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An information guide to trade mark oppositions for trade mark applicants

What happens when someone objects to your trade mark being registered

The registration of a trade mark involves two stages. The first stage is known as 'examination'. IP Australia examines the trade mark application to see if there is any conflict with earlier trade mark registrations/applications. It will also decide whether there is any other reason for rejecting the application. If everything is in order, the application is accepted and advertised in the *Australian Official Journal of Trade Marks*. The date of advertisement commences the next stage, the 'opposition' stage.

Notice of opposition

Any person who believes the trade mark should not be registered has three months from the date acceptance was advertised in which to object. By filing a notice of opposition with IP Australia, the registration process is stopped until the merits of the objection/opposition are decided.

Registration can only be opposed under the grounds contained in the *Trade Marks Act & Regulations 1995*. There is a list of the grounds in the official form for a notice of opposition at the following web page: www.ipaustralia.gov.au/pdfs/trademarks/oppositions/Tm00003.pdf

Evidence to support notice of opposition

Filing a notice of opposition is only the first step. The person who has filed the notice (called 'the opponent') has to satisfy the Registrar of Trade Marks in IP Australia that at least one of the grounds in the notice has been established. That is done by the opponent filing and serving evidence. The information guide at the following web page explains the proper form for evidence: www.ipaustralia.gov.au/pdfs/trademarks/Information_guide_evidence_TM_oppositions_1206.pdf

The timeframes for preparing evidence are explained at: www.ipaustralia.gov.au/pdfs/trademarks/Information_guide_Oppositions_National_1206.pdf

Please note: in addition to filing its original evidence with IP Australia, the opponent must ensure a copy of its evidence is received by you in the time allowed.

When do I get a chance to respond?

You will have an opportunity to respond to the opposition once you have received a copy of the opponent's evidence or the time allowed for the opponent to prepare its



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evidence has expired. You may decide the opponent has not made out a case for registration to be refused and that it is not necessary for you to prepare any evidence in answer to the opposition. IP Australia suggests you seek professional advice in this regard. Lawyers and solicitors who specialise in trade marks advertise in the Yellow Pages. In addition there is a list of registered trade mark attorneys at www.psb.gov.au.

IMPORTANT NOTE if your trade mark application was accepted under the provisions of subsection 44(3) or 44(4).

This means another person's trade mark was raised as a ground for rejecting your application and you had to provide IP Australia with evidence of your use of your trade mark. Although that evidence will still be on the official file, it will not be taken into account when the opposition to registration is decided unless you send a copy to the opponent. The law of the Trade Marks Act & Regulations does not allow the Registrar of Trade Marks to take any information into account unless it has been made available to the other side.

What else can I do?

This may be the time for you to consider whether it is worthwhile continuing with your application, particularly if you haven't already used your trade mark. Trade mark rights are established through trade mark use. A business name registration by itself does not give you rights in that name as a trade mark.

If you are a small business owner with limited resources, it may be a better use of those resources to withdraw this application and choose another trade mark.

When you are deciding what to do, please be aware of the following.

- Trade mark oppositions are legal proceedings and you should not expect they will be resolved quickly. The law of the *Trade Marks Act & Regulations* allows for both parties to be given extensions of time in which to prepare their evidence. It is usual for at least one extension of time to be granted so the time for preparing evidence may take a year or more.
- If the opponent is successful in having registration refused, costs may be awarded against you. The average award of costs is between \$2,000 and \$3,000 but it may be more than that if there has been a hearing where the opponent was represented by a barrister.
- Any decision by IP Australia about the merits of the opposition can be appealed in the Federal Court. The cost of court proceedings is considerably higher than the cost of proceedings before the Registrar of Trade Marks.

Another option may be to settle the opposition by negotiation. Most oppositions are finalised this way to the mutual satisfaction of both parties. The parties avoid unnecessary costs and there is no 'official' decision that can be appealed. If IP Australia is satisfied both parties want to negotiate a settlement and need time to do so, the opposition proceedings can be temporarily suspended.

Decision on whether registration should be refused

Once you and the opponent have had a reasonable opportunity to file and serve evidence, the merits of its opposition will be decided by a hearing officer. A hearing officer is an experienced person within IP Australia who has been delegated by the Registrar of Trade Marks to decide oppositions.



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Much like a judge in a court, the hearing officer will only take into account evidence which has been filed and served. Hearing officers do not conduct their own investigations about whether or not a trade mark should be registered. It is the opponent's responsibility to make sure its evidence contains sufficient information to show why the trade mark should not be registered. And it is your responsibility to make sure your evidence answers the opponent's case.

The opposition can be decided by the hearing officer based 'on the written record', that is, any evidence properly filed and served and any arguments in written form you and the opponent may have made. If you want to present your arguments in person to the hearing officer, you can ask to be heard. However there is a fee of \$500 which must be paid when you request the hearing. There is no fee for a decision on the written record.

IMPORTANT: Please do not make the mistake of thinking you can bring evidence to the hearing which has not been filed and served. Once the evidence stage is over, it is only under very special circumstances that either party will be allowed to introduce new evidence.

I need more information

More detailed information about trade mark oppositions is contained in parts 46 to 55 of the Trade Marks Office Manual of Practice and Procedure which can be downloaded at the following web page:
www.ipaustralia.gov.au/resources/manuals/trademarks.shtml

Other official information guides are listed below.

- Information guide to objecting to registration of another person's trade mark
- Information guide to trade mark oppositions (National)
- Information guide to trade mark oppositions (International under the Madrid Protocol)
- Information guide to evidence in trade mark oppositions
- Information guide to provision of written submissions or a written outline in relation to a hearing
- Information guide to representing yourself at a Trade Mark Hearing

All these guides can be found at the web page:

www.ipaustralia.gov.au/resources/forms_trademarks.shtml#tm_oppositions

Links to the *Trade Marks Act & Regulations* are at the web page:

www.ipaustralia.gov.au/resources/legislation/index.shtml

IP Australia cannot advise you what to do. The Registrar of Trade Marks must remain impartial in these proceedings. Otherwise the official decision on the merits of the opposition could be appealed on the basis that the decision maker was biased.

If you want legal advice IP Australia strongly suggests that you consult persons who are experienced in trade mark law.



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Information and advice

IP Australia's Information and Advice Policy can be viewed by following the link at www.ipaustralia.gov.au/about/whatis_whatwedo.shtml

IP Australia contact details

Ph: **1300 65 1010** 9am to 5pm Monday to Friday (except public holidays)
(Ph: +61 2 6283 2999 for international callers only)

Secure fax: **02 6283 7999** (from within Australia) (+61 2 6283 7999 for international callers only) Note all documents are receipted at Australian Eastern Standard/Daylight Saving Time. Request confirmation via your fax machine or contact Customer Service Network to confirm receipt (provide date/time/your fax/number pages sent).

Email: assist@ipaustralia.gov.au

Post: Registrar of Trade Marks IP Australia PO Box 200 WODEN ACT 2606