

Non-use Actions

Sometimes a trade mark may go unused for a period of time or may not have been initially applied for with the intention that the applicant would actually use it in good faith. In such instances, action can be taken at the Trade Marks Office (instead of the Federal Court) to have a trade mark registration removed from the Trade Marks Register. This is referred to as a Non-use Action.

A successful non-use action will result in the trade mark registration being struck from the Trade Marks Register, possibly leaving the registered owner without any rights in the trade mark.

Non-use actions generally occur where a person has applied to register a trade mark and the Trade Marks Office has raised objection to its registration based on a similar, pre-existing trade mark registration. The owner of that trade mark application may then commence a non-use action to remove the pre-existing conflicting trade mark registration from the Trade Marks Register, which will permit the Trade Marks Office to then withdraw the objection.

To defend a non-use action, and prevent the removal of its trade mark registration from the register, the registered owner must show by submission of evidence that the trade mark, or a similar trade mark to that which is registered, has been used on the goods and/or services for which it is registered in the prescribed period. The prescribed period is five (5) years from date of application or three (3) years if the registered trade mark has been registered for more than five (5) years.

Often a registered owner will seek to defend a non-use action on the basis of evidence of use by others of its goods and/or services in relation to the trade mark. Such evidence will only be acceptable where the registered owner can show that it controlled the use by the other person. For this reason it is important to ensure that where another person is permitted to use a registered trade mark, the registered owner has a licence agreement in place to control that use and does in fact exercise control of the use of the registered trade mark.

Contact us today for assistance with your NON-USE ACTION

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