



HIGH COURT OF AUSTRALIA

15 March 2023

SELF CARE IP HOLDINGS PTY LTD & ANOR v ALLERGAN AUSTRALIA PTY LTD &
ANOR
[2023] HCA 8

Today, the High Court allowed two appeals from the Full Court of the Federal Court of Australia. The appeals concerned whether Self Care IP Holdings Pty Ltd and Self Care Corporation Pty Ltd (collectively, "Self Care") infringed one of Allergan Inc's BOTOX trade marks under the *Trade Marks Act 1995* (Cth) ("the TM Act") and whether Self Care contravened the Australian Consumer Law in Sch 2 of the *Competition and Consumer Act 2010* (Cth) ("the ACL").

Allergan Inc manufactures Botox, an injectable pharmaceutical product containing botulinum toxin, and is the registered owner of the BOTOX trade mark. Self Care supplied cosmetic products, including the anti-wrinkle skincare products Inhibox (which it described on its packaging and website as an "instant Botox® alternative") and Protox (which used the trade mark PROTOX on its packaging and website). Allergan Inc, and its subsidiary Allergan Australia Pty Ltd (collectively, "Allergan") brought proceedings in the Federal Court of Australia claiming, among other things, that Self Care had infringed the BOTOX trade mark under s 120(1) of the TM Act by using deceptively similar trade marks – "instant Botox® alternative" and PROTOX – and had contravened ss 18(1) and 29(1)(a) and (g) of the ACL by conveying misleading representations about the long term efficacy of Inhibox.

The primary judge found that Self Care's use of "instant Botox® alternative" and PROTOX did not infringe the BOTOX trade mark and that Self Care's use of "instant Botox® alternative" in relation to Inhibox did not contravene the ACL. On appeal, the Full Court of the Federal Court held that both "instant Botox® alternative" and PROTOX infringed the BOTOX trade mark. The Full Court relied on the reputation of BOTOX, holding that PROTOX was deceptively similar because some potential customers would wonder whether Allergan had decided to expand into topical cosmetic anti-wrinkle products. The Full Court also held that Self Care's use of "instant Botox® alternative" contravened the ACL by representing that the wrinkle reducing effects of Inhibox would last, after treatment, for a period equivalent to that which would be achieved with treatment by a Botox injection ("the long term efficacy representation").

Self Care appealed to the High Court. The High Court unanimously held that Self Care did not use "instant Botox® alternative" as a trade mark and therefore the question of deceptive similarity under s 120(1) of the TM Act did not arise. As the parties did not dispute that Self Care used PROTOX as a trade mark, the determinative question was whether PROTOX was deceptively similar to BOTOX. The Court held that, when assessing deceptive similarity under s 120(1), reputation of the registered trade mark and that of its owner is not relevant. PROTOX was not deceptively similar to BOTOX because the similarities between the marks, considered in the circumstances, were not such that the notional buyer was likely to wonder whether the products came from the same trade source. Self Care did not contravene the ACL because the reasonable consumer would not have understood that the phrase "instant Botox® alternative", in context, conveyed the long term efficacy representation.

- *This statement is not intended to be a substitute for the reasons of the High Court or to be used in any later consideration of the Court's reasons.*