



# Trade Marks Amendment Act 1981

No. 43 of 1981

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

[Assented to 13 May 1981]

BE IT ENACTED by the Queen, and the Senate and the 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 1981*.
- (2) The *Trade Marks Act 1955*<sup>1</sup> 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.

### References to prescribed courts

3. Section 6A of the Principal Act is amended by omitting paragraph (a) and substituting the following paragraph:

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

4. Section 67 of the Principal Act is repealed and the following section is substituted:

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

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

5. (1) Section 103 of the Principal Act is repealed and the following section is substituted:

**Importation of goods infringing Australian trade marks**

“103. (1) In this section—

‘objector’, in relation to goods imported into Australia, means—

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

‘owner’, in relation to goods imported into Australia, means the person whose name appears on the entry made in relation to the goods under section 36 of the *Customs Act* 1901 as being the owner of the goods.

“(2) References in this section to the owner of goods shall, where a notice under sub-section (7) has been given to a person who acted as agent of the owner in relation to the importation of the goods, be read as including references to the person to whom that notice was given.

“(3) Where—

- (a) goods manufactured outside Australia are imported into Australia and are, in accordance with the *Customs Act* 1901, subject to the control of the Customs;
- (b) a notice in writing objecting to the importation of goods infringing a trade mark registered in respect of goods (in this section referred to as the ‘relevant trade mark’) has been given to the Comptroller-General of Customs, after the commencement of the *Trade Marks Amendment Act* 1981 and before the importation of the goods referred to in paragraph (a), being a notice that has not been revoked, by—
  - (i) the registered proprietor of the relevant trade mark; or
  - (ii) if a registered user of the relevant trade mark satisfies the Comptroller-General that he is, by virtue of sub-section (5), entitled to give such a notice—that registered user;

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

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

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

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

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

“(7) Where goods have been seized under sub-section (3), the Comptroller-General of Customs shall, as soon as practicable after the goods were seized—

- (a) give to the owner of the goods or a person who acted as agent of the owner in relation to the importation of the goods, either personally or by post, a notice in writing identifying the goods and stating that the goods so identified have been seized under sub-section (3); and
- (b) give to the objector or to each objector, either personally or by post, a notice in writing—
  - (i) identifying the goods and stating that the goods so identified have been seized under sub-section (3); and
  - (ii) stating that the goods will be released to the owner unless an action or proceeding for infringement of the relevant trade mark in respect of the goods is instituted by an objector before the expiration of the period of one month after the giving of the notice and the objector gives notice in writing to the Comptroller-General before the expiration of that period stating that that action or proceeding has been instituted.

“(8) Where—

- (a) goods have been seized under sub-section (3);
- (b) the Comptroller-General of Customs is satisfied that, having regard to information that has come to his knowledge after the goods were so

seized, there are no reasonable grounds for believing that the importation of the goods constituted an infringement of the relevant trade mark; and

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

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

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

“(10) Where—

- (a) goods have been seized under sub-section (3);
- (b) the objector or each objector gives notice in writing to the Comptroller-General of Customs stating that that objector consents to the release of the goods; and
- (c) no action or proceeding for infringement of the relevant trade mark has been instituted by an objector in respect of the goods,

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

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

- (a) that the improper marks will be effectually removed from the goods;
- (b) that such additions will be made as will render unobjectionable any mark applied to the goods; or
- (c) that the goods will be forthwith exported.

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

- (a) instituted an action or proceeding for infringement of the relevant trade mark in respect of the goods; and
- (b) given notice in writing to the Comptroller-General stating that that action or proceeding has been instituted.

“(13) Where—

- (a) goods have been seized under sub-section (3); and

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

“(14) Where—

- (a) an action or proceeding for infringement of a trade mark has been instituted in respect of goods seized under sub-section (3); and
- (b) at any time after the expiration of 3 weeks after the date on which the action or proceeding was instituted there is not in force an order of the court in which the action or proceeding was instituted restraining the release of the goods,

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

“(15) Where—

- (a) an action or proceeding for infringement of a trade mark has been instituted in respect of goods seized under sub-section (3); and
  - (b) a person applies to the court in which the action or proceeding was instituted to be joined as a defendant to the action or proceeding,
- the court may permit that person to be joined as a defendant to the action or proceeding.

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

“(17) Where—

- (a) in an action or proceeding for infringement of a trade mark instituted by an objector in respect of goods seized under sub-section (3), a court determines that the importation of the goods did not constitute an infringement of the relevant trade mark; and
- (b) the defendant satisfies the court that he has suffered loss or damage by reason of the goods being detained,

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

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

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

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

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

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

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

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

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

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

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

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

“(27) A delegation under sub-section (25) does not prevent the exercise of a power by the Comptroller-General of Customs.”.

(2) Section 103 of the Principal Act as amended by this Act applies in relation to—

- (a) goods imported into Australia after the commencement of this Act;

- (b) goods imported into Australia before the commencement of this Act, being goods that are, in accordance with the *Customs Act* 1901, subject to the control of the Customs and—
  - (i) that had not, before the commencement of this Act, been seized under sub-section 103 (1) of the Principal Act; and
  - (ii) that were, immediately before the commencement of this Act, liable to be seized under that sub-section of the Principal Act; and
- (c) goods imported into Australia before the commencement of this Act, being goods that are, in accordance with the *Customs Act* 1901, subject to the control of the Customs and—
  - (i) that had, before the commencement of this Act, been seized under sub-section 103 (1) of the Principal Act; and
  - (ii) in relation to which no further action had, before the commencement of this Act, been taken under section 103 of the Principal Act.

(3) For the purposes of the application of section 103 of the Principal Act as amended by this Act in relation to—

- (a) goods of the kind referred to in paragraph (2) (a) that are imported into Australia before the expiration of 3 months after the commencement of this Act; and

- (b) goods of the kind referred to in paragraph (2) (b) or (c),

a notice given before the commencement of this Act by a registered proprietor of a trade mark or a registered user of a trade mark under sub-section 103 (1) of the Principal Act objecting to the importation of goods shall be deemed to be a notice properly given by that registered proprietor or that registered user, as the case may be, under paragraph 103 (3) (b) of the Principal Act as amended by this Act.

(4) Nothing in sub-section (3) affects the giving of a notice of the kind referred to in paragraph 103 (3) (b) of the Principal Act as amended by this Act by any person after the commencement of this Act.

(5) For the purposes of the application of section 103 of the Principal Act as amended by this Act in relation to goods of the kind referred to in paragraph (2) (c), those goods shall be deemed to have been seized by the Comptroller-General of Customs under sub-section 103 (3) of the Principal Act as amended by this Act and to have been so seized on the date of commencement of this Act.

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

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

6. Section 104 of the Principal Act is amended by omitting from sub-section (1) “forfeiture under the last preceding section” and substituting “be seized under section 103”.

**Jurisdiction of prescribed courts**

7. Section 112 of the Principal Act is amended—

- (a) by omitting sub-sections (1) and (2) and substituting the following sub-sections:

“(1) Subject to sub-section (2), every prescribed court has jurisdiction with respect to matters arising under this Act in respect of which actions or proceedings may, under this Act, be instituted in a prescribed court.

“(2) The jurisdiction conferred by sub-section (1) on the Supreme Court of a Territory—

- (a) to the extent that it relates to an action or proceeding for the infringement of a trade mark, an action under section 124 or a matter arising under this Act that may be heard and determined together with such an action or proceeding—is conferred to the extent that the Constitution permits; and
- (b) in any other case—is conferred only in relation to an action or proceeding instituted by a natural person who is resident in the Territory, or a corporation that has its principal place of business in the Territory, at the time of the institution of the action or proceeding.”;
- (b) by omitting from sub-section (4) “proceedings” and substituting “an action or proceeding”; and
- (c) by omitting from sub-section (4) “proceeding” and substituting “action or proceeding”.

**Transfer of proceedings**

8. Section 113 of the Principal Act is amended—

- (a) by omitting from sub-section (1) “proceedings have been” and substituting “an action or proceeding has been”;
- (b) by omitting from sub-section (1) “proceedings” (second, third and fourth occurring) and substituting “action or proceeding”; and
- (c) by omitting sub-section (2) and substituting the following sub-section:

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

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



- (b) the court to which the action or proceeding is transferred shall proceed as if the action or proceeding had been originally instituted in that court and as if the same proceedings had been taken in that court as had been taken in the court from which the action or proceeding was transferred.”.

**Appeals from prescribed courts**

9. Section 114 of the Principal Act is amended by adding at the end of sub-section (1) “or 124”.

**Application for review**

10. (1) Section 116 of the Principal Act is amended by omitting paragraphs (b) and (c) and substituting the following word and paragraph:

“or (b) a decision of the Registrar under sub-section (1) of section 131 not to extend the time for doing an act or taking a step.”.

(2) The amendment made by sub-section (1) does not affect any application made under paragraph 116 (c) of the Principal Act before the commencement of this section, or anything arising out of, or any proceeding incidental to or connected with, any such application.

**Groundless threats of legal proceedings**

11. Section 124 of the Principal Act is amended by omitting sub-section (4) and substituting the following sub-section:

“(4) An action under this section may be instituted in a prescribed court, but nothing in this section prevents such an action being instituted in a court that is not a prescribed court.”.

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**NOTE**

1. No. 20, 1955 as amended. For previous amendments, see No. 42, 1958; No. 93, 1966; No. 216, 1973; Nos. 91 and 163, 1976; No. 130, 1978 and No. 19, 1979.