

Trade-marks Act, 1898.

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SCHEDULE.

No. , 1898.

A BILL

To amend and consolidate the Law relating to Trade-marks.

BE it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Legislative Council and Legislative Assembly of New South Wales in Parliament assembled, and by the authority of the same, as follows :—

PART I.

REGISTRATION OF TRADE-MARKS.

Application and registration.

1. (1) The registrar may, on application by or on behalf of any person claiming to be the proprietor of a trade-mark, register the trade-mark.
- Application for registration.
46 & 47 Vic., c. 57,
s. 62.
51 & 52 Vic., c. 50,
s. 8.
- 41—A (4) (2)

(2) The application must be made in the form set forth in the Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, such place and in such manner as may be prescribed.

(3) The application must be accompanied by the prescribed number of representations of the trade-mark, and must state the particular goods, or classes of goods, in connection with which the applicant desires the trade-mark to be registered.

(4) The registrar may, if he thinks fit, refuse to register a trade-mark; but any such refusal shall be subject to appeal to the Colonial Treasurer, who shall, if required, hear the applicant and the registrar, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

(5) The said Treasurer may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

(6) Where an applicant for the registration of a trade-mark otherwise than under an international convention entered into under the Imperial Patents, Designs, and Trade-marks Act, 1883, and acceded to by Her Majesty on behalf of this Colony, is out of the Colony at the time of making the application, he shall give the registrar an address for service in the Colony, and if he fails to do so the application shall not be proceeded with until the address has been given.

2. Where registration of a trade-mark has not been completed within twelve months from the date of the application by reason of default on the part of the applicant, the registrar shall give notice of the non-completion to the agent employed on behalf of the applicant, and if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the registrar may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.

3. (1) For the purposes of this Act a trade-mark must consist of or contain at least one of the following essential particulars:—

- (a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or
- (b) A written signature, or copy of a written signature, of the individual or firm applying for registration thereof as a trade-mark; or
- (c) A distinctive device, mark, brand, heading, label, or ticket; or
- (d) An invented word or invented words; or
- (e) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or any of them, but the applicant

Limit of time for proceeding with application.

46 & 47 Vic., c. 57, s. 63.

51 & 52 Vic., c. 50, s. 9.

Conditions of registration of trade-mark.

51 & 52 Vic., c. 50, s. 10.

applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3) Provided as follows:—

- (i) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.
- (ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade-mark before the twenty-sixth day of May, one thousand eight hundred and sixty-five, may be registered as a trade-mark under this Act.

4. A trade-mark must be registered for particular goods or classes of goods. Connection of trade-mark with goods. 46 & 47 Vic., c. 57, s. 65.

5. When a person claiming to be the proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of— Registration of a series of trade-marks. Ibid. s. 66.

- (a) the statement of the goods for which they are respectively used or proposed to be used; or
- (b) statements of numbers; or
- (c) statements of price; or
- (d) statements of quality; or
- (e) statements of names of places,

seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately.

6. A trade-mark may be registered in any colour or colours, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours. Trade-marks may be registered in any colour. Ibid. s. 67. 51 & 52 Vic., c. 50, s. 11.

7. Every application for registration of a trade-mark under this Act shall as soon as may be after its receipt be advertised by the registrar, unless the registrar refuses to entertain the application. Advertisement of application. 46 & 47 Vic., c. 57, s. 68. 51 & 52 Vic., c. 50, s. 12.

8. (1) Any person may within one month or such further time not exceeding three months as the registrar may allow after the advertisement of the application, give notice in duplicate at the office of the registrar of opposition to registration of the trade-mark, and the registrar shall send one copy of such notice to the applicant. Opposition to registration. 46 & 47 Vic., c. 57, s. 69. 51 & 52 Vic., c. 50, s. 13.

(2)

(2) Within one month after receipt of such notice, or such further time as the registrar may allow, the applicant may send to the registrar a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3) If the applicant sends such counter statement, the registrar shall furnish a copy thereof to the person who gave notice of opposition, and shall after hearing the applicant and the opponent, if so required, decide whether the trade-mark is to be registered, but his decision shall be subject to appeal to the Colonial Treasurer, who shall, if required, hear the applicant and the opponent and the registrar, and may make an order determining whether and subject to what conditions (if any) registration is to be permitted.

(4) The Colonial Treasurer may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

(5) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the registrar may determine to be reasonable.

(6) Where the opponent is out of the Colony, he shall give the registrar an address for service in the Colony.

9. A trade-mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

10. Where each of several persons claims to be registered as proprietor of the same trade-mark, the registrar may refuse to register any of them until their rights have been determined according to law, and the registrar may himself submit or require the claimants to submit their rights to the Court.

11. (1) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the registrar shall not register in respect of the same goods or description of goods a trade-mark identical with the one already on the register with respect to such goods or description of goods.

(2) Except as aforesaid, the registrar shall not register with respect to the same goods or description of goods a trade-mark having such resemblance to a trade-mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

12. It shall not be lawful to register as part of or in combination with a trade-mark any words the use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

13.

Assignment and
transmission of
trade-mark.
Ibid. s. 70.

Conflicting claims to
registration.
Ibid. s. 71.

Restrictions on
registration.
46 & 47 Vic., c. 57,
s. 72.
51 & 52 Vic., c. 50,
s. 14.

Further restriction
on registration.
46 & 47 Vic., c. 57,
s. 73.
51 & 52 Vic., c. 50,
s. 14.

13. (1) Nothing in this Act shall be construed to prevent the registrar entering on the register in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark :—

(a) In the case of an application for registration of a trade-mark used before the twenty-sixth day of May, one thousand eight hundred and sixty-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b) In the case of an application for registration of a trade-mark not used before the twenty-sixth day of May, one thousand eight hundred and sixty-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the disclaimer shall be entered on the register :

Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business ; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.

(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were before the twenty-sixth day of May, one thousand eight hundred and sixty-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

Effect of registration.

14. Application for registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark ; and the date of the application shall, for the purposes of this Act, be deemed to be, as and from the twenty-sixth day of May, one thousand eight hundred and sixty-five to have been the date of the registration.

15. The registration of a person as proprietor of a trade-mark shall be *primâ facie* evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act.

Restrictions on actions for infringement, and on defence to action in certain cases.

Ibid. s. 77.

16. A person shall not be entitled to institute any proceeding to prevent, or to recover damages for the infringement of a trade-mark, unless, in the case of a trade-mark capable of being registered under this Act, it has been registered in pursuance of this Act or of any enactment repealed by this Act, or in the case of any other trade-mark in use before the twenty-sixth day of May, one thousand eight hundred and sixty-five, registration thereof under this Act, or of any enactment repealed by this Act, has been refused. The registrar may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Certificate as to exclusive use, and costs thereon.

51 & 52 Vic., c. 50, s. 18.

17. In a suit or action for infringement of a registered trade-mark, the Court or a Judge thereof may certify that the right to the exclusive use of the trade-mark came in question; and if the Court or a Judge thereof so certifies, then in any subsequent suit or action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor or attorney and client, unless the Court or Judge trying the subsequent suit or action certifies that he ought not to have the same.

Register of trade-marks.

Register of trade-marks.

46 & 47 Vic., c. 57, ss. 78, 114.

18. (1) There shall be kept at the office of the registrar a book called the register of trade-marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed.

(2) The register of trade-marks kept under any enactment repealed by this Act shall be deemed a part of the same book as the register of trade-marks kept under this Act.

Removal of trade-mark after fourteen years unless fee paid.

Ibid. s. 79.

51 & 52 Vic., c. 50, s. 19.

19. (1) At a time, not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the registrar shall send notice to the registered proprietor that the trade-mark will be removed from the register unless the proprietor pays to the registrar before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall, at the expiration of one month from the date of the giving of the first notice, send a notice to the same effect.

(2) If such fee be not paid before the expiration of such fourteen years, the registrar may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3) If before the expiration of the said three months the registered proprietor pays the said fee, together with the additional prescribed

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prescribed fee, the registrar may, without removing such trade-mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4) Where, after the said three months a trade-mark has been removed from the register for non-payment of the prescribed fee, the registrar may, if satisfied that it is just so to do, restore such trade-mark to the register on payment of the prescribed additional fee.

(5) Where a trade-mark has been removed from the register for non-payment of the fee or otherwise, such trade-mark shall nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade-mark which is already registered, unless it is shown to the satisfaction of the registrar that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade-mark.

Fees.

20. There shall be paid, in respect of applications and registrations and other matters under this Part, such fees as may be from time to time prescribed by the Governor, and such fees shall be levied and paid to the Treasury in such manner as may be prescribed.

Fees for registration, &c.
46 & 47 Vic., c. 57,
s. 80.

Office of registrar and proceedings thereat.

21. There shall be a seal for the office of the registrar, and impressions thereof shall be judicially noticed and admitted in evidence.

Seal of office of registrar.
Ibid. s. 84.

22. There shall not be entered in any register kept under this Act, or be receivable by the registrar, any notice of any trust expressed, implied, or constructive.

Trust not to be entered in register.
Ibid. s. 85.

23. The registrar may refuse to register a trade-mark of which the use would, in his opinion, be contrary to law or morality.

Refusal to register in certain cases.
Ibid. s. 86.

24. Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade-mark, the registrar shall, on request and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the trade-mark in the register of trade-marks. The person for the time being entered in the register of trade-marks as proprietor of a trade-mark shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, license, or dealing: Provided that any equities in respect of such trade-mark may be enforced in like manner as in respect of any other personal property.

Entry of assignments and transmissions in register.
Ibid. s. 87.
51 & 52 Vic., c. 50,
s. 21.

Inspection of and extracts from register.

46 & 47 Vic., c. 57, s. 88.

51 & 52 Vic., c. 50, s. 22.

Sealed copies to be received in evidence.

46 & 47 Vic., c. 57, s. 89.

Rectification of register by Court.

Ibid. s. 90.

51 & 52 Vic., c. 50, s. 23.

Power for comptroller to correct clerical errors.

46 & 47 Vic., c. 57, s. 91.

51 & 52 Vic., c. 50, s. 24.

Alteration of registered mark.

46 & 47 Vic., c. 57, s. 92.

25. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such rules as may be prescribed; and certified copies, sealed with the seal of the registrar's office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

26. Printed or written copies of extracts, purporting to be certified by the registrar and sealed with the seal of his office, of or from registers and other books kept there, shall be admitted in evidence in all Courts and in all proceedings without further proof or production of the originals.

27. (1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars, from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application, and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the registrar.

28. The registrar may, on request in writing, accompanied by the prescribed fee,—

- (a) correct any clerical error in or in connection with an application for registration of a trade-mark; or
- (b) correct any clerical error in the name, style, or address of the registered proprietor of a trade-mark; or
- (c) cancel the entry or part of the entry of a trade-mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade-mark; or
- (d) Permit an applicant for registration of a trade-mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the trade-mark to be registered.

29. (1) The proprietor of any registered trade-mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

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(2) Notice of any intended application to the Court under this section shall be given to the registrar by the applicant; and the registrar shall be entitled to be heard on the application.

(3) If the Court grants leave, the registrar shall, on proof thereof, and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

30. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Falsification of entries in register.
Ibid. s. 93.

31. Where any discretionary power is by this Act given to the registrar, he shall not exercise that power adversely to the applicant for registration of a trade-mark, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Exercise of discretionary power by registrar.
Ibid. s. 94.

32. The registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to the Attorney-General for directions in the matter.

Power of registrar to take directions of Attorney-General.
Ibid. s. 95.

33. A certificate purporting to be under the hand of the registrar as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be prima facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Certificate of registrar to be evidence.
Ibid. s. 96.

34. Any application, notice, or other document authorised or required to be left, made, or given at the office of the registrar, or to any other person under this Act, may be sent by a prepaid letter through the post.

Applications and notices by post.
Ibid. s. 97.

35. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the office of the registrar falls on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a bank holiday, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document, or to pay such fee, on the day next following such excluded day or days, if two or more of them occur consecutively.

Provision as to days for leaving documents at office.
Ibid. s. 98.

36. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act, or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or Judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such

Declaration by infant, lunatic, &c.
Ibid. s. 99.

incapable person, or of any other person interested in the making of such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Governor may make
general rules.
Ibid. s. 101.

37. (1) The Governor may make such general rules and do such things as he may think expedient, subject to the provisions of this Act :—

- (a) For regulating the practice of registration under this Act.
- (b) For classifying goods, for the purposes of trade-marks.
- (c) For making or requiring duplicates of drawings and other documents.
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Governor may think fit, of drawings and other documents.
- (e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, drawings and other documents in the office of the registrar; and providing for the inspection of indexes and abridgments and other documents.
- (f) Generally for regulating the business of the office of the registrar, and all things by this Act placed under the direction or control of the registrar or the Governor.

(2) The form in the Schedule to this Act may be altered or amended by rules made by the Governor as aforesaid.

(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the Gazette.

(5) If either House of Parliament within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule, or to the making of any new rules or rule.

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38. The registrar shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Annual reports of registrar.
Ibid. s. 102.

Offences.

39. (1) Any person who describes any trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

Penalty on falsely representing articles to be patented.
Ibid. s. 105.

(2) A person shall be deemed, for the purposes of this enactment, to represent that a trade-mark is registered if he sells the article with the word "registered," or any word or words expressing or implying that a registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.

40. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Penalty on unauthorised assumption of Royal arms.
Ibid. s. 106.

PART II.

FRAUDULENT TRADE-MARKS.

Forged trade-marks and false descriptions of goods.

41. (1) Every person who—
- (a) forges any registered trade-mark; or
 - (b) falsely applies to goods any registered trade-mark or any mark so nearly resembling a registered trade-mark as to be calculated to deceive; or
 - (c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a registered trade-mark; or
 - (d) applies any false trade description to goods; or
 - (e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a registered trade-mark; or

Forging or falsely applying trade-marks and descriptions.
50 & 51 Vic., c. 28, s. 2.

(f)

(f) causes any of the things above in this section mentioned to be done, shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Part.

Selling goods to which false trade-marks or descriptions applied.

(2) Every person who sells or exposes for, or has in his possession for sale or any purpose of trade or manufacture, any goods or things to which any forged registered trade-mark or false trade description is applied, or to which any registered trade-mark or mark so nearly resembling a registered trade-mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

- (a) that having taken all reasonable precautions against committing an offence against this Part, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade-mark, mark, or description; and
 - (b) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things;
 - (c) that otherwise he had acted innocently,
- be guilty of an offence against this Part.

Punishment of offences against Part.

(3) Every person guilty of an offence against this Part shall be liable—

- (a) on conviction on indictment to imprisonment, with or without hard labour, for a term not exceeding *two* years, or to fine, or to both imprisonment and fine; and
- (b) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding *four* months, or to a fine not exceeding *twenty* pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding *fifty* pounds; and
- (c) in any case to forfeit to her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

Destruction of forfeited articles.

(4) Any Court before which any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as such Court thinks fit.

(5) A person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before such court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.

Punishment of accessories.
Ibid. s. 11.

42. Any person who, being within this Colony, procures, counsels, aids, abets, or is accessory to the commission without the Colony of any act which, if committed in the Colony, would under this Part be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any place in the Colony in which he may be, as if the misdemeanour had been there committed.

43. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act; be it therefore enacted as follows:—

Prohibition on
importation.
Ibid. s. 16.

- (1) All such goods, and also all goods of foreign manufacture bearing any name or trade-mark being or purporting to be the name or trade-mark of any manufacturer, dealer, or trader in this Colony or the United Kingdom, unless such name or trade-mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into this Colony, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in section thirty-one of the Customs Regulation Act, 1879. For the purposes of this subsection, the expression "foreign manufacture" means manufacture at some place not being in this Colony, or in the United Kingdom, or in any British Possession.
- (2) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the customs, the commissioners of customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited to be imported.
- (3) The commissioners of customs may from time to time make, revoke, and vary regulations, either general or special, respecting the detention and forfeiture of goods, the importation of which is prohibited by this section, and the conditions (if any) to be fulfilled before such detention and forfeiture; and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.
- (4) Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in this Colony or the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were a name of a place in this Colony or the United Kingdom.
- (5) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods, or of offences in relation to such goods.
- (6) The commissioners of customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion or otherwise, shall act under the control of the Colonial Treasurer.

(7)

- (7) The regulations may provide for the informant reimbursing the commissioners of customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.
- (8) All regulations under this section shall be published in the Gazette.
- (9) This section shall have effect as if it were part of the Customs Regulation Act, 1879.

Implied warranty on
sale of marked goods.
Ibid. s. 17.

44. On the sale or in the contract for the sale of any goods to which a registered trade-mark, or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine registered trade-mark, and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Part, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.

False representation
as to royal warrant.
Ibid. s. 20.

45. Any person who falsely represents that any goods are made by a person holding a royal warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government Department, shall be liable on summary conviction to a penalty not exceeding *twenty* pounds.

Procedure.

Trade-mark how
described in pleading.
Ibid. s. 9.

46. In any indictment, pleading, proceeding, or document, in which any registered trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without further description, and without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark.

Rules as to evidence.
Ibid. s. 10.

47. In any prosecution for an offence against this Part in the case of imported goods, evidence of the port of shipment shall be prima facie evidence of the place or country in which the goods were made or produced.

Search warrant.
Ibid. s. 12.

48. (1) Where, upon information of an offence against this Part, a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control, in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any member of the police force named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and
any

any goods or things seized under any such warrant shall be brought before a Court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture under this Part.

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Part, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a Court of summary jurisdiction may cause notice to be advertised, stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place such Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3) Any goods or things forfeited under this section or any other provision of this Part may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and such Court may, out of any proceeds which may be realised by the disposition of such goods (all trade-marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

49. Section three hundred of the Criminal Law Amendment Act of 1883 as explained by the Criminal Law and Evidence Amendment Act of 1891 shall apply to any offence punishable on indictment under this Part, in like manner as if such offence were the offence specified in the said section. Extension of s. 300 of C. L. A. Act to offences under this Part. *Ibid.* s. 13.

50. On any prosecution under this Part, the Court before which the prosecution is had may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively. Costs of defence or prosecution. *Ibid.* s. 14.

51. No prosecution for an offence against this Part shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens. Limitation of prosecution. *Ibid.* s. 15.

Savings and Exemptions.

52. Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a registered trade-mark, or with falsely applying to goods any registered trade-mark or any mark so nearly resembling a registered trade-mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves— Exemption of certain persons employed in ordinary course of business. *Ibid.* s. 6.

- (a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other

other instruments for making, or being used in making, registered trade-marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in this Colony, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

- (b) that he took reasonable precautions against committing the offence charged; and
- (c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade-mark, mark, or trade description; and
- (d) that he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade-mark, mark, or description was applied,

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor unless he has given due notice to him that he will rely on the above defence.

Provision as to false description not to apply where trade description lawfully applied to goods of particular class.

Ibid. s. 18.

53. Where, on the commencement of this Act, a trade description is lawfully and generally applied to goods of a particular class or manufactured by a particular method to indicate the particular class or method of manufacture of such goods, the provisions of this Part with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply, unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

Savings.

Ibid. s. 19.

54. (1) This Part shall not exempt any person from any action, suit, or other proceeding, which might, but for the provisions of this Part, be brought against him.

(2) Nothing in this Part shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any suit or action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Part.

(3) Nothing in this Part shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in this Colony, who bona fide acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

Definitions.

Definitions.

55. (1) For the purposes of this Part—
- the expression “registered trade-mark” means a trade-mark registered in the register kept under this Act, and includes any trade-mark which, either with or without registration is protected by law in England or in any foreign state to which the provisions of section two of the International Patents and Trade-marks Arrangement Act, 1897, relating to trade-marks apply, or which is registered in a British possession to which all or any of the provisions of the said section relating to trade-marks apply. Definitions.
Ibid. s. 3.
- the expression “trade description” means any description, statement, or other indication, direct or indirect— Trade description.
- (a) as to number, quantity, measure, gauge, or weight of any goods; or
 - (b) as to the place or country in which any goods were made or produced; or
 - (c) as to the mode of manufacturing or producing any goods; or
 - (d) as to the materials of which any goods are composed; or
 - (e) as to any goods being the subject of an existing patent, privilege, or copyright,
- and the use of any figure, word, or mark, which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Part.
- The customs entry relating to imported goods shall for the purposes of this Part be deemed to be a trade description applied to the goods. 54 & 55 Vic., c. 15,
s. 1.
- The expression “false trade description” means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect, and the fact that a trade description is a trade-mark, or part of a trade-mark, shall not prevent such trade description being a false trade description within the meaning of this Part. False trade
description.
- The expression “goods” means anything which is the subject of trade, manufacture, or merchandise. Goods.
- The expressions “person,” “manufacturer, dealer, or trader,” and “proprietor” include any body of persons corporate or unincorporate. Person, &c.
- The expression “name” includes any abbreviation of a name.
- (2) The provisions of this Part respecting the application of a false trade description to goods shall extend to the application of a false trade description to goods.

goods of any such figures, words, or marks, or arrangement or combination thereof whether including a registered trade-mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

False name.

(3) The provisions of this Part respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with a false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment, the expression false name or initials means as applied to any goods any name or initials of a person which—

- (a) are not a registered trade-mark, or part of a registered trade-mark ; and
- (b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with the goods of the same description, and not having authorised the use of such name or initials ; and
- (c) are either those of a fictitious person or of some person not bona fide carrying on business in connection with such goods.

Forging trade-mark.
Ibid. s. 4.

56. A person shall be deemed to forge a registered trade-mark who either—

- (a) without the assent of the proprietor of the trade-mark makes that trade-mark or a mark so nearly resembling that trade-mark as to be calculated to deceive ; or
- (b) falsifies any genuine registered trade-mark, whether by alteration, addition, effacement, or otherwise ;

and any registered trade-mark or mark so made or falsified is in this Part referred to as a forged registered trade-mark :

Provided that in any prosecution for forging a registered trade-mark the burden of proving the assent of the proprietor shall lie on the defendant.

Applying marks and descriptions.
Ibid. s. 5.

57. (1) For the purposes of this Part a person shall be deemed to apply a trade-mark, or mark, or trade description to goods who—

- (a) applies it to the goods themselves ; or
- (b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture ; or
- (c) places, encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a registered trade-mark or trade description has been applied ; or
- (d) uses a registered trade-mark, or mark, or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade-mark, or mark, or trade description. (2)

(2) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression "label" includes any band or ticket. Covering.

For the purposes of this Part a trade-mark, or mark, or trade description shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed or affixed to the goods, or to any covering, label, reel, or other thing.

(3) A person shall be deemed to falsely apply to goods a registered trade-mark or mark, who without the assent of the proprietor of a registered trade-mark applies such trade-mark, or a mark so nearly resembling it as to be calculated to deceive, but in any prosecution for falsely applying a registered trade-mark, or mark to goods, the burden of proving the assent of the proprietor shall lie on the defendant.

58. Where a watch-case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall prima facie be deemed to be a description of that country within the meaning of this Part, and the provisions of this Part with respect to goods to which a false trade description has been applied, and with respect to selling, or exposing for, or having in possession for sale or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch-case. Application of Part to watches. Ibid. s. 7.

PART III.

SUPPLEMENTAL.

59. An appeal from a summary conviction under this Act shall lie to such court and in such manner as is provided by the Criminal Law Amendment Act of 1883 in the case of convictions under that Act. Appeal from summary conviction.

60. In and for the purposes of this Act, unless the context otherwise requires— General definitions.

"British Possession" has the meaning given to that expression in the International Patents and Trade-marks Arrangements Act, 1897.

"Court of summary jurisdiction" means a stipendiary or police magistrate, or any two justices of the peace sitting in petty sessions.

"The Court" means the Supreme Court.

"Prescribed"

Trade-marks.

“Prescribed” means prescribed by the Schedule to this Act or by general rules under or within the meaning of this Act.

“Registrar” means registrar of trade-marks.

“Summary conviction” means a conviction by a court of summary jurisdiction.

“This Part” means the Part of this Act in which the expression occurs.

Repeal.

61. The Trade-marks Act, 1865, and the Trade-marks Amendment Act are hereby repealed, and any unrepealed enactment referring to any enactment so repealed shall be construed to apply to the corresponding provision of this Act.

Commencement and short title.

62. This Act shall come into operation on the _____ day of _____, one thousand eight hundred and ninety-_____, in this Act referred to as the commencement of this Act, and may be cited as the “Trade-marks Act, 1898.”

SCHEDULE.

FORM OF APPLICATION FOR REGISTRATION OF TRADE-MARK.

(One representation to be fixed within this square, and two others on separate sheets of foolscap of same size.)

(Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.)

You are hereby requested to register the accompanying trade-mark. [*In class iron in bars and plates; in class steam-engines and boilers; and in class warming apparatus*] in the name of [*here insert legibly the name, address, and business of the individual or firm*] who claims to be the proprietor thereof.

Registration fees enclosed _____ pounds.

To the Registrar of Trade-marks.

(Signed)

NOTE.—If the trade-mark has been in use before the twenty-sixth day of May, one thousand eight hundred and sixty-five, state length of user.