in 1 or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of goods or services.

(3) The last preceding subsection does not have effect in relation to

as to which the Registrar is satisfied:

(a) that compliance with that subsection in relation to those goods w  
involve undue complexity; and

(b) that the addition or antedating, as the case may be, would not af  
substantial quantity of goods and would not substantially prejudice the  
of any person.

(4) A proposal for the amendment of the Register for the purpose refe  
in subsection (1):

(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  
that the proposed amendment contravenes the provisions of subsection (1

(5) An appeal lies to the Federal Court from a decision of the Regist  
under this section.

## **TRADE MARKS ACT 1955 - SECT 140**

### **Making and signing of applications**

## **SECT**

140. Where, by this Act, an application or notice is required or perm  
to be made or signed by a person, that application or notice may be mad  
signed, on behalf of that person, by a patent attorney, legal practitio



person entitled to practise as a trade marks agent.

## **TRADE MARKS ACT 1955 - SECT 141**

### **Examiners' reports to be communicated**

## **SECT**

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.

## **TRADE MARKS ACT 1955 - SECT 142**

### **Security for costs**

## **SECT**

142. If a person who appeals to the Federal Court neither resides nor carries on business in Australia, the Federal Court 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 Federal Court, the appeal may be dismissed.

## **TRADE MARKS ACT 1955 - SECT 143**

### **Costs of attendance of patent attorney**

## **SECT**

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

### **TRADE MARKS ACT 1955 - SECT 144** **Service of orders on appeal**

## **SECT**

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 th in Council, or by a court, on appeal from such a judgment or order, a p in whose favour the order on appeal is made is not entitled to enforce 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 mak entries (if any) in the Register, or take such other action (if any), a case requires.

### **TRADE MARKS ACT 1955 - SECT 145** **Improperly describing an office as the Trade Marks Office**

## SECT

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

Penalty:

- (a) in the case of a natural person - \$500; or
- (b) in the case of a body corporate - \$2,500.

(2) Without limiting the effect or application of the last preceding subsection, a person who:

(a) places, or suffers or permits to be placed, on the building in wh 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 wit words, shall be deemed to use, in connexion with his business, words wh would reasonably lead to the belief that his office is the Trade Marks

## **TRADE MARKS ACT 1955 - SECT 146** **Falsely representing a trade mark as registered an offence**

## SECT

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 or services in respect of which it is not registered; or

(d) to the effect that the registration of a trade mark gives a right of exclusive use of the trade mark in circumstances in which, having regard to the conditions or limitations entered on the Register, the registration does not give that right.

Penalty:

(a) in the case of a natural person - \$1,000; or

(b) in the case of a body corporate - \$5,000.

(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 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 used by 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 or services

exported to that country.

## **TRADE MARKS ACT 1955 - SECT 147 Regulations**

### **SECT**

147. The Governor-General may make regulations, not inconsistent with 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:

(a) for providing for the destruction of documents relating to trade marks the registration of which has ceased not less than 25 years before the destruction; and

(b) for prescribing penalties not exceeding a fine of \$500 for offences against the regulations; and

(c) making provision for and in relation to the refund, in specified circumstances, of the whole or part of a fee paid in respect of the lodgment of a document; and

(d) making provision for and in relation to the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a fee.

## **TRADE MARKS ACT 1955 - SCHEDULE 1**

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## THE SCHEDULE

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First Column	Second Column
Acts Repealed	Extent of Repeal

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Trade Marks Act 1905	The whole
Patents Trade Marks and Designs Act 1910	Section 4
Trade Marks Act 1912	The whole
Trade Marks Act 1919	The whole
Trade Marks Act 1922	The whole
Trade Marks Act 1936	The whole
Trade Marks Act 1948	The whole

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