



HIGH COURT OF AUSTRALIA

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Details of Filing

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IN THE HIGH COURT OF AUSTRALIA
SYDNEY REGISTRY

No. S140 of 2025

BETWEEN:

ZIP CO LIMITED
First appellant

ZIPMONEY PAYMENTS PTY LTD
Second appellant

AND:

FIRSTMAC LIMITED
Respondent

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RESPONDENT'S OUTLINE OF ORAL SUBMISSIONS

I CERTIFICATION

This submission is in a form suitable for publication on the internet.

II OUTLINE OF ARGUMENT

1. The date of the application of the defences (appeal ground 2): Section 122(1)(f) and (fa), read with s 44(3)(a), of the *Trade Marks Act* 1995 (Cth) apply to a person's use of a trade mark, and are considered, at the time of the person's use in issue (RS [2], [11]).

20 Registration gives the owner the exclusive right to use the trade mark and the right to obtain relief under the Act if the trade mark has been infringed (s 20(1), (2); RS [12]). Those rights accrue from the “*date of registration*” which is taken to be the filing date in respect of the application for registration (s 20(3), s 72(1); RS [17]). There is a limitation for concurrent registered rights (s 23; RS [17]).

3. Registration is obtained by an application process (Pt 4), with or without an opposition (Pt 5) followed by registration (Pt 7) (RS [14]). An application that must be rejected under s 44(2) (substantially identical with or deceptively similar to another trade mark whose “*priority date*” is earlier registered in similar services) may be accepted under s 44(3)(a) if the Registrar is satisfied that “*there has been honest concurrent use of the 2 trade marks*” (use in the period before and up to the priority date of the application) (RS [18]-[19]).

30 4. The “*priority date*” is the “*date of registration of the trade mark*” (actual or prospective), i.e., the filing date (ss 6, 12 and 72(1); RS [15]). The priority date is significant as: (i) the rights of the parties are determined at the priority date (RS [16]; *Southern Cross; Reg. of TM v Woolworths*); (ii) it is the date from which registration takes effect and rights taken to have accrued (RS [17]).

5. Registration on the basis of honest concurrent user does not, of itself, absolve the owner of the later registered mark of liability in an infringement action in respect of the period of use before the priority date (RS [19]).

6. A person infringes a registered trade mark if a person uses a substantially identical or deceptively similar trade mark in relation to services in the ways in s 120 (RS [12]). By s 122, the use of such a trade mark in a manner in s 120 does not infringe when the circumstances and nature of that use meet the conditions in paras (a)-(g) (RS [20]-[21]). These are directed to the same time. Read harmoniously, s 122(f)(/fa) takes a person's use of a sign (s 120(1)) and asks, in respect of that use, would the person obtain registration of that sign in the face of the earlier registered mark (s 122(f)(/fa)(ii), s 44(3)(a)). The time of the person's use provides the notional priority date of the notional application for registration (RS [20]-[21]).

10 7. There is no textual (or other) reason why the question of registrability should be considered at the time of filing a defence to the action or some later time (RS [21]; *cf.* AS [65], ASR [17]).

8. The respondent's construction: (i) best achieves the purpose of the Act (*Self Care* at [22]; RS [22]); (ii) is supported by the legislative history (RS [23]-[26]); (iii) is consistent with the trend of authorities—there is no authority to the contrary (RS [27]-[31]). It is not an exercise of wholly backward-looking forgiveness (*cf.* ASR [17]).

9. The Full Court correctly applied the defence at the time when the conduct started in November 2013 (an unchallenged finding) (FCJ [3], [8], [10] CAB 158-160; [61]-[62] CAB 181. At that date: (i) the use was not honest (FCJ [16] CAB 162; [75]-[76] CAB 185); (ii) there was no concurrency of use to satisfy honest concurrent use (FCJ [76] CAB 185).

10. **Honest concurrent user (appeal ground 1):** Honest concurrent user derives from the common law as an accommodation between the rights of the public not to be confused or deceived about the origin of products and the rights of traders who had legitimately built up goodwill in similar signs in public use (*Campomar*; RS [37]). It usually arises in the registration context where the later user prudently applies and presses their application (not this case).

11. The appellants' approach (in which honesty is subjective, focussing on honesty of adoption, balanced against objective criteria) should not be accepted (RS [38]): (i) It is not based on the statutory text. (ii) The so-called *McCormick* factors are not exhaustive and all surrounding circumstances should be considered before a trade mark is given the privilege of concurrent registration (*Re Electrix Ltd's App'n*). (iii) It wrongly excises “*honesty*” from “*concurrent use*”, confines “*honesty*” to the time of adoption and separates it from both use and knowledge of the earlier registered mark. Honesty of adoption is not to be equated with honesty

of use and those concepts should not be conflated (*Fanatics*; RS [58]). (iv) The consequences would be inconsistent with the Act's purposes.

12. The proper approach: The assessment of honest concurrent user is an exercise of characterisation. It calls for an assessment, at the relevant date, of the person's conduct in all the circumstances, including the person's motives and knowledge and having regard to the conduct's potential and actual effects, measured against the standard of commercial honesty such as may justify the moderation of the existing trade mark owner's exclusive rights by affording to the person their own registration and accompanying rights (RS [39], [60]).

13. This is supported by: (i) *Alex Pirie and Parkington* (RS [41]-[46]); and (ii) the good 10 faith cases (RS [47]-[50], [52]-[56]). The principles align: there is no line of demarcation, no distinct doctrinal basis (*cf.* ASR [6]-[7]).

14. An objective test taking into account all the circumstances for honest concurrent user coheres with: (i) the Act (see the good faith cases and s 62A for an application made in bad faith); (ii) equity and related areas (*Farah Constructions* at [173]; RS [60]); (iii) the UK ("*in accordance with honest practices in industrial or commercial matters*"), *Flexopack*; RS [56]).

15. The Full Court did not err (RS [61]-[62]). It recognised the distinction between adoption and use (FCJ [10], [14], [16] CAB 160-162; FCJ [72]-[73], [75]-[76], [82]-[83] CAB 184, 185, 187) and applied an objective test (FCJ [63], CAB 181). It took into account the facts as to adoption and the appellants' actual knowledge of Firstmac's registration and the direct conflict 20 with their proposed use before that use commenced (FCJ [68]-[72] CAB 183; FCJ [9]-[10] CAB 159). Fixed with knowledge, the appellants took a risk (FCJ [10], [16] CAB 160-161; FCJ [72]-[73], [88]-[89] CAB 184, 188). This was not commercial honesty (FCJ [3], [16] CAB 184; FCJ [73], [76] CAB 184).

16. Even if a later date applied, the defence would not be made out (FCJ [76] CAB 185; RS [63]).

17. **Ground of cancellation (s 88(2)(c)) (contention ground 1) and discretion not to cancel (s 89) (appeal ground 3; contention ground 2):** The ground in s 88(2)(c) is not made out on actual use (RS [66]; PJ [377]-[378] CAB 126; FCJ [165] CAB 219). Regardless of the defence, in light of the facts and the principles embodied in the discretion, there is no error in 30 Firstmac's retaining its long-standing registration (FCJ [153]-[157], [174]-[180] CAB 214-217, 222-223).

Dated: 12 February 2026



H P T Bevan