

Trade mark oppositions in Australia

Procedural steps in Australian trade mark oppositions

Notice of Opposition

Under Australian practice, filing a Notice of Opposition is a two-step process. The opposition is considered filed when both of the following steps have been completed:

- **Notice of Intention to Oppose (NIO)** – the first step is to file a NIO indicating an intention to oppose registration of a trade mark. This must be filed within *two months* of the date of advertisement of acceptance of a trade mark. There are extremely limited grounds for obtaining an extension of time to file a NIO – typically an error or omissions on the part of the opponent or its agent. For this reason, it is best practice to treat the opposition deadline as non-extendable; and
- **Statement of Grounds and Particulars (SGP)** – following filing of the NIO, there is a one month deadline to file the SGP. The SGP particularises the grounds/basis of opposition but is not required or intended to be evidence of the grounds of opposition. However, if prior use or reputation in a trade mark is included in a ground of opposition, the SGP must contain statements as to the date of first use of the trade mark in Australia and the goods/services for which such use is claimed.

The Australian Trade Marks Office (TMO) assesses the SGP for compliance and will issue a Notice of Irregularity for correction or deletion of grounds if it is considered any ground is not adequately particularised. The TMO notifies the applicant/holder for the opposed trade mark when a compliant SGP is filed.

Notice of Intention to Defend

The applicant/holder of the opposed trade mark has one month from the date of official notification of the SGP to file a Notice of Intention to Defend (NID). If the NID is not filed by the deadline, the opposed trade mark will automatically lapse and the opposition proceedings will be concluded. If the NID is filed, the opposition enters the evidence cycle and each party has limited timeframes to file its evidence.

Cooling-off period

If genuine settlement negotiations are underway the parties may jointly request a cooling-off period at any time **after** the SGP has been filed. The initial cooling-off period is for six (6) months and can be extended for one further six (6) month period on joint request by the parties. A total of no more than 12 months cooling-off may be granted. The cooling-off period may be terminated by either party at any time and the Registrar has no power to grant any further cooling-off. However, in certain circumstances, the parties *may* be able to jointly request a suspension of the proceedings.



Evidence cycle

An Australian trade mark opposition is not merely an administrative review and provides both parties with the opportunity to file evidence before the matter is determined. Evidence in Support filed by the opponent is followed by Evidence in Answer by the applicant/holder. The opponent may file Evidence in Reply in some circumstances. Any evidence filed in the opposition must be in the form of a declaration (witness statement).

Evidence typically includes a detailed history of the creation, adoption and use of the trade mark including sales figures and promotional expenditure in Australia supported with dated invoices, samples of advertisements, labels or signage to show the extent of reputation and goodwill in the trade mark. Evidence may include details of market conditions, instances of confusion or evidence that might support a ground such as bad faith.

A period of three months is allowed to file Evidence in Support or Evidence in Answer. A shortened period of two months only is allowed to file Evidence in Reply. There are extremely limited grounds for requesting an extension of time to file evidence - such as an error or omission on the part of the parties or their agent. For this reason, it is best practice to treat the deadlines as non-extendable.

Decision

When the evidence cycle is completed, either party may request that the opposition be decided and elect to file submissions or be represented at a Hearing. In the absence of a request by either party within a time specified by the Registrar, the Registrar may make a direction for decision of the opposition on the written record.

The Registrar's Delegate deciding the opposition issues a written decision which may include an award of costs. An award of costs for the successful party is common and is based on a scale published in the Trade Marks Regulations (rather than a party's actual costs). Enforcement of a costs award is a civil matter outside the jurisdiction of the TMO.

The decision of the Registrar may be appealed (*de novo*) to the Federal Court or Federal Circuit Court within 21 days of the date of the decision.

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