

Trade mark opposition procedures - Australia

Introduction

The Australian trade mark system is governed by the *Trade Marks Act and Regulations 1995* and consists of full examination covering both absolute and relative grounds. Applications are advertised at both filing and acceptance, although opposition can only be officially filed post acceptance and pre registration. An application is given 15 months from filing to achieve acceptance, however this time may be extended easily to 21 months and also after that time as long as sufficient justification is provided and fees are paid. Opposition decisions on substantive matters may be appealed to the Federal Court of Australia. Trade mark registrations may be cancelled by the Federal Court, and with the imminent proclamation of new legislation, the Registrar of Trade Marks will have the power to revoke registration in certain circumstances.

Opposition procedures

An application for standard trade mark registration that has been advertised as accepted may be opposed by any person on any number of the following grounds:¹

- Trade mark containing etc. certain signs (prescribed and prohibited signs)
- Trade mark not distinguishing applicant's goods or services
- Trade mark scandalous or its use contrary to law
- Trade mark likely to deceive or cause confusion
- Identical etc. trade marks (substantially identical or deceptively similar)
- Applicant not owner of trade mark
- Opponent's earlier use of similar trade mark
- Applicant not intending to use trade mark
- Trade mark similar to one that has acquired a reputation in Australia
- Trade mark containing or consisting of a false geographical indication
- Application etc. defective etc. (illegal amendment or false material particulars)
- Application made in bad faith

The opponent bears the onus of establishing at least one ground for the opposition to be successful. The process begins with the filing of the notice of opposition, which must be filed within time,² nominate at least one valid ground, be served upon the trade mark applicant³ and be accompanied by the appropriate fee.⁴ The claims made in the notice of opposition should be substantiated by evidence in support, a copy of

¹ Please refer to Attachment A – relevant extracts from the Trade Mark Examiners Manual

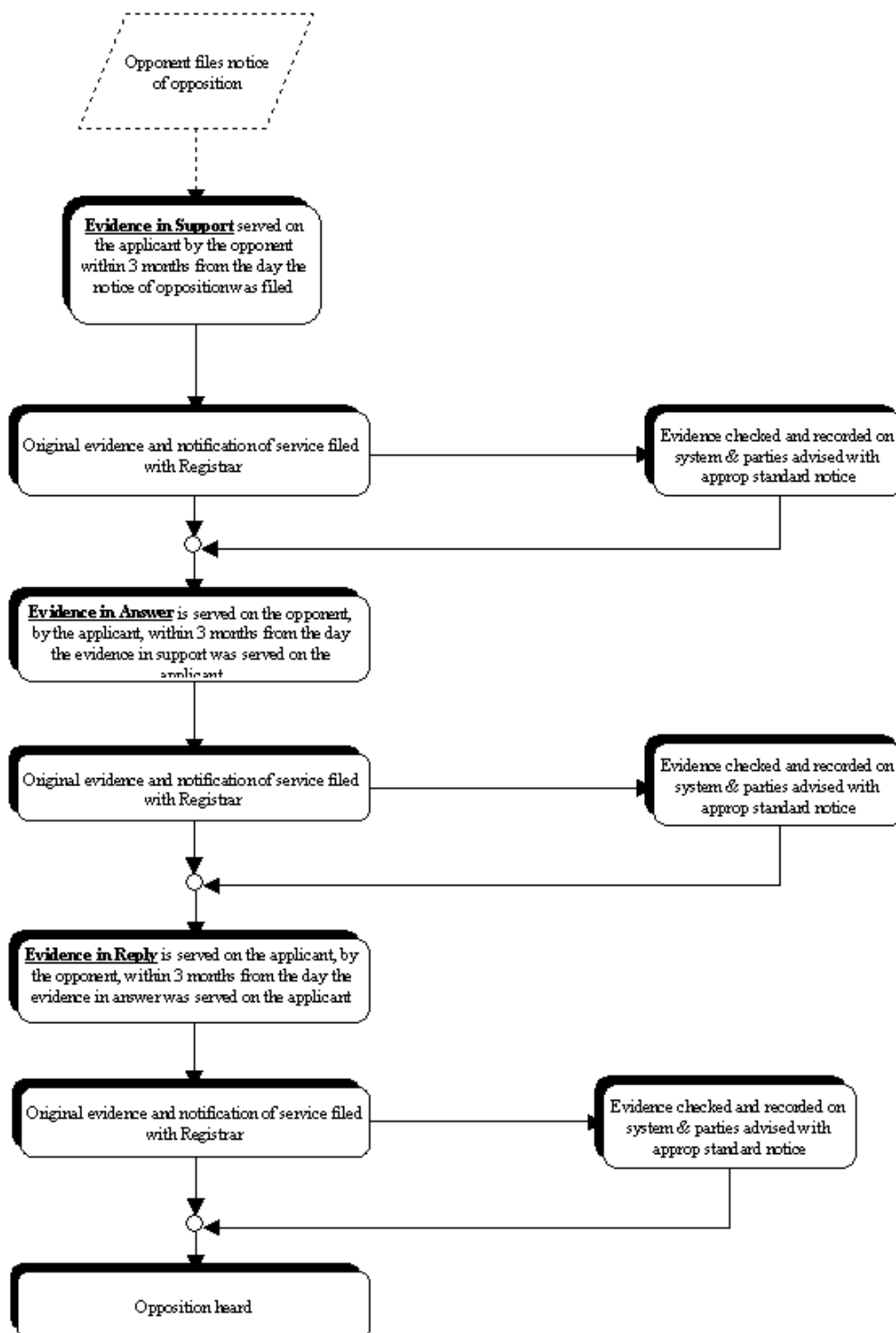
² A period of 3 months is allowed from the date of advertisement of acceptance. This period is extendable for a further 3 months in certain circumstances.

³ If the opposition is against an application made under the Madrid Protocol there is no requirement for service of the notice of opposition, or any evidence, unless the holder has an address for service in Australia.

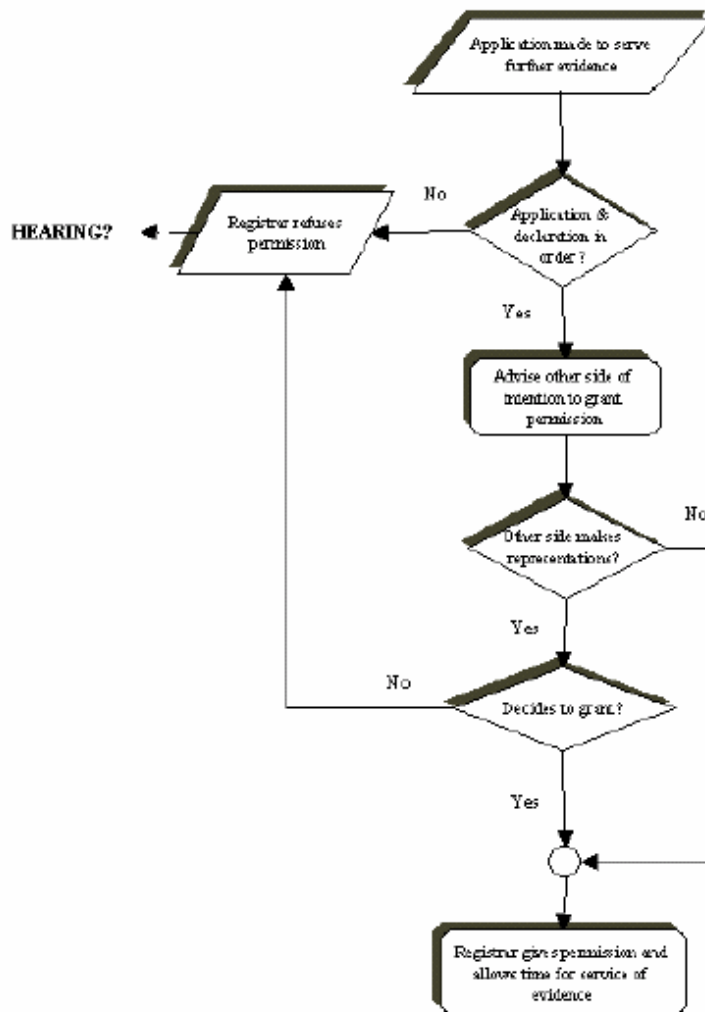
⁴ Please refer to Attachment B – current schedule of trade mark fees

which needs to be served upon the applicant and the original evidence filed with the Trade Marks Office. The applicant is then permitted to serve and file evidence in answer to both the claims in the notice of opposition and in the evidence in support. This is followed by the opponent's evidence in reply, strictly in reply to the applicant's evidence in answer, and this generally finalises the evidence stages. Permission for service and filing of further evidence may be requested by either party at any time in the process, and may be granted with a right of reply given to the receiving party. These procedures are set out in the following flow charts:

SERVICE OF EVIDENCE



FURTHER EVIDENCE



The timeframes for service of evidence are extendable, in blocks of 3 months or less upon provision of fees and written justification for requiring further time. Multiple extensions are allowed in this fashion; however the onus on the requesting party rises with time to provide adequate justification for the delay. If the parties are negotiating a settlement of any kind it is relatively easy to obtain multiple extensions.⁵ If the parties are contesting the same or similar questions before the Federal Court as before the Registrar, a stay or suspension of proceedings may be granted until the Court has handed down a judgement or until the matter is otherwise finalised.

At the conclusion of the evidence stages it is open for either party to request, and pay for, a hearing. Hearings may be conducted with the parties in person, via telephone or video conference, or simply through the provision of written submissions. A decision on the substantive matter is generally reserved at the conclusion of the hearing, and the decision with written reasons is normally issued within 3 months of the hearing. If neither party requests a hearing the Registrar of Trade Marks is entitled to make a

⁵ Please refer to Attachment C – extension of time process

decision on the written record – taking into account all submissions and evidence which has been properly served and filed in the course of the proceedings. A decision with brief reasons is issued, however matters where parties have paid a hearing fee do receive priority over such decisions on the written record.

Approximately 3.5% of acceptances attract an opposition action, equalling almost 1450 oppositions per year for the last two calendar years. Of these oppositions an average of 230 have requested a hearing each year. In the decisions issued throughout the last two years 33% of oppositions have been at least partially successful in establishing a ground of opposition and either preventing the application from gaining registration or limiting its registration to less than what was originally requested. Of the decisions issued by the Registrar over the past two years an average of 9.4% have been appealed to the Federal Court.

The system of opposition pre registration suits Australia's full examination practice and the rising numbers of applicants, including individuals and small businesses, who are unrepresented. Australia has a large private applicant base; over 60% of applications are filed by unrepresented parties. This translates to a number of oppositions filed and defended without the aid of an attorney or other representative. These unrepresented parties are not afforded any special aid or information, however attempts may be made to retain the same contact officer throughout the evidence stages.

A review of the hearings and opposition process was conducted with the aims of improving customer focus, business efficiencies and alignment with the legislation review. The overwhelming feedback from the public, trade mark users and trade mark professionals is that the opposition process works well.⁶ In response to the review it was suggested that tightening up on the timeframes for service of evidence and appointing a Case Manager to see each opposition through to finalisation would improve the opposition process. The Courts have also seen the opposition process and the decisions of the Registrar as worthwhile, and have commented that the opinions of Delegates are to be given due weight as they are made by skilled and experienced officers.⁷

Full examination followed by an opposition process administered by the Registrar prior to registration offers a high value service at minimum cost to trade mark users. Applications which are considered to be unsuitable for registration are prevented from acceptance by the full examination system, thereby preventing some opposition actions. Having the same grounds for rejection used in examination fully tested, along with additional grounds, during the opposition process leads to a conclusive outcome for trade mark users. This has the additional benefit of being without the high costs associated with Court action and without the necessity for legal representation, further reducing costs to clients. The pre registration opposition avoids the uncertainty of untested registrations on the register, and lessens the need

⁶ *Trade Marks Legislation Review Paper 3* 30 September 2004

⁷ See such decisions as *NEC Corporation v Punch Video (s) PTE Limited* [2005] FCA 1126 and *Registrar of Trade Marks v Woolworths Limited* (1999) 93 FCR 365

for the general public and trade mark users to carefully scrutinise trade marks which have been considered suitable for registration.

Grounds for opposition to registration of national trade marks

Registration of a national trade mark may only be opposed on the grounds contained in the Act and Regulations, and on no other grounds. In general, it is for the opponent to make out the ground(s) on which it relies. If the opponent does not successfully establish any of the grounds on which the application was opposed, then, subject to the Registrar taking into account all of the relevant circumstances relating to the matter, the opposition will fail.

5.1 Registration may be opposed on the same grounds as for rejection

Registration may be opposed on the grounds for rejection listed in the Act and Regulations with the exception of the ground under section 40 that the trade mark cannot be represented graphically ([section 57](#)).

5.2 Registration may be opposed on the ground that the applicant is not the owner of the trade mark - section 58

This ground is provided for by [section 58](#) of the Act. Ownership is ownership at common law. Note the comments in the Reader's Guide to the *Trade Marks Act 1995* to the effect that "owner" equates to "proprietor" under the 1955 Act. However, prima facie, the application is a claim to ownership of the trade mark in relation to particular goods or services ([see paragraph 27\(1\)\(a\)](#)). The Registrar has accepted that claim by accepting the application ([see subsection 33\(1\)](#)). It is then for the opponent to establish the ground on which it relies. In deciding if this has been done in terms of [section 58](#), the Registrar will consider whether there has been prior use in Australia of the same or of a substantially identical trade mark, by another person, for the same goods and services.

5.2.1 Prior use

This must be use, in the relevant sense of that word, in Australia by someone other than the applicant/authorised user. The use need not be extensive (see *The Seven Up Co v O.T. Ltd* (1947) 75 CLR 203 at p 211), but must be before the priority date or the date of first use by the applicant, whichever is the earlier.

See also Shanahan, *Australian Law Of Trade Marks And Passing Off* pp 154 - 157 for a discussion of "Prior use under section 40". Section 40 of the 1955 Act equates generally to [paragraph 27\(1\)\(a\)](#) of the 1995 Act.

5.2.2 The same or substantially the same trade mark

5.2.3 Same goods or services

The position at common law is not changed from that at Shanahan pp 158-159. The Registrar will decide the extent of sameness of the goods

or services, a matter that may often be contentious. In the case of a multi-class application, or even an application covering a broad range of goods or services in a single class, the ground of opposition may succeed for only part of the application.

5.3 Registration may be opposed on the ground that the opponent has prior use of a similar trade mark – section 58A

PLEASE NOTE: This ground can only be relied on for oppositions to national trade marks which were accepted after 23 October 2006.

The provisions of [subsection 44\(4\)](#) allow the Registrar to accept a trade mark for possible registration even though it may be similar to an earlier trade mark (application or registration) for similar goods and services. For [subsection 44\(4\)](#) to apply the applicant must be able to show they first used their trade mark before the filing date of the earlier trade mark, that the use was in relation to the relevant goods and/or services and that it has been continuous use.

The Registrar will accept the trade mark on that basis but will notify the owner of the earlier trade mark. If the owner of the earlier trade mark had used their trade mark before applying for trade mark registration and that use pre-dates that of the accepted application, it may oppose registration on the basis of its prior use.

5.4 Registration may be opposed on the ground that the applicant does not intend to use the trade mark - section 59

PLEASE NOTE: This ground does not apply to oppositions to registration of defensive trade marks.

In applying for trade mark registration, the applicant is also claiming that he or she is using, or intends to use, the trade mark on the nominated goods or services (see [paragraph 27\(1\)\(b\)](#)). It follows that the Registrar, by accepting the application for a trade mark under [section 33](#), is prima facie satisfied that there existed such an intention to use the trade mark, on those goods and services. For an opposition to be successful on this ground, the opponent must satisfy the Registrar that the applicant does not have the requisite intention.

5.4.1 Intention

The onus under [section 59](#) is on the opponent to show that, as at the date of opposition, the applicant's intention was neither to use nor to authorise the use of the trade mark, nor to assign the trade mark to be used by a body corporate, in relation to the specified goods or services. To succeed in its opposition on this ground, an opponent would need to show that, although the intention to use may have been taken as existing at the date

of acceptance, it was never actually there or that it was no longer present at the date of the opposition.

It should be noted here that, by virtue of the expression "does not intend", [section 59](#) appears to be concerned with the situation as existing at the time of the opposition, while [section 27](#) deals with the circumstances as at the time of filing of the application. Therefore, despite the applicant successfully showing an intention either to use, authorise the use of, or assign the trade mark at the date of filing, that might not be sufficient to defeat the opposition based on this ground. However, the opponent has the difficult task of convincing the Registrar of a negative and it would appear that this ground might not be often used, given the problematic nature of demonstrating it.

5.5 Registration may be opposed on the ground that use of the trade mark may confuse or deceive because of another trade mark with a reputation in Australia - section 60

The intention of [section 60](#) of the *Trade Marks Act 1995* is to implement Australia's obligations to protect well-known trade marks under the Paris Convention for the Protection of Intellectual Property and the 1994 World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). [Section 60](#) requires an assessment of the reputation in Australia that has been acquired by a particular trade mark and whether, in light of that reputation, use of the applied-for trade mark would be likely to deceive or cause confusion. Prior to the *Trade Marks Amendment Act 2006* [section 60](#) also required that the applied-for trade mark be substantially identical with or deceptively similar to the trade mark with the reputation.

An amendment to [paragraph 60\(a\)](#) removed the requirement for substantial identity or deceptive similarity. The amended [section 60](#) provides that a trade mark may be opposed where another trade mark has a reputation in Australia and because of that reputation the use of the applied-for trade mark is likely to cause confusion or deception in the market place.

PLEASE NOTE: This amendment only applies to oppositions to national trade marks accepted after 23 October 2006. For oppositions to national trade marks accepted on or before 23 October 2006, the requirement for the trade marks to be substantially identical or deceptively similar remains.

The effect of the amendment should be born in mind when reading paragraphs 5.5.1 and 5.5.2 as follows.

5.5.1 Factors to be considered

The factors to be considered in relation to a ground of opposition under [section 60](#) were dealt with in a decision of the Registrar (dated 15 October 1999) on an opposition to registration of trade mark application

No 730699 (*Macdonald's Corporation v Steve M. Bowditch* - to be published). Deputy Registrar Hardie pointed out that [Section 60](#) comprises two paragraphs. Paragraph 60(a) lays down the necessary preliminary condition for a section 60 ground. Paragraph 60(b) then prescribes the test which, operating in respect of those conditions, will achieve success for a [section 60](#) ground. This is consistent with comments by Justice Branson in the Metro case (*Registrar of Trade Marks v Woolworths Limited* [1999] FCA 1020) where she says at paragraph 82,

...the ground for opposing registration of a trade mark provided by [s 60](#) requires not only that the trade mark for which registration is sought be substantially identical with, or deceptively similar to, another trade mark, but also that, because of the reputation of that other trade mark, the use of the first mentioned trade mark would be likely to deceive or cause confusion,

Deputy Registrar Hardie enumerated four preliminary conditions for the operation of paragraph 60(a):

- the application trade mark must be either substantially identical with or deceptively similar to the trade mark or trade marks cited by the opponent
- the cited mark or marks must have acquired a reputation
- that reputation has to have been acquired before the priority date of the opposed trade mark, and
- the reputation has to have been acquired in Australia.

[Paragraph 60\(b\)](#) provides that once these threshold conditions are established, the section 60 ground will succeed if, because of the reputation in the cited mark(s), the use of the application trade mark is likely to deceive or cause confusion.

5.5.2 Substantial identity or deceptive similarity

PLEASE NOTE: The following is not a requirement for oppositions to national trade marks accepted after 23 October 2006.

The preliminary condition for a [section 60](#) ground to succeed is that the trade mark(s) cited by the opponent must be substantially identical or deceptively similar to the opposed trade mark. The tests of comparison are the same as applied in making an assessment of trade marks in terms of [section 44](#) of the Act. Under [section 60](#), however, the cited marks need not be registered for the same, or similar, or closely related

goods or services. What is more, they need not be registered at all.

5.5.3 Analysis of conflicting reputation

Once the trade marks are found to be substantially identical or deceptively similar, the strength of a ground under [section 60](#) will depend on the substance and extent, at the priority date, of the reputation in the cited trade mark(s). The opponent must bear the onus of demonstrating both the reputation and the likelihood of deception and confusion occurring because of it, if the application trade mark is used on the particular goods or services to be covered by the registration.

There are many factors which must be taken into account. Per *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 608, it is necessary to look at whether the trade mark in which the reputation resides is general or special in character. This inquiry goes to the novelty or memorability of the trade mark, be it an invented word, a rare surname or a trade mark proceeding on evidence of use. The nature of the trade mark has considerable bearing on the likelihood that a connection will be seen between the applicant's trade mark and the source of the conflicting reputation.

A further consideration is whether the goods for which that reputation exists are a wide or a narrow range and the extent to which the goods are restricted to a niche market. The possibilities for some real or expected relationship between the field of interest of the opponent's trade marks, on one hand, and that of the applicant, on the other, must be considered.

5.5.4 The likelihood of deception or confusion

The evaluation of the likelihood of deception or confusion resulting from use of the application trade mark because of the reputation of the cited trade mark(s) is complex. It requires all of the above factors to be looked at simultaneously and their contribution to the overall likelihood assessed. No one factor is necessarily determinative.

Justice Kitto spells out the criteria for assessing the likelihood of deception and confusion under the 1905 Act in the *Southern Cross* case. These same criteria were equally applicable under the 1955 Act. In the *Metro* case (*Registrar of Trade Marks v Woolworths Limited* [1999] FCA 1020) Justice French considered the application of these criteria under the *Trade Marks Act 1995* where an underlying policy is a presumption of registrability. He considered the case law on deception and confusion under earlier statutes can still be relied on, provided the change in law as to onus is borne in mind (*Metro* case (supra) at paragraph 48).

The cases show that the opponent must establish some "real risk" ("*Southern Cross*", supra). There must be a "substantial number" of people, (see *The Kendall Co v Mulsyn Paints* (1963) 109 CLR 300 at

305), who would be deceived or confused. The word "substantial" must, however, be sensibly related to the size of the market in question because, as noted by Lord Upjohn (in *Bali trade mark* (1969) RPC 472 at 496) "substantial number" is no more than a "judicial gloss".

5.6 Registration may be opposed on the ground that the trade mark contains or consists of a false geographical indication - section 61

[Section 61](#) was included in the *Trade Marks Act 1995* to ensure that Australia met its obligations under the Agreement establishing the World Trade Organization. It originally provided a ground of opposition if an application for a trade mark for particular goods (*relevant goods*) contains a sign which is a geographical indication for goods (*designated goods*) originating in a country, region or locality other than the country in which the relevant goods originated, or a region or locality in a country other than the region or locality in which the relevant goods originated. However the wording was such that it allowed a person to oppose a trade mark that contains a geographical indication where the goods to which the trade mark is applied are different from the goods to which the geographical indication relates.

As an example, "Hilltops" is a geographical indication for wine produced around the town of Hilltops in southern New South Wales. [Section 61](#) as originally written allowed for an opposition to a trade mark containing the word "Hilltops" used in relation to kites made in Perth, even though there is no association between the Hilltops wine region and kites, and even though kites and wine are unrelated goods.

This is contrary to the original intention for [section 61](#) and by means of the *Trade Marks Amendment Act 2006* paragraph 61(1)(b) was amended. As a result of the amendment it is only possible to oppose a trade mark containing a geographical indication if the goods specified by the trade mark are similar to those covered by the geographical indication or if the use of the trade mark would be likely to deceive or cause confusion.

PLEASE NOTE: This amendment only applies to oppositions to national trade marks accepted after 23 October 2006. For oppositions to national trade marks accepted on or before 23 October 2006, there is no requirement that the goods be similar or that use would be likely to deceive or cause confusion.

The effect of the amendment should be born in mind when reading paragraphs 5.6.3 as follows.

5.6.1 Geographical indication

The definition of "geographical indication", in relation to goods (see [section 6](#)), says that it means a sign which is recognised in a country as indicating that those goods originated in that country, region or locality, and that they have a quality, reputation or other characteristic attributable

to their geographical origin. The word "recognise" is listed, *inter alia*, in the *Macquarie Dictionary*, as meaning, "...to acknowledge or accept formally as being something stated...". Therefore, its use in the context of the Act would appear to be intended to mean that the reputation of the sign as a geographical indication for the designated goods must be of some significance in that country.

To show the extent of that reputation, an opponent would need to show, through evidence, that it had a significant presence within its particular field. This material could comprise declarations from experts in relation to the goods, references in texts or the like, or some evidence of a form of recognition of the sign in that country which supported claims of such a reputation, eg. registration as an appellation of origin.

5.6.3 Overcoming an opposition - subsection 61(2)

If the opponent has established that the trade mark contains a geographical indication; and, in the case of oppositions to trade marks accepted after 23 October 2006, that the goods specified by the trade mark are similar to those covered by the geographical indication, the onus shifts to the applicant. The applicant must then establish:

- per section [61\(2\)\(a\)](#):

that the relevant goods actually did originate in the country, region or locality indicated (note that this would not be enough if it emerged in the proceedings that the provisions of Division 2 Part 4 then applied adversely), or

- per section [61\(2\)\(b\)](#):

that the sign in question has ceased to be a geographical indication in the country of origin for the designated goods, or

- per section [61\(2\)\(c\)](#):

that the applicant, or predecessor in title, used, or applied for the trade mark, in good faith for the relevant goods before 1 January 1996, or the day that the sign was recognised as a geographical indicator for the designated goods in their country of origin - whichever is the later.

5.6.4 Wines or spirits - paragraph 61(2)(d)

If the sign is for wine or spirits and includes a geographical indication, the applicant has an additional means to overcome this ground of opposition if it can show that the sign was identical with the customary name, as at 1 January 1995 in the country where the wine or spirits originated (see

[section 15](#) for the definition of "originate" in relation to wine), of a variety of grapes used to produce them. It is possible, however, that resolving this problem may give rise to a ground for rejection under Division 2 Part 4 that the trade mark is not capable of distinguishing the applicant's goods.

5.6.5 Deception or confusion

An opposition also fails under this ground if the applicant establishes that, although the sign might be a geographical indication for the designated goods, it is also a geographical indication for the relevant goods, and that the applicant has not used, nor intends to use the trade mark in a way that is likely to deceive or confuse the public as to the origin of the relevant goods.

5.7 Registration may be opposed on the grounds of improper amendment or acceptance on the basis of evidence or submissions false in material particulars - section 62

- [Subsection 62\(a\)](#) allows, as a ground of opposition, the fact that an application, or other document filed in support of the application, has been amended contrary to the Act. This may have occurred because the document was interfered with by an unauthorised person, or an amendment of it may have been improperly allowed.
- [Subsection 62\(b\)](#) provides as a ground of opposition the fact that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

While an opponent may succeed in establishing either of these grounds, this may not necessarily be fatal to an application, as the Registrar retains the discretion to register, to refuse to register the trade mark or, for oppositions to national applications accepted after 23 October 2006, to revoke acceptance. (See the discussion regarding the Registrar's role in opposition to registration at [section 3 of this Part](#), above.)

5.8 Registration may be opposed on the ground that the application was made in bad faith – 62A

PLEASE NOTE: This ground can only be relied on for oppositions to national trade marks accepted after 23 October 2006.

The *Trade Marks Act 1995* allows for the removal of a registered trade mark on the basis that at the date of application there was no intention in good faith to use, authorise the use of, or to assign the trade mark ([section 92](#)). However until the Act was amended by means of the *Trade Marks Amendment Act 2006* there was

no provision for opposing registration on the basis that the application for registration was made in bad faith. The Registrar's experience has shown that such a provision is necessary. She is aware of instances where the trade mark applicants have deliberately set out to gain registration of their trade marks, or have adopted trade marks, in bad faith. Examples include:

- persons who monitor new property developments, register the names of new developments as trade marks for a number of services and then threaten the property developers with trade mark infringement proceedings unless the developers licence or buy the trade marks;
- persons who have a history of applying for trade marks that are deliberate misspellings of other registered trade marks;
- persons who identify trade marks used overseas but with no Australian use as yet who then apply to register the trade marks in Australia for the express purpose of selling them to the overseas owners.

For this reason [section 62A](#) was added to the Act so that registration of a trade mark could be opposed on the basis that the trade mark applicant applied for registration in bad faith.

Grounds for opposition to registration of international trade marks

Apart from the instances noted below, oppositions to registration of international trade marks may be based on the grounds contained in sections 39, 41 (177 for certification trade marks), 42, 43, 44, 58, 58A, 59, 60, 61, 62A and regulation 17A.31(4).

- For oppositions to international trade marks accepted on or before 23 October 2006, the section 58A and 62A grounds **do not** apply, nor do the amendments to sections 60 and 61 discussed in [section 5 of this Part](#).
- For oppositions to international trade marks accepted after 23 October but on or before 19 December 2006, the section 58A ground applies as do the amendments to sections 60 and 61 but **NOT** the section 62A ground.

Attachment B

Trade Marks Office Fee Schedule (in \$AUS)

Regulation 21.21

1	Filing an application for register a trade mark under subsection 27(5) of the Act in respect of goods or services in 1 or more of the prescribed classes:	\$AUS
	(a) by an electronic means approved by the Registrar for this paragraph	120 per class
	(b) by AFS request mentioned in regulation 4.2A	90 per class
	(c) by another means	150 per class
2	Filing an application for an extension of: a period under subregulation 4.12 (3) or regulation 17A.20; or time under regulation 21.25	100 per month or part month for which the extension is sought
3	Filing an application for an extension of: a period under subregulation 5.15 or regulation 17A.33; or time under regulation 5.2 or 17A.30	150 per month or part month for which the extension is sought
4	Filing a notice of opposition under: (a) section 52 of the Act; or (b) section 96 of the Act (including section 96 as applied by regulation 17A.48); or (c) subsection 224 (6) of the Act; or (d) regulation 17A.29	250
5	Filing an application for permission to serve a copy of further evidence in opposition proceedings under paragraph 5.15 (1) (b)	100
6	Single registration of a trade mark under section 68 of the Act in respect of goods or services: in a single prescribed class in more than 1 class	300 300 for each class
7	Renewal of a single registration of a trade mark under section 75 of the Act in respect of goods or services:	300

	<p>in a single prescribed class</p> <p>in more than 1 class</p>	300 for each class
8	<p>Filing an application for removal of a trade mark from the Register:</p> <p>(a) for non-use under section 92 of the Act; or</p> <p>(b) for cessation of protection for non-use under subregulation 17A.48 (1)</p>	150
9	<p>Request for a hearing under:</p> <p>(a) regulation 5.14 (including regulation 5.14 as applied by regulation 17A.33); or</p> <p>(b) regulation 9.4, (including regulation 9.4 as applied by regulation 17A.48)</p>	500
10	Request for a hearing in relation to any other matter	300
11	<p>Attendance at a hearing under:</p> <p>(a) regulation 5.14 (including regulation 5.14 as applied by regulation 17A.33); or</p>	\$500 for each day, or part of a day, less any amount paid under item 14 in relation to
12	Attendance at a hearing in relation to any other matter	\$300 less any amount paid under item 15 in relation to the hearing
13	Handling an application for the international registration of a trade mark under regulation 17A.7	100
14	Transmitting a renewal fee for the international registration of a trade mark under Article 7 of the Madrid Protocol	100

Step	Period allowed	Extendible?
Acceptance of tm advertised in AOJTM	AOJTM date	
<u>Notice of Opposition</u>	3 months from advertisement date	<p>Yes</p> <p><i>Within the period</i></p> <ul style="list-style-type: none"> *error or omission by an employee of IP Australia, the person concerned or their agent, or *circumstances beyond control of the person, *to undertake research or negotiations <p><i>Outside the period</i></p> <ul style="list-style-type: none"> *error or omission by an employee of IP Australia, the person concerned or their agent, *circumstances beyond control of the person, <p><i>How many extensions?</i></p> <p>Usually only 3 months</p>
<u>Evidence in Support (EIS)</u> (opponent)	3 months from date Notice of Opposition is served and filed	<p>Yes</p> <p><i>Reason</i></p> <ul style="list-style-type: none"> *party needs more time to prepare and serve evidence, or *negotiating with other party <p><i>How many extensions?</i></p> <p>If the parties are not negotiating 9 months is usually allowed including the statutory 3 months. When the parties are negotiating 15 months is usually allowed.</p> <p>But further extensions may be allowed.</p>
<u>Evidence in Answer (EIA)</u> (applicant)	3 months from date EIS served	<p>Yes</p> <p><i>Reason</i></p> <ul style="list-style-type: none"> *party needs more time to prepare and serve evidence, or *negotiating with other party <p><i>How many extensions?</i></p> <p>If the parties are not negotiating 9 months is usually</p>

		<p>allowed including the statutory 3 months. When the parties are negotiating 15 months is usually allowed.</p> <p>But further extensions may be allowed</p>
<p><u>Evidence in Reply (EIR)</u> (opponent)</p>	<p>3 months from date EIA was served</p>	<p>Yes</p> <p><i>Reason</i> *party needs more time to prepare and serve evidence, or *negotiating with other party</p> <p><i>How many extensions?</i></p> <p>If the parties are not negotiating 6 months is usually allowed including the statutory 3 months. When the parties are negotiating 9 months is usually allowed.</p> <p>But further extensions may be allowed</p>
<p><u>Hearing or Decision on the Written record</u></p>	<p>Either party may request one of these within one month from the date of the Official Notice</p>	<p>Yes</p> <p>If both parties are negotiating and both agree to defer the hearing request.</p> <p>If a hearing is not requested- Decision will issue based on evidence on file.</p>