TRADE MARKS AMENDMENT BILL 1981

Date Introduced: 8 April 1981
House: House of Representatives
Presented by: Hon. D.S. Thompson, M.C., Minister for Science and Technology

Short Digest of Bill

Purpose

The main purpose is to amend section 103 of the Trade Marks Act 1955 dealing with seizure by the Customs of improperly marked goods.

Background

Section 103 of the Trade Marks Act 1955 prohibits the importation and allows for the seizure of goods bearing a trade mark that is or is substantially identical to a mark registered in Australia if the registered owner or user objects to the importation. This has given rise to problems. Under section 62 of the Act "use" of a mark constitutes infringement and it is established that importing goods carrying a registered mark constitutes use. However this would only apply if the goods are ones for which no mark is registered and are imported in the course of trade or if the Australian owner of the mark applied the mark to the goods or it was done with his consent.

Further section 100 makes it an offence to knowingly import goods to which a forgery of a registered mark is applied or to which a registered mark has been falsely applied and sub-sections 106(1) and 107(4) make it clear that forgery and false application can occur where the mark is made or applied without the consent of the registered proprietor. Thus goods which are quite properly marked (because the owner of the mark in another place applied it) can be covered by section 62 and section 100 as well as by section 103.

Following an Interdepartmental Committee Report in 1976, and submissions to the Government following its circulation to interested parties, the question of section 103 was referred to the Industrial Property Advisory Committee chaired by Mr. J. Stonier. Its report recommended changes to section 103 but did not suggest changes to section 62 or section 100 (as affected by sub-sections...
106(1) and 107(4)) noting that these were outside its terms of reference but that they raised "serious and topical questions which may well warrant review at an early time."

The Committee recommended that section 103 should be confined to goods where importation constitutes an infringement and that registered users of marks should also be able to use the remedy in certain circumstances.

Main Provisions

Clause 5 of the Bill substitutes a new section 103. The procedures for notices etc. are complicated but basically they involve a notice by the registered proprietor to the Customs objecting to the importation of goods bearing the mark and registered users being able to give notices objecting if they call on the registered proprietor to do so and this has not occurred within two months. Goods may be imported if, in the opinion of the Comptroller-General, to do so would not constitute an infringement. There is provision for objectors to lodge security. Owners (of the goods) are notified and a one month period is given within which the proprietor or user of the mark may bring infringement proceedings. No amendments are made to sections 62, 100, 106 or 107.

Other technical amendments to provisions dealing with jurisdiction of courts are, according to the Explanatory Memorandum circulated by the Minister, to enable jurisdiction to be conferred on Territory courts. Clause 10 omits from section 116 a paragraph which conferred jurisdiction on the Administrative Appeals Tribunal to consider actions of the Comptroller-General of Customs in releasing goods subject to conditions under the repealed section 103.

For further information, if required, contact: