

# Australian Trade Mark Non-Use Removal Applications

## **What are the grounds for filing a Non-Use Removal Application?**

There are two potential grounds for filing a non-use removal application against an Australian trade mark registration.

It is possible to request the removal of a trade mark registration on the basis of "non-use" once the trade mark has been registered for a certain number of years. For a trade mark filed before 24 February 2019, the mark is vulnerable to challenge only after the mark has been registered for more than 5 years (with the 5 year period calculated from the filing date of the application). For a trade mark filed after 24 February 2019, the mark is vulnerable to challenge after the mark has been registered for more than 3 years (but in this case the 3 year period is calculated from the date the mark proceeds to registration).

It is also possible to request the removal of a trade mark registration on the basis that the owner had "no intention to use" the mark at the time of filing the application. A removal application based on this ground may be filed at any time after the mark is registered.

To defend a removal application based on "non-use", the registered owner will need to demonstrate some use of the mark in the 3 year period ending one month prior to the removal application being filed, or establish that there were obstacles which prevented the use of the mark within this period. To defend a removal application based on "no intention to use", the registered owner must simply show that they had a genuine intention to use the mark in the future. In both cases, the Registrar has the discretion to maintain a registration even if the requirements have not been satisfied, but only if there are reasonable grounds for not removing the registration taking into account the public interest.

## **What is the process?**

To commence the process, a removal application must be filed with the Trade Marks Office specifying the grounds for requesting the cancellation and specifying whether the request is for a full or partial cancellation of the registration (i.e. for all or some of the goods/services covered by the registration).

To defend a removal application, the registered owner must file a Notice of Intention to Oppose the removal of the registration, followed by a Statement of Grounds and Particulars outlining the basis for defending the registration. If this documentation is not filed by the registered owner, the registration will be cancelled, or partially cancelled, as requested in the removal application.

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- 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

## **What is the process? (continued)**

If this documentation is filed, the removal applicant is then required to file a Notice of Intention to Defend. If the removal applicant fails to file this Notice, the removal application will be abandoned and the trade mark will remain registered.

After a Notice of Intention to Defend is filed, the parties have an opportunity to file evidence (in the form of a declaration(s)). First, the registered owner has the opportunity to file evidence in support of the registration. Secondly, the removal applicant has the opportunity to file evidence in answer. Finally, the registered owner may file evidence in reply to the evidence in answer.

The relevant time periods for taking each step are outlined in the flow chart overleaf.

## **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 non-use removal proceedings 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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