

Trade mark opposition FAQs

What is an opposition? Once a trade mark application is accepted for registration, details of the application are advertised in the Intellectual Property Office Journal so that any interested parties can object to it being registered. The objection process is known as a trade mark opposition.

Can anyone oppose a trade mark? Yes. Any person having reasonable grounds may oppose the registration of a trade mark.

What are the usual grounds of an opposition?

The grounds of opposition are set out in the Trade Marks Act 2002. The most common claims are that:

- The mark sought to be registered is confusingly similar to another trade mark which is either registered or in use by another party,
- The mark is descriptive or incapable of distinguishing the applicant's goods or services from those of others,
- The mark is deceptive, and/or
- The mark has been misappropriated from another party;

Who decides whether the application will be registered? Trade mark opposition proceedings are dealt with by the Intellectual Property Office of New Zealand ("IPONZ") and decided by the Commissioner of Trade Marks.

How and when do I oppose a trade mark application?

- **Notice of opposition:** Once a trade mark application has been accepted and advertised in the Intellectual Property Office Journal anyone wanting to oppose the application has three months from the date of advertisement to file a Notice of Opposition. The Notice of Opposition must identify the grounds of opposition.
- **Counterstatement:** Once the Notice of opposition is filed, the applicant has 2 months to file a counterstatement setting out its response to the grounds of opposition. The counterstatement should also contain reasons why the applicant says the application should be registered. If the applicant does not file a counterstatement within the 2 month period allowed, the trade mark application is deemed to have been abandoned.
- **Evidence:** Evidence is given in the form of statutory declarations or affidavits. After the counterstatement is filed, the opponent has two months to file evidence in support of the opposition. If the opponent does not file evidence (or give notice of an intention not to file any evidence) it is deemed to have abandoned its opposition. Once the opponent's evidence is completed the applicant has two months to file evidence in support of the application. After the applicant's evidence is filed,

the opponent can lodge evidence in reply. This evidence must be confined to matters raised in the applicant's evidence.

- **Hearing:** No further evidence can be filed by either party except with leave of the Commissioner. The opposition will usually be set down for a hearing where each party speaks to written submissions in support of their case.

Can these deadlines be extended? In most cases yes, although you need to be careful in relation to the Notice of opposition as the Commissioner is constrained by the Act in terms of what extensions can be granted and when. Also, to obtain an extension you need to show that you have acted diligently to meet the previous deadline and that the justice of the case warrants an extension (i.e. you will suffer prejudice if it isn't granted).

How long will the opposition take? If all steps are completed within the specified time frames the opposition will take 10 – 11 months to be heard. If extensions are granted it will take longer, but most opposition proceedings should be concluded within 18 months.

How is the decision made? Decisions are issued in writing by the Commissioner of Trade Marks and usually issue within 2 – 3 months of the hearing.

Can I get costs and damages if I am successful? The Commissioner does have the power to award costs to the successful party. However these follow a set schedule for each step completed and usually only cover a small percentage of costs actually incurred by the parties. The Commissioner has no power to award damages.

Can I appeal the decision? Yes. Decisions can be appealed to the High Court within 20 working days of the decision.

Where can I find out more information on trade mark oppositions? You can find out more by reading our *Guide to the protection of innovation and goodwill*, available as a pdf download from the Media/Publications page on our website, or by contacting our Trade Marks Team or Litigation Team.

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