

1995—No. 770

SUPREME COURT RULES (AMENDMENT No. 297) 1995

NEW SOUTH WALES



[Published in Gazette No. 156 of 22 December 1995]

1. These rules are made by the Rule Committee on 18 December 1995.
2. The Criminal Appeal Rules are amended as follows:
 - (a) Rule 53
Renumber the rule as 53 (1).
 - (b) After subrule (1) insert:
 - (2) Such entry shall be made in conformity with the administration of the Court of Trial on:
 - (a) the indictment;
 - (b) the appropriate Court file; or
 - (c) the appropriate computer record.
3. The Supreme Court Rules 1970 are amended as follows:
 - (a) Part 81 rule 2 (1) (g)
Omit “1955” and insert instead “1995”.
 - (b) Part 81 rule 38
Omit the rule and insert instead:

Pending proceedings—defence, etc to action for infringement

38A. (1) This rule applies to proceedings:

 - (a) to which section 250 of the Trade Marks Act applies (proceedings arising from an application to a court under section 22 of the Trade Marks Act 1955 which were pending immediately before 1 January 1996); or
 - (b) to which section 251 of the Trade Marks Act applies (proceedings arising from an application to the Registrar or a court under section 23 of the Trade Marks Act 1955 which were pending immediately before 1 January 1996).

(2) The defendant in an action for infringement of a registered trade mark may:

- (a) in a defence, dispute the validity of the registration of that trade mark;
- (b) apply by way of counter-claim for an order:
 - (i) under section 22 (1) of the Trade Marks Act 1955 for the rectification of the Register by the expunging or amendment of the entry wrongly made or remaining in the Register; or
 - (ii) under section 23 (1) of the Trade Marks Act 1955 (which subsection relates to removal of a trade mark from the Register); or
- (c) do both.

(3) A person who:

- (a) in an action, disputes the validity of the registration of a registered trade mark;
- (b) applies for an order mentioned in (2) (b); or
- (c) does both,

shall deliver with the pleading in which the person disputes the validity of the trade mark, particulars of the grounds of invalidity on which the person relies.

(c) Part 81

After rule 37 insert:

Counter-claim to action for infringement

38. (1) The defendant in an action for infringement of a registered trade mark may apply by way of counter-claim for an order:

- (a) that the Register be rectified; or
- (b) directing the Registrar to remove the trade mark from the Register.

(2) There shall be delivered with the counter-claim particulars of the grounds on which the order is sought.

(d) Part 81

After rule 38A insert:

Judgment in absence of defendant

38B. (1) Unless the Court otherwise orders, a judgment based on infringement of a trade mark shall not be given or entered against a defendant in his or her absence, unless the plaintiff files an affidavit that the action is not in contravention of section 128 of the Trade Marks Act.

(2) Unless the Court otherwise orders, a judgment based on section 129 of the Trade Marks Act shall not be given or entered against a defendant in his or her absence, unless the plaintiff files an affidavit that the action is not in contravention of section 129 (5) of the Trade Marks Act.

Evidences for purposes of Regulation 8.2

38C. The evidence in support of an application to which regulation 8.2 of the Trade Marks Regulations (which relates to certain applications for rectification of the Register) applies shall, unless the Court otherwise orders, include evidence which is sufficient to enable the Court to comply with the regulation.

4. The amendments contained in paragraph 3 shall take effect on 1 January 1996.

5. The Supreme Court Rules are further amended as follows:

Part 52A rule 30

After subrule (5), insert:

(6) Where, by operation of section 18 (5) (a) or (b) of the subject Act, an order for rehearing of proceedings ceases to have effect, the applicant shall pay the costs of every other party incurred by reason of the order for rehearing, unless the Court otherwise orders.

EXPLANATORY NOTE

(This note does not form part of the rules)

1. The object of the amendment contained in paragraph 2 is to require:
 - (a) particulars of orders or directions of the Court of Criminal Appeal to be noted by the proper officer of the Court of Trial on the record of the Court of Trial;
 - (b) such entry to be made in conformity with the administration of the Court of Trial on:
 - (i) the indictment;
 - (ii) the appropriate Court file; or
 - (iii) the appropriate computer record.

Such orders or directions are presently required to be recorded on the indictment.

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2. The object of the amendments contained in paragraph 3 is to take account of the replacement of the Trade Marks Act 1955 (Commonwealth) by the Trade Marks Act 1995 (Commonwealth).

3. The object of the amendment contained in paragraph 5 is to add a subrule which was inadvertently omitted when Part 52A (which superseded Part 52) was being prepared.

M. A. Blay,
Secretary of the Rule Committee.
