

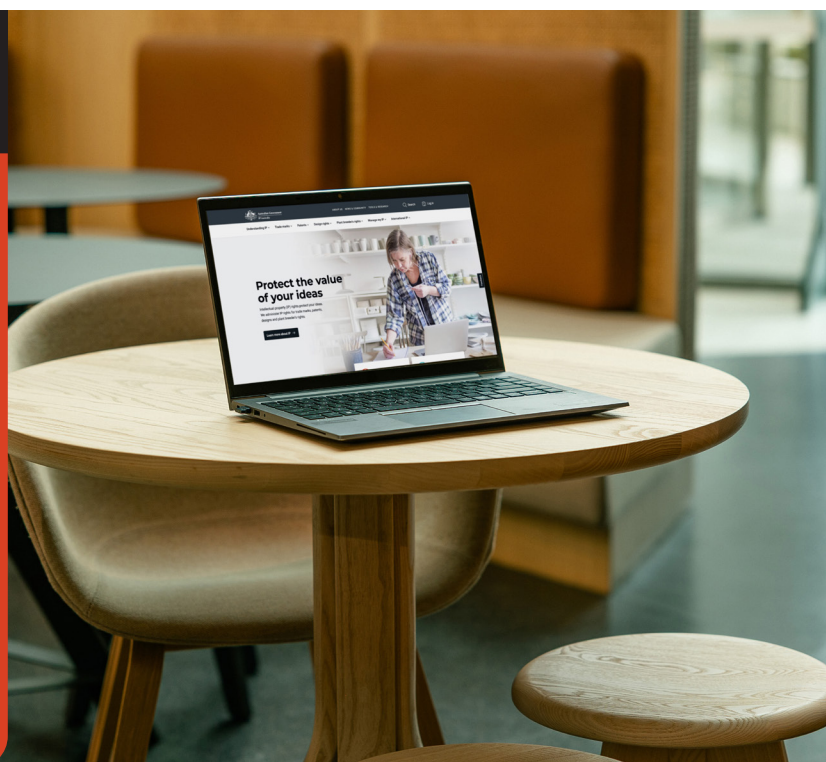


# Requesting an extension of time for trade mark opposition evidence



## At a glance

- This factsheet is intended to assist representatives who need to seek extensions of time for their clients to file evidence during trade marks oppositions.
- It gives guidance on how to prepare evidence in order to have the best chance of obtaining an extension, and how to draft your request to contain all the necessary information.
- It aims to supplement the guidance in 51.2 of the [Trade Marks Manual of Practice and Procedure](#).
- This factsheet is for trade marks and patent attorneys, lawyers and other IP professionals.
- It is not aimed at unrepresented parties, though they may find it useful.



## When extensions can be granted

Extensions of time to file evidence during the trade mark opposition process must meet different criteria to other extensions of time.

There are 2 'limbs' – or components – under which such an extension may be granted <sup>1</sup>.

1. **The 'prompt and diligent' limb:** The party has made 'all reasonable efforts' to comply **and** despite acting 'promptly and diligently at all times' has been unable to file evidence within the time period.
2. **The 'exceptional circumstances' limb:** There are 'exceptional circumstances' that justify the extension of time.

<sup>1</sup> *Trade Marks Regulations 1995* ('TM Regs'), regs 5.15, 9.18, 17A.34K or 17A.48T.

Once **either** of those limbs are satisfied, the Registrar **may** grant the extension.

Importantly, extensions for opposition evidence are **not** available solely for errors or omissions by the opposition party or their agent.<sup>2</sup> Do not rely on the other extension of time provisions that apply outside of the opposition evidentiary process. The following guidance provides explanation of both limbs and the delegate's discretion.

<sup>2</sup> Cf *Trade Marks Act 1995* ('TM Act'), s 224(2)(a). Extensions to the period to file opposition evidence are not available under s 224: see s 224(8)(a) and reg 21.28(1)(f) of the TM Regs.



## The prompt and diligent approach

This limb includes 2 parts – ‘all reasonable efforts’ and ‘promptly and diligently at all times’.

This guidance will focus on the prompt and diligent part, which is typically the more difficult part to satisfy.

Acting ‘promptly and diligently at all times’ is not a standard of perfection. It is intended to ensure that parties and their representatives act like competent and industrious professionals within normal business practices. The following tips are useful when requesting extensions on this basis.

### Do this ...

- ✓ Briefly outline any **plan** you made to have the evidence filed on time.
- ✓ Explain why your plan **was reasonable**.
- ✓ If you do not have a plan, focus on the **actions that you have previously taken** to prepare the evidence up to the point you realised an extension would be required.
- ✓ In the absence of a plan, set out a **timeline** of the dates of the key interactions you had with your client (documents sent or received, meetings and so on).
- ✓ Explain the reasons for any **extended periods** where there were no planned or actual actions taken to progress preparation of the evidence.
- ✓ Explain what **caused** the delay.
- ✓ If the delay is caused by something that could reasonably have been foreseen, explain what steps were taken to **plan around or mitigate this risk**.
- ✓ Apply for an extension **as soon as you become aware** that one will be needed.
- ✓ **Keep working** to file the evidence while you wait for the request to be assessed, and file it as soon as it is finalised (even if the extension has not yet been granted).

### Don't do this ...

- ✗ Don't assert that you or your client were acting promptly and diligently **without providing supporting information**.
- ✗ Don't make **vague statements** such as ‘I was extremely busy with other case files’ or ‘it was difficult to find an appropriate declarant’ **without providing specifics**.
- ✗ Don't focus on steps **you will take** to file the evidence in the extended time (if granted), **without** also explaining what steps you took up to this point.
- ✗ Don't focus **only** on why an extension would not be a **significant detriment** to the other party.
- ✗ Don't stop preparing evidence just because you are **conducting settlement negotiations** with the other party.



## The exceptional circumstances approach

The ‘exceptional circumstances’ limb is separate to the prompt and diligent limb. It includes (but is not limited to) 3 distinct types of exceptional circumstance<sup>3</sup>.

1. A circumstance beyond the control of a party.
2. An error or omission by the Registrar or an employee (of the Registrar).
3. An order of a court or a direction by the Registrar that the opposition be stayed.

It does not include ordinary, non-exceptional errors or omissions by the party or their agent. The following tips are useful when requesting extensions on this basis.

### Do this ...

- ✓ Explain how the ‘exceptional circumstance(s)’ led to the delay in filing evidence.
- ✓ Explain why the cause (or causes) of the delay is something that is **rare** or that would be **difficult** to guard against or plan around.
- ✓ Provide **sufficient detail** for the delegate to understand why the cause of the delay was rare or unusual or unexpected.
- ✓ If the cause of the delay was a mistake by an **IP Australia employee** or an error of an **IP Australia system** explain this clearly.
- ✓ If multiple events conspired to cause the delay explain why that **combination of events is exceptional** (even if each individual cause on its own would be ordinary).

### Don't do this ...

- ✗ Don't use **vague explanations** that do not give sufficient information to determine if the cause of the delay was an exceptional or commonplace circumstance.
- ✗ Don't rely on this ground where the cause of the delay was something that could reasonably be **expected, planned for, or mitigated** with reasonable preparation.
- ✗ Don't rely on delays to **negotiate a settlement**.

<sup>3</sup>TM Regs, regs 5.15(4), 9.18(4), 17A.34K(4) or 17A.48T(4).



## Exercise of discretion

Once one of the 2 limbs described above has been satisfied, the Registrar has discretion when considering whether to grant the extension. The Registrar can consider any relevant issues beyond the 2 limbs discussed above. For example:

- the probative value of the evidence
- the detriment to the party requesting the extension if it is refused
- the lack of significant detriment to the other party if the extension is granted
- the steps that the party proposes to take if the extension is granted.



## Examples where requests are likely to succeed

The following are examples of situations where requests for extensions of time that have been drafted consistent with these guidelines would likely be granted, subject in large part to the Registrar's exercise of discretion. None of the examples below describe any of the examples of factors referred to above under the Registrar's exercise of discretion. Whether a request for an extension will be granted depends on the unique situation a party and the party's representative find themselves in, in light of **all** relevant factors.

This guidance should not be interpreted as a guarantee that, in each case where the facts set out in the below examples exist, a request for an extension will be granted.

Supporting reasons can be provided in a declaration, but it is not a requirement. Writing a letter is sufficient.

- **Administrative error by the party's representative:** For example, accidentally saving one declaration folder in internal systems causing it to be omitted from the opponent's evidence. Once aware of the error, they immediately filed the declaration.
- **IT error by the party's representative:** For example, failure of an office's case management software system for an extended period which resulted in an inability to retrieve the evidence. Once aware of the issue, they called IT support, continued making repeated attempts to retrieve the evidence and subsequently filed the evidence once the issue was resolved (which was the day after the filing deadline).
- **Declarants unavailable and intervening holidays and sickness:** For example, a sole practitioner taking leave and the planned replacement practitioner (the only other practitioner at that workplace, or an external practitioner) becoming unexpectedly ill.
- **Severe sickness of a key declarant:** For example, a key declarant suffering a major illness requiring hospitalisation.
- **Unusually large volume of evidence:** For example, evidence of more than 800 records dating back 15 years, which were not readily retrievable by the IT systems and including unsupported file formats, requiring the opponent to engage an IT professional and leading to unexpected delays.

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