



Supreme Court of New Zealand | Te Kōti Mana Nui o Aotearoa

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15 October 2020

**MEDIA RELEASE**

**INTERNATIONAL CONSOLIDATED BUSINESS PROPRIETARY LIMITED v SC  
JOHNSON & SON INCORPORATED**

(SC 32/2019) [2020] NZSC 110

**PRESS SUMMARY**

This summary is provided to assist in the understanding of the Court's judgment. It does not comprise part of the reasons for that judgment. The full judgment with reasons is the only authoritative document. The full text of the judgment and reasons can be found at Judicial Decisions of Public Interest: [www.courtsfnz.govt.nz](http://www.courtsfnz.govt.nz).

This is a case about registration and revocation of trade marks. International Consolidated Business Pty Ltd (ICB) held the registered trade mark ZIPLOC from 8 June 2006, with a deemed date of registration of 22 November 2001. SC Johnson & Son Inc (Johnson) filed a revocation application against ICB's trade mark on 22 April 2013. That trade mark was revoked for non-use on 26 June 2014, effective from 22 April 2013, the date the revocation action was filed. Three days earlier, that is on 19 April 2013, Johnson had applied to register its own ZIPLOC trade mark.

The Assistant Commissioner of Trade Marks held that Johnson's application of 19 April 2013 should not proceed to registration because, at the date of the application, ICB was still the registered owner of the ZIPLOC mark. She also held there were special circumstances under s 26 of the Trade Marks Act 2002 but these did not override ICB's ownership.

The High Court partially overturned that decision and backdated the revocation of ICB's registered trade mark to 19 April 2013. It remitted the matter to the Assistant Commissioner for further determination of the ownership issue.

The Court of Appeal held that Johnson's April application could proceed to registration on the basis that the register is assessed for competing marks only at the date of actual entry of the new mark onto the register. The Court did not consider s 68(2) of the 2002 Act (providing for the backdating of revocation of a trade mark) changed that position.

The Supreme Court granted leave to appeal on the question of whether the Court of Appeal interpreted s 68(2) correctly. It refused leave on broader ownership issues ICB sought to raise.

The Supreme Court has unanimously dismissed the appeal but for different reasons than those given by the Court of Appeal.

The first issue on appeal was when the state of the register is assessed for the purposes of ascertaining whether there are competing marks. The Supreme Court held that the date of assessment is the date of entry onto the register.

The second issue was whether the application date for a trade mark remains relevant. The Supreme Court held that the date of application remains relevant in cases of revocation. This means that an application for revocation must pre-date the application for registration or there must be an application for backdating of revocation under s 68(2). In this case, Johnson's application for registration preceded its revocation application but there was no application for backdating.

The third issue was whether ICB was the owner of the ZIPLOC trade mark at the date of Johnson's 19 April application. Whether the Court of Appeal was correct to hold that Johnson had a legitimate claim to ownership was not before the Supreme Court, leave having been refused on that issue. However, the Supreme Court still needed to address the submission that, because ICB was the registered owner of the ZIPLOC mark at 19 April 2013, Johnson's application cannot proceed to registration.

This depended on the final issue, which is the effect of s 26 of the 2002 Act. Section 26 overrides the prohibition in s 25(1)(a) of registration of identical marks. The Supreme Court held this means that the fact of ICB's registration alone cannot stop Johnson's application proceeding to registration. There was nothing ICB could put forward, other than mere registration, to defeat what the Court of Appeal held to be Johnson's legitimate claim to ownership. There was thus no impediment to Johnson's application proceeding to registration.

The appeal was therefore dismissed.

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