

Opposing registration of a trade mark

[Advertisement](#)

[Opposition](#)

[Counter-statement](#)

[Evidence](#)

[Extensions of time](#)

[Withdrawal](#)

[Decision](#)

[Appeal](#)

[Overview of the opposition process](#)

Please note that this information is intended to be a guide only. For legal advice, we recommend that you contact a patent attorney or lawyer familiar with intellectual property law.

Advertisement

When an application for registration of a trade mark is accepted, the application is advertised in the [Journal](#). Any person who wishes to oppose the registration of the trade mark can do so within three months from the date of advertisement in the Journal.

Opposition is an objection to the registration of an application in the form it was advertised. The Intellectual Property Office of New Zealand recommends that a potential opponent first contacts the trade mark applicant directly about their concerns before they formally file a Notice of Opposition. The three month opposition period allows time for this exchange to happen.

Opposition

If the parties are unable to settle the matter between them, the opponent may formally file a Notice of Opposition with the [fee](#).

Counter-statement

Once a Notice of Opposition has been filed, the trade mark applicant then has two months to file a Counter-statement, or to abandon their trade mark application. If the applicant does not file a Counter-statement within the required two months, the application will be deemed abandoned.

Process time limits

These time limits apply to any further proceedings:

- Two months for an opponent to file more evidence in reply to a counterstatement (or advise they do not intend to file evidence)
- Two months for the trade mark applicant to respond to the opponent's further evidence
- One month for the opponent to file evidence strictly in reply to the applicant's evidence.

It is expected that no further evidence will be filed, although in some circumstances the Trade Mark Regulations 2003 make provision for this.

Extensions of time

Either party may apply for extensions of time. Such applications are subject to some limitations, and the applicant must convince the Office that an extension is justified in the circumstances.

Withdrawal

Parties may withdraw from the proceedings at any time, and at various points within the process a failure to meet time limits may result in the application, or the opposition, being ruled abandoned or discontinued. If a party withdraws without making any prior arrangements regarding costs, costs may be awarded against them.

Decision

Once all evidence is filed and the case is ready to be decided by the Commissioner, who will write to the parties to ask how they want a decision to be made. The parties may:

- Elect for a decision on the basis of the pleading and evidence as filed, with no written or oral submissions from the parties; or
- Elect for a decision on the basis of an exchange of written submissions, in accordance with a timetable agreed in advance with the Hearings Officer; or
- Elect to attend a hearing in person and make oral submissions.

Parties who elect to submit written submissions, or to attend a formal hearing, will be required to pay a [Hearing Fee](#), at the time they state their wish to make submissions or be heard.

An Assistant Commissioner then considers the case and issues a written decision, including any order as to payment of costs. For more information please [see our practice guidelines on cost awards in proceedings before the Commissioner](#).

Appeal

Either party may appeal the Commissioner's decision within 20 working days after the date of the decision. The appeal must be made to the High Court.

Overview of the opposition process

