



Guidance for completing Statement of Grounds and Particulars

Grounds and Particulars (Opposition to Registration)

Earlier similar trade mark(s) applied for with this office (s 44/reg 4.5A)

You need to let us know the trade mark number(s). Make sure the numbers provided are:

- Australian trade mark(s) and
- Have an earlier priority date than the trade mark being opposed.

The trade marks must be pending or registered/protected.

Trade mark has earlier use than the applied for trade mark (s 58A)

You need to select one or more of the trade marks relied upon for s 44. Common law trade marks aren't permitted for this ground.

Trade mark is similar to a trade mark that has a reputation in Australia (s 60)

You need to let us know the Australian trade mark application or registration numbers in the response box. Common law trade marks are permitted for this ground and for these you should either:

- Upload a file showing the trade mark representation/s, and/or
- Type the word trade mark/s into the response box.

The applicant isn't the owner of the trade mark (s 58)

You need to let us know the Australian trade mark application or registration numbers in the response box. Common law trade marks are permitted for this ground and for these you should either:

- Upload a file showing the trade mark representation/s, and/or
- Type the word trade mark/s into the response box.

Use of the trade mark would be contrary to law (s 42(b))

Clearly and concisely indicate the law/s you believe the trade mark is contrary to and why you believe use of the trade mark would contravene the law/s.

For example:

- Section 36 of the *Copyright Act 1968* (Cth)

The Opponent owns the copyright in the trade mark. Any use of the trade mark would constitute copyright infringement because the Applicant is not the owner or a licensee of the copyright in the trade mark.

- Section 18(1) of *Australian Consumer Law* (contained in Schedule 2 of the *Competition and Consumer Act 2010* (Cth))

Use of the trade mark would mislead or deceive consumers into believing that the Applicant's goods and/or services are related to the Opponent because of the reputation the Opponent has acquired in its XYZ trade mark.

Trade mark isn't capable of distinguishing the applicant's goods and/or services (s 41)

You need to provide brief reasons why other traders are likely to want to use the opposed trade mark in the ordinary course of trade. For example, in order to describe the goods and/or services they provide.

Examples:

- Descriptive – e.g. SOAP for 'soap' goods
- Quality – e.g. AWESOME SOAP for 'soap' goods
- Quantity – e.g. 2 LITRE for 'milk' goods
- Geographical location – e.g. SYDNEY for 'car wash services'.

Trade mark likely to deceive or cause confusion (s 43)

Deception or confusion could arise in regard to the:

- Character of the goods and/or services including their composition, nature or other properties
- Quality or quantity of the goods and/or services
- Geographical origin of the goods and/or services
- Intended use or purpose of the goods and/or services.

For section 43 to apply, the connotation must be obvious and within the trade mark itself.

For example, the trade mark includes the term 'non-dairy', which suggests that goods offered under the trade mark won't include dairy products. However, the specification of goods for the trade mark includes 'cheese made from goat's milk', which is a dairy product.

Note: if you believe deception or confusion arises from the existence of another trade mark, please refer to sections 58, 60 and/or 44 of the Act.

Trade mark contains scandalous matter (s 42(a))

You need to identify the part/s in the trade mark that is/are scandalous and briefly outline why the

part/s is/are scandalous.

The trade mark contains a false geographical indication (s 61)

A geographical indication is a sign that identifies the goods as originating in a country, or in a region or locality in that country, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin. A geographical place name that simply describes the place a business is based or where a good is sourced isn't necessarily a geographical indication.

There are occasions where over time a region has developed a strong reputation for produce of a certain quality. For example, a banana grower in Brisbane may wish to promote his fruit as Brisbane bananas. Even if these bananas are actually grown in Brisbane, this alone doesn't make 'Brisbane' a GI. The bananas would also need to have some special characteristic or reputation (such as sweeter, or larger, or thinner) that is attributable to the Brisbane area. The link between the special characteristics of the bananas and the geography or reputation of the region is what creates a GI.

Trade mark contains a prescribed sign (s 39)

You need to provide details of the prohibited or prescribed sign in the trade mark. For example, the trade mark contains the copyright symbol '©'.

The application was filed in bad faith (s 62A)

You need to provide a brief explanation of why you believe the application was filed in bad faith.

The application was filed with no intention to use the trade mark (s 59)

You need to explain why you believe the applicant had no intention to use, authorise use or assign the trade mark to a body corporate in Australia.

Important: indicating there's been no actual use of a trade mark to date without something more, isn't sufficient. It's commonplace for businesses to wait for registration before using a trade mark.

The trade mark application was accepted on the basis of false evidence or representations (s 62(b))

You need to provide details of the false evidence or representations and why you believe it's false.

The trade mark application has been amended contrary to the Trade Marks Act (s 62(a))

You need to provide details of the defective amendment.

The applicant for the defensive trade mark isn't the same as the supporting trade mark (s 187(c))

You need to explain how the supporting trade mark isn't registered in the name of the applicant for the defensive trade mark. For example, the supporting trade mark is owned by XYZ Pty Ltd, but the applicant for the defensive mark is EFG Pty Ltd.

The goods and/or services in the defensive application are unlikely to be seen as connected to the owner of the supporting trade mark (s 187(d))

You need to explain why the defensive trade mark isn't likely to indicate a connection between the goods and/or services applied for, and the owner of the supporting trade mark.

Certification trade mark doesn't distinguish certified goods and/or services (s 177)

You need to provide an explanation of why the opposed trade mark isn't capable of distinguishing the goods and/or services certified by the applicant from those not so certified.

Grounds and particulars (Opposition to Removal/Cessation for non-use)

You need to provide brief facts about:

- The alleged use or intended use, or circumstances preventing use, of the trade mark and/or
- Any other information that may justify the exercise of the Registrar's discretion not to remove the trade mark.

Important: evidence isn't required at this stage. We won't accept it if you try to file it with the statement of grounds and particulars.