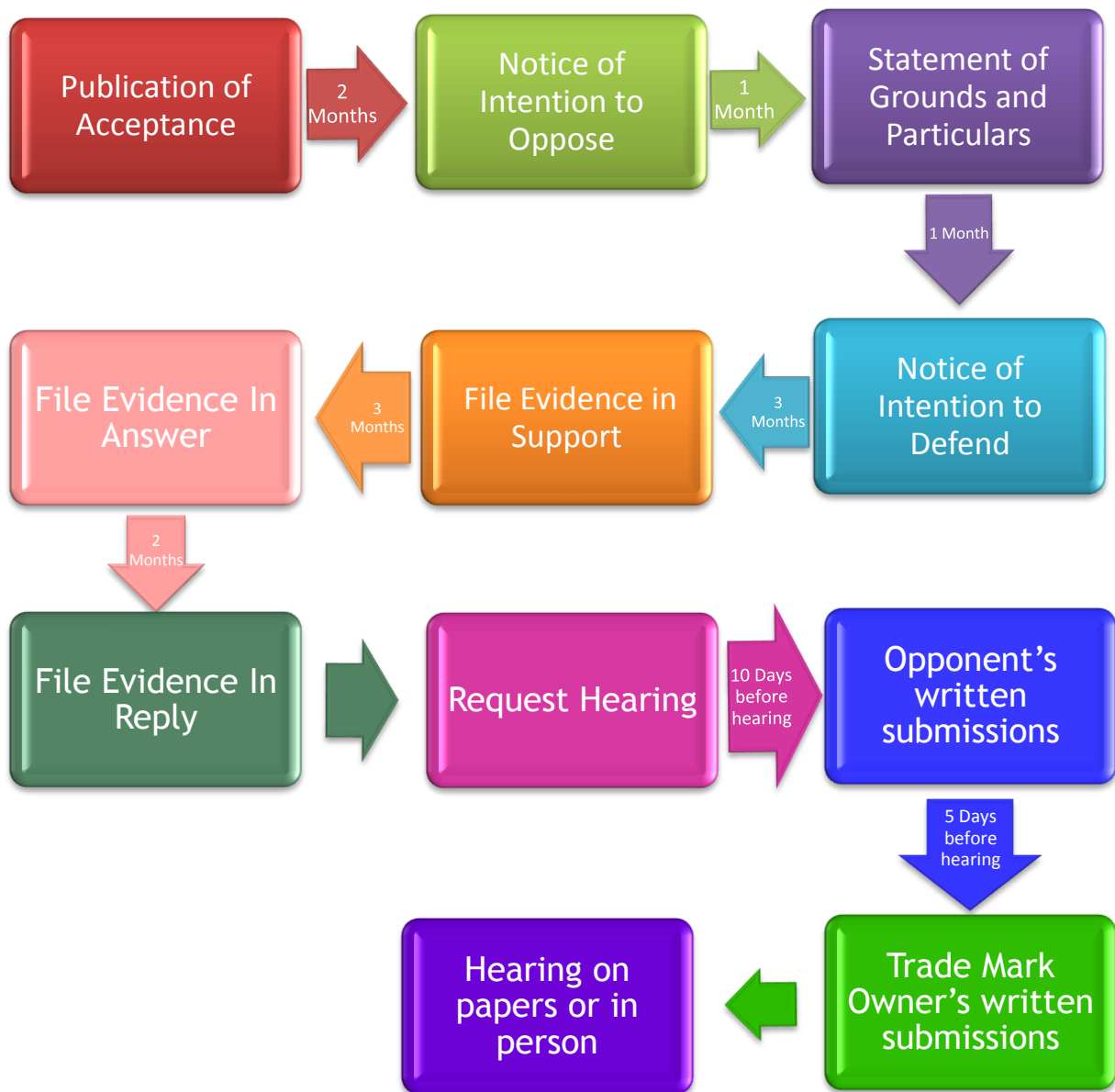


PIZZEY'S ILLUSTRATED GUIDE TO THE NEW TRADE MARK OPPOSITION PROCEDURES IN AUSTRALIA



PIZZEYS

Patent and Trade Mark Attorneys
AUSTRALIA and NEW ZEALAND
www.pizzeys.com.au

QUESTION	ANSWER
When do the new trade mark opposition procedures start in Australia?	On 15 April 2013
Publication of Acceptance	
What is the new time period for oppositions? Docketing Alert!	For a National Application 2 months from publication of acceptance
	For an International Registration Designating Australia 2 months from publication of acceptance
	For a removal action on the basis of non-use 2 months from the date of advertisement of application to remove.
Notice of Intention to Oppose	
What document does the Opponent need to file by the opposition deadline?	A Notice of Intention to Oppose.
What happens if a Notice of Intention to Oppose is not filed by the deadline?	For a National Application it will proceed to registration upon payment of the registration fee.
	For an International Registration Designating Australia it will become protected.
	For a removal action on the basis of non-use the challenged mark will be removed from the Register
Is it possible to obtain an extension of time to file the Notice of Intention to Oppose?	<p>Yes, but only:</p> <ul style="list-style-type: none"> • before the application is entered on the Register (i.e. registered/protected)**; <p>and on the grounds of:</p> <ul style="list-style-type: none"> • error or omission of the person, person's agent, the Registrar or an employee; and/or • circumstances beyond the control of the person. <p>** Note this time limitation does not apply to a removal for non-use action</p>
Statement of Grounds and Particulars	
What does the Opponent have to do next? Docketing Alert!	File a Statement of Grounds and Particulars within 1 month from the filing of the Notice of Intention to Oppose.
Is it possible to file this document with the Notice of Intention to Oppose?	Yes the two documents may be filed at the same time.
Is it possible to obtain an extension of time to file the Statement of Grounds and Particulars?	<p>Yes, but only on the grounds of:</p> <ul style="list-style-type: none"> • error or omission of the person, person's agent, the Registrar or an employee; and/or • circumstances beyond the control of the person.

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What if the Statement of Grounds and Particulars is not filed by the deadline?	The opposition is dismissed.
What is in this document?	<p>It must state the grounds from the Act upon which the opposition will be based.</p> <p>It must also state the material facts upon which the Opponent intends to rely to support those grounds but the evidence supporting such facts is not provided at this stage.</p>
Can you add extra grounds or facts later?	Only if you can convince the Registrar that the information is something of which the Opponent could not have reasonably been aware at the time of filing the Statement of Grounds and Particulars.
Notice of Intention to Defend	
When does the Removal Applicant/Trade Mark Owner need to file a Notice of Intention to Defend? Docketing Alert!	1 month from the day a copy of the Statement of Grounds and Particulars is “given” to them by the Registrar.
What happens if a Notice of Intention to Defend is not filed?	For a National Application it will lapse.
	For an International Registration Designating Australia it will be refused.
	For a removal action on the basis of non-use the challenged mark will be removed from the Register.
Do Applicants using the Madrid Protocol have to comply with this? Madrid Alert!	Yes, you should be aware that if you receive an Australian opposition notification from the International Bureau that you need to arrange for this document to be filed by the set deadline and that you need to have an Australian address for service entered on the case.
Is it possible to obtain an extension of time to file the Notice of Intention to Defend?	There is no specific provision in the new Regulations to extend this deadline – it is believed that the general extension provisions in the Act (s224) will apply
Cooling Off Period?	
Will it be possible to “suspend” the opposition?	<p>Yes. A “cooling off” period may be requested anytime after the filing of the Statement of Grounds and Particulars</p> <p>The initial “cooling off” period will be 6 months. With one extension of 6 months available.</p> <p>There can only be one cooling off period even if all the time is not consumed.</p> <p>Both parties must agree to the request but may unilaterally discontinue it at anytime.</p>

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QUESTION	ANSWER
Evidence in Support	
When does the Opponent file Evidence in Support?	3 months from the day a copy of the Notice of Intention to Defend is “given” to them by the Registrar.
Is it possible to seek extensions of time to file each evidence stage?	Yes, but only on the grounds of: <ul style="list-style-type: none"> • error or omission of the person, person’s agent, the Registrar or an employee; • circumstances beyond the control of the person; and • all reasonable efforts have been made to comply with the deadline and despite acting promptly and diligently at <u>all</u> times to ensure the filing by the deadline the person is unable to do so.
Evidence in Answer	
When does the Applicant/Trade Mark Owner file Evidence in Answer?	3 months from the day a copy of the Evidence in Support is “given” to them by the Registrar.
Evidence in Reply	
When does the Opponent file Evidence in Reply? Docketing Alert!	2 months from the day a copy of the Evidence in Answer is “given” to them by the Registrar.
Hearings Generally	
Are the parties able to decide if the hearing is “in person”?	No, this is now at the discretion of the Registrar.
Are written submissions required on the given deadlines?	It is expected that there may be cost penalties imposed if written submissions are requested and not filed.
Transitional Provisions	
What is the opposition deadline if your acceptance was advertised before 15 April 2013?	3 months but when the opposition is filed it must follow the new process.
If opposition proceedings are already in progress, do the new provisions apply after 15 April 2013?	Yes, the new procedures will apply to any un-served evidence and the hearing of the matter.



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