

Australian Trade Mark Oppositions

What is an Opposition?

An opposition is an objection to the registration of a trade mark. If the Trade Marks Office accepts a trade mark application, any person may object to the registration of a trade mark by filing a formal opposition with the Trade Marks Office.

There are several potential grounds for opposing a trade mark. For example, an opposition could be filed on the basis that the trade mark is too similar to a mark that is already registered.

What is the Process?

The first step is for the opponent to file a Notice of Intention to Oppose within the two month "opposition period" commencing on the date the acceptance of the mark is advertised. The two month opposition period may only be extended in very limited circumstances.

The opponent is then required to prepare and file a Statement of Grounds and Particulars within one month of filing the Notice of Intention to Oppose. This Statement will need to specify the exact grounds of opposition relied upon by the opponent and the material facts upon which each ground is based. The Registrar has the power to dismiss an opposition if this Statement is not filed.

In order to defend the opposition, the applicant is required to file a Notice of Intention to Defend within one month of receiving the opponent's Statement of Grounds and Particulars. If the applicant fails to file this Notice, the application will lapse and the opponent will not need to pursue the opposition.

After a Notice of Intention to Defend is filed, the parties have an opportunity to file evidence. Evidence must be filed in the form of a declaration(s).

First, the opponent has a three month period within which to file evidence in support of the opposition. Secondly, the applicant has a three month period within which to file evidence in answer. Finally, the opponent has a two month period within which to file evidence in reply.

Extensions of time for filing evidence

Extensions of time for filing evidence will only be granted at the discretion of the Registrar and extensions may only be given if:

- (i) the Registrar is satisfied that all reasonable efforts have been made to meet a deadline, and failure to meet the deadline is despite acting promptly and diligently; or
- (ii) if there are exceptional circumstances.

How is a decision made?

Once the evidence stage is complete, both parties will be given an opportunity to request a hearing.

If a hearing is requested, the parties will have an opportunity to make submissions before a hearing officer. A hearing officer will decide whether to hold an oral hearing or whether the parties will only be given an opportunity to make written submissions. If an oral hearing is held, it can be attended in person (generally in Canberra) or by telephone.

If there is an oral hearing, it is usual for each side to be represented by a trade marks practitioner and, in some cases, barristers are also engaged. After the hearing, the hearing officer will issue a written decision.

If there is no oral hearing, a decision will be issued based on the evidence and any written submissions filed by the parties.

Hearing decisions may be appealed to the Federal Court of Australia or the Federal Circuit Court.

How much do Oppositions cost?

The costs involved will depend on a number of factors including the nature and extent of the evidence filed, whether extensions of time are requested and whether there is a hearing. In some cases, the opposition is resolved between the parties during the course of the proceedings and the timing of settlement will affect the costs involved.

If a matter proceeds to a decision, an award of costs is generally awarded against the unsuccessful party according to a set scale.

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Our trade mark services include:

- Advising on the registrability of proposed trade marks
- Preparing and filing trade mark applications in Australia and also overseas
- Prosecuting trade mark applications through to registration
- Providing trade mark infringement advice
- Handling trade mark opposition matters and trade mark cancellation proceedings
- Filing domain name applications and handling domain name complaints

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