We have some recommendations on areas for review relating to trade mark opposition proceedings.

- Hearing fees Where proceedings are discontinued prior to hearing and a hearing fee has been paid by one or both parties, the current Office practice is not to issue a refund. This disadvantages parties who have managed to resolve their dispute prior to hearing, eg through negotiation. While we accept that part of the hearing fee is attributable to IP Australia’s administrative cost (allocating Hearing Officer, setting directions etc) the bulk of that fee would be attributable to the actual hearing (i.e. delegate’s time for attending the hearing and writing the decision and technology expenses). As such, we suggest that IP Australia consider a full or partial refund in cases where the matter does not proceed to a full hearing.

- Items 7, 9, 11, and 13 – 16 of Schedule 8 of the Trade Marks Regulations We note that the scale of costs for the abovementioned items contained in Part 1 of Schedule 8 of the Trade Marks Regulations was last reviewed over 12 years ago (on 1 March 2007). The fees listed in the abovementioned items are not proportionate to, and do not reflect, market realities. We recommend that these items be reviewed, taking into account average hourly rates of practitioners and counsel. In conducting its review, IP Australia might have regard to the corresponding fee scales applicable to proceedings held before the Federal Circuit Court. We also invite IP Australia to review its practice on the award of costs in concurrently heard and determined opposition proceedings. The existing policy (if any) is unclear. It seems that IP Australia will generally award 20% of costs in each subsequent case. This may be appropriate where the grounds of opposition and evidence are identical across all relevant cases but may disadvantage the costs awardee in circumstances where the grounds and/or evidence are materially different.