



# Academy of Education

Institute of Patent and Trade Mark Attorneys of Australia

## **A MASTERCLASS IN TRADE MARK OPPOSITIONS**

**15-16 June 2021**

**RACV Club, Melbourne**



Academy of Education

A MASTERCLASS IN TRADE MARK OPPOSITIONS

MELBOURNE 15-16 JUNE 2021

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## A MASTERCLASS IN TRADE MARK OPPOSITIONS

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Following on from previous successful masterclasses in other areas of practice the Academy of Education is proud to present a masterclass dedicated to Trade Mark opposition practice and procedure. The Masterclass will be held in Melbourne on the 15 and 16 June 2021. The Masterclass will also be held in both Sydney and Adelaide in the second half of the year on dates to be advised.

### *Why attend this Masterclass?*

The Trade Marks Opposition Masterclass is a well-crafted session designed to allow trade marks attorneys and trade mark focused lawyers to sharpen their opposition practice. The day and a half course will traverse important aspects of trade marks opposition practice with a case study to put learnings into practice. The course will provide a unique opportunity to interact with experienced practitioners in the area to hone your skills and provide you with insights into the best strategic approaches to resolving trade mark oppositions.

### *About the facilitators*

The Masterclass will be facilitated by Ian Horak, Siobhan Ryan and Andrew Sykes. Each of the facilitators are well respected barristers and experienced Counsel who regularly appear in trade mark opposition and appeal proceedings. Together they have over 50 years' experience in conducting trade mark oppositions, appeals and trade mark litigation. The practitioners have extensive knowledge of trade mark law and practice and intend to bring that experience to the fore in this class so that you can learn the best strategies and tactics for resolving trade mark oppositions.

### *Who should attend?*

The Masterclass is designed for IPTA Members who are registered trade mark attorneys and want to improve the effectiveness of their trade mark opposition practice. The class will assume a good knowledge of the general principles of trade mark law and their application. It will best suit those who have had some trade mark opposition experience, although previous opposition experience is not essential. Those who infrequently deal with oppositions or wish to deal with oppositions on a more frequent basis in the future are encouraged to attend. If you are not currently an IPTA member please contact the Secretariat. Numbers are limited and attendees are encouraged to register as soon possible.

*At IPTA we are eager to empower you with the tools you need  
to enhance your already remarkable skills.*

## ABOUT THE FACILITATORS

### *Ian Horak*

Ian is a barrister at the Victorian Bar. He was first admitted as a lawyer in 1999 and signed the bar roll in 2003. He is a registered Australian Patent and Trade Marks Attorney. Ian also holds a First Class Honours degree in Chemical Engineering. Ian practises exclusively in intellectual property law and regularly appears before the Federal Court of Australia and the Australian Trade Marks Office. He has appeared in many oppositions, appeals and trade mark infringement matters over his career, first as a trade marks attorney and lawyer and then as Counsel. Since joining the bar he has been consistently ranked in publications including Best Lawyers, Doyle's Guide and World Trade Mark Review. Ian is also a Senior Fellow at Monash University's Law School where he is the Chief Examiner and lecturer in postgraduate subjects on intellectual property and trade mark practice. He is a co-author with Professor Mark Davison of the seminal trade mark publication *Shanahan's, Australian Trade Marks Law and Passing Off* (5th and 6th edition).



### *Siobhan Ryan*

Siobhan is an experienced intellectual property lawyer - specialising in trade marks and copyright. Siobhan also advises and appears in trade practices, passing off and designs matters. She practices in all Federal and State Courts. Siobhan is a registered trade mark attorney and regularly appears before the Registrar of Trade Marks in oppositions and registrability cases. Siobhan has been consistently recognised in the Intellectual Property category in Best Lawyers, Doyles Guide and the World Trademark Review's, Leading Trade Mark Professionals. Siobhan is a nationally accredited mediator (NMAS) and is the President of the Trans-Tasman IP Attorneys Disciplinary Tribunal. She is an editor of the *Intellectual Property Reports* and an author for *Lahore, Patents, Trade Marks & Related Rights*.



### *Andrew Sykes*

Andrew Sykes is a barrister at the Victorian Bar. He is also a registered trade marks attorney and NMAS mediator. Andrew conducts a specialist national practice in intellectual property law with a predominate focus on trade mark law. His other areas include domain names, copyright, designs, internet law, software and confidential information. He frequently appears in the Federal Court of Australia and hearings before IP Australia, particularly in trade mark matters. He has been consistently recognised in the World Trademark Review's, Leading Trade Mark Professionals. He is also the author of *Australian Trade Mark Opposition Law* which is currently in its second edition and the Co-author of the chapter "Trade Marks and the Internet" in *"Lahore, Patents, Trade Marks & Related Rights"*.



## DATES & VENUE

RACV Club, 501 Bourke Street, Melbourne Victoria. Registration commences at 9:00am with the Masterclass commencing at 9:30am.

## FORMAT:

Conducted over 1 ½ days with morning and afternoon tea and lunch provided, and dinner also included on the first day with a venue to be announced. An indicative course outline is attached and a final outline together with case study and notes will be provided prior to students the course commencing. The course will involve a combination of seminars and interactive panel discussions in conjunction with a trade mark opposition case study.

## CPE:

The Masterclass includes at least 9 hours of education content, which can contribute towards continuing professional education requirements.

## COST

IPTA Members \$800

\*YIPTA Members \$700

Dinner included

**Spaces are limited to ensure a personal learning experience**

**REGISTER TODAY**

*If you would like to attend, please register online by no later than Monday 31 May 2021. Places are limited and the institute reserves the right to close registration early.*

*Please call IPTA on (03)9639 4377 if you require more information*

\*YIPTA – members of IPTA with less than 5 years post-registration experience as patent and/or trade mark attorneys

## Indicative Course Outline – A Masterclass in Trade Mark Oppositions\*

\*indicative course outline subject to finalisation

### Day 1

|         |   |
|---------|---|
| 9:00am  | Registration  |
| 9:30am  | Opening Masterclass and introductions   |
| 9:35am  | Introduction to case study concerning trade mark opposition.  |
| 9:50am  | <u>Reasons for opposing</u> : introduction to and initiating trade mark oppositions: Strategic approaches to commencing and defending an opposition to achieve a desired outcome.   |
| 10:00am | <u>Instituting an opposition</u> : timing; selection of grounds; preparation of the notice of opposition and statement of grounds and particulars; appropriate selection of particulars.  |
| 10:30am | Morning Tea   |
| 10:45am | <u>Preparation of evidence</u> : collecting the appropriate evidence; working with witnesses (lay and expert); type of evidence required for the various grounds of opposition; corroborative materials; preparing the best evidence; roles of evidence in support, answer and reply. |
| 12:30pm | <u>Procedural aspects</u> : Procedural matters including timelines; extensions of time and allowability; amendments; security for costs; possibilities to introduce further or supplementary evidence.  |
| 1:00pm  | Lunch   |
| 2:15pm  | <u>Preparation for hearing</u> : strategies to be adopted; interplay between grounds of opposition; successful arguments and strategies; written submissions; oral advocacy and successful presentation.  |
| 2:45pm  | Afternoon Tea   |

- 3:00pm Continue preparation for hearing
- 4:15pm Appeals and Court proceedings: nature of appeals de novo; judicial review; conduct of appeals in comparison to opposition hearings; hearing appeals with other proceedings such as infringement; appeals to the administrative appeals tribunal and judicial review.
- 4:45pm End of Day 1
- 6:30pm Dinner - Spice Temple, Southbank

## Day 2

- 9:30am Strategy discussion and case study: Working through an opposition case study and application of tips, traps and strategies that can be deployed in an opposition context.
- 10:45am Morning Tea
- 11:15am Panel discussion: Panel discussion with hearing officer from IP Australia (to be confirmed).
- 12:45pm End of Masterclass in Trade Mark Oppositions