

Are You Properly Protecting Your Trade Marks?

On 15 April 2013 key changes to the *Trade Marks Act 1995* were implemented that dramatically tighten the time frames available in a trade mark opposition.

Are you aware of these changes? Are you prepared to protect your trade mark in line with these changes?

Opposing a Trade Mark Application

Previously, the time period to oppose the acceptance of a trade mark application for registration was **three months**. This period could be **extended by up to a further three months**. To oppose an application a Notice of Opposition was filed claiming all possible grounds of opposition available.

Now, the procedure for opposing a trade mark application consists of two mandatory elements:

1. A “**Notice of Intention to Oppose**” must be filed **within two months** of advertisement of acceptance in the Australian Official Journal of Trade Marks; and
2. A “**Statement of Grounds and Particulars**” (**SGP**) setting out the grounds of opposition must be filed **within one month** of filing the Notice of Intention to Oppose. The grounds must be “adequate” and supported by material facts.

Extensions of time will only be granted in very limited circumstances.

The Registrar has the power to dismiss an opposition proceeding if an opponent does not comply with their obligation to file a SGP within the time period.

Defending a Trade Mark Application

If your application to register a trade mark is opposed, you are now required to file a “**Notice of Intention to Defend**” **within one month** from the day you receive a copy of the SGP.

If you do not file a Notice of Intention to Defend, your application for registration will lapse. Lapsed applications will be treated in the same way as discontinued or dismissed applications.

How Can We Help?

We can assist you at any stage of opposing or defending a trade mark application. We can help you to:

- Regularly monitor the Australian Official Journal of Trade Marks to ensure that trade marks similar to yours are quickly identified;
- Carefully consider where there are adequate grounds of opposition in order to file an SCG;
- Ensure that both the Notice of Intention to Oppose and the SGP are filed within the prescribed time frames;
- Act promptly to defend your trade mark in any opposition proceedings by filing a Notice of Intention to Defend within the specified time limit.

If you would like more information about these reforms and how you can protect your trade mark, please contact our office on **02 9221 7555** or **legal.one@advantagepartnership.net**

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