

## Addisons FocusPapers

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### **Resolving Trade Mark Opposition Proceedings Faster**

IP Australia has recently released a consultation paper entitled “Resolving Trade Mark Opposition Proceedings Faster”. This paper sets out a number of proposals which are directed at improving the Australian intellectual property system and is aimed particularly at resolving trade mark oppositions in a more efficient manner.

#### **Extensions of time to oppose/filing a notice of opposition**

IP Australia proposes to remove the following grounds for extending the period of filing a notice of opposition:

- conduct of genuine negotiations; and
- undertaking of research to decide whether to oppose the grounds of opposition.

If these grounds are removed, it will only be possible to extend the period for filing a notice of opposition in the case of an error or omission by IP Australia, the opponent, or its agent, or if there are circumstances beyond the control of the party concerned.

IP Australia has also proposed that at the time of filing a notice of opposition, the opponent must specify the following to ensure that the opponent’s case is sufficiently defined early in the opposition proceedings:

- the grounds on which the application is being opposed (as is currently required); and
- the particulars of those grounds - that is, the material facts on which each ground of opposition is based.

It is also proposed that the Registrar is given the power to dismiss an opposition if the statement of goods and particulars is not provided. If the applicant wishes to proceed with its applications once it has been opposed, it would be required to provide a “notice of intention to defend” within one month of the filing of the notice of opposition.

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## **Time limits for extensions of time for providing evidence**

IP Australia has noted that the numerous extensions of time requested for providing evidence delay opposition proceedings. In light of this, IP Australia is proposing that the Registrar would direct that any extension of time only be granted if the Registrar is satisfied that:

- although the party has acted diligently, it is unable to serve the evidence in that period; or
- some other compelling circumstance requires such a direction.

An example of a compelling circumstance provided in the consultation paper is where there are pending proceedings before a court which may be relevant to the current opposition proceedings.

## **Cooling-off period**

IP Australia proposes that a cooling-off period be introduced to allow parties to enter into settlement negotiations. This may be requested at any time once the notice of opposition has been filed. The suspension may be requested for a minimum of 6 months initially and extended for a further 6 month period after that for a total of 12 months.

## **Summoning of witnesses/production of documents**

In order to reduce delays further, IP Australia proposes that the Registrar be able to exercise the power to summon witnesses and/or the production of articles only if they are relevant to the present opposition proceedings and if the Registrar is satisfied that this would substantially contribute to the correct decision being made.

## **Summary of submissions**

IP Australia proposes that a summary of submissions be submitted prior to attending hearing. It is proposed that the opponent be required to file and serve submissions on the applicant at least 5 business days before the hearing and the applicant be required to file and serve submissions on the opponent at least 2 business days before the hearing.

## **Conclusion**

IP Australia welcomes any written submissions from interested parties in response to the proposals put forward as well as any suggestions. IP Australia will consider submissions received and will provide recommendations to the government accordingly. Please note that the closing date for submissions is **17 August 2009**.

## **For more information please contact:**

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