

Time to Update Trade Mark Law Changes

The *Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 (Bill)*, introduced in the Senate in June 2011, amends the Patent, Trade Mark, Design and Copyright laws.

As for the Trade Mark law amendments, the Bill is mostly involved with opposition proceedings but it also includes strengthened provisions in relation to protecting trade mark owners.

We are pleased to have contributed to this reform by submitting our comments on IP Australia's consultation paper "Towards a Stronger and More Efficient IP Rights Systems" which was based on the Bill.

The key elements of change are as follows:

Key Changes

(a) Opposition Proceedings

- Notice of Opposition should be filed within 2 months (not 3 months)
- Notice of Opposition will be served on the Applicant by the Trade Marks Office (not by the opponent);
- Opponent must file a Statement of particulars of the grounds on which they intend to oppose (**SGP**) within 1 month of the Notice of Opposition;
- Applicant must file a Notice of Intention to Defend within 1 month from the SGP (otherwise the application will lapse);
- Evidence-in-Reply should be filed within 2 months from being served the Evidence-in-Answer; and
- If the parties agree, the proceedings will be suspended for 6 months (plus further 6 months), so called "Cooling Off".

(b) Protecting trade mark owner from counterfeiting

- A Trade Mark owner can request to access items in Customs and may remove some samples of the counterfeit item; and
- Maximum penalty for trade mark infringement will be increased to the level of similar offence under the *Copyright Act 1968*.

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Conclusion

These changes are beneficial to trade mark applicants and opponents, making it faster and more prudent to take action.

Even though the amendments propose to shorten the period of opposition (i.e. 3 months to 2 months for filing the Notice of Opposition), the result is the same 3 month period, as the SGP must be filed within 1 month of filing of the Notice of Opposition.

We note that the requirement for the Applicant to file a Notice of Intention to Defend means an Applicant must maintain awareness of their trade marks, as failing to lodge a Notice will result in their application lapsing.

The changes to the Trade Marks Act are expected to take effect in early 2012.

We will keep an eye on these changes, including subsequent amendments to the Regulations.

If you are seeking a safe way to protect your brand, Axis Legal is the first place to contact.

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