**TRADE MARKS AMENDMENT ACT 1978**

**No. 130 of 1978**

An Act to amend the *Trade Marks Act* 1955.

BE IT ENACTED by the Queen, and the Senate and House of Representatives of the Commonwealth of Australia, as follows:

**Short title, &c.**

**1.** (1) This Act may be cited as the *Trade Marks Amendment Act* 1978.

(2) The *Trade Marks Act* 1955 is in this Act referred to as the Principal Act.

**Commencement**

**2.** This Act shall come into operation on a date to be fixed by Proclamation.

**Interpretation**

**3.** Section 6 of the Principal Act is amended—

(a) by inserting “or services” after “goods” in paragraph (a) of the definition of “permitted use” in sub-section (1); and

(b) by inserting “or services” after “goods” (wherever occurring) in the definition of “trade mark” in sub-section (1).

**Correction of Register**

**4.** Section 19 of the Principal Act is amended by inserting in paragraph (d) of sub-section (1) “or services” after “goods”.

**Registration of assignment**

**5.** Section 20 of the Principal Act is amended by inserting in sub-section (1) “or services” after “goods”.

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

**6.** Section 23 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods” (wherever occurring);

(b) by inserting in sub-section (2) “or services” after “goods” (first and second occurring);

(c) by omitting from sub-section (2) “in relation to goods of the same description, being goods in respect of which the trade mark is registered.” and substituting:

“in relation to goods or services in respect of which the trade mark is registered, being—

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

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

(d) by inserting after sub-section (3) the following sub-section:

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

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

(b) a person has been permitted under section 34 to register a substantially identical or deceptively similar trade mark in respect of those services under a registration extending to use in relation to services provided in that place, or the prescribed court or the Registrar is of the opinion that that person may properly be permitted to register such a trade mark,

a prescribed court or the Registrar may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions or limitations as the prescribed court or the Registrar thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to services provided in that place.”;

(e) by inserting in sub-section (4) “or (3a)” after “sub-section (3)”; and

(f) by inserting in sub-section (4) “or services” after “goods”.

**Registrable trade marks— Part A**

**7.** Section 24 of the Principal Act is amended—

(a) by inserting in paragraph (d) of sub-section (1) “or services” after “goods”;

(b) by inserting in sub-section (3) “or services” after “goods” (first occurring); and

(c) by omitting from sub-section (3) “or different goods” and substituting “goods or services or other goods or services”.

**Registrable trade marks—Part B**

**8.** Section 25 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods”;

(b) by inserting in sub-section (2) “or services” after “goods” (first occurring); and

(c) by omitting from sub-section (2) “or different goods” and substituting “goods or services or other goods or services”.

**Distinctiveness**

**9.** Section 26 of the Principal Act is amended by inserting in sub-section (1), (3) and (5) “or services” after “goods” (wherever occurring).

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

**10.** Section 31 of the Principal Act is amended by inserting “or services” after “goods” (wherever occurring).

**Identical marks**

**11.** Section 33 of the Principal Act is amended—

(a) by omitting from sub-section (1) “or of goods of the same description” and substituting “, of goods of the same description as those goods or of services that are closely related to those goods”; and

(b) by omitting sub-section (2) and inserting the following sub-sections:

“(2) Subject to this Act, a trade mark is not capable of registration by a person in respect of services if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same services, of services of the same description as those services, or of goods that are closely related to those services, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

“(3) Where, in accordance with this section, a trade mark is not capable of registration by reason of the existence of another trade mark, the Registrar may defer acceptance of the application for registration of the first-mentioned trade mark until the second-mentioned trade mark has been registered.”.

**Concurrent use**

**12.** Section 34 of the Principal Act is amended by omitting from sub-section (1) “or different goods” and substituting “goods or services or other goods or services”.

**Jointly owned trade marks**

**13.** Section 35 of the Principal Act is amended by inserting in paragraph (b) of sub-section (1) “or services” after “goods”.

**Association of trade marks**

**14.** Section 36 of the Principal Act is amended—

(a) by omitting from paragraph (a) of sub-section (1) “or goods of the same description” and substituting “, of goods of the same description as those goods or of services that are closely related to those goods”; and

(b) by inserting after sub-section (1) the following sub-section:

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

(a) is substantially identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same services, of services of the same description as those services, or of goods that are closely related to those services; or

(b) so nearly resembles such a trade mark as to be likely to deceive or cause confusion if used by a person other than the proprietor,

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

**Series of trade marks**

**15.** Section 39 of the Principal Act is amended—

(a) by omitting from sub-section (1) “goods or” and substituting “goods,”;

(b) by inserting in sub-section (1) “, for the same services or for services of the same description within a single class” after “class”; and

(c) by inserting in paragraph (a) of sub-section (1) “or services” after “goods”.

**Application for registration**

**16.** Section 40 of the Principal Act is amended by inserting in paragraph (a) of sub-section (2) and in sub-section (3) “or services” after “goods”.

**Division of application**

**17.** Section 43 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods”; and

(b) by inserting in sub-section (3) “or services” after “goods” (wherever occurring).

**Applications may be accepted where trade mark is to be used by assignee or registered user**

**18.** Section 45 of the Principal Act is amended by inserting “or services” after “goods” (wherever occurring).

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

**19.** Section 56 of the Principal Act is amended—

(a) by omitting from sub-section (1) “or substance” and substituting “, substance or service”;

(b) by omitting from paragraph (a) of sub-section (2) “or substance” (wherever occurring) and substituting “, substance or service”;

(c) by inserting in paragraph (a) of sub-section (2) “or services” after “goods” (wherever occurring);

(d) by inserting in paragraph (b) of sub-section (2) “or the service formerly provided was a patented process, as the case requires” after “patent” (first occurring);

(e) by omitting from paragraph (b) of sub-section (2) “or substance” (last occurring) and substituting “, substance or service”;

(f) by inserting in sub-section (3) “, or of the services or of any services of the same description, as the case requires” after “description”;

(g) by inserting in sub-section (4) “, or of the services or of any services of the same description” after “description” (first occurring);

(h) by inserting in sub-section (4) “or to the services or to any service of the same description, as the case may be,” after “description” (second occurring); and

(j) by inserting in sub-section (5) “, or to the service or to any services of the same description, as the case requires” after “description”.

**Rights given by registration**

**20.** Section 58 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods”; and

(b) by omitting from sub-section (3) “or different goods” and substituting “goods or services or other goods or services”.

**Limitation on removal of trade mark after three years**

**21.** Section 60 of the Principal Act is amended by inserting “or services” after “goods”.

**Registration conclusive after seven years**

**22.** Section 61 of the Principal Act is amended by inserting in paragraph (c) of sub-section (1) “or services” after “goods”.

**Infringement of trade marks**

**23.** Section 62 of the Principal Act is amended by inserting “or services” after “goods” (wherever occurring).

**Acts not constituting infringement**

**24.** Section 64 of the Principal Act is amended—

(a) by inserting in paragraphs (b), (c) and (d) of sub-section (1) “or services” after “goods” (wherever occurring); and

(b) by inserting in sub-section (2) “, in relation to services to be provided in a place” after “market”.

**Passing off actions**

**25.** Section 68 of the Principal Act is amended by inserting “or services” after “goods”.

**Registered users**

**26.** Section 74 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods”;

(b) by inserting in paragraphs (b) and (c) of sub-section (2) “or services” after “goods”; and

(c) by inserting in sub-section (3) “or services” after “goods” (wherever occurring).

**Variation, &c., of registration**

**27.** Section 75 of the Principal Act is amended by inserting in paragraph (a) “or services” after “goods”.

**Cancellation of registration**

**28.** Section 76 of the Principal Act is amended by inserting “or services” after “goods”.

**Effect of permitted user**

**29.** Section 77 of the Principal Act is amended by inserting in paragraph (c) of sub-section (2) “or services” after “goods”.

**Assignment and transmission of trade marks**

**30.** Section 82 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods” (wherever occurring);

(b) by inserting in paragraph (b) of sub-section (2) “or services” after “goods” (wherever occurring); and

(c) by inserting in sub-section (4) “or services” after “goods”.

**Certification trade marks**

**31.** Section 83 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods” (first occurring);

(b) by inserting in sub-section (1) “or services, as the case may be,” after “goods” (second occurring);

(c) by omitting from sub-section (1) “origin, material, mode of manufacture, quality, accuracy or other characteristics” and substituting “quality, accuracy, or other characteristics, including, in the case of goods, origin, material or mode of manufacture,”;

(d) by inserting in sub-section (1) “or services, as the case may be,” after “goods” (third occurring);

(e) by inserting in sub-section (1) “or services” after “goods” (last occurring);

(f) by inserting in sub-section (2) “or a trade of the provision of services of the kind certified” after “certified”; and

(g) by inserting in sub-section (3) “or services” after “goods”.

**Rights given by registration**

**32.** Section 84 of the Principal Act is amended—

(a) by inserting in sub-section (1) “or services” after “goods”;

(b) by inserting in sub-section (2) “, in relation to services to be provided in a place” after “market”;

(c) by inserting in sub-section (3) “or services” after “goods” (first occurring);

(d) by inserting in paragraph (a) of sub-section (3) “in the case of goods,” before “as”; and

(e) by inserting in sub-section (4) “or services” after “goods” (wherever occurring).

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

**33.** Section 85 of the Principal Act is amended by inserting in sub-section (2) “or services” after “goods” (wherever occurring).

**Matters to be considered before acceptance**

**34.** Section 86 of the Principal Act is amended by inserting in paragraph (a) of sub-section (1) “or services” after “goods”.

**Rectification of the register**

**35.** Section 88 of the Principal Act is amended by inserting in paragraph (a) of sub-section (1) “or services” after “goods” (wherever occurring).

**Defensive registration of well-known trade marks**

**36.** Section 93 of the Principal Act is amended—

(a) by inserting in sub-sections (1), (2) and (3) “or services” after “goods” (wherever occurring); and

(b) by omitting from sub-section (4) “in respect of different goods” and substituting “not registrations in respect of the same goods or services”.

**Rectification of Register**

**37.** Section 94 of the Principal Act is amended by inserting in sub-section (1) “or services” after “goods”.

**Forgery, &c., of trade marks**

**38.** Section 98 of the Principal Act is amended by inserting in paragraph (b) of sub-section (1) “or services” after “goods”.

**Prohibition of importation of goods bearing Australian trade marks**

**39.** Section 103 of the Principal Act is amended by omitting from sub-section (1) “or trader” and substituting “, trader or person providing a service”.

**When trade mark deemed applied**

**40.** Section 107 of the Principal Act is amended—

(a) by adding “or” at the end of paragraph (a) of sub-section (2);

(b) by omitting paragraphs (c) and (d) of sub-section (2);

(c) by inserting after sub-section (2) the following sub-section:

“(2a) A trade mark shall be deemed to be applied to goods or services if—

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

(b) it is used in—

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

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

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

(d) by inserting in sub-section (4) “or services” after “goods” (wherever occurring); and

(e) by inserting in sub-section (5) “or services” after “goods”.

**Trade mark not to be deemed to be deceptive or confusing in certain cases**

**41.** Section 118 of the Principal Act is amended by inserting “or services” after “goods” (wherever occurring).

**Adaption of classification**

**42.** Section 139 of the Principal Act is amended—

(a) by omitting from sub-section (1) “or classes of goods” and substituting “, classes of goods, services or classes of services”;

(b) by inserting in sub-section (1) “or services” after “goods” (last occurring);

(c) by omitting from sub-section (2) “or classes of goods” and substituting “, classes of goods, services or classes of services”; and

(d) by inserting in sub-section (2) “or services” after “goods” (last occurring).

**Falsely representing a trade mark as registered an offence**

**43.** Section 146 of the Principal Act is amended by inserting in paragraph (c) of sub-section (1) “or services” after “goods”.