

## Changes to the Australian trade mark opposition process: *Raising the Bar* reforms

The *Raising the Bar* statutory reforms that commence on 15 April 2013 will introduce substantive changes to Australian trade mark opposition process and procedure. The reforms will impact strongly on the way trade mark oppositions are presently managed and will also likely affect the tactics and pace of any commercial negotiations or co-existence discussions.

In short, the burden to identify relevant grounds of opposition and to substantiate an opposition case has been brought sharply forward, a positive requirement to indicate whether an opposition will be defended has been imposed, the periods within which to oppose and file evidence have been condensed and rights to extensions of time to oppose and to suspend proceedings for commercial negotiations curtailed. The Registrar will also have greater powers to case manage oppositions.

We comment on some of those changes below:

### NOTICE OF INTENTION TO OPPOSE

- An opponent will only have **2 months** (as opposed to the current 3 months) from advertising of acceptance of a trade mark application in the *Australian Official Journal of Trade Marks* to file a notice of intention to oppose.
- The opponent must lodge the notice with the Trade Marks Office and the Office then effects service on the trade mark applicant. There will no longer be the need for direct service as is currently the case.
- Importantly, no extension of the opposition period will be allowed except where the opponent can satisfy the Registrar that an extension is justified due to error or omission or circumstances beyond the control of the opponent. Presently, the period within which to oppose can be extended, amongst other things, on the grounds that the opponent and the applicant are conducting genuine negotiations or that the opponent is genuinely researching the grounds of opposition or whether an opposition is justified. That will no longer be the case.

### STATEMENT OF GROUNDS AND PARTICULARS (SGP)

- Within **1 month** of filing a notice of intention to oppose, the opponent must file particulars of the material facts in respect of **each** ground of opposition. The Registrar will consider the adequacy of the statement and may either request further particulars or dismiss the opposition.
- Failure to lodge a statement of grounds and particulars (**SGP**) within time may result in dismissal of the opposition by the Registrar.
- There is very limited opportunity to amend a SGP or seek an extension of time to put on a SGP.

### NOTICE OF INTENTION TO DEFEND

- Within **1 month** of being given a copy of the SGP the applicant must file a notice of intention to defend.
- The applicant for an international registration designating Australia (**IRDA**) will be required to provide an Australian address for service for its application when filing a notice of intention to defend.
- Failure to file a notice of intention to defend (or supply an Australian address for service for an IRDA) within time will result in the application lapsing.
- The requirement for a notice of intention to defend has been introduced to avoid the problem of a passive applicant where, under current rules, a notice of opposition is filed, the opponent puts on substantive evidence of evidence in support only to then find that the applicant does not wish to proceed with the application.

### EVIDENCE IN SUPPORT

- Within **3 months** of being given a copy of the notice of intention to defend, the opponent must file evidence in support.
- Extensions of time will be tightly controlled. The Registrar must be satisfied before granting an extension of time that the opponent has made all reasonable efforts to comply with all relevant filing requirements and despite acting promptly and diligently at all times is unable to file the evidence within the period or there are exceptional circumstances that justify the extension.

### EVIDENCE IN ANSWER

- Within **3 months** of being given a copy of the evidence in support, the applicant must file evidence in answer.
- Extensions of time will be tightly controlled.

### EVIDENCE IN REPLY

- Within **2 months** (as opposed to the current 3 months) of being given a copy of the evidence in answer, the opponent must file evidence in reply.
- Extensions of time will be tightly controlled.

### FURTHER EVIDENCE

- It will no longer be possible to file further evidence.

### COOLING OFF PERIOD

- Subject to both parties agreeing, the Registrar may suspend opposition proceedings for **6 months** but only after a complete notice of opposition (both notice of intention to oppose and SGP) is filed.
- A further period of **6 months** is possible if an application is made before expiry of the first cooling off period but the total period cannot go beyond **12 months**.
- Only one cooling off period is allowed.

### SUMMARY OF SUBMISSIONS

- The opponent must file summary submissions at least **10 business days** prior to hearing.
- The applicant must file summary submissions at least **5 business days** prior to hearing.
- The Trade Marks Office will provide a copy of each party's filed submissions to the other party.

### HEARING

- The Registrar may decide on the Registrar's own initiative to hold a hearing despite a request by the parties that a decision be made on the papers.
- The Registrar also has discretion whether the hearing is conducted orally or by written submissions.

### APPEALS

- Choice to appeal to the Federal Magistrates Court (proposed to be shortly renamed as the Federal Circuit Court of Australia) as an alternative to the Federal Court of Australia.



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