

Trade Mark Oppositions

Once the Trade Marks Office (IP Australia) has approved a trade mark for registration it will advertise its acceptance for registration in the Official Journal of Trade Marks. Any person can oppose the registration of that trade mark by filing a Notice of Intention to Oppose within two (2) months of the date on which it was advertised in the Official Journal.

If no Notices are filed, the trade mark will proceed to registration upon payment of the registration fees. Once the trade mark is registered, opposition to it cannot be lodged with the Trade Marks Office, except in certain limited circumstances. If a party wishes to oppose the registration of a trade mark after it has proceeded to registration, they will need to do so by application to the Federal Court, which will be very costly.

Your business may be the applicant for registration of a trade mark which has been opposed or may wish to oppose the registration of a trade mark. The business applying for registration of the trade mark is often referred to as the Applicant and the business opposing it, the Opponent.

The registration of a trade mark may only be opposed on a limited number of specific grounds, including whether another person (not necessarily the Opponent) has better rights to the trade mark than the Applicant, or that the trade mark should not have been registered, including that it is not capable of operating as a trade mark.

The opposition proceedings are adversarial, in that each party puts forward its evidence to support or defend the opposition. The period in which each party has to submit its evidence and submissions is tightly controlled. The Opponent must file its Evidence in Support to the grounds of opposition within three (3) months of the request to do so by the Trade Marks Office. The Applicant may then file its Evidence in Answer within three (3) months, and the Opponent may then file Evidence in Reply within three (3) months after the Evidence in Answer has been filed.

Once the evidence rounds are completed, each party files its submissions (arguments) and may elect to attend a hearing at the Trade Marks Office in Canberra to present their case to a Hearing Officer of the Trade Marks Office or have a decision made based on the evidence and written submissions.

The Hearing Office will then make their decision as to whether the Opponent has successfully opposed registration of the trade mark or not. If the opposition is successful then the trade mark will NOT proceed to registration. If the opposition is NOT successful the trade mark will proceed to registration.

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The cost of an opposition is related to the costs of collecting evidence to support or refute the grounds of opposition and the submissions (argument). As such costs will depend on the extent of the evidence available and the complexity of the submissions.

Costs are awarded in opposition proceedings to the party that wins the opposition. However, costs are governed by a scale of costs contained in the regulations to the *Trade Marks Act 1995* (Cth), and rarely exceed several thousand dollars. They are not based on how much each party spends on representation in the opposition.

If a business loses an opposition and is using the trade mark that it sought registration of, there may be a possibility that use of the opposed trade mark may infringe the rights of the Opponent. As such, conflicts relating to trade mark rights that are played out in oppositions may have wider repercussions, on which advice should be taken at an early stage of the opposition proceedings.

Contact us today for assistance with your TRADE MARK OPPOSITION

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