Trade mark opposition in Australia.

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Trade mark Opposition

Opposition is the mechanism most commonly used to provide an interested person, generally a person who would in some way be affected by the entry of that trade mark on the Register, to object to the registration.

Opposition proceedings are generally conducted before the Registrar of Trade Marks or a Delegate of the Registrar.

The procedure set out below, and which should be read in conjunction with the accompanying flowchart, relates to opposition to registration. The procedure is also generally applicable to less frequently used oppositions such as opposition to removal of a registration for non-use or an opposition to an extension of time.

Extensions of time limits for serving evidence may be obtained. However, such extension requests may be objected to by the other party and can result in a hearing to deal solely with the extension request, often causing significant delays.

When either party prepares evidence, a copy of the evidence must be served on the other party with the original evidence filed with IP Australia.

Notice of Opposition

A Notice of Opposition is a formal document which sets out in general terms the grounds upon which the opponent objects to the registration of the trade mark.

The Notice must be lodged with IP Australia within three months from the date on which the application was advertised as accepted in the Australian Official Journal of Trade Marks. A copy of the Notice must also be provided to the applicant, or the Australian representative of the applicant, as soon as possible after lodgement.

A single extension of time of up to three months is available within which to file and serve a Notice of Opposition.

Evidence in Support

If the opponent intends to rely on evidence, a copy of the evidence must be served on the applicant for registration, or its Australian representative if any, within three months of the date on which the Notice of Opposition was filed. The original evidence must be filed with IP Australia as soon as practicable.

The evidence must only relate to the grounds specified in the Notice of Opposition.

Evidence in Answer

If the applicant intends to respond to the evidence in support, a copy of the applicant's evidence must be served on the opponent, or its Australian representative if any, within three months of the date on which it was served with the opponent's evidence in support. The original evidence must be filed with IP Australia as soon as practicable.

Evidence in answer should strictly address only the opponent's evidence in support.

Evidence in Reply

If served with evidence in answer, the opponent may respond by way of evidence in reply. A copy of any such evidence must be served on the applicant within three months of the date in which the applicant had served its evidence in answer. Again, the original evidence must be lodged with IP Australia as soon as practicable.

The Hearing

Once the evidentiary stages have been completed, the matter is set down for a hearing before the Registrar of Trade Marks or, more usually, a Delegate of the Registrar.

Hearings may generally be scheduled in Canberra at any stage throughout the year. Specific hearing sessions are also scheduled in the State capital cities.

A hearing is an informal procedure that allows each party a fair opportunity to present its case. Whilst the Delegate controls the proceedings, the hearing process is not a mediation.

The Delegate will not, as a rule, decide the opposition at the hearing. The decision will generally be reserved and, after due consideration has been given to the evidence and submissions, a reasoned written decision will be sent to both parties. Any application for an award of costs will be addressed in the decision.

Appeal

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

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

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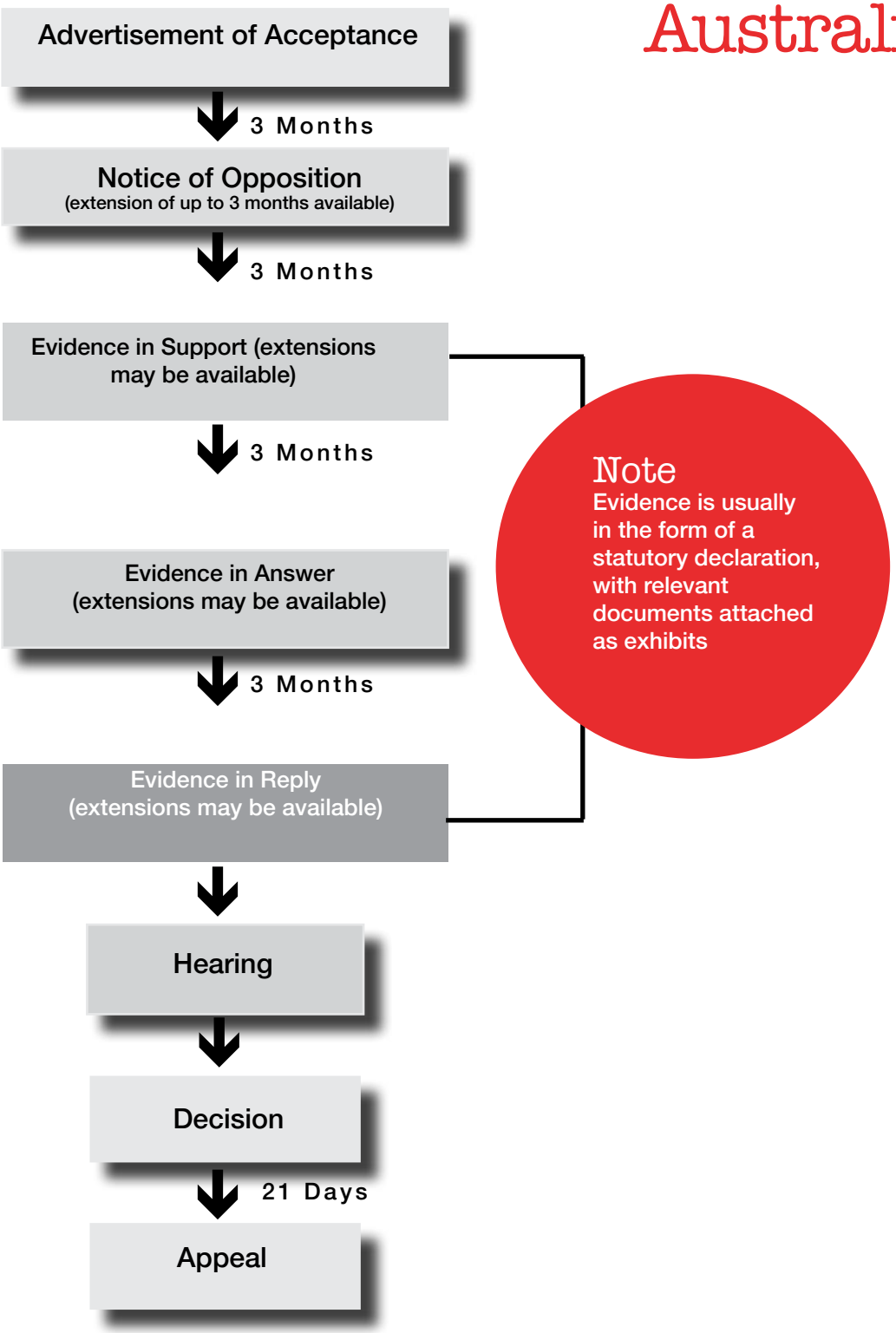
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