

Chapter 385.

***Trade Marks Act 1978.***

Certified on: / /20 .



INDEPENDENT STATE OF PAPUA NEW GUINEA.



Chapter 385.

*Trade Marks Act 1978.*

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INDEPENDENT STATE OF PAPUA NEW GUINEA.



AN ACT

entitled

*Trade Marks Act 1978,*

Being an Act relating to trade marks.

**PART I. – PRELIMINARY.**

**1. INTERPRETATION.**

(1) In this Act, unless the contrary intention appears–

“**assignment**” means assignment by act of the parties concerned;

“**the commencement date**” means–

- (a) as regards Section 104, Part XIV and the Act to the extent that allows the operation of Part XIV–18 October 1979; and
- (b) as regards the balance of the Act–8 May, 1980;

“**the Court**” means the National Court;

“**the expiration of the last registration**”, in relation to a registered trade mark or to a registered user of a trade mark, means the date of the expiration of–

- (a) the original registration of the trade mark; or
- (b) the original registration of the registered user, or the last renewal of that registration, as the case may be;

“**goods**” includes services, and where goods are to be compared with services, or vice versa, the expression “of the same description as” is to be construed as “closely related to”;

“**limitations**” means limitations of the right to the exclusive use of a trade mark given by the registration of the trade mark, including limitations of that right as to–

- (a) mode of use; or
- (b) use within a particular area within Papua New Guinea; or

- (c) use in relation to goods to be exported to a market outside Papua New Guinea;

“**mark**” includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral, or any combination of them;

“**permitted use**”, in relation to a registered trade mark means the use of the trade mark by a registered user of the trade mark—

- (a) in relation to goods—
- (i) with which he is connected in the course of trade; and
  - (ii) in respect of which the trade mark remains registered; and
  - (iii) for which he is registered as a registered user; and
- (b) which complies with any conditions or restrictions to which his registration is subject;

“**the Register**” means the Register of Trade Marks established under Section 6;

“**registered proprietor**”, in relation to a trade mark, means the person for the time being entered in the Register as proprietor of the trade mark;

“**registered trade mark**” means a trade mark that is registered under this Act;

“**registered user**” means a person who is registered as such under Section 64;

“**the Registrar**” means the Registrar of Trade Marks appointed under Section 3;

“**this Act**” includes the regulations;

“**trade mark**” means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and a person who has the right, either as proprietor or as registered user, to use the mark whether with or without an indication of the identity of that person;

“**transmission**” means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being assignment;

“**word**” includes an abbreviation of a word.

(2) In this Act—

- (a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark; and
- (b) references to the use of a mark in relation to goods shall be construed as references to the use of the mark on, or in physical or other relation to, goods.

(3) For the purposes of this Act, a trade mark shall be deemed to be deceptively similar to another trade mark if it so nearly resembles that other trade mark as to be likely to deceive or cause confusion.

## 2. APPLICATION TO THE STATE.

This Act binds the State.



**PART II. – ADMINISTRATION.****3. OFFICE OF REGISTRAR.**

(1) For the purposes of this Act, the Minister–

- (a) shall appoint a Registrar of Trade Marks; and
- (b) may appoint such Deputy Registrars of Trade Marks and other officers as he considers necessary.

(2) A Deputy Registrar of Trade Marks may, subject to the directions of the Registrar, exercise any power or carry out any function of the Registrar.

(3) The appointment of a Deputy Registrar of Trade Marks does not affect the exercise of a power or the performance of a function by the Registrar.

**4. SEAL.**

(1) The Registrar shall have and use as his seal of office a seal in such form as the Minister determines.

(2) In pursuance of his statutory duties and functions, the Registrar may affix, or cause to be affixed, a facsimile of his signature which shall be deemed to be the signature of the Registrar.

(3) All courts, Judges and persons acting judicially shall take judicial notice of–

- (a) a signature of any person who holds or has held the office of Registrar, or Deputy Registrar and of the fact that that person holds or has held that office; and
- (b) the seal of the Registrar.

**5. POWERS OF REGISTRAR.**

(1) The Registrar may, for the purposes of this Act–

- (a) summon witnesses; and
- (b) receive evidence on oath, whether orally or otherwise; and
- (c) require the production of documents or articles; and
- (d) award costs against a party to proceedings before him.

(2) The Registrar may, on such terms as to costs or otherwise as he thinks just–

- (a) whether for the purpose of correcting a clerical error or an obvious mistake or otherwise–permit the amendment of an application for the registration of a trade mark, a notice of opposition or other document lodged at his office; or
- (b) for the purpose of correcting a clerical error or an obvious mistake–amend an entry in the Register.

(3) An amendment of an application shall not be permitted under Subsection (2) if the amendment would substantially affect the identity of the trade mark as specified in the application before amendment.

(4) Where the Registrar is of the opinion that any document submitted to him–

- (a) contains any matter contrary to law; or

- (b) by reason of any omission or misdescription has not been duly completed; or
- (c) does not comply with the requirements of this Act; or
- (d) contains any error, alteration or erasure,

he may refuse to receive or register the document and request that the document be appropriately amended or completed or re-submitted, or that a fresh document be submitted in its place.

**PART III. – THE REGISTER.**

**6. REGISTER OF TRADE MARKS.**

(1) The Registrar shall establish and maintain a Register of Trade Marks in which shall be entered particulars of all registered trade marks and such other matters as are prescribed.

(2) The Register shall be divided into two parts, which shall be known as Part A and Part B respectively.

**7. TRUSTS NOT TO BE ENTERED.**

A notice of trust, express, implied or constructive, shall not be entered in the Register or be received by the Registrar.

**8. INSPECTION.**

The Register shall be available for inspection by any person, on payment of the prescribed fee during such hours as the office of the Registrar is open for public business.

**9. CERTIFICATES, ETC.**

Subject to this Act, the Registrar may–

- (a) issue copies of or extracts from entries in the Register or other documents or publications in his office, certified under his hand and seal; and
- (b) certify under his hand and seal that an entry, act, matter or thing required or authorized by or under this Act to be made or done, or required by this Act not to be done, has or has not been made or done, as the case may be.

**10. REGISTER, ETC., TO BE EVIDENCE.**

(1) The Register is evidence of all matters required or authorized by this Act to be entered in it.

(2) A certified copy or extract issued by the Registrar under Section 9 is admissible in evidence in all courts and proceedings without further proof or production of the original.

(3) A certificate of the Registrar under Section 9 is evidence of the statements contained in the certificate.

**11. ALTERATION OF REGISTER.**

(1) The Registrar may, on application by the registered proprietor, amend or alter the Register by–

- (a) correcting an error in the entry of a trade mark in the Register; or
- (b) entering a change of name, address or description of the registered proprietor; or
- (c) cancelling the entry of a trade mark in the Register; or

- (d) amending the specification of the goods in respect of which the trade mark is registered but so that the amendment does not in any way extend the rights given by the registration; or
- (e) entering a disclaimer or memorandum relating to the trade mark that does not in any way extend the rights given by the registration of the trade mark.

(2) A person who is aggrieved by the decision of the Registrar under this section may appeal to the Court.

(3) The Registrar may, on application by a registered user of a trade mark, correct an error, or enter a change, in the name, address or description of the registered user.

## **12. ALTERATION OF REGISTERED TRADE MARK.**

(1) The registered proprietor of a trade mark may apply to the Registrar for leave to alter the trade mark in a manner not substantially affecting its identity and the Registrar may refuse the leave or grant it on such terms and subject to such conditions and limitations as he thinks fit.

(2) The Registrar may require an application under this section to be advertised in such manner as is prescribed.

(3) Any person may, within the prescribed time, give notice to the Registrar of opposition to the application and shall serve a copy of such notice on the applicant.

(4) The Registrar may require the applicant or the opponent to appear before him and give evidence or further explanation in regard to the application or the opposition.

(5) The Registrar shall consider the application and the opposition (if any) and shall decide the matter

(6) A person who is aggrieved by the decision of the Registrar under this section may appeal to the Court.

(7) Where leave to alter the trade mark is granted, the Registrar shall alter the Register accordingly and notice of the alteration shall be advertised in such manner as is prescribed and the advertisement shall include a representation of the trade mark as altered unless such representation has already been advertised in such manner in an advertisement under Subsection (2).

## **13. RECTIFICATION OF REGISTER BY COURT.**

(1) Subject to this Act, the Court may, on the application of the Registrar or a person aggrieved, order the rectification of the Register by—

- (a) making an entry wrongly omitted to be made; or
- (b) deleting or amending an entry wrongly made or wrongly remaining; or
- (c) inserting a condition or limitation that ought to be inserted; or
- (d) correcting an error or defect.

(2) On the application of the Registrar or of a person aggrieved, the Court may make such order as it thinks fit for the purpose of cancelling or varying a registration on the ground of failure to observe, or contravention of, a condition or limitation entered in the Register.

(3) The power to order rectification of the Register conferred by this section includes power to order the removal of a registration from Part A to Part B of the Register.

(4) The Registrar shall not make an application to the Court under this section unless he considers the application is desirable in the public interest.

(5) Notice of an application under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard, and shall appear if so directed by the Court.

(6) An office copy of an order made under this section shall be served on the Registrar who shall, on receipt of the order, take such steps as are necessary to give effect to the order.

#### **14. NON-USE OF TRADE MARK.**

(1) Subject to this Act, the Court may, on application by a person aggrieved, order that a trade mark be removed from the Register in respect of any of the goods in respect of which it is registered, on the ground—

- (a) that the trade mark was registered without an intention in good faith on the part of the applicant for registration that it should be used in relation to those goods by him or, if it was registered under Section 35(1) by the corporation or registered user concerned and that there has in fact been no use in good faith of the trade mark in relation to those goods by the registered proprietor or a registered user of the trade mark for the time being earlier than one month before the application; or
- (b) that, up to one month before the application, a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods by the registered proprietor or a registered user of the trade mark for the time being.

(2) Except where an applicant has been permitted under Section 26 to register a substantially identical or deceptively similar trade mark in respect of the goods to which the application relates, or the Court is of the opinion that the applicant can properly be permitted to register such a trade mark, the Court may refuse an application made under Subsection (1) in relation to any goods if there has been before the relevant date or during the relevant period, as the case may be, use in good faith by the registered proprietor, or a registered user of the trade mark for the time being, in relation to goods of the same description, being goods in respect of which the trade mark is registered.

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

- (a) the matters referred to in Subsection (1)(b) are shown as far as regards failure to use the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in Papua New Guinea (otherwise than for export from Papua New Guinea), or in relation to goods to be exported to a particular market outside Papua New Guinea; and
- (b) a person has been permitted under Section 26 to register a substantially identical or deceptively similar trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Papua New Guinea), or in relation to goods to be exported to that market, or the Court is of the opinion that that person might properly be permitted to register such a trade mark,

the Court 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 Court thinks proper for ensuring that the registration shall cease to extend to use of the trade mark in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Papua New Guinea), or in relation to goods to be exported to that market.

(4) An applicant is not entitled to rely, for the purposes of Subsection (1)(b) or (3) on failure to use a trade mark if the failure is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

(5) An office copy of an order under this section shall be served on the Registrar who shall take such steps as are necessary to give effect to the order.

**PART IV. – REGISTRABLE TRADE MARKS.****15. REGISTRABLE TRADE MARKS: PART A.**

(1) A trade mark is registrable in Part A of the Register if it contains or consists of–

- (a) the name of a person represented in a special or particular manner; or
- (b) the signature of the applicant for registration or of some predecessor in his business; or
- (c) an invented word; or
- (d) a word–
  - (i) not having a direct reference to the character or quality of the goods in respect of which registration is sought; and
  - (ii) not being, according to its ordinary meaning, a geographical name or a surname; or
- (e) any other distinctive mark.

(2) A name, signature or word (not being a name, signature or word specified in Subsection (1)(a), (b), (c) or (d)) is not registrable in Part A of the Register unless it is, by evidence, shown to be distinctive.

(3) A trade mark may be registered in Part A of the Register in respect of any goods notwithstanding the registration of the trade mark, or of a part or parts of the trade mark, in Part B of the Register, in the name of the same person, in respect of the same or different goods.

**16. REGISTRABLE TRADE MARKS: PART B.**

(1) A trade mark is registrable in Part B of the Register if it is distinctive, or is not distinctive but is capable of becoming distinctive, of goods in respect of which registration of the trade mark is sought and with which the applicant for registration is or may be connected in the course of trade.

(2) A trade mark may be registered in Part B of the Register in respect of any goods notwithstanding the registration of the trade mark, or of a part or parts of the trade mark, in Part A of the Register, in the name of the same person, in respect of the same or different goods.

**17. DISTINCTIVENESS.**

(1) For the purposes of this Act, a trade mark is not distinctive of the goods of a person unless it is adapted to distinguish goods with which that person is or may be connected in the course of trade from goods in respect of which no such connection subsists, either generally or, where the trade mark is sought to be registered, or is registered, subject to conditions or limitations in relation to use, subject to those conditions or limitations.

(2) In determining whether a trade mark is distinctive, regard may be had to the extent to which–

- (a) the trade mark is inherently adapted so to distinguish; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark does so distinguish.

(3) Where—

- (a) an application for registration of a trade mark has been made by a person; and
- (b) before the date of the application the trade mark was used by a person other than the applicant under the control of, and with the consent and authority of, the applicant; and
- (c) an application has been made by the applicant and that other person for registration of that other person as a registered user of the trade mark; and
- (d) the Registrar is satisfied that that other person is entitled to be registered as a registered user of the trade mark immediately after registration of the trade mark,

the Registrar may, for the purpose of determining whether the trade mark is distinctive of the goods of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by the applicant.

## **18. COLOURED TRADE MARKS.**

(1) A trade mark may be limited, in whole or in part, to one or more colours and in that case the fact that the trade mark is so limited shall be taken into consideration for the purpose of determining whether the trade mark is distinctive.

(2) In so far as a trade mark is registered without limitation as to colour it shall be deemed to be registered for all colours.

## **19. PROHIBITED MARKS.**

A mark—

- (a) the use of which would be likely to deceive or cause confusion; or
- (b) the use of which would be contrary to law; or
- (c) which comprises or contains scandalous or otherwise offensive matter; or
- (d) which would otherwise be not entitled to protection in a court of justice,

shall not be registered as a trade mark.

## **20. REGISTRATION OF CERTAIN MARKS MAY BE REFUSED.**

(1) The Registrar may refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as to be likely to be taken for that mark:—

- (a) the word or words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Copyright”, “To counterfeit this is a forgery”, or a word or words or symbol or symbols to the like effect;
- (b) a representation of the Sovereign or of a member of the Royal Family;
- (c) a representation of
  - (i) the Royal Arms, crests, armorial bearings, insignia or devices; or
  - (ii) any of the Royal crowns; or



- (iii) the national flag of a part of the Queen's dominions;
- (d) the word "Royal" or any other word, or any letters or device, likely to lead persons to think that the applicant has or has had Royal or Government patronage or authority;
- (e) a representation of the National Flag, National Emblem, National Motto or National Seal or of the flag, emblem, motto or seal of a province;
- (f) a representation of the flag or emblem of a city or town or Local-level Government or of a statutory body or instrumentality in Papua New Guinea;
- (g) a mark prescribed as being, for the purposes of this section, a prohibited mark.

(2) The regulations may provide that a mark to which Subsection (1) applies (not being a registered trade mark or a mark in use in good faith as a trade mark) shall not be used as a trade mark or as a part of a trade mark, either at all or without the consent of the Minister.

## **21. NAMES OF LIVING PERSONS OR PERSONS RECENTLY DECEASED.**

(1) Where a person makes an application for registration of a trade mark which consists of or includes the name or a representation of a living person or of a person believed by the Registrar to be living, the Registrar may require the applicant to furnish him with the consent of that person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

(2) Where a person makes an application for registration of a trade mark which consists of or includes the name or a representation of a person recently dead, or of a person believed by the Registrar to be recently dead, the Registrar may require the applicant to furnish him with the consent of the legal representative of the deceased person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

## **22. TRADE MARKS TO BE REGISTERED FOR CERTAIN GOODS.**

(1) A trade mark shall be registered in respect of any or all of the goods comprised in a prescribed class of goods.

(2) Where a question arises as to the class in which goods are comprised, that question shall be decided by the Registrar and the decision of the Registrar is not subject to appeal and shall not be called in question in an appeal or other proceedings under this Act.

## **23. DISCLAIMERS.**

(1) Where a trade mark—

- (a) contains parts that are not separately registered in the name of the proprietor as trade marks, or are not the subject of separate applications by the proprietor for registration as trade marks; or
- (b) contains matter that is common to the trade or is otherwise not distinctive,

the Registrar or the Court, in deciding whether the trade mark may be registered or remain on the Register, may in his or its discretion require as a condition that the proprietor—

- (c) disclaim any right to the exclusive use of any of those parts, or of that matter; or

(d) make such other disclaimer as the Registrar or the Court considers to be proper for the purpose of defining the rights of the proprietor under the registration.

(2) A disclaimer under Subsection (1) does not affect the rights of the proprietor of the trade mark that do not arise out of the registration of the trade mark.

#### **24. IDENTICAL AND SIMILAR MARKS.**

(1) Subject to this Act, a trade mark is not capable of registration by a person in respect of goods 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 goods or of goods of the same description, 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.

(2) The Registrar may defer acceptance of the application for registration of the trade mark first mentioned in Subsection (1) until the trade mark second mentioned in that subsection has been registered.

#### **25. RIVAL CLAIMS TO PROPRIETORSHIP.**

Where each of several persons claims to be the proprietor of a trade mark, the Registrar may refuse to accept an application for registration by any of them until their respective rights have been determined by the Court.

#### **26. CONCURRENT USE.**

(1) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper to do so, the Registrar may permit the registration of trade marks which are substantially identical or deceptively similar, or, but for the honest concurrent use or other special circumstances would be deceptively similar, for the same or different goods, by more than one proprietor subject to such conditions and limitations (if any) as the Registrar imposes.

(2) Where a person has, by himself or his predecessors in business, continuously used a trade mark before the use, or before the date of registration, whichever is the earlier, of another registered trade mark by the registered proprietor of that other trade mark, by his predecessors in business or by a registered user of that trade mark, the Registrar shall not refuse to register the first-mentioned trade mark by reason of the registration of that other trade mark.

#### **27. JOINTLY OWNED TRADE MARKS.**

(1) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others to use the trade mark except—

(a) on behalf of both or all of them; or

(b) in relation to goods with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act has effect in relation to any rights of those persons to the use of the trade mark as if those rights were rights of a single person.

(2) Subject to Subsection (1) this Act does not authorize the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors of the trade mark.

## **28. ASSOCIATED TRADE MARKS.**

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

- (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 goods or goods of the same description; 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.

(2) On application made by the registered proprietor of two or more associated trade marks, the Registrar may, if he is satisfied that there would be no likelihood of deception or confusion being caused, dissolve the association with respect to one or more of those trade marks and amend the Register accordingly.

(3) A person who is aggrieved by the decision of the Registrar under Subsection (1) or (2), may appeal to the Court.

## **29. ASSIGNMENT OF ASSOCIATED TRADE MARKS.**

Associated trade marks are assignable or transmissible only as a whole and not separately, but, subject to this Act, they shall for all other purposes be deemed to have been registered as separate trade marks.

## **30. USE OF TRADE MARKS.**

(1) Where, under this Act, use of a trade mark is required to be proved for any purpose, the Registrar or the Court may, if and so far as he or it thinks right, accept use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting the identity of the trade mark, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall, for the purposes of this Act, be deemed to be also a use of any registered trade mark, being a part of it, registered in the name of the same proprietor.

## **31. SERIES OF TRADE MARKS.**

(1) Where a person, who claims to be the proprietor of several trade marks for the same goods or for goods of the same description within a single class, seeks to register those trade marks and the trade marks, although they resemble each other in material particulars, differ in respect of—

- (a) statements or representations as to the goods in respect of which the trade marks are used or proposed to be used; or

- (b) statements or representations as to number, price, quality or names of places; or
- (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or
- (d) colour,

or in respect of any two or more of those matters, the trade marks may be registered as a series in one registration.

(2) All the trade marks in a series of trade marks registered under Subsection (1) shall be deemed to be, and shall be registered as, associated trade marks.

**PART V. – APPLICATIONS FOR REGISTRATION.**

**32. APPLICATION FOR REGISTRATION.**

(1) A person who claims to be the proprietor of a trade mark may apply to the Registrar in the prescribed manner for the registration of that trade mark in Part A or Part B of the Register.

(2) An application under this section shall specify the goods in respect of which registration of the trade mark is sought.

(3) An application under this section shall not be made in respect of goods comprised in more than one class.

**33. ACCEPTANCE OR REFUSAL OF APPLICATIONS.**

(1) The Registrar, if he is satisfied that—

- (a) the application complies with the requirements of this Act; and
- (b) the trade mark is capable of registration under this Act; and
- (c) there is no other lawful ground of objection to the application,

may accept an application under Section 32 for registration of a trade mark either without conditions or limitations or subject to such conditions or limitations as he sees fit.

(2) If the Registrar is not satisfied that the requirements of Subsection (1) have been complied with, he may—

- (a) refuse to accept the application altogether; or
- (b) require the application to be amended to his satisfaction so as to remove the grounds of objection within such time as he allows.

(3) An application shall not be amended under Subsection (2) in such a manner that the amendment would substantially affect the identity of the trade mark before amendment.

(4) Where the Registrar requires an application to be amended under Subsection (2) and the application is not amended within the time allowed, the Registrar may refuse to accept the application.

(5) In the case of an application for registration of a trade mark in Part A of the Register, the Registrar may, with the consent of the applicant, instead of refusing to accept the application, treat the application as an application for registration in Part B of the Register and deal with the application accordingly.

(6) Where, after the acceptance of an application for registration of a trade mark but before the registration of the trade mark, the Registrar is satisfied—

- (a) that the application has been accepted in error; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations,

he may withdraw the acceptance and proceed as if the application had not been accepted.

(7) An applicant who is aggrieved by a decision of the Registrar—

- (a) to accept an application subject to such conditions and limitations as he sees fit under Subsection (1); or
- (b) to refuse an application under Subsection (2)(a),

may appeal to the Court.

(8) The Registrar is entitled to appear and be heard on the hearing of the appeal and shall appear if so directed by the Court.

#### **34. DIVISION OF APPLICATION.**

(1) Where a part of a trade mark which is the subject of an application for registration is separately registrable as a trade mark, the applicant may, before the application has been accepted or refused, make a further application for the registration of that part in respect of goods in relation to which the first-mentioned application was made.

(2) A further application made under Subsection (1) shall, if the Registrar so directs, be deemed to have been lodged on the date on which the first-mentioned application was lodged.

(3) Where an application has been made for registration of a trade mark in respect of certain goods and, before the application has been accepted or refused, the applicant has made a further application for the registration of that trade mark in respect of goods included in the description of goods in respect of which the first-mentioned application was made, the Registrar may direct that the further application shall be deemed to have been lodged on the date on which the first-mentioned application was lodged.

#### **35. APPLICATION WHERE TRADE MARK IS TO BE USED BY ASSIGNEE OR REGISTERED USER.**

(1) An application for the registration of a trade mark may be accepted, and the trade mark may be registered, notwithstanding that the applicant does not use or propose to use the trade mark—

- (a) where the Registrar is satisfied that a corporation is about to be constituted and that the applicant intends to assign the trade mark to the corporation with a view to the use by the corporation of the trade mark in relation to the goods in respect of which registration is sought; or
- (b) where an application has been made for the registration of a person as registered user of the trade mark and the Registrar is satisfied that—
  - (i) the proprietor intends the trade mark to be used by that person in relation to those goods; and
  - (ii) that person will be registered as a registered user of the trade mark immediately after registration of the trade mark.

(2) Where a trade mark is registered under Subsection (1) in the name of an applicant who relies on an intention to assign to a corporation, then, unless within the prescribed or within such further period, not exceeding six months, as the Registrar allows, the corporation has been registered as the proprietor of the trade mark in respect of the goods in respect of which the trade mark is registered, the registration shall cease to have effect at the expiration of that period and the Registrar shall amend the Register accordingly.

**36. APPLICATION TO LAPSE ON REFUSAL.**

Where the Registrar refuses to accept an application for the registration of a trade mark he shall give written notice of the refusal to the applicant and, subject to any appeal from the Registrar's decision, the application shall lapse.

**37. ADVERTISEMENT OF ACCEPTANCE.**

(1) On acceptance of an application for the registration of a trade mark the Registrar shall give written notice of the acceptance to the applicant.

(2) The applicant shall cause the acceptance to be advertised in the prescribed manner.

**38. WITHDRAWAL OF APPLICATION.**

An applicant for the registration of a trade mark may, at any time before the trade mark is registered, withdraw his application.

**PART VI. – OPPOSITION TO REGISTRATION.****39. INTERPRETATION OF PART VI.**

In this Part, unless the contrary intention appears–

“**applicant**” means a person who has made an application to the Registrar for the registration of a trade mark;

“**notice of opposition**” means a notice given in accordance with Section 40(1);

“**opponent**” means a person who has given notice of opposition in accordance with Section 40(1).

**40. NOTICE OF OPPOSITION.**

(1) A person may, within three months after the date of advertisement of the acceptance of an application for the registration of a trade mark, or within such further period as the Registrar, on application made to him within the first-mentioned period, allows, give notice to the Registrar in the prescribed manner of opposition to the registration of the trade mark.

(2) The opponent shall serve a copy of the notice of opposition on the applicant on or before the date on which the notice is given to the Registrar.

(3) The applicant may, within three months after the date of service on him of the copy of notice of opposition, lodge with the Registrar in the prescribed manner a counter statement in support of his application.

(4) The applicant shall serve a copy of the counter statement on the opponent on or before the date on which the counter statement is lodged with the Registrar.

(5) The Registrar may require the opponent or the applicant to appear before him and give evidence or further explanation in respect of the opposition or the application.

(6) Subject to Section 41, the Registrar shall, after the expiration of a period of three months from the date on which the notice of opposition is given to him, or such further period, not exceeding three months, as the Registrar on the application of the opponent or the applicant allows, determine the opposition and decide–

(a) to register the trade mark without conditions or limitations; or

(b) to register the trade mark subject to such conditions or limitations as he thinks fit; or

(c) to refuse to register the trade mark.

(7) In determining the opposition the Registrar may take into account a ground of objection whether relied on by the opponent or not.

(8) A person who is aggrieved by a decision of the Registrar under Subsection (6), may appeal to the Court.

**41. OPPOSITION MAY BE REFERRED TO COURT.**

(1) At any time after notice of opposition to the registration of a trade mark has been given to him the Registrar may, and on the application of both the opponent and the applicant shall, refer the matter to the Court for determination.



(2) In determining the opposition the Court may take into account a ground of objection whether relied on by the opponent or not.

(3) On determination of the opposition the Court may order—

- (a) that the trade mark may be registered without conditions or limitations; or
- (b) that the trade mark may be registered subject to such conditions or limitations as it thinks fit; or
- (c) that registration of the trade mark be refused.

(4) An office copy of an order made under this section shall be served on the Registrar, who shall, on receipt of the order, take such steps as are necessary to give effect to the order.

#### **42. SECURITY FOR COSTS.**

If a person giving notice of opposition does not reside in or carry on business in the country the Court may order him to give security for costs within a specified time, and if the order is not complied with the opposition shall lapse.

#### **43. WITHDRAWAL OF OPPOSITION.**

Opposition to the registration of a trade mark may be withdrawn by the opponent at any time before the opposition is determined by the Registrar or by the Court.

**PART VII. – REGISTRATION AND EFFECT OF REGISTRATION.****44. REGISTRATION OF TRADE MARK.**

(1) Subject to Section 33(6), after the expiration of the period allowed under Section 40(1), if no notice of opposition to the registration of a trade mark has been given to the Registrar, or if such notice has been withdrawn, the Registrar shall register the trade mark in the appropriate part of the Register.

(2) Subject to Section 33(6), where notice of opposition to the registration of a trade mark is given to the Registrar in accordance with Section 40(1), and the decision of the Registrar or of the Court in determining the opposition is that the trade mark should be registered, the Registrar shall, after expiration of the period allowed for appeal from that decision, register the trade mark in the appropriate part of the Register.

**45. DATE OF REGISTRATION.**

Subject to this Act, on the registration of a trade mark the date of lodgement of the application for its registration with the Registrar shall be deemed to be the date of registration and the trade mark shall be deemed, for the purposes of this Act, to have been a registered trade mark from that date.

**46. DURATION OF REGISTRATION.**

(1) The registration of a trade mark shall be for a period of 10 years.

(2) The registration of a trade mark may be renewed from time to time in accordance with this Act.

**47. WORDS USED AS NAME OR DESCRIPTION OF ARTICLE OR SUBSTANCE.**

(1) Subject to this section, the registration of a trade mark does not become invalid by reason only of the use, after the date of the registration, of a word or words which the trade mark contains or of which it consists, as the name or description of an article or substance.

(2) Subsections (3), (4) and (5) have effect where–

(a) there is a well-known and established use of a word as the name or description of an article or substance by a person or persons carrying on a trade in that article or substance, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark; or

(b) the article or substance was formerly manufactured under a patent, a period of two years or more after the patent has ceased has elapsed, and the word is the only practicable name or description of the article or substance.

(3) If the trade mark consists solely of that word, the registration of the trade mark, so far as regards registration in respect of the article or substance or of any goods of the same description, shall be deemed for the purposes of Section 13 to be an entry wrongly remaining in the Register.

(4) If the trade mark contains that word and other matter, the Court, in deciding whether the trade mark shall remain in the Register, so far as regards registration in respect of the article or substance or of any goods of the same description, may, in the case of a decision in favour of the

trade mark remaining in the Register, require as a condition that the proprietor shall disclaim any right to the exclusive use of that word in relation to that article or substance or to any goods of the same description, but no such disclaimer affects any rights of the proprietor of the trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

- (5) For the purposes of any other legal proceedings relating to the trade mark—
- (a) if the trade mark consists solely of that word—all rights of the registered proprietor to the exclusive use of the trade mark; or
  - (b) if the trade mark contains that word and other matter all rights of the registered proprietor to the exclusive use of that word,

in relation to the article or substance or to any goods of the same description, shall be deemed to have ceased on the date at which the use mentioned in Subsection (2)(a) first became well-known and established, or at the expiration of the period of two years mentioned in Subsection (2)(b).

#### **48. POWERS OF REGISTERED PROPRIETORS.**

(1) Subject to this Act the registered proprietor of a trade mark has, subject to any rights appearing from the Register to be vested in some other person, power to assign the trade mark and to give good discharges for any consideration for the assignment.

(2) Equities in respect of a trade mark may be enforced in like manner as in respect of other personal property.

#### **49. RIGHTS GIVEN BY REGISTRATION.**

(1) Subject to this Act, the registration of a trade mark in Part A or Part B of the Register, if valid, gives to the registered proprietor of the trade mark the right to the exclusive use of the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The rights acquired by the registration of a trade mark are subject to any conditions or limitations to which the registration is subject.

(3) Where two or more persons are proprietors of registered trade marks, which are substantially identical or deceptively similar, whether for the same or different goods, rights of exclusive use of either of those trade marks are not (except so far as their respective rights have been defined by the Registrar or a court) acquired by any one of those persons as against any other of those persons by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users) as he would have if he were the sole registered proprietor.

#### **50. REGISTRATION EVIDENCE OF VALIDITY.**

In legal proceedings relating to a registered trade mark, including applications under Section 13, the original registration of the trade mark and the registration of any assignment or transmission of the trade mark shall be deemed to be valid unless the contrary is shown.

**51. LIMITATION ON REMOVAL OF TRADE MARK.**

In legal proceedings relating to a trade mark registered in Part A of the Register including applications under Section 13 instituted after the expiration of three years from the date of registration, the trade mark shall not be removed from the Register, or be held invalid on the ground that it was not a registrable trade mark under Section 15, unless it is proved that it was not, at the commencement of the proceedings, distinctive of the goods of the registered proprietor.

**52. REGISTRATION CONCLUSIVE AFTER 10 YEARS.**

In legal proceedings relating to a trade mark registered in Part A of the Register, including applications under Section 13, the original registration of the trade mark under this Act shall, after the expiration of 10 years from the date of the original registration, be taken to be valid in all respects, unless it is shown—

- (a) that the original registration was obtained by fraud; or
- (b) that the trade mark offends against the provisions of Section 19; or
- (c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods of the registered proprietor.

**53. INFRINGEMENT OF TRADE MARKS.**

(1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user of the trade mark using by way of permitted use, uses a mark which is substantially identical with, or deceptively similar to the trade mark, in the course of trade, in relation to goods in respect of which the trade mark is registered.

(2) In an action for infringement of a trade mark registered in Part B of the Register (not being an infringement occurring by reason of an act referred to in Section 54), an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods in respect of which the trade mark is registered and a person having the right, either as registered proprietor or as registered user, to use the trade mark.

**54. INFRINGEMENT BY BREACH OF CERTAIN RESTRICTIONS.**

(1) In this section, references in relation to goods, to the registered proprietor, to a registered user and to the registration of a trade mark shall be construed, respectively, as references to the registered proprietor of the trade mark, to a registered user of the trade mark and to the registration of the trade mark, in respect of those goods, and “on” includes, in relation to goods, a reference to physical relation to the goods.

(2) Where by notice on goods or on the container of goods, the registered proprietor or a registered user of a trade mark registered in Part A or Part B of the Register makes a statement prohibiting the doing of an act to which this section applies, a person who, being the owner for the time being of the goods, does that act, or authorizes it to be done in relation to the goods in the course of trade or with a view to a dealing with the goods in the course of trade, infringes the trade mark unless—

- (a) at the time when that person agreed to buy the goods he acted in good faith without notice that the statement appeared on the goods; or
  - (b) he became the owner of the goods by virtue of a title derived from another person who had so agreed to buy the goods.
- (3) The acts to which this section applies are—
- (a) the application of the trade marks on goods after they have suffered alteration to their state, condition, get-up or packing; and
  - (b) in a case in which the trade mark is on the goods and there is also other matter on the goods, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods—the removal or obliteration (whether wholly or partially), of the trade mark unless that other matter is wholly removed or obliterated; and
  - (c) in a case in which the trade mark is on the goods—
    - (i) the alteration, partial removal or partial obliteration of the trade mark; and
    - (ii) the application of some other trade mark to the goods; and
    - (iii) the addition to the goods of other matter, in writing or otherwise, that is likely to injure the reputation of the trade mark.

## 55. ACTS NOT CONSTITUTING INFRINGEMENT.

(1) Notwithstanding anything in this Act, the following acts do not constitute an infringement of a trade mark:—

- (a) the use in good faith by a person of his own name or the name of his place of business, or the name, or the name of the place of business of any of his predecessors in business;
- (b) the use in good faith by a person of a description of the character or quality of his goods;
- (c) the use by a person of a trade mark in relation to goods in relation to which that person has, by himself or his predecessors in business, continuously used the trade mark from a date before—
  - (i) the use of the registered trade mark by the registered proprietor, by his predecessors in business or by a registered user of the trade mark; or
  - (ii) the registration of the trade mark,

whichever is the earlier;
- (d) the use of the trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the facts, a connection in the course of trade between any person and the goods;

- (e) the use of a trade mark, being one of two or more registered trade marks, which are substantially identical in exercise of the right to the use of that trade mark given by registration as provided by this Act.

(2) Where a trade mark is registered subject to conditions or limitations, the trade mark is not infringed by the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in a place, in relation to goods to be exported to a market, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend.

#### **56. RELIEF IN INFRINGEMENT ACTIONS.**

The relief which a Court may grant in an action or proceeding for infringement of a registered trade mark includes an injunction, subject to such terms (if any) as the Court thinks fit, and, at the option of the plaintiff, either damages or an account of profits.

#### **57. EVIDENCE OF TRADE USAGE.**

In an action or proceeding relating to a trade mark, evidence is admissible of the usages of the trade concerned and of any relevant trade mark, trade name or get-up legitimately used by other persons.

#### **58. JURISDICTION OF COURT.**

Jurisdiction is, by this section, conferred on the Court to hear and determine an action or proceeding for the infringement of a trade mark, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action or proceeding.

#### **59. PASSING OFF ACTIONS.**

In an action for passing off arising out of the use by the defendant of a registered trade mark of which he is the registered proprietor or a registered user, being a trade mark substantially identical with, or deceptively similar to, the trade mark of the plaintiff, damages shall not be awarded against the defendant if he satisfies the court—

- (a) that at the time he commenced to use the trade mark he was unaware and had no reasonable means of ascertaining that the trade mark of the plaintiff was in use; and
- (b) that when he became aware of the existence and nature of the plaintiff's trade mark he immediately ceased to use the trade mark in relation to goods in relation to which it was used by the plaintiff.

**PART VIII. – RENEWAL OF REGISTRATION.****60. RENEWAL OF REGISTRATION.**

Subject to this Act, the Registrar shall, on application in the prescribed manner by the registered proprietor, renew the registration of a trade mark for a further period of 10 years from the expiration of the last registration of that trade mark.

**61. PROCEDURE ON EXPIRY OF REGISTRATION.**

(1) At the prescribed time before the expiration of the registration of a trade mark the Registrar shall send notice to the registered proprietor of the date on which the registration will expire and the conditions as to payment of fees and otherwise on which the renewal of the registration may be obtained.

(2) If, at the expiration of the prescribed time the conditions referred to in Subsection (1) have not been complied with, the Registrar may remove the trade mark from the Register.

**62. RESTORATION OF REMOVED TRADE MARK.**

(1) Where a trade mark has been removed from the Register under Section 61(2) the Registrar may within 12 months of the date of expiration of the registration of that trade mark, if he is satisfied that it is just to do so, restore the trade mark to the Register and renew its registration, either generally or subject to such conditions or limitations as he sees fit to impose, for a further period of 10 years from the expiration of the last registration.

(2) A person who is aggrieved by a decision of the Registrar under Subsection (1) may appeal to the Court.

(3) Section 95 does not apply in relation to Subsection (1).

**63. STATUS OF UN-RENEWED TRADE MARK.**

Where a trade mark has been removed from the Register under Section 61(2) the trade mark shall, for the purpose of an application for registration by another person, for a period of 12 months next after the expiration of the last registration, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that—

- (a) there has been no use in good faith of the trade mark during the two years immediately preceding the expiration of the last registration; or
- (b) no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

**PART IX. – REGISTERED USERS.****64. REGISTERED USERS.**

(1) Subject to this section, a person other than the registered proprietor of a trade mark may be registered as a registered user of that trade mark for all or any of the goods in respect of which the trade mark is registered.

(2) An application for the registration of a person as the registered user of a trade mark shall be made to the Registrar in the prescribed manner by the registered proprietor of the trade mark and the proposed registered user and shall be accompanied by such further documents, information or evidence as is required under the regulations or by the Registrar.

(3) Subject to this Act, where the requirements of Subsection (2) have been complied with, the Registrar may register the proposed registered user as a registered user of the trade mark for all or any of the goods in respect of which the application is made and subject to such conditions or restrictions as the Registrar thinks appropriate.

(4) The Registrar may refuse to register a person as a registered user of a trade mark for all or any of the goods in respect of which an application is made if, in his opinion, such registration would be contrary to the public interest.

(5) The Registrar shall not register a person as a registered user of a trade mark if it appears to him that the registration would tend to facilitate trafficking in the trade mark.

(6) The Registrar may determine that the registration of a person as a registered user of a trade mark shall be for such period as, having regard to the information supplied to him, he thinks fit, but such period shall not extend beyond the date of expiration of the current period of registration of the trade mark.

(7) The Registrar may determine that, on the registration of a person as a registered user of a trade mark, the period of the registration shall be deemed to have commenced on the date on which the application for the registration was lodged with the Registrar, and that person shall be deemed to have been a registered user of the trade mark from that date.

(8) The Registrar shall, if so required by an applicant under Subsection (2), ensure that any document, information or evidence furnished for the purpose of that application, other than matter entered in the Register, is not disclosed to any other person except by order of the Court.

**65. EXPIRATION OF REGISTRATION OF REGISTERED USER.**

Subject to Section 67(1)(b) the registration of a person as a registered user of a trade mark shall expire on the date of expiration of the registration of the trade mark or such earlier date as may be determined by the Registrar under Section 64(6).

**66. RENEWAL OF REGISTRATION OF REGISTERED USER.**

(1) The registration of a person as registered user of a trade mark may be renewed from time to time in accordance with this Act.

(2) At the prescribed time before the expiration of the registration of a person as a registered user of a trade mark, the Registrar shall send notice to the registered user and to the registered proprietor of the trade mark of the date on which the registration will expire and the



conditions as to payment of fees or otherwise on which renewal of the registration may be obtained.

(3) If the conditions referred to in Subsection (2) are complied with the Registrar may renew the registration for such period as he thinks fit commencing from the date of expiration of the last registration, but the period shall not extend beyond the date of expiration of the current period of registration of the trade mark.

(4) Where a trade mark that has been removed from the Register under Section 61(2) is restored to the Register under Section 62, the registration of a person as a registered user of that trade mark may be renewed under this section as of the date of expiration of the last registration.

## **67. VARIATION, ETC., OF REGISTRATION.**

(1) Without affecting the operation of Section 13, the registration of a person as a registered user—

- (a) may be varied by the Registrar, on the application of the registered proprietor and the registered user, with respect to the goods for which, or any conditions or restrictions subject to which, the registration has effect; or
- (b) may be extended by the Registrar, on the application of the registered proprietor and the registered user, for such period not exceeding three years, as the Registrar thinks fit, but such period shall not extend beyond the date of expiration of the current registration of the trade mark; or
- (c) may be cancelled by the Registrar on the application of the registered proprietor or of the registered user; or
- (d) may be cancelled by the Registrar on the application of a person on the ground—
  - (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion; or
  - (ii) that the registered proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration or that the circumstances have materially changed since the date of the registration; or
  - (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(2) An application under this section shall be made in the prescribed manner and shall be accompanied by such further documents, information or evidence as is required under the regulations or by the Registrar.

(3) The Registrar may, instead of determining an application under Subsection (1)(d) refer the application to the Court and the Court shall hear and determine the application.

(4) An office copy of an order of the Court made under Subsection (3) shall be served on the Registrar, who shall, on receipt of the order, take such steps as are necessary to give effect to the order.

**68. CANCELLATION OF REGISTRATION.**

The Registrar shall cancel the registration of a person as a registered user of a trade mark for any goods in respect of which the trade mark is no longer registered.

**69. EFFECT OF PERMITTED USE.**

(1) The permitted use of a registered trade mark shall be deemed to be use by the registered proprietor of the trade mark and shall be deemed not to be use by a person other than the registered proprietor for the purposes of Section 14 and for any other purpose for which use by the registered proprietor of the trade mark is material under this Act.

(2) Where—

- (a) a person is registered as a registered user of a trade mark; and
- (b) there has been previous use (whether before or after the commencement of this Act) of the trade mark by that person; and
- (c) that use is in relation to goods in respect of which that person is registered and, where he is registered subject to conditions or restrictions—
  - (i) that use complied substantially with those conditions or restrictions; or
  - (ii) did not so comply but was not such as to be contrary to the public interest,

Subsection (1) has effect as if that previous use had been permitted use.

(3) The registration of a person as a registered user of a trade mark, or the use by that person of the trade mark as a registered user, does not prejudice any of the rights arising at common law of the person who is the registered proprietor of the trade mark.

(4) For the purpose of determining the rights arising at common law of the person who is the registered proprietor of a trade mark, the use of the trade mark by a registered user shall be deemed to be use by that person and shall be deemed not to be use by a person other than that person.

**70. INFRINGEMENT PROCEEDINGS.**

(1) Subject to any agreement subsisting between the registered user of a trade mark and the registered proprietor of the trade mark, the registered user is entitled to call on the registered proprietor to take proceedings for infringement of the trade mark, and, if the registered proprietor refuses or neglects to do so within two months after being so called on, the registered user may institute proceedings for infringement in his own name as if he were the registered proprietor and shall make the registered proprietor a defendant.

(2) A registered proprietor added as a defendant under Subsection (1) is not liable for costs unless he enters an appearance and takes part in the proceedings.

**71. RIGHTS NOT ASSIGNABLE.**

This Part does not confer on the registered user of a trade mark an assignable or transmissible right to use of that trade mark.

**72. APPEAL.**

A person who is aggrieved by a decision of the Registrar under this Part may appeal to the Court.

**PART X. – ASSIGNMENT OF TRADE MARKS.****73. ASSIGNMENT AND TRANSMISSION OF TRADE MARKS.**

(1) Subject to this section, a registered trade mark may be assigned or transmitted with or without the goodwill of the business concerned in the goods in respect of which the trade mark is registered or of some of those goods.

(2) Subject to Subsections (3), (4) and (5) an assignment of a registered trade mark without goodwill is invalid if–

- (a) the trade mark was not at any time in use in good faith in Papua New Guinea by the assignor or his predecessor in title; or
- (b) a substantially identical or deceptively similar trade mark continues to be used by the assignor, after the assignment in relation to other goods, where–
  - (i) there exists a connection in the course of trade between those goods and the assignor; and
  - (ii) those goods are–
    - (A) of the same description as those in respect of which the trade mark has been assigned; or
    - (B) of such a description that the public is likely to be deceived by the use of the trade mark by the assignor and assignee on their respective goods.

(3) Subsection (2)(a) does not apply where–

- (a) the trade mark was registered with the intention that it should be assigned to a corporation to be formed and the trade mark has been so assigned; or
- (b) the trade mark was registered with the intention that a person should be permitted to use it as a registered user and a registered user has been registered in respect of the trade mark within six months after the registration of the trade mark and has used the trade mark within that period.

(4) An assignment of a trade mark is not invalid if, at the date of the institution of proceedings in which the validity of the assignment is called in question, the trade mark has come to denote to the public a connection in the course of trade between the goods and the assignee to the exclusion of all other persons or, if the registration is limited to a particular area, to the exclusion of all other persons within that particular area.

(5) An assignment of a trade mark shall not be held to be invalid except in proceedings instituted within three years after the registration of the assignment.

(6) If goods bearing a registered trade mark are purchased or acquired by a person, the sale of or other dealing in those goods by that person, or by a person claiming under or through him, is not an infringement of the trade mark by reason only of the trade mark having been assigned by the registered proprietor to some other person after the purchase or acquisition of those goods.

(7) All rights subsisting in a trade mark (being a registered trade mark) whether under this Act or otherwise, shall be deemed to be assigned on the registration of the assignment of the trade mark.

**74. REGISTRATION OF ASSIGNMENT.**

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application and of proof of title to his satisfaction register that person as the proprietor of the trade mark in respect of goods in respect of which the assignment or transmission has effect and cause particulars of the assignment or transmission to be entered in the Register.

(2) A person who is aggrieved by a decision of the Registrar under Subsection (1) may appeal to the Court.

(3) Except in the case of an appeal under this section or of an application under Section 13, a document or instrument in respect of which no entry has been made in the Register in accordance with Subsection (1) is not, unless the Court otherwise directs, admissible in evidence in a court in proof of a title to a registered trade mark.

**PART XI. – PROTECTION OF TRADE MARKS.****75. FORGERY, ETC., OF TRADE MARKS.**

(1) A person who–

- (a) forges a registered trade mark; or
- (b) falsely applies a registered trade mark to goods; or
- (c) makes a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark; or
- (d) disposes of or has in his possession a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark,

is guilty of an offence.

Penalty: A fine not exceeding K2,000.00 or imprisonment for a term not exceeding three years.

(2) It is a defence in proceedings for an offence against Subsection (1) if the defendant proves that he acted without intent to defraud.

**76. SELLING, ETC., OF GOODS WITH FALSE MARKS.**

(1) A person who sells or exposes for sale, or has in his possession for sale or for the purpose of trade or manufacture, goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied, is guilty of an offence.

Penalty: A fine not exceeding K500.00.

(2) It is a defence in proceedings for an offence against Subsection (1) if the defendant proves that he acted without intent to defraud.

**77. IMPORTING GOODS WITH FALSE MARKS.**

A person who knowingly imports into the country goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied, is guilty of an offence.

Penalty: A fine not exceeding K500.00.

**78. FORFEITURE OF GOODS.**

A person convicted of an offence against Section 75, 76 or 77 is liable, in addition to the punishment provided by those sections to forfeit to the State all goods by means of which, or in relation to which, the offence was committed.

**79. AIDING AND ABETTING OFFENCES.**

(1) A person who aids, abets, counsels or procures, or is in any way, directly or indirectly, knowingly concerned in or party to the commission of an act outside Papua New Guinea which if it were committed in Papua New Guinea, would be an offence against this Act, is guilty of an offence.

Penalty: A fine not exceeding K500.00.

(2) Subsection (1) does not affect the operation of the *Criminal Code 1974*.

**80. FORGERY OF TRADE MARK.**

(1) A person shall be deemed to forge a registered trade mark—

- (a) if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of this Act, he makes the trade mark or a mark substantially identical with it; or
- (b) if he falsifies a registered trade mark, whether by alteration, addition, effacement or otherwise.

(2) In a prosecution for forging a trade mark, the burden of proving the assent of the registered proprietor or registered user lies on the defendant.

**81. WHEN TRADE MARK DEEMED APPLIED.**

(1) For the purposes of this section—

“**covering**” includes a stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper;

“**label**” includes a band or ticket.

(2) A trade mark shall be deemed to be applied to goods if it is woven in, impressed on, worked into, or annexed or affixed to, the goods.

(3) A trade mark shall be deemed to be applied to goods where—

- (a) it is applied to the goods themselves; or
- (b) it is applied to a covering, label, reel or thing in or with which the goods are sold or exposed or had in possession for a purpose of trade or manufacture; or
- (c) it is used in a manner likely to lead to the belief that it refers to or describes or designates the goods; or
- (d) it is used in a sign, advertisement, invoice, wine list, catalogue, business letter, business paper, price list or other commercial document and goods are delivered to a person in pursuance of a request or order made by reference to the trade mark as so used.

(4) A registered trade mark shall be deemed to be falsely applied to goods if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark or the authority of this Act, the trade mark or a mark substantially identical with it is applied to the goods.

(5) In a prosecution for falsely applying a registered trade mark to goods, the burden of proving the assent of the registered proprietor or a registered user lies on the defendant.

**PART XII. – APPEALS.**

**82. POWERS OF COURT.**

On the hearing of an appeal under this Act, the Court may–

- (a) admit further evidence, either orally or on affidavit or otherwise; and
- (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence orally or on affidavit or otherwise to the Registrar; and
- (c) order an issue of fact to be tried in such manner as it directs; and
- (d) affirm, reverse or modify the decision, determination or direction appealed from; and
- (e) give such judgement, or make such order, as in all the circumstances it thinks fit, or refuse to make an order; and
- (f) order a party to pay costs to another party.

**83. INTERVENTION BY THE REGISTRAR.**

The Court may grant to the Registrar leave to intervene in an appeal.

**84. SPECIAL CASES.**

The Court may state a case or reserve a question for the consideration of the Supreme Court, or may direct that a case or question be argued before the Supreme Court.



**PART XIII. – MISCELLANEOUS.****85. USE OF TRADE MARK FOR EXPORT TRADE.**

(1) The application in Papua New Guinea of a trade mark to goods to be exported from Papua New Guinea and any other act done in Papua New Guinea in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Papua New Guinea, would constitute use of a trade mark in Papua New Guinea, shall, for the purposes of this Act, be deemed to constitute use of the trade mark in relation to those goods.

(2) Subsection (1) shall be deemed to have had effect in relation to an act done before the commencement date as it has effect in relation to an act done after that date, but does not affect a determination of a court which has been made before that date or the determination of an appeal from a determination so made.

**86. TRADE MARK NOT DECEPTIVE IN CERTAIN CASES.**

The use of a registered trade mark in relation to goods, between which and the person using the trade mark a form of connection in the course of trade subsists, shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of that person, a different form of connection in the course of trade subsisted or subsists.

**87. DISOBEDIENCE TO SUMMONS, ETC., TO BE TREATED AS CONTEMPT OF COURT.**

(1) Where—

- (a) a person fails to appear in obedience to a summons of the Registrar, or to produce a document or article in accordance with a requirement of the Registrar; or
- (b) a person who appears before the Registrar as a witness refuses to be sworn or to make an affirmation, or to produce a document or article or to answer a question which he is lawfully required to produce or answer,

the Registrar may certify the failure or refusal under his hand to the Court.

(2) Where the Registrar gives a certificate under Subsection (1), the Court may enquire into the case and—

- (a) order the person to comply with the requirement of the Registrar within such period as is fixed by the Court; or
- (b) where the Court is satisfied that the failure or refusal was without lawful excuse—punish the person in like manner as if he had been guilty of contempt of the Court, and, if it sees fit, also make an order under Paragraph (a).

**88. RECOVERY OF COSTS.**

Costs awarded by the Registrar may, in default of payment, be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were awarded to the person in whose favour they were awarded.

**89. CERTIFICATE OF VALIDITY.**

In an action or proceeding in which the validity of the registration of a trade mark is unsuccessfully disputed, the Court may certify that the validity of the registration of the trade mark came in question and, if the Court so certifies, then, in a subsequent action or proceeding in which the validity of the registration of the trade mark is disputed, the registered proprietor of the trade mark, on obtaining a final order or judgement in his favour, is entitled, unless the court trying the action or proceeding otherwise directs, to have his full costs, charges, and expenses as between solicitor and client.

**90. GROUNDLESS THREATS.**

(1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding for infringement of a trade mark which is registered, or alleged by the first-mentioned person to be registered, or some other like proceeding, a person aggrieved may, whether the person making the threats is or is not the registered proprietor or the registered user of the trade mark—

- (a) bring any action against the first-mentioned person; and
- (b) obtain a declaration to effect that the threats are unjustifiable and an injunction against the continuance of the threats; and
- (c) recover such damages (if any) as he has sustained,

unless the first-mentioned person satisfies the court that the trade mark is registered and that the acts in respect of which the proceedings were threatened constitute, or, if done, would constitute, an infringement of the trade mark.

(2) Subsection (1) does not apply if the registered proprietor of the trade mark, or a registered user acting in pursuance of Section 70(1) with due diligence commences and prosecutes an action against the person threatened for infringement of the trade mark.

(3) This section does not render a lawyer liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4) Jurisdiction is, by this section, conferred on the Court to hear and determine an action under this section, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action.

**91. COUNTER-CLAIM BY DEFENDANT.**

The defendant in an action or proceeding under Section 90 may apply, by way of counter-claim, for relief to which he would be entitled in a separate action in respect of an infringement by the plaintiff of the trade mark to which the threats relate and in that case the provisions of this Act with respect to an action for infringement of a trade mark are, with the necessary modifications, applicable in relation to that action.

**92. DESCRIPTION OF REGISTERED TRADE MARK.**

In an indictment, information, pleading or proceeding in relation to a registered trade mark, it is not necessary to set out a copy or facsimile of the trade mark or a description of it, but the trade mark may be referred to as a registered trade mark and identified by its registered number.

**93. FEES.**

- (1) There shall be paid to the Registrar such fees as are prescribed.
- (2) Where—
  - (a) a fee is payable in respect of the doing of an act by the Registrar—the Registrar shall not do that act until the fee has been paid; or
  - (b) a fee is payable in respect of the doing of an act by a person other than the Registrar—the act shall be deemed not to have been done until the fee has been paid; or
  - (c) a fee is payable in respect of the lodging of a document—the document shall be deemed not to have been lodged until the fee has been paid.

**94. EXTENSION OF TIME.**

Where, by this Act, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.

**95. COSTS OF REGISTRAR.**

In all proceedings before a court under this Act the costs of the Registrar shall be in the discretion of the court but the Registrar shall not be ordered to pay the costs of any other of the parties.

**96. ADDRESS OF REGISTERED PROPRIETOR OR REGISTERED USER.**

- (1) The address of the registered proprietor and the address of any registered user of a trade mark, as appearing for the time being in the Register, shall for all purposes under this Act be deemed to be the address of the registered proprietor or the registered user, as the case may be.
- (2) The registered proprietor and each registered user of a trade mark shall from time to time notify the Registrar in writing of any change in his address and the Registrar shall alter the Register accordingly.

**97. ADDRESS FOR SERVICE.**

- (1) Notwithstanding Section 96 the registered proprietor and each registered user of a trade mark shall have an address for service, being an address in Papua New Guinea at which documents under this Act may be served on him personally or on a person specified by him on his behalf, which shall be entered in the Register.
- (2) The registered proprietor and each registered user of a trade mark shall from time to time notify the Registrar in writing of any change in his address for service and the Registrar shall alter the Register accordingly.
- (3) In addition to any other method of service provided for by or under this Act or any other law, a document may be served on a registered proprietor or a registered user of a trade mark by leaving it at, or sending it by post to, the address for service of the registered proprietor or the registered user, as the case may be, notified in the Register.

(4) An address for service stated in an application or notice of opposition shall, for the purposes of the application or notice of opposition be deemed to be the address of the applicant or the opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them by post to the address for service of the applicant or the opponent, as the case may be.

#### **98. DECLARATION BY PERSON UNDER DISABILITY.**

If a person is by reason of infancy, lunacy or other disability, incapable of making a declaration or doing anything required or permitted by this Act, the guardian or committee of the incapable person, or if there is no such guardian or committee, a person appointed by a court possessing jurisdiction in respect of the property of incapable persons, on the petition of a person on behalf of the incapable person or of some other person interested in the making of the declaration or the doing of the thing, may make the declaration (or a declaration as nearly corresponding to the declaration as the circumstances permit) and may do that thing, in the name and on behalf of the incapable person and all acts so done are, for the purposes of this Act, as effectually done as if they had been done by the incapable person and that person had not been incapable at the time of the making of the declaration or the doing of the thing.

#### **99. DEATH OF PARTY TO PROCEEDING.**

If a person who is party to a proceeding under this Act (not being a proceeding in a court) dies pending the proceeding, the Registrar may—

- (a) on request, and on proof to his satisfaction of the transmission of the interest of the deceased person—substitute in the proceeding his successor in interest in his place; or
- (b) if he is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties—permit the proceeding to continue without the substitution of his successor in interest.

#### **100. ADAPTATION OF CLASSIFICATION.**

(1) The regulations may make provision for the amendment of the Register, whether by making, expunging or varying entries in the Register, for the purpose of adapting the designation in the Register of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification of goods which is prescribed.

(2) An amendment for the purpose referred to in Subsection (1) shall not be made if it would have the effect of adding goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of goods.

(3) Subsection (2) does not have effect in relation to goods as to which the Registrar is satisfied—

- (a) that compliance with that subsection in relation to those goods would involve undue complexity; and
- (b) that the addition or antedating, as the case may be, would not affect a substantial quantity of goods and would not substantially prejudice the right of any person.

- (1)–
- (4) A proposal for the amendment of the Register for the purpose referred to in Subsection (1)–
- (a) shall be notified to the registered proprietor of the trade mark affected; and
  - (b) shall be advertised in such manner as is prescribed; and
  - (c) may be opposed before the Registrar by a person aggrieved on the ground that the proposed amendment contravenes the provisions of this section.
- (5) A person who is aggrieved by a decision of the Registrar under this section may appeal to the Court.

### **101. SECURITY FOR COSTS.**

Where a person who appeals to the Court under this Act does not reside or carry on business in Papua New Guinea, the Court may require that person to give security for the costs of the appeal, and in default of security being given to the satisfaction of the Court, the appeal may be dismissed.

### **102. SERVICE OF ORDERS ON APPEAL.**

- (1) Where by this Act provision is made for the service on the Registrar of a judgement or order of a court, and an order is made by a court on appeal from the judgement or order, a person in whose favour the order on appeal is made is not entitled to enforce the order until he has served on the Registrar an office copy of the order.
- (2) On the service on him of an order, under Subsection (1), the Registrar shall make such entries (if any) in the Register, or take such other action (if any), as the case requires.

### **103. FALSELY REPRESENTING REGISTRATION OF TRADE MARK.**

- (1) For the purposes of this section, the use in Papua New Guinea, in relation to a trade mark, of the word “registered”, or of some other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration under this Act, except–
- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated, and indicating that the reference is to registration as a trade mark under the law of a country outside Papua New Guinea, being a country under the law of which the registration referred to is in force; or
  - (b) where that word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to such registration as is referred to in Paragraph (a); or
  - (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Papua New Guinea and in relation to goods to be exported to that country.
- (2) A person who makes a representation to the effect–
- (a) with respect to a mark, not being a registered trade mark—that it is registered trade mark; or

- (b) with respect to a part of a registered trade mark, not being a part separately registered as a trade mark—that it is so registered; or
- (c) that a registered trade mark is registered in respect of goods in respect of which it is not registered; or
- (d) that the registration of a trade mark gives a right to the exclusive use of the trade mark in circumstances in which, having regard to conditions or limitations entered on the Register, the registration does not give that right,

is guilty of an offence.

Penalty: A fine not exceeding K200.00.

#### **104. REGULATIONS.**

The Head of State, acting on advice, may make regulations, not inconsistent with this Act, prescribing all matters that by this Act are required or permitted to be prescribed, or that are necessary or convenient to be prescribed for carrying out or giving effect to this Act, or for the conduct of any business relating to the office of the Registrar, and in particular—

- (a) for providing for the destruction of documents relating to trade marks the registration of which has ceased; and
- (b) for prescribing penalties of fines not exceeding K500.00 for offences against the regulations.

**PART XIV. – TRANSITIONAL.****105. INTERPRETATION OF PART XIV.**

(1) In this Part–

**“applicant to whom this Part applies”** in relation to an application means the proprietor of a trade mark–

- (a) who applies to the Registrar for the registration of that trade mark within a period of 12 months from the commencement date, and
- (b) who shows to the satisfaction of the Registrar that he was–
  - (i) on the relevant date, the registered proprietor; or
  - (ii) on the relevant date or subsequent to the relevant date and before the commencement date the successor in title of the registered proprietor,

of that trade mark in and for Papua New Guinea in respect of the same goods to which his application relates by virtue of the registration in Part A or Part B of the Australian Register at that date;

**“application”** means an application for the registration of a trade mark under this Act;

**“the Australian Act”** means the *Trade Marks Act 1955* of Australia;

**“the Australian Register”** means the Register of Trade Marks kept at the Trade Marks Office under the *Trade Marks Act 1955* of Australia;

**“the relevant date”** means 15 September 1975.

(2) For the purposes of this Part, a person is deemed not to have been registered in the Australian Register as the registered proprietor of a trade mark in respect of any goods at the relevant date if his registration as such in respect of those goods was not entered in the Australian Register at that date, notwithstanding that, by virtue of the provisions of the Australian Act, he may be deemed by that Act to have been so registered by that date in consequence of an entry made in the Australian Register after that date.

(3) Where, on the relevant date, a firm or partnership was registered in Part A or Part B of the Australian Register as the proprietor of a trade mark, all the persons who were on that date the proprietors of the firm or the members of the partnership shall be deemed, for the purposes of this Part, to have been registered jointly as the proprietors of the trade mark in the Australian Register at that date.

**106. PRIORITY GIVEN TO CERTAIN APPLICATIONS.**

(1) Notwithstanding any provision of this Act–

- (a) where an application is made by an applicant to whom this Part applies, the Registrar shall give priority to the registration of the trade mark, the subject of that application, over that of any applicant for the registration of a substantially identical or deceptively similar trade mark in respect of the same goods or goods of the same description who is not an applicant to whom this Part applies; and

- (b) on acceptance of an application made by an applicant to whom this Part applies, the Registrar may register the trade mark in the appropriate Part of the Register without advertisement of the acceptance of the application and the provisions of Part VI do not apply to the application.

(2) Subsection (1) applies to an application only where the rights of the applicant in respect of the trade mark would, as a consequence of the registration of the trade mark, in no way extend beyond the rights held by the applicant in respect of that trade mark in Papua New Guinea on the relevant date.

(3) The Registrar may defer acceptance of any application made by a person who is not an applicant to whom this Part applies until after the expiration of a period of 12 months from the commencement date, or he may accept the application and determine any opposition to the application within that period, but may defer registration of the trade mark until after the expiration of that period.

(4) Subject to Subsections (5) and (6), all trade marks registered in accordance with this section shall be deemed to have been registered from 16 September 1975.

(5) Notwithstanding the provisions of Subsection (4) no action for infringement of, or passing off a trade mark registered under this section shall lie in respect of the period from 16 September 1975 to the day before the commencement date.

(6) The provisions of Subsection (5) do not derogate from or affect any common law rights.

Office of Legislative Counsel, PNG