

Act No. 19, 1900.

TRADE MARKS

An Act to consolidate the Acts relating to Trade Marks and fraudulent marks. [22nd September, 1900.]

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

PART I.

Preliminary.

Short title.

1. This Act may be cited as the "Trade Marks Act, 1900," and contains the following Parts:—

PART I.—*Preliminary.*—ss. 1-4.

PART II.—*Registration and transfer.*—ss. 5-9.

PART III.—*Offences.*—ss. 10-29.

PART IV.—*Warranty.*—ss. 30, 31.

PART V.—*Proceedings in suits.*—ss. 32-36.

Repeal.

Interpretation.

28 Vic. No. 9, s. 1. indicates or requires,—

"Apply" and "applied" respectively include attach, attached, and cause or procure to be applied or attached.

"Cover" includes any cask, bottle, stopper, vessel, case, wrapper, band, reel, ticket, or label.

"Denoted" includes intended to be denoted.

"Goods" includes any chattel or article.

"Forge," "forging," and "forged" respectively include counterfeit, counterfeiting, and counterfeited.

"Intent to defraud" includes intent to enable any other person to defraud.

"Justice" means justice of the peace.

"Manufacture" includes workmanship and production.

"Mark" includes any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description.

"Trade

Trade Marks.

“Trade mark” includes any mark lawfully used by any person to denote any goods to be goods of the manufacture or merchandise of such person, or to be goods of any particular description made or sold by such person.

“Person” includes any person whether a subject of Her Majesty or not, and any body corporate or body of the like nature, company, association, or society of persons, whether the same is established or carries on business within or without Her Majesty’s dominions, and whether the members thereof are *saving* or are not subjects of Her Majesty.

“Registrar” means the registrar of trade marks.

4. Nothing in this Act shall be deemed to affect the operation of the “International Patents and Trade-marks Arrangements Act, 1897.”

PART II.

Registration and transfer.

Appointment of
registrar.
28 Vic. No. 9, s. 3.

5. (1) The Governor may appoint a registrar of trade marks and an office to be the place of registration for the purposes of this Act. Any such appointment made under any Act hereby repealed shall have the same force and effect as it would have had if this Act had been in force when such appointment was made and it had been made hereunder.

(2) The registrar shall keep a proper register of all certificates issued and of all acts done by him in pursuance of this Act, and such register shall be open to the inspection of any person during office hours on payment of the sum of sixpence.

6. Any person desirous of registering a trade mark shall deliver to the registrar two copies thereof, and shall at the same time pay to the registrar for the public uses of New South Wales a sum of three pounds and three shillings, and shall also state in writing the nature of the article to which it is proposed that such trade mark shall apply. The registrar shall within fourteen days of the payment of such fee publish in the Gazette a notice stating—

- (a) the name of the applicant;
- (b) a description of the trade mark as nearly as may be; and
- (c) the nature of the article to which it is proposed that such trade mark shall apply;

and after the expiration of fourteen days from the publication aforesaid the registrar shall, unless it is shown to his satisfaction

- (d) that such trade mark has been previously registered; or
- (e) that some other person is entitled to such trade mark; or
- (f) that such trade mark is so like some other trade mark that it may be mistaken for the same,

Registration of
trade mark.
Ibid. s. 4.

issue

Trade Marks.

issue to the applicant a certificate setting forth that such trade mark to be described in such certificate has been duly registered, and that the person named in such certificate is entitled to the use of the trade mark described therein.

Transfer.

28 Vic. No. 9, s. 6.

7. Any certificate may be transferred either wholly or in part by any document in writing signed by the transferor, but no transfer shall be valid against the person named in such certificate until after such transfer has been duly registered, and the registrar shall register such transfer on payment of the sum of one pound one shilling.

Trade mark must be registered.

Ibid. s. 2.

Effect of registration.

Ibid. s. 7.

8. A mark shall not be recognised or considered to be the trade mark of any person until it has been registered by or on behalf of the person claiming to be entitled thereto as his trade mark.

9. The registration of any trade mark shall not confer any patent right over, or any sole right to manufacture, any article to which it is proposed to apply such trade mark, but the certificate of the registration of any trade mark shall be a proof of the right of the person named in such certificate, or of the registered transferee of such certificate, to use such trade mark, except in case of any suit instituted to try the right of any person to have had such trade mark registered.

PART III.

Offences.

Forging or fraudulently applying trade mark to goods.

Ibid. s. 8.

10. Whosoever with intent to defraud—

- (a) forges or procures to be forged any trade mark; or
- (b) applies any trade mark or any forged trade mark to any goods, not being the manufacture or merchandise of any person denoted by such trade mark or whose trade mark is so forged; or
- (c) applies any trade mark or forged trade mark to any goods not being the particular description of manufacture or merchandise denoted by such trade mark or forged trade mark,

shall be guilty of a misdemeanour, and shall also forfeit to Her Majesty all goods belonging to him to which he shall have so applied any such trade mark or forged trade mark.

Applying forged trade mark to cover, &c.

Ibid. s. 9.

11. Whosoever with intent to defraud—

- (a) applies any trade mark or forged trade mark to any cover or other thing in or with which any goods are intended to be sold, or are sold, or uttered or exposed for sale, or for any purpose of trade or manufacture; or
- (b) places, or causes or procures to be enclosed or placed, any goods in or with, or applies to any goods, any cover or other thing

Trade Marks.

thing to which any trade mark has been falsely applied, or to which any forged trade mark has been applied, or having thereon any trade mark of any other person,

shall be guilty of a misdemeanour, and shall also forfeit to Her Majesty all such goods, and also every such cover or other thing in his possession or power, and every other similar cover or other thing made to be used in like manner.

12. Any person who commits any of the misdemeanours under the tenth and eleventh sections hereof, shall also forfeit to Her Majesty every instrument in his possession or power which has been, or is fitted to be, used for applying any such trade mark or forged trade mark, and the Court before which any such misdemeanour is tried may order all goods, instruments, and things forfeited under this or the said sections to be destroyed or otherwise disposed of as such Court thinks fit.

13. Whosoever with intent to defraud puts or causes or procures to be put upon any goods, or upon any cover, case, frame, or other thing, with or in or by means of which any goods are intended to be or are sold, or uttered, or exposed for any purpose of trade or manufacture—

- (a) any false description, statement, or other indication of or respecting the number, quantity, measure, or weight of such goods, or any part thereof, or of the place or country in which such goods have been made, manufactured, or produced; or,
- (b) any word, letter, figure, signature, or mark for the purpose of falsely indicating such goods, or the mode of manufacturing or producing the same, or the ornamentation, shape, or configuration thereof, to be the subject of any existing patent, privilege, or copyright,

shall, for every such offence, forfeit and pay a sum of money equal to the value of the goods so falsely described or indicated, and a further sum not exceeding five pounds and not less than ten shillings.

14. At the trial of any person charged with an offence under sections ten, eleven, or thirteen, it shall not be necessary to prove that the acts complained of were done with intent to defraud, but the burden of proving that they were done without intent to defraud shall be on the person so charged.

15. (1) Whosoever sells, utters, or exposes for sale or for any purpose of trade or manufacture, or causes or procures to be sold, uttered, or exposed for sale or such purpose any goods—

- (a) with any forged trade mark knowing the same to be forged; or,
- (b) with the trade mark of any other person used falsely or wrongfully or without lawful authority or excuse, knowing such trade mark to be so used,

shall,

Forfeiture of certain instruments.
28 Vic. No. 9, ss. 8, 9.

False description of goods.
Ibid. s. 13.

Burden of proof under ss. 10, 11, and 13.

56 Vic. No. 13, s. 2.

Selling goods bearing forged trade mark.
28 Vic. No. 9, s. 10.

Trade Marks.

shall, for every such offence, forfeit and pay a sum equal to the value of the goods so sold, uttered, or exposed, and a further sum not exceeding five pounds and not less than ten shillings.

Definition.

28 Vic. No. 9, s. 10. (2) Any such goods shall be deemed to be sold, uttered, or exposed with such forged or other trade mark, if the same—

- (a) is in or with such goods; or,
- (b) is in or with any cover or other thing used with such goods.

Burden of proof under s. 15.

56 Vic. No. 13, s. 3. 16. At the trial of any person charged with an offence under the last preceding section, it shall not be necessary to prove that he knew that the trade mark was forged, or knew that the trade mark of another person had been applied or used falsely, wrongfully, or without lawful authority or excuse, as the case may be, but the burden of proving the absence of such knowledge shall be on the person so charged.

Definition of forging.

28 Vic. No. 9, s. 11. 17. Every addition to and alteration of, and also every imitation of any trade mark made, applied, or used with intent to defraud, or which causes a trade mark with such alteration or addition, or such imitation of a trade mark to resemble any genuine trade mark so as to be calculated or likely to deceive, shall be deemed to be a false and forged trade mark within the meaning of this Act: And every act of making, applying, or otherwise using any such addition to or alteration or imitation of a trade mark as aforesaid, done by any person with intent to defraud, shall be deemed to be forging a trade mark within the meaning of this Act.

Any person selling goods with forged trade mark may be required to state where he obtained them.

Ibid. s. 12.

18. Any person who has sold, uttered, or exposed for sale or for any purpose of trade or manufacture, or has caused or procured to be so sold, uttered, or exposed, any goods with any forged trade mark, or with the trade mark of any other person used without lawful authority or excuse (whether such forged or other trade mark is upon or with such goods, or upon or with any cover or other thing with which such goods have been so sold, uttered, or exposed), shall be bound upon demand in writing, delivered to him or left for him at his last known dwelling-house, or at the place of sale, uttering, or exposure, by or on behalf of any person whose trade mark has been so forged or used, to give to the person requiring the same, or his attorney or agent, within forty-eight hours after such demand, full information in writing of the name and address of the person from whom, and of the time when, he obtained such goods, and if he refuses so to do, any justice, on information on oath of such demand and refusal, may summon before him the party refusing, and on being satisfied that such demand ought to be complied with, may order such information to be given within a certain time to be appointed by him, and any party who refuses or neglects to comply with such order shall, for every such offence, forfeit and pay the sum of five pounds, and such refusal or neglect shall be evidence that such party knew

Trade Marks.

knew that the trade mark with which such goods were so sold, uttered, or exposed was a forged trade mark, or a trade mark used without lawful authority or excuse, as the case may be.

19. Whosoever, knowing that any false description, statement, or other indication of or respecting—

*Selling goods with
false description.*
28 Vic. No. 9, s. 14.

(a) the number, quantity, measure or weight of any goods or of any part thereof; or

(b) the place or country where such goods have been manufactured or produced;

has been put upon—

(c) any such goods; or

(d) any cover or other thing containing or with such goods; or

(e) any case, frame, or thing used to expose such goods for sale, sells, utters, or exposes any such goods for sale or any purpose of trade or manufacture, or causes or procures any such goods to be so sold, uttered, or exposed shall, for every such offence, be liable to a penalty not exceeding five pounds and not less than ten shillings.

20. At the trial of any person charged with an offence under the last preceding section it shall not be necessary to prove that the said person knew that any false description, statement, or other indication of or respecting any of the matters mentioned in the said section had been put upon any of the goods, articles, or things in the said section mentioned, but the burden of proving the absence of such knowledge shall be on the person so charged.

*Burden of proof
under s. 19.*
56 Vic. No. 13, s. 4.

21. The provisions of this Act shall not be construed to make it an offence for any person—

*Class of goods may
be indicated by word
in general use.*
28 Vic. No. 9, s. 15.

(a) to apply to any goods or to any cover or other thing with which such goods are sold or intended to be sold, any name, word, or expression generally used for indicating such goods to be of some particular description of manufacture; or

(b) to sell, utter, or expose for sale any goods to which, or to any cover or other thing sold therewith, any such generally used name, word, or expression has been applied.

22. In every indictment, pleading, proceeding, and document whatsoever in which any trade mark or forged trade mark is intended to be mentioned, it shall be sufficient to state the same to be a trade mark or forged trade mark, as the case may be, without further describing such trade mark or forged trade mark, or setting forth any copy or fac-simile thereof.

*Description of trade
mark in indictment.*
Ibid. s. 16.

23. The provisions of this Act concerning any offence under this Act shall not affect any right or remedy which any person aggrieved by such act is entitled to at law, or in equity, and shall not excuse any person from answering or making discovery upon examination as a witness or upon interrogatories or otherwise in any suit or other civil proceeding.

*Civil rights not
affected by this Act.*
Ibid. s. 17.

Provided

Trade Marks.

Proviso.

Provided always that no evidence, statement, or discovery, which any person is compelled to give or make, shall be admissible in evidence against such person in support of any indictment or of any proceeding under this Act.

Intent to defraud.

28 Vic. No. 9, s. 18.

24. In every case where it is necessary to allege an intent to defraud, it shall be sufficient to allege that the person accused did the act with intent to defraud without alleging an intent to defraud any particular person.

Punishment for
misdemeanour.*Ibid.* s. 20.

25. Every person convicted of any offence which is by this Act made a misdemeanour shall be liable to imprisonment, with or without hard labour, for not more than two years, or to a fine, or to imprisonment with or without hard labour and a fine, and also to imprisonment until the fine, if any, has been paid.

Recovery of
penalties.*Ibid.* s. 21.

26. (1) Where any person has committed any offence whereby he has forfeited or become liable to pay any of the penalties or sums mentioned in this Act, every such penalty or sum may be recovered in an action of debt which any person may, as plaintiff for and on behalf of Her Majesty, commence in any Court of Record; and the amount of every such penalty or sum shall be determined by the jury (if any), and if there is no jury, then by the Court, or some other jury as the Court thinks fit.

(2) In lieu of such proceeding such penalty or sum may be recovered by a summary proceeding before two justices having jurisdiction in the district or place where the offender resides or has any place of business, or in the district or place in which the offence was committed.

Execution and costs.

Ibid. s. 23.

27. In every case in which judgment is obtained in any such action for the amount of any such penalty or sum, such amount shall be paid by the defendant to the sheriff or the officer of the Court who shall account for the same to the Colonial Treasurer, and if it is not paid may be recovered, or the amount thereof levied, or the payment thereof enforced, by execution or other proper proceeding as money due to Her Majesty; and the plaintiff suing on behalf of Her Majesty shall, upon obtaining judgment, be entitled to have execution for all his costs of suit which shall include all costs and charges which he has expended or incurred in, about, or for the purposes of the action, unless the Court or a Judge thereof directs that costs of the ordinary amount only shall be allowed.

Summary
proceedings.*Ibid.* s. 22.

28. All penalties and forfeitures under this Act may be recovered and adjudged, and all offences, except misdemeanours, may be prosecuted before and heard and determined by any two justices in accordance with the Acts in force for the time being relating to summary proceedings before justices.

Search warrants.

29. Where, upon information of an offence against this Act, a justice has issued a summons requiring the defendant to appear, or a warrant

Trade Marks.

warrant for the arrest of the defendant, and either the said or any other justice is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to, which the said offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, the said justice may issue a warrant under his hand, by virtue of which any constable named may enter the said house, premises, or place at any reasonable time by day, and there search for and seize and take away such goods and things, and any goods or things seized under any such warrant shall be brought before a justice who shall thereupon determine whether the same are or are not liable to forfeiture under this Act.

PART IV.

Warranty.

30. If any person sells or contracts to sell, whether by writing or not, to any other person any goods upon which, or upon any cover or other thing, with which such goods are sold, or contracted to be sold, there is any trade mark, the sale, or contract to sell, shall in every such case be deemed to be made with a warranty or contract by the vendor with the vendee that such trade mark is genuine, and not wrongfully used, unless the contrary is expressed in some writing, signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

Warranty of trade
mark.
28 Vic. No. 9, s. 25.

31. If any person sells or contracts to sell, whether by writing or not, to any other person, any goods upon which, or upon any cover or other thing with which such goods are sold, or contracted to be sold, any description, statement, or other indication of or respecting the number, quantity, measure, or weight of such goods, or the place or country in which such goods have been made, manufactured, or produced appears, the sale or contract to sell shall in every such case be deemed to be made with a warranty or contract by the vendor, to or with the vendee, that no such description, statement, or other indication is in any material respect untrue, unless the contrary is expressed in some writing, signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

Warranty of
description.
Ibid. s. 26.

PART

PART V.

Proceedings in suits.

Powers of Court.

28 Vic. No. 9, s. 27.

32. (1) In any suit at law or in equity against any person for forging any trade mark, or for fraudulently applying any trade mark to any goods, or for selling, exposing for sale, or uttering any goods with any trade mark falsely or wrongfully applied thereto, or with any forged trade mark applied thereto, or for preventing the repetition or continuance of any such wrongful act, or the committal of any similar act, in which the plaintiff obtains a judgment or decree against the defendant, the Court may direct such goods to be destroyed or otherwise disposed of.

Inspection.

(2) In any such suit the Court or Judge may make an order as such Court or Judge thinks fit for the inspection of—

- (a) any manufacture or process carried on by the defendant in which any such forged trade mark or any such trade mark as aforesaid shall be alleged to be so used or applied; and
- (b) all goods in the possession or power of the defendant, alleged to have thereon, or in any way attached thereto, any forged trade mark, or any trade mark falsely or wrongfully applied; and
- (c) every instrument in the possession or power of the defendant used, or intended to be, or capable of being used for making any forged trade mark or trade mark alleged to be forged, or falsely or wrongfully applying any trade mark;

and any person who refuses or neglects to obey any such order shall be guilty of a contempt of Court.

Injunction.

(3) In any such suit at law the Court may, upon giving judgment for the plaintiff, award a writ of injunction against the defendant commanding him to forbear from committing, and not, by himself or otherwise, to repeat or commit, any offence or wrongful act of the like nature as that of which he has been convicted by such judgment, and any disobedience of any such writ of injunction shall be punished as a contempt of Court.

Action for damages
in respect of certain
wrongful acts.*Ibid.* s. 28.

33. Whenever any person,—

- (a) forges any trade mark; or,
- (b) for the purpose of sale or for any purpose of trade or manufacture applies any forged trade mark to any goods or to any cover or other thing used with any goods; or,
- (c) encloses or places any goods in or with any cover or other thing, to which any trade mark has been falsely applied or to which any forged trade mark has been applied; or,
- (d) applies to any goods, any cover or other thing to which any trade mark has been falsely applied, or to which any forged trade mark has been applied; or,
- (e)

Trade Marks.

(e) encloses, or places any goods in or with any cover or other thing having thereon any trade mark of any other person; every person aggrieved thereby may maintain an action or suit for damages in respect thereof, and for preventing the repetition or continuance of the wrongful act and the committal of any similar act.

34. In every action which any person under the provisions of this Act commences as plaintiff, for or on behalf of Her Majesty, for recovering any penalty or sum, if the defendant obtains judgment he shall be entitled to recover his costs of suit which shall include a full indemnity for all the costs, charges, and expenses by him expended or incurred in, about, or for the purposes of the action, unless the Court or a Judge thereof directs that costs of the ordinary amount only shall be allowed.

35. In any action which any person under the provisions of this Act commences as plaintiff, for or on behalf of Her Majesty, to recover any penalty or sum, if it is shown to the satisfaction of the Court or a Judge thereof that such person has no ground for alleging that he has been aggrieved by the committing of the alleged offence in respect of which the penalty or sum is alleged to have become payable, and also that such person is not resident within the jurisdiction of the Court, or not a person of sufficient property to be able to pay any costs which the defendant may recover in the action, the Court or Judge may order that the plaintiff shall give security by the bond or recognizance of himself and a surety, or by the deposit of a sum of money, or otherwise as the Court or Judge thinks fit, for the payment to the defendant of any costs which he may be entitled to recover in the action.

36. No person shall commence any action or proceeding for the recovery of any penalty, or for procuring the conviction of any offender, in manner hereinbefore provided, after the expiration of one year next after the committing of the offence, or one year next after the first discovery thereof by the person proceeding.

SCHEDULE.

Reference to Acts.	Title or short title.	Extent of repeal.
28 Vic. No. 9 ...	The Trades Marks Act, 1865	The whole.
56 Vic. No. 13 ...	Trades Marks Act Amendment Act	The whole.