



Trade Marks Act 1994

No. 156 of 1994

An Act relating to trade marks

[Assented to 13 December 1994]

The Parliament of Australia enacts:

PART 1—PRELIMINARY

Short title

1. This Act may be cited as the *Trade Marks Act 1994*.

Commencement

2.(1) Subject to subsection (2), this Act commences on a day to be fixed by Proclamation.

(2) If this Act does not commence under subsection (1) before 1 January 1996, it commences on that day.

Act binds the Crown

3.(1) This Act binds the Crown in right of the Commonwealth, of each of the States, of the Australian Capital Territory, of the Northern Territory and of Norfolk Island.

(2) Nothing in this Act makes the Crown liable to be prosecuted for an offence.

Application of Act

4. This Act extends to:

- (a) each external Territory; and
- (b) the Australian continental shelf; and
- (c) the waters above the Australian continental shelf; and
- (d) the airspace above Australia, each external Territory and the Australian continental shelf.

PART 2—INTERPRETATION

Definitions

5. In this Act, unless the contrary intention appears:

“**abandon**”, in relation to a trade mark, has the meaning given by section 11;

“**applicant**”, in relation to an application, means the person in whose name the application is for the time being proceeding;

“**applied to**” and “**applied in relation to**” have the respective meanings given in section 8;

“**approved form**” means a form approved by the Registrar for the purposes of the provision in which the expression appears;

“**assignment**”, in relation to a trade mark, means an assignment by act of the parties concerned;

“**associated trade marks**” has the meaning given by section 10;

“**association**” does not include a body corporate;

“**Australia**” includes each external Territory;

“**Australian continental shelf**” means the continental shelf, within the meaning of the Continental Shelf Convention, adjacent to the coast of Australia (including the coast of any island forming part of a State or Territory);

“**authorised use**”, in relation to a trade mark, has the meaning given by section 7;

“**certification trade mark**” has the meaning given by section 177;

“**collective trade mark**” has the meaning given by section 170;

“**commencing day**” means the day on which this Act commences;

“Commission” means:

- (a) the Trade Practices Commission established under the *Trade Practices Act 1974*; or
- (b) a member of the Commission (within the meaning of that Act);

“Comptroller” means the Comptroller-General of Customs;

“Convention country” means a country declared (by regulations made under section 235) to be a Convention country for the purposes of this Act;

“date of registration”, in relation to a registered trade mark, means the day from which the registration of the trade mark is taken to have had effect under subsection 73(1) or (2);

“deceptively similar” has the meaning given by section 9;

“defensive trade mark” has the meaning given by section 193;

“Deputy Registrar” means a Deputy Registrar of Trade Marks;

“Designs Office” means the Designs Office established by the *Designs Act 1906*;

“designated owner”, in relation to goods imported into Australia, means the person identified as the owner of the goods on the entry made in relation to the goods under section 68 of the *Customs Act 1901*;

“divisional application” means an application made under Division 3 of Part 4 for the registration of a trade mark;

“employee” means a person, other than the Registrar or a Deputy Registrar, who:

- (a) is an officer or employee within the meaning of the *Public Service Act 1922* and is performing duties in the Trade Marks Office, the Patent Office or the Designs Office; or
- (b) is not such an officer or employee but performs services, for or on behalf of the Commonwealth, in the Trade Marks Office, the Patent Office or the Designs Office;

“examine”, in relation to an application for the registration of a trade mark, means to carry out an examination under section 30 in relation to the application;

“existing registered mark” means a mark that was registered in Part A, B, C or D of the old register immediately before the commencement of this Act;

“Federal Court” means the Federal Court of Australia;

“file” means to file at the Trade Marks Office;

Note: See section 222;

“filing date” means:

- (a) in relation to an application for the registration of a trade mark other than an application referred to in another paragraph of this definition—the day on which the application is filed; or

- (b) in relation to a divisional application for the registration of a trade mark:
 - (i) if the Registrar has given a direction under section 50—the day on which the initial application (within the meaning of Division 3 of Part 4) was filed; or
 - (ii) if subparagraph (i) does not apply—the day on which the divisional application is filed; or
- (c) in relation to an application to which section 249 applies—the day referred to in subsection 249(6); or
- (d) in relation to an application made under section 251—the day referred to in subsection 251(3);

“geographical indication”, in relation to wine or spirits originating in a particular country or in a region or locality of that country, means a sign recognised in that country as a sign indicating that the wine or spirits:

- (a) originated in that country, region or locality; and
- (b) have a quality, reputation or other characteristic attributable to their geographical origin;

“goods of a person” means goods dealt with in the course of trade by the person;

“lawyer” means a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory;

“limitations” means limitations of the right to the exclusive use of a trade mark given by the registration of the trade mark, including limitations of that right as to:

- (a) mode of use;
- (b) use within a territorial area within Australia; or
- (c) use in relation to goods to be exported;

“notified trade mark” means a trade mark in respect of which a notice under section 141 is in force;

“objector”, in relation to seized goods, means any person who has given under section 141 a notice in respect of those goods that is in force;

“Official Journal” means the *Official Journal of Trade Marks* mentioned in section 236;

“old register” means the Register of Trade Marks kept under the repealed Act;

“Patent Office” means the Patent Office established by the *Patents Act 1990*;

“pending”, in relation to an application for the registration of a trade mark, has the meaning given by section 12;

“person” includes a body of persons, whether incorporated or not;

“person’s goods” (see goods of a person);

“**person’s services**” (see services of a person);

“**prescribed court**” means a court that is under section 199 a prescribed court for the purposes of this Act;

“**Register**” means the Register of Trade Marks kept under section 215;

“**registered owner**”, in relation to a registered trade mark, means the person in whose name the trade mark is registered;

“**registered patent attorney**” means a person registered as a patent attorney under the *Patents Act 1990*;

“**registered trade mark**” means a trade mark whose particulars are entered in the Register under this Act;

“**registered user**”, in relation to a trade mark, means a person registered as a user of a trade mark under Part 11;

“**Registrar**” means the Registrar of Trade Marks;

“**registration number**”, in relation to a registered trade mark, means the number given to it under subsection 69(2);

“**remove from the Register**”, in relation to a trade mark, has the meaning given by section 13;

“**repealed Act**” has the meaning given by section 15;

“**restore to the Register**”, in relation to a trade mark, has the meaning given by section 14;

“**seized goods**” means goods seized under section 142;

“**services of a person**” means services provided in the course of trade by a person;

“**sign**” includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, sound or aspect of packaging;

“**this Act**” includes the regulations;

“**trade mark**” has the meaning given by section 16;

“**transmission**” means:

- (a) transmission by operation of law; or
- (b) devolution on the personal representative of a deceased person; or
- (c) any other kind of transfer except assignment;

“**use**”, in relation to a trade mark, has the meaning given by section 6;

“**word**” includes an abbreviation of a word.

Use of trade mark

6.(1) In this Act:

- (a) a reference to the **use of a trade mark** is a reference to the use of any visual or aural representation of a trade mark in relation to goods or services; and

(b) a reference to the **use of a trade mark in relation to goods** is a reference to the use of a representation of a trade mark upon, or in physical or other relation to, the goods.

(2) If the Registrar or a prescribed court, having regard to the circumstances of a particular case, thinks fit, the Registrar or the court may decide that a person has used a trade mark if it is established that the person:

- (a) has used the trade mark with additions or alterations that do not substantially affect the identity of the trade mark; or
- (b) has used an associated trade mark.

(3) If the registered owner of a registered trade mark ("**first trade mark**") is also the registered owner of another registered trade mark that contains the first trade mark, the registered owner is taken, when he or she uses the other trade mark, to have also used the first trade mark.

(4) The use of a trade mark by a person authorised to use the trade mark (see section 7) is taken, for the purposes of this Act, to be a use of the trade mark by the owner of the trade mark.

Authorised use of trade mark

7.(1) The use of a trade mark by a person is an **authorised use** only if the person uses the trade mark under the control of the owner of the trade mark.

Note: A person may be an authorised user of a trade mark even if the person is not a registered user of the trade mark.

(2) If the owner of a trade mark exercises quality control over goods or services:

- (a) dealt with or provided by another person; and
- (b) in relation to which the trade mark is used;

the trade mark is taken, for the purposes of subsection (1), to have been used by the other person under the control of the owner. This subsection does not, however, limit the meaning of the expression "under the control of" in subsection (1).

Definition of "applied to" and "applied in relation to"

8.(1) For the purposes of this Act:

- (a) a representation of a trade mark is taken to be **applied to** any goods, material or thing if it is woven in, impressed on, worked into, or affixed or annexed to, the goods, material or thing; and
- (b) a representation of a trade mark is taken to be **applied in relation to** goods or services:
 - (i) if it is applied to any covering, document, label, reel or thing in or with which the goods are, or are intended to be, dealt with or provided in the course of trade; or

- (ii) if it is used in a manner likely to lead persons to believe that it refers to, describes or designates the goods or services; and
- (c) a representation of a trade mark is taken also to be **applied in relation to goods or services** if 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 following a request or order made by referring to the trade mark as so used.

(2) In subparagraph (1)(b)(i):

“**covering**” includes packaging, frame, wrapper, container, stopper, lid or cap;

“**label**” includes a band or ticket.

Definition of “deceptively similar”

9. For the purposes of this Act, a trade mark is taken to be **deceptively similar** to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

Associated trade marks

10.(1) If a trade mark that is registered, or whose registration is being sought, in the name of a person and in respect of particular goods:

- (a) is substantially identical with another trade mark that is registered, or whose registration is being sought, in the name of the same person and in respect of:
 - (i) the same goods; or
 - (ii) goods of the same description as those goods; or
 - (iii) services that are closely related to those goods; or
- (b) so nearly resembles such a trade mark that the use of the first trade mark by another person would be likely to deceive or cause confusion;

the 2 trade marks are **associated trade marks**.

(2) If a trade mark that is registered, or whose registration is being sought, in the name of a person and in respect of particular services:

- (a) is substantially identical with another trade mark that is registered, or whose registration is being sought, in the name of the same person and in respect of:
 - (i) the same services; or
 - (ii) services of the same description as those services; or

- (iii) goods that are closely related to those services; or
- (b) so nearly resembles such a trade mark that the use of the first trade mark by another person would be likely to deceive or cause confusion;

the 2 trade marks are **associated trade marks**.

Abandonment of trade mark

11. A trade mark is **abandoned** if it has not been used for a continuous period of 3 years or more.

Definition of “pending”

12.(1) An application for the registration of a trade mark under this Act is **pending** if it has not lapsed or been withdrawn and:

- (a) the Registrar has not yet made a decision about it under section 32; or
- (b) the Registrar has accepted it under subsection 32(3) but has not yet made a decision whether to register the trade mark or not under section 55.

(2) An application for the registration of a trade mark under the repealed Act was **pending** immediately before the commencement of this Act if:

- (a) it had not lapsed or been withdrawn under the repealed Act; and
- (b) before the commencing day:
 - (i) the Registrar had not made a decision about it under subsection 44(1) of that Act; or
 - (ii) the Registrar had accepted it under that subsection but had not yet made a decision whether to register the trade mark or not under subsection 50(1) of that Act.

Remove from the Register

13. A trade mark is taken to have been **removed from the Register** if the Registrar makes an entry in the Register to the effect that all particulars relating to the trade mark entered in the Register are taken to have been removed from the Register.

Restore to the Register

14. A trade mark that has been removed from the Register is taken to be **restored to the Register** if the Registrar makes an entry in the Register to the effect that all particulars relating to the trade mark taken to have been removed from the Register are restored to the Register.

Repealed Act

15.(1) The **repealed Act** means:

- (a) the *Trade Marks Act 1955* as in force immediately before its repeal;
and
- (b) the regulations under that Act as in force immediately before its repeal.

Note: For the repeal of the *Trade Marks Act 1955* see section 241.

(2) In this Act, a reference to a particular section of the repealed Act includes a reference to the regulations made for the purposes of that section as in force immediately before that Act was repealed.

PART 3—TRADE MARKS AND TRADE MARK RIGHTS

What is a trade mark?

16. A trade mark is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so provided or dealt with by any other person.

Note: For “sign” see section 5.

Certain signs not to be used as trade marks etc.

17.(1) The regulations may provide that a sign specified in the regulations is not to be used as a trade mark or as part of a trade mark.

(2) Regulations made under subsection (1) do not affect any trade mark that:

- (a) was a registered trade mark; or
- (b) in the case of an unregistered trade mark—was being used in good faith;

immediately before the regulations were notified in the *Gazette*.

Certain trade marks may be registered

18.(1) A trade mark may be registered in accordance with this Act in respect of:

- (a) goods; or
- (b) services; or
- (c) both goods and services.

(2) The registration of a trade mark may be in respect of goods or services of one or more of the classes prescribed under subsection (3).

(3) The regulations may prescribe the classes into which goods and services are to be divided for the purposes of this Act.

Rights given by registration of trade mark

19.(1) If a trade mark is registered, the registered owner of the trade mark has, subject to this Part, the exclusive rights:

- (a) to use the trade mark; and
- (b) to authorise other persons to use the trade mark;

in relation to the goods and services in respect of which the trade mark is registered.

Note: For “use” see section 6.

(2) The registered owner of a trade mark has also the right to obtain relief under this Act if the trade mark has been infringed.

Note: For what amounts to an infringement of a trade mark see Part 13.

(3) The rights are taken to have accrued to the registered owner as from the date of registration of the trade mark.

Note: For “date of registration” see section 5.

(4) If the trade mark is registered subject to conditions or limitations, the rights of the registered owner are restricted by those conditions or limitations.

(5) If the trade mark is registered in the name of 2 or more persons as joint owners of the trade mark, the rights granted to those persons under this section are to be exercised by them as if they were the rights of a single person.

Nature of registered trade mark as property

20. A registered trade mark is personal property.

Power of registered owner to deal with trade mark

21.(1) The registered owner of a trade mark may, subject only to any rights vested in another person, deal with the trade mark as its absolute owner and give in good faith discharges for any consideration for that dealing.

(2) This section does not protect a person who deals with the registered owner otherwise than:

- (a) as a purchaser in good faith for value; and
- (b) without notice of any fraud on the part of the owner.

(3) Equities in respect of a trade mark may be enforced against the registered owner in the same way as equities in respect of any other personal property.

Limitation on rights if similar trade marks etc. registered by different persons

22. If trade marks that are substantially identical or deceptively similar have been registered by more than one person, (whether in respect of the same or different goods or services), the registered owner of any one of those trade marks does not have the right to prevent the registered owner of any

other of those trade marks from using that trade mark except to the extent that the first-mentioned owner is authorised to do so under the registration of his or her trade mark.

Note: For “deceptively similar” see section 9.

Trade mark consisting of sign that becomes accepted as sign describing article etc.

23.(1) This section applies if a registered trade mark consists of, or contains, a sign that, after the date of registration of the trade mark, becomes well known, or becomes accepted generally, as the sign that describes or is the name of an article, substance or service.

(2) If the trade mark consists of the sign, the registered owner:

(a) does not have any exclusive rights to use, or authorise other persons to use, the trade mark in relation to:

(i) the article or substance or other goods of the same description; or

(ii) the service or other services of the same description; and

(b) is taken to have ceased to have those exclusive rights from and including the day determined by the court under subsection (4).

(3) If the trade mark contains the sign, the registered owner:

(a) does not have any exclusive rights to use, or authorise other persons to use, the sign in relation to:

(i) the article or substance or other goods of the same description; or

(ii) the service or other services of the same description; and

(b) ~~is taken to have ceased to have those exclusive rights from the day~~ determined by the court under subsection (4).

(4) For the purposes of subsections (2) and (3), a prescribed court may determine the day on which a sign first became well known or generally accepted as the sign that describes or is the name of the article, substance or service.

Trade mark relating to article etc. formerly manufactured under patent

24.(1) This section applies if:

(a) a registered trade mark consists of, or contains, a sign that describes or is the name of:

(i) an article or substance that was formerly exploited under a patent; or

(ii) a service that was formerly provided as a patented process; and

(b) it is at least 2 years since the patent has expired or ceased; and

- (c) the sign is the only commonly known way to describe or identify the article, substance or service.
- (2) If the trade mark consists of the sign, the registered owner:
 - (a) does not have any exclusive rights to use, or authorise other persons to use, the trade mark in relation to:
 - (i) the article or substance or other goods of the same description; or
 - (ii) the service or other services of the same description; and
 - (b) is taken to have ceased to have those exclusive rights from the end of the period of 2 years after the patent expired or ceased.
- (3) If the trade mark contains the sign, the registered owner:
 - (a) does not have any exclusive rights to use, or authorise other persons to use, the sign in relation to:
 - (i) the article or substance or other goods of the same description; or
 - (ii) the service or other services of the same description; and
 - (b) is taken to have ceased to have those exclusive rights from the end of the period of 2 years after the patent expired or ceased.

PART 4—APPLICATION FOR REGISTRATION

Division 1—General

Application—how made

25.(1) A person who claims to be the owner of a trade mark may apply to the Registrar for the registration of the trade mark.

- (2) The application must:
 - (a) be in accordance with the regulations; and
 - (b) be filed, together with any prescribed document, in accordance with the regulations.
- (3) Without limiting the particulars that may be included in an application, the application must:
 - (a) include a representation of the trade mark; and
 - (b) specify the goods and/or services (“**relevant goods and services**”) in respect of which it is sought to register the trade mark; and
 - (c) contain:
 - (i) a statement that the applicant is the owner of the trade mark; and
 - (ii) a statement of a kind referred to in subsection (4) relating to the use of the trade mark.

- (4) The application must contain:
- (a) a statement that the applicant:
 - (i) is using or intends to use; or
 - (ii) has authorised or intends to authorise another person to use; the trade mark in relation to the relevant goods and services; or
 - (b) a statement that the applicant intends to assign the trade mark to a body corporate that is about to be constituted and that the body corporate intends to use the trade mark in relation to the relevant goods and services.

Note: For “use” see section 6.

(5) An application may be made in respect of goods and services of one or more of the classes prescribed under subsection 18(3).

Application by joint owners

26. If the relations between 2 or more persons interested in a trade mark are such that none of them is entitled to use the trade mark except:

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

the persons may together apply for its registration under subsection 25(1).

Application for registration of trade mark whose registration has been sought in a Convention country—claim for priority

27.(1) If:

- (a) a person has made an application for the registration of a trade mark in one or more than one Convention country; and
- (b) within 6 months after the day on which that application, or the first of those applications, was made, that person or that person’s successor in title applies to the Registrar for the registration of the trade mark;

the person or the person’s successor in title may, when filing the application, or within the prescribed period after filing the application but before the application is accepted, claim a right of priority for the application in accordance with the regulations.

(2) The regulations may provide for the filing of documents in support of a notice claiming priority and, in particular, for the filing of certified copies of any application for the registration of the trade mark made in a Convention country.

Details of application to be published

28. The Registrar must publish the details of the application in accordance with the regulations.

Application—trade mark consisting etc. of name etc. of a person other than the applicant

29.(1) If the application is for the registration of a trade mark that consists of, or contains, the name or a representation of a living person, the Registrar may ask the applicant to provide evidence that the person has consented to the name or representation appearing in the trade mark.

(2) If the application is for the registration of a trade mark that consists of, or contains, the name or a representation of a person who has recently died, the Registrar may ask the applicant to provide evidence that the legal representative of the deceased person has consented to the name or representation appearing in the trade mark.

Examination of application

30.(1) The Registrar must examine:

- (a) whether the application has been made in accordance with this Act; and
- (b) whether there are grounds under Division 2 for rejecting it.

(2) The examination is to be carried out in accordance with the regulations.

Registrar to decide on disputed classification of goods etc.

31. If a question arises as to the class in which goods or services are comprised:

- (a) that question is to be decided by the Registrar; and
- (b) the decision of the Registrar is not subject to appeal and may not be called into question in an appeal or other proceedings under this Act.

Application accepted or rejected

32.(1) If the Registrar is satisfied that:

- (a) the application has not been made in accordance with this Act; or
- (b) there are grounds for rejecting it;

the Registrar must reject the application.

Note: For the grounds on which an application may be rejected see Division 2.

(2) The Registrar may not reject an application without giving the applicant an opportunity of being heard.

(3) If the Registrar is not satisfied as set out in subsection (1), he or she must accept the application.

(4) The Registrar may accept the application subject to conditions or limitations.

Notice etc. of decision

33. The Registrar must:

- (a) notify the applicant in writing of:
 - (i) his or her findings, and any prescribed matter, arising out of the examination; and
 - (ii) his or her decision under section 32; and
- (b) advertise the decision in the *Official Journal*.

Appeal

34. The applicant may appeal to the Federal Court against a decision of the Registrar:

- (a) to accept the application subject to conditions or limitations; or
- (b) to reject the application.

Lapsing of application

35.(1) Subject to subsection (2), an application lapses if it is not accepted within the prescribed period.

(2) If, after the prescribed period has expired, the Registrar under section 234 extends the period within which the application may be accepted, the application:

- (a) is taken not to have lapsed when the prescribed period expired; and
- (b) lapses if it is not accepted within the extended period.

Revocation of acceptance

36.(1) If, before a trade mark is registered, the Registrar is satisfied:

- (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; 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 revoke the acceptance of the application.

(2) If the Registrar revokes the acceptance, the Registrar must examine the application as necessary under section 30.

(3) In every case, sections 32 and 33 again apply in relation to the application.

Division 2—Grounds for rejecting an application

Trade mark containing etc. certain signs

37. An application for the registration of a trade mark may be rejected if the trade mark contains or consists of:

- (a) a sign that is prescribed for the purposes of this section; or
- (b) a sign so nearly resembling such a sign as to be likely to be taken for it.

Trade mark that cannot be represented in writing

38. An application for the registration of a trade mark must be rejected if the trade mark cannot be represented in writing.

Note: "Writing" has the meaning given by section 25 of the *Acts Interpretation Act 1901* which provides as follows: " 'Writing' includes any mode of representing or reproducing words, figures, drawings or symbols in a visible form."

Trade mark consisting of shape of goods

39. An application for the registration of a trade mark in respect of goods must be rejected if the trade mark consists wholly or principally of:

- (a) the shape, or some other characteristic, possessed, because of their nature, by the goods; or
- (b) a shape, or some other characteristic, that the goods must have if a particular technical result is to be obtained.

Trade mark not distinguishing applicant's goods or services

40.(1) In this section, a reference to the use of a trade mark by an applicant for the registration of the trade mark includes a reference to the use of the trade mark by a predecessor in title (if any) of the applicant.

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered ("**designated goods or services**") from the goods or services of other persons.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services.

(4) Then, if the Registrar is still unable to decide the question, the Registrar is to take into account:

- (a) the extent to which the trade mark does in fact so distinguish the designated goods or services because of any or all of the following:
 - (i) the use made by the applicant of the trade mark;
 - (ii) the extent to which it is inherently adapted to distinguish the designated goods or services;
 - (iii) any other circumstances; or
- (b) the extent to which the trade mark will in fact so distinguish the designated goods or services because of any or all of the following:
 - (i) the use made, and likely to be made, by the applicant of the trade mark;
 - (ii) the extent to which it is inherently adapted to distinguish the designated goods or services;

- (iii) any other circumstances; or
- (c) if the applicant has not used the trade mark—the extent to which the trade mark will in fact so distinguish the designated goods or services because of either or both of the following:
 - (i) the intended use of the trade mark by the applicant together with the extent to which it is inherently adapted to distinguish the designated goods or services;
 - (ii) any other circumstances.

Trade mark consisting of signs designating quality etc.

41.(1) Subject to subsection (2), an application for the registration of a trade mark must be rejected if the trade mark consists wholly or principally of a sign that is ordinarily used to indicate:

- (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of the goods or services; or
- (b) the time of production of the goods or of the rendering of the services.

(2) The application must not be rejected if the applicant establishes that, because of the extent to which the applicant has used the trade mark, the trade mark does distinguish the goods or services in relation to which it has been used as being those of the applicant.

Scandalous marks etc.

42.(1) An application for the registration of a trade mark must be rejected if:

- (a) the trade mark contains or consists of scandalous matter; or
- (b) its use would be contrary to law or would not be entitled to protection in a court.

(2) An application for the registration of a trade mark in respect of particular goods or services must be rejected if the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion regarding:

- (a) the nature, quality, origin, intended purpose, or some other characteristic, of the goods or services; or
- (b) any connection or relationship that they may have with any particular person.

Trade mark consisting etc. of name etc. of person other than the applicant

43. If:

- (a) in relation to an application, the Registrar has asked under section 29 that evidence be provided of the consent of a particular person; and

(b) the applicant has not provided the evidence as asked;
the Registrar must reject the application.

Identical etc. trade marks

44.(1) Subject to subsections (3) and (4), an application for the registration of a trade mark in respect of goods (“**applicant’s trade mark**”) must be rejected if:

(a) the applicant’s trade mark is substantially identical with, or deceptively similar to:

- (i) a trade mark registered by another person; or
- (ii) a trade mark in respect of which an application for registration has been made by another person;

that relates to:

- (iii) goods that are the same as, or of the same description as that of, the goods (“**applicant’s goods**”) to which the applicant’s trade mark relates; or
 - (iv) services that are closely related to the applicant’s goods; and
- (b) the priority date for the applicant’s trade mark is not earlier than the priority date for the other trade mark.

Note: For “priority date” see subsection (5).

(2) Subject to subsections (3) and (4), an application for the registration of a trade mark in respect of services (“**applicant’s trade mark**”) must be rejected if:

(a) it is substantially identical with, or deceptively similar to:

- (i) a trade mark registered by another person; or
- (ii) a trade mark in respect of which an application for registration has been made by another person;

that relates to:

- (iii) services that are the same as, or are of the same description as that of, the services (“**applicant’s services**”) to which the applicant’s trade mark relates; or
 - (iv) goods that are closely related to the applicant’s services; and
- (b) the priority date for the applicant’s trade mark is not earlier than the priority date for the other trade mark.

Note: For “priority date” see subsection (5).

(3) If the Registrar in either case is satisfied:

- (a) that there has been an honest concurrent use of the 2 trade marks; or
- (b) that, because of the other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's trade mark subject to any condition or limitation that the Registrar thinks fit to impose. If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

(4) If the Registrar in either case is satisfied:

- (a) that the applicant, or a predecessor in title of the applicant, has continuously used the applicant's trade mark for a period before the date of registration of the other trade mark; and
- (b) that the applicant's trade mark was never abandoned;

the Registrar may not reject the application because of the existence of the other trade mark.

(5) The "priority date" for a trade mark is:

- (a) if the trade mark is registered—the date of registration of the trade mark; or
- (b) if the registration of the trade mark is being sought—the day that would be the date of the registration of the trade mark if it were registered.

Division 3—Divisional applications

Object of Division

45. This Division provides that a person who has made an application ("initial application") for the registration of a trade mark in respect of certain goods and services may, in the circumstances set out in the Division, make another application ("divisional application"):

- (a) for the registration of a part only of the trade mark in respect of those goods and services; or
- (b) for the registration of the trade mark in respect of some only of the goods or services in respect of which registration is sought under the initial application; or
- (c) if the initial application has been amended to exclude some of the goods or services in respect of which registration was sought in the first place—for the registration of the trade mark in respect of any or all of the goods or services that have been so excluded.

Divisional application possible only if initial application is pending

46. A divisional application for the registration of a trade mark or a part of a trade mark may be made only if the initial application for the registration of the trade mark is pending.

Divisional application for registration of part of trade mark

47.(1) If a part of a trade mark, by itself, may be registered as a trade mark, the applicant for the registration of the trade mark may, within the prescribed period but subject to subsection (2), make a divisional application for the registration of that part as a trade mark in respect of the goods and services specified in the initial application.

(2) If the initial application has been accepted, the divisional application may not be made after the acceptance is advertised in the *Official Journal*.

Divisional application for registration of trade mark in respect of some of the goods and services specified in the initial application

48.(1) The applicant for the registration of a trade mark may, subject to subsection (2), make a divisional application for the registration of the trade mark in respect of any (but not all) of:

- (a) the goods and services specified in the initial application; or
- (b) if the initial application has been amended to exclude some of the goods or services specified in that application before its amendment—the goods and services specified in the initial application as amended.

(2) If the initial application has been accepted, the divisional application may not be made after the acceptance is advertised in the *Official Journal*.

Divisional application for registration of trade mark in respect of goods or services excluded from the initial application

49.(1) This section applies if the initial application for the registration of a trade mark is amended to exclude some of the goods or services specified in that application before its amendment.

- (2) If the initial application is amended:
 - (a) before a decision is made about it under section 32; or
 - (b) if the initial application is accepted—before its acceptance is advertised in the *Official Journal*;

the applicant may, within the prescribed period but subject to subsection (3), make a divisional application for the registration of the trade mark in respect of any or all of the goods or services that have been excluded from the initial application.

(3) If the initial application has been accepted, the divisional application may not be made after the acceptance is advertised in the *Official Journal*.

(4) If the initial application (whether it has already been amended or not) is amended after its acceptance has been advertised in the *Official Journal*, the applicant may, within the prescribed period, make a divisional

application for the registration of the trade mark in respect of any or all of the goods or services that have been excluded from the application whose acceptance was advertised in the *Official Journal*.

Filing date

50. If the Registrar so directs, a divisional application is taken to have been filed on the day on which the initial application concerned was filed.

Division 4—Application for registration of series of trade marks

Application—series of trade marks

51.(1) A person may make a single application under subsection 25(1) for the registration of several trade marks in respect of any or all of the following:

- (a) the same goods within a single class;
- (b) the same services within a single class;
- (c) goods of the same description within a single class;
- (d) services of the same description within a single class;

if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (e) statements or representations as to the goods or services in relation to which the trade marks are used or intended to be used;
- (f) statements or representations as to number, price, quality or names of places;
- (g) colour;
- (h) any matter that is not capable of distinguishing the goods or services and does not substantially affect the identity of the trade marks.

(2) If the Registrar decides to register the trade marks, he or she may register them as a series in one registration.

PART 5—OPPOSITION TO REGISTRATION

Division 1—General

Opposition

52.(1) If the Registrar has accepted an application for the registration of a trade mark, a person may oppose the registration by filing a notice of opposition.

(2) The notice of opposition must be in an approved form and must be filed within the prescribed period.

(3) The opponent must serve a copy of the notice on the applicant.

(4) The registration of a trade mark may be opposed on any of the grounds specified in Division 2 and on no other grounds.

Re-examination

53.(1) An opponent to the registration of a trade mark may, in accordance with the regulations, ask the Registrar to re-examine the application for the registration of the trade mark on the ground that there has been an error or omission in the course of the examination of the application.

(2) The Registrar may not decide to re-examine the application without:

- (a) giving an opportunity to the applicant to make representations (either orally or in writing) on the matter; and
- (b) taking into account the representations (if any) made by the applicant.

(3) If the Registrar decides to re-examine the application, the Registrar must revoke the acceptance of the application.

(4) If the Registrar revokes the acceptance of the application:

- (a) the notice of opposition is taken to have been withdrawn; and
- (b) the Registrar must re-examine the application as necessary to take into account any matter that he or she failed to consider because of the error or omission; and
- (c) sections 32 and 33 again apply in relation to the application.

(5) If the Registrar decides not to re-examine the application, the Registrar continues to deal with the opposition under this Division.

Opposition proceedings

54.(1) The Registrar must give to the opponent and to the applicant an opportunity of being heard on the opposition.

(2) Subject to subsection (1), the proceedings for dealing with the opposition must be in accordance with the regulations.

Decision

55. At the end of the proceedings, the Registrar must decide:

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark with or without conditions and limitations in respect of the goods and services then specified in the application;

having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Appeal

56. The applicant or the opponent may appeal to the Federal Court from a decision of the Registrar under section 55.

Division 2—Grounds for opposing registration

Registration may be opposed on same grounds as for rejection

57. The registration of a trade mark may be opposed on any of the grounds on which an application for the registration of a trade mark may be rejected under Division 2 of Part 4, except the ground that the trade mark cannot be represented in writing.

Applicant not owner of trade mark

58.(1) Subject to subsection (2), the registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

(2) The opposition fails if:

- (a) in order to establish that the applicant is not the owner of the trade mark, the opponent relies on the fact that another person used the trade mark at an earlier time than the applicant; and
- (b) the applicant establishes that:
 - (i) the application was filed with the consent or approval of the other person; and
 - (ii) as at the filing date in respect of the application, the other person had ceased to use the trade mark.

Applicant not intending to use trade mark

59. The registration of a trade mark may be opposed on the ground that the applicant does not intend:

- (a) to use, or authorise the use of, the trade mark in Australia; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods or services specified in the application.

Interference with right of opponent to use another trade mark

60. The registration of a trade mark may be opposed on the ground that its registration would prevent the opponent from continuing to use an unregistered trade mark:

- (a) that the opponent, or a predecessor in title of the opponent, had previously used; and
- (b) that had not been abandoned by either of them on the filing date in respect of the application for the registration of the trade mark.

Trade mark similar to well-known trade mark

61. The registration of a trade mark may be opposed on the ground that:

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the filing date in respect of the application for the registration of the first-mentioned trade mark, had acquired a reputation in Australia; and

- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

Trade mark in respect of wine etc. containing or consisting of a false geographical indication

62.(1) If the application is for the registration of a trade mark in respect of wine or spirits (“**relevant wine or spirits**”), the registration may be opposed on the ground that the trade mark contains or consists of a sign that is a geographical indication for wine or spirits (“**designated wine or spirits**”) originating in:

- (a) a country, or in a region or locality in a country, other than the country in which the relevant wine or spirits originated; or
- (b) a region or locality in the country in which the relevant wine or spirits originated other than the region or locality in which the relevant wine or spirits originated.

Note: For “geographical indication” see section 5.

(2) The opposition fails if the applicant establishes that:

- (a) the relevant wine or spirits originated in the country, region or locality identified by the geographical indication; or
- (b) the sign has ceased to be used as a geographical indication for the designated wine or spirits in the country in which the designated wine or spirits originated; or
- (c) the applicant, or a predecessor in title of the applicant, used the sign in respect of the relevant wine or spirits, or applied for the registration of the trade mark in respect of the relevant wine or spirits, before:
 - (i) 1 January 1996; or
 - (ii) the day on which the sign was recognised as a geographical indication for the designated wine or spirits in their country of origin;

whichever is later; or

- (d) the sign is identical with the name that, on 1 January 1995, was, in the country in which the relevant wine or spirits originated, the customary name of a variety of grapes used in the production of the relevant wine or spirits.

(3) The opposition also fails if the applicant establishes that:

- (a) although the sign is a geographical indication for the designated wine or spirits, it is also a geographical indication for the relevant wine or spirits; and

- (b) the applicant has not used, and does not intend to use, the trade mark in relation to the relevant wine or spirits in a way that is likely to deceive or confuse members of the public as to the origin of the relevant wine or spirits.

Application etc. defective etc.

63. The registration of a trade mark may be opposed on any of the following grounds:

- (a) that the application, or a document filed with the application, was amended contrary to this Act;
- (b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

PART 6—AMENDMENT OF APPLICATION AND OTHER DOCUMENTS

Amendment of application

64.(1) The Registrar may, at the request of the applicant, amend an application for the registration of a trade mark as provided in this Part.

(2) If:

- (a) an application for the registration of a trade mark may be amended under section 66; and
- (b) the applicant has not asked that the application be amended;

the Registrar may, in accordance with the regulations, direct that the application be amended as necessary to remove any ground on which the application could be rejected:

Amendment before details of application are published

65. If:

- (a) the details of the application have not yet been published under section 28; and
- (b) the request for the amendment is made within the prescribed period;

an amendment may be made to correct a clerical error or an obvious mistake.

Amendment after details of application have been published

66.(1) If the details of the application have been published under section 28, the application may be amended as provided in this section.

(2) An amendment may be made to the representation of the trade mark if the amendment does not substantially affect the identity of the trade mark as at the time when the details of the application were published.

(3) An amendment may be made to correct a mistake of fact or an error in the classification of any goods or services specified in the application.

(4) An amendment may be made to change the type of registration sought in the application (for example, an application for the registration of a trade mark as a certification trade mark may be amended to an application for registration as a collective trade mark).

(5) An amendment may be made to any other particular specified in the application unless the amendment would have the effect of extending the rights that (apart from the amendment) the applicant would have under the registration if it were granted.

Amendment of other documents

67. The Registrar may, at the request of the person who has filed an application (other than an application for the registration of a trade mark), a notice or other document for the purposes of this Act, amend the application, notice or document:

- (a) to correct a clerical error or an obvious mistake; or
- (b) if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

Appeal

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

PART 7—REGISTRATION OF TRADE MARKS

Division 1—Initial registration

Obligation to register

69.(1) The Registrar must, within the prescribed period, register a trade mark that has been accepted for registration:

- (a) if there has been no opposition to the registration; or
- (b) if there has been an opposition—if the Registrar's decision, or (in the case of an appeal against the Registrar's decision) the decision on appeal, is that the trade mark should be registered.

Otherwise, the application for the registration of the trade mark lapses.

(2) On registering the trade mark, the Registrar must give it a number by which it may be identified.

Registration—how effected

70.(1) The trade mark must be registered:

- (a) in the name of the applicant for registration; and

- (b) in respect of the goods and services specified in the application at the time of registration; and
- (c) subject to the conditions (if any) and the limitations (if any) imposed by the Registrar in accepting the application for registration or deciding to register the trade mark.

The Registrar must enter these particulars in the Register.

- (2) The Registrar must also enter in the Register:
 - (a) a representation in writing of the trade mark; and
 - (b) its registration number; and
 - (c) any other particulars that are prescribed.

(3) If 2 or more persons applied together for the registration of the trade mark (see section 26), the applicants must be registered as joint owners of the trade mark.

Colours in registered trade marks

71.(1) A trade mark may be registered with limitations as to colour.

(2) The limitations may be in respect of the whole, or a part, of the trade mark.

(3) To the extent that a trade mark is registered without limitations as to colour, it is taken to be registered for all colours.

Notification of registration

72. As soon as practicable after the registration of a trade mark, the Registrar must:

- (a) advertise the registration in the *Official Journal*; and
- (b) give to the registered owner of the trade mark a certificate of registration in an approved form.

Date and term of registration

73.(1) Subject to subsection (2), the registration of a trade mark is taken to have had effect from (and including) the filing date in respect of the application for registration.

(2) If:

- (a) the application was in respect of a trade mark whose registration had also been sought in one or more than one Convention country; and
- (b) the applicant claimed a right of priority for the registration under section 27; and
- (c) the trade mark is registered under this Act;

the registration of the trade mark is taken to have had effect:

- (d) if an application to register the trade mark was made in only one Convention country—from (and including) the day on which the application was made in that country; or

(e) if applications to register the trade mark were made in more than one Convention country—from (and including) the day on which the earliest of those applications was made.

(3) Unless it is earlier cancelled, or the trade mark is earlier removed from the Register, the registration of the trade mark expires 10 years after the filing date in respect of the application for its registration.

Note: This is so even for a trade mark whose registration has effect from (and including) the day on which an application was made in a Convention country.

Ceasing of registration

74. The registration of a trade mark ceases if:

- (a) the trade mark is taken to have been removed from the Register under section 79 or Part 9; or
- (b) the registration of the trade mark is cancelled.

Disclaimers

75.(1) An applicant for the registration of a trade mark, or the registered owner of a registered trade mark, may, by notice given to the Registrar, disclaim any exclusive right to use, or authorise the use of, a specified part of a trade mark.

(2) The disclaimer affects only the rights given by this Act to the registered owner of the trade mark on registration of the trade mark.

(3) The Registrar must, on registering the trade mark or on receiving notice of the disclaimer (whichever is later), enter the particulars of the disclaimer in the Register in accordance with the regulations.

(4) A disclaimer properly made and remaining in the Register may not be revoked.

Division 2—Renewal of registration

Request for renewal

76.(1) Any person may, within the prescribed period before the registration of a trade mark expires, request the Registrar to renew the registration.

(2) The request must:

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

Notice of renewal due

77. If, at the beginning of the prescribed period, the Registrar has not received a request for the renewal of the trade mark, the Registrar must, in accordance with the regulations, notify the registered owner of the trade mark that the renewal is due.

Renewal

78.(1) If a request for the renewal of the registration of a trade mark is made in accordance with the regulations, the Registrar must renew the registration for a period of 10 years from the day on which the registration of the trade mark would expire if it were not renewed.

(2) The Registrar must give notice of the renewal to the registered owner of the trade mark in accordance with the regulations.

Failure to renew—entry in Register

79. If the registration of a trade mark is not renewed, then:

- (a) subject to subsection 80(1), the registration ceases to have effect when it expires; and
- (b) the Registrar must remove the trade mark from the Register.

Restoration of trade mark to Register

80.(1) If a trade mark is removed from the Register under section 79, the Registrar may, within the prescribed period:

- (a) restore the trade mark to the Register; and
- (b) renew the registration of the trade mark for 10 years from the day on which the registration of the trade mark expired;

if the Registrar is satisfied that it is just to do so.

(2) The renewal may be subject to any conditions or limitations that the Registrar thinks fit to impose.

(3) The Registrar must give notice of his or her decision in accordance with the regulations.

(4) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Registrar under this section.

Status of unrenewed trade mark

81. If:

- (a) the registration of a trade mark (“unrenewed trade mark”) has not been renewed; and
- (b) within the prescribed period after the registration expired, an application for the registration of a trade mark is made by a person other than the person who was registered as the owner of the unrenewed trade mark;

the unrenewed trade mark is taken to be a registered trade mark for the purposes of the application unless the Registrar is satisfied that:

- (c) there has been no use in good faith of the unrenewed trade mark during the 2 years immediately before its registration expired; or
- (d) no deception or confusion is likely to arise from the use of the trade mark whose registration is sought because of any previous use of the unrenewed trade mark.

PART 8—AMENDMENT AND CANCELLATION OF REGISTRATION

Division 1—Action by Registrar

Correction of Register

82. The Registrar may, on his or her own initiative, correct any error or omission made in entering in the Register any particular in respect of the registration of a trade mark.

Adaptation of classification

83. The Registrar may, in accordance with the regulations, amend the Register (whether by making, removing or altering entries) for the purpose of adapting the designation of the goods or services in respect of which trade marks are registered to reflect any change that has occurred in the classification of goods or services for the purposes of this Act.

Note: For the classification of goods and services see subsection 18(3).

Amendment of particulars of trade mark entered in Register

84.(1) Subject to Parts 11 and 12 the Registrar may, at the request of the registered owner of a registered trade mark:

- (a) amend the representation of the trade mark as entered in the Register if the amendment does not substantially affect the identity of the trade mark as at the time when the details of the trade mark were published under section 28; or
- (b) amend particulars of the goods or services in respect of which the trade mark is registered if the amendment does not have the effect of extending the rights that (apart from the amendment) the owner has under the registration; or
- (c) amend, or enter in the Register, any other particular in respect of the trade mark if the amendment or entry does not have the effect of extending the rights that (apart from the amendment or entry) the owner has under the registration.

(2) An appeal lies to the Federal Court from a decision of the Registrar under subsection (1).

Cancellation of registration

85. The Registrar must cancel the registration of a trade mark:

- (a) if the registered owner asks in writing that the registration be cancelled; or
- (b) if:
 - (i) the application for registration stated that the applicant intended to assign the trade mark to a body corporate about to be constituted; and

- (ii) the body corporate has not, within the prescribed period, applied for a record of the assignment to be entered in the Register.

Division 2—Action by court

Amendment to correct error or omission

86. A prescribed court may, on the application of an aggrieved person, order that the Register be rectified by:

- (a) entering in the Register particulars that were wrongly omitted from it; or
- (b) correcting any error in an entry in the Register.

Amendment or cancellation on ground of contravention of condition etc.

87. A prescribed court may, on the application of an aggrieved person, order that the Register be rectified by:

- (a) cancelling the registration of a trade mark; or
- (b) removing or amending any entry in the Register relating to the trade mark;

on the ground that a condition or limitation entered in the Register in relation to the trade mark has been contravened.

Amendment or cancellation—loss of exclusive rights to use trade mark

88.(1) If section 23 or 24 applies in relation to a registered trade mark, a prescribed court may, on the application of an aggrieved person, but subject to subsection (2), order that the Register be rectified as necessary, either by:

- (a) cancelling the registration of the trade mark; or
- (b) removing or amending any entry in the Register relating to the trade mark;

having regard to the effect of section 23 or 24 (as the case may be) on the rights of the registered owner of the trade mark to use the trade mark, or any sign that is part of the trade mark, in relation to particular goods or services.

(2) If section 23 or 24 applies in relation to the trade mark because the trade mark contains a sign that:

- (a) has become well known, or accepted generally, as the sign that describes or is the name of an article, substance or service; or
- (b) describes or is the name of:
 - (i) an article or substance that was formerly exploited under a patent; or

(ii) a service that was formerly provided as a patented process;

the court may decide not to make an order under subsection (1) and allow the trade mark to remain on the Register in respect of:

- (c) the article or substance or goods of the same description; or
 - (d) the service or services of the same description;
- subject to any condition or limitation that the court may impose.

Amendment or cancellation—other specified reasons

89.(1) Subject to subsection (2), a prescribed court may, on the application of an aggrieved person, order that the Register be rectified by:

- (a) cancelling the registration of a trade mark; or
 - (b) removing or amending an entry wrongly made or remaining on the Register; or
 - (c) entering any condition or limitation affecting the registration of a trade mark that ought to be entered.
- (2)** An application may be made only on the following grounds:
- (a) any of the grounds on which the registration of the trade mark could have been opposed under Division 2 of Part 5;
 - (b) the entry was made, or has been previously amended, as a result of fraud, false suggestion or misrepresentation;
 - (c) an amendment of the application for the registration of the trade mark was obtained as a result of fraud, false suggestion or misrepresentation;
 - (d) the trade mark:
 - (i) is not inherently capable of distinguishing the goods or services; and
 - (ii) on the day on which the application for rectification was filed, had ceased to be used to a sufficient extent for it to be capable of distinguishing the goods or services of the registered owner from the goods or services of any other person;
 - (e) the following circumstances apply:
 - (i) on the filing date in relation to the application for its registration, the trade mark did not distinguish the goods or services of the registered owner from the goods or services of any other person; and
 - (ii) the application for rectification is made at least 10 years after that filing date; and
 - (iii) on the day on which the application for rectification is filed, the trade mark still does not so distinguish the goods or services of the registered owner.
- (3)** The court may decide not to grant an application for rectification made:
- (a) under section 88; or

- (b) on the ground that the trade mark is liable to deceive or confuse (a ground on which its registration could have been opposed, see paragraph (2)(a)); or
 - (c) on the ground referred to in paragraph 2(d);
- if the registered owner of the trade mark satisfies the court that the ground relied on by the applicant has not arisen through any act or fault of the registered owner.
- (4) In making a decision under subsection (3), the court:
 - (a) must also take into account any matter that is prescribed; and
 - (b) may take into account any other matter that the court considers relevant.

Duties and powers of Registrar

90.(1) A person applying to a prescribed court under this Division must give notice of the application to the Registrar.

(2) On receiving the notice, the Registrar must appear if directed by the court to do so. Otherwise, the Registrar may appear before the court and be heard at his or her discretion.

(3) The applicant must give to the Registrar a copy of any order made by the court under this Division and the Registrar must comply with the order.

PART 9—REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE

Object of Part

91. This Part makes provision for:

- (a) removing a registered trade mark from the Register; or
- (b) not restoring to the Register a trade mark that has been removed because of a failure to renew the registration;

if the registered owner of the trade mark has not used the trade mark in good faith.

Application for removal of trade mark from Register etc.

92.(1) A person aggrieved by the fact that:

- (a) a trade mark is or may be registered; or
- (b) a trade mark removed from the Register for non-renewal of its registration may be restored to the Register;

may, subject to subsection (3), apply to the Registrar for the trade mark to be removed from, or not to be restored to, the Register.

(2) The application:

- (a) must be in accordance with the regulations; and

(b) may be made in respect of any or all of the goods or services in respect of which the trade mark may be, is, or was, registered.

(3) An application may not be made to the Registrar under subsection (1) if an action concerning the trade mark is pending in a prescribed court, but the person aggrieved may apply to the court for an order directing the Registrar to remove the trade mark from the Register or not to restore it to the Register.

(4) An application under subsection (1) or (3) (“**non-use application**”) may be made on either or both of the following grounds, and on no other grounds:

(a) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith:

(i) to use the trade mark in Australia; or

(ii) to authorise the use of the trade mark in Australia; or

(iii) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods or services to which the non-use application relates and that the registered owner has not used the trade mark in good faith in Australia in relation to those goods or services at any time before the period of one month ending on the day on which the non-use application is filed;

(b) that the trade mark has remained registered, or (if it were restored to the Register) would have remained registered, for a continuous period of 3 years ending one month before the day on which the non-use application is filed, and, at no time during that period, the person who was then the registered owner used the trade mark in good faith in Australia in relation to the goods or services to which the application relates.

Time for making application

93.(1) Subject to subsection (2), an application for the removal of a trade mark from the Register, may be made at any time after the filing date in respect of the registration of the trade mark.

(2) An application on the ground referred to in paragraph 92(4)(b) may not be made before a period of 5 years has passed from the filing date in respect of the registration of the trade mark.

Referral to court

94. If:

(a) an application has been made to the Registrar under subsection 92(1);
and

(b) the Registrar is of the opinion that the matter should be decided by a prescribed court;
the Registrar may refer the matter to that court and the court may hear and determine the matter as if an application had been made to it under subsection 92(3).

Notification of application

95.(1) If an application has been made to the Registrar under section 92, the Registrar must give notice of the application, in accordance with the regulations.

(2) The Registrar must also advertise the application in the *Official Journal*.

Notice of opposition

96.(1) Any person may oppose an application under section 92 by filing a notice of opposition with the Registrar or the court, as the case requires.

(2) The notice of opposition:

(a) must be in a form approved by the Registrar or by the court; and

(b) must be filed in accordance with the regulations or the rules of court (as the case may be).

Removal of trade mark from the Register etc. if application unopposed

97.(1) If there is no opposition to an application to the Registrar under subsection 92(1), the Registrar must remove the trade mark from the Register, or refrain from restoring the trade mark to the Register, in respect of the goods or services specified in the application.

(2) If there is no opposition to an application to a court under subsection 92(3), the court must order the Registrar to remove the trade mark from the Register, or refrain from restoring the trade mark to the Register, in respect of the goods or services specified in the application.

Trade mark restored to Register if notice of opposition filed within extended time

98. If:

(a) the Registrar has removed a trade mark from the Register under subsection 97(1) because no notice of opposition was filed within the period provided under the regulations; and

(b) the Registrar subsequently extends the period within which the notice may be filed; and

(c) a notice of opposition is filed within the extended period;

the Registrar must restore the trade mark to the Register. Also, the trade mark is taken not to have been removed from the Register.

Proceedings before Registrar

99. If an application to the Registrar is opposed, the Registrar must deal with the matter in accordance with the regulations.

Burden on opponent to establish use of trade mark etc.

100.(1) In any proceedings relating to an opposed application, it is for the opponent to rebut:

- (a) any allegation (made under paragraph 92(4)(a)) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith:
 - (i) to use the trade mark in Australia; or
 - (ii) to authorise the use of the trade mark in Australia; or
 - (iii) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods or services to which the opposed application relates; or

- (b) any allegation (made under paragraph 92(4)(a) or (b)) that a trade mark has not, at any time before or during a specified period (as the case may be), been used in good faith by its registered owner in relation to the goods or services to which the opposed application relates (“**relevant goods or services**”).

(2) For the purposes of subsection (1), (except if subsection (5) applies) the opponent is taken to have rebutted the allegation that a trade mark has not been used in good faith by its registered owner in relation to the relevant goods or services if the opponent has established:

- (a) that the trade mark has been used by its registered owner in relation to the relevant goods or services; or
- (b) that the trade mark has been used by its registered owner in relation to goods or services in respect of which the trade mark is registered (“**registered goods or services**”) that are goods of the same description as, or closely related to, the relevant goods or services; or
- (c) that the trade mark with additions or alterations not substantially affecting its identity has been used by its registered owner in relation to:
 - (i) the relevant goods or services; or
 - (ii) registered goods or services that are of the same description as, or closely related to, the relevant goods or services; or
- (d) the trade mark was not used by its registered owner because of circumstances (whether affecting traders generally or only the registered owner of the trade mark) that were an obstacle to the use of the trade mark during the specified period.

(3) For the purposes of subsection (1), (except if subsection (5) applies) the opponent is also taken to have rebutted the allegation that the trade mark has not been used in good faith by its registered owner in relation to the relevant goods or services if the opponent has established:

- (a) that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, has been used by the registered owner in relation to goods or services (other than registered goods or services) that are of the same description as, or closely related to, the relevant goods or services (for example, the relevant goods may be silk ties and the unregistered goods nylon ties); or
- (b) that the registered owner of the trade mark has used an associated trade mark;

and the Registrar or the court is of the opinion that it is reasonable, having regard to all the circumstances of the case, to treat the registered owner as having used the trade mark in relation to the relevant goods or services.

(4) For the purposes of subsection (1), (except if subsection (5) applies) the opponent is also taken to have rebutted the allegation that the trade mark has not been used in good faith by the registered owner in relation to the relevant goods or services if the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used by an unregistered assignee of the trade mark in relation to:

- (a) the relevant goods or services; or
- (b) goods or services (whether registered or not) that are of the same description as, or closely related to, the relevant goods or services;

and the Registrar or the court is of the opinion that it is reasonable, having regard to all the circumstances of the case, to treat the registered owner as having used the trade mark in relation to the relevant goods or services if:

- (c) the unregistered assignee subsequently becomes the registered owner of the trade mark; and
- (d) the use of the trade mark by the assignee is in accordance with the assignment.

(5) The opponent to an application may not rely on paragraph (2)(b), subparagraph (2)(c)(ii) or paragraph (3)(a) or (b):

- (a) in the case of an application by the registered owner of a trade mark registered in respect of the relevant goods or services—if the applicant's trade mark is substantially identical with, or deceptively similar to, the opponent's trade mark and:
 - (i) the applicant was granted registration of his or her trade mark on the ground that there had been honest concurrent use of the trade marks; or

- (ii) the applicant was a person in relation to whom subsection 44(4) applied; or
- (b) in any other case—if:
 - (i) the applicant's trade mark is substantially identical with, or deceptively similar to, the opponent's trade mark; and
 - (ii) the Registrar or the court is of the opinion that the applicant's trade mark could properly be granted registration in respect of the relevant goods or services on the ground that there has been honest concurrent use of the trade marks or on the ground that subsection 44(4) would apply in relation to the applicant.

Determination of opposed application—general

101.(1) Subject to subsection (3) and to section 102, if, at the end of the proceedings relating to an opposed application, the Registrar is satisfied that the grounds on which the application was made have been established, the Registrar may decide to remove the trade mark from, or not to restore it to, the Register in respect of any or all of the goods or services to which the application relates.

(2) Subject to subsection (3) and to section 102, if, at the end of the proceedings relating to an opposed application, the court is satisfied that the grounds on which the application was made have been established, the court may order the Registrar to remove the trade mark from, or not to restore it to, the Register in respect of any or all of the goods or services to which the application relates.

(3) If satisfied that it is reasonable to do so, the Registrar or the court may decide that the trade mark should not be removed from, or should be restored to, the Register even if the grounds on which the application was made have been established.

Determination of opposed application—localised use of trade mark

102.(1) This section applies if an application is made on the ground referred to in paragraph 92(4)(b) and:

- (a) the applicant is the registered owner of a trade mark that is substantially identical with, or deceptively similar to, that of the opponent and is registered in respect of the goods or services specified in the application subject to the condition or limitation that the use of a trade mark is to be restricted to:
 - (i) goods to be sold, or otherwise traded in, in a particular place (“**specified place**”) in Australia (otherwise than for export from Australia); or
 - (ii) goods to be exported to a particular market (“**specified market**”); or

- (iii) services provided in a particular place in Australia (“specified place”); or
 - (b) the Registrar or the court is of the opinion that such a trade mark may properly be registered in the name of the applicant with that condition or limitation.
- (2) If the Registrar or the court is satisfied:
- (a) that the opponent’s trade mark has remained registered for the period referred to in paragraph 92(4)(b); and
 - (b) that during that period there has been no use in good faith of the opponent’s trade mark in relation to:
 - (i) goods to be sold, or otherwise traded in, in the specified place; or
 - (ii) goods to be exported to the specified market; or
 - (iii) services provided in the specified place;

the Registrar or the court may decide that the opponent’s trade mark should not be removed from, or should be restored to, the Register but that the registration of the trade mark should be subject to the conditions or limitations that the Registrar or the court considers necessary to ensure that the registration does not extend to the use of the trade mark in relation to:

- (c) goods to be sold, or otherwise traded in, in the specified place; or
- (d) goods to be exported to the specified market; or
- (e) services provided in the specified place.

Registrar to comply with order of court

103. A court making an order under section 101 or 102 must cause a copy of the order to be served on the Registrar and the Registrar must comply with the order.

Appeal

104. An appeal lies to the Federal Court from a decision of the Registrar under section 101 or 102.

Certificate—use of trade mark

105.(1) If in any proceedings relating to an opposed application the Registrar or the court has found that:

- (a) the trade mark has been used during a particular period; or
- (b) a trade mark has not been used during a particular period solely because of circumstances that were an obstacle to its use;

the Registrar or the court must, if so requested by the registered owner of the trade mark, give to the registered owner a certificate of those findings.

(2) In any subsequent proceedings in which non-use of the trade mark is alleged:

- (a) the certificate is, on being produced, evidence of the facts stated in it; and
- (b) if the proceedings are determined in favour of the opponent and, on or before filing the notice of opposition, the opponent notified the applicant of the contents of the certificate—the opponent is entitled, unless the Registrar or the court otherwise directs, to have the opponent's full costs paid by the applicant.

PART 10—ASSIGNMENT AND TRANSMISSION OF TRADE MARKS

Assignment etc. of trade mark

106.(1) A registered trade mark, or a trade mark whose registration is being sought, may be assigned or transmitted under this Part.

(2) The assignment or transmission may be partial, that is, it may apply to some only of the goods or services in respect of which registration is sought or the trade mark is registered, but it may not be partial in relation to the use of a trade mark in a particular area.

(3) The assignment or transmission may be with or without the goodwill of the business concerned in the relevant goods or services.

Assignment of associated trade marks

107.(1) Associated trade marks may not be assigned unless they are all assigned to the same person.

(2) If:

- (a) associated trade marks have been assigned to a person; and
- (b) subsequently it is found that another trade mark associated with those trade marks has not been assigned to the assignee;

the assignor (or, if the case so requires, his or her successor in title) must assign the other trade mark to the assignee as soon as practicable.

Assignment etc. of trade mark whose registration is sought

108.(1) If a trade mark whose registration is being sought is assigned or transmitted, the person to whom it has been assigned or transmitted must apply to the Registrar for the assignment or transmission to be recorded.

(2) The application must:

- (a) be in an approved form; and
- (b) be filed, together with any prescribed document, in accordance with the regulations.

- (3) If the application complies with the Act, the Registrar must:
 - (a) record in the manner that the Registrar thinks fit (but not in the Register) the particulars of the assignment or transmission; and
 - (b) advertise the recording in the *Official Journal*.

(4) On and after the day on which the Registrar records the particulars of the assignment or transmission, the person to whom the trade mark has been assigned or transmitted is taken, for the purposes of this Act, to be the applicant for the registration of the trade mark.

Application for record of assignment etc. of registered trade mark to be entered in Register

109.(1) A person to whom a registered trade mark has been assigned or transmitted must apply to the Registrar for a record of the assignment or transmission to be entered in the Register.

- (2) The application must:
 - (a) be in an approved form; and
 - (b) be filed, together with any prescribed document, in accordance with the regulations.

Recording of assignment etc. of registered trade mark

110.(1) If the application complies with this Act, the Registrar must in accordance with the regulations:

- (a) enter the particulars of the assignment or transmission in the Register; and
- (b) register the person as the owner of the trade mark in relation to the goods or services in respect of which the assignment or transmission has effect.

(2) The particulars are taken to have been entered in the Register on the day on which the application was filed, and the registration is taken to have had effect from and including that day.

(3) The Registrar must advertise the recording of the assignment or transmission in the *Official Journal*.

Notice of application to be given to registered user etc.

111. If an application is made under section 108 or 109 in relation to the assignment or transmission of a trade mark, the Registrar must notify in accordance with the regulations:

- (a) any person who has applied to be registered, or is registered, as a user of the trade mark; and
- (b) any person recorded under Part 12 as claiming a right in respect of, or an interest in, the trade mark.

Invalidity

112.(1) If the assignment of a trade mark has been recorded either in the Register or elsewhere, the assignment may not be declared to be invalid unless a court action seeking the declaration was started within the period of 3 years after the day on which the application for the assignment to be recorded was filed.

(2) The assignment of a registered trade mark may not be declared to be invalid if the assignee establishes that, at the time when the action was started, the trade mark did in fact distinguish the assignee's goods or services from:

- (a) if the trade mark is registered subject to the condition that the use of the trade mark is to be restricted to a particular area—the goods or services of other persons in that area; or
- (b) if paragraph (a) does not apply—the goods or services of all other persons.

PART 11—REGISTERED USERS

Registration of users

113. A person other than the registered owner of a registered trade mark may be registered as a user of the trade mark under this Part in relation to any or all of the goods or services in respect of which the trade mark is registered.

Application for registration

114.(1) A person seeking to be registered as a user of a registered trade mark must, together with:

- (a) the applicant for the registration of the trade mark; or
- ~~(b) the registered owner of the trade mark;~~

apply to the Registrar for the person to be so registered.

(2) The application must:

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

Registration—how effected

115.(1) If the application under section 114 relates to a registered trade mark, the Registrar must register the person as a user of the trade mark.

(2) If the application under section 114 relates to a trade mark whose registration is sought, the Registrar must register the person as a user of the trade mark if and when the trade mark is registered.

(3) Particulars of the registration of the person as a user of the trade mark must be entered in the Register in accordance with the regulations.

(4) The registration has effect from and including the day on which the application was filed under subsection 114(2).

Powers of registered user

116.(1) Subject to this Act and to any agreement with the registered owner of the trade mark, the registered user of the trade mark may bring an action for infringement of the trade mark if the registered owner of the trade mark has refused or neglected to do so within the prescribed period.

(2) If the registered user brings an action for infringement of the trade mark, he or she must make the registered owner of the trade mark a defendant in the action. However, the registered owner is not liable for costs if he or she does not take part in the proceedings.

Note: See subsections 130(1) and 141(3) for other powers of the registered user.

User may not assign etc. any right

117. The registration of a person as a user of a trade mark does not enable the person to assign or transmit to another person any right to use the trade mark.

Common law rights of registered owner not affected by registration

118.(1) Any rights that the registered owner of a trade mark has at common law regarding the trade mark are not affected by:

- (a) the registration of a person as a user of a trade mark; or
- (b) any use of the trade mark by a registered user.

(2) For the purpose of deciding the rights of the registered owner at common law regarding the trade mark, any use of the trade mark by the registered user is taken to be a use of the trade mark by the registered owner.

Amendment of registration

119. The particulars entered in the Register in respect of the registration of a person as a user of a trade mark may be amended in accordance with the regulations.

Cancellation of registration

120.(1) The Registrar may, in accordance with the regulations, cancel the registration of a person as a user of a trade mark if asked to do so by the person and/or the registered owner of the trade mark.

(2) The request for cancellation must be filed in accordance with the regulations.

(3) If a registered trade mark of which a person is a registered user is assigned or transmitted, the Registrar must cancel the registration of the person as a user of the trade mark unless the assignee, or the person to whom the trade mark is transmitted, notifies the Registrar in writing within the prescribed period that the registration of the person is to continue to have effect.

PART 12—VOLUNTARY RECORDING OF INTERESTS IN AND RIGHTS IN RESPECT OF TRADE MARKS

Division 1—Preliminary

Object of Part

121. This Part makes provision:

- (a) for recording in the Register interests in, and rights in respect of, registered trade marks that may not be so recorded under another Part; and
- (b) for the Registrar to keep a record of interests in, and rights in respect of, trade marks for which registration is sought.

Division 2—Interests in, and rights in respect of, registered trade marks

Application to have interest etc. recorded

122.(1) If:

- (a) a person (other than the registered owner of the trade mark) claims to have an interest in, or a right in respect of, a registered trade mark; and
- (b) this right or interest has not been recorded in the Register under Part 10 or 11;

the person and the registered owner of a trade mark may together apply to the Registrar to have particulars of the right or interest recorded in the Register.

(2) The application must be in an approved form and must be filed in accordance with the regulations.

Record of interest etc.

123.(1) If the application has been made in accordance with section 122, the Registrar must enter in the Register the particulars of the right or interest set out in the application.

(2) If:

- (a) a trade mark is registered; and
- (b) immediately before the registration, particulars of an interest in or right in respect of the trade mark were recorded under Division 3;

the Registrar must enter those particulars in the Register.

Amendment and cancellation

124. The regulations may provide for the amendment and cancellation of particulars entered in the Register under this Division.

Record not proof etc. of existence of right etc.

125. The fact that a record has been made in the Register under this Part that a person claims an interest in, or a right in respect of, a registered trade mark is not proof or evidence that the person has that right or interest.

Division 3—Interests in, and rights in respect of, unregistered trade marks

Application to have interest etc. recorded

126.(1) If:

- (a) a person has applied for the registration of a trade mark; and
- (b) another person claims to have an interest in, or a right in respect of, the trade mark;

they may together apply to the Registrar for a record to be kept of the other person's right or interest.

(2) The application must be in an approved form and must be filed in accordance with the regulations.

Record of interest etc.

127. If the application has been made in accordance with section 126, the Registrar must record in the manner that the Registrar thinks fit (but not in the Register) the particulars of the right or interest set out in the application.

Amendment and cancellation

128. The regulations may provide for the amendment and cancellation of particulars recorded in this Division.

PART 13—INFRINGEMENT OF TRADE MARKS

When is a trade mark infringed?

129.(1) A person infringes a registered trade mark if the person uses in the course of trade a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered.

(2) A person infringes a registered trade mark if the person uses in the course of trade a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services that are of the same description as, or are closely related to, goods or services in respect of which the trade mark is registered. However, the person is not taken to have infringed the trade mark if the person establishes that using the sign in that way is not likely to deceive or cause confusion.

(3) A person infringes a registered trade mark if:

- (a) the trade mark is well known in Australia; and
- (b) the person uses in the course of trade a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services (“unrelated goods or services”) that are not:

- (i) goods or services in respect of which the trade mark is registered; or
 - (ii) goods or services of the same description as, or closely related to, goods or services in respect of which the trade mark is registered; and
- (c) because of the use of the sign by the person:
- (i) the unrelated goods or services are likely to be mistaken as goods or services dealt with or provided by the registered owner of the trade mark; and
 - (ii) for that reason, the interests of the registered owner are likely to be adversely affected.

Infringement of trade mark by breach of certain restrictions

130.(1) This section applies to a registered trade mark if the registered owner or a registered user of the trade mark has caused to be displayed on goods in respect of which the trade mark is registered, or on their package, or on the container in which they are offered to the public, a notice (“**notice of prohibition**”) prohibiting any act that is under subsection (2) a prohibited act in relation to the goods.

(2) Each of the following is a prohibited act:

- (a) applying the trade mark to the goods, or using the trade mark in relation to them, after the state, condition, get-up or packaging in which they were originally offered to the public has been altered;
- (b) altering, or partially removing or obliterating, any representation of the trade mark applied to the goods or used in relation to them;
- (c) if the trade mark has been applied to the goods, or used in relation to them, together with other matter indicating that the registered owner or user has dealt with the goods—removing or obliterating, totally or in part, any representation of the trade mark without totally removing or obliterating the other matter;
- (d) applying another trade mark to the goods or using another trade mark in relation to them;
- (e) if the trade mark has been applied to the goods or used in relation to them—using on the goods, or on the packaging or container of the goods, any matter that is likely to injure the reputation of the trade mark.

(3) Subject to subsection (4), a person infringes a trade mark to which this section applies if the person:

- (a) is the owner of goods in respect of which the trade mark is registered; and

- (b) in the course of trade, or with a view to a dealing with the goods in the course of trade:
 - (i) does an act that is prohibited under the notice of prohibition; or
 - (ii) authorises that act to be done.
- (4) The trade mark is not infringed if the owner of the goods:
 - (a) acquired them in good faith and without being aware of the notice of prohibition; or
 - (b) became the owner of the goods by virtue of a title derived from a person who had so acquired them.

When is a trade mark not infringed?

131.(1) In spite of section 129, a person does not infringe a registered trade mark when:

- (a) the person uses in good faith:
 - (i) the person's name or the name of the person's place of business; or
 - (ii) the name of the person's predecessor in business or the name of the predecessor's place of business; or
- (b) the person uses a sign in good faith to indicate:
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
 - (ii) the time of production of goods or of the rendering of services; or
- (c) the person uses the trade mark in good faith to indicate the intended purpose of:
 - (i) the goods (in particular as accessories or spare parts); or
 - (ii) the services; or
- (d) the person uses the trade mark in good faith for the purposes of comparative advertising; or
- (e) the person exercises a right to use a trade mark given to the person under this Act; or
- (f) the person, in using the trade mark or a sign in a manner referred to in section 129, does not infringe any right of the registered owner to use the trade mark.

(2) In spite of section 129, if a disclaimer has been registered in respect of a part of a registered trade mark, a person does not infringe the trade mark by using that part of the trade mark.

Goods to which registered trade mark affixed by or with consent of registered owner

132. In spite of section 129, a person who uses a registered trade mark in relation to:

- (a) goods in respect of which the trade mark is registered; or
- (b) goods that are of the same description as, or are closely related to, goods in respect of which the trade mark is registered;

does not infringe the trade mark if a representation of the trade mark has been applied to the goods by, or with the consent of, the registered owner of the trade mark. However, except in the case of second-hand goods (see section 134), the trade mark is infringed if the goods have been changed or impaired after they have been put on the market.

Prior use of identical trade mark etc.

133.(1) A person does not infringe a registered trade mark by using an unregistered trade mark that is substantially identical with, or deceptively similar to, the registered trade mark if the person, or the person and the person's predecessor in title, have continuously used the unregistered trade mark in the course of trade from a time before:

- (a) the date of registration of the registered trade mark; or
- (b) the registered owner of the registered trade mark, or a predecessor in business, or a registered user of the trade mark, first used the trade mark;

whichever is earlier.

(2) If the unregistered trade mark has continuously been used only in a particular area of Australia, subsection (1) applies only to the use of the trade mark by the person in that area.

Second-hand goods

134.(1) This section applies if:

- (a) second-hand goods to which or in relation to which a representation of a registered trade mark is applied are put on the market; and
- (b) the registered owner, or a registered user, of the trade mark has not consented or approved that the goods be put on the market in the condition in which they are.

(2) In spite of section 129, a person who trades in the goods does not infringe the trade mark if:

- (a) the person indicates clearly that the goods are second-hand goods; and
- (b) the changes, alterations or repairs that have been made to the goods are not so extensive or fundamental that the goods can no longer reasonably be regarded as possessing the main characteristics, qualities or attributes inherent to the goods when they were new.

What courts may hear action etc. for infringement of registered trade mark

135.(1) An action for an infringement of a registered trade mark may be brought in a prescribed court.

(2) Subsection (1) does not prevent an action for infringement of a registered trade mark from being brought in any other court that has jurisdiction to hear the action or proceeding.

What relief can be obtained from court

136. The relief that a court may grant in an action for an infringement of a registered trade mark includes:

- (a) an injunction, which may be granted subject to any condition that the court thinks fit; and
- (b) at the option of the plaintiff but subject to section 137, damages or an account of profits.

Special case—plaintiff not entitled to damages etc.

137. If:

- (a) in an action for the infringement of a trade mark registered in respect of particular goods or services, the court finds that the defendant has infringed the trade mark; and
- (b) the defendant has applied to the court under subsection 92(3) for an order directing the Registrar to remove the trade mark from the Register in respect of those goods or services; and
- (c) the court finds that, because the trade mark has not during a particular period (“**critical period**”) been used in good faith by its registered owner in relation to those goods or services, there are grounds (under subsection 92(4)) for so removing the trade mark from the Register;

the court may not grant relief to the plaintiff by way of damages or an account of profits in respect of any infringement of the trade mark that happened during the critical period.

Groundless threats of legal proceedings

138.(1) If a person threatens to bring an action against another person (“**threatened person**”) on the ground that the threatened person has infringed:

- (a) a registered trade mark; or
- (b) a trade mark alleged by the person to be registered;

any person aggrieved by the threat (“**plaintiff**”) may bring an action (either in a prescribed court or in any other court having jurisdiction) against the person making the threat (“**defendant**”).

- (2) The purpose of the action is to obtain from the court:
 - (a) a declaration that the defendant has no grounds for making the threat; and
 - (b) an injunction restraining the defendant from continuing to make the threat.

The plaintiff may also recover any damages that he or she has sustained because of the defendant's conduct.

(3) The action may be brought whether or not the defendant is the registered owner, or a registered user, of the trade mark alleged to have been infringed.

(4) The court may not find in favour of the plaintiff if the defendant satisfies the court that:

- (a) the trade mark is registered; and
- (b) the acts of the plaintiff in respect of which the defendant threatened to bring an action constitute an infringement of the trade mark.

(5) An action may not be brought, or (if brought) may not proceed, under this section if the registered owner or a registered user of the trade mark, with due diligence, begins and pursues an action against the threatened person for infringement of the trade mark.

(6) This section does not make a lawyer or patent attorney liable to an action for an act done in a professional capacity on behalf of a client.

Counterclaim by defendant in action on groundless threats

139. If the defendant in an action brought under section 138 would be entitled to bring against the plaintiff an action for infringement of the registered trade mark ("**infringement action**"):

- (a) the defendant may file in the court a counterclaim against the plaintiff for any relief to which the defendant would be entitled in the infringement action; and
- (b) the provisions of this Act applicable to infringement actions apply in relation to the counterclaim as if it were an infringement action brought by the defendant against the plaintiff.

PART 14—IMPORTATION OF GOODS INFRINGING AUSTRALIAN TRADE MARKS

Object of Part

140. The object of this Part is to protect registered trade marks by making provision allowing the Comptroller to seize and deal with goods that are imported into Australia if the importation infringes, or appears to infringe, a registered trade mark.

Notice of objection to importation

141.(1) The registered owner of a registered trade mark may, in accordance with the regulations, give to the Comptroller a notice in writing objecting to any importation of goods that infringes the trade mark. The notice is to be given together with any prescribed document.

(2) If:

(a) the registered owner of the registered trade mark has not given a notice under subsection (1); or

(b) any notice given under subsection (1) is no longer in force;
a registered user of the trade mark may, subject to any agreement between the user and the registered owner, ask the registered owner to give such a notice in respect of the trade mark.

(3) If the registered owner does not comply with the request within the prescribed period, the registered user may, subject again to the agreement, give the notice to the Comptroller.

(4) A notice given by the registered owner of a trade mark remains in force for 2 years unless it is revoked before the end of that period by notice in writing given to the Comptroller by that registered owner or a subsequent registered owner of the trade mark.

(5) A notice given by a registered user of the trade mark remains in force for 2 years unless it is revoked before the end of that period by notice in writing given to the Comptroller:

(a) if the registered user is authorised under the agreement referred to in subsection (2) to revoke the notice—by the registered user; or

(b) in any other case—by the registered owner of the trade mark.

Comptroller may seize goods infringing trade mark

142.(1) This section applies to goods manufactured outside Australia that:

(a) are imported into Australia; and

(b) are subject to the control of the Customs within the meaning of the *Customs Act 1901*.

(2) If goods to which this section applies:

(a) have applied to them a sign that, in the opinion of the Comptroller, is substantially identical with, or deceptively similar to, a notified trade mark; and

(b) are goods in respect of which the notified trade mark is registered;
the Comptroller must seize the goods unless he or she is satisfied that there are no reasonable grounds for believing that the notified trade mark is infringed by the importation of the goods.

(3) The Comptroller may decide not to seize the goods if he or she has not been given by the objector, or by one or more of the objectors, security in an amount that he or she considers sufficient to repay to the Commonwealth the expense that may be incurred by the Commonwealth if the goods were seized.

(4) Goods seized under this section must be kept in a secure place as directed by the Comptroller.

Notice of seizure

143. The Comptroller must, as soon as practicable:

- (a) give (either personally or by post) to the designated owner of any seized goods a notice in writing identifying the goods and stating that they have been seized under section 142; and
- (b) give (either personally or by post) to the objector, or to each objector, a notice in writing:
 - (i) identifying the goods and stating that they have been seized under section 142; and
 - (ii) stating that the goods will be released to their owner unless the objector or one of the objectors (as the case requires) brings an action for infringement of the notified trade mark in respect of the goods, and gives to the Comptroller notice in writing of the action, within the period of 10 working days after he or she has been given the notice or, if the Comptroller extends that period under subsection 146(1), within the extended period.

Forfeiture of goods

144.(1) The designated owner of any seized goods may, at any time before an objector starts an action for infringement of a notified trade mark in respect of the goods, consent to the goods being forfeited to the Commonwealth by giving notice in writing to that effect to the Comptroller.

(2) If the designated owner gives such a notice, the goods are forfeited to the Commonwealth.

Release of goods to owner—no action for infringement

145.(1) The Comptroller must release the seized goods to their designated owner if, within the action period, the objector has not, or none of the objectors has:

- (a) brought an action for infringement of the notified trade mark in respect of the goods; and
- (b) given to the Comptroller notice in writing of the action.

Note: For "action period" see subsection (4).

(2) The Comptroller must also release the seized goods to their designated owner if:

- (a) before the end of the action period, the objector or each of the objectors has, by notice in writing to the Comptroller, consented to the release of the goods; and
- (b) at that time:
 - (i) the objector has not, or none of the objectors has, brought an action for infringement of the notified trade mark in respect of the goods; or
 - (ii) any action brought by an objector has been withdrawn.

Note: For “action period” see subsection (4).

(3) The Comptroller may release the seized goods to their designated owner at any time before the end of the action period if:

- (a) the Comptroller, having regard to information that has come to his or her knowledge after the goods were seized, is satisfied that there are no reasonable grounds for believing that the notified trade mark has been infringed by the importation of the goods; and
- (b) the objector has not, or none of the objectors has, brought an action for infringement of the notified trade mark in respect of the goods.

Note: For “action period” see subsection (4).

(4) In this section:

“**action period**”, in relation to seized goods, means:

- (a) if there is only one objector to the importation of the goods—the period within which the objector may bring an action for infringement of the registered trade mark in respect of goods under subsection 146(1); or
- (b) if there is more than one objector to the importation of the goods—the period beginning on the earliest day on which an objector may bring an action for infringement of the registered trade mark in respect of the goods under subsection 146(1) and ending at the end of the last day on which an objector may bring such an action under subsection 146(1).

Action for infringement of trade mark

146.(1) An objector may bring an action for infringement of a notified trade mark in respect of seized goods and give notice of it to the Comptroller:

- (a) if paragraph (b) does not apply—within the period (“**notified period**”) of 10 working days specified in the notice given to the objector in respect of the goods under section 143; or
- (b) if:
 - (i) the objector has, before the end of the notified period, applied in writing to the Comptroller for an extension of the notified period; and

(ii) the Comptroller, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended the notified period for a number of working days not exceeding 10; within that period as so extended by the Comptroller.

(2) The court hearing the action:

- (a) may, on the application of a person, allow the person to be joined as a defendant to the action; and
- (b) must allow the Comptroller to appear and be heard.

(3) In addition to any relief that the court may grant apart from this section, the court may:

- (a) at any time, if it thinks it just, order that the seized goods be released to their designated owner subject to the conditions (if any) that the court considers fit to impose; or
- (b) order that the seized goods be forfeited to the Commonwealth.

(4) If:

- (a) the court decides that the trade mark was not infringed by the importation of the seized goods; and
- (b) the designated owner of the goods, or any other defendant, satisfies the court that he or she has suffered loss or damage because the goods were seized;

the court may order the objector to pay to the designated owner or other defendant compensation, in the amount determined by the court, for any part of that loss or damage that is attributable to any period beginning on or after the day on which the action was brought.

(5) If, after 3 weeks from the day on which the action was brought, there is not in force at any time an order of the court preventing the goods from being released, the Comptroller must release the goods to their owner.

(6) If the court orders that the goods be released, the Comptroller must, subject to section 149, comply with the order.

Action for infringement by registered user

147. If a registered user of a notified trade mark is an objector in relation to any seized goods, subsection 116(1) does not prevent the registered user from starting an action for the infringement of the trade mark in respect of the goods within the required period.

Forfeited goods—how to be disposed of

148. If:

- (a) goods are forfeited to the Commonwealth under section 144; or
- (b) the court orders under section 146 that goods be forfeited to the Commonwealth;

the goods are to be disposed of:

- (c) in accordance with the regulations; or
- (d) if no regulations are in force—as the Comptroller directs.

Power of Comptroller to retain control of goods

149. In spite of this Part, the Comptroller:

- (a) must not release, or dispose of, any seized goods; or
- (b) must not take any action in relation to the goods to give effect to any order of a court under section 146;

if the Comptroller is required or allowed to retain control of the goods under any other law of the Commonwealth.

Insufficient security

150. If security given under subsection 142(3) by the objector or objectors who gave notice under section 141 in respect of a trade mark is not sufficient to meet the expenses incurred by the Commonwealth as a result of the action taken by the Comptroller under this Part because of the notice, the amount of the difference between those expenses and the amount of security:

- (a) is a debt due by the objector, or by the objectors jointly or each of them separately, to the Commonwealth; and
- (b) may be recovered by an action taken in a court of competent jurisdiction.

Commonwealth not liable for loss etc. suffered because of seizure

151. The Commonwealth is not liable for any loss or damage suffered by a person:

- (a) because the Comptroller seized, or failed to seize, goods under this Part: or
- (b) because of the release of any seized goods.

Power to require information

152.(1) If:

- (a) goods that may be seized under this Part are imported into Australia; and
- (b) the Comptroller, relying on information received, is satisfied that the use of a trade mark applied to those goods is fraudulent;

the Comptroller may ask the importer of the goods or an agent of the importer:

- (c) to produce any document in his or her possession relating to the goods; and
- (d) to give information about:
 - (i) the name and address of the person by whom the goods were consigned to Australia; and

(ii) the name and address of the person in Australia to whom the goods were consigned.

(2) The importer or his or her agent must comply with the request within the prescribed period.

Penalty: Imprisonment for 6 months.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

(3) The Comptroller may give any information obtained under this section, or from any other source, to any objector in relation to the goods.

Modification in relation to Norfolk Island etc.

153. The regulations may provide for the modification or adaptation of this Part in its application to:

- (a) Norfolk Island; or
- (b) Christmas Island; or
- (c) Cocos (Keeling) Islands.

PART 15—OFFENCES

Falsifying etc. a registered trade mark

154.(1) If a person, knowing that a trade mark is registered, falsifies or unlawfully removes a representation of the trade mark applied to any goods, or in relation to any goods or services, dealt with or provided in the course of trade, the person is guilty of an offence punishable on conviction by imprisonment not exceeding 2 years.

(2) A person falsifies a representation of a registered trade mark if the person:

- (a) alters or defaces it; or
- (b) makes any addition to it; or
- (c) partly removes, erases or obliterates it;

without the permission of the registered owner, or a registered user, of the trade mark and without being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

(3) A person unlawfully removes a representation of a registered trade mark if the person removes it:

- (a) without the permission of the registered owner, or a registered user, of the trade mark; and
- (b) without being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

(4) In a prosecution for an offence against subsection (1), if 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 trade mark is a registered trade mark, the person is taken to have known that the trade mark is a registered trade mark.

Falsely applying a registered trade mark

155.(1) A person must not falsely apply a representation of a registered trade mark to goods, or in relation to goods or services, dealt with or provided in the course of trade.

Penalty: Imprisonment for 2 years.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

(2) A person **falsely applies a representation of a registered trade mark** to goods, or in relation to goods or services if the person applies a representation of the trade mark or of a sign substantially identical with it to the goods or in relation to the goods or services:

- (a) without the permission of the registered owner, or of a registered user, of the trade mark; and
- (b) without being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

Manufacture and possession of die etc. for use in commission of offence

156.(1) A person must not:

- (a) make a die, block, machine or instrument; or
- (b) draw, or program a computer or other device to draw, a representation of a registered trade mark or part of a registered trade mark;

for the purpose of its being used for, or in the course of, committing an offence against section 154 or 155.

Penalty: Imprisonment for 2 years.

(2) A person must not have in his or her possession, or dispose of:

- (a) a die, block, machine or instrument; or
- (b) a computer, or other device, programmed to draw a representation of a registered trade mark; or
- (c) a representation of a registered trade mark or part of a registered trade mark;

for the purpose of its being used for, or in the course of, committing an offence against section 154 or 155.

Penalty: Imprisonment for 2 years.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Selling etc. goods with false marks

157.(1) A person must not:

- (a) sell goods; or
- (b) expose goods for sale; or
- (c) have goods in his or her possession for the purpose of trade or manufacture; or
- (d) import goods into Australia for the purpose of trade or manufacture;

if the person knows that:

- (e) a falsified representation of a registered trade mark is applied to them; or
- (f) a representation of a registered trade mark has been unlawfully removed from them; or
- (g) a representation of a registered trade mark is falsely applied to them.

(2) A person contravening subsection (1) is guilty of an offence punishable on conviction by:

- (a) a fine not exceeding 5 penalty units for each item of goods to which the offence relates; or
- (b) imprisonment for a period not exceeding 2 years; or
- (c) by both a fine and a term of imprisonment.

(3) ~~The total fine imposed on a person convicted of an offence may not exceed 120 penalty units.~~

(4) In a prosecution for an offence against subsection (1), if, 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 were goods of that kind.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Aiding and abetting offences

158.(1) If a person, by engaging in any conduct outside Australia:

- (a) aids, abets, counsels or procures; or
- (b) is in any way, directly or indirectly, knowingly concerned in, or party to;

the doing of an act in Australia that is an offence against this Act, the person is taken to have committed that offence and is punishable accordingly.

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

False representations regarding trade marks

159.(1) A person must not make a representation to the effect that a trade mark is a registered trade mark unless the person knows, or has reasonable grounds to believe, that the trade mark is registered in Australia.

(2) A person must not make a representation to the effect that a part of a registered trade mark is registered as a trade mark unless the person knows, or has reasonable grounds to believe, that that part is registered as a trade mark in Australia.

(3) A person must not make a representation to the effect that a trade mark is registered in respect of goods or services unless the person knows, or has reasonable grounds to believe, that the trade mark is registered in Australia in respect of those goods or services.

(4) A person must not make a representation to the effect that the registration of a trade mark gives exclusive rights to use the trade mark in circumstances in which, having regard to conditions or limitations entered in the Register, the registration does not give those rights unless the person has reasonable grounds to believe that the registration does give those exclusive rights.

(5) For the purposes of this section, the use in Australia in relation to a trade mark:

- (a) of the word “registered”; or
- (b) of any other word or any symbol referring (either expressly or by implication) to registration;

is taken to be a representation that the trade mark is registered in Australia in respect of the goods or services in relation to which it is used except if the trade mark is registered in a country other than Australia in respect of those goods or services and:

- (c) the word or symbol by itself indicates that the trade mark is registered in that other country or a country outside Australia; or
- (d) the word or symbol is used, together with other words or symbols of the same or a bigger size, to indicate that the trade mark is registered in that other country or a country outside Australia; or

- (e) the word or symbol is used in relation to goods that are to be exported to that country.

Penalty: 60 penalty units.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

False entries in Register etc.

160. A person must not knowingly or recklessly:

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

Penalty: Imprisonment for 2 years.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Disobeying summons etc.

161.(1) A person who:

- (a) has been summonsed to appear as a witness before the Registrar; and
- (b) has been offered payment of reasonable expenses;

must not, without lawful excuse, fail to appear in answer to the summons.

Penalty: 10 penalty units.

(2) A person who:

- (a) has been required by the Registrar to produce a document or any other thing; and
- (b) has been offered payment of reasonable expenses;

must not, without lawful excuse, fail to produce the document or thing.

Penalty: 10 penalty units.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Refusing to give evidence etc.

162. A person appearing before the Registrar as a witness must not, without lawful excuse, refuse:

- (a) to be sworn or to make an affirmation; or
- (b) to answer questions that he or she is lawfully required to answer; or
- (c) to produce any document or thing that he or she is lawfully required to produce.

Penalty: 30 penalty units.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Unauthorised persons not to act in trade mark matters

163. A person must not ask, or be given, any payment or other reward for:

- (a) applying for, or obtaining, on behalf of another person:
 - (i) the registration of a trade mark; or
 - (ii) the making of any entry in the Register; or
 - (iii) the amendment, cancellation, removal or restoration of any entry in the Register; or
- (b) preparing, or causing to be filed in accordance with this Act, a document necessary for another person to obtain or oppose:
 - (i) the registration of a trade mark; or
 - (ii) the making of an entry in the Register; or
 - (iii) the amendment, cancellation, removal or restoration of any entry in the Register; or
- (c) giving advice about the validity of the registration of a trade mark or the infringement of a trade mark;

unless the person is:

- (d) a lawyer; or
- (e) a registered patent attorney; or
- (f) a person permanently employed by, and only by, that other person; or
- (g) a person referred to in paragraph 135(1)(h) or (i) of the repealed Act.

Penalty: 30 penalty units.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Unregistered persons

164.(1) A person must not carry on business or practise as a trade marks attorney, trade marks agent or agent for obtaining the registration of trade marks unless the person is:

- (a) a lawyer; or
- (b) a registered patent attorney; or
- (c) a person referred to in paragraph 135(1)(h) or (i) of the repealed Act.

Penalty: 30 penalty units.

(2) The members of a partnership must not carry on business or practise as trade marks attorneys or trade marks agents or agents for obtaining the registration of trade marks unless each member is:

- (a) a lawyer; or
- (b) a registered patent attorney; or
- (c) a person referred to in paragraph 135(1)(h) or (i) of the repealed Act.

Penalty: 30 penalty units.

(3) A person must not describe himself or herself, or hold himself or herself out, or permit himself or herself to be described or held out, as:

- (a) a trade marks attorney; or
- (b) a trade marks agent; or
- (c) an agent for obtaining the registration of a trade mark;

unless the person is a registered patent attorney or a lawyer.

Penalty: 30 penalty units.

(4) The members of a partnership must not describe themselves, or hold themselves out, or permit themselves to be described or held out, as:

- (a) trade marks attorneys; or
- (b) trade marks agents; or
- (c) agents for obtaining the registration of a trade mark;

unless each member is a registered patent attorney or a lawyer.

Penalty: 30 penalty units.

(5) If:

- (a) a company is found guilty of an offence against this section; and
- (b) a director, manager, secretary or other officer of the company has knowingly been a party to the offence;

the director, manager, secretary or officer is guilty of an offence punishable, on conviction, by a fine not exceeding 30 penalty units.

(6) In spite of section 15B of the *Crimes Act 1914*, a prosecution for an offence against this section may be started at any time within 5 years after the offence was committed.

(7) For the purposes of this section, a person is taken to carry on business or practise as a trade marks attorney or a trade marks agent if the person undertakes in Australia to do, for gain, any or all of the acts referred to in paragraph 163(a), (b) or (c).

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

False representation about Trade Marks Office

165. A person:

(a) must not:

- (i) place, or allow to be placed, on the building in which his or her office is situated; or
- (ii) use when advertising his or her office or business; or
- (iii) place on a document, as a description of his or her office or business;

the words "Trade Marks Office" or "Office for registering trade marks", or words of similar import (whether alone or together with other words); or

- (b) must not use in any other way, in connection with his or her business, words that would reasonably lead other persons to believe that his or her office is, or is officially connected with, the Trade Marks Office.

Penalty: 30 penalty units.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Registrar etc. not to prepare documents etc.

166. The Registrar, a Deputy Registrar or an employee must not:

- (a) prepare, or help prepare, a document to be filed under this Act; or
- (b) search the records of the Trade Marks Office;

unless required or authorised to do so by this Act, a written direction of the Registrar or an order of a court.

Penalty: 10 penalty units.

Note: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Forfeiture orders under the *Proceeds of Crime Act 1987*

167. If a person other than the Director of Public Prosecutions has instituted proceedings for the trial of another person in respect of an indictable offence against this Part, Division 2 of Part II 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 person who has instituted the proceedings.

Conduct of directors, servants and agents

168.(1) This section applies for the purposes of a prosecution for:

- (a) an offence under this Act; or
- (b) an offence under section 5, 6, 7 or 7A or subsection 86(1) of the *Crimes Act 1914* that relates to this Act.

(2) If it is necessary to establish the state of mind of a company in relation to particular conduct, it is sufficient to show:

- (a) that the conduct was engaged in by a director, servant or agent of the company within the scope of his or her actual or apparent authority; and
- (b) that the director, servant or agent had the state of mind.

(3) Any conduct engaged in on behalf of a company by a director, servant or agent of the company within the scope of his or her actual or apparent authority is taken to have been engaged in also by the company, unless it establishes that it took reasonable precautions and exercised due diligence to avoid the conduct.

(4) If it is necessary to establish the state of mind of a person other than a company in relation to particular conduct, it is sufficient to show:

- (a) that the conduct was engaged in by a servant or agent of the person within the scope of his or her actual or apparent authority; and
- (b) that the servant or agent had the state of mind.

(5) Any conduct engaged in on behalf of a person other than a company by a person's servant or agent within the scope of his or her actual or apparent authority is taken to have been engaged in also by the person, unless the person establishes that he or she took reasonable precautions and exercised due diligence to avoid the conduct.

(6) If:

- (a) an individual is convicted of an offence under this Act; and
- (b) the individual would not have been convicted of the offence but for subsections (4) and (5);

the individual is not liable to be punished by imprisonment for that offence.

(7) In this section:

- (a) a reference to the state of mind of a person includes a reference to:
 - (i) the knowledge, intention, opinion, belief or purpose of the person; and
 - (ii) the person's reasons for the intention, opinion, belief or purpose; and
- (b) a reference to a director of a company includes a reference to a constituent member of a body corporate incorporated for a public purpose by a law of the Commonwealth, of a State or of a Territory; and
- (c) a reference to engaging in conduct includes a reference to failing or refusing to engage in conduct.

PART 16—COLLECTIVE TRADE MARKS

Object of Part

169. This Part:

- (a) defines a collective trade mark; and
- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to collective trade marks.

What is a collective trade mark?

170. A **collective trade mark** is a sign used, or intended to be used, in relation to goods and services dealt with or provided in the course of trade by members of an association to distinguish those goods and services from goods and services so provided or dealt with by persons who are not members of the association.

Application of Act

171.(1) Subject to this Part, the provisions of this Act relating to trade marks (other than Part 10—Assignment and Transmission of Trade Marks and Part 11—Registered Users) apply to collective trade marks and so apply as if:

- (a) a reference to a trade mark included a reference to a collective trade mark; and
- (b) a reference to a person doing something for the registration of a trade mark included a reference to an association doing that thing for the registration of the collective trade mark; and
- (c) a reference to a trade mark registered by a person included a reference to a collective trade mark registered by an association.

(2) For the purposes of this Act:

- (a) the use of a collective trade mark by a member of the association that is the applicant for the registration of the collective trade mark is taken to be a use of the collective trade mark by the applicant; and
- (b) the use of a registered collective trade mark by a member of the association that is the registered owner of the collective trade mark is taken to be a use of the collective trade mark by the registered owner.

(3) Section 40 (trade mark not distinguishing applicant's goods or services) applies in relation to a collective trade mark as if a reference to the applicant were a reference to the members of the association that applied for registration of the collective trade mark.

Application for registration

172. An application for the registration of a collective trade mark:

- (a) must be made by the association to which the mark belongs; and
- (b) must, instead of a statement referred to in subsection 25(4), contain a statement that members of the association are using, or intend to use, the mark in relation to goods and services:
 - (i) dealt with or provided by those members; and
 - (ii) in respect of which it is sought to register the mark.

Limitation on rights given by registered collective trade mark

173. A member of an association in whose name a collective trade mark is registered does not have the right to prevent another member of the association from using the collective trade mark in accordance with the rules of the association (if any).

Assignment etc. of collective trade mark

174. A collective trade mark may not be assigned or transmitted.

Infringement of collective trade mark

175. In an action by an association in whose name a collective trade mark is registered seeking relief for infringement of the collective trade mark, the association may take into account, in claiming damages, any damage or loss of profits sustained or incurred by the members of the association as a result of the infringement.

PART 17—CERTIFICATION TRADE MARKS

Object of Part

176. This Part:

- (a) defines a certification trade mark; and
- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to certification trade marks; and
- (c) outlines the role of the Commission in the regulation of certification trade marks.

What is a certification trade mark?

177. A certification trade mark is a sign used, or intended to be used, to distinguish goods or services:

- (a) dealt with or provided in the course of trade; and
- (b) certified by a person (“owner of the certification trade mark”), or by another person approved by that person, in relation to quality, accuracy or some other characteristic including (in the case of goods) origin, material or mode of manufacture;

from other goods and services dealt with or provided in the course of trade but not so certified.

Note: The goods certified may be those of any person including the owner of the certification trade mark or any person approved by the owner for the purpose of certifying goods or services.

Application of Act

178. Subject to this Part, the provisions of this Act relating to trade marks (other than sections 7, 32, 33, 40 and 130, Part 9—Removal of trade mark from Register for non-use and Part 11—Registered Users) apply to certification trade marks and so apply as if a reference to a trade mark included a reference to a certification trade mark.

Rights given by registration of a certification trade mark

179. Section 19 applies in relation to a certification trade mark as if subsection (1) were omitted and the following subsection were substituted:

“(1) If a certification trade mark is registered, the registered owner has, subject to this Part, the exclusive rights to use, and to allow other persons to use, the certification trade mark, in relation to the goods and services in respect of which the certification trade mark is registered.”.

Rights of persons allowed to use certification trade mark

180. When the registered owner of a certification trade mark allows another person (“**approved user**”) to use the certification trade mark in relation to goods or services in respect of which it is registered, the approved user has a right to use the certification trade mark in relation to those goods or services in accordance with the rules governing the use of the certification trade mark.

Application for registration

181. An application for the registration of a certification trade mark is not to contain a statement referred to in subsection 25(4).

Rules governing the use of certification trade marks

182.(1) In addition to any document prescribed under subsection 25(2), a copy of the rules governing the use of the certification trade mark whose registration is sought must also be filed in accordance with the regulations.

(2) The rules are to include provisions regarding:

- (a) the persons (“**approved certifiers**”) who may be approved for the purpose of certifying goods and services; and
- (b) the cases in which goods or services are to be certified; and
- (c) the conditions under which an approved user is to be allowed to use the certification trade mark in relation to goods or services; and
- (d) the use of the certification trade mark by the owner (if he or she intends to use it) and any approved user; and
- (e) the settlement of any dispute arising from a refusal:
 - (i) to certify goods or services; or
 - (ii) to allow the use of the certification trade mark;

and any other provision that the Commission requires or permits to be inserted.

Note: For “approved user” see section 180.

Ground for rejecting an application—certification trade mark not distinguishing certified goods or services

183.(1) In addition to any other ground on which it may be rejected, an application for the registration of a certification trade mark must be rejected if the trade mark is not capable of distinguishing goods or services certified by the applicant or an approved certifier from goods or services not so certified.

Note 1: For “approved certifier” see paragraph 182(2)(a).

Note 2: Division 2 of Part 4 sets out the grounds for rejecting an application, but section 40 does not apply to certification trade marks (see section 178).

(2) In deciding whether or not the certification trade mark is capable of so distinguishing goods or services certified by the applicant or an approved certifier, the Registrar must take into account:

- (a) the extent to which the certification trade mark is inherently adapted so to distinguish those goods or services; or
- (b) the extent to which, because of its use or of any other circumstances, the certification trade mark has become adapted so to distinguish.

Registrar to reject application or send it to Commission

184.(1) If the Registrar is satisfied that:

- (a) the application has been made in accordance with this Act; and
- (b) there are no grounds for rejecting it;

the Registrar must, in accordance with the regulations, send to the Commission a copy of the application and of any prescribed document.

(2) If the Registrar is not satisfied as set out in subsection (1), he or she must reject the application.

Certificate by Commission

185.(1) The Commission must consider the application and any documents received under section 184 in accordance with the regulations.

(2) If the Commission is satisfied that:

- (a) the applicant and the approved certifiers are competent to certify the goods and services in respect of which the certification trade mark is to be registered; and
- (b) the rules referred to in section 182 are satisfactory having regard to the criteria prescribed for the purposes of this paragraph; and
- (c) the registration would not be to the detriment of the public;

the Commission must give a certificate to that effect and send a copy to the Registrar. The Commission must also send a certified copy of the rules to the Registrar.

(3) The Commission may require the applicant to make amendments or modifications to the rules as the Commission considers necessary.

(4) If the Commission is not satisfied as set out in subsection (2):

- (a) the Commission must notify the Registrar in writing; and
- (b) the Registrar must advertise the matter in the *Official Journal* in accordance with the regulations.

(5) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Commission:

- (a) refusing to give a certificate; or
- (b) requiring amendments or modifications to the rules governing the use of the certification trade mark.

Acceptance of application

186.(1) If the Commission has given a certificate under subsection 185(2), the Registrar must accept the application. Otherwise, the Registrar must reject the application.

(2) The Registrar may accept the application subject to conditions or limitations.

(3) The Registrar must:

- (a) give to the applicant notice in writing of his or her decision; and
- (b) advertise the decision in the *Official Journal*.

Variation of rules

187.(1) Subject to subsection (2), the rules governing the use of a registered certification trade mark may be varied in accordance with the regulations.

(2) The rules may not be varied without the approval of the Commission.

(3) In deciding whether or not to approve a variation, the Commission is to have regard to the criteria prescribed for the purposes of paragraph 185(2)(b).

(4) The Commission must notify the Registrar in writing of any variation to the rules and the Registrar must cause a notice of the variation to be advertised in the *Official Journal* in accordance with the regulations.

(5) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Commission to approve or not to approve a variation of the rules.

Rules to be available for inspection

188. Rules governing the use of a registered certification trade mark must be available for inspection at the same time and in the same manner as the Register.

Infringement

189. The relief that a court may grant in an action for an infringement of a registered certification trade mark does not include damages or an account of profits.

Assignment of registered certification trade mark

190.(1) A registered certification trade mark may be assigned only with the consent of the Commission.

(2) In deciding whether or not to give its consent, the Commission must have regard to the matters provided for under the regulations.

(3) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Commission refusing to give its consent.

Rectification of the Register etc.

191.(1) In addition to its powers under Division 2 of Part 8 in relation to certification trade marks, a prescribed court may, on the application of a person aggrieved, order that the Register be rectified by cancelling the registration of a certification trade mark, or removing or amending an entry in the Register relating to the certification trade mark, on the ground that:

- (a) the registered owner or an approved certifier is no longer competent to certify any of the goods or services in respect of which the mark is registered; or
- (b) it would be to the detriment of the public if the certification trade mark were to remain registered; or
- (c) the registered owner or an approved user has failed to comply with a provision of the rules governing the use of the certification trade mark.

Note 1: For "approved certifier" see section 182.

Note 2: For "approved user" see section 180.

(2) A prescribed court may, on the application of a person aggrieved, make such order as it thinks fit for varying the rules governing the use of a certification trade mark.

(3) Notice of an application to the prescribed court must be given to the Registrar.

(4) Except for cases in which the court directs the Registrar to appear, the Registrar may appear and be heard at his or her discretion.

(5) A copy of any order made by the court under this section must be given to the Registrar and the Registrar must comply with the order.

PART 18—DEFENSIVE TRADE MARKS

Object of Part

192. This Part:

- (a) provides for the registration of certain trade marks as defensive trade marks; and
- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to defensive trade marks.

Defensive trade marks

193.(1) If, because a registered trade mark has been used so much in relation to all or any of the goods or services in respect of which it is registered, it is likely that its use in relation to other goods or services will be taken to indicate that there is a connection between those other goods or

services and the registered owner of the trade mark, the trade mark may, on the application of the registered owner, be registered as a **defensive trade mark** in respect of any or all of those other goods or services.

(2) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if the registered owner does not intend to use the trade mark in relation to those goods or services.

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

(4) A trade mark that is registered as a defensive trade mark in respect of particular goods or services may be subsequently registered otherwise than as a defensive trade mark in the name of the registered owner in respect of the same goods or services.

Application of Act

194. Subject to this Part, the provisions of this Act (other than subsection 19(1), sections 23, 24, 40, 57 and 130 and Part 9—Removal for non-use) apply to defensive trade marks and so apply as if a reference to a trade mark included a reference to a defensive trade mark.

Application for registration

195. An application for the registration of a trade mark as a defensive trade mark need not contain a statement referred to in subsection 25(4).

Grounds for rejecting application

~~196. The application must be rejected:~~

- (a) if the trade mark is not registered as a trade mark in the name of the applicant; or
- (b) in the case of a registered trade mark—if it is not likely that the use of the trade mark in relation to the goods or services in respect of which its registration as a defensive trade mark is sought will be taken to indicate that there is a connection between those goods or services and the registered owner.

Cancellation of registration by order of court

197.(1) A prescribed court may, on the application of a person aggrieved, cancel the registration of a trade mark as a defensive trade mark in respect of all or any of the goods or services in respect of which it is so registered if the requirements of subsection 193(1) are no longer satisfied.

(2) A person applying to a prescribed court under subsection (1) must give notice of the application to the Registrar.

(3) On receiving the notice, the Registrar must appear if directed by the court to do so. Otherwise, the Registrar may appear before the court and be heard at his or her discretion.

- (4) If the court directs that the registration be cancelled:
- (a) a copy of the order must be given to the Registrar; and
 - (b) the Registrar must comply with it.

Cancellation of registration by Registrar

198. The Registrar may cancel the registration of a trade mark as a defensive trade mark if the trade mark is not otherwise registered in the name of the registered owner of the defensive trade mark.

PART 19—JURISDICTION AND POWERS OF COURTS

Prescribed courts

199. Each of the following courts is a prescribed court for the purposes of this Act:

- (a) the Federal Court;
- (b) the Supreme Court of a State;
- (c) the Supreme Court of the Australian Capital Territory;
- (d) the Supreme Court of the Northern Territory;
- (e) the Supreme Court of Norfolk Island.

Jurisdiction of the Federal Court

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

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

(3) A prosecution for an offence against this Act may not be started in the Federal Court.

Jurisdiction of other prescribed courts

201.(1) Each prescribed court (other than the Federal Court) has jurisdiction with respect to matters in respect of which proceedings may, under this Act, be started in a prescribed court.

(2) The jurisdiction conferred by subsection (1) on the Supreme Court of a Territory is conferred to the extent that the Constitution permits in the case of:

- (a) an action for the infringement of a trade mark; or

- (b) an action under section 138; or
- (c) a matter arising under this Act that may be heard and determined in the course of such proceedings.

(3) In any other case, the jurisdiction is conferred only in relation to an action brought 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 the proceedings are started.

Exercise of jurisdiction

202. The jurisdiction of a prescribed court under section 200 or 201 is to be exercised by a single judge.

Transfer of proceedings

203.(1) A prescribed court in which an action or proceeding under this Act has been started may, on the application of a party made at any stage, by an order, transfer the action or proceeding to another prescribed court having jurisdiction to hear and determine the action or proceeding.

- (2) When a court transfers an action or proceeding to another court:
 - (a) all relevant documents of record filed in the transferring court must be sent to the other court by the Registrar or other appropriate officer of the transferring court; and
 - (b) the action or proceeding must continue in the other court as if:
 - (i) it had been started there; and
 - (ii) all steps taken in the transferring court had been taken in the other court.

Appeals

204.(1) An appeal lies to the Federal Court against a judgment or order of:

- (a) another prescribed court exercising jurisdiction under this Act; or
- (b) any other court in an action under Part 13.

(2) Except with the leave of the Federal Court, an appeal does not lie to the Full Court of the Federal Court against 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 or directions of the Registrar.

(3) With the special leave of the High Court, an appeal lies to the High Court against a judgment or order referred to in subsection (1).

(4) Except as otherwise provided by this section, an appeal does not lie against a judgment or order referred to in subsection (1).

Registrar may appear in appeals

205. The Registrar may appear and be heard at the hearing of an appeal to the Federal Court against a decision or direction of the Registrar.

Powers of Federal Court

206. On hearing an appeal against a decision or direction of the Registrar, the Federal Court may do any one or more of the following:

- (a) admit further evidence orally, or on affidavit or otherwise;
- (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence before the Registrar;
- (c) order an issue of fact to be tried as it directs;
- (d) affirm, reverse or vary the Registrar's decision or direction;
- (e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;
- (f) order a party to pay costs to another party.

Practice and procedure of prescribed courts

207. The regulations may make provision about the practice and procedure of prescribed courts in an action or proceeding under this Act, including provision:

- (a) prescribing the time for starting the action or proceeding or for doing any other act or thing; or
- (b) for an extension of that time.

PART 20—ADMINISTRATION

Trade Marks Office and sub-offices

208.(1) For the purposes of this Act, there is to be an office called the Trade Marks Office.

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

Seal of Trade Marks Office

209. There is to be a seal of the Trade Marks Office and impressions of the seal must be judicially noticed.

Registrar of Trade Marks

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

- (2) The Registrar has the powers and functions that are given to him or her under this Act or any other Act (including regulations under that Act).

Registrar's powers

211. The Registrar may, for the purposes of this Act:

- (a) summon witnesses; and
- (b) receive written or oral evidence on oath or affirmation; and
- (c) require the production of documents or articles; and
- (d) award costs against a party to proceedings before the Registrar.

Exercise of power by Registrar

212. The Registrar may not exercise a power under this Act in any way that adversely affects a person applying for the exercise of that power without first giving that person a reasonable opportunity of being heard.

Deputy Registrar of Trade Marks

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

(2) Subject to any direction by the Registrar, a Deputy Registrar has all the powers and functions of the Registrar, except the powers of delegation under section 214.

(3) A power or function of the Registrar, when exercised by a Deputy Registrar, is taken to have been exercised by the Registrar.

(4) The exercise of a power or function of the Registrar by a Deputy Registrar does not prevent the exercise of the power or function by the Registrar.

(5) If the exercise of a power or function by the Registrar is dependent on the opinion, belief or state of mind of the Registrar in relation to a matter, that power or function may be exercised by a Deputy Registrar on his or her opinion, belief or state of mind in relation to that matter.

(6) If the operation of a provision of this Act or another Act is dependent on the opinion, belief or state of mind of the Registrar in relation to a matter, that provision may operate on the opinion, belief or state of mind of a Deputy Registrar in relation to that matter.

Delegation of Registrar's powers and functions

~~214.(1) The Registrar may by signed instrument delegate all or any of his or her powers or functions to an employee.~~

Note: See section 34AB of the *Acts Interpretation Act 1901* regarding the effect of this subsection.

(2) A delegate must, if so required by the instrument of delegation, exercise or perform a delegated power or function under the direction or supervision of the Registrar or an employee specified in the instrument.

PART 21—THE REGISTER AND OFFICIAL DOCUMENTS

The Register

215.(1) A Register of Trade Marks is to be kept at the Trade Marks Office.

(2) The Registrar must enter in the Register in accordance with this Act:

- (a) all particulars of registered trade marks, certification trade marks and defensive trade marks, and all other matters, that were on the old register when the repealed Act was repealed; and

- (b) particulars of all trade marks, certification trade marks, collective trade marks and defensive trade marks that are to be registered under this Act; and
 - (c) other prescribed matters.
- (3) All particulars entered in the Register under paragraph (2)(a) are taken to have been so entered on the commencing day.

Register may be kept on computer

216.(1) The Register may be kept in whole or in part by using a computer.

(2) Any record of a particular or other matter made by using a computer for the purpose of keeping the Register is taken to be an entry in the Register.

Inspection of Register

217.(1) The Register must be available at the Trade Marks Office for inspection by any person during the hours when the Office is open for business.

(2) If the Register, or any part of the Register, is kept by using a computer, subsection (1) is satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he or she can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

Documents and records open to inspection

~~**218.(1)** Any document or record that is:~~

- (a) held in the Trade Marks Office; and
- (b) relates to a trade mark (whether registered or not);

is available for inspection by any person during the hours when the Office is open for business.

(2) Subsection (1) does not apply to any document or record that is, under the regulations, an exempt document or record for the purposes of that subsection.

Evidence—the Register

219.(1) The Register is evidence of any particular or other matter entered in it.

(2) A copy of, or an extract from, the Register that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.

(3) If the Register or a part of the Register is kept by using a computer, a document certified by the Registrar as reproducing in writing a computer record of all or any of the particulars comprised in the Register or in that part of the Register is admissible in any proceedings as evidence of those particulars.

Evidence—certified copies of documents

220.(1) A certificate signed by the Registrar and stating that:

- (a) anything required or permitted to be done by the Act or the repealed Act was done or not done on, or had been done or not been done by, a specified date; or
- (b) anything prohibited by the Act or the repealed Act was done or not done on, or had been done or not been done by, a specified date; or
- (c) a document was available for public inspection at the Trade Marks Office on a specified date or during a specified period;

is evidence of the matters so stated.

(2) A copy of, or an extract from, a document held in the Trade Marks Office that is certified by the Registrar to be a true copy or extract is admissible in any proceedings as if it were the original.

PART 22—MISCELLANEOUS

Division 1—Applications and other documents

Making and signing applications etc.

221. An application, notice or request required or permitted under this Act to be made or signed by a person may be made or signed, on behalf of that person, by:

- (a) a lawyer; or
- (b) a patent attorney; or
- (c) a person referred to in paragraph 135(1)(h) or (i) of the repealed Act.

Filing of documents

222. A document may be filed at the Trade Marks Office by delivering the document to a sub-office of the Trade Marks Office either personally or by post or by any other prescribed means.

Withdrawal of application etc.

223. A person who has filed an application, notice or request may withdraw it, in accordance with the regulations, at any time while it is still being considered by the Registrar.

Address for service

224.(1) The address for service of a person who has filed an application, notice or request is:

- (a) the address for service stated in the application, notice or request; or
- (b) if the person has notified in writing another address to the Registrar—that other address.

(2) When:

- (a) a trade mark is registered; or
- (b) an interest in, or a right in respect of, a trade mark that a person (including a registered user) has is recorded in the Register;

the registered owner or the person must give to the Registrar his or her address for service and the Registrar must enter that address in the Register.

(3) The registered owner of a registered trade mark or any person whose right or interest in a trade mark is recorded in the Register must notify the Registrar in writing of any change in his or her address for service and the Registrar must alter the Register accordingly.

(4) An address for service must be an address in Australia.

(5) If this Act provides that a document is to be served on, or given or sent to, a person:

- (a) the document may be served on, or sent by post to, the person at the address for service of the person; or
- (b) if the person does not have an address for service—the document may be served on an agent of the person in Australia or may be sent by post to any address of the person in Australia that is known to the Registrar.

Death of applicant etc.

~~225.(1)~~ If an applicant for the registration of a trade mark dies before registration is granted on the application, his or her legal representative may proceed with the application.

(2) If, at any time after a trade mark is registered, the Registrar is satisfied that the person in whose name the trade mark is registered had died (or, in the case of a body corporate, had ceased to exist) before registration was granted, the Registrar may amend the Register by substituting for the name entered in the Register the name of the person who should be the registered owner of the trade mark.

Division 2—Proceedings before the Registrar or a court

Description of registered trade mark

226. In an indictment, information, pleading or proceeding relating to a registered trade mark, the trade mark may be identified by its registration number. It is not necessary to reproduce or describe the trade mark.

Evidence of trade usage

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

Death of party to proceeding before Registrar

228. If a person who is party to a proceeding pending before the Registrar dies, the Registrar may:

- (a) on being so asked, substitute in the proceeding another person in the place of the deceased party if the Registrar is satisfied that the interest of the deceased party has been transmitted to that other person; or
- (b) allow the proceeding to continue without any substitution if the Registrar is of the opinion that the interest of the deceased party is sufficiently represented by the surviving parties.

Costs awarded by Registrar

229.(1) Costs may be awarded by the Registrar either:

- (a) when proceedings before him or her are discontinued; or
- (b) when they are over.

(2) If a party is ordered to pay the costs of another party, the costs may be recovered in a court of competent jurisdiction as a debt due by the first party to the other party.

Costs of attendance of patent attorney

230. If:

- (a) a patent attorney has attended in court to assist a party at the hearing of an action or proceeding under this Act; and
- (b) an order is made for payment of the costs of that party;

those costs may include an allowance for that attendance.

Security for costs

231. If a person who neither resides nor carries on business in Australia:

- (a) gives notice of opposition under this Act; or
- (b) applies to the Registrar under Part 9 for a trade mark to be removed from, or not to be restored to, the Register; or
- (c) appeals to the Federal Court under this Act;

the Registrar or the Federal Court (as the case may be) may require the person to give security for the costs of the proceeding or appeal and may, if security is not given, dismiss the proceeding or appeal.

Passing off actions

232. In an action for passing off arising out of the use by the defendant of a registered trade mark:

- (a) of which he or she is the registered proprietor or a registered user; and
- (b) that is substantially identical with, or deceptively similar to, the trade mark of the plaintiff;

damages may not be awarded against the defendant if the defendant satisfies the court:

- (c) that, at the time when the defendant began to use the trade mark, he or she was unaware, and had no reasonable means of finding out, that the trade mark of the plaintiff was in use; and
- (d) that, when the defendant became aware of the existence and nature of the plaintiff's trade mark, he or she immediately ceased to use the trade mark in relation to the goods or services in relation to which it was used by the plaintiff.

Division 3—General

Fees

233.(1) The regulations may prescribe the fees to be paid for the purposes of this Act and may prescribe different fees in respect of the doing of an act according to the time when the act was done.

(2) Prescribed fees are payable in accordance with the regulations.

(3) If a fee is payable in respect of the doing of an act by the Registrar, the Commission or the Comptroller, the Registrar, Commission or Comptroller must not do the act until the fee has been paid.

(4) Subject to subsection (5), if:

(a) a fee is payable in respect of the doing of an act by a person other than the Registrar, the Commission or the Comptroller; or

(b) a fee is payable in respect of the filing of a document;

the act is taken to have been done, or the document is taken to have been filed, in spite of the failure to pay the fee.

(5) If the Registrar, the Commission or the Comptroller notifies the person concerned, or his or her agent or attorney, in accordance with the regulations, that the fee has not been paid, the act is not taken to have been done, or the document is not taken to have been filed, before the day on which the fee is paid.

Extension of time

234.(1) If, because of an error or omission by the Registrar, a Deputy Registrar or an employee, a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Registrar must extend the time for doing the act.

(2) If, because of:

(a) an error or omission by the person concerned or by his or her agent or attorney; or

(b) circumstances beyond the control of the person concerned;
a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Registrar may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.

(3) If:

(a) a relevant act that a person is required to do within a certain time is not, or cannot be, done within that time; and

(b) on application made by that person in accordance with the regulations, the Registrar is of the opinion that special circumstances exist that justify an extension of that time;

the Registrar may extend the time for doing the act.

(4) The time allowed for doing a relevant act may be extended, whether before or after that time has expired.

(5) If an application is made for an extension of time for more than 3 months, the Registrar must advertise the application in the *Official Journal*.

(6) A person may, as prescribed, oppose the granting of the application.

(7) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Registrar not to extend the time for the doing of an act.

(8) An action cannot be brought in respect of an infringement of a trade mark committed between:

(a) the day on which the trade mark was removed from the Register because a particular act was not done within a particular period; and

(b) the day on which the trade mark is restored to the Register because the act was done within the period as extended under this section.

(9) In this section:

“relevant act” means:

(a) any act (other than a prescribed act) done in relation to a trade mark;
or

(b) the filing of any document (other than a prescribed document) for the purposes of this Act; or

(c) any proceedings under this Act (other than court proceedings).

Convention countries

235. The regulations may declare a foreign country to be a Convention country for the purposes of this Act.

Publication of *Official Journal* etc.

236.(1) The Registrar must issue at regular intervals, as determined by the Registrar, an *Official Journal of Trade Marks* containing:

- (a) the matters that are required under this Act to be advertised in the *Official Journal*; and
 - (b) any other matter that the Registrar thinks fit.
- (2) The Registrar must make arrangements for selling copies of the *Official Journal*.
- (3) The Registrar may prepare, publish and sell documents relating to trade marks as the Registrar thinks fit.

Notice regarding review of decision by Administrative Appeals Tribunal

- 237.(1)** If, under a provision of this Act, an application may be made to the Administrative Appeals Tribunal for the review of a decision of a person:
- (a) the person must give a written notice of the decision to any person affected by it; and
 - (b) the notice must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for the review of the decision to which the notice relates by or on behalf of the person or persons whose interests are affected by the decision.
- (2) Failure to comply with subsection (1) in relation to a decision does not affect the validity of the decision.
- (3) In this section:
“decision” has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

Use of trade mark for export trade

- 238.** If:
- (a) a trade mark is applied in Australia to goods that are to be exported from Australia (“export goods”); or
 - (b) any other act is done in Australia to export goods which, if done in relation to goods to be dealt with in the course of trade in Australia, would constitute a use of the trade mark in Australia;
- the application of the trade mark or the other act is taken, for the purposes of this Act, to constitute use of the trade mark in relation to the export goods.

Rights etc. of patent attorney

- 239.(1)** A patent attorney:
- (a) is entitled to prepare documents, transact business and conduct proceedings for the purposes of this Act; and
 - (b) has any right or privilege that is prescribed.
- (2) This section does not authorise a patent attorney to prepare a document that is to be issued from or filed in a court or to transact business or to conduct proceedings in a court.

Regulations

240.(1) The Governor-General may make regulations:

- (a) prescribing matters required or permitted by this Act to be prescribed; or
- (b) prescribing matters necessary or convenient to be prescribed for carrying out or giving effect to this Act; or
- (c) prescribing matters necessary or convenient to be prescribed for the conduct of any business relating to the Trade Marks Office.

(2) Without limiting subsection (1), the regulations may:

- (a) provide for appeals against decisions of the Registrar made under the regulations; and
- (b) require persons to make statutory declarations in support of any application, notice or request filed under this Act; and
- (c) provide for the making of a declaration, or the doing of an act, under this Act on behalf of a person who, because of infancy or physical or mental disability, is unable to make the declaration or do the act; and
- (d) provide for the refund, in specific circumstances, of the whole or part of a fee paid in respect of the filing of a document; and
- (e) provide for the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a fee; and
- (f) give power to the Registrar:
 - (i) to require, in specified circumstances, a person applying under Part 9 for a trade mark to be removed from, or not to be restored to, the Register to give security for any costs that may arise from the proceedings; and
 - (ii) not to proceed with the application if security is not given; and
 - (iii) to refund to the applicant any amount given as security and not applied in settling costs awarded against the defendant; and
- (g) provide for the destruction of documents relating to a trade mark at least 25 years after the registration of the trade mark has ceased; and
- (h) prescribe as penalties for offences against the regulations fines not exceeding 10 penalty units; and
- (i) make transitional or consequential provision as necessary or convenient because of the repeal of the repealed Act and the enactment of this Act; and
- (j) provide for regulations made under the repealed Act to continue to have effect (with any prescribed alterations) for specified purposes of this Act.

PART 23—REPEAL AND TRANSITIONAL

Division 1—Repeal

Repeal

241. The *Trade Marks Act 1955* is repealed.

Division 2—Marks registered under the repealed Act

Automatic registration under this Act

242.(1) All trade marks that, immediately before the commencement of this Act, were registered in Part A or B, or both Parts A and B, of the old register are registered trade marks for the purposes of this Act.

(2) All trade marks that, immediately before the commencement of this Act, were registered as certification trade marks in Part C of the old register are registered certification trade marks for the purposes of this Act.

(3) All trade marks that, immediately before the commencement of this Act, were registered as defensive trade marks in Part D of the old register are registered as defensive trade marks for the purposes of this Act.

Associated trade marks

243. If 2 or more trade marks were entered as associated trade marks in the old register, no equivalent entry designating them as associated trade marks is to be made in the Register.

Registration conclusive after 7 years

244.(1) This section applies in relation to:

(a) a registered trade mark that:

- (i) immediately before the commencement of this Act, was registered in Part A of the old register; and
- (ii) has not at any time after the commencement of this Act ceased to be registered; and

(b) a registered trade mark:

- (i) whose application for registration in Part A of the old register had been accepted under the repealed Act and was still pending before the Registrar immediately before the commencement of this Act; and
- (ii) that has not at any time after the commencement of this Act ceased to be registered.

(2) In any legal proceedings:

- (a) the original registration under the repealed Act of a trade mark referred to in paragraph (1)(a); or
- (b) the original registration under this Act of a trade mark referred to in paragraph (1)(b);

is taken to be valid in all respects after a period of 7 years from the date of registration of the trade mark unless it is shown that:

- (c) the original registration was obtained by fraud; or
- (d) an application for the registration of the trade mark would be rejected under section 42; or
- (e) the trade mark was not, at the commencement of the proceedings, capable of distinguishing the goods or services of the registered owner in relation to which the trade mark is used from the goods or services of other persons.

Term of registration

245. The registration of an existing registered mark expires on the day on which it would have expired under the repealed Act if that Act had not been repealed.

Renewal

246.(1) Subject to subsection (2), Division 2 of Part 7 applies in relation to the renewal of the registration of an existing registered mark.

(2) If the registration of an existing registered mark is due to expire within 6 months after the commencement of this Act and the registration is renewed, the registration is to be renewed for a period of 14 years from the day on which the registration would have expired if it had not been renewed.

Restoration of trade mark removed from old register for non-payment of renewal fee

247.(1) If:

- (a) a trade mark was removed from the old register under subsection 70(2) of the repealed Act because the registration of the trade mark had expired and had not been renewed; and
- (b) the registration of the trade mark had expired within 12 months before the commencing day;

then, if the Registrar is satisfied that it is just to do so, the Registrar may, within 12 months from the day on which the registration expired:

- (c) make an entry in the Register to the effect that all particulars of the trade mark removed from the old register under the repealed Act are restored to the Register; and
- (d) renew the registration of the trade mark for the period beginning on the commencing day that, together with the period immediately before the commencing day during which the trade mark remained unregistered, equals 14 years.

(2) The renewal may be subject to any conditions or limitations that the Registrar thinks fit to impose.

(3) The Registrar must give notice of his or her decision in accordance with the regulations.

(4) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Registrar under this section.

Division 3—Matters pending at commencement of Act

Applications, notices etc.—general

248.(1) Subject to this Division, an application, notice or request that:

- (a) was lodged with the Registrar in accordance with the repealed Act; and
- (b) was pending immediately before the commencement of this Act; is to be dealt with as if it had been made under this Act.

(2) The application, notice or request may not be rejected on the ground that it was not filed in accordance with this Act.

Application for registration of trade mark

249.(1) This section applies to an application for the registration of a trade mark in Part A or B of the old register if the application was pending immediately before the commencement of this Act.

(2) Except as provided under subsection 248(2), Parts 3, 4 and 5 apply in relation to the application as if it had not been accepted under the repealed Act.

(3) If the application had been accepted under the repealed Act but the trade mark had not been registered before the commencement of this Act, then, except as provided in subsection (4), the provisions of the repealed Act continue to apply until the Registrar makes a decision to register, or to refuse to register, the trade mark.

(4) If, when dealing with the application under the repealed Act as provided by subsection (3), the Registrar withdraws the acceptance of the application under subsection 44(3) of that Act, the Registrar must then continue to deal with the application under this Act as if it were an application whose acceptance had been revoked under subsection 36(1).

(5) If the Registrar decides to register the trade mark, Part 7 applies.

(6) The filing date in respect of the application is the day on which the application was lodged with the Trade Marks Office under the repealed Act.

Divisional application in relation to pending application

250. If an application for the registration of a trade mark in the old register was pending, but had not been accepted, immediately before the commencement of this Act, the applicant may, within 6 months after the commencing day, apply under subsection 47(1) for a part of that trade mark to be registered as a trade mark.

More than one application made on same day for registration of trade mark

251.(1) If:

- (a) on the same day before the commencement of this Act, a person made more than one application each seeking the registration of the same trade mark but in respect of goods or services of different classes; and
- (b) those applications (“existing applications”) were pending, but had not been accepted, immediately before the commencement of this Act;

the applicant may, at any time before any existing application is accepted, apply to the Registrar to have all the existing applications dealt with under this Act as if they were one application for the registration of the trade mark in respect of all goods and services specified in the existing applications.

(2) If an application is made under subsection (1), the Registrar must deal with the existing applications as if they were a single application in respect of the trade mark made on the commencing day.

(3) The filing date for the single application taken to have been made under subsection (2) is the day on which the existing applications were lodged, or would be taken to have been lodged (as the case may be), with the Trade Marks Office under the repealed Act.

Application for registration of trade mark whose registration has been sought in Convention country

252.(1) This section applies if:

- (a) an application for the registration in Australia of a trade mark whose registration had been sought in a Convention country was made under section 109 of the repealed Act; and
- (b) the application was still pending immediately before the commencement of this Act.

(2) If the application had not been accepted under the repealed Act, the applicant (or the applicant’s successor in title) must, within 6 months after the commencing day but before the application is accepted, claim priority for the registration of the trade mark in accordance with section 27 in order to obtain registration from the date on which an application was made in a Convention country. If priority is so claimed and the trade mark is registered under this Act, subsection 73(2) applies in relation to the registration.

(3) If:

- (a) the application had been accepted, but the trade mark had not been registered, under the repealed Act; and
- (b) the trade mark is registered under this Act;

subsection 73(2) applies in relation to the registration as if priority had been claimed under section 27.

Application for registration of a mark in Part C of the old register

253. Subject to Part 17, sections 249 to 252 apply to an application for the registration of a mark as a certification trade mark in Part C of the old register if the application was pending immediately before the commencement of this Act.

Application for registration of defensive trade mark in Part D of the old register

254. Subject to Part 18, sections 249 to 252 apply to an application for the registration of a mark as a defensive trade mark in Part D of the old register if the application was pending immediately before the commencement of this Act.

Amendment of application—specification of goods or services

255.(1) If:

- (a) an application for the registration of a mark in Part A, B, C or D of the old register was pending, but had not been accepted, immediately before the commencement of this Act; and
- (b) the application had previously been amended; and
- (c) the application as amended did not relate to all of the goods or services specified in the application before its amendment;

the applicant may, within 6 months after the commencing day, apply to the Registrar for the application to be again amended so as to relate to some or all of the goods and services specified in the application before its amendment under the repealed Act, if:

- (d) the application is still pending, but has not been accepted, under this Act; and
- (e) subsection 43(3) of the repealed Act would apply in relation to a further application for the registration of the mark in respect of the goods or services excluded from the original application, if that Act were still in force.

(2) If an application is amended under subsection (1), it must (if necessary) be also amended so as to be in accordance with Part 4.

Term of registration if filing date is earlier than commencement of this Act

256. If:

- (a) a trade mark, collective trade mark, certification trade mark or defensive trade mark is registered under this Act; and
- (b) the filing date in respect of the application for the registration of the trade mark is a date before the commencement of this Act;

the registration of the trade mark is to expire 7 years after the filing date.

Application for registration of assignment etc.

257. If an application for the registration in the old register of the assignment or transmission of an existing registered mark is pending on the commencement of this Act, this Act applies in relation to the application as if:

- (a) it were an application under section 109 for a record of the assignment or transmission to be entered in the Register; and
- (b) that application was filed on the commencement of this Act.

Rectification of Register

258. If proceedings arising from an application to a court under section 22 (Rectification of Register) of the repealed Act are pending immediately before the commencement of this Act, the matter is to be decided under the repealed Act as if the old register were to be rectified, but any order made by the Court may only be in respect of the rectification of the Register.

Action for removal of trade mark from Register for non-use

259. If proceedings arising from an application to the Registrar or a court under section 23 (Provisions as to non-use of trade mark) of the repealed Act are pending immediately before the commencement of this Act, the repealed Act continues to apply:

- (a) in relation to those proceedings; and
- (b) for the purposes of any appeal from an order or direction of the Registrar or the court under that section;

as if the reference in subsection 23(1) to the Register were a reference to the Register within the meaning of this Act.

Action for infringement of trade mark etc.

260. Sections 62 to 67 and section 78 of the repealed Act continue to apply in relation to an action for the infringement of an existing registered mark that was pending immediately before the commencement of this Act.

Action under this Act for infringement of trade mark under repealed Act

261. If:

- (a) before the commencement of this Act a person engaged in conduct that infringed a mark registered under the repealed Act; and
- (b) an action relating to that infringement was not pending immediately before the commencement of this Act; and
- (c) the mark is an existing registered mark for the purposes of this Act;

then, subject to any law limiting the time within which such an action may be started, an action may be brought under this Act for that infringement of the trade mark. The registered owner (or a registered user) of the existing trade mark is not, however, entitled under this Act to any injunction or other relief to which he or she would not have been entitled under the repealed Act.

Acts not constituting infringement of trade mark

262.(1) This section applies if:

- (a) immediately before the commencement of this Act, a person was engaging in conduct that did not constitute an infringement of a mark registered under the repealed Act; and
- (b) the mark is an existing registered mark for the purposes of this Act; and
- (c) the person has, since the commencement of this Act, continuously engaged in, and is engaging in, that conduct; and
- (d) that conduct is an infringement of the existing registered mark under this Act.

(2) In spite of section 129, the person does not infringe the existing registered mark by engaging in that conduct.

Application of this Act—general

263.(1) Except as otherwise provided by this Division or the regulations, this Act applies in relation to any action or proceeding validly brought for the purposes of the repealed Act that were still pending immediately before the commencement of this Act as if it were an action or proceeding validly brought on the commencing day under the relevant provision of this Act.

(2) Anything done under the repealed Act for the purposes of the action or proceeding is taken to have been done:

- (a) on the commencing day; and
- (b) in accordance with this Act.

Fees

264. No fee is payable under this Act in relation to an act that was done under the repealed Act and is taken, under this Division, to be an act done under this Act.

Division 4—General

The Registrar and Deputy Registrar

265. Persons holding office as Registrar of Trade Marks and Deputy Registrar of Trade Marks immediately before the commencement of this Act continue to hold those respective offices on and after that day.

Address for service

266.(1) If, immediately before the commencement of this Act, the address for service of an applicant for the registration of a trade mark, or of an opponent to the registration, under subsection 132(1) or (2) of the repealed Act (“existing address”) was an address in Australia, that address remains the address for service of the applicant or opponent for the purposes of this Act until he or she notifies another address to the Registrar under section 224.

(2) If the address appearing in the old register immediately before the commencement of this Act as the address of the proprietor or of a registered user of an existing registered mark (“existing address”) is an address in Australia, that address is the address for service of the registered owner of that mark or of the registered user for the purposes of this Act until the registered owner or registered user notifies another address to the Registrar under section 224.

(3) If the existing address of a person immediately before the commencement of this Act was not an address in Australia, the person must give in writing to the Registrar an address in Australia as his or her address for service.

Notices to Comptroller objecting to importation of goods

267.(1) If a notice under paragraph 103(3)(b) of the repealed Act objecting to the importation of goods infringing a registered trade mark had not been revoked before the commencement of this Act, then, subject to subsection (2), the notice continues to have effect for the purposes of Part 14 of this Act as if it were a notice given under section 141 of this Act.

(2) The notice ceases to have effect:

- (a) if the Comptroller is given a notice under section 141 objecting to any importation of goods infringing the trade mark; or
- (b) at the end of 3 months from the commencing day;

whichever first occurs.

*[Minister's second reading speech made in—
House of Representatives on 18 October 1994
Senate on 7 November 1994]*