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### Trade Marks Act 1976: A 2019 Outfit on its Way (Part 3)

As noted in our previous updates ([“Trade Marks Act 1976: A 2019 Outfit on its Way \(Part 1\)”](#) and [\(Part 2\)](#)), the House of Representatives had its first reading of the Trademarks Bill 2019 (“**the Bill**”) recently, which proposes to include various amendments, including the recognition of non-conventional trademarks.

Other amendments include changes to the provisions in relation to trademark infringement. The Bill proposes to, among others:

- ☞ expand both the list of what amounts to “use of a mark” for the purposes of establishing infringement, and what amounts to “use in good faith” of a mark as an act not amounting to infringement;
- ☞ provide expressly that an infringement action cannot be instituted in relation to “an act that was done after the registration of trademark has expired or has been deemed removed and before it was renewed or restored”;
- ☞ expands the scope of remedies available for trademark owners.

❖ These new provisions effectively entrench in statute the remedies available for trademark infringement, which includes:

- ✓ an injunction;
  - ☞ The provision on the granting of injunction also includes preventing the infringing goods “from entering into the channels of commerce”.
- ✓ damages;
- ✓ account of profits; and
- ✓ additional damages for counterfeit trademark.

☞ In relation to use by the infringer of a counterfeit trademark, the plaintiff would also be entitled to additional damages. In assessing

whether additional damages ought to be granted, the court may take into account the “flagrancy of the infringement”, whether the defendant has obtained any benefits as a result of the infringement, and whether the defendant is to be punished for infringing the trademark.

☞ in the event of trademark infringement, the court may order:

- ✓ the infringer to erase, remove or obliterate *the infringing mark* “from any infringing goods, material or articles in his possession, custody or control”;
- ✓ “the destruction of the infringing goods, material or articles in question”; or
- ✓ delivery up to the plaintiff to ensure that the infringing mark is erased, removed or obliterated.
- ✓ a declaration for delivery up and destruction of *counterfeit goods* which are in the “possession, custody or control” of the infringer upon the application by the plaintiff.
- ✓ a declaration for delivery up of infringing goods, material or articles to the plaintiff, for the purposes of destroying *the infringing goods or forfeiting the goods* to the plaintiff.

☞ a remedy for an aggrieved party who can establish they are facing groundless threats of infringement proceedings

❖ The types of relief available include:

- ✓ “a declaration that the threats are unjustifiable”;
- ✓ “an injunction against the continuance of the threats”; or
- ✓ damages.

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