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ORGANISATION MONDIALE DU COMMERCE

ORGANIZACIÓN MUNDIAL DEL COMERCIO

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**Council for Trade-Related Aspects
of Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY LAWS AND REGULATIONS
NOTIFIED UNDER ARTICLE 63.2 OF THE AGREEMENT**

Australia

The present document reproduces the Trade Marks Act 1995 (No. 119 of 1995)¹, as notified by Australia under Article 63.2 of the Agreement (see document IP/N/1/AUS/1/Rev.1).

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET REGLEMENTATIONS CONSACREES
A LA PROPRIETE INTELLECTUELLE NOTIFIEES
AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD**

Australie

Le présent document contient le texte de la Loi de 1995 sur les marques (n° 119 de 1995)¹, notifiée par l'Australie au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/AUS/1/Rev.1).

**Consejo de los Aspectos de los Derechos de Propiedad
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA
PROPIEDAD INTELECTUAL NOTIFICADOS EN VIRTUD
DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

Australia

En el presente documento se reproduce la Ley de Marcas de 1995 (N° 119 de 1995)¹, que Australia ha notificado en virtud del párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/AUS/1/Rev.1).

¹English only/anglais seulement/inglés solamente.



Trade Marks Act 1995

No. 119 of 1995

READER'S GUIDE

This guide aims to give you a general idea of the purpose of this Act and some information about its structure. It also explains briefly how the operation and interpretation of this Act is affected by other Acts.

Purpose of this Act

This Act provides for the registration of trade marks, collective trade marks, certification trade marks and defensive trade marks (for a definition of these terms, see sections 17, 162, 169 and 185 respectively) and sets out and protects the rights deriving from registration.

It is a rewrite of the legislation relating to trade marks, certification trade marks and defensive trade marks. The previous Act did not deal with collective trade marks.

Trade Marks No. 119, 1995

In rewriting the legislation, some changes have been made to reflect international trends towards greater uniformity in that field of law. In particular, this Act conforms with the minimum standards and principles prescribed for trade marks in the Agreement Establishing the World Trade Organization.

An attempt has also been made to simplify the language as much as possible to make it easier for readers to understand the law. For that reason, a number of terms used in the old legislation have been replaced by simpler ones. For example, the word "owner" has been used where the previous Act referred to the proprietor of a trade mark. No difference in meaning is intended when simpler terms have thus been used.

Summary of this Act

- | | |
|----------------------|--|
| Part 1: | Deals with formal matters such as the commencement of this Act and its general application. |
| Part 2: | Contains definitions and terms that are used frequently throughout this Act. |
| Part 3: | Explains what is a trade mark and sets out the rights given by this Act to the registered owner and any authorised user of a registered trade mark. |
| Parts 4 and 5: | Deal with the steps that you have to take to have a trade mark registered. |
| Part 6: | Sets out how and why an application for registration and other documents may be amended. |
| Parts 7, 8 and 9: | Deal with the registration of trade marks and how and why particulars of the registration of a trade mark may be amended, cancelled or removed from the Register. |
| Parts 10 and 11: | Deal with the assignment of trade marks, the registration of assignments of registered trade marks and the recording of the rights and interests that persons (other than registered owners) may have in registered trade marks or trade marks whose registration is being sought. |
| Parts 12, 13 and 14: | Deal with the protection of trade marks. Part 12 sets out what constitutes an infringement of a trade mark and how to obtain redress and relief in cases of infringement. Part 13 provides for a special regime to deal with any importation of goods that would infringe a registered trade mark. Part 14 makes certain types of conduct offences against this Act. |

Trade Marks No. 119, 1995

- Parts 15, 16 and 17: Explain what are collective trade marks, certification trade marks and defensive trade marks and apply to them, with necessary alterations, the provisions of this Act relating to trade marks.
- Part 18: Deals with the jurisdiction of the courts to hear and determine matters arising under this Act.
- Parts 19 and 20: Deal with the Trade Marks Office, the officials responsible for its administration and the keeping of the Register of Trade Marks.
- Part 21: Deals with miscellaneous matters such as the payment of fees, the service of documents and the making of regulations.
- Part 22: Repeals the *Trade Marks Act 1955* and explains how matters that were being dealt with under that Act at the time of its repeal are to be dealt with when this Act is in force.

How to use this Act

Definitions: Section 6 contains definitions of terms that have special meanings and are used frequently in this Act. A list of terms defined in section 6 appears after the Table of Provisions.

Notes: Notes are to be found throughout the text. They are designed to help you find your way through the Act. They may tell you that certain words or terms are defined and where to find the definition; they may alert you to other provisions in this Act and in other legislation that are relevant to the text you are reading; or they may draw your attention to information that may help you to understand the contents or legal consequences of certain provisions or how to comply with them.

Chart: The appendix to this Guide contains a chart showing the main steps involved in obtaining the registration of a trade mark. The chart is intended to be used only as an illustration and is not intended to have any other effect. If there is any inconsistency between any matter contained in the chart and a provision of this Act or the regulations, the provision prevails.

Related legislation

The following Acts are directly relevant to the operation or interpretation of this Act.

Acts Interpretation Act 1901

That Act contains general rules about the meaning or effect of many terms and provisions that are commonly used in Commonwealth Acts. Some of the notes used in this Act draw your attention to some of them, but it is not possible to refer to all of them.

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Crimes Act 1914

In Parts 13 and 14, you will find that a penalty, expressed as imprisonment for a particular period or a number of penalty units, is set out at the foot of some sections or subsections. Section 4D of the *Crimes Act 1914* provides that this indicates that any contravention of the section or subsection is an offence against this Act punishable upon conviction by a penalty not exceeding the penalty set out.

If only a term of imprisonment is provided as the penalty for an offence, subsections 4B(2) and 4B(3) of the *Crimes Act 1914* allow a court to impose an appropriate fine instead of, or in addition to, the term of imprisonment.

Section 4AA of the *Crimes Act 1914* sets out the amount of a penalty unit. Under subsection 4B(3) of that Act a court may impose on a body corporate convicted of an offence a fine of up to 5 times the amount of the fine that could be imposed on a natural person convicted of that offence.

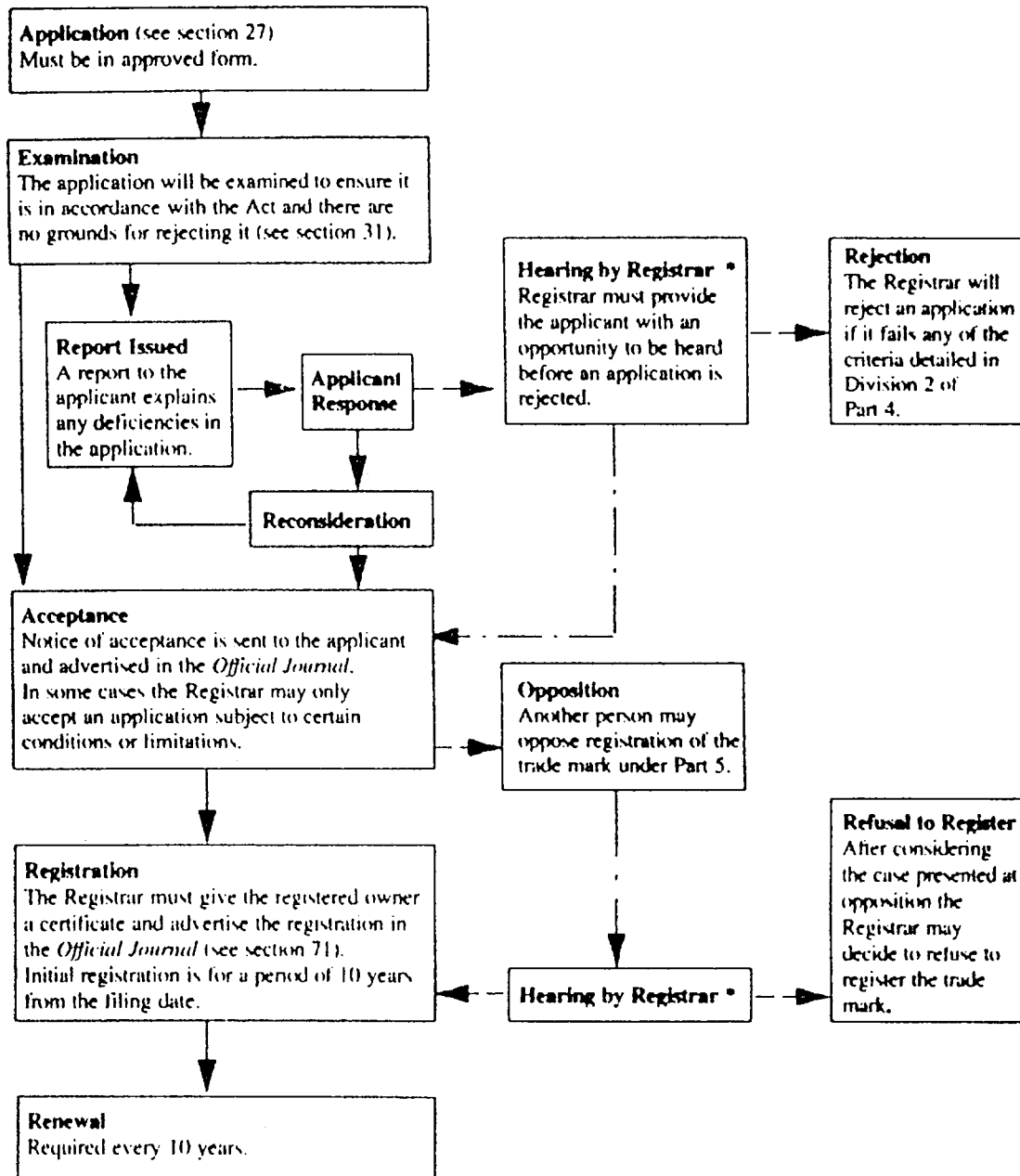
The *Crimes Act 1914* contains many other general rules that apply to offences. It also creates offences for conduct related to Commonwealth Acts. For example, if, knowing what is going on, you are in any way knowingly involved with another person in committing an offence against this Act, section 5 of the *Crimes Act 1914* provides that you have committed the same offence as the other person.

Trade Marks Act 1955

That Act is repealed by this Act. It contained the legislation that previously applied to trade marks, certification trade marks and defensive trade marks. Even though it is repealed, this Act provides that some of the provisions of that Act are to continue to apply to certain matters that were being dealt with under that Act immediately before it was repealed.

The list of Acts cited above is not exhaustive. Other Acts may also affect the operation or interpretation of this Act.

APPENDIX—OBTAINING REGISTRATION OF A TRADE MARK



* An Appeal may be made to the Federal Court against the decision of the Registrar.

← Unbroken lines signify the most likely course of events.

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List of terms defined in section 6

applicant	Official Journal
applied to	old register
applied in relation to	opponent
approved form	originate
assignment	patent attorney
association	pending
Australia	person
Australian continental shelf	predecessor in title
authorised use	prescribed court
authorised user	priority date
certification trade mark	Register
collective trade mark	registered owner
Commission	registered trade mark
Comptroller	Registrar
Convention country	registration number
date of registration	remove from the Register
deceptively similar	repealed Act
defensive trade mark	seized goods
Deputy Registrar	services of a person
designated owner	sign
divisional application	similar goods
employee	similar services
examine	this Act
existing registered mark	trade mark
Federal Court	trade marks officer
file	transmission
filing date	use of a trade mark
geographical indication	use of a trade mark in relation to
goods of a person	goods
lawyer	use of a trade mark in relation to
limitations	services
notified trade mark	word
objector	



Trade Marks Act 1995

No. 119 of 1995

An Act relating to trade marks

[Assented to 17 October 1995]

The Parliament of Australia enacts:

PART 1—PRELIMINARY

Short title

1. This Act may be cited as the *Trade Marks Act 1995*.

5 Commencement

2.(1) Part 1 commences on the day on which this Act receives the Royal Assent.

(2) This Act, other than Part 1, commences on 1 January 1996.

*Trade Marks No. 119, 1995***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. 5

Application of Act

4. This Act extends to:

- (a) Christmas Island; and
- (b) Cocos (Keeling) Islands; and 10
- (c) Norfolk Island; and
- (d) the Australian continental shelf; and
- (e) the waters above the Australian continental shelf; and
- (f) the airspace above Australia and the Australian continental shelf.

Note: For *Australia* and *Australian continental shelf* see section 6. 15

Repeal of *Trade Marks Act 1994*

5. The *Trade Marks Act 1994* is repealed.

Trade Marks No. 119, 1995

PART 2—INTERPRETATION

Definitions

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

5 *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 9.

approved form means a form approved by the Registrar for the purposes of the provision in which the expression appears.

10 *assignment*, in relation to a trade mark, means an assignment by act of the parties concerned.

association does not include a body corporate.

Australia includes the following external Territories:

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

Australian continental shelf has the same meaning as in the *Seas and Submerged Lands Act 1973*.

20 *authorised use*, in relation to a trade mark, has the meaning given by section 8.

authorised user, in relation to a trade mark, has the meaning given by section 8.

certification trade mark has the meaning given by section 169.

collective trade mark has the meaning given by section 162.

25 *Commission* means the Trade Practices Commission established under the *Trade Practices Act 1974*.

Comptroller means the Comptroller-General of Customs.

Convention country means a country declared (by regulations made under section 225) to be a Convention country for the purposes of this Act.

30 *date of registration*, in relation to the registration of a trade mark in respect of particular goods or services, means the day from which the registration of the trade mark in respect of those goods or services is taken to have had effect under subsection 72(1) or (2).

deceptively similar has the meaning given by section 10.

35 *defensive trade mark* has the meaning given by section 185.

Deputy Registrar means a Deputy Registrar of Trade Marks.

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*.

40 *divisional application* has the meaning given by section 45.

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

examine, in relation to an application for the registration of a trade mark, means to carry out an examination under section 31 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 before 1 January 1996 and whose registration under the repealed Act was due to expire after that day. 5

Federal Court means the Federal Court of Australia.

file means to file at the Trade Marks Office.

Note: See section 213. 10

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—the day on which the initial application (within the meaning of Division 3 of Part 4) was filed; or 15
- (c) in relation to an application to which section 241 applies—the day referred to in subsection 241(5); or
- (d) in relation to an application made under section 243—the day referred to in subsection 243(6). 20

geographical indication, in relation to goods 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 goods:

- (a) originated in that country, region or locality; and 25
- (b) have a quality, reputation or other characteristic attributable to their geographical origin.

goods of a person means goods dealt with or provided 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. 30

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

- (a) mode of use; or
- (b) use within a territorial area within Australia; or 35
- (c) use in relation to goods or services to be exported.

notified trade mark means a trade mark in respect of which a notice under section 132 is in force.

objector, in relation to seized goods, means any person who has given under section 132 a notice in respect of those goods that is in force. 40

Official Journal means the Official Journal of Trade Marks mentioned in section 226.

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old register means the Register of Trade Marks kept under the repealed Act.

opponent, in relation to the registration of a trade mark, means:

- (a) the person who has filed (under section 52) a notice of opposition to the registration of the trade mark; or
- 5 (b) if section 53 applies—a person in whose name the notice of opposition is taken to have been filed.

originate, in relation to wine, has the meaning given by section 15.

patent attorney means a person registered as a patent attorney under the *Patents Act 1990*.

- 10 **pending**, in relation to an application for the registration of a trade mark, has the meaning given by section 11.

person includes a body of persons, whether incorporated or not.

predecessor in title, in relation to a person who claims to be the owner of a trade mark, means:

- 15 (a) if the trade mark was assigned or transmitted to one or more than one other person before it was assigned or transmitted to the first-mentioned person—that other person or any one of those other persons; or
- 20 (b) if paragraph (a) does not apply—the person who assigned the trade mark, or from whom the trade mark was transmitted, to the first-mentioned person.

- 25 **Note:** In the case of a trade mark that is neither registered nor the subject of an application for registration, the trade mark may be assigned or transmitted in Australia only in conjunction with the goodwill of a business concerned with the trade mark. If the trade mark is registered or the subject of an application for registration, section 106 provides that the trade mark may be assigned or transmitted with or without the goodwill of the business.

prescribed court means a court that is under section 190 a prescribed court for the purposes of this Act.

priority date has the meaning given by section 12.

- 30 **Register** means the Register of Trade Marks kept under section 207.

registered owner, in relation to a registered trade mark, means the person in whose name the trade mark is registered.

registered trade mark means a trade mark whose particulars are entered in the Register under this Act.

- 35 **Registrar** means the Registrar of Trade Marks.

Note: Sections 201, 202, 203, 204 and 206 deal with the office, powers and functions of the Registrar of Trade Marks.

registration number, in relation to a registered trade mark, means the number given to it under subsection 68(2).

- 40 **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 16.

seized goods means goods seized under section 133.

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services of a person means services dealt with or provided in the course of trade by the person.

sign includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent. 5

similar goods has the meaning given by subsection 14(1).

similar services has the meaning given by subsection 14(2).

this Act includes the regulations.

trade mark has the meaning given by section 17.

trade marks officer means a person who: 10

- (a) holds, or performs the duties of, an Australian Public Service office in the Trade Marks Office; or
- (b) is an employee employed in the Trade Marks Office; or
- (c) is not a person referred to in paragraph (a) or (b) but performs services, under the control of the Registrar, for or on behalf of the Commonwealth. 15

Note 1: For *employee* see this section.

Note 2: The Registrar and a Deputy Registrar are trade marks officers.

transmission means:

- (a) transmission by operation of law; or 20
- (b) devolution on the personal representative of a deceased person; or
- (c) any other kind of transfer except assignment.

use of a trade mark has a meaning affected by subsections 7(1), (2) and (3).

use of a trade mark in relation to goods has the meaning given by subsection 7(4). 25

use of a trade mark in relation to services has the meaning given by subsection 7(5).

word includes an abbreviation of a word.

Use of trade mark

7.(1) 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 has used the trade mark with additions or alterations that do not substantially affect the identity of the trade mark. 30

Note: For *prescribed court* see section 190. 35

(2) To avoid any doubt, it is stated that, if a trade mark consists of the following, or any combination of the following, namely, any letter, word, name or numeral, any aural representation of the trade mark is, for the purposes of this Act, a use of the trade mark.

(3) An authorised use of a trade mark by a person (see section 8) is taken, for the purposes of this Act, to be a use of the trade mark by the owner of the trade mark. 40

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(4) In this Act:

use of a trade mark in relation to goods means use of the trade mark upon, or in physical or other relation to, the goods (including second-hand goods).

(5) In this Act:

5 *use of a trade mark in relation to services* means use of the trade mark in physical or other relation to the services.

Definitions of *authorised user* and *authorised use*

10 8.(1) A person is an *authorised user* of a trade mark if the person uses the trade mark in relation to goods or services under the control of the owner of the trade mark.

(2) The use of a trade mark by an authorised user of the trade mark is an *authorised use* of the trade mark to the extent only that the user uses the trade mark under the control of the owner of the trade mark.

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

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

the other person is taken, for the purposes of subsection (1), to use the trade mark in relation to the goods or services under the control of the owner.

20 (4) If:

- (a) a person deals with or provides, in the course of trade, goods or services in relation to which a trade mark is used; and
- (b) the owner of the trade mark exercises financial control over the other person's relevant trading activities;

25 the other person is taken, for the purposes of subsection (1), to use the trade mark in relation to the goods or services under the control of the owner.

(5) Subsections (3) and (4) do not limit the meaning of the expression "under the control of" in subsections (1) and (2).

Definition of *applied to* and *applied in relation to*

30 9.(1) For the purposes of this Act:

- (a) 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 trade mark is taken to be *applied in relation to* goods or services:

- 35
- (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

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(c) a trade mark is taken also to be ***applied in relation to*** goods or services if it is used:

(i) on a signboard or in an advertisement (including a televised advertisement); or

(ii) in an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; 5

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): 10

covering includes packaging, frame, wrapper, container, stopper, lid or cap.
label includes a band or ticket.

Definition of *deceptively similar*

10. 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. 15

Definition of *pending*

Application for registration under this Act

11.(1) An application for the registration of a trade mark under this Act is ***pending*** from the time it is filed until: 20

(a) it lapses (see section 37), is withdrawn (see section 214) or is rejected (see section 33); or

(b) if the Registrar refuses (under section 55) to register the trade mark and there is no appeal against the decision—the end of the period allowed for the appeal; or 25

(c) if the Registrar refuses (under section 55) to register the trade mark and:

(i) there is an appeal against the decision; and

(ii) the decision is confirmed on appeal;

— the day on which the decision is confirmed on appeal; or 30

(d) the trade mark is registered under section 68.

Note: For ***file*** see section 6.

Application for registration under repealed Act

(2) An application for the registration of a trade mark under the repealed Act was ***pending*** immediately before 1 January 1996 if before that day: 35

(a) the application had not lapsed (see subsection 48(1)), been withdrawn (see subsection 40A(1)) or refused (see subsection 44(1)); and

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- (b) the Registrar had not refused (under section 50) to register the trade mark or if he or she had refused to register the trade mark:
 - (i) the period allowed for appealing against the decision had not yet ended; or
 - 5 (ii) an appeal had been made against the decision but had not yet been decided; and
- (c) the trade mark had not been registered under section 53.

Definition of *priority date*

10 **12.** The *priority date* for the registration of a trade mark in respect of particular goods or services is:

- (a) if the trade mark is registered—the date of registration of the trade mark in respect of those goods or services; or
- (b) if the registration of the trade mark is being sought—the day that would be the date of registration of the trade mark in respect of those
15 goods or services if the trade mark were registered.

Definition of *remove from the Register*

20 **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 entries in the Register relating to the trade mark are taken to have been removed from the Register.

Definition of *similar goods and similar services*

- 14.(1)** For the purposes of this Act, goods are *similar* to other goods:
- (a) if they are the same as the other goods; or
 - (b) if they are of the same description as that of the other goods.
- 25 **(2)** For the purposes of this Act, services are *similar* to other services:
- (a) if they are the same as the other services; or
 - (b) if they are of the same description as that of the other services.

Definition of *originate in relation to wine*

- 30 **15.** For the purposes of this Act:
- (a) a wine is taken to have *originated* in a foreign country or Australia only if the wine is made within the territory of that country or of Australia, as the case may be; and
 - (b) a wine is taken to have *originated* in a particular region or locality of a foreign country or of Australia only if the wine is made from
35 grapes grown in that region or locality.

Definition of *repealed Act*

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

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

Note: For the repeal of the *Trade Marks Act 1955* see section 232.

5

(2) In this Act, unless the contrary intention appears, a reference to a particular section of the repealed Act includes a reference to the regulations made for the purposes of that section and that were in force immediately before that Act was repealed.

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PART 3—TRADE MARKS AND TRADE MARK RIGHTS

What is a trade mark?

- 5 **17.** 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 dealt with or provided by any other person.

Note: For *sign* see section 6.

Certain signs not to be used as trade marks etc.

- 10 **18.(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.

- 10 **(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;

- 15 immediately before the regulations were registered under the *Legislative Instruments Act 1995*.

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

Certain trade marks may be registered

- 20 **19.(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.

- 25 **(2)** The registration of a trade mark may be in respect of goods or services of more than one class.

Note: See subsection (3) for division into classes.

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

Rights given by registration of trade mark

- 30 **20.(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;

- 35 in relation to the goods and/or services in respect of which the trade mark is registered.

Note 1: For *registered owner* see section 6.

Note 2: For *use* see section 7.

- 40 **(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 12.

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(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 6.

(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

Note: For *limitations* see section 6.

(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. 10

Nature of registered trade mark as property

21.(1) A registered trade mark is personal property.

(2) Equities in respect of a registered trade mark may be enforced in the same way as equities in respect of any other personal property. 15

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

Power of registered owner to deal with trade mark

22.(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. 20

(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. 25

Note: For *registered owner* see section 6.

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

23. 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. 30

Note: For *deceptively similar* see section 10. 35

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

5 **24.(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 generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service.

Note: For *registered trade mark*, *sign* and *date of registration* see section 6.

- 10 (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
- 15 (b) is taken to have ceased to have those exclusive rights from and including the day determined by the court under subsection (4).

Note: For *registered owner* see section 6.

- 20 (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).

25 Note: For *registered owner* see section 6.

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

30 Note: For *prescribed court* see section 190.

Trade mark relating to article etc. formerly manufactured under patent

- 35 **25.(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
- 40 (c) the sign is the only commonly known way to describe or identify the article, substance or service.

Note: For *registered trade mark* and *sign* see section 6.

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- (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 5
 - (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: 10
 - (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. 15

Powers of authorised user of registered trade mark

- 26.(1)** Subject to any agreement between the registered owner of a registered trade mark and an authorised user of the trade mark, the authorised user may do any of the following: 20
- (a) the authorised user may use the trade mark in relation to the goods and/or services in respect of which the trade mark is registered, subject to any condition or limitation subject to which the trade mark is registered;
 - (b) the authorised user may (subject to subsection (2)) bring an action for infringement of the trade mark if the registered owner refuses or neglects to do so within the prescribed period; 25
 - (c) the authorised user may cause 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 prohibiting any act that is under subsection 121(2) a prohibited act in relation to the goods; 30
 - (d) the authorised user may:
 - (i) give to the Comptroller a notice under section 132 objecting to the importation of goods that infringe the trade mark; or 35
 - (ii) revoke such a notice;
 - (e) an authorised user may give permission to any person:
 - (i) to alter or deface; or
 - (ii) to make any addition to; or
 - (iii) to remove, erase or obliterate, wholly or partly; 40

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a registered trade mark that is applied to any goods, or in relation to any goods or services, in respect of which the trade mark is registered;

- 5 (f) the authorised user may give permission to any person to apply the trade mark to goods, or in relation to goods or services, in respect of which the trade mark is registered.

Note 1: For *registered owner* and *registered trade mark* see section 6.

Note 2: For *authorised user* see section 8.

Note 3: For what amounts to an infringement of a trade mark see Part 12.

- 10 Note 4: For *apply to* and *apply in relation to* see section 9.

(2) If the authorised user brings an action for infringement of the trade mark, the authorised user 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.

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PART 4—APPLICATION FOR REGISTRATION

Division 1—General

Application—how made

5 **27.(1)** A person may apply for the registration of a trade mark in respect of goods and/or services if:

- (a) the person claims to be the owner of the trade mark; and
- (b) one of the following applies:
 - (i) the person is using or intends to use the trade mark in relation to the goods and/or services;
 - 10 (ii) the person has authorised or intends to authorise another person to use the trade mark in relation to the goods and/or services;
 - (iii) the person intends to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods and/or services.

Note: For *use* see section 7.

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

Note: For *file* see section 6.

- (3) Without limiting the particulars that may be included in an application, the application must:
 - 25 (a) include a representation of the trade mark; and
 - (b) specify, in accordance with the regulations, the goods and/or services in respect of which it is sought to register the trade mark.

- (4) Regulations made for the purposes of paragraph (3)(b) may apply, adopt or incorporate any matter contained in any listing of goods and/or services published by the Registrar from time to time and made available for inspection by the public at the Trade Marks Office and its sub-offices.
- 30

- (5) An application (other than an application under section 51 for the registration of 2 or more trade marks as a series) may be made in respect of goods and services of one or more of the classes provided for in regulations made under subsection 19(3).
- 35

Application by joint owners

28. 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:

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

the persons may together apply for its registration under subsection 27(1).

Application for registration of trade mark whose registration has been sought in a Convention country—claim for priority 5

29.(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 another person (*successor in title*) of whom that person is a predecessor in title applies to the Registrar for the registration of the trade mark in respect of some or all of the goods and/or services in respect of which registration was sought in that country or those countries; 10 15

that person or that 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 registration of the trade mark in respect of any or all of those goods and/or services in accordance with the regulations. 20

(2) The priority claimed is for the registration of the trade mark in respect of the goods or services:

- (a) 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 25
- (b) 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) 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. 30

Note: For *Convention country* see section 225.

Particulars of application to be published

30. The Registrar must publish the particulars of the application in accordance with the regulations. 35

Registrar to examine, and report on, application

31. The Registrar must, in accordance with the regulations, examine and report on:

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

Registrar to decide on disputed classification of goods etc.

5 32. 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.

10 **Application accepted or rejected**

33.(1) The Registrar must, after the examination, accept the application unless he or she is satisfied that:

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

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

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

Note: For *limitations* see section 6.

(3) If the Registrar is satisfied that:

- 20 (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.

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

25 Note: For *applicant* see section 6.

Notice etc. of decision

34. The Registrar must:

- (a) notify the applicant in writing of his or her decision under section 33;
and
- 30 (b) advertise the decision in the *Official Journal*.

Note: For *applicant* see section 6.

Appeal

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

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

Note: For *applicant* see section 6.

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Deferment of acceptance

36. The Registrar may defer the acceptance of the application in the circumstances, and for the period, provided for in the regulations.

Lapsing of application

37.(1) Subject to subsection (2), an application lapses if it is not accepted within the prescribed period or within that period as extended in accordance with the regulations. 5

(2) If, after the prescribed period or the prescribed period as extended (as the case may be) has expired, the Registrar extends under section 224 the period within which the application may be accepted, the application: 10

- (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

38.(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 15
- (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. 20

Note: For *limitations* see section 6.

(2) If the Registrar revokes the acceptance:

- (a) the application is taken to have never been accepted; and
- (b) the Registrar must examine, and report on, the application as necessary under section 31; and 25
- (c) sections 33 and 34 again apply in relation to the application.

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Division 2—Grounds for rejecting an application

Trade mark containing etc. certain signs

5 39.(1) An application for the registration of a trade mark must be rejected if the trade mark contains or consists of a sign that, under regulations made for the purposes of section 18, is not to be used as a trade mark.

(2) 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 subsection; or
 - 10 (b) a sign so nearly resembling:
 - (i) a sign referred to in paragraph (a); or
 - (ii) a sign referred to in subsection (1);
- as to be likely to be taken for it.

Trade mark that cannot be represented graphically

15 40. An application for the registration of a trade mark must be rejected if the trade mark cannot be represented graphically.

Trade mark not distinguishing applicant's goods or services

20 41.(1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

Note 1: For *applicant* and *predecessor in title* see section 6.

Note 2: If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

25 (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.

Note: For *goods of a person* and *services of a person* see section 6.

30 (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 from the goods or services of other persons.

35 (4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

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- (a) the Registrar is to consider whether, because of the combined effect of the following:
 - (i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;
 - (ii) the use, or intended use, of the trade mark by the applicant; 5
 - (iii) any other circumstances;
 the trade mark does or will distinguish the designated goods or services as being those of the applicant; and
 - (b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; and 10
 - (c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons. 15
- Note 1: For *goods of a person* and *services of a person* see section 6.
- Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8). 20
- (6) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:
 - (a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant—the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons; 25
 - (b) in any other case—the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons. 30
- Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate: 35
- (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
 - (b) the time of production of goods or of the rendering of services.
- Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8). 40

Trade mark scandalous or its use contrary to law

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

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- (a) the trade mark contains or consists of scandalous matter; or
- (b) its use would be contrary to law.

Trade mark likely to deceive or cause confusion

5 43. An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

Identical etc. trade marks

10 44.(1) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of goods (*applicant's goods*) must be rejected if:

- (a) the applicant's trade mark is substantially identical with, or deceptively similar to:
 - 15 (i) a trade mark registered by another person in respect of similar goods or closely related services; or
 - (ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and
- 20 (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar goods* see subsection 14(1).

25 Note 3: For *priority date* see section 12.

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

- (a) it is substantially identical with, or deceptively similar to:
 - 30 (i) a trade mark registered by another person in respect of similar services or closely related goods; or
 - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
- 35 (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar services* see subsection 14(2).

40 Note 3: For *priority date* see section 12.

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

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(a) that there has been honest concurrent use of the 2 trade marks; or
(b) that, because of 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 conditions or limitations 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. 5

Note: For *limitations* see section 6.

(4) If the Registrar in either case is satisfied that the applicant, or the
applicant and the predecessor in title of the applicant, have continuously
used the applicant's trade mark for a period: 10

(a) beginning before the priority date for the registration of the other
trade mark in respect of:

(i) the similar goods or closely related services; or

(ii) the similar services or closely related goods; and 15

(b) ending on the priority date for the registration of the applicant's trade
mark;

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

Note 1: An authorised use of the trade mark by a person is taken to be a use of the trade mark by the
owner of the trade mark (see subsection 7(3)). 20

Note 2: For *predecessor in title* see section 6.

Note 3: For *priority date* see section 12.

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Division 3—Divisional applications

Definition of *divisional application*

5 **45.(1)** A person who has made an application (*initial application*) for the registration of a trade mark in respect of certain goods and/or services may, in accordance with this Division, make another application (*divisional application*):

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

(2) For the purposes of this Division, the initial application is taken to be the application whose particulars have been published by the Registrar under section 30.

Divisional application possible only if initial application is pending

20 **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.

Note 1: For *initial application* and *divisional application* see section 45.

Note 2: For *pending* see section 11.

25 **Divisional application for registration of part of trade mark**

47.(1) This section provides for the making of a divisional application for the registration of a part only of the trade mark that is the subject of the initial application.

- 30 (2) 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 (3), make a divisional application for the registration of that part as a trade mark in respect of any or all of the goods and/or services specified in the initial application.

Note: For *applicant* see section 6.

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

Note: For *initial application* and *divisional application* see section 45.

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Divisional application for registration of trade mark in respect of some of the goods etc. specified in the initial application

48.(1) This section provides for the making of a divisional application for the registration of a trade mark in respect of some of the goods and/or services in respect of which registration of the trade mark is being sought by the initial application. 5

(2) The applicant for the registration of a trade mark may, subject to subsection (3), make a divisional application for the registration of the trade mark in respect of any (but not all) of:

- (a) the goods and/or services specified in the initial application; or 10
- (b) if the initial application has been amended to exclude some of the goods and/or services specified in that application before its amendment—the goods and/or services specified in the initial application as amended.

Note: For *applicant* see section 6. 15

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

Note: For *initial application* and *divisional application* see section 45.

Divisional application for registration of trade mark in respect of goods etc. excluded from the initial application 20

49.(1) This section applies if the initial application for the registration of a trade mark is amended to exclude some of the goods and/or services specified in that application before its amendment. It provides for the making of a divisional application in respect of any or all of the excluded goods and/or services. 25

(2) If the initial application is amended:

- (a) before a decision is made about it under section 33; 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 and/or services that have been excluded from the initial application. 30

(3) If the initial application has been accepted, the divisional application may not be made after the acceptance is advertised in the *Official Journal*. 35

(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

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

Note 1: For *initial application* and *divisional application* see section 45.

5

Note 2: For *applicant* see section 6.

Filing date

50. A divisional application is taken to have been filed on the day on which the initial application concerned was filed.

Note: For *file* see section 6.

*Trade Marks No. 119, 1995****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 27(1) for the registration of 2 or more trade marks in respect of similar goods or similar services 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: 5

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places; 10
- (c) the colour of any part of the trade mark;
- (d) any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks. 15

(2) If:

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required (under section 68) to register the trade marks;

he or she must register them as a series in one registration. 20

*Trade Marks No. 119, 1995***PART 5—OPPOSITION TO REGISTRATION*****Division 1—General*****Opposition**

5 **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 or within that period as extended in accordance with the regulations.

10 Note: For *approved form* and *file* see section 6.

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

 Note: For *opponent* see section 6.

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

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

53. If:

(a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes
20 vested in another person; and

(b) the other person:

(i) notifies the Registrar in writing that the right or interest is vested in him or her; and

(ii) does not withdraw the opposition;

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

 Note: For *file* see section 6.

Opposition proceedings

30 **54.(1)** The Registrar must give to the opponent and to the applicant an opportunity of being heard on the opposition.

 Note: For *opponent* and *applicant* see section 6.

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

Decision

35 **55.** Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

(a) to refuse to register the trade mark; or

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- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or 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.

5

Note: For *limitations* see section 6.

Appeal

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

Note: For *applicant* and *opponent* see section 6.

10

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Division 2—Grounds for opposing registration

Registration may be opposed on same grounds as for rejection

- 5 **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 graphically.

Applicant not owner of trade mark

- 10 **58.** The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.
Note: For *applicant* see section 6.

Applicant not intending to use trade mark

- 15 **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 and/or services specified in the application.
Note: For *applicant* see section 6.

20 **Trade mark similar to trade mark that has acquired
a reputation in Australia**

- 60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:
 (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the
25 first-mentioned trade mark in respect of those goods or services, 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.
30 Note 1: For *deceptively similar* see section 10.
Note 2: For *priority date* see section 12.

Trade mark containing or consisting of a false geographical indication

- 35 **61.(1)** The registration of a trade mark in respect of particular goods (*relevant goods*) may be opposed on the ground that the trade mark contains or consists of a sign that is a geographical indication for goods (*designated goods*) originating in:
 (a) a country, or in a region or locality in a country, other than the country in which the relevant goods originated; or

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- (b) a region or locality in the country in which the relevant goods originated other than the region or locality in which the relevant goods originated.

(2) An opposition on a ground referred to in subsection (1) fails if the applicant establishes that:

- (a) the relevant goods 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 goods in the country in which the designated goods originated; or
(c) the applicant, or a predecessor in title of the applicant, used the sign in good faith in respect of the relevant goods, or applied in good faith for the registration of the trade mark in respect of the relevant goods, before:

- (i) 1 January 1996; or
(ii) the day on which the sign was recognised as a geographical indication for the designated goods in their country of origin;

whichever is the later; or

- (d) if the registration of the trade mark is being sought in respect of wine or spirits (*relevant wine or spirits*)—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) An opposition on a ground referred to in subsection (1) also fails if the applicant establishes that:

- (a) although the sign is a geographical indication for the designated goods, it is also a geographical indication for the relevant goods; and
(b) the applicant has not used, and does not intend to use, the trade mark in relation to the relevant goods in a way that is likely to deceive or confuse members of the public as to the origin of the relevant goods.

Note 1: For *applicant*, *predecessor in title* and *geographical indication* see section 6.

Note 2: For *originate* (in relation to wine only) see section 15.

Application etc. defective etc.

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

- (a) that the application, or a document filed in support of 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.

Note: For *file* see section 6.

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**PART 6—AMENDMENT OF APPLICATION FOR
REGISTRATION OF A TRADE MARK AND OTHER
DOCUMENTS**

Amendment of application for registration of trade mark

5 **63.(1)** The Registrar may, at the written request of the applicant or of his
or her agent, amend an application for the registration of a trade mark in
accordance with section 64 or 65.

(2) If:

10 (a) an application for the registration of a trade mark may be amended
under section 65; and

(b) the applicant has not asked in writing that the application be
amended;

15 the Registrar may, on his or her own initiative but in accordance with the
regulations, amend the application as necessary to remove any ground on
which the application could be rejected.

Amendment before particulars of application are published

64. If:

(a) the particulars of the application have not yet been published under
section 30; and

20 (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 particulars of application have been published

65.(1) If the particulars of the application have been published under
section 30, the application may be amended as provided in this section.

25 **(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 particulars 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.

30 **(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).

35 **(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.

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Amendment of other documents

66. The Registrar may, at the written 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 or at the written request of the person's agent, amend the application, notice or document: 5

- (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.

Note: For *file* see section 6.

Appeal 10

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

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PART 7—REGISTRATION OF TRADE MARKS

Division 1—Initial registration

Obligation to register

5 68.(1) The Registrar must, within the period provided under the regulations, 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.

10 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

15 69.(1) The trade mark must be registered:

- (a) in the name of the applicant for registration; and
 - (b) in respect of the goods and/or 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
- 20 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 graphical representation of the trade mark; and
- (b) its registration number; and
- 25 (c) any other particulars that are required by this Act to be entered in the Register.

 (3) If 2 or more persons applied together for the registration of the trade mark (see section 28), the applicants must be registered as joint owners of the trade mark.

30 Note: For *limitations*, *Registrar* and *applicant* see section 6.

Colours in registered trade marks

 70.(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.

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

Note: For *limitations* see section 6.

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Notification of registration

71. When a trade mark has been registered, 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.

5

Note: For *registered owner* and *approved form* see section 6.

Date and term of registration

- 72.(1) Subject to subsection (2), the registration of a trade mark in respect of the goods and/or services in respect of which the trade mark is registered is taken to have had effect from (and including) the filing date in respect of the application for registration.

10

Note: For *filing date* see section 6.

(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 under section 29 for the registration of the trade mark in respect of particular goods or services; and

15

- (c) the trade mark is registered under this Act;

the registration of the trade mark in respect of those goods or services is taken to have had effect:

20

- (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.

25

Note: For *Convention country* see section 225.

- (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.

30

Note 1: This is so even for a trade mark whose registration in respect of particular goods or services has effect from (and including) the day on which an application was made in a Convention country.

Note 2: For *filing date* see section 6.

Ceasing of registration

35

73. The registration of a trade mark ceases if:

- (a) the trade mark is removed from the Register under section 78 or Part 9; or
- (b) the registration of the trade mark is cancelled.

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Disclaimers

5 **74.(1)** An applicant for the registration of a trade mark, or the registered owner of a registered trade mark, may, by notice in writing given to the Registrar, disclaim any exclusive right to use, or authorise the use of, a specified part of the 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.

10 **(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.

(4) A disclaimer properly made may not be revoked.

Note: For *applicant*, *registered owner*, *registered trade mark* and *Register* see section 6.

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Division 2—Renewal of registration

Request for renewal

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

5

(2) The request must:

(a) be in an approved form; and

(b) be filed in accordance with the regulations.

Notice of renewal due

76. If, at the beginning of the prescribed period, the Registrar has not received a request for the renewal of the registration 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.

10

Note: For *registered owner* see section 6.

Renewal before registration expires

15

77.(1) If a request for the renewal of the registration of a trade mark is made in accordance with section 75, 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.

20

Note: For *registered owner* see section 6.

Failure to renew

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

(a) subject to sections 79 and 80, the registration ceases to have effect when it expires; and

25

(b) unless the registration is renewed under section 79, the Registrar must remove the trade mark from the Register 12 months after the day on which the registration expired.

Note: For *Register* see section 6.

30

Renewal within 12 months after registration expires

79. If, within 12 months after the registration of a trade mark has expired, a person asks the Registrar, in accordance with subsection 75(2), to renew the registration of the trade mark, the Registrar must renew the registration of the trade mark for 10 years from the day on which the registration expired.

35

Status of unrenewed trade mark

80. If:

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- (a) the registration of a trade mark (*unrenewed trade mark*) has not been renewed; and
 - (b) within 12 months 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;
- 5 the unrenewed trade mark is taken to be a registered trade mark for the purposes of the application.

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**PART 8—AMENDMENT AND CANCELLATION OF
REGISTRATION**

Division 1—Action by Registrar

Correction of Register

- 5 **81.** 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.

Note: For *Register* see section 6.

Adaptation of classification

- 10 **82.** 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.

15 Note 1: For *Register* see section 6.

Note 2: For the classification of goods and services see subsection 19(3).

Amendment of particulars of trade mark entered in Register

83.(1) Subject to Part 11, the Registrar may, at the written request of the registered owner of a registered trade mark:

- 20 (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 particulars of the application for the registration of the trade mark were published under section 30; or
- 25 (b) amend any particulars entered in the Register relating to any 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
- 30 (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.

Note: For *registered owner*, *registered trade mark* and *Register* see section 6.

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

Note: See sections 215 and 216 for amendments of the Register to record changes in addresses for service and in the names of registered owners etc.

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Cancellation of registration

84.(1) The Registrar must cancel the registration of a trade mark in accordance with the regulations if the registered owner asks in writing that the registration be cancelled.

Note: For *registered owner* see section 6.

5

(2) Before cancelling the registration of the trade mark, the Registrar must notify in accordance with the regulations:

(a) any person recorded under Part 11 as claiming a right in respect of, or an interest in, the trade mark; and

(b) if:

10

(i) an application has been made to the Registrar for a record of the assignment or transmission of the trade mark to a person to be entered in the Register (see section 109); and

(ii) the assignment has not yet been recorded;

the person to whom the trade mark has been assigned or transmitted.

15

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Division 2—Action by Court

Amendment to correct error or omission

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

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

Note: For *prescribed court* see section 190.

10 **Amendment or cancellation on ground of contravention of condition etc.**

86. 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
15 (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.

Note: For *prescribed court* see section 190.

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

87.(1) If section 24 or 25 applies in relation to a registered trade mark, a prescribed court may, on the application of an aggrieved person, but subject to subsection (2) and section 89, order that the Register be rectified by:

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

having regard to the effect of section 24 or 25 (as the case may be) on the right 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.

30 **(2)** If section 24 or 25 applies in relation to the trade mark because the trade mark contains a sign that:

- (a) has become generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service; or
 (b) describes or is the name of:
35 (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:

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- (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.

Note 1: Sections 24 and 25 provide that the registered owner of a trade mark does not have exclusive rights to use, or to authorise the use of, the trade mark if it consists of, or contains, a sign that:

- (a) becomes generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service; or
- (b) is the only commonly known way to describe or identify an article formerly exploited under a patent, or a service formerly provided as a patented process, where the patent has expired more than 2 years ago.

Note 2: For *registered trade mark*, *registered owner* and *Register* see section 6.

Note 3: For *prescribed court* see section 190.

Amendment or cancellation—other specified grounds

88.(1) Subject to subsection (2) and section 89, 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 on any of the following grounds, and on no other 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) an amendment of the application for the registration of the trade mark was obtained as a result of fraud, false suggestion or misrepresentation;
- (c) because of the circumstances applying at the time when the application for rectification is filed, the use of the trade mark is likely to deceive or cause confusion for a reason other than one for which:
 - (i) the application for the registration of the trade mark could have been rejected under section 43 or 44; or
 - (ii) the registration of the trade mark could have been opposed under section 60;

(d) the following circumstances apply:

- (i) the Registrar accepted the application for the registration of the trade mark because he or she was satisfied, having regard to the extent to which the trade mark was inherently adapted to distinguish the goods or services of the applicant for

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registration from the goods or services of any other person and the intended use of the trade mark, that the trade mark would distinguish those goods or services as being those of the applicant (see paragraph 41(5)(a));

5 (ii) the application for rectification is made at least 10 years after the filing date;

(iii) in the intervening period, the trade mark has not been used to an extent sufficient for it to distinguish, in fact, the goods or services of the registered owner from the goods or services of
10 any other person;

(e) if the application is in respect of an entry in the Register—the entry was made, or has been previously amended, as a result of fraud, false suggestion or misrepresentation.

Note 1: For *prescribed court* see section 190.

15 Note 2: For *file*, *filing date* and *registered owner* see section 6.

Rectification may not be granted in certain cases if registered owner not at fault etc.

89.(1) The court may decide not to grant an application for rectification made:

20 (a) under section 87; 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 88(2)(a)); or

(c) on the ground referred to in paragraph 88(2)(c);

25 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.

Note: For *registered owner* see section 6.

(2) In making a decision under subsection (1), the court:

30 (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

35 **90.(1)** A person applying to a prescribed court under this Division must give notice of the application to the Registrar.

Note: For *prescribed court* see section 190.

(2) Except for cases where the court directs the Registrar to appear, the Registrar may appear before the court and be heard at his or her discretion.

40 (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.

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Division 3—Amendment of certificate of registration

Amendment of certificate of registration

91. When the Registrar amends any particular entered in the Register in respect of a trade mark, the Registrar may also amend the certificate of registration if he or she thinks it appropriate to do so.

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

Application for removal of trade mark from Register etc.

5 92.(1) A person aggrieved by the fact that a trade mark is or may be registered may, subject to subsection (3), apply to the Registrar for the trade mark to be removed from the Register.

(2) The application:

(a) must be in accordance with the regulations; and
10 (b) may be made in respect of any or all of the goods and/or services in respect of which the trade mark may be, or is, 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.

15 Note: For *prescribed court* see section 190.

(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:

20 (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
25 (iii) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods and/or services to which the non-use application relates and that the registered owner:

(iv) has not used the trade mark in Australia; or
(v) has not used the trade mark in good faith in Australia;
30 in relation to those goods and/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 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:

(i) used the trade mark in Australia; or
(ii) used the trade mark in good faith in Australia;
40 in relation to the goods and/or services to which the application relates.

Note: For *file* see section 6.

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(5) If the right or interest on which a person relied to make an application (under subsection (1) or (3)) to obtain the removal of a trade mark from the Register becomes vested in another person, the other person may, on giving notice of the relevant facts to the Registrar or the court (as the case requires), be substituted for the first-mentioned person as the applicant. 5

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 application for 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 application for the registration of the trade mark. 10

Note: For *filing date* see section 6.

Referral to court

94. If: 15

(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 such a court and the court may hear and determine the matter as if an application had been made to it under subsection 92(3). 20

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. 25

(2) If the application is in respect of a trade mark already entered on the Register, the Registrar must advertise the application in the *Official Journal*.

(3) If the application is in respect of a trade mark whose registration is being sought, the Registrar is to advertise the application in the *Official Journal* only if the trade mark is registered. 30

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: 35

(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).

Note: For *file* see section 6.

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

5 **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 in respect of the goods and/or services specified in the application.

10 **(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 in respect of the goods and/or services specified in the application. The court must cause a copy of the order to be served on the Registrar and the Registrar must comply with the order.

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

98. If:

- 15 (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
- 20 (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.

Note: For *file* see section 6.

Proceedings before Registrar

25 **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:

- 30 (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
- 35 (iii) to assign the trade mark to a body corporate for use by the body corporate in Australia;
- in relation to the goods and/or services to which the opposed application relates (*relevant goods and/or services*); or

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(b) any allegation made under paragraph 92(4)(a) that the trade mark has not, at any time before the period of one month ending on the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods and/or services; or

5

(c) any allegation made under paragraph 92(4)(b) that the trade mark has not, at any time during the period of 3 years ending one month before the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods and/or services.

10

Note 1: If the registered owner of the trade mark has authorised another person to use it, any authorised use of the trade mark by that person is taken to be a use of the trade mark by the registered owner (see subsection 7(3)).

Note 2: For *file* and *registered owner* see section 6.

(2) For the purposes of paragraph 1(b), the opponent is taken to have rebutted the allegation that the trade mark has not, at any time before the period referred to in that paragraph, been used, or been used in good faith, by its registered owner in relation to the relevant goods and/or services if:

15

(a) the opponent has established that the trade mark or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by its registered owner in relation to those goods or services before that period; or

20

(b) in a case where the trade mark has been assigned but a record of the assignment has not been entered in the Register:

(i) the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by the assignee in relation to those goods or services before that period and that that use was in accordance with the terms of the assignment; and

25

(ii) 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 use of the trade mark by the assignee before that period as having been a use of the trade mark in relation to those goods or services by the registered owner.

30

Note 1: If the registered owner of the trade mark has authorised another person to use it, any authorised use of the trade mark by that person is taken to be a use of the trade mark by the registered owner (see subsection 7(3)).

35

Note 2: For *registered owner* see section 6.

(3) For the purposes of paragraph 1(c), the opponent is taken to have rebutted the allegation that the trade mark has not, at any time during the period referred to in that paragraph, been used, or been used in good faith, by its registered owner in relation to the relevant goods and/or services if:

40

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(a) the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by its registered owner in relation to those goods or services during that period; or

(b) in a case where the trade mark has been assigned but a record of the assignment has not been entered in the Register:

(i) the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by the assignee of the trade mark in relation to those goods or services during that period and that that use was in accordance with the terms of the assignment; and

(ii) 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 use of the trade mark by the assignee during that period as having been a use of the trade mark in relation to those goods or services by the registered owner; or

(c) the opponent has established that the trade mark was not used by its registered owner in relation to those goods and/or services during that period 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 that period.

Note 1: If the registered owner of the trade mark has authorised another person to use it, any authorised use of the trade mark by that person is taken to be a use of the trade mark by the registered owner (see subsection 7(3)).

Note 2: For *registered owner* see section 6.

Determination of opposed application—general

101.(1) Subject to subsection (3) and to section 102, if:

(a) the proceedings relating to an opposed application have not been discontinued or dismissed; and

(b) 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 the Register in respect of any or all of the goods and/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 the Register in respect of any or all of the goods and/or services to which the application relates.

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(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 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 for the removal of a trade mark (*challenged trade mark*) from the Register is made on the ground referred to in paragraph 92(4)(b) and: 5

(a) the applicant is the registered owner of a trade mark that is substantially identical with, or deceptively similar to, the challenged trade mark and is registered in respect of the goods and/or services specified in the application subject to the condition or limitation that the use of the trade mark is to be restricted to: 10

(i) goods and/or services to be dealt with or provided in a particular place (*specified place*) in Australia (otherwise than for export from Australia); or 15

(ii) goods and/or services to be exported to a particular market (*specified market*); 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. 20

Note 1: For *registered owner* see section 6.

Note 2: For *deceptively similar* see section 10.

(2) If the Registrar or the court is satisfied:

(a) that the challenged trade mark has remained registered for the period referred to in paragraph 92(4)(b); and 25

(b) that during that period there has been no use, or no use in good faith, of the challenged trade mark in relation to:

(i) goods or services dealt with or provided in the specified place; or

(ii) goods or services to be exported to the specified market; 30

the Registrar may decide, or the court may order, that the challenged trade mark should not be removed from 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: 35

(c) goods or services dealt with or provided in the specified place; or

(d) goods or services to be exported to the specified market.

Note: For *limitations* see section 6.

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. 40

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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

5 **105.(1)** If in any proceedings relating to an opposed application the Registrar or the court has found that:

 (a) a trade mark has been used in good faith during a particular period;
 or

10 (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:

15 (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,
20 unless the Registrar or the court otherwise directs, to have the opponent's full costs paid by the applicant.

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PART 10—ASSIGNMENT AND TRANSMISSION OF TRADE MARKS

Assignment etc. of trade mark

5 **106.(1)** A registered trade mark, or a trade mark whose registration is being sought, may be assigned or transmitted in accordance with this section.

(2) The assignment or transmission may be partial, that is, it may apply to some only of the goods and/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.

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

Note: For *assignment* and *transmission* see section 6.

Applications for record to be made of assignment etc. of trade mark whose registration is sought

15 **107.(1)** If a trade mark whose registration is being sought is assigned or transmitted:

(a) the applicant for the registration of the trade mark; or

(b) the person to whom it has been assigned or transmitted;

20 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.

25 Note: For *approved form* and *file* see section 6.

Recording of assignment etc. of trade mark whose registration is sought

108.(1) If the application complies with this Act, the Registrar must:

30 (a) at, or within, the time provided for in the regulations, record in the manner that the Registrar thinks fit (but not in the Register) the particulars of the assignment or transmission; and

(b) publish the particulars of the assignment or transmission in accordance with the regulations.

35 (2) 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

40 **109.(1)** If a registered trade mark is assigned or transmitted:

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(a) the person registered as the owner of the trade mark; or
(b) the person to whom the 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: 5
- (a) be in an approved form; and
- (b) be filed, together with any prescribed document, in accordance with the regulations.

Note: For *approved form* and *file* see section 6.

Recording of assignment etc. of registered trade mark 10

110.(1) If the application complies with this Act, the Registrar must, at, or within, the time provided for in the regulations:

- (a) enter the particulars of the assignment or transmission in the Register; and
- (b) register the person to whom the trade mark has been assigned or transmitted (*beneficiary*) as the owner of the trade mark in relation to the goods and/or services in respect of which the assignment or transmission has effect. 15

(2) The particulars are taken to have been entered in the Register on the day on which the application was filed, and the registration of the beneficiary as the owner of the trade mark is taken to have had effect from and including that day. 20

- (3) The Registrar must advertise in the *Official Journal*:
- (a) the recording of the assignment or transmission; and
- (b) the registration of the beneficiary as the owner of the trade mark. 25

Notice of application to be given to person recorded as claiming interest in trade mark etc.

111. If an application made under section 107 or 109 in relation to the assignment or transmission of a trade mark complies with this Act, the Registrar must notify in accordance with the regulations any person recorded under Part 11 as claiming an interest in, or a right in respect of, the trade mark. 30

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**PART 11—VOLUNTARY RECORDING OF CLAIMS TO
INTERESTS IN AND RIGHTS IN RESPECT OF TRADE
MARKS**

Division 1—Preliminary

5 Object of Part

112. This Part makes provision:

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

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

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

Application to have claims to interest etc. recorded

113.(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 5

(b) this interest or right may not be recorded in the Register under Part 10;

the person and the registered owner of the trade mark may together apply to the Registrar to have particulars of the claim recorded in the Register. 10

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

Note: For registered owner, registered trade mark, approved form and file see section 6.

Record of claims to interest etc.

114.(1) If the application has been made in accordance with section 113, the Registrar must enter in the Register the particulars of the claim set out in the application. 15

(2) If:

(a) a trade mark is registered; and

(b) immediately before the registration, particulars of a claim to an interest in, or right in respect of, the trade mark were recorded under Division 3; 20

the Registrar must enter those particulars in the Register.

Amendment and cancellation

115. The regulations may provide for the amendment and cancellation of particulars entered in the Register under this Division. 25

Record not proof etc. of existence of right etc.

116. 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. 30

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

Application to have claims to interest etc. recorded

117.(1) If:

- 5 (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 claim.

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

Note: For *approved form* and *file* see section 6.

Record of claims to interest etc.

- 15 118. If the application has been made in accordance with section 117, the Registrar must record in the manner that the Registrar thinks fit (but not in the Register) the particulars of the claim set out in the application.

Amendment and cancellation

119. The regulations may provide for the amendment and cancellation of particulars recorded under this Division.

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PART 12—INFRINGEMENT OF TRADE MARKS

When is a registered trade mark infringed?

- 5 **120.(1)** A person infringes a registered trade mark if the person uses as a trade mark 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.

Note 1: For *registered trade mark* see section 6.

Note 2: For *deceptively similar* see section 10.

- 10 **(2)** A person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:

- (a) goods of the same description as that of goods (*registered goods*) in respect of which the trade mark is registered; or
 (b) services that are closely related to registered goods; or
15 (c) services of the same description as that of services (*registered services*) in respect of which the trade mark is registered; or
 (d) goods that are closely related to registered services.

- 20 However, the person is not taken to have infringed the trade mark if the person establishes that using the sign as the person did is not likely to deceive or cause confusion.

Note 1: For *registered trade mark* see section 6.

Note 2: For *deceptively similar* see section 10.

- (3)** A person infringes a registered trade mark if:
 (a) the trade mark is well known in Australia; and
25 (b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:
 (i) goods (*unrelated goods*) that are not of the same description as that of the goods in respect of which the trade mark is registered (*registered goods*) or are not closely related to
30 services in respect of which the trade mark is registered (*registered services*); or
 (ii) services (*unrelated services*) that are not of the same description as that of the registered services or are not closely related to registered goods; and
35 (c) because the trade mark is well known, the sign would be likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark; and
 (d) for that reason, the interests of the registered owner are likely to be adversely affected.

- 40 Note 1: For *registered trade mark* see section 6.

Note 2: For *deceptively similar* see section 10.

Note 3: For *well known in Australia* see subsection (4).

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(4) In deciding, for the purposes of paragraph (3)(a), whether a trade mark is *well known in Australia*, one must take account of the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or for any other reason.

Infringement of trade mark by breach of certain restrictions 5

121.(1) This section applies to a registered trade mark if the registered owner, or an authorised user of the trade mark having power to do so, has caused to be displayed on goods (*registered 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. 10

Note 1: An authorised user of the trade mark may not have power to cause notices of prohibition to be displayed on goods etc. because of the terms of the agreement between the authorised user and the registered owner of the trade mark (see section 26).

Note 2: For *registered owner* and *registered trade mark* see section 6. 15

Note 3: For *authorised user* see section 8.

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

(a) applying the trade mark to registered goods, or using the trade mark in physical relation to them, after the state, condition, get-up or packaging in which they were originally offered to the public has been altered; 20

(b) altering, or partially removing or obliterating, any representation of the trade mark applied to registered goods or used in physical relation to them;

(c) if the trade mark has been applied to registered goods, or used in physical relation to them, together with other matter indicating that the registered owner or authorised 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; 25 30

(d) applying another trade mark to registered goods or using another trade mark in physical relation to them;

(e) if the trade mark has been applied to registered goods or used in physical 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. 35

Note 1: For *applied to* see section 9.

Note 2: For *authorised user* see section 8.

(3) Subject to subsection (4), a person infringes a trade mark to which this section applies if the person: 40

(a) is the owner of registered goods; and

(b) in the course of trade, or with a view to a dealing with the goods in the course of trade:

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- (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:

- 5 (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?

10 **122.(1)** In spite of section 120, 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
 - 15 (ii) the name of a predecessor in business of the person 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
 - 20 (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 goods (in particular as accessories or spare parts) or services; or
- 25 (d) the person uses the trade mark 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
- 30 (f) the court is of the opinion that the person would obtain registration of the trade mark in his or her name if the person were to apply for it; or
- 35 (g) the person, in using a sign referred to in subsection 120(1), (2) or (3) in a manner referred to in that subsection, does not (because of a condition or limitation subject to which the trade mark is registered) infringe the exclusive right of the registered owner to use the trade mark.

40 (2) In spite of section 120, 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.

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Goods etc. to which registered trade mark has been applied by or with consent of registered owner

123.(1) In spite of section 120, a person who uses a registered trade mark in relation to goods that are similar to goods in respect of which the trade mark is registered does not infringe the trade mark if the trade mark has been applied to, or in relation to, the goods by, or with the consent of, the registered owner of the trade mark. 5

Note: For *similar goods* see subsection 14(1).

(2) In spite of section 120, a person who uses a registered trade mark in relation to services that are similar to services in respect of which the trade mark is registered does not infringe the trade mark if the trade mark has been applied in relation to the services by, or with the consent of, the registered owner of the trade mark. 10

Note: For *similar services* see subsection 14(2).

Prior use of identical trade mark etc. 15

124.(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 in relation to:

- (a) goods similar to goods (*registered goods*) in respect of which the trade mark is registered; or 20
- (b) services closely related to registered goods; or
- (c) services similar to services (*registered services*) in respect of which the trade mark is registered; or
- (d) goods closely related to registered services;

if the person, or the person and the person's predecessor in title, have continuously used in the course of trade the unregistered trade mark in relation to those goods or services from a time before: 25

- (e) the date of registration of the registered trade mark; or
- (f) the registered owner of the registered trade mark, or a predecessor in title, or a person who was a registered user of the trade mark under the repealed Act, first used the trade mark; 30

whichever is earlier.

Note 1: For *deceptively similar* see section 10.

Note 2: For *predecessor in title* and *date of registration* see section 6.

(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. 35

What courts may hear action for infringement of registered trade mark

125.(1) An action for an infringement of a registered trade mark may be brought in a prescribed court. 40

Note: For *prescribed court* see section 190.

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(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.

What relief can be obtained from court

5 **126.** 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
- 10 (b) at the option of the plaintiff but subject to section 127, damages or an account of profits.

Special case—plaintiff not entitled to damages etc.

127. If:

- 15 (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
- 20 (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
- 20 (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;
- 25 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.

Circumstances in which action may not be brought

128. If the registration of a trade mark is renewed (under section 79) within 12 months after it has expired, an action may not be brought in respect of an act that:

- 30 (a) infringed the trade mark; and
- 30 (b) was done after the registration had expired and before it was renewed.

Groundless threats of legal proceedings

35 **129.(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;

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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*).

Note: For *prescribed court* see section 190.

- (2) The purpose of the action is to obtain from the court: 5
 - (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. 10

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

Note: For *authorised user* see section 8.

(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 threatened person in respect of which the defendant threatened to bring an action constitute an infringement of the trade mark. 20

(5) An action may not be brought, or (if brought) may not proceed, under this section if the registered owner of the trade mark, or an authorised user of the trade mark having power to bring an action for infringement of the trade mark, with due diligence, begins and pursues an action against the threatened person for infringement of the trade mark. 25

Note: An authorised user of the trade mark may not have power to bring an action for infringement of the trade mark because of the terms of the agreement between the authorised user and the registered owner of the trade mark (see section 26).

(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. 30

Note: For *lawyer* and *patent attorney* see section 6.

Counterclaim by defendant in action on groundless threats

130. If the defendant in an action brought under section 129 would be entitled to bring against the plaintiff an action for infringement of the registered trade mark (*infringement action*): 35

- (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. 40

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**PART 13—IMPORTATION OF GOODS INFRINGING
AUSTRALIAN TRADE MARKS**

Object of Part

5 **131.** 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

10 **132.(1)** The registered owner of a registered trade mark may give to the Comptroller a notice in writing objecting to the importation after the date of the notice of goods that infringe the trade mark. The notice is to be given together with any prescribed document.

(2) If:

15 (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;
an authorised user of the trade mark having power to give a notice under subsection (1) may ask the registered owner to give such a notice in respect of the trade mark.

20 Note 1: For *authorised user* see section 8.

Note 2: An authorised user of the trade mark may not have power to give a notice under subsection (1) because of the terms of the agreement between the authorised user and the registered owner of the trade mark (see section 26).

25 **(3)** If the registered owner does not comply with the request within the prescribed period, the authorised user may give the notice to the Comptroller. The authorised user must give also to the Comptroller, together with the notice:

(a) any document prescribed for the purposes of subsection (1); and

(b) any other prescribed document.

30 **(4)** A notice given by the registered owner of a trade mark remains in force for 2 years from the day on which the notice is given unless it is revoked, before the end of that period, by notice in writing given to the Comptroller by the person who is then the registered owner of the trade mark.

35 **(5)** A notice given by an authorised 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 authorised user has power to revoke the notice—by the authorised user; or

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- (b) in any other case—by the person who is then the registered owner of the trade mark.

Note 1: For *authorised user* see section 8.

Note 2: An authorised user of a trade mark may not have power to revoke the notice because of the terms of the agreement between the authorised user and the registered owner of the trade mark (see section 26).

5

Comptroller may seize goods infringing trade mark

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

- (a) are imported into Australia; and 10
(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 or in relation to them a sign that, in the opinion of the Comptroller, is substantially identical with, or deceptively similar to, a notified trade mark; and 15

(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. 20

Note 1: For *applied to or in relation to goods* see section 9.

Note 2: For *deceptively similar* see section 10.

Note 3: For *notified trade mark* see section 6.

(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. 25

Note: For *objector* see section 6.

(4) Goods seized under this section must be kept in a secure place as directed by the Comptroller. 30

Notice of seizure

134. 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 133; and 35

(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 133; and 40

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- (ii) giving the full name and address of the designated owner of the goods and any information that the Comptroller has and that he or she believes, on reasonable grounds, to be likely to help the objector to identify the importer of the goods; and
- 5 (iii) stating that the goods will be released to the designated 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
- 10 after he or she has been given the notice or, if the Comptroller extends that period under subsection 137(1), within the extended period.

Note: For *designated owner, objector, seized goods* and *notified trade mark* see section 6.

Forfeiture of goods

- 15 **135.(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.

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

Note: For *designated owner, seized goods, objector* and *notified trade mark* see section 6.

Release of goods to owner—no action for infringement

- 25 **136.(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 1: For *seized goods, designated owner, objector* and *notified trade mark* see section 6.

- 30 Note 2: For *action period* see subsection (4).

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

- 35 (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

- 40 (ii) any action brought by an objector has been withdrawn.

Note 1: For *seized goods, designated owner, objector* and *notified trade mark* see section 6.

Note 2: For *action period* see subsection (4).

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(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 5
- (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 1: For *seized goods*, *designated owner*, *objector* and *notified trade mark* see section 6.

Note 2: For *action period* see subsection (4).

Note 3: In obtaining information for the purposes of this section, the Comptroller must comply with Principles 1, 2 and 3 in section 14 of the *Privacy Act 1988*.

(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 137(1); or 15
- (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 137(1) and ending at the end of the last day on which an objector may bring such an action under subsection 137(1). 20

Note: For *objector* see section 6.

Action for infringement of trade mark

137.(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 134; or 30
- (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 35
 - (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.

Note: For *objector*, *notified trade mark* and *seized goods* see section 6.

(2) The court hearing the action:

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- (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
5 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.

10 Note: For *seized goods* and *designated owner* see section 6.

- (4) If:
 - (a) the court decides that the trade mark was not infringed by the importation of the goods; and
 - (b) the designated owner of the goods, or any other defendant, satisfies
15 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
20 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 designated owner.

25 (6) If the court orders that the goods be released, the Comptroller must, subject to section 140, comply with the order.

Action for infringement by authorised user

30 **138.** If an authorised user of a notified trade mark is an objector in relation to any seized goods, the authorised user may start an action for the infringement of the trade mark in respect of the goods within the required period without first ascertaining whether the registered owner is willing to bring the action.

Note 1: For *notified trade mark*, *objector* and *seized goods* see section 6.

Note 2: For *authorised user* see section 8.

35 Note 3: Under paragraph 26(b) an authorised user of a trade mark may bring an action for infringement of the trade mark only if the registered owner of the trade mark refuses or neglects to do so.

Forfeited goods—how to be disposed of

- 139.** If:
 - (a) goods are forfeited to the Commonwealth under section 135; or
 - (b) the court orders under section 137 that goods be forfeited to the
40 Commonwealth;

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the goods are to be disposed of as the Comptroller directs.

Power of Comptroller to retain control of goods

140. 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 137; 5

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

Note: For *seized goods* see section 6.

Insufficient security 10

141. If security given under subsection 133(3) by the objector or objectors who gave notice under section 132 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: 15

- (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. 20

Note: For *objector* see section 6.

Commonwealth not liable for loss etc. suffered because of seizure

142. 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 25
- (b) because of the release of any seized goods.

Power to require information

143.(1) If:

- (a) goods that may be seized under this Part are imported into Australia; and 30
- (b) the Comptroller, relying on information received, is satisfied on reasonable grounds that the use of a trade mark applied to or in relation to those goods is fraudulent;

the Comptroller may ask the importer of the goods or an agent of the importer: 35

- (c) to produce any document in his or her possession relating to the goods; and
- (d) to give information about:

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- (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.

5 Note 1: For *applied to in relation to goods* see section 9.

Note 2: In obtaining information for the purposes of this subsection, the Comptroller must comply with Principles 1, 2 and 3 in section 14 of the *Privacy Act 1988*.

- 10 (2) If the importer or his or her agent intentionally or recklessly fails to comply with the request within the prescribed period, the importer or agent is guilty of an offence punishable, on conviction, by imprisonment for a period not exceeding 6 months.

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

Modification in relation to Norfolk Island etc.

- 15 **144.** 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.

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PART 14—OFFENCES

Falsifying etc. a registered trade mark

145.(1) A person is guilty of an offence if, intentionally or recklessly, the person falsifies or unlawfully removes a trade mark that:

- 5 (a) has been applied to any goods that are being, or are to be, dealt with or provided in the course of trade; or
- (b) has been applied in relation to any goods or services that are being, or are to be, dealt with or provided in the course of trade;
- 10 knowing that the trade mark is registered or reckless of whether or not the trade mark is registered.

Note 1: For *applied to goods* and *applied in relation to goods or services* see section 9.

Note 2: For the penalty for this offence see section 149.

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

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

without the permission of the registered owner, or an authorised 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.

20 Note 1: For *registered trade mark* and *registered owner* see section 6.

Note 2: For *authorised user* see section 8.

(3) A person unlawfully removes a registered trade mark if the person wholly removes, erases or obliterates it:

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

Note 1: For *registered trade mark* and *registered owner* see section 6.

Note 2: For *authorised user* see section 8.

30 **Falsely applying a registered trade mark**

146.(1) A person is guilty of an offence if, intentionally or recklessly, the person:

- (a) falsely applies a registered trade mark to goods that are being, or are to be, dealt with or provided in the course of trade; or
- 35 (b) falsely applies a registered trade mark in relation to goods or services that are being, or are to be, dealt with or provided in the course of trade;

knowing that the trade mark is registered or reckless of whether or not the trade mark is registered.

40 Note 1: For *registered trade mark* see section 6.

Note 2: For the penalty for this offence see section 149.

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(2) A person falsely applies a registered trade mark to goods, or in relation to goods or services if the person applies the trade mark or 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 an authorised user, of the trade mark; and 5
- (b) without being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

Note 1: For *registered trade mark* and *registered owner* see section 6.

Note 2: For *authorised user* see section 8.

10

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

147.(1) A person is guilty of an offence if the person makes a die, block, machine or instrument:

- (a) knowing that it is likely to be used for, or in the course of, committing an offence against section 145 or 146; or 15
- (b) reckless of whether or not it is likely to be used for, or in the course of, committing an offence against section 145 or 146.

(2) A person is guilty of an offence if the person draws, or programs a computer or other device to draw, a registered trade mark or part of a registered trade mark: 20

- (a) knowing that the trade mark or part of the trade mark is likely to be used for, or in the course of, committing an offence against section 145 or 146; or
- (b) reckless of whether or not the trade mark or part of a trade mark is likely to be used for, or in the course of, committing an offence against section 145 or 146. 25

(3) A person is guilty of an offence if intentionally the person has in his or her possession, or disposes of:

- (a) a die, block, machine or instrument; or 30
- (b) a computer, or other device, programmed to draw a registered trade mark or part of a registered trade mark; or
- (c) a representation of a registered trade mark or of part of a registered trade mark;

knowing that, or reckless of whether or not, the die, block, machine, instrument, computer, device or representation is likely to be used for, or in the course of, committing an offence against section 145 or 146. 35

Note 1: For *registered trade mark* see section 6.

Note 2: For the penalty for an offence under this section see section 149.

Selling etc. goods with false marks

40

148. A person is guilty of an offence if the person intentionally:

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- (a) sells goods; or
- (b) exposes goods for sale; or
- (c) has goods in his or her possession for the purpose of trade or manufacture; or
- 5 (d) imports goods into Australia for the purpose of trade or manufacture; knowing that, or reckless of whether or not:
 - (e) a falsified registered trade mark is applied to them or in relation to them; or
 - (f) a registered trade mark has been unlawfully removed from them; or
 - 10 (g) a registered trade mark is falsely applied to them or in relation to them.

Note 1: For *registered trade mark* see section 6.

Note 2: For *applied to or in relation to goods* see section 9.

Note 3: For the penalty for this offence see section 149.

15 **Penalty for offence under section 145, 146, 147 or 148**

149. A person guilty of an offence under section 145, 146, 147 or 148 is punishable on conviction by:

- (a) a fine not exceeding 500 penalty units; or
- (b) imprisonment for a period not exceeding 2 years; or
- 20 (c) by both a fine and a term of imprisonment.

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

Aiding and abetting offences

150.(1) If a person:

- 25 (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 outside Australia which, if it were done in Australia, would be an offence against this Act, the person is taken to have committed
30 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

35 **151.(1)** A person must not intentionally or recklessly 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.

Penalty: 60 penalty units.

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(2) A person must not intentionally or recklessly 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.

Penalty: 60 penalty units. 5

(3) A person must not intentionally or recklessly 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.

Penalty: 60 penalty units. 10

(4) A person must not intentionally or recklessly 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. 15

Penalty: 60 penalty units.

Note 1: For *registered trade mark* and *limitations* see section 6.

Note 2: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*). 20

(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; 25

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 in a country outside Australia; or 30
- (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 in a country outside Australia; or
- (e) the word or symbol is used in relation to goods that are to be exported to that country. 35

Note: For *use of a trade mark in relation to goods or services* see subsections 7(4) and (5).

False entries in Register etc.

152. A person must not intentionally:

- (a) make a false entry in the Register; or 40
- (b) cause a false entry to be made in the Register; or

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- (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.

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

Disobeying summons etc.

153.(1) A person:

- 10 (a) who has been summonsed to appear as a witness before the Registrar; and
(b) to whom a reasonable sum has been tendered in payment for expenses;

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

- 15 Penalty: 10 penalty units.

(2) A person:

- (a) who has been required by the Registrar to produce a document or any other thing; and
20 (b) to whom a reasonable sum has been tendered in payment for expenses;

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

Penalty: 10 penalty units.

(3) An offence under this section is an offence of strict liability.

- 25 Note 1: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Note 2: An offence is one of strict liability if a person may be found guilty of the offence just for having done, or not having done, something regardless of any intention or recklessness on his or her part.

Refusing to give evidence etc.

- 30 154.(1) A person appearing before the Registrar as a witness must not, without reasonable excuse:

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

Penalty: 10 penalty units.

(2) An offence under this section is an offence of strict liability.

- 40 Note 1: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Note 2: For what is an offence of strict liability see note 2 at the end of section 153.

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Unauthorised persons not to act in trade mark matters

155.(1) A person must not ask, or accept, any payment or other reward for:

- (a) applying for, or obtaining, on behalf of another person:
 - (i) the registration of a trade mark; or 5
 - (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: 10
 - (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 to another person about the validity of the registration of a trade mark or the infringement of a trade mark; 15

unless the person is:

- (d) a lawyer; or
- (e) a patent attorney; or
- (f) a person permanently employed by, and only by, that other person; 20
- or
- (g) a person referred to in paragraph 135(1)(h) or (i) of the repealed Act.

Penalty: 30 penalty units.

(2) An offence under this section is an offence of strict liability.

Note 1: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*). 25

Note 2: For what is an offence of strict liability see note 2 at the end of section 153.

Note 3: For *file*, *lawyer* and *patent attorney* see section 6.

Note 4: Paragraphs 135(1)(h) and (i) of the repealed Act provided as follows:

- "(h) a person who, within 1 year after the commencement of this Act, has satisfied the Registrar that, for a continuous period of 2 years immediately before 1 January 1955, he was practising as a trade marks agent in Australia; or 30
- (i) a person who:
 - (i) within 1 year after the commencement of this Act, has satisfied the Registrar that, for a continuous period of 2 years immediately before 1 January 1955, he was employed by a registered patent attorney in Australia and his duties related solely or principally to the lodging, prosecuting and opposing of applications for the registration of trade marks; and 35
 - (ii) unless the Registrar otherwise directs, has, within 1 year after the commencement of this Act or within such further time as the Registrar allows, passed the prescribed examination." 40

Subsection 135(2) of the repealed Act provided as follows:

"(2) For the purposes of paragraph (h) of the last preceding subsection, a person shall not be deemed to have practised as a trade marks agent unless the only or the principal business carried on by him was the business of lodging, prosecuting and opposing, for gain, applications for the registration of trade marks in Australia on behalf of applicants or opponents." 45

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Unregistered persons

156.(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:

- 5 (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.
Penalty: 30 penalty units.

10 **(2)** 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 patent attorney or a lawyer or a person referred to in
15 paragraph 135(1)(h) or (i) of the repealed Act.
Penalty: 30 penalty units.

Note 1: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Note 2: For *lawyer* and *patent attorney* see section 6.

20 Note 3: For the provisions of paragraphs 135(1)(h) and (i) of the repealed Act see note 4 at the end of section 155.

(3) If:

- (a) a body corporate is found guilty of an offence against this section;
 and
25 (b) a director, manager, secretary or other officer of the body corporate 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.

30 **(4)** 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.

35 **(5)** 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 155(a), (b) or (c).

(6) An offence under this section is an offence of strict liability.

Note: For what is an offence of strict liability see note 2 at the end of section 153.

False representation about Trade Marks Office

40 **157.(1)** A person:

- (a) must not:

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- (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; 5
- 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. 10

Penalty: 30 penalty units.

(2) An offence under this section is an offence of strict liability.

Note 1: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*). 15

Note 2: For what is an offence of strict liability see note 2 at the end of section 153.

Trade marks officer not to prepare documents etc.

158.(1) A trade marks officer 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; 20

unless required or authorised to do so by this Act, or any other Act (including the regulations under that Act), a written direction of the Registrar or an order of a court.

Penalty: 10 penalty units.

(2) An offence under this section is an offence of strict liability. 25

Note 1: For *trade marks officer* see section 6.

Note 2: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Note 3: For what is an offence of strict liability see note 2 at the end of section 153.

Forfeiture orders under the *Proceeds of Crime Act 1987* 30

159. 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. 35

Conduct of directors, servants and agents

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

- (a) an offence under this Act; or
- (b) an offence under section 6, 7 or 7A or subsection 86(1) of the *Crimes Act 1914* that relates to this Act. 40

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(2) If it is necessary to prove the state of mind of a body corporate in relation to particular conduct, it is enough to show:

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

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

(4) If it is necessary to prove the state of mind of an individual in relation to particular conduct, it is enough to show:

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

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

(6) If:

- 25 (a) an individual is convicted of an offence under this Act; and
 - (b) the individual would not have been convicted of the offence if subsections (4) and (5) had not been enacted;
- the individual is not liable to be punished by imprisonment for that offence.

(7) In this section:

director, in relation to a body that:

- 30 (a) is incorporated for a public purpose by a law of the Commonwealth, of a State or of a Territory; and
- (b) is constituted by one or more members;

means the member, or any of the members, constituting the body.

engage in conduct includes fail or refuse to engage in conduct.

35 *state of mind*, in relation to a person, includes:

- (a) the person's knowledge, intention, opinion, belief or purpose; and
- (b) the person's reasons for the intention, opinion, belief or purpose.

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PART 15—COLLECTIVE TRADE MARKS

Object of Part

161. This Part:

- (a) defines a collective trade mark; and
- 5 (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?

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

Note: For *association* see section 6.

15 **Application of Act**

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

- 20 (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
- 25 (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
- 30 (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.

- 35 **(3)** Section 41 (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

- 40 **164.** An application for the registration of a collective trade mark must be made by the association to which the mark belongs.

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Limitation on rights given by registered collective trade mark

165. 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).

5

Assignment etc. of collective trade mark

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

Infringement of collective trade mark

167. 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.

10

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PART 16—CERTIFICATION TRADE MARKS

Object of Part

168. This Part:
- (a) defines a certification trade mark; and
 - 5 (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.

10 **What is a certification trade mark?**

169. 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
 - 15 (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 or services dealt with or provided in the course of trade but not so certified.

- 20 Note: The goods or services 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

- 25 170. Subject to this Part, the provisions of this Act relating to trade marks (other than sections 8 and 26, paragraph 27(1)(b), sections 33, 34 and 41, paragraph 88(2)(d), sections 121 and 127, Part 9—Removal of trade mark from Register for non-use and Part 17—Defensive Trade Marks) apply to certification trade marks and so apply as if a reference to a trade mark included a reference to a certification trade mark.

30 **Rights given by registration of a certification trade mark**

171. Section 20 applies in relation to a certification trade mark as if subsection (1) were omitted and the following subsection were substituted:

- 35 “(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/or services in respect of which the certification trade mark is registered. The registered owner may, however, use the certification trade mark only in accordance with the rules governing the use of the certification trade mark.

Note: For the rules governing the use of the certification trade mark see section 173.”

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Rights of persons allowed to use certification trade mark

172. When the registered owner of a registered 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. 5

Note 1: For *registered owner* see section 6.

Note 2: For the rules governing the use of the certification trade mark see section 173.

Rules governing the use of certification trade marks 10

173.(1) A person who has filed an application for the registration of a certification trade mark must, in accordance with the regulations, file a copy of the rules governing the use of the certification trade mark. The copy of the rules is to be filed in addition to any document prescribed under subsection 27(2). 15

Note: For *file* see section 6.

(2) The rules are to include provisions regarding:

(a) the persons (*approved certifiers*) who may be approved for the purpose of certifying goods and/or services; and

(b) the cases in which goods or services are to be certified; and 20

(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: 25

(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 172. 30

Registrar to reject application or send it to Commission

174.(1) If, after examining the application, 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 send to the Commission a copy of the application and of any prescribed document. 35

(2) If the Registrar is not satisfied as set out in paragraph (1)(b), he or she must:

(a) reject the application; and

(b) give notice of the decision to the applicant. 40

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

Certificate by Commission

5 **175.(1)** The Commission must consider the application and any documents received under section 174 in accordance with the regulations.

(2) If the Commission is satisfied that:

(a) the applicant or the approved certifiers are competent to certify the goods and/or services in respect of which the certification trade mark is to be registered; and

10 (b) the rules referred to in section 173:

(i) would not be to the detriment of the public; and

(ii) are satisfactory having regard to the criteria prescribed for the purposes of this paragraph;

15 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.

Note 1: For *applicant* see section 6.

Note 2: For *approved certifiers* see paragraph 173(2)(a).

20 (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 applicant and the Registrar, in writing, of its decision not to give a certificate; and

25 (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 refusing to give a certificate.

Acceptance of application

30 **176.(1)** If the Commission has given a certificate under subsection 175(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.

Note: For *limitations* see section 6.

35 (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*.

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Additional ground for rejecting an application or opposing registration—certification trade mark not distinguishing certified goods or services

177.(1) In addition to any other ground on which:

(a) an application for the registration of a certification trade mark may be rejected; or 5

(b) the registration of a certification trade mark may be opposed; the application must be rejected or the registration may be opposed 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. 10

Note 1: For *applicant* see section 6.

Note 2: For *approved certifier* see paragraph 173(2)(a).

Note 3: Division 2 of Part 4 sets out the grounds for rejecting an application, but section 41 does not apply to certification trade marks (see section 170).

(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: 15

(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 those goods or services. 20

Variation of rules

178.(1) Subject to subsection (2), the rules governing the use of a registered certification trade mark may be varied in accordance with the regulations. 25

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

(3) Before deciding to approve a variation, the Commission must be satisfied that the rules as varied:

(a) would not be to the detriment of the public; and 30

(b) are satisfactory having regard to the criteria prescribed for the purposes of paragraph 175(2)(b).

(4) The Commission must notify the registered owner of the certification trade mark and the Registrar, in writing, of its decision to approve or not to approve a variation of the rules and the Registrar must cause a notice of the decision and (if applicable) of any variation of the rules to be advertised in the *Official Journal* in accordance with the regulations. 35

Note: For *registered owner* see section 6.

(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. 40

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(6) If the Commission approves a variation of the rules, the Commission:

- (a) must certify in writing that it is satisfied of the matters referred to in subsection (3) and send a copy of the certificate to the Registrar; and
- 5 (b) must also send a certified copy of the rules as varied to the Registrar.

Rules to be available for inspection

179. 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.

10 Note: For provisions regarding the inspection of the Register see section 209.

Assignment of registered certification trade mark

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

15 (2) An application to the Commission for its consent to the assignment of a registered certification trade mark must be in accordance with the regulations.

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

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

Rectification of the Register by order of court

181.(1) Section 88 applies in relation to a certification trade mark as if "or under section 177" was added at the end of paragraph (2)(a).

25 Note: Paragraph 88(2)(a) provides that an application to a prescribed court for the rectification of the Register may be made on "any of the grounds on which the registration of the trade mark could have been opposed under Division 2 of Part 5". Section 177 provides an additional ground on which the registration of a certification trade mark may be opposed.

30 (2) In addition to its powers under Division 2 of Part 8 (as affected by subsection (1)) 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:

- 35 (a) the registered owner or an approved certifier is no longer competent to certify any of the goods and/or services in respect of which the mark is registered; or
- (b) the rules governing the use of the certification trade mark are detrimental to the public; or

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- (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 *prescribed court* see section 190.

Note 2: For *approved certifier* see paragraph 173(2)(a).

Note 3: For *approved user* see section 172.

5

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

(4) Except for cases in which the court directs the Registrar to appear, the Registrar may appear before the court and be heard at his or her discretion. 10

(5) Except for cases in which the court directs the Commission to appear, a delegate of the Commission may appear before the court and be heard at his or her discretion.

(6) 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. 15

Variation of rules by order of court

182.(1) A prescribed court may, on the application of a person aggrieved, make such orders as it thinks fit for varying the rules governing the use of a certification trade mark. 20

Note: For *prescribed court* see section 190.

(2) Notice of an application to the prescribed court must be given to the Commission.

(3) Except for cases in which the court directs the Commission to appear, a delegate of the Commission may appear before the court and be heard at his or her discretion. 25

(4) A copy of any order made by the court under this section must be given to the Commission.

(5) If the court orders that the rules are to be varied, the registered owner of the certification trade mark must give to the Registrar a copy of the rules as varied that is certified by the Commission to be a true copy. 30

Delegation of Commission's powers and functions

183. The Commission may, by resolution, delegate all or any of its powers and functions under this Part to a member of the Commission.

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

35

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PART 17—DEFENSIVE TRADE MARKS

Object of Part

184. This Part:

- 5 (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

- 10 **185.(1)** If, because of the extent to which a registered trade mark has been used 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,
- 15 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.

Note: For *registered trade mark* and *registered owner* see section 6.

- (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 use or
- 20 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 otherwise than as a defensive trade mark in the name of the applicant in respect of those goods or services.

- 25 (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

- 30 **186.** Subject to this Part, the provisions of this Act (other than subsection 20(1), paragraph 27(1)(b), sections 41 and 59, paragraph 88(2)(d), sections 121 and 127, Part 9—Removal of trade mark from Register for non-use and Part 16—Certification Trade Marks) apply to defensive trade marks and so apply as if a reference to a trade mark included a reference to a defensive
- 35 trade mark.

Additional grounds for rejecting application for registration or opposing registration

187. In addition to any other ground on which:

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- (a) an application for the registration of a trade mark as a defensive trade mark may be rejected; or
 - (b) the registration of a trade mark as a defensive trade mark may be opposed;
- the application must be rejected or the registration may be opposed: 5
- (c) if the trade mark is not registered as a trade mark in the name of the applicant; or
 - (d) 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. 10
- Note: Division 2 of Part 4 sets out the grounds for rejecting an application but section 41 does not apply to defensive trade marks (see section 186). Division 2 of Part 5 sets out the grounds for opposing registration. 15

Amendment or cancellation of registration by order of court

188. Section 88 applies in relation to a defensive trade mark as if “or under section 187” were added at the end of paragraph (2)(a).

Note: Paragraph 88(2)(a) provides that an application to a prescribed court for the rectification of the Register may be made on “any of the grounds on which the registration of the trade mark could have been opposed under Division 2 of Part 5”. Section 187 provides additional grounds on which the registration of a trade mark as a defensive trade mark may be opposed. 20

Cancellation of registration by Registrar

189. 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. 25

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PART 18—JURISDICTION AND POWERS OF COURTS

Prescribed courts

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

- 5 (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.

10 Jurisdiction of the Federal Court

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

- 15 (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

- 20 **192.(1)** Each prescribed court (other than the Federal Court) has jurisdiction with respect to matters in respect of which an action or proceeding may, under this Act, be started in a prescribed court.

Note: For *prescribed court* see section 190.

- 25 (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 129; or
- 30 (c) a matter arising under this Act that may be heard and determined in the course of such an action.

(3) In any other case, the jurisdiction is conferred only in relation to an action or proceeding brought by a natural person who is resident in the Territory, or a corporation that has its principal place of business in the Territory, when the action or proceeding is started.

35 Exercise of jurisdiction

193. The jurisdiction of a prescribed court under section 191 or 192 is to be exercised by a single judge.

Note: For *prescribed court* see section 190.

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Transfer of proceedings

194.(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.

5

Note: For *prescribed court* see section 190.

(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

10

(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

15

195.(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 12.

20

Note: For *prescribed court* see section 190.

(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).

25

(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

196. 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.

30

Powers of Federal Court

197. 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;

35

(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;

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- (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.

5 **Practice and procedure of prescribed courts**

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

- 10 (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.

Note: For *prescribed court* see section 190.

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PART 19—ADMINISTRATION

Trade Marks Office and sub-offices

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

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

Seal of Trade Marks Office

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

Registrar of Trade Marks

10 **201.(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

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

- 15 (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 brought before the Registrar; and
20 (e) notify, as he or she considers fit, any person of any matter that, in his or her opinion, should be brought to the person's notice.

Note: For the awarding of costs see section 221.

Exercise of power by Registrar

25 **203.** 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.

Registrar to act as soon as practicable

204. If:

- 30 (a) the Registrar is required under this Act to do any act or thing; and
 (b) no time or period is provided within which the act or thing is to be done;

the Registrar is to do the act or thing as soon as practicable.

Deputy Registrar of Trade Marks

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

35 **(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 206.

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(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

(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. 10

Delegation of Registrar's powers and functions

206.(1) The Registrar may by signed instrument delegate all or any of his or her powers or functions to: 15

- (a) a prescribed person, or persons included in a prescribed class, holding or performing the duties of an Australian Public Service office in the Trade Marks Office; or
- (b) a prescribed employee, or employees included in a prescribed class, employed in the Trade Marks Office. 20

Note 1: For *employee* see section 6.

Note 2: See section 34AB of the *Acts Interpretation Act 1901* about 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: 25

- (a) the Registrar; or
- (b) a person specified in the instrument, being a person referred to in paragraph (1)(a) or (b).

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PART 20—THE REGISTER AND OFFICIAL DOCUMENTS

The Register

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

- 5 (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, with the exception of particulars and other matters relating to registered users of trade marks; and
- 10

Note 1: For *old register* see section 6.

Note 2: See subsection (3) for entries relating to associated trade marks.

- (b) particulars of trade marks, certification trade marks, collective trade marks and defensive trade marks, and all other matters, that are required to be registered under this Act; and
- 15
- (c) other prescribed matters.

(3) 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.

20 Note: For *old register* see section 6.

(4) All particulars entered in the Register under paragraph (2)(a) are taken to have been so entered on 1 January 1996.

Register may be kept on computer

25 **208.(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

30 **209.(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.

35

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Evidence—the Register

210.(1) The Register is *prima facie* evidence of any particular or other matter entered in it.

Note: See section 116 about records of claims to interests and rights made under Part 11.

(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. 5

(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. 10

Evidence—certified copies of documents

211.(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 15
- (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; 20

is *prima facie* 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. 25

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PART 21—MISCELLANEOUS

Division 1—Applications and other documents

Making and signing applications etc.

5 **212.** 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 permanently employed by, and only by, that person; or
- 10 (d) a person referred to in paragraph 135(1)(h) or (i) of the repealed Act.

Note 1: For *lawyer* and *patent attorney* see section 6.

Note 2: Paragraphs 135(1)(h) and (i) of the repealed Act provided as follows:

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

- (i) a person who:
 - (i) within 1 year after the commencement of this Act, has satisfied the Registrar that, for a continuous period of 2 years immediately before 1 January 1955, he was employed by a registered patent attorney in Australia and his duties related solely or principally to the lodging, prosecuting and opposing of applications for the registration of trade marks; and
 - 20 (ii) unless the Registrar otherwise directs, has, within 1 year after the commencement of this Act or within such further time as the Registrar allows, passed the prescribed examination.”.

25 Subsection 135(2) of the repealed Act provided as follows:

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

30 **Filing of documents**

213.(1) A document is taken to be filed at the Trade Marks Office if it is filed at a sub-office of the Trade Marks Office.

(2) A document may be filed at the Trade Marks Office or any of its sub-offices by being delivered there:

- 35 (a) personally; or
- (b) by post; or
- (c) by any prescribed means.

Withdrawal of application etc.

40 **214.(1)** 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.

(2) If:

- (a) the right or interest on which the person relied to file the application, notice or request has become vested in another person; and

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- (b) the other person notifies the Registrar in writing that the right or interest is vested in him or her;

the other person may withdraw the application, notice or request as provided in subsection (1).

Note: For *file* see section 6.

5

Address for service

215.(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 subsequently notifies in writing another address to the Registrar—that other address. 10

Note: For *file* see section 6.

(2) When:

- (a) a trade mark is registered; or
 (b) a claim to an interest in, or to a right in respect of, a registered trade mark that a person has is recorded in the Register; 15

the Registrar must enter in the Register as the address for service of the registered owner or of the person:

- (c) if paragraph (d) does not apply—the address given, or last given, by the registered owner or the person to the Registrar under subsection (1); or 20
 (d) if, before the Registrar registers the trade mark or records the claim to the interest or right, the registered owner or person gives in writing to the Registrar another address as his or her address for service—that other address. 25

Note: For *registered trade mark* and *registered owner* see section 6.

(3) The registered owner of a registered trade mark, or any person whose claim to an interest in, or to a right in respect of, 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 amend the Register accordingly. 30

(4) The address for service of:

- (a) the registered owner of a registered trade mark; or
 (b) a person whose claim to an interest in, or to a right in respect of, a trade mark is recorded in the Register;

is the address set out from time to time in the Register as being the address for service of the registered owner or of the person. 35

(5) An address for service must be an address in Australia.

(6) If this Act provides that a document is to be served on, or given or sent to, a person:

- (a) the document may be left at, or sent by post to, the address for service of the person; or 40

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- (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.

5 (7) Subsection (6) does not affect the operation of section 28A of the *Acts Interpretation Act 1901*.

Note: Section 28A of the *Acts Interpretation Act 1901* provides that a document may be served (this term includes given, or sent, to):

- 10 “(a) on a natural person:
 - (i) by delivering it to the person personally; or
 - (ii) by leaving it at, or by sending it by pre-paid post to, the address of the place of residence or business of the person last known to the person serving the document; or
- (b) on a body corporate—by leaving it at, or sending it by pre-paid post to, the head office, a registered office or a principal office of the body corporate.”

15 **Change of name**

216.(1) If there is a change in the name of a person who has filed an application, notice or request, the person must notify the Registrar in writing of the change.

Note: For *file* see section 6.

- 20 (2) If there is a change in the name of:
 - (a) the registered owner of a registered trade mark; or
 - (b) a person whose claim to an interest in, or to a right in respect of, a trade mark is recorded in the Register;
- the registered owner or the person must notify the Registrar in writing of the change and the Registrar must amend the Register accordingly.

25

Death of applicant etc.

217.(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.

30 Note: For *applicant* see section 6.

- (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.

35

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Division 2—Proceedings before the Registrar or a court

Description of registered trade mark

218. 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. 5

Evidence of trade usage

219. 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 10

220. 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 15
- (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

221.(1) The Registrar may award costs in respect of the matters, and in the amounts, provided for in the regulations against any party to proceedings brought before him or her. 20

(2) A party desiring to obtain costs must apply to the Registrar in accordance with the regulations.

(3) 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. 25

Security for costs

222. If a person who neither resides nor carries on business in Australia:

- (a) gives notice of opposition under this Act; or 30
- (b) applies to the Registrar under Part 9 for a trade mark to be removed from the Register;

the Registrar may require the person to give security for the costs of the proceeding and may, if security is not given, dismiss the proceeding.

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Division 3—General

Fees

5 **223.**(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 is 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.

10 (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,
15 in spite of the failure to pay the fee.

Note: For *file* see section 6.

 (5) If the Registrar, the Commission or the Comptroller notifies the person concerned or his or her agent, in accordance with the regulations, that the fee has not been paid, the act is not taken to have been done, or the
20 document is not taken to have been filed, before the day on which the fee is paid.

Extension of time

25 **224.**(1) If, because of an error or omission by a trade marks officer, a relevant act that is required by this Act 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.

Note: For *trade marks officer* see section 6.

 (2) If, because of:

30 (a) an error or omission by the person concerned or by his or her agent;
 or

 (b) circumstances beyond the control of the person concerned;
a relevant act that is required by this Act 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
35 time for doing the act.

 (3) If:

40 (a) a relevant act that a person is required by this Act 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;

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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 under subsection (2) or (3) for an extension of time for more than 3 months, the Registrar must advertise the application in the *Official Journal*. 5

(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. 10

(8) 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); or 15
- (c) any proceedings (other than court proceedings).

Convention countries

225.(1) The regulations may declare a foreign country to be a Convention country for the purposes of this Act.

(2) If: 20

- (a) the regulations declare that, under the terms of a treaty subsisting between 2 or more Convention countries, an application made for the registration of a trade mark in one of those countries is equivalent to an application made in another of those countries; and
- (b) an application for the registration of a trade mark is made in one of those Convention countries; 25

then, for the purposes of this Act, an application for the registration of the trade mark is taken to have also been made in the other Convention country or in each of the other Convention countries (as the case may be).

(3) If: 30

- (a) the regulations declare that, under the law of a Convention country, an application for the registration of a trade mark made in another country is equivalent to an application made in the Convention country; and
- (b) an application for the registration of a trade mark is made in that other country; 35

then, for the purposes of this Act, an application for the registration of the trade mark is taken to have also been made in the Convention country.

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Publication of Official Journal etc.

226.(1) The Registrar must issue at regular intervals, as determined by the Registrar, an *Official Journal of Trade Marks* containing:

- 5 (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*.

- 10 (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

227.(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:

- 15 (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
20 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:

- 25 *decision* has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

Use of trade mark for export trade

228.(1) If:

- 30 (a) a trade mark is applied in Australia:
(i) to, or in relation to goods that are to be exported from Australia (*export goods*); or
(ii) in relation to services that are to be exported from Australia (*export services*); or
35 (b) any other act is done in Australia to export goods or export services which, if done in relation to goods or services to be dealt with or provided 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 or export services.

40 Note: For *applied to or in relation to goods* and *applied in relation to services* see section 9.

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(2) Subsection (1) applies to an act done before 1 January 1996 as it applies to an act done on or after that day, but it does not affect:

- (a) a decision of a court made before that day; or
- (b) the determination of an appeal from such a decision.

Rights etc. of patent attorney 5

229.(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: 10

- (a) to prepare a document that is to be issued from or filed in a court; or
- (b) to transact business or to conduct proceedings in a court.

Note: For *patent attorney* see section 6.

Passing off actions

230.(1) Except as provided in subsection (2), this Act does not affect the law relating to passing off. 15

(2) 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 owner or an authorised user; and
- (b) that is substantially identical with, or deceptively similar to, the trade mark of the plaintiff; 20

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 25
- (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. 30

Note 1: For *authorised user* see section 8.

Note 2: For *deceptively similar* see section 10.

Regulations

231.(1) The Governor-General may make regulations:

- (a) prescribing matters required or permitted by this Act to be prescribed; or 35
- (b) prescribing matters necessary or convenient to be prescribed for carrying out or giving effect to this Act; or

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- (c) prescribing matters necessary or convenient to be prescribed for the conduct of any business relating to the Trade Marks Office or a sub-office of the Trade Marks Office.
- (2) Without limiting subsection (1), the regulations may:
- 5 (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
- Note: For *file* see section 6.
- 10 (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
- 15 of a fee paid under this Act; 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) provide for the expenses and allowances to be paid to witnesses or persons attending at proceedings before the Registrar; and
- 20 (g) 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 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
- 25 (iii) to refund to the applicant any amount given as security and not applied in settling costs awarded against the applicant; and
- (h) 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
- (i) prescribe as penalties for offences against the regulations fines not
- 30 exceeding 10 penalty units; and
- (j) make transitional or consequential provision as necessary or convenient because of the repeal of the repealed Act and the enactment of this Act; and
- (k) provide for regulations made under the repealed Act to continue to
- 35 have effect (with any prescribed alterations) for specified purposes of this Act.

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PART 22—REPEAL AND TRANSITIONAL

Division 1—Repeal

Repeal

232. The *Trade Marks Act 1955* is repealed.

5 ***Division 2—Marks registered under the repealed Act***

Automatic registration under this Act

233.(1) All trade marks that, immediately before 1 January 1996, 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.

10 Note: For *old register* and *registered trade mark* see section 6.

(2) All trade marks that, immediately before 1 January 1996, were registered as certification trade marks in Part C of the old register are registered certification trade marks for the purposes of this Act.

15 (3) All trade marks that, immediately before 1 January 1996, 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.

Registration conclusive after 7 years

234.(1) This section applies in relation to:

- (a) a registered trade mark that:
- 20 (i) immediately before 1 January 1996, was registered in Part A of the old register; and
- (ii) has not at any time on or after that day ceased to be registered; and
- (b) a registered trade mark:
- 25 (i) whose application for registration in Part A of the old register had been accepted under the repealed Act and was still pending immediately before 1 January 1996; and
- (ii) that has not at any time on or after that day ceased to be registered.

30 Note 1: For *registered trade mark* and *old register* see section 6.

Note 2: For *pending* see subsection 11(2).

(2) In any legal proceedings:

- (a) the original registration under the repealed Act of a trade mark referred to in paragraph (1)(a); or
- 35 (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:

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- (c) the original registration was obtained by fraud; or
- (d) the registration of the trade mark would be contrary to section 28 of the repealed Act; or
- (e) the trade mark did not, at the commencement of the proceedings, distinguish 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. 5

Note 1: For *date of registration* see section 6.

Note 2: Section 28 of the repealed Act provided as follows:

- "28. A mark: 10
 - (a) the use of which would be likely to deceive or cause confusion;
 - (b) the use of which would be contrary to law;
 - (c) which comprises or contains scandalous matter; or
 - (d) which would otherwise be not entitled to protection in a court of justice;
- shall not be registered as a trade mark." 15

Term of registration

235. 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.

Note: For *existing registered mark* see section 6. 20

Renewal

236.(1) Division 2 of Part 7 applies in relation to the renewal of the registration of an existing registered mark.

(2) If, before 1 January 1996, the Registrar had (under section 69 of the repealed Act) renewed for a period of 14 years the registration of a trade mark that was due to expire on or after that day: 25

- (a) that renewal has no effect for the purposes of this Act; and
- (b) the Registrar must renew the registration of the trade mark for a period of 10 years from the day on which the registration would expire if it were not renewed. 30

Restoration of particulars to Register and renewal of registration where registration expired within 12 months before 1 January 1996

237.(1) This section applies if the registration of a trade mark under the repealed Act had expired within 12 months before 1 January 1996.

- (2)** The Registrar must: 35
 - (a) 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 (because the trade mark had not been renewed) are restored to the Register; and
 - (b) enter those particulars in the Register. 40

Note: For *old register* see section 6.

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5 (3) If an application for the renewal of the registration of the trade mark is made under this Act within 12 months from the day on which the registration expired, the Registrar must renew the registration of the trade mark for the period beginning on 1 January 1996 that, together with the period during which the trade mark remained unregistered under the repealed Act, equals 10 years.

(4) If the registration of the trade mark is not renewed under subsection (3), the Registrar must remove the trade mark from the Register 12 months after the day on which the registration expired.

10 **Disclaimers**

15 238. If the particulars entered in the Register under paragraph 207(2)(a) in respect of an existing registered mark include particulars of a disclaimer made (under section 32 of the repealed Act) by the registered proprietor of the mark about the exclusive right to use a specified part of the mark, that disclaimer has effect as if it were a disclaimer made under section 74 of this Act.

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

Rules governing the use of certification trade marks registered in Part C of the old register

20 239. Any rules that, immediately before 1 January 1996, were governing the use of a trade mark then registered as a certification trade mark in Part C of the old register:

- (a) apply in relation to the use of the certification trade mark on or after that day as if they were rules made in accordance with this Act; and
- 25 (b) may be varied under section 178.

Note: For *old register* see section 6.

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Division 3—Matters pending immediately before repeal of repealed Act

Applications, notices etc.—general

240.(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 1 January 1996;
is to be dealt with in accordance with this Act.

Note: For *pending* see subsection 11(2).

(2) The application, notice or request is taken to have been filed in
accordance with this Act.

Note: For *file* see section 6.

Application for registration of trade mark

241.(1) This section applies if an application for the registration of a
trade mark in Part A or B of the old register was pending immediately before
1 January 1996.

Note 1: For *old register* see section 6.

Note 2: For *pending* see subsection 11(2).

(2) If the application had been accepted under the repealed Act and the
acceptance was in force immediately before 1 January 1996, the following
provisions apply:

(a) subject to subsection (4), the repealed Act (other than paragraph
45(1)(b)) continues to apply in relation to the application;

(b) if, after dealing with the application in accordance with the repealed
Act, the Registrar is required under section 53 of that Act to register
the trade mark in the old register—the Registrar is to register the
trade mark under Part 7 of this Act.

Note: Subsection 45(1) of the repealed Act provided as follows:

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

(a) ...

(b) if an application has been made for the registration of a person as a registered user of the
trade mark and the Registrar is satisfied that the proprietor intends the trade mark to be
used by that person in relation to those goods or services and is also satisfied that that
person will be registered as a registered user of the trade mark immediately after
registration of the trade mark."

(3) If, immediately before 1 January 1996, the application had not been
accepted, the following provisions apply:

(a) subject to subsection 240(2) and subsection (5) of this section, the
application is to be dealt with in accordance with this Act;

(b) if:

(i) there is no opposition to the registration; or

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- (ii) there is an opposition to the registration but 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;

5 Part 7 is to apply in relation to the registration of the trade mark.

(4) If, when dealing with the application under the repealed Act as provided by paragraph (2)(a), the Registrar withdraws the acceptance of the application under subsection 44(3) of that Act, the following provisions apply:

- 10 (a) subject to subsection 240(2) and subsection (5) of this section, the application is to be dealt with in accordance with this Act as if it were an application whose acceptance had been revoked under subsection 38(1);

(b) if:

- 15 (i) there is no opposition to the registration; or
- (ii) there is an opposition to the registration but 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;

20 Part 7 is to apply in relation to the registration of the trade mark.

(5) The filing date in respect of the application is:

- (a) if paragraph (b) does not apply—the day on which the application was lodged with the Trade Marks Office under the repealed Act; or
- 25 (b) if section 43 of the repealed Act applied to the application and the Registrar had made the proper direction—the day on which the application is to be taken to have been lodged with the Trade Marks Office under the repealed Act.

Divisional application in relation to pending application

30 **242.(1)** This section applies if, immediately before 1 January 1996, an application (*initial application*) for the registration of a trade mark in the old register was pending and had not been accepted.

Note 1: For *old register* see section 6.

Note 2: For *pending* see subsection 11(2).

(2) If:

- 35 (a) at any time within 6 months after 1 January 1996, the initial application is still pending; and
- (b) a part of the trade mark, by itself, may be registered as a trade mark; the applicant may, subject to subsection (4), make an application (*divisional application*) for the registration of that part as a trade mark in respect of any
- 40 or all of the goods or services specified in the initial application.

Note: For *pending* see subsection 11(1).

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- (3) If the initial application:
- (a) was amended under the repealed Act to exclude some of the goods and/or services specified in the application before its amendment; and
 - (b) is still pending at any time within one month after 1 January 1996; 5
- the applicant may, subject to subsection (4), make an application (***divisional application***) for the registration of the trade mark in respect of any or all of the goods and/or services that were excluded from the initial application.
- Note: For *pending* see subsection 11(1).
- (4) If the initial application is accepted under Part 4, a divisional 10
application may not be made after the acceptance is advertised in the *Official Journal*.

More than one application lodged on same day for registration of same trade mark

- 243.(1) If: 15
- (a) before 1 January 1996 a person made a number of applications each seeking the registration of one and the same trade mark but in respect of goods or services of different classes; and
 - (b) all the applications were lodged, or were taken under the repealed Act to have been lodged, on the same day with the Trade Marks 20
Office;
- the applications are called linked applications in this section.
- (2) This section applies if, immediately before 1 January 1996, a number of linked applications for the registration of a trade mark were pending and had not been accepted. 25
- Note: For *pending* see subsection 11(2).
- (3) If, at any time on or after 1 January 1996, there are linked applications pending, the applicant may, subject to subsection (4), apply to the Registrar to have some or all of those 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 those applications. 30
- Note: For *pending* see subsection 11(1).
- (4) If:
- (a) one of the linked applications has been accepted under Part 4; and
 - (b) the acceptance has been advertised in the *Official Journal*; 35
- that application may not be included in the application made to the Registrar under subsection (3).
- (5) If an application is made under subsection (3), the Registrar must deal with the linked applications as if they were a single application for the registration of a trade mark made on 1 January 1996. 40

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(6) The filing date for the single application taken to have been made under subsection (5) is the day on which the linked applications were lodged, or were taken to have been lodged (as the case may be), with the Trade Marks Office under the repealed Act.

5 Application for registration of trade mark whose registration has been sought in Convention country

244.(1) This section applies if:

- 10 (a) an application for the registration in Australia of a trade mark whose registration had been sought in one or more than one Convention country was made under section 109 of the repealed Act; and
- (b) immediately before 1 January 1996, the application was still pending.

Note 1: For *pending* see subsection 11(2).

Note 2: For *Convention country* see section 225.

15 (2) If:

- (a) for the purposes of the repealed Act, the Registrar had been notified that an application had been made in that Convention country or in those Convention countries for the registration of the trade mark; and
- (b) the trade mark is registered under this Act;
- 20 subsection 72(2) applies in relation to the registration as if a right of priority had been claimed under section 29 for the registration of the trade mark.

(3) If the Registrar had not, for the purposes of the repealed Act, been notified that an application had been made in that Convention country or in those Convention countries for the registration of the trade mark, the applicant must, within 6 months after 1 January 1996 but subject to subsection (5), claim a right of priority for the registration of the trade mark in accordance with section 29 in order to obtain registration from the date on which that application or the earliest of those applications was made in a Convention country.

25

30 (4) If:

- (a) the applicant claims a right of priority for the registration of the trade mark under subsection (3); and
- (b) the trade mark is registered under this Act;
- subsection 72(2) applies in relation to the registration.

35 (5) If the application is accepted under Part 4, the applicant may not claim a right of priority in accordance with section 29 after the acceptance is advertised in the *Official Journal*.

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Application for registration of a mark in Part C of the old register

245.(1) Subject to Part 16, section 241 applies to an application for the registration of a mark as a certification trade mark in Part C of the old register as if the reference in subsection (1) to Part A or B of the old register were a reference to Part C of that register. 5

(2) Subject to Part 16, sections 242 to 244 apply to an application for the registration of a mark as a certification trade mark in Part C of the old register.

Note: For *old register* see section 6.

Application for registration of a mark in Part D of the old register 10

246.(1) Subject to Part 17, section 241 applies to an application for the registration of a mark as a defensive trade mark in Part D of the old register as if the reference in subsection (1) to Part A or B of the old register were a reference to Part D of that register.

(2) Subject to Part 17, sections 242 to 244 apply to an application for the registration of a mark as a defensive trade mark in Part D of the old register. 15

Amendment of application—specification of goods or services

247.(1) This section applies if:

- (a) immediately before 1 January 1996 an application for the registration of a mark in Part A, B, C or D of the old register (other than an application made under section 39 of the repealed Act) was pending and had not been accepted; and 20
- (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. 25

Note 1: For *old register* see section 6.

Note 2: For *pending* see subsection 11(2).

(2) The applicant may, within 6 months after 1 January 1996, apply to the Registrar for the application to be again amended so as to relate to some or all of the goods or services specified in the application before its amendment under the repealed Act, if: 30

- (a) the application is still pending under this Act; and:
 - (i) it has not been accepted; or
 - (ii) if it has been accepted, the acceptance has not been advertised in the *Official Journal*; and 35
- (b) 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 included from the original application, if that Act were still in force. 40

Note: For *pending* see subsection 11(1).

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(3) If an application is amended under subsection (2), it must (if necessary) be also amended so as to be in accordance with Part 4.

Revival of application for registration of trade mark that had lapsed before 1 January 1996

5 **248.(1) If:**

- (a) an application under the repealed Act for the registration of a trade mark had lapsed (under subsection 48(1) of that Act); and
- (b) the application would have been pending immediately before 1 January 1996 if:

- 10 (i) an application had been made to the Registrar under the repealed Act for an extension of the time within which the application for registration would be accepted; and
- (ii) the Registrar had allowed an extension of that time under that Act;

15 the applicant may apply in writing to the Registrar for a declaration that the application is revived.

Note: For *pending* see subsection 11(2).

(2) The Registrar must grant the application if he or she considers, in all the circumstances of the case, that it is fair and reasonable to do so.

20 (3) If the Registrar declares that the application is revived, the application is to be dealt with as if it were an application that was pending immediately before 1 January 1996.

Note 1: For *pending* see subsection 11(2).

25 Note 2: Sections 240 to 247 make provision relating to applications for registration of trade marks that were pending immediately before 1 January 1996.

Application for registration of assignment etc.

30 **249.** If an application for the registration in the old register of the assignment or transmission of an existing registered mark was pending immediately before 1 January 1996, 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 1 January 1996.

Note: For *old register*, *existing registered mark* and *file* see section 6.

35 **Rectification of Register**

40 **250.** If proceedings arising from an application to a court under section 22 (Rectification of Register) of the repealed Act were pending immediately before 1 January 1996, 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.

Note: For *old register* see section 6.

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Action for removal of trade mark from Register for non-use

251. 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 were pending immediately before 1 January 1996, 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.

Note: For *pending* see subsection 11(2).

Action for infringement of trade mark etc.

252. Sections 62 to 67 and section 78 of the repealed Act continue to apply in relation to an action for the infringement of a trade mark that was pending immediately before 1 January 1996.

Action under this Act for infringement of trade mark under repealed Act

253. If:

- (a) before 1 January 1996 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 1 January 1996; 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. A person is not, however, entitled under this Act to any injunction or other relief to which the person would not have been entitled under the repealed Act.

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

Acts not constituting infringement of trade mark

254.(1) This section applies if:

- (a) immediately before 1 January 1996, 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, on or after that day, continuously engaged in, and is engaging in, that conduct; and
- (d) that conduct is an infringement of the existing registered mark under this Act.

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(2) In spite of section 120, the person does not infringe the existing registered mark by engaging in that conduct.

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

Application of this Act—general

5 **255.(1)** If:

(a) an action or proceeding validly brought for the purposes of the repealed Act was still pending immediately before 1 January 1996; and

10 (b) that action or proceeding could have been brought under this Act if this Act had been in force when the action or proceeding was started; then, except as otherwise provided by this Division or the regulations, this Act applies in relation to the action or proceeding as if it were an action or proceeding validly brought on 1 January 1996 under the relevant provision of this Act.

15 (2) Anything done under the repealed Act for the purposes of the action or proceeding is taken to have been done:

(a) on 1 January 1996; and

(b) in accordance with this Act.

Fees

20 **256.** 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.

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Division 4—General

The Registrar and Deputy Registrar

257. Persons holding office as Registrar of Trade Marks and Deputy Registrar of Trade Marks immediately before 1 January 1996 continue to hold those respective offices on and after that day. 5

Confidential information received by Registrar under section 74 of the repealed Act

258. If, immediately before 1 January 1996, the Registrar was required under subsection 74(7) of the repealed Act to ensure that any document, information or evidence given for the purpose of an application for the registration of a person as a registered user of a trade mark was not disclosed to any other person, the Registrar must continue to ensure that the document, information or evidence is not so disclosed except by order of a prescribed court. 10

Note: For *prescribed court* see section 190. 15

Documents kept under repealed Act

259. The Registrar is to continue to keep in accordance with this Act all documents that, immediately before 1 January 1996, were kept by the Registrar under the repealed Act.

Address for service 20

260.(1) If, immediately before 1 January 1996, 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 215. 25

Note: For *applicant* and *opponent* see section 6.

(2) If the existing address of an applicant for the registration of a trade mark or of an opponent to the registration is not an address in Australia, the applicant or opponent must give in writing to the Registrar an address in Australia as his or her address for service. 30

(3) If, immediately before 1 January 1996, the proprietor of an existing registered mark had an agent in Australia for the purposes of subsection 70(1) of the repealed Act, the address of that agent is the address for service of the registered owner of the mark for the purposes of this Act until the registered owner notifies another address to the Registrar under section 215. 35

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

(4) If:

(a) immediately before 1 January 1996, the proprietor of an existing registered mark did not have an agent in Australia for the purposes of subsection 70(1) of the repealed Act; and 40

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- (b) the address then entered in the old register as the address of the proprietor was an address in Australia;
that address is the address for service of the registered owner of the mark for the purposes of this Act until the registered owner notifies another address to the Registrar under section 215.

Note: For *existing registered mark* and *old register* see section 6.

- (5) If:
- (a) immediately before 1 January 1996, the proprietor of an existing registered mark did not have an agent in Australia for the purposes of subsection 70(1) of the repealed Act; and
- (b) the address then entered in the old register as the address of the proprietor was not an address in Australia;
that address is not to be used as the address for service of the registered owner of the mark, and the registered owner must give in writing to the Registrar an address in Australia as his or her address for service.

Note: For *existing registered mark* and *old register* see section 6.

Notices to Comptroller objecting to importation of goods

- 261.(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 1 January 1996, then, subject to subsection (2), the notice continues to have effect for the purposes of Part 13 of this Act as if it were a notice given under section 132 of this Act.

- (2) The notice ceases to have effect:
- (a) if the Comptroller is given a notice under section 132 objecting to any importation of goods infringing the trade mark; or
- (b) at the end of 3 months from 1 January 1996;
whichever first occurs.

[Minister's second reading speech made in—
Senate on 30 March 1995
House of Representatives on 27 September 1995]