

Zombie Marks Invade New Zealand! How Scared Should the Rest of the World Be?

Michael Handler* and Robert Burrell**

1. Introduction

Is a trade mark whose registration has been revoked nevertheless still an ‘earlier’ registered mark that can block a subsequent application for registration? It is difficult to see any justification for allowing for such a possibility, except in those rare situations where the registration has been revoked on the grounds of non-use but the mark maintains a residual reputation among consumers.¹

It is therefore surprising that the above question has generated controversy around the world, and has been the subject of decisions of apex courts in Singapore and New Zealand. Still more surprising are the outcomes of those decisions. Both the Singapore Court of Appeal, in *Campomar SL v Nike International Ltd (Campomar)*,² and the New Zealand Supreme Court, in *International Consolidated Business Pty Ltd v SC Johnson & Son Inc (ICB)*,³ refused to rule out the possibility of revoked marks turning into ‘zombies’ and blocking the registration of later, similar marks.⁴ Instead, those courts interpreted their laws in such a way that later applicants for registration, in order to avoid the possibility of this situation arising, must take certain practical and procedural steps before filing their applications for registration. This is

* Professor, School of Private and Commercial Law, Faculty of Law & Justice, UNSW Sydney <<https://orcid.org/0000-0001-8980-5099>>

** Professor of Intellectual Property and Information Law, Faculty of Law, University of Oxford; Professor, Melbourne Law School.

Our thanks go to Rob Batty, Emily Hudson, Megan Jones and Ng-Loy Wee Loon.

¹ For discussion, see Lionel Bently and Robert Burrell, ‘The Requirement of Trade Mark Use’ (2002) 13 Australian Intellectual Property Journal 181.

² [2011] SGCA 6 (Singapore Court of Appeal). For commentary, see Tan Teem Jim and Ng-Loy Wee Loon, ‘Intellectual Property’ in Teo Keang Sood (ed), *Singapore Academy of Law Annual Review of Singapore Cases 2011* (Academy Publishing 2012) 366–71.

³ [2020] NZSC 110 (New Zealand Supreme Court (NZSC)).

⁴ The term ‘zombie mark’ was introduced in Michael Handler and Robert Burrell, ‘Zombie Marks? Ceased Registrations, Failed Applications and Citation Objections under Section 44 of the Trade Marks Act’ (2013) 23 Australian Intellectual Property Journal 206. The term was adopted by the Australian Trade Marks Office in *1872 Holdings VOF v Havana Club Holding SA* [2017] ATMO 12 (Australian Trade Marks Office (ATMO)) and subsequently used in *Gaseosas Lux SA v Sanson* [2017] ATMO 151 (ATMO) [11]–[12] and *iGuard Pty Ltd v iGuard Australia Pty Ltd* [2018] ATMO 91 (ATMO) [30]. It differs from the way the term has been used in some US commentary (to refer to abandoned trade marks adopted for re-use by third parties: see, eg, Jerome Gilson and Anne Gilson LaLonde, ‘The Zombie Trademark: A Windfall and a Pitfall’ (2008) 98 Trademark Reporter 1280) and in some EU commentary (to refer to a trade mark containing an artistic work in which copyright has expired: see, eg, Martin Senftleben, *The Copyright/Trademark Interface: How the Expansion of Trademark Protection Is Stifling Cultural Creativity* (Wolters Kluwer 2021) 4).

less than ideal: taking these steps might result in parties having to delay the filing of their applications or, worse still, might not be realistic in some circumstances, causing such parties undue hardship. While the New Zealand Supreme Court did set up a further safeguard for those applicants that do not take these steps (leading to a sensible result in *ICB*), the scope of this safeguard remains highly uncertain. Given that the approach to ‘zombie marks’ in other jurisdictions, such as the EU, the UK and Hong Kong, has not yet been settled by the courts, there is a real risk that if *ICB* were to be followed it would create new problems for applicants for registration in these jurisdictions.⁵

In Section 2 we start by exploring the history of zombie marks in British Commonwealth law, before analysing the *ICB* decision. We then turn in Section 3 to explain the significant new challenges applicants for registration in New Zealand will now face. In Section 4 we seek to explain why both *ICB* and *Campomar* involve a misinterpretation of a provision also contained (in substantially identical form) in UK, EU and Hong Kong law that allows for the ‘backdating’ of the effects of an order for the revocation of registration of a mark on the grounds of non-use, genericide or deceptiveness. It is argued that the courts in *ICB* and *Campomar* mistakenly considered that this ‘backdating’ provision was designed overcome a problem of two identical or similar marks co-existing on the register at the same time, when no such problem will in fact arise. By way of conclusion in Section 5, we make a number of suggestions for reform of New Zealand and Singaporean law, noting that the direction of reform over the past 20 years has been to demand more from owners of registered marks to show that their marks are, in fact, in use.

2. How *ICB* Countenances Zombie Marks in New Zealand

Understanding the significance of the change to New Zealand law brought about by *ICB* requires some appreciation of the position under former twentieth century British Commonwealth law.

Section 19 of the Trade Marks Act 1905 (UK) provided that ‘no trade mark shall be registered’ if it was identical with or sufficiently similar to a mark ‘already on the register’ that belonged to another proprietor. In 1932, in *Palmolive Trade Mark*,⁶ the Comptroller-General was confronted with an argument that even if an applicant for registration managed to persuade

⁵ As will be explored in Section 5, there are additional safeguards in place in the UK and EU for dealing with ‘unused’ marks blocking an applicant’s path to registration that mean that the precise scenario in *Campomar* and *ICB* is less likely to arise. However, the potential for ‘zombie marks’ remains in these jurisdictions where an applicant seeks to have the registration of a conflicting mark revoked on the basis of genericide or deceptiveness.

⁶ (1932) 49 RPC 269 (Comptroller-General).

the court to cancel the registration of the earlier, conflicting mark, this could have no effect on the application of s 19. It was contended that the only relevant consideration was whether the earlier mark was ‘already on the register’ as at the applicant’s filing date, and that events after that date could not be taken into account. The Comptroller-General roundly rejected the idea that the trade marks system countenanced the existence of such zombie marks, determining instead that the command in s 19 that ‘no trade mark shall be registered’ referred:

to the actual making of the entry of the Mark upon the Register; and that, in considering the operation of that Section, regard must be had to the state of the Register at the date upon which the new entry therein is proposed to be made.⁷

Consequently, an applicant could, *after* its filing date, take steps to have the earlier, conflicting registered mark assigned to it, or to have that conflicting registration cancelled (for example, on the basis of non-use) or its scope restricted, such that by the time the registry came to reconsider the application of s 19, that mark no longer remained a barrier to registration. The Comptroller-General recognised that to find otherwise would mean that the applicant would need to file a new application for registration after the registration of the earlier mark had been cancelled, etc, which would ‘present obvious inconveniences’,⁸ in particular, in that the applicant might lose priority if a third party were to file for registration of a similar mark in the meantime. The Comptroller-General did not consider that the fact that a registered proprietor’s rights were backdated to its filing date was any impediment to this interpretation of s 19.⁹

Palmolive was followed in cases decided under the Trade Marks Act 1938 (UK)¹⁰ and in British Commonwealth countries with laws based on that Act. It was adopted by the Australian Office in decisions under the Trade Marks Act 1955 (Cth) where, after the applicant’s filing date, the registration of the earlier, initially conflicting mark had been expunged for non-use¹¹ or had not been renewed.¹² Notwithstanding some recent controversies, this remains the

⁷ *ibid* 276.

⁸ *ibid* 277.

⁹ *ibid* 276.

¹⁰ See, eg, *POLYMAT Trade Mark* [1968] RPC 124 (Board of Trade) 126; *Kambly SA Spécialités de Biscuits Suisses v Intersnack Knabber-Gebäck GmbH & Co KG* [2004] EWHC 943 (Ch) (High Court of England and Wales (EWHC)) [26].

¹¹ See, eg, *Legal & General Life of Australia Ltd v Carlton-Jones & Associates Pty Ltd* (1987) 9 IPR 447 (Australian Patent Office) 451 (following the approach taken in *POLYMAT* (n 10)).

¹² *Roll International Corporation v Teleflora (Australia) Inc* (1997) 40 IPR 318 (ATMO) 321.

Office's approach under Australia's current Act.¹³ The *Palmolive* approach was also embraced by the New Zealand Court of Appeal under the Trade Marks Act 1953 (NZ)¹⁴ and by the IP Office of Singapore under the 1992 revision of its Trade Marks Act.¹⁵ It was recognised by the Singapore Court of Appeal to be 'sensible, pragmatic and realistic',¹⁶ since it did not put the applicant in the risky position of having to file and rely on a new application for registration after the registration of the mark blocking the path of the first application had been revoked.

The starting point for the move away from *Palmolive* came with the passage of the UK's Trade Marks Act 1994. Section 46 of that Act sets out a number of grounds on which a registration may be revoked, including for non-use, genericide, and deceptiveness. Notably, s 46(6) provides:

Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.

Interestingly, s 46(6) was not required by the 1989 Trade Marks Directive,¹⁷ which the 1994 Act was designed to implement. Rather, this provision owes its origins to a similarly-worded provision in the 1993 Community Trade Mark Regulation that established the EU-wide trade mark regime.¹⁸ Virtually identical provisions to s 46(6) were subsequently adopted in new trade mark statutes in Singapore,¹⁹ Hong Kong²⁰ and New Zealand.²¹

The key issue before the Supreme Court of New Zealand in *ICB* was whether *Palmolive* remained good law or whether the position had been altered by s 68(2) of the Trade Marks Act 2002, which replicates s 46(6) of the UK's 1994 Act. The facts of *ICB* are straightforward.

¹³ See, eg, *Omega SA v Robinson* [2012] ATMO 92 (ATMO) [10]–[11]; *1872 Holdings* (n 4) [17]–[31]; *Real Estate Institute of Australia Ltd v REA Group Pty Ltd* [2017] ATMO 82 (ATMO) [28]. On the recent controversies, see Handler and Burrell (n 4).

¹⁴ *Unilever plc v Cussons (New Zealand) Pty Ltd* [1997] 1 NZLR 433 (New Zealand Court of Appeal (NZCA)) 440–41.

¹⁵ *Hugo Boss AG v Reemtsma Cigarettenfabriken GmbH* [2009] SGIPOS 7 (IP Office of Singapore).

¹⁶ *Campomar* (n 2) [18].

¹⁷ First Council Directive 89/104/EEC of 21 December 1988 to Approximate the Laws of the Member States Relating to Trade Marks [1989] OJ L40/1.

¹⁸ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark [1993] OJ L11/1, art 54(1). These origins were not identified in either *Campomar* or *ICB*. As a result, neither the Singapore Court of Appeal nor the New Zealand Supreme Court considered the approach taken at the EU level.

¹⁹ Trade Marks Act 1998 (Singapore) (TMA SG) s 22(7).

²⁰ Trade Marks Ordinance (Hong Kong) cap 559 (TMO HK) s 52(7).

²¹ Trade Marks Act 2002 (NZ) (TMA NZ) s 68(2).

Johnson applied for registration of the word mark ZIPLOC for ‘Plastic bags and plastic film for wrapping purposes’ on 19 April 2013. Anticipating that the relative or ‘conflicts’ ground of refusal in s 25(1) of the 2002 Act would be raised due to ICB’s earlier registered ZIPLOC mark for goods including ‘plastic bags’ and ‘cling wrap’, Johnson applied on 22 April 2013 for revocation of the registration of ICB’s mark on the basis of non-use. On 26 June 2014 the New Zealand registry (IPONZ) determined that ICB’s registration should be revoked. Because Johnson did not seek to argue under s 68(2)(b) that an earlier date should apply, the effect of the revocation order under s 68(2)(a) was that ICB’s rights in its mark ceased from 22 April 2013.²² However, ICB continued to oppose the registration of Johnson’s mark on the basis that, as at Johnson’s filing date of 19 April 2013, ICB’s ZIPLOC mark remained a ‘registered’ mark for the purposes of s 25(1).²³ In response, Johnson argued, consistent with *Palmolive*, that once ICB’s registration was revoked in 2014 it no longer formed a barrier to Johnson’s registration, and that s 68(2) had no role to play in the interpretation of s 25(1)—an argument that found favour with the Court of Appeal.²⁴ The Supreme Court disagreed, instead following the approach taken by the Singapore Court of Appeal in *Campomar* (a case with nearly identical facts²⁵) and by the UK Registry in *RIVERIA Trade Mark* (a decision where the applicant for revocation was seeking to ‘clear the register’ to prevent its own registered mark from being found invalid²⁶).

The Supreme Court’s reasoning in *ICB* has three key parts. In its first part, the Court accepted that for the purposes of s 25(1) the relevant date for assessing the state of the register, and whether there is an earlier mark blocking the applicant’s way, is the date at which the decision-maker is required to determine whether or not the applicant’s mark should be entered on the register. The Court held that the addition of s 68(2) did not change the position under the former law; it did not require the assessment under s 25(1) to be made, once and for all and

²² *International Consolidated Business Pty Ltd v SC Johnson & Son Inc* [2014] NZIPOTM 27 (IP Office of New Zealand (IPONZ)) [70] (*ICB (IPONZ)*). On the need for the applicant for revocation to plead that an earlier date should apply, see *Omega SA v Omega Engineering Inc* [2003] FSR 49 (EWHC) [11].

²³ ICB also sought to argue that Johnson’s application for registration should be rejected on the basis that ICB was the ‘owner’ of the ZIPLOC mark as at 19 April 2013. While this argument was successful at IPONZ (*SC Johnson & Son Inc v International Consolidated Business Pty Ltd* [2017] NZIPOTM 4 (IPONZ)), it was rejected by the Court of Appeal (*International Consolidated Business Pty Ltd v SC Johnson & Son Inc* [2019] NZCA 61 (NZCA), [90]–[91] (*ICB (NZCA)*)) and leave to appeal to the Supreme Court was not granted on this issue (*International Consolidated Business Pty Ltd v SC Johnson & Son Inc* [2019] NZSC 71 (NZSC)). For analysis of this aspect of the litigation, see Earl Gray and Rob Batty, ‘Ownership Jurisprudence under the Trade Marks Act 2002—Past and Future Directions’ (2019) 9 New Zealand Intellectual Property Journal 1.

²⁴ *ICB (NZCA)* (n 23) [83]–[85].

²⁵ The only relevant difference is that in *Campomar* the gap between the applicant’s filing date and the date of cessation of the rights in the mark whose registration was revoked was two months.

²⁶ [2003] RPC 50 (UK Trade Marks Registry (UK Reg)).

in every case, as at the applicant's filing date.²⁷ This aspect of the decision is consistent with *Palmolive*. It means, for example, that if a mark was present on the register at the applicant's filing date but the registration expires before the application comes to be assessed it will not form a barrier to the registration of the applicant's mark. It is also consistent with the approach taken by the UK Registry under current UK law on the specific issue of expired registrations.²⁸

However, in the second part of its reasoning, the Supreme Court held that where the registration of the earlier mark is revoked under s 66 of the 2002 Act (for example, on the basis of non-use, but potentially also on the basis of genericide or deceptiveness), then s 68(2) *does* impact on the question of whether there is an earlier registered mark for the purposes of s 25(1). This was said to be because s 68(2) specifies the date on which the rights in the revoked mark are deemed to have ceased. Following both *RIVERIA* and *Campomar*, the Supreme Court considered that unless the order for revocation of the unused mark is 'backdated' sufficiently far that the owner's rights are deemed to have ceased at a date before the applicant's filing date, then that unused mark must still be taken into account in the assessment of whether there is a conflicting mark under s 25(1).²⁹ To emphasise, as under 46(6) of the UK Act, an order can be backdated in New Zealand in two ways. Under s 68(2)(a) of the 2002 Act an order will always be backdated at least as far as the date of the application for revocation, but under s 68(2)(b) of that Act the order can be backdated still further if the tribunal 'is satisfied that the grounds for revocation existed at an earlier date'.

The Supreme Court justified its approach by noting that s 25(1) 'expressly prohibited' a situation where two conflicting marks were on the register at the same time and it was only in cases where the order for revocation was backdated sufficiently far that this problem could be avoided.³⁰ In the circumstances of the case, where no request for an exercise of the power to backdate the order under s 68(2)(b) had been made, this meant that ICB's unused ZIPLOC mark remained an earlier conflicting mark for the purposes of s 25(1). In so doing, the Supreme Court countenanced the possibility of unused revoked marks turning into zombies.

²⁷ *ICB* (n 3) [43], [45].

²⁸ See *TRANSPAY Trade Mark* [2001] RPC 10 (UK Reg) [16]. This summary is slightly simplistic since account also needs to be had of any period in which an expired mark can be restored to the register. In all of the jurisdictions with which we are concerned this period is six months after expiry. See Trade Marks Rules 2008 (UK) (TMR 2008 UK) r 36; Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark [2017] OJ L154/1 (EUTMR) art 53(3); TMA NZ, ss 59–60; TMA SG, s 19(3); TMO HK, s 50(3).

²⁹ *ICB* (n 3) [47]–[55], [60].

³⁰ *ibid* [53].

This did not, however, result in a successful outcome for ICB, due to the third part of the Supreme Court's reasoning. Unlike in the UK and Singapore (but like in Hong Kong³¹), New Zealand's Act contains a provision, in s 26(b), that allows a mark that falls foul of s 25(1) to be accepted for registration if 'a case of honest concurrent use exists, or *other special circumstances* exist, that, in the opinion of the court or the Commissioner, makes it proper for the trade mark to be registered'. The presence of this proviso can be explained on the basis that even though New Zealand modelled its 2002 Act on Singaporean and post-Directive UK trade mark law,³² it retained some features of its former law, including the 'special circumstances' safeguard.³³ Whereas in *RIVERIA* and *Campomar* the failure to ask for the revocation orders to be backdated was fatal, in *ICB* s 26(b) came to the rescue.³⁴ The Supreme Court noted that ICB had not challenged IPONZ's finding that 'special circumstances' existed because Johnson's filing date was only three days before the date ICB's rights ceased, with those three days covering a weekend. This meant Johnson's ZIPLOC mark could proceed to registration.³⁵

3. Can Zombie Marks Be Despatched? Practical Difficulties for Applicants in New Zealand after *ICB*

Because Johnson ultimately succeeded before the Supreme Court, it needs to be asked whether *ICB* will have much practical impact and, in particular, whether applicants for registration in New Zealand will need to change their filing strategies. The same might be said for applicants for registration in Hong Kong, given that the relevant parts of its trade mark statute are substantially identical to New Zealand's, such that *ICB* is likely to be considered highly persuasive.

Most applicants for registration (in any jurisdiction) will want to file as early as possible. This is to ensure that they can gain priority over a third party that might happen to file for registration of a similar mark at around the same time. It is also to ensure that once their mark is registered, their rights are backdated to the earliest possible date. Well-advised applicants will search the register before filing, but if they identify a potentially conflicting mark and wish to proceed, those applicants will still want to file for registration as soon as is practicable. They can then wait to see if the registry does in fact raise an earlier, conflicting mark as a barrier to

³¹ TMO HK, s 13(1)(b).

³² William Cornish, 'Trade Marks: The Europlan for Trade Marquetry' [2006] New Zealand Law Review 665, 665.

³³ Cf Trade Marks Act 1953 (NZ) s 17(2).

³⁴ *ICB* (n 3) [80]–[81].

³⁵ *ibid* [72], [84].

registration and to deal with that conflict if and when it arises (or at least use the time between filing and the registry's identification of the conflict to consider what strategy to take).

It might be thought that nothing in *ICB* would impact on an applicant for registration in New Zealand adopting the conventional filing approach outlined above. That is, an applicant might still choose to file and wait to see if IPONZ raises an objection under s 25(1) on the basis of an earlier conflicting registered mark, or wait for an opponent to raise s 25(1) as a ground of opposition. Once that objection or ground of opposition is raised, the applicant can then consider whether the registration of the conflicting mark might be vulnerable on the grounds of non-use, genericide or deceptiveness and, if so, file for revocation. If the applicant can satisfy the tribunal that the grounds for revocation existed at a date before the applicant's filing date, that conflicting mark will no longer form a barrier to the registration. And even if the applicant cannot persuade the tribunal to backdate the order for revocation to before the filing date, then although the conflicting mark will technically be a zombie mark as a result of *ICB*, the applicant can still make a case that its application for registration should be accepted on the basis of 'special circumstances' under s 26(b).

There are, however, substantial risks in an applicant choosing to proceed in this way. Most obviously, there is a risk in having to rely on the 'special circumstances' proviso if the tribunal finds that rights in the conflicting mark cease only from a time after the applicant's filing date. At present we have very little guidance on how the special circumstances exception is to be applied. The facts of *ICB*—where the gap between the applicant's filing date and the date on which the rights in the earlier mark ceased was only three days, which included a weekend—are of limited general assistance. Until a body of case law develops, an applicant will not be in a position to know whether its particular circumstances qualify as sufficiently 'special' for its mark to be accepted for registration.

Because of this uncertainty, an applicant seeking to have a conflicting registration revoked will therefore want to ensure that it can persuade the tribunal to backdate the order for revocation to a date before the applicant's filing date. However, an applicant that has adopted the conventional filing strategy outlined above—that is, filing early and waiting to see if s 25(1) is raised by an examiner or an opponent before launching revocation proceedings—can never be sure that the Commissioner or court will backdate the revocation order sufficiently far. This creates a risk for applicants adopting a conventional filing approach in New Zealand, as demonstrated by the following scenario.

Assume that an applicant files for registration on 1 February 2022. In its compliance report IPONZ does not raise s 25(1) but does raise a separate objection (for example, to the

way the applicant's goods are classified). As commonly happens, this takes time for the applicant to resolve, meaning that IPONZ only advertises the mark for registration on 1 November 2022. On 1 February 2023 the owner of an arguably conflicting registered mark files a notice of opposition, raising s 25(1). After investigating whether the opponent's mark is in use, the applicant applies to the Commissioner on 1 March 2023 to have the opponent's registration revoked on the grounds of non-use. To counter this, the opponent needs to be able to show that its mark was in use during the three year period from 1 February 2020 to 1 February 2023.³⁶ If the opponent cannot show this and the registration is to be revoked, the most the Commissioner would be able to do under s 68(2)(b) is find that the grounds for revocation existed as at 1 February 2023 (that is, the end of the three year non-use period). Because this is a year after the applicant's filing date, the opponent's mark will remain a barrier to the registration of the applicant's mark, with no guarantee that the 'special circumstances' proviso will apply to assist the applicant. To avoid this situation, the applicant will need to plead that the grounds for revocation of the registration of the opponent's mark in fact existed as at the applicant's filing date—that is, 1 February 2022. In other words, the applicant will need to allege that the opponent's mark was not in use for a continuous period of more than three-years dating back to 1 February 2019. This is where the applicant will be at a significant risk. If the opponent can point to evidence of use of its mark between 1 February 2019 and 1 February 2020,³⁷ or if its mark was only entered on the Register in this time period,³⁸ the Commissioner will not be able to find that the grounds for revocation existed as at the applicant's filing date. In either of these cases, the opponent's zombie mark will block the applicant's path to registration.

The conventional filing approach is therefore no longer a safe option in New Zealand. An applicant wishing to avoid the potential problems outlined above will now need to devote considerable additional resources to clearing its path to registration. To start, it will need to identify all potentially conflicting earlier registered marks that might form a barrier to registration before it files its application and, if such a mark is identified, it will need to consider

³⁶ See TMA NZ, s 66(1A) (non-use period ends one month before the application for revocation).

³⁷ The latter date is 1 February 2020 because it will already have been established that the opponent had not been able to show any use of its mark from 1 February 2020 to 1 February 2023.

³⁸ This follows from TMA NZ, s 66(1A), which provides that the period of non-use needed to establish a ground of revocation must commence 'from a date after the actual date of registration' (with 'actual date of registration' being defined in contradistinction to the 'deemed date of registration', which is the date of the application for registration in New Zealand or in a convention country: see ss 5 and 51(a)). In the scenario, this means that if the opponent's mark was entered on the register on 1 September 2019, the earliest date on which grounds for revocation potentially existed was 1 September 2022—after the applicant's filing date. See further *ICB (NZCA)* (n 23) [82].

ways of clearing its path. This is, of course, standard practice for large brand owners. But it is not uncommon to find smaller players in the market adopting a ‘hit it and hope’ strategy, self-filing an application or using a ‘filing only’ trade mark service, and seeking legal representation only if the application runs into difficulty. Moreover, even for large and well-established players the additional difficulty and cost will be substantial. Consider, for instance, the well-advised applicant who identifies a potentially conflicting mark, and who conducts investigations that suggest the mark has not been put to genuine use in New Zealand within the previous three years, such that the potentially conflicting mark is vulnerable to revocation. The next step would be to write to the owner of the earlier mark seeking a letter of consent, since this will be the quickest and cheapest way of avoiding the conflict.³⁹ Sending the letter will, however, also serve to put any moderately well-advised party on notice that an application for revocation may be made. If the owner of the conflicting mark is not minded to give its consent, the applicant for registration will from this point be under considerable time pressure. Specifically, within the next month, the applicant for registration will need *both* to file for registration of its mark and apply for revocation of the earlier conflicting mark.⁴⁰

The applicant will need to file for registration of its mark in this period in order to ensure that any subsequent use of the earlier mark will not defeat the non-use action, bearing in mind that the standard of use is very low, such that many owners would have little difficulty in (re)commencing use with 30 or so days’ notice. The applicant will need to apply for revocation in this period to ensure that the three-year non-use period ends before the applicant’s filing date. This is critical because the applicant for registration will ultimately need to ensure that the order for revocation is backdated to before its filing date. In order to guarantee this, the applicant will either (i) need to apply for revocation before filing for registration, thereby bringing itself with s 68(2)(a); or (ii) remember to request that the order for revocation be backdated under s 68(2)(b) in circumstances where it can be confident that such a request will be granted: this will only be the case if the request for revocation is made within the month following the date that the owner of the earlier was put on notice through the sending of the letter of consent.⁴¹

³⁹ Letters of consent have legal force in New Zealand pursuant to TMA NZ, s 26(a).

⁴⁰ See also Malobika Banerji, “‘Deemed Dates’ and Earlier Trade Marks: Singapore Clarifies the Position” (2011) 6 *Journal of Intellectual Property Law and Practice* 520 (discussing the need for new filing strategies after *Campomar*).

⁴¹ See TMA NZ, s 66(3)–(4). In *ICB* (n 3) the Supreme Court showed some awareness of the practical consequences of its decision, but failed to appreciate quite how early the application for revocation would need to be made. It asserted: ‘A warning could still be given at the end of the three-year non-use period, with the application for new registration being lodged at the same time. The revocation application could then be filed later, *after the one-month grace period*, with a request, under s 68(2)(b), that revocation be backdated to the end

This truncated time frame is likely to make it harder for owners of conflicting marks to reach a negotiated settlement: hesitation on the part of the owner of the earlier mark is likely to force the would-be applicant's hand. This is particularly undesirable in cases where the earlier mark is in partial use, but the potential conflict relates to goods and services for which the earlier mark is not being used. In such cases a privately negotiated division of use agreement provides the best means of creating a clear segmentation of markets, thereby minimising the risk of confusion and securing the best outcome for the public as well as the parties concerned.

Importantly, the application for revocation will most likely have to be lodged before the applicant for the later mark has received a compliance report from IPONZ. Yet the compliance report may not cite the potentially conflicting mark at all. Perhaps the most serious problem with the decision of the Supreme Court in *ICB* is that it suffers from a touch of unreality. The Court seemed to assume that it would be relatively straightforward for an applicant to be able to determine, in advance of filing its application for registration, whether it was likely to be confronted with a conflicting mark, such that the new, pre-filing steps that the applicant would need to take would not be especially onerous. In response to Johnson drawing the Court's attention to applicants 'who only find out about competing registrations after the receipt of the examination report from the Commissioner', the Court said:

There are, however, search facilities on the New Zealand Intellectual Property Office website to lessen the risk of an applicant being in this position. There is also a 'search and preliminary advice' service, which is recommended for those who are unfamiliar with the trade mark registration process.⁴²

Such a comment fails to appreciate the substantial difficulties that are often involved in determining whether two marks or two sets of goods or services are 'similar', and whether the applicant's use of its mark would be likely to deceive or confuse. These are some of the most complex issues in trade mark law, not only in New Zealand but throughout the world.⁴³ It will often be the case that even a well-advised applicant will remain in doubt as to whether its path is likely to be blocked by an earlier registered mark. The effect of *ICB* is that applicants will

of the three-year period of non-use (the date of the application for the new registration)': at [57] (emphasis added). The problem with this suggestion is that if the application for revocation is made more than one month after the warning, any use by the registered owner after the warning but more than one month before the revocation application will defeat the non-use application.

⁴² *ICB* (n 3) [59] (emphasis added).

⁴³ For comprehensive analysis of this issue under EU law, see Ilanah Fhima and Dev S Gangjee, *The Confusion Test in European Trade Mark Law* (Oxford University Press 2019).

need to err on the side of assuming that a conflict will arise, go to the expense of investigating whether all potentially conflicting marks are in use, send letters of consent, and then apply for revocation, all before IPONZ has determined whether a conflict exists.

Separate mention must be made of the role of ‘preliminary advice’ services of the type referred to by the Supreme Court. It is true to say that these services can provide an early indication of a registry’s likely response to an application and may help provide a more certain guide as to whether a mark is likely to be cited as a barrier to registration. This is not, however, because those providing the ‘preliminary advice’ are equipped with some special insight into the legal tests that govern conflicts between marks. Rather, it is because in most jurisdictions the person who provides the preliminary advice will be the eventual trade mark examiner. It has long struck us as surprising that this arrangement does not attract more comment or discussion. But irrespective of the merits of this system generally, it was never intended that use of preliminary advice services would become all but compulsory for applicants of all kinds.

In any event, what all of this misses is that there are times when because of quirk in the way a mark has been indexed, or because of a difficult to spot overlap between goods and services, no conflict will be identified until the owner of the earlier mark launches an opposition. By this time there may be little that the applicant can do to secure its registration even in the face of a challenge from an owner of an unused mark. This may provide a significant boon to trade mark squatters who find that applicants are more willing to pay them off, now that clearing a path to registration by bringing an application for revocation has become a less certain and more difficult proposition.

However one looks at it, the effect of *ICB* is to put applicants for registration at significant disadvantage compared to when *Palmolive* applied in an unqualified manner. There may, moreover, be other unanticipated consequences of the Supreme Court’s decision. In particular, there must be an argument that the test for standing for bringing an application for revocation now needs to be revisited. New Zealand, like Hong Kong, has kept a standing requirement for non-use proceedings, requiring an applicant for revocation to establish that it is an ‘aggrieved person’.⁴⁴ The approach adopted by IPONZ is that standing is established if the applicant for revocation has applied to register a mark whose acceptance has been blocked by the mark for

⁴⁴ See TMA NZ, s 65(1). See also TMO HK, s 37(1). For discussion, see Rob Batty and Richard Watts, ‘Aggrieved No More: Is There a Need for Standing to Remove Unused Trade Marks?’ [2013] New Zealand Law Review 1. See also *Health World Ltd v Shin-Sun Australia Pty Ltd* [2010] HCA 13 (High Court of Australia) [34]–[45], strongly criticising the approach taken in a number of earlier Australian cases to standing requirements. In Australia the standing requirement has been abandoned in non-use cases, although it remains for some other mechanisms for challenging the validity of a registered mark.

which revocation is being sought. It is said that in such a case the applicant for revocation will be ‘appreciably disadvantaged in a legal or practical sense if the owner’s registration remains on the register’.⁴⁵ The decision of the Supreme Court may disrupt the operation of the standing requirement in two somewhat different ways. First, there is the problem identified and discussed by Nick Holmes, namely, that applicants for revocation are likely to find it more difficult to demonstrate that they are an aggrieved person if they have not yet filed for registration and have not received an adverse compliance report.⁴⁶ But, as we have seen, this is exactly the sequence that the Supreme Court’s decision seems to demand. Secondly, and conversely, if the applicant only files for revocation after they have applied to register (perhaps because they are unaware of the zombie marks problem⁴⁷ or have taken the view that the best way forward is to rely on the ‘special circumstances’ exception) a different question arises. At this point there is no guarantee that revocation will cure the disadvantage the applicant will face from the mark remaining on the register: the very nature of the zombie marks problem is that such a mark may continue to stand in the way of acceptance. If the legal or practical disadvantage faced by the applicant would not be cured by revocation, it is difficult to see why the applicant should be regarded as an aggrieved person. It is, admittedly, not difficult to imagine that tribunals will go out of their way to seek to avoid problems of standing,⁴⁸ but it remains a matter of real concern that the Supreme Court does not seem to have anticipated these issues.

4. Why *ICB* Should Not Be Followed in the EU, the UK or Hong Kong

In addition to creating a range of practical difficulties for applicants for registration, the Supreme Court’s reasoning in *ICB*, which was based on the Singapore Court of Appeal’s

⁴⁵ See, for example, *ICB (IPONZ)* (n 22) [37]–[38].

⁴⁶ Nick Holmes, ‘New Zealand’s Highest Court Find[s] that “Zombies” Do Exist in New Zealand after All’ (*Institute of Patent and Trade Mark Attorneys of Australia*, 12 February 2021) <<https://ipta.org.au/news/new-zealands-highest-court-find-that-zombies-do-exist-in-new-zealand-after-all/>> accessed 31 August 2021 (drawing attention to *Tui AG v DB Breweries Ltd* [2010] NZIPOTM 31 (IPONZ) which can be read as setting up a requirement that an objection based on a conflicting mark must have been raised by the registry before the applicant for revocation of that mark could be considered to be ‘aggrieved’. For what it is worth, our view is that *Tui* rests on a misreading of *KODIAK Trade Mark* [1987] RPC 269 (Court of Appeal of England and Wales).

⁴⁷ This will inevitably remain the case despite the best efforts of trade mark offices to publicise the issue. It is notable, for example, that the Intellectual Property Office of Singapore has publicised this issue both through Practice Circulars and training sessions for trade mark agents. Our thanks go to Mark Lim of IPOS for bringing these efforts to our attention.

⁴⁸ It is worth drawing particular attention in this context to *Nitro AG v Nitro Circus IP Holdings LP* [2020] NZIPOTM 23 (IPONZ). The owner in that case had sought to argue, consistent with the second problem identified here, that the applicant could not be an aggrieved person if removal of the mark in question from the register would not improve their position. Assistant Commissioner Alley was able to conclude on the facts at hand that the applicant’s position would be sufficiently improved to justify concluding that the applicant had standing, but the broader point being made here stands.

reasoning in *Campomar*, is flawed in allowing for the existence of zombie marks at all. Both courts misunderstood the significance of the fact that an order for revocation on the grounds of non-use, genericide or deceptiveness can be ‘backdated’, and the consequences of the task the decision-maker is required to undertake in assessing conflicts between an application for registration and an earlier registered mark. An appreciation of these errors is vital to understanding how the equivalent backdating provisions for revocation orders contained in the trade mark statutes of Hong Kong⁴⁹ and the UK,⁵⁰ in the current EU Trade Mark Regulation (EUTMR),⁵¹ and in the provisions that EU Member States are required to have in their domestic trade mark laws as a result of the 2015 Trade Marks Directive,⁵² should all be interpreted.

The starting point is to note the circumstances in which the backdating provision clearly does have work to do. Knowing the date of cessation of the rights in a mark whose registration is to be revoked on the grounds of non-use, genericide or deceptiveness is critically important in cases where the party seeking revocation is also being sued for infringement. Under former UK, New Zealand, Singaporean and Hong Kong law the rights in a mark whose registration had been revoked for non-use ceased only on the date the order for revocation was made. This meant that a defendant being sued for infringement, who was successful in seeking to have the registered mark revoked, still remained liable for its infringing conduct (and thus liable to pay damages) up to the date of revocation.

The backdating provision contained in the current UK, New Zealand, Singaporean and Hong Kong statutes, and in the EUTMR and the 2015 Trade Marks Directive, changes this position. It means that a defendant being sued for infringement can have its liability limited, or potentially avoid liability altogether. The default position is that if a registration is revoked for non-use, genericide or deceptiveness, the owner’s rights will be deemed to have ceased from the date of the application for revocation, meaning that the defendant will only be liable for any infringing conduct up to that date. If the defendant can persuade the tribunal that the grounds for revocation existed at an earlier point in time, the owner’s rights will be deemed to have ceased from, and the defendant will only be liable for infringing conduct up to, that earlier date. If the defendant only started using its mark after the date on which the rights in the revoked mark ceased, the defendant will avoid liability entirely. Amanda Michaels discussed

⁴⁹ TMO HK, s 52(7).

⁵⁰ TMA UK, s 46(6).

⁵¹ EUTMR, art 62(1).

⁵² Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to Approximate the Laws of the Member States Relating to Trade Marks [2015] OJ L336/1 (2015 Trade Marks Directive) art 47(1).

the UK's backdating provision in the third edition of *A Practical Guide to Trade Mark Law* in a section titled 'Defences to Infringement under the 1994 Act'⁵³ and, in classifying it as a 'defence', correctly identified its purpose.

There is no indication in any historical material leading to the introduction of the backdating provision in the jurisdictions mentioned above that it was intended to play any additional role. However, in the UK Registry's decision in *RIVERIA* the Hearing Officer considered that the backdating provision is also relevant to the question of whether the mark whose registration has been revoked remains an 'earlier' mark for the purpose of assessing whether there is a conflict with a later, similar mark.⁵⁴ This approach was followed by the Appointed Person in *Starbucks (UK) Ltd v Now Wireless Ltd*,⁵⁵ and by the apex courts in Singapore and New Zealand in *Campomar* and *ICB*, respectively. While the Appointed Person in *Starbucks* merely sought to distinguish EU case law to the contrary,⁵⁶ the courts in *Campomar* and *ICB* provided a positive justification for why they believed the backdating provision had work to do in this context. They considered that if the date of cessation of rights in a revoked mark was later than the applicant's filing date a 'problem'⁵⁷ or an 'undesirable situation'⁵⁸ would arise, in that 'there would be two identical or ... similar marks on the register at the same time at some point'.⁵⁹ In *Campomar*, it was said that the legislator 'could not have contemplated or sanctioned that',⁶⁰ while in *ICB* it was said that 'having two similar or identical marks belonging to different parties on the register is expressly prohibited by s 25(1) of the 2002 Act'.⁶¹ It was thought that one of the objects of the backdating provision was to overcome this problem.⁶²

A positive feature of both *Campomar* and *ICB* is that the courts attempted to read their trade mark statutes as a whole and make sense of the way in which a complex set of provisions interoperated. The reasoning in these cases is, however, unsustainable.

The courts in *Campomar* and *ICB* lost sight of the fact that the decision-maker's task in assessing whether there is a conflict between an application for registration and an earlier

⁵³ Amanda Michaels, *A Practical Guide to Trade Mark Law* (3rd ed, Sweet & Maxwell 2002) [4.75].

⁵⁴ [2003] RPC 50 (UK Reg) [15], [20].

⁵⁵ [2011] RPC 13 (Appointed Person). See also *Skyclub* (O/462/20, 18 September 2020) (Appointed Person) [18]–[19] (considering that the same outcome would apply under the EUTMR).

⁵⁶ *Starbucks* (n 55) [26]–[34]. Cf Case R787/2005-2 *Mejerigaarden Holdings A/S v Berentzen Brennereien GmbH & Co KG* (OHIM Second Board of Appeal, 23 January 2007).

⁵⁷ *Campomar* (n 2) [29].

⁵⁸ *ICB* (n 3) [52].

⁵⁹ *Campomar* (n 2) [29].

⁶⁰ *ibid* [38].

⁶¹ *ICB* (n 3) [52].

⁶² *Campomar* (n 2) [29], [40]; *ICB* (n 3) [55].

registered mark is essentially a forward-looking one. As *Palmolive* recognised, it looks to the consequences of a mark being entered on the register from the date of that entry.⁶³ The only relevant question should be whether, at *that* point in time, an earlier, registered mark does or does not exist. This is because the entire rationale of the ‘conflicts’ ground of refusal is to ensure that a later mark is not put on the register (where the rights in the mark will be backdated to the filing date) when this would impact on the rights that the owner of an earlier, conflicting mark *continues* to have. However, if the initially conflicting mark is no longer registered at the time the conflicts ground of refusal is being considered—meaning that the former proprietor no longer has exclusive rights in the mark at that time—that should be the end of the inquiry. From this forward-looking perspective, the ‘problem’ identified in *Campomar* and *ICB* is illusory.

The weight placed by the courts on not having two conflicting marks on the register at the same time therefore requires unpacking. As between trade mark owners and third parties this cannot be a concern (or at least not one of sufficient magnitude that would justify the creation of zombie marks). Letters of consent and exceptions to the usual operation of the relative grounds of refusal (such as honest concurrent use) anticipate the possibility of conflicting marks being on the register. There is no obvious normative problem with third parties being exposed to double liability if they are trespassing on the rights of two previous trade mark owners and this could occur even if one adopted the strictest possible position on not having conflicting marks on the register at the same time.⁶⁴ What the courts really seemed to be concerned about was the possibility of setting up a situation where different parties had *as between each other* ‘overlapping’ exclusive rights, which the courts believed the conflicts ground of refusal was designed to avoid. That is, they considered it to be a problem if Y’s mark were to be entered on the register after X’s registration had been revoked, where Y’s rights would be backdated to its priority date (say, 19 April 2013), in circumstances where X’s mark *was* on the register at that date and where X had exclusive rights for a period of time that is now covered by Y’s registration (say, up to 22 April 2013). This might seem to be a problem, until it is remembered that we are only interested in a state of affairs where Y’s mark has been entered on the register at a point in time when X’s registration has already been revoked. At

⁶³ *Palmolive* (n 6) 276.

⁶⁴ This is because mark C might always conflict with both mark A and mark B in circumstances where there is no conflict whatsoever between A and B (as, for example, where C is a composite mark made up of the word NIKE and the Adidas three stripe device for sporting goods).

that point, X no longer has any enforceable rights in its formerly-registered mark, irrespective of the date on which its rights were deemed to have ceased.

Staying with the above example, while X might once have had exclusive rights in its mark from 19–22 April 2013, by the time Y’s mark is entered on the register (that is, after the revocation of X’s registration) X can no longer take any action against Y in relation to Y’s conduct before 22 April 2013. With X no longer having any rights, no problem of ‘overlapping’ exclusive rights ever arises. This is not something that the conflicts ground of refusal is designed to prevent, nor is there any ‘problem’ here that needs to be addressed by the backdating provision.

The approach taken in *Campomar* and *ICB*, which confuses the effect of marks being registered or ‘on the register’ with the dates from which a registered proprietor’s rights take effect and cease, should not be followed in the other jurisdictions we are considering. Importantly, the EU has already moved in the opposite direction, towards the position for which we are advocating. Although the EUTMR and the 2015 Trade Marks Directive do not specifically state that it is the ‘registration’ of the mark that is to be revoked for non-use, genericide or deceptiveness,⁶⁵ which might give rise to formalistic arguments that such a mark can somehow remain an earlier ‘registered’ mark for the purposes of the conflicts ground of refusal, this is not the way that revocation is understood in the EU. As Annette Kur and Martin Senftleben have argued with reference to the position under the EUTMR:

[e]ven though revocation will not lead to invalidity *ex tunc*, the ground for refusal [on the basis of a conflict with an earlier, registered mark] must exist ... at the time of the decision. A trade mark registration that has been revoked no longer has the effects of a trade mark registration (see [art 62(1)]) and can therefore not be held against another trade mark in opposition proceedings.⁶⁶

This explains why oppositions are routinely suspended by the EUIPO if the earlier right is ‘at risk’, for example, because the applicant for registration has sought to have the registration of the opponent’s earlier, conflicting mark revoked on the basis of non-use.⁶⁷

⁶⁵ Article 58(1) of the EUTMR provides that the ‘rights of the proprietor of the EU trade mark shall be declared to be revoked’ while art 19 of the 2015 Trade Marks Directive provides that ‘[a] trade mark shall be liable to revocation’.

⁶⁶ Annette Kur and Martin Senftleben, *European Trade Mark Law: A Commentary* (Oxford University Press 2017) [11.88].

⁶⁷ See European Union Intellectual Property Office, *Guidelines for Examination of European Union Trade Marks: Part C: Opposition: Section 1: Opposition Proceedings*, part 7.3.2 <<https://guidelines.euipo.europa.eu/binary/1803468/2000160000>> accessed 31 August 2021.

It is to be hoped that UK courts will embrace the EU approach, rather than the approach adopted in Singapore and New Zealand. This is particularly important in the UK because, as we will see in the final Section of this article, there are additional consideration of ‘fit’ that point against the *Campomar* / *ICB* interpretation.

5. The Way Forward

The fact that the Singapore Court of Appeal in *Campomar* and the New Zealand Supreme Court in *ICB* interpreted their trade mark statutes in a manner that countenances the existence of zombie marks is regrettable. Although both courts were dealing with complex issues of statutory interpretation, their approaches were not supported by the histories of the statutes and have led to normatively undesirable outcomes for applicants for registration. These approaches should not be followed by tribunals in Hong Kong, the UK and the EU when they come to interpret their legislative provisions that allow for the backdating of orders for revocation.

In order to consider the best way forward, it is necessary to take a detour into provisions that now govern trade mark oppositions under UK and EU law.⁶⁸ In these jurisdictions there is the possibility of putting the owner of the earlier conflicting mark to proof of use if it wishes to rely on an earlier registered mark as the basis for an opposition. There is no need for the applicant to launch revocation proceedings and, in the UK at least, the procedural requirements for putting the opponent to proof of use are minimal. To expand on the position in the UK, an opponent to registration wishing to rely on an earlier registered mark must generally lodge a ‘statement of use’. A statement of use is required for all marks registered for more than 5 years at the priority date (this being the period post-registration in which use of a mark must have commenced, subject to there being exceptional circumstances justifying non-use). The statement of use must detail whether the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use.⁶⁹ Importantly, moreover, applicants for registration who are not prepared to accept the statement of use at face value can put the opponent to proof of use simply by ticking a box on the ‘notice of defence and counterstatement’.⁷⁰ If the use conditions are not

⁶⁸ The relevant provisions of UK law are referenced below. In the EU, see EUTMR, art 47(2); 2015 Trade Marks Directive, art 44.

⁶⁹ See TMA UK, s 6A (added by the Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004/946)); TMR 2008 UK, r 17(5)(d).

⁷⁰ See Form TM8: Notice of Defence and Counterstatement <<https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees>> accessed 31 August 2021. Applicants who wish to contest an opposition are always required to file such a notice: TMR 2008 UK, r 18. For ‘fast track’ oppositions governed by r 17A opponents have to lodge proof of use with the notice of opposition, helping to establish proof of use as the default.

met, the registrar will not refuse to register the trade mark by reason of the earlier trade mark, but the registration of the earlier trade mark is not automatically revoked.⁷¹

The proof of use provisions under UK and EU law are significant in a number of ways. First, they mean that the type of scenario that gave rise to *Campomar* and *ICB* is less likely to arise. In this respect introducing a proof of use requirement for oppositions would offer a partial solution for New Zealand and Singapore. It must, however, be remembered that an applicant for registration might be seeking to have an earlier mark expunged from the register on a ground other than non-use, such as for genericide or deceptiveness, that will also not result in the mark being declared invalid *ex tunc*. It is for this reason that the broader issue of interpretation raised in *Campomar* and *ICB* remains important in the UK and EU and why the introduction of a proof of use requirement for oppositions would not solve all of the issues in Singapore and New Zealand.

A second, quite different, way in which the proof of use requirement is significant is that it undercuts the notion that the legislature cannot have intended ‘overlapping’ marks to be on the Register at the same time. By preventing an opponent from succeeding in an opposition but without causing the registration of the earlier mark to be revoked, such overlapping is exactly what the proof of use procedure contemplates. Consequently, there is a case to be made that considerations of fit also point against the adoption of the *Campomar* / *ICB* interpretation in the UK and EU. One might go further, however, and note that in these jurisdictions it is by no means uncommon to find overlapping marks on the register. This is because trade mark offices in these jurisdictions do not seek, *ex officio*, to prevent conflicting marks from being entered onto the register. In these jurisdictions owners of marks are solely responsible for policing their own rights through the medium of opposition proceedings. Owners not infrequently decide not to launch an opposition even though there may be a paper conflict with a later application. This may, for example, be because further research causes them to realise that although there may be a conflict on paper, there will be little danger of conflict in practice. This creates a further consideration of fit that points against the adoption of the New Zealand and Singapore rule. But it also reminds us that in reality trade mark registers are cluttered and noisy. Letters of consent, exceptions to the usual bars on registrability, and oversight and error will inevitably lead to circumstances where there are overlapping rights on the register. It is for this reason that many countries, including New Zealand, provide for ‘registration defences’ (that is, provisions to the effect that a registered trade mark is not infringed by the use of another

⁷¹ TMA UK, s 6A(2).

registered trade mark in relation to any goods or services for which that other trade mark is registered⁷²). The elimination of overlaps is a worthy goal, but it ought not to drive out all other considerations of policy. This is particularly true in a case where, as we have sought to demonstrate in Section 4, no real problem of overlapping rights ever truly arises.

We are now in a position where it is almost certainly for legislatures in Singapore and New Zealand to kill off zombie marks in those jurisdictions. This could be achieved by stipulating that when a registration is revoked, the date on which the rights of the proprietor shall be deemed to have ceased has no impact on whether or not that mark is to be considered to be an ‘earlier’ registered mark for the purposes of the conflicts ground of refusal, thus restoring the *Palmolive* approach. In Hong Kong, the EU and the UK courts can still guard against marks crossing back across the Styx, but ultimately a legislative amendment in these jurisdictions might also be the surest safeguard.

⁷² See TMA NZ, s 93.