

Trade Mark Oppositions in Australia.

Trade mark opposition in Australia

This brochure sets out the relevant procedures and timelines applicable to trade mark oppositions in Australia.

Notice of Opposition

A 'Notice of Opposition' is completed in two stages:

1. Notice of Intention to Oppose

The Notice of Intention to Oppose (NIO) must be lodged within two months from the date of advertisement of acceptance, or from the date of advertisement of a removal action. The NIO sets out the name and address of the opponent, its Australian address for service, and the details of the application or action being opposed.

2. Statement of Grounds and Particulars

Within one month of filing the NIO, an opponent must file a Statement of Grounds and Particulars (SoGaP) setting out the grounds on which the opponent intends to rely, and the facts and circumstances forming the basis for those grounds. This requirement is strictly enforced, and the Registrar of Trade Marks may dismiss an opposition or strike out grounds if the SoGaP is found inadequate.

Notice of Intention to Defend

The trade mark applicant, or applicant of the removal action, must file a Notice of Intention to Defend (NID) within one month of the date on which the Office gives it the SoGaP. Failure to file the NID will result in the lapsing of the opposed application or action. It is therefore critical that applicants maintain a current Australian address for service or, in the case of holders of international registrations designating Australia, appoint an Australian address for service upon receipt of the NIO.

Evidentiary Stages

After the NID has been given to the opponent, the parties may lodge evidence to support their respective cases, or to rebut the grounds raised by the other side, where applicable. All evidence should be provided in declaratory form, and must be lodged with the Office electronically where possible.

Evidence in Support

If an opponent wishes to rely on any Evidence in Support of the opposition, this evidence must be filed with the Office within three months of the date on which the Office gives the opponent a copy of the NID. Evidence in Support should relate to the grounds set out in the SoGaP.

Evidence in Answer

If the applicant intends to respond to the opponent's Evidence in Support, the applicant must file its Evidence in Answer within three months of the date on which the Office gives the applicant a copy of the Evidence in Support.

Evidence in Reply

If Evidence in Answer is filed, the opponent may respond by filing Evidence in Reply with the Office within two months of being given a copy of the Evidence in Answer.

Extensions of Time

Extensions of time to file documents and evidence are subject to strict requirements. In the absence of exceptional circumstances, it will be necessary for parties seeking extensions to show that they have made reasonable efforts to comply with relevant deadlines, and have acted 'promptly and diligently' at all times.

Cooling Off Period

The parties may request a single 'cooling off' period of six months by consent, which may be extended (by consent) for a further six months. A cooling off period may be requested at any time after the filing of the SoGaP, and may be terminated unilaterally by either party.

Hearing

Once the evidentiary stages have been completed, the Office will decide whether to set the matter down for a hearing, or to make a decision on the written record. If the matter is set down for a hearing, the hearing will generally occur before a Delegate of the Registrar either in person or by teleconference. The Delegate will issue a written decision within 3 months of considering the parties' evidence and submissions.

Costs

The successful party can apply to the Office for an award of costs, which will be assessed and 'taxed' by the Office. Taxed costs typically only cover a portion of the actual expenses incurred by the parties.

Appeal

Either party may appeal the decision of a Delegate to the Federal Court of Australia.

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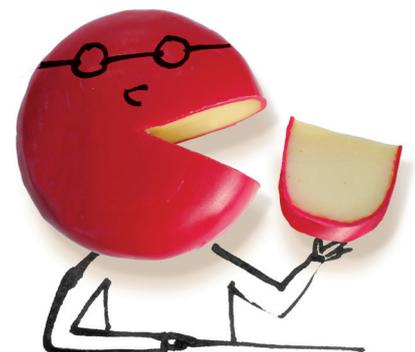
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The diagram overleaf shows, in a simple way, the process for trade mark opposition.



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