Raising the Bar: changes to Australian trade mark opposition

The IP Laws Amendment (Raising the Bar) Act 2012 was given Royal Assent on 15 April 2012, and many of the substantive changes will come into effect on 15 April 2013.

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All trade mark applications whose acceptance is advertised in the Official Journal of Trade Marks on or after 15 April 2013, will be subject to the new Opposition practice rules.

The Act also amended the Australian patent legislation.

The changes

The purpose of these changes is to streamline and improve the practice and procedure in relation to trade mark oppositions, and to enable trade mark disputes to be resolved more quickly.

The new Notice of Opposition will have 2 components:

1. The Notice of Intention to Oppose - to be filed two months from date of advertisement of acceptance of TM Application in Official Journal of Trade Marks
2. The Statement of Grounds and Particulars (SGP) - to be filed one month from date of filing Notice of Intention to Oppose.

Together, these documents will constitute the Notice of Opposition. The official Trade Marks Office opposition fee (currently AUD$250) will be payable at the time of filing the Notice of Intention to Oppose.

Extension of time for Notice of Intention to Oppose

It will be very difficult to obtain an extension of time to file Notice of Intention to Oppose; this will only be available on the grounds of:

- error or omission by IP Australia or person seeking extension or attorney/agent
- circumstances beyond the control of the person

It will no longer be possible to obtain an extension of time on the basis of "genuine research" or "settlement negotiations" (but see the new cooling off period, below)

The SGP

The introduction of the SGP is designed to make it easier for trade mark applicants whose application is being opposed to know what case they have to meet. Under the current practice, Notices of Opposition can be filed claiming all available grounds and these do not have to be refined until much later in the process, usually just prior to the hearing. The practical implication of this change is that opponents and their attorneys/ lawyers will need to think about actual grounds of opposition much earlier. This may prove challenging as sometimes the actual grounds do not become apparent until the evidence phase of the opposition.

The SGP must state the material facts on which each ground of opposition is based, but not the evidence by which those facts will be proved. It is expected that IP Australia will provide some guidelines in relation to the nature and level of detail of the information which will be required.

If the Trade Marks Office believes that the opposition has not been sufficiently particularised, the Registrar may dismiss the opposition (but will give Opponent an opportunity to rectify the SGP first). The registrar will consider whether the Opponent has made "a genuine but inadequate attempt" to particularise the grounds.

Amendment of Notice of Intention to Oppose SGP

There will be very limited opportunity to amend the documents comprising the Notice of Opposition. For example, the Opponent will be able to correct clerical errors or obvious mistakes on Notice of Intention to Oppose or SGP. However, the Opponent can only add a ground to the SGP after filing if the failure to include it initially was because of information which Opponent did not know, or could not reasonably have known, at the time of filing the SGP.

Under the new practice, the Opponent will not have to serve the Notice of Intention to Oppose or SGP on the trade mark Applicant - IP Australia will do this. This is designed to make the process easier for Opponents, particularly self-represented individuals and small businesses. It will also give IP Australia more control to ensure opposition documents actually served on the Applicant in a timely way.
Notice of Intention to Defend

Another significant change is the introduction of a Notice of Intention to Defend. This is to be filed by trade mark Applicant one month from the day the Applicant is given a copy of the SGP. The Notice of Intention to Defend will not be very detailed, there will be no need for the applicant to expressly admit or deny Opponent's allegations, and there will be no fee associated with filing this document. However, IP Australia believes it will help resolve uncontested oppositions much earlier, because if the Applicant does not file a Notice of Intention to Defend, the trade mark application will lapse, and there is no need for the Opponent to prove its case.

Cooling off period

As mentioned above, one of the practice changes will be the introduction of a cooling off period for the purpose of conducting settlement negotiations to try to resolve the opposition. The parties to the Opposition may apply by consent to suspend the Opposition at any time after Notice of Intention to Oppose and the SGP have been filed. There will be an initial cooling off period of six months and this will be extendible for one further period of six months. The cooling off period can be terminated at any time at request of either party and the opposition will resume.

Filing evidence

There will also be new timeframes for evidence in Opposition proceedings (and again, the deadlines will be for filing, rather than serving, the relevant documents).

The Opponent's Evidence in Support will now need to be filed within three months from the filing date of the Notice of Intention to Defend (previously this time ran from date of filing the Notice of Opposition). The Applicant's Evidence in Answer will then need to be filed within three months of the date of filing the Evidence in Support. The Opponent's Evidence in Reply (if any) will then need to be filed within two months (reduced from three months) from the filing of the Evidence in Answer.

It will become much more difficult under the new rules to obtain any extensions of time for filing evidence. Currently it is generally possible to obtain up to six months' extension without having to justify why the extension is required (and further extensions may be possible after that if genuine reasons are given). The new practice means that all evidence deadlines will be extendable only on provision of compelling reasons (in the form of a Declaration).

After the evidence phase has been completed, either party may ask the Trade Marks Office to set the opposition down for hearing. A Hearing may also be set on the Registrar's own initiative. The Registrar will direct whether there will be an oral hearing or whether the matter will be considered on the basis of written submissions only. If there is to be an oral hearing, then written submissions must be filed:

- by the Opponent ten business days before Hearing
- by the Applicant five business days before Hearing.

The Registrar will then issue a decision in the Opposition.

If you have any questions about the new Opposition procedure, please contact any of our trade mark partners.
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